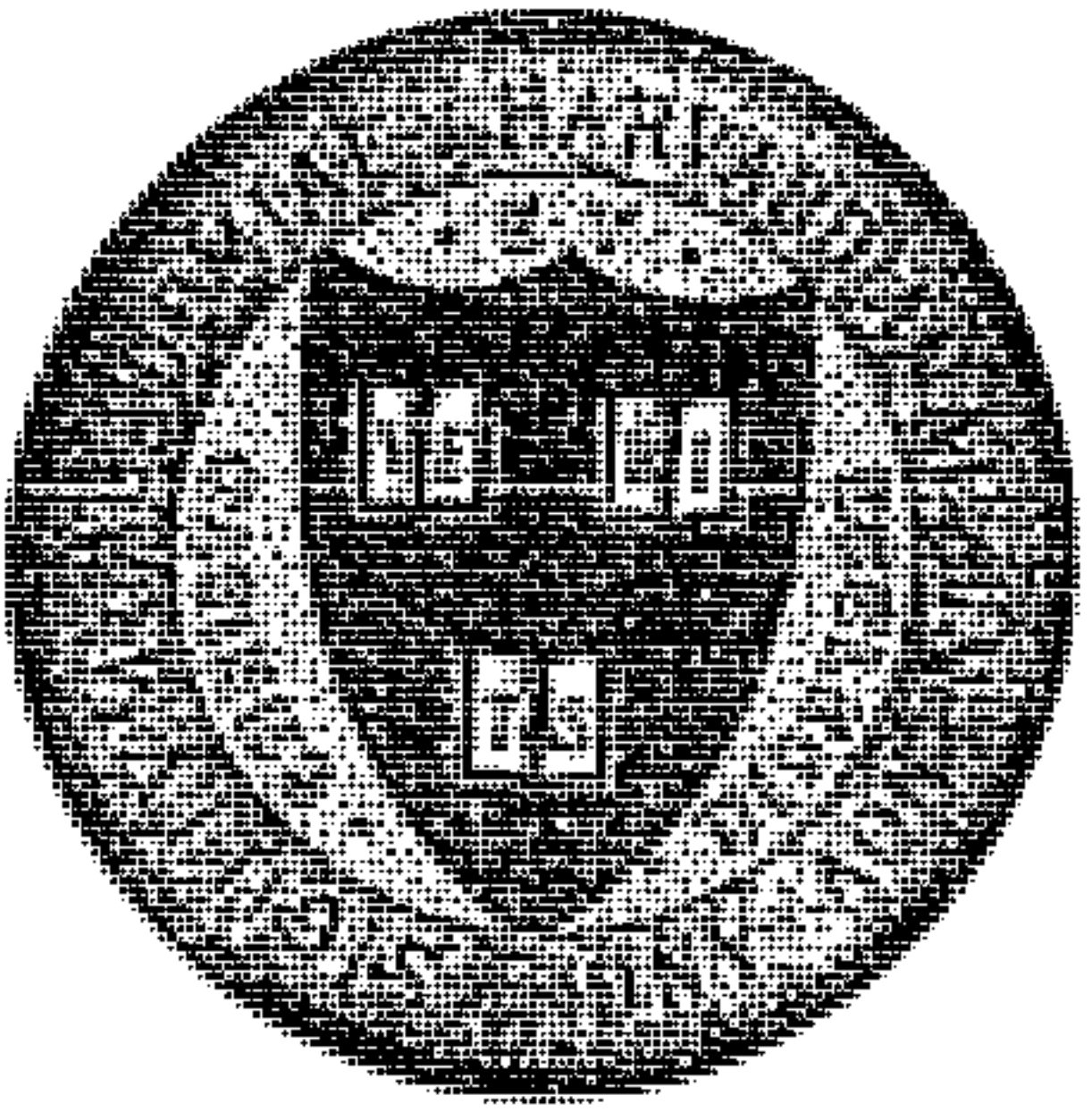
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DESIGNS, TRADE MARKS

ETC.

A MANUAL OF PRACTICAL LAW

BY

WYNDHAM ANSTIS BEWES, LL.B.

OF LINCOLN'S INN, BARRISTER-AT-LAW

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ADAM AND CHARLES BLACK

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PREFACE

It has been thought well to include in this Handbook all the principal legal monopolies depending on invention, and for this reason the law of copyright finds a place in close relationship with the law of patents.

The Author is conscious that the book is open to criticism, as well on account of what it omits as of its inclusions; but in writing, under somewhat strict conditions, a volume that is intended to be very concise, and, as far as the subjects permit, of a popular nature, it is impossible to fulfil the requirements of every critic, or even of the Author himself. Some will no doubt object to the meagre reference to points of practice, others that practice should have been wholly excluded. A similar difference of opinion will manifest itself regarding the citation of cases.

The reader is warned that a Copyright Bill (H. L. 7) was this year introduced into the House of Lords by Lord Monkswell, acting at the request

of the Society of Authors; that it reached the stage of second reading; and that this Bill, whatever its ultimate shape, is bound to alter in many important particulars the existing law on the subject.

In conclusion, the Author should be thankful for any communications pointing out errors in commission or omission, so that future editions may be as far as possible complete.

W. A. BEWES.

11 STONE BUILDINGS,
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1st August 1891.

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Anst.	Anstruther.
App. Cas.	Appeal Cases.
B. and A.	Barnewall and Alderson.
B. and S.	Best and Smith.
Barn.	Barnardiston.
Beav.	Beavan.
Burr.	Burrow.
C. B.	Common Bench.
C. B., N. S.	Common Bench, New Series.
C. P.	Common Pleas.
C. and P.	Carrington and Payne.
Ch.	Chancery Appeals.
Ch. D.	Chancery Division.
Co. R.	Coke's Reports.
Dec. Ct. Ses.	Decrees of the Court of Session.
Eq.	Equity.
Ex. Rep.	Exchequer Reports.
H. L.	House of Lords Appeals.
H. L. C.	House of Lords Cases.
H. and N.	Hurlston and Norman.
Giff.	Giffard.
J. and H.	Johnson and Hemming.
Jac.	Jacob.
Jur.	Jurist.
K. and J.	Kay and Johnson.
L. J.	Law Journal.
L. T.	Law Times.
M. and R.	Moody and Robinson.
M. and W.	Meeson and Welsley.
Mac. and G.	Macnaghten and Gordon.
Q. B.	Queen's Bench.
Q. B. D.	Queen's Bench Division.
R. P. C.	Reports of Patent Cases.
S. and S.	Simon and Stuart.
Sim.	Simon.

Stark . . .	*Starkie.*
T. R. . . .	Term Reports (Durnford and East's).
Tyr. . . .	Tyrwhitt.
Ves. . . .	Vesey, junior.
W. N. . . .	Weekly Notes.
W. R. . . .	Weekly Reporter.
Web. . . .	Webster's Patent Cases.
Wils. C. C. . .	Wilson's Chancery Cases.

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PATENTS.—Edmunds, 1890; Goodeve, 1878; Higgins, 1890; Lawson, 1889; Carpmael, 1889; Bryce, 1884; Terrell, 1884; Waggett (*Prolongation*), 1886; Morris (*Conveyancing*), 1887; Hindmarch, 1846; Frost, 1891.

DESIGNS.—Lawson, 1889; Bryce, 1884.

TRADE MARKS.—Sebastian, 1890; Aston, 1884; Terrell, 1884; Lawson, 1889.

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PART I

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COPYRIGHT

INTRODUCTION

THE popular idea of the meaning of the word "copyright" corresponds in the main with the legal usage of the word, and is interpreted to be, so far as concerns certain subjects to which the word may be applied, "the sole and exclusive liberty of printing or otherwise multiplying copies" (5 and 6 Vict., c. 45, s. 2).

For the purpose of ascertaining the condition and principles of the existing law, it is unnecessary to pursue historical studies with any minuteness, as ever since the reign of Queen Anne copyright has existed only as the creation of statutes. It will be sufficient, in considering this part of our subject, to remember that shortly after the invention of printing and its introduction into England, the Crown successfully claimed on the ground of prerogative—first, general censorial rights over all matter printed and to be printed; secondly, from the time of the Reformation the power of granting, as a monopoly, the right of printing or selling books. The censorial jurisdiction of the Star Chamber is to be traced to the first claim, and to the second the foundation by Queen Mary of the Stationers Company, with the privilege of printing confined to its members.

The suppression of the Star Chamber gave occasion for the Licensing Act of 1662 (13 and 14 Car. II, c. 33), which was a temporary measure renewed, with intervals,

until the year 1695. The extinction of the licensing authority left authors of works and owners of copyrights with most imperfect remedies for the protection of their property, and so gross did literary piracy become that in the year 1709 the first Copyright Act (8 Anne, c. 21) was passed.

This Act, besides giving a monopoly to the owners of works already published for the term of twenty-one years from 10th April 1710, gave to the author of any book, not already published, the sole liberty of printing and reprinting the same for the term of fourteen years from the date of publication, and, if the authors were living at the end of this term, a further term of fourteen years.

The most instructive case to show the change wrought by this Statute is *Donaldson* v. *Becket*, 4 Burr. 2408, which went to the House of Lords, which decided in accordance with the views of the majority of the Judges:

1st. That at Common Law (*i.e.* by the law not contained in Statutes) the author of any book or literary composition had, before the Statute of Anne, the sole right of first printing and publishing the same for sale; and might bring an action against any person who printed, published, and sold the same without his consent.

2d. That the Common Law did not take away his right, upon his printing and publishing such book or literary composition.

3d. That such right of action was taken away by the Statute of 8th Anne, s. 19, the author having thereafter only the rights and remedies given or reserved by that Statute.

This Act was repealed by 5 and 6 Vict., c. 45, the provisions of which will be found in the following pages, *passim*.

CHAPTER I

RIGHTS OF AUTHORS PREVIOUS TO PUBLICATION

PREVIOUS to publication an author has absolute control over his own production, and this whether it be literary, artistic, or any other work. It is within his power to determine whether he will publish at all, and under what conditions. If he decline to publish, no unauthorised person may publish his production. The right of secrecy descends to the author's representatives, and is of so personal a nature that it does not pass to the official receiver, in the event of bankruptcy; although, if the work were published during the bankruptcy, the creditors could claim the benefit.

The leading case on this branch of the subject is *Prince Albert* v. *Strange* (1849), 1 Mac. and G. 25, in which it was proved that Her Majesty the Queen and the Prince Consort both etched certain plates, partly from drawings made by themselves and partly from old engravings; that occasionally and very rarely copies of such etchings had been given to some of their personal friends. Certain plates were confided to a Mr. Brown, of Windsor, with instructions to take a definite number of impressions; but an employé of his, in breach of confidence, took extra impressions, which came into the possession of Strange, who proposed to exhibit them to the public. The Lord

Chancellor, in upholding an injunction, held that the defendant had no right even to publish a descriptive catalogue, much less to exhibit the engravings. Mr. Justice Yates said, in *Millar* v. *Taylor* (1749), 4 Burr., p. 2379: "Ideas are free. But while the author confines them to his study, they are like birds in a cage, which none but he can have a right to let fly."

Closely connected with the above is the right of preventing publication of private or confidential communications, whether oral or written, as Lord Eldon once said: "If one of the late king's physicians had kept a diary of what he heard and saw, this Court would not, in the king's lifetime, have permitted him to print and publish it;" nor, it is presumed, even after his death, if his representatives objected. Persons who write "reminiscences" would do well to remember this and what follows.

Letters written by one person to another, and not intended for publication, cannot be published by the receiver without the consent of the sender, though the receiver owns the paper on which the letter is written, and may recover it even from the sender, if it is returned to him without the intention that the property should pass. The sender's right of secrecy is based on breach of confidence and of the author's right to publish. Thus, in 1741, the poet Pope succeeded in stopping the sale of his private correspondence, which had already been published in Ireland; and Lord Chesterfield's executors in 1774 prevented the publication of his letters to his son, though the book was subsequently published with their consent.

The receiver may show the letter to others, provided he be not thereby publishing a libel, or even may read it aloud to several persons at once, unless there is an agreement to the contrary express or implied, *e.g.* if a con-

dition of privacy were imposed. It seems that even letters marked "private" may be published, if necessary to the defence of character. They may also be printed in a fair report of proceedings in a Court of Justice, if published without malice—*White* v. *Dickson* (1881), 8 Dec. Ct. Ses., 4th Ser., 898. The receiver has, of course, the right to destroy unless there be a condition to the contrary express or implied.

Letters sent for publication, *e.g.* to the editor of a newspaper, may be withdrawn by the writer before publication—*Davis* v. *Millar* (1855), 17 Dec. Ct. Ses., 2d Ser., 1166.

The rights in respect of correspondence, written or received by a servant or agent in the course of his employment, are in the principal; and so, too, where a person alleges untruly that he acts on behalf of a principal. An employé may be prevented by injunction from divulging secrets or confidential communications learnt in the execution of his duty.

In the case of lectures, it is necessary to observe that delivery to a private or limited audience is not delivery to the world at large, and does not give hearers the right to publish. See p. 19.

By the Official Secrets Act 1889, 52 and 53 Vict., c. 52, any person attempting to obtain official information wrongfully, as in the Act specified, and any person who by means of holding or having held office has obtained any document, etc., and communicated such document, etc., to any person to whom the same ought not in the public interest to be communicated at that time, are liable to fine and imprisonment. The prosecution must be by or with the consent of the Attorney-General.

Secret official documents are always protected from production in a Court of Justice.

CHAPTER II

THE SUBJECT-MATTER

N.B.—It is intended in this chapter to deal only with those works which come under the definition clause of the Act of 1842 (5 and 6 Vict., c. 45).

By s. 2 of that Act it is enacted: "That in the construction of this Act the word 'book' shall be construed to mean and include every volume, part, or division of a volume, pamphlet, sheet of letterpress, sheet of music, map, chart, or plan separately published; that the words 'dramatic piece' shall be construed to mean and include every tragedy, comedy, play, opera, farce, or other scenic, musical, or dramatic entertainment."

Provided the work be literary (even in the most attenuated sense) it will be protected, and it is not necessary to show any lasting benefit to the world.

The following have been held to be within the definition:—A periodical or magazine, *Punch*—being one sheet of letterpress folded in form of a book, a collection of private correspondence, a bird's-eye map published separately, a calendar, a single sheet of music forming part of a book, a gazetteer, a directory, a trade catalogue, a Christmas card, a book of prints and illustrations. See *Maple & Co.* v. *Junior Army, etc.* (1882), 21 Ch. D., 369.

The following are not within the definition:—A single

design or picture, the face of a barometer with letterpress printed on it and separately published, a photograph-album—the only infringement alleged being in respect of the title, nor a scoring-sheet with common printed words, a puzzle with a printed key attached.

ORIGINALITY

No work that is not *original* can be copyright; and this applies to all productions within the copyright statutes. See also under "Infringement," *infra*.

It should be premised that the Court will not allow its procedure to be used to protect a work that is libellous, blasphemous as controverting the doctrines of Scripture, indecent, or inimical to the interests of the State; and this although the refusal to restrain publication by another indirectly operates to increase the circulation of a bad book.

Originality must be either in matter or arrangement. Although but a small portion of a book be original, the author is entitled to protect that by registration, unless other parts of the work infringe another's copyright.

The following are among those held to be "original":—Translations from a foreign language (but see pp. 62 and 71), engraving reduced from a picture, law reports, a law digest; but not such common-place productions as simple calculation-tables, which can easily be compiled by any person in a few hours.

There is no monopoly in a theory, nor in the arguments which support it.

A work may be "original" which consists of a compilation of existing information, not protected as copyright, or which is founded upon authorities to which the author has been referred by an existing work.

Again, although there be no copyright in a reprint,

there is in any new notes and illustrations that are added, as in *Black* v. *Murray* (1870), 9 Dec. Ct. Ses., 3d Ser., 341; and so new matter in new editions is protected.

It is dangerous to rely on the dictum in one case, that the necessary originality may consist in arrangement, as it is difficult to conceive a case in which material, plainly stolen from an existing work, can be so arranged as to be entirely novel, all forms of arrangement of ordinary books being merely new applications of existing principles. Thus information imparted by question and answer may be protected as original in itself, but not on the ground of its form; and it has been held that material on one branch of a subject, *e.g.* law, extracted from a copyright digest and published separately, infringes the law.

Infringement

By s. 15 of the 1842 Act, "If any person shall, in any part of the British Dominions, . . . print or cause to be printed, either for sale or exportation, any book in which there shall be subsisting copyright, without the consent in writing of the proprietor thereof, or shall import for sale or hire any such book so having been unlawfully printed from parts beyond the sea, or knowing such book to have been so unlawfully printed or imported, shall sell, publish, or expose to sale or hire, or cause to be sold, published, or exposed to sale or hire, or shall have in his possession, for sale or hire, any such book so unlawfully printed or imported, without such consent as aforesaid," he shall be liable to an action for damages, in any court of record having jurisdiction where the offence shall be committed. The Court of Chancery would assist by granting an injunction where the case is clear or the balance of convenience allows.

The defendant in an action for infringement must, with his pleading, deliver to the plaintiff notice in writing of any objections which he means to rely upon at the trial, and must in certain cases set out what he alleges to be the true facts.

Mere imitation is allowable, and so is fair use of existing books, but not servile copying, even though the copy be made for private use and not for sale.

It is not all copying that is actionable, the Court always regarding not merely quantity but quality. Thus Mr. Smith, in his "Leading Cases," had copied verbatim several reports of cases, the copyright in which belonged to the plaintiffs; but the Court refused an injunction on the ground that the bulk of the work was composed of laborious notes, which were original. In another case, Mr. Hotten had published a *Life of Napoleon III*, and part of the book was illustrated by caricatures, nine of which were taken from *Punch*. The Court held that this was an infringement mainly on the ground of quantity. The decision would have been the other way if (say) only one picture had been copied. And yet under other circumstances the copying of a single picture might be actionable, *e.g.* a rare picture in a book or a picture protected by artistic copyright (*q.v.* p. 35).

The slightest circumstances make important distinctions. For instance, a fair history of the maps of a country, including a reprint of both the old and copyright maps, might be held legal if the object were a *bonâ fide* history, but not if the jury were of opinion that the book were a scheme for profiting by publishing the copyright maps of another man. See *Wilkins* v. *Aikin* (1810), 17 Ves., 422. Again, a learned judge has said, "You cannot make out piracy where you have to track mere passages and lines through hundreds of pages."

The question of materiality, or quality of the matter appropriated, was much discussed in *Chatterton* v. *Cuve* (1878), L. R., 3 App. Cas., 483, where part of the plaintiff's drama was said to have been unfairly copied. Lord O'Hagan said: "To render a writer liable for literary piracy, he must be shown to have taken a material portion of the publication of another: the question as to its materiality being left to be decided by the consideration of its quantity and value, which must vary indefinitely in various circumstances. . . . The quantity taken may be great or small, but if it comprise a material portion of the book, it is taken illegally. The question is as to the substance of the thing, and if there be no abstraction of that which may be substantially appreciated, no penalty is incurred. . . . In all cases, the matter is dealt with as one of degree. In all, quantity and value are both the subjects of consideration, and in none of them has an infringement been established without satisfactory evidence of an appropriation, possibly involving a substantial loss to one person and a substantial gain to another, although . . . the damage to the plaintiff is not the test of the defendant's liability, and the penalty is to be paid even if there is no actual damage."

Of course it is no more justifiable to retranslate a copyright work from a foreign language than to use the original itself.

Fair Use.—It is a fair use of a preceding work to consult the authorities referred to therein.

Where the information in rival books must necessarily be the same, the question arises: What use may an author make of a previous work on the same subject? In the case of directories, it appears that a canvasser for the proposed work may fairly use the preceding book for the purpose of ascertaining names,

addresses, etc., of communicating with the persons therein indicated, and putting questions to them with the object of correcting or verifying the entries. But he must not use slips taken from the former book, even after correction or verification, and print them bodily into his new book. The "copy" must be prepared by fresh and independent labour. See *Morris* v. *Wright* (1870), L. R., 5 Ch., 279.

Spiers v. *Brown* (1858), 6 W. R., 352, is the chief case on dictionaries. The defendant was proved to have had the plaintiff's work constantly before him; but, though by far the greater portion had been taken and abridged from this book, it was held that as much consisted of emanations from the defendant's brain, much of translations from another author, some parts from other dictionaries, and as the defendant had subsequently compared, revised, erased, and elaborated, and the book was then subjected to revision and examination by another learned man, the defendant had not gone beyond what the Court would allow, but had produced a different work from the plaintiffs.

Abridgment and Reviews.—It is well established that an abridgment of a copyright book may be published provided the abridgment be "fair." But it is certain that the old cases allowed greater liberties than would now be permitted.

It is safe to say that a man may not, under pretence of reviewing, publish the major part of another's work, as where seventy-five pages out of one hundred and eighteen were printed together with three similar engravings; nor may he reprint, *e.g.*, a whole act or scene from a play, when, although it form but a small portion of the review, it is an important part of the play; nor may he reproduce a book that is colourably shortened only; nor copyright matter which forms the bulk of the new book, the review being

an inferior addition; nor, under the pretence of publishing illustrations, etc., may he publish copyright letterpress to which the illustrations apply. But, on the other hand, as was said by Lord Hatherley in *Chatterton* v. *Cave* (1878), 3 App. Cas., 492: "Books are published with an expectation, if not a desire, that they will be criticised in the reviews, and, if deemed valuable, that parts of them will be used as affording illustrations by way of quotation, or the like; and if the quantity taken be neither substantial nor material—if, as it has been expressed by some judges, 'a fair use' only be made of the publication, no wrong is done, and no action can be brought."

Dramatisation of a Tale.—Copyright in a book is not infringed by its representation on the stage, the two rights being absolutely distinct; but if, for the purpose of production on the stage, copies, manuscript or otherwise, are made of material parts of the book, the person causing the copies to be made is liable to a perpetual injunction—*Warne* v. *Seebohm* (1888), 39 Ch. D., 73. To avoid this result it is only necessary that the book itself, and not unauthorised copies, should be used.

Music.—The music of an unpublished opera may be infringed by opera-music taken from the pianoforte arrangement already published—*Fairlie* v. *Boosey* (1879), 4 App. Cas., 711.

Fraud.—There is no monopoly in the subject-matter of a publication, nor in its appearance or "get-up"; nor is there any copyright in a simple title, though there may be one in a title occupying a whole page and requiring ingenuity in its composition. But similarity in title, advertisement, shape, appearance, etc., are all material for ascertaining whether a man is passing off another man's work as his own or his own as another man's. The plaintiff, in seeking to protect his title, would have to

prove (1) that his work had acquired reputation in the market, under the title sought to be protected; (2) that the title was used exclusively by the plaintiff, and was original in its application to the special class of work; (3) that the defendant's title was the same, or so similar as to be calculated to deceive the public—giving, except in very plain cases, instances of deception; (4) that the nature of the two works was similar; (5) the probability that the plaintiff would be injured. See *Borthwick* v. *Evening Post* (1888), 37 Ch. D., 449; *Metzler* v. *Wood* (1878), 8 Ch. D., 606; and *Ingram* v. *Stiff* (1859), 5 Jur. N. S., 947, where defendant was restrained from publishing *The Daily London Journal* in breach of a covenant made on parting with *The London Journal*. And see p. 76.

Practice.—A plaintiff can only succeed in an action for infringement if he is acting in good faith; and so, where his book is substantially a reproduction of another's book, he cannot prevent a third person copying his improvements and alterations; but where the plaintiff is acting honestly, though in fact infringing, his additions, etc., will be protected.

Of course, if the plaintiff advertises his book in a fraudulent manner, *e.g.* as the work of a man other than the author, he will not be protected in defending it from piracy.

Again, where the plaintiff has misled the defendant as to his rights he cannot succeed. A proprietor does not lose his rights because he does not proceed against every infringer or for every infringement; but infringements, being acquiesced in, form good evidence of abandonment of rights. So, according to one case, where the owner allows ten pirates, he may not restrain the eleventh; and, again, long-continued acquiescence in infringement by one

man would prevent an injunction being granted against another.

Copyright is not lost by the book being allowed to remain out of print for a number of years, unless there is some further evidence of abandonment. The proprietor may use his own discretion as to how and when he will re-publish.

An equitable title will be protected as thoroughly as one which has been perfected according to the common law.

The defendant, however honest in intention, will be liable to an injunction if he has in fact made an undue use of another's work, and although he has fully acknowledged the original source of the appropriated material. In *Ager* v. *P. & O. Co.* (1884), 26 Ch. D., 637, the defendant company purchased from the plaintiff a copy of his *Standard Telegram Code*, and made their own code by using his words and affixing their own meanings to them. Although they conceived they had a right to do this, the Court granted an injunction.

It is no defence to prove that the defendants' work is useful to the public. The Copyright Acts are designed to protect individuals, and a man has no right to benefit the public to the detriment of the proprietor.

Importation.—The 1842 Act, in s. 17, forbids the importation into the British Dominions, for sale or hire, of any "printed book" (see p. 8) wherein there is copyright, and first composed or written or printed and published in the United Kingdom, and imposes penalties together with liability to forfeiture and seizure. The Act of 1862, s. 10 (p. 39), prohibits the importation of copies of paintings, drawings, and photographs, except with the consent of the proprietor or his agent authorised by writing, and makes the pirate copies liable to seizure at the customs houses.

Proceedings may also be taken either in a civil court for damages, or before the magistrates in petty sessions. The importation of copies of protected engravings is made subject to penalties by 8 Geo. II, c. 13 (p. 36); and that of sculptures, etc., to an action for damages by 54 Geo. III, c. 56 (p. 44). And see p. 72.

It was held in *Cooper* v. *Whittingham* (1880), 15 Ch. D., 501, that innocent importation will expose a defendant to an *ex parte* injunction, etc., but if the plaintiff charges him with "knowingly selling, publishing, or exposing, etc.," he must prove the knowledge.

By the Customs Laws Consolidation Act 1876, s. 44, importation is forbidden of "books wherein the copyright shall be first subsisting, first composed, or written or printed in the United Kingdom, and printed or reprinted in any other country, as to which the proprietor of such copyright, or his agent, shall have given to the Commissioners of Customs a notice in writing, duly declared, that such copyright subsists, such notice also stating when such copyright will expire."

By s. 44, lists of prohibited books must be exposed at the customs houses in the several ports.

By s. 45, any person having cause to complain of the insertion of any book in such lists, may apply to a judge at chambers for a summons calling upon the person who gave the above notice to show cause why the book should not be expunged from the list. This section is not to prevent persons aggrieved from pursuing any other remedies.

By s. 54, packages reported "contents unknown" may be opened and examined, and prohibited goods forfeited, unless the Commissioners of Customs permit them to be exported.

As to offences under the Merchandise Marks Act 1887, see Appendix.

By the 1842 Act, s. 23, pirate books are deemed the property of the registered proprietor of the original work, who, after demand thereof in writing, may bring an action of detinue or conversion.

By s. 26, all proceedings must be commenced within twelve months of the offence having been committed, but this does not extend to actions, etc., for the non-delivery of books (p. 30).

By s. 27, the rights of the Universities and of the Colleges of Eton, Westminster, and Winchester are preserved.

CHAPTER III

PUBLICATION

STATUTORY copyright springs from "publication," which is equivalent to "issuing to the public." The exhibition to a few friends of a manuscript is not publication, nor is the printing and private circulation thereof.

"A book is published by being printed and issued to the public; a dramatic piece or a musical composition is published by being publicly performed; a piece of sculpture or other work of art by being multiplied by casts or other copies" (*Boucicault* v. *Chatterton* (1876), 5 Ch. D., 267), but it does not mean "being made *publici juris*, that is to say, being made the common property of everybody, so that the author has lost all exclusive right in this country."

In *Caird* v. *Sime* (1887), 12 App. Cas., 344, Lord Watson said: "The author's right of property in his unpublished work being undoubted, it has also been settled that he may communicate it to others, under such limitations as will not interfere with the continuance of the right. He cannot print and sell without publishing his work, but he may legitimately impose restrictions which will prevent its publication, whether the communication be made by giving copies for private perusal or by recitation before a select audience. In the latter case the

retention of the author's right depends upon its being either a matter of contract or an implied condition." It was held that Professor Caird was entitled to an interdict prohibiting the defender, one of his class at Glasgow University, from publishing notes of the lectures, although the lecturer was under an obligation to receive into his class all possessing the requisite qualification. Lectures delivered to an audience, admitted even gratuitously by ticket or admitted by payment, may not be published against the will of the lecturer—*Nicols* v. *Pitman* (1884), 26 Ch. D., 374. But a man who lectures to any one who chooses to attend, or a minister who preaches in open church, thereby publishes his lectures or sermons to the world, and makes them the property of the public. If the lecture or sermon had been previously published as a book, copyright in the book would be secure; but there is no right to prevent oral repetition of the contents of a book, and to that extent there would be no protection. Of course any member of an audience may take notes for private use and show them to private friends.

It seems convenient to notice here that the right of authors to their lectures is also to some extent protected by 5 and 6 Will. IV, c. 65 (1835), but the Act only applies where notice in writing of the intended delivery of the lecture has been given to two justices living within five miles of the place of lecturing, two days at least before the delivery of the lecture. It does not apply to any lecture "delivered in any university or public school or college, or on any public foundation, or by any individual in virtue of or according to any gift, endowment, or foundation." (S. 5.)

Any one who copies and publishes the lecture without leave of the author or his assigns, and any one

who knowingly sells, etc., shall forfeit all copies and parts of copies, together with one penny for every sheet thereof found in his custody, one-half to the Crown and one-half to any person who shall sue for the same by action. (S. 1.)

S. 2 applies the Act to the printers and publishers of newspapers; and s. 3 declares that persons being allowed to attend any lecture shall not therefore be deemed to have had leave to copy.

Of course where a lecture has been previously printed, the rights of the proprietor depend on 5 and 6 Vict., c. 45, and not on this Act.

Music and Drama.—Representation of an opera on the stage is not publication of the score, nor is the playing of a piece of music or the singing of a song.

In *Fairlie* v. *Boosey* (1879), L. R., 4 App. Cas., 711, it was shown that *Vert-Vert*, an opera by Offenbach, although it had been performed in Paris, had never been published. Two arrangements for the pianoforte, one with and the other without vocal parts, had been published. Fairlie used the pianoforte arrangements, and produced a dramatic piece with English words. It was held that Boosey, who was entitled to the MS. score of the opera, could obtain an injunction to prohibit Fairlie infringing his rights, as the opera had never been published. The question was chiefly one of degree; it being held that the publication of the arrangements was not publication of the opera.

Place.—To secure copyright under 5 and 6 Vict., c. 45, the first publication must be in the United Kingdom (and see p. 51); for although this is not expressed in so many words in the statute, there are numerous indications which show that this was intended—*Routledge* v. *Low* (1868), L. R., 3 H. L., 100. Where copyright once

exists, it extends, by virtue of s. 29, to every part of the British Dominions, whether there are local laws affecting the matter or not.

There is no property in a future publication, nor in its proposed title, and the registration of a work not already published is void.

CHAPTER IV

LITERARY COPYRIGHT

The Term.—By s. 3 of the Act of 1842 it was enacted that the copyright in every book should be the property of the author and his assigns, and should endure for the life of the author and seven years after his death, or for forty-two years from the first publication, whichever term should be the longer, and that copyright in a posthumous book should endure for forty-two years from the first publication thereof, and should belong to the proprietor of the author's manuscript.

By s. 25, copyright is to be deemed personal property, descending, on the death of the owner, like any other personal estate.

Registration

Registration is necessary for the protection of copyright in "books" (for definition see p. 8), dramatic pieces, musical compositions (see p. 47), and for paintings (p. 39). No legal proceeding can be taken before registration (s. 24), but there is no limit of time fixed within which a work must be registered. In the case of "books," dramatic pieces, and musical compositions, the proprietor may take proceedings in respect of acts of infringement committed

before registration, but it is otherwise in the case of paintings.

By s. 11 of the Act of 1842 it was provided that a registry should be kept at Stationers Hall, which should be open to inspection on payment of one shilling for every entry searched for. A stamped and certified copy of an entry is obtainable on payment of five shillings, and is *primâ facie* evidence of the proprietorship, assignment or licence as therein expressed, and of the right of performance. By s. 12, making a false entry is a misdemeanour.

By s. 13 it is enacted that "it shall be lawful for the proprietor of copyright in any book heretofore published or in any book hereafter to be published, to make entry in the registry books of the Stationers Company of the title of such book, the time of the first publication thereof, the name and place of abode of the publisher thereof, and the name and place of abode of the proprietor of the copyright of the said book, or of any portion of such copyright, in the form in that behalf given in the schedule to this Act, annexed (*infra*), upon payment of the sum of five shillings to the officer of the said company; and that it shall be lawful for every such registered proprietor to assign his interest, or any portion of his interest therein, by making entry in the said book of registry of such assignment, and of the name and place of abode of the assignee thereof, in the form given in that behalf in the said schedule (*infra*), on payment of the like sum; and such assignment so entered shall be effectual in law to all intents and purposes whatsoever, without being subject to any stamp or duty, and shall be of the same force and effect as if such assignment had been made by deed."

The forms referred to above are as follows:—

No. 2.

Form of Requiring Entry of Proprietorship.

I *A.B.* of do hereby certify, That I am the Proprietor of the Copyright of a Book, intituled *Y.Z.*, and I hereby require you to make Entry in the Register Book of the Stationers Company of my Proprietorship of such Copyright, according to the Particulars underwritten.

Title of Book.	Name of Publisher and Place of Publication.	Name and Place of Abode of the Proprietor of the Copyright.	Date of First Publication.
Y.Z.		*A.B.*	

Dated this day of 18 .

Witness, *C.D.* (Signed) *A.B.*

No. 3.

Original Entry of Proprietorship of Copyright of a Book.

Time of making the Entry.	Title of Book.	Name of the Publisher, and Place of Publication.	Name and Place of Abode of the Proprietor of the copyright.	Date of First Publication.
	Y.Z.	*A.B.*	*C.D.*	

No. 4.

Form of Concurrence of the Party assigning in any Book previously registered.

I *A.B.* of being the Assigner of the Copyright of the Book hereunder described, do hereby require you to make Entry of the Assignment of the Copyright therein.

Title of Book.	Assigner of the Copyright.	Assignee of Copyright.
Y.Z.	*A.B.*	*C.D.*

Dated this day of 18 .

(Signed) *A.B.*

No. 5.

Form of Entry of Assignment of Copyright in any Book previously registered.

Date of Entry.	Title of Book.	Assigner of the Copyright.	Assignee of Copyright.
	[Set out the Title of the Book, and refer to the Page of the Registry Book in which the original Entry of the Copyright thereof is made.]	*A.B.*	*C.D.*

By s. 20 of the same Act these provisions are applied to dramatic pieces and musical compositions, the first representation or performance being equivalent to first publication; so that registration is needed to secure performing-right as well as copyright. It is necessary to register the title, the name and abode of the author or composer and of the proprietor, and the time and place of the first representation or performance.

Name, etc., of the Publisher, etc.—By "the publisher" is meant he who published the work at the time of the first publication; but "proprietor" means the owner at the date of registration. The name to be registered may be either the individual or firm name. Where a proprietor has no abode in the British Dominions the registration of the publisher's address as his own has been held good. When the abode of the publisher is not the same as the place of publication, it seems that the latter should be entered. See Form above.

The Name, etc., of Proprietor.—An author who has not assigned his rights is *primâ facie* proprietor; but where he has composed a work to the order of another, the employer is the proprietor, and this is so without any assignment. It was said in *Grace* v. *Newman* (1875), L. R., 19 Eq., 623, "In this Court the person who remunerates must be taken to be the equitable assignee;" and even where there is no remuneration the proprietors are those on whose behalf the work is composed and published—*Marzials* v. *Gibbons* (1874), L. R., 9 Ch., 518. So in the case of a drama—the music, which was composed to the order of the defendant, was held his without assignment—*Hatton* v. *Kean* (1859), 7 C. B. N. S., 268. And in *Sweet* v. *Benning* (1855), 16 C. B., 459, where the defendant, for payment, contributed reports to *The Jurist*, Jervis, C.-J., said: "Where the proprietors of a periodical

employ a gentleman to write a given article, or a series of articles or reports, expressly for the purpose of publication therein, of necessity it is implied that the copyright of the articles so expressly written for such periodical, and paid for by the proprietors and publishers thereof, shall be the property of such proprietors and publishers."

Where articles are composed at the joint expense of the owners of several newspapers, there is a joint property in the copyright in such articles. *Trade, etc., Co.* v. *Middlesborough, etc.* (1889), 40 Ch. D., 425. See further as to encyclopædias, periodicals, etc., p. 77.

Of course, employment may be upon the terms that the author is to have the copyright. *Eaton* v. *Lake* (1888), 20 Q. B. D., 378. To constitute joint authorship there must be preconcerted common design and co-operation. Alteration of a completed manuscript is not enough—*Levy* v. *Rutley* (1871), L. R., 6 C. P., 523.

It has been held that the registration of the author—as "Bruno Piglhein, Munich, Germany"—is *primâ facie* sufficient—*Fishburn* v. *Hollingshead* (1891), 2 Ch. 371.

Time.—Not only the year and the month but the actual day of publication must be registered. The registration of a subsequent edition only protects the new matter first contained therein and not the matter in the former editions.

Book.—It is necessary to register subsequent editions whenever it is wished to protect new matter, although this evil result follows—that when the copyright in the first and presumably imperfect edition expires, unauthorised reprints may appear without the corrections and additions of the later issues.

In *Fairlie* v. *Boosey* (1879), 4 App. Cas., 711, where, with the intention of protecting an opera-score, reference was made to a book (then deposited) of pianoforte

arrangement and the time of publication thereof, both of which were superfluous, Lord O'Hagan said: "The complete title cannot be vitiated because of an entry which was unnecessary, a lodgment of a book which was not required and was really of no effect, and a statement which could not mislead as to the real purpose and object of the registration."

Maps, engraved or not, were, by the Act of 1842, taken out of works of art, and they now require registration —*Stannard* v. *Lee* (1871), L. R., 6 Ch., 346.

Assignment.—Under 25 and 26 Vict., c. 68 (1862), which applies to paintings, drawings, and photographs, it has been held that assignments of earlier date than the first registration of the copyright need not be entered. *Graves' Case* (1869), L. R., 4 Q. B., 715; and no doubt the law is the same with regard to books.

The first number or part of an encyclopædia, review, magazine, periodical, or serial work, should be registered. (S. 19 of 1842 Act.) This registration protects the work as a whole, and also every article, etc., contained in any number. If there is no registration, or it is bad, the article or serial may be registered separately. *Dicks* v. *Yates* (1881), 18 Ch. D., 76. The right of an author to prevent separate publication by the proprietor of an encyclopædia, etc., is not "copyright," but may be enforced without registration—*Mayhew* v. *Maxwell* (1860), 1 J. & H., 312.

Expunging, etc., entry.—Power is given by s. 14 of 1842 Act, to "any person aggrieved by any entry," to apply to the Court (now the Queen's Bench Division) for an order that the entry may be expunged or varied.

"Person aggrieved" includes the proprietor who caused the entry to be made, and one whose title conflicts with that of the registered proprietor, and one who is pre-

judiced by the state of the register. "It is not enough to entitle a person to say that he is aggrieved . . . that although the registered proprietor has a complete title in equity and good sense, yet there is some slip either in the signing of the memorandum or in the spelling of a name." And again, "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 some other person, or that the entry would really interfere with some intended action on the part of the person making the application. For instance, if a person brought to the notice of the Court that he had a right to take certain pictures, but that he was afraid to do so while the entry existed, the Court might entertain his application if they thought it made *bonâ fide*"—*Graves' Case* (1869), L. R., 4 Q. B., 715.

Deposit of Copies

It is enacted, by s. 6 of the 1842 Act, that the whole of every book (*i.e.* wherever published, and whether copyright or not), together with all maps, prints, or other engravings belonging thereto, and of any subsequent edition published with any additions or alterations, shall be delivered, on behalf of the publisher,—bound, sewed, or stitched together, and upon the best paper,—to the British Museum within one month of the first sale or publication or offering for sale within the bills of mortality, or within three months of the first sale, etc., in any part of the United Kingdom, or within twelve months of the first sale, etc., in any other part of the British dominions.[1]

By s. 7, the copy must be delivered between ten A.M. and four P.M., on any day but Sunday, Ash Wednesday, Good

[1] The whole book, and not any separate parts, should be deposited.

Friday, and Christmas Day, to an officer of the Museum, who must, if required, give a receipt.

By s. 8, etc., the Bodleian Library at Oxford, the Public Library at Cambridge, the Advocates' Library at Edinburgh, and Trinity College Library at Dublin, may, within twelve months of publication, demand a copy of the book, through the officer of the Stationers Company, who must give a receipt and forward the book. By s. 9, it is lawful for the publisher to send the book direct to the library, free of expense. By s. 10, neglect to deliver the book subjects the publisher to the penalty of £5, which may be recovered by the librarian.

Formerly there was a similar obligation to forward to the Libraries of Sion College, the four Universities of Scotland, and of the King's Inns at Dublin; but this was abolished in 1836, and compensation was paid out of the Consolidated Fund.

CHAPTER V

ASSIGNMENT

It is important to bear in mind the provisions of the seventeenth section of the Statute of Frauds, which apply to contracts for sale of goods in cases where a manuscript or other work is sold before publication or before registration, and where the copyright is sold after registration, but not by means of an entry on the register.

The seventeenth section, as amended by Lord Tenterden's Act, is to the following effect:—That no contract for the sale of any goods of the value of £10 or upwards, whether the goods are in existence and completed, or incomplete or to be provided, shall be good, "except the buyer shall accept part of the goods so sold, and actually receive the same, or give something in earnest to bind the bargain, or in part payment, or that some note or memorandum in writing of the said bargain be made, and signed by the parties to be charged by such contract, or by their agents thereunto lawfully authorised."

In *Benjamin on Sales* the following definition appears:—"If the contract is intended to result in transferring for a price, from B to A, a chattel in which A had no previous property, it is a contract for sale."

The Act does not apply to contracts for labour, or to "choses in action." The Stamp Acts except from duty

every "memorandum, letter, or agreement, made for or relating to the sale of any goods, wares, or merchandise."

The assignment of an unpublished work need not be in writing.

An assignment of copyright must be in writing or by entry on the register, a verbal assignment being of no validity as against a subsequent innocent assignee. The performing-right in a musical composition or dramatic piece is assignable only by entry on the register or in writing; so that an author, even after a verbal agreement to assign, can bring an action for infringement — *Euton* v. *Lake* (1888), 20 Q. B. D., 378. An agreement to assign, provided it be in writing, is as good as an assignment.

By s. 22 of the 1842 Act, no assignment of the copyright of a dramatic piece or musical composition shall be holden to convey the performing-right, "unless an entry in the said registry book shall be made of such assignment, wherein shall be expressed the intention of the parties that such right should pass by such assignment." *Ex p. Hutchins* (1879), 4 Q. B. D., 483, decided that an assignment of the copyright, "together with all interest, property, contingency, possibility, benefit," was sufficient to pass the performing-right: from which case it also appears that s. 22 was not meant to control the operation of deeds of assignment, but to control the effect of entries in the register.

The vendor of a copyright is entitled to retain and sell all copies made previous to the contract for sale; and the purchaser of a copyright for a term of years may, after the expiration of the term, sell copies printed during its currency, but cannot prevent republication by the vendor on the ground that some copies remained unsold.

Licence to Publish.—This is not an assignment, and need not be in writing. It has no effect on a subsequent assignment, when the assignee has no notice of the licence

—*London, etc., Alliance* v. *Cox* (1891), W. N., 157. Acquiescence in piracy may have the effect of a licence.

An assignment of partial rights[1] in a copyright is in fact a licence, and does not require registration. See *Tuck* v. *Canton* (1882), 51 L. J., Q. B., 363.[1] A licence will be strictly confined to its purport; and, accordingly, it has been held that a licence to publish photographs in a serial publication does not authorise separate publication with the story in book form. Although in form a licence, a document may amount to an assignment; and, if so, should be registered.

Where there are part owners, each should join in the assignment or licence.

A licensee cannot sue for infringement in his own name—*Lucas* v. *Cooke* (1880), 13 Ch. D., 872.

Compulsory Licence.—By s. 5 of the 1842 Act, it is lawful for the Judicial Committee of the Privy Council, "on complaint made to them that the proprietor of the copyright in any book, after the death of its author, has refused to republish or allow the republication of the same, and that by reason of such refusal such book may be withheld from the public, to grant a licence to such complainant to publish such book, in such manner and subject to such conditions as they may think fit."

[1] *E.g.*, a particular mode of reproducing a picture, of publishing a book. A man may carve out his personal rights by assignment, but may not divide the subject-matter of copyright otherwise than by licence.

CHAPTER VI

ARTISTIC COPYRIGHT

APART from statutes, the owner of a work of art has the right of preventing piracy before publication. Exhibition in a gallery is not publication—*Turner* v. *Robinson* (1860), 10 Ir. Ch. Rep., 510. According to the opinion of Lord Esher, M. R., in *Tuck* v. *Priester* (1887), 19 Q. B. D., 629, copyright given by the Act of 1862 (p. 39) attaches immediately a work is made, and so the rights in respect of works within that statute are dependent on its provisions and not on the old common law.

Apart from "international copyright" (see p. 54), only works produced and first published in Great Britain are protected.

A person who is employed to print copies for the owner of a copyright is liable to an action for breach of contract, and to an injunction, if he strikes off copies for his own purposes—*Tuck* v. *Priester* (*supra*). A photographer may be restrained from selling or exposing copies of a photograph taken to order, although the negative is his own —*Pollard* v. *Photographic Co.* (1888), 40 Ch. D., 345.

An engraved plate, supplied by the engraver, is his property, although the engravings are made to the order of the owner of an original drawing—*Murray* v. *Heath* (1831), 1 B. & A., 804, and although the plate may not

be sold, *Mayall* v. *Higbey* (1862), 6 L. T. N. S., 362; but when the owner of a picture himself draws on the printing blocks, they are his property, subject to payment for the blocks supplied—*Hole* v. *Bradbury* (1879), 12 Ch. D., 886.

Where engravings, photographs, etc., form a book or part of a book they are protected by 5 and 6 Vict., c. 45, as a book, and so are maps, plans, and charts, whether in book form or not. See *Maple* v. *Junior, etc.* (1882), 21 Ch. D., 369, and *supra*, p. 9. But when proceedings are taken to protect prints as engravings and not as a book, registration under 1842 Act is not required—*Blackwell* v. *Harper* (1740), 1 Barn., 210; and, conversely, when proceedings are taken under the 1842 Act, the formalities of the "engraving" statutes need not be complied with—*Bogue* v. *Houlston* (1852), 21 L. J., Ch., 470.

Engravings, etc.

The statutes protecting artistic copyright commence with the year 1735, when 8 Geo. II, c. 13, was passed, by which, combined with 7 Geo. III, c. 38 (1766), and 17 Geo. III, c. 57 (1777),[1] copyright for the term of twenty-eight years from the date of first publication was given to "every person who shall invent and design, engrave, etch, or work in mezzotint or chiaro-oscuro, or shall cause to be designed, etc.," any print whatsoever, and whether or not from his own original design. The date of first publication (p. 19) and the name of the proprietor must be engraved on each plate, and printed on each print. Any person who copies and sells, or causes to be copied and sold, a print "in the whole or

[1] These Acts were extended to Ireland by 6 and 7 Will. IV, c. 59 (1836).

part by varying, adding to, or diminishing from the main design," without the previous consent of the proprietor, by writing, signed in the presence of at least two attesting witnesses, or who knowingly publishes and sells, or exposes to sale, a pirate print, is liable to forfeiture of the plates and prints to the proprietor (who shall forthwith destroy and damask the same); and to payment of five shillings for every copy found or disposed of, one-half going to the Crown; or else is liable to an action for damages. The Court has inherent jurisdiction to order infringing prints, etc., to be delivered up.

The purchaser from the original proprietor of a plate for printing has the right of printing therefrom without penalty.

Proceedings for penalties must be commenced within six months after the offence is committed, or (but this is not certain) within three months "after the discovery of every such offence, and not afterwards." This limitation does not apply to the action for damages.

The Act 15 and 16 Vict., c. 12, declares (s. 14) that the foregoing Acts apply to "prints taken by lithography, or any other mechanical process by which prints or impressions of drawings or designs are capable of being multiplied indefinitely."

A person may "invent and design" without being able to draw or execute the invention—*Stannard* v. *Harrison* (1871), 24 L. T., N. S., 570.

A reduced engraving of a specification has been held protected, though not the specification itself—*Newton* v. *Cowie* (1827), 12 Moore, 457.

An innocent seller is liable—*Gambart* v. *Sumner* (1859), 5 H. & N., 5.

Name, etc.—The name should be that of the proprietor at the date of first publication. It is not necessary that the name of a subsequent assignee should be substituted—

Thompson v. *Symonds* (1792), 5 T. R., 41. It is sufficient if the name of the proprietor be published without a statement that he is proprietor—so, "Published by Henry Graves & Co." is good, so is a surname alone, or a firm name, as in *Rock* v. *Lazarus* (1872), L. R., 15 Eq., 104. See p. 41.

Infringement.—Engravings are protected from unauthorised copying by means of photography—*Graves* v. *Ashford* (1867), L. R., 2 C. P., 410. But where a plaintiff had the right of producing engravings of a picture in one size only, it was held that a chromo-lithograph imitating the picture was not an infringement of the engraving. The burden of proof that the defendant copied from the engraving, and not from the picture, lay on the plaintiff—*Graves* v. *Ashford* (*supra*).

The copyright in engravings is not commensurate with that in pictures, etc., so that a production may be an infringement of a picture copyright and yet not of the copyright engraving from the picture. "It appears to me that the protection given . . . to the mere engraver was intended to be, and was, commensurate with that which the engraver did; that the engraver did not acquire against anybody in the world any right to that which was the work of the original painter, did not acquire any right to the design, did not acquire any right to the grouping or composition, because that was not his work but the work of the original painter. . . . I cannot conceive that such a reproduction of the subject in tapestry, or Berlin wool, or upon china, or earthenware, is within the meaning of the Act of Parliament"—Per James, L.-J., in *Dicks* v. *Brooks* (1880), 15 Ch. D., 22.

In *De Berenger* v. *Wheble* (1819), 2 Stark, N. P., 548, it was held that where the plaintiff had purchased the right to engrave a picture, but not in terms or construction

the sole right, another artist might make another engraving from the same original.

It should be remembered that when the engraving is copyright its design is copyright also.

A proper direction to the jury would be "to consider whether the main design of the plaintiff's engraving had been copied, and whether the defendant's engraving was substantially a copy of the plaintiff's."

Paintings, Drawings, and Photographs

were not protected from piracy until the year 1862, when 25 and 26 Vict., c. 68, was passed. By the first section copyright, lasting until seven years after the author's death, is conferred on the author, if he is a British subject or resident within the dominions of the Crown, of every original painting, drawing, and photograph. But when a painting, drawing, or negative of a photograph is first sold or disposed of, the copyright vanishes, unless at or before the sale or disposition an agreement in writing is made reserving or conferring the right, and is signed by the purchaser or seller as the case requires (p. 43).

Where the painting, etc., is made or executed for another person "for a good or valuable consideration," the copyright belongs to the person for or on whose behalf the same is made or executed, and no agreement in writing is necessary unless the copyright is meant to be reserved to the author; in which case the reservation is in the nature of a re-grant.

All assignments and licences must be in writing, signed by the proprietor or "his agent appointed for that purpose in writing." (S. 3.)

By s. 4, a register of proprietors of copyright in "paintings, drawings, and photographs" was established at

Stationers Hall, wherein a memorandum of every copyright and every assignment thereof is to be entered. The memorandum is to contain: 1. Date of agreement or assignment. 2. Names of the parties thereto. 3. Name and place of abode of person acquiring the copyright. 4. And of the author. 5. A short description of the nature and subject of the work; and, if the person registering shall so desire, a sketch, outline, or photograph of the work.

No proprietor is to be entitled to the benefit of the Act until such registration, and no action can be brought nor penalty recovered in respect of anything done before registration.

By s. 5, several sections of 5 and 6 Vict., c. 45, viz., ss. 11, 12, 14, are applied to this Act (pp. 24 and 29). They refer to the keeping of the register and expunging false entries. The fee for making an entry is fixed at one shilling.

S. 6 renders liable to a penalty of £10 for each offence whoever, without the consent of the proprietor, copies, imports, sells, publishes, lets to hire, exhibits or distributes or offers, causes or procures others so to do. All copies and negatives are to be forfeited to the proprietor of the copyright.

By s. 7, any one who fraudulently affixes any name, initials, or monogram, or sells, publishes, exhibits, disposes of, etc., a picture so fraudulently marked, or who utters a copy of a picture, etc., as having been executed by the author of the original, or who during the life of the author publishes copies of a work altered without the consent of the author, as the unaltered work of the author, is liable upon summary conviction to forfeit to the aggrieved person a sum not exceeding £10, or not exceeding double the full price at which the pictures, etc., have

been offered for sale. The pictures are to be forfeited to the aggrieved person. But the penalties are only incurred when the person whose name, etc., has been fraudulently marked, or to whom his altered work has been ascribed is living, or has been living within twenty years of the offence.

Penalties are recoverable in England and Ireland by civil action or by summary proceeding in Petty Sessions having jurisdiction where the party offending resides, and in Scotland by action before the Court of Session, or by summary action before the Sheriff of the county where the offence may be committed or the offender resides. (Ss. 8, 11.)

Subject-matter.—"The mere choice of a subject can rarely, if ever, confer upon the author of the drawing an exclusive right to represent the subject, and certainly where the subject chosen is merely the representation to the eye of a simple operation, which must be performed by every person who records a vote, there cannot possibly be an exclusive right to represent in a picture that operation"—*Kenrick* v. *Lawrence* (1890), 25 Q. B. D., 99. The drawing in this case was a delineation on a voting-card of a hand marking the vote with a cross. And see *Hildesheimer* v. *Dunn* (1891), W. N., 66. A photograph of an engraving of a picture is an original photograph within the Act—*Graves' Case* (1869), L. R., 4 Q. B., 715.

Name of Proprietor.—The firm name will do—*Kenrick* v. *Lawrence* (u.s.), see p. 38.

Author.—"The author of a painting is the man who paints it, and the author of a drawing is the man who draws it." The author of a photograph is he who actually takes or at least superintends the taking. "The nearest I can come to is that it is the person who effectually is, as near as he can be, the cause of the picture which is produced—that is, who has actually formed the picture

by putting the people into position, etc.; . . . the man who is the effective cause of that. . . . There is nothing in the nature of the thing to make us give a different interpretation to the word 'author' in the case of a photograph to that which we should give to it in the case of an author of a painting or drawing"—*Nottage* v. *Jackson* (1883), 11 Q. B. D., 627. So, the registration of partners not personally superintending their business, or of a corporate body, is bad; and so is that of a member of a firm who designs but does not execute his idea, or of a tradesman whose assistant takes the photograph. It is doubtful whether, in the case of joint authors, the copy right extends to seven years beyond the joint lives, or beyond the life of the survivor.

Registration.—A registered assignment protects the owner, though there has been no registration of the first proprietor or of the copyright—*Graves' Case* (1869), L. R., 4 Q. B., 715.

Description.—The name of the picture may be enough, *e.g.* "Ordered on Foreign Service," being an officer taking leave of a lady; "My First Sermon," being a child in a pew with her eyes wide open; "My Second Sermon," being the same child fast asleep. It seems that "A distinguished Member of the Humane Society" would not sufficiently describe a Newfoundland dog; nor "A Piper and a Pair of Nut-crackers," a bull-finch and two squirrels—*Ex p. Beal* (1868), L. R., 3 Q. B., 387.

While no proceedings can be taken for acts done previous to registration, a defendant is liable if he sells after registration copies that were made before—*Tuck* v. *Priester* (1887), 19 Q. B. D., 629. There is no necessity for registering a licence, and it is doubtful whether it is necessary to register an assignment when the original copyright is registered—*Tuck* v. *Canton* (1882), L. J., 51 Q. B., 363.

Infringement.—By s. 2 of the 1862 Act, "Nothing herein contained shall prejudice the right of any person to copy or use any work in which there shall be no copyright, or to represent any scene or object, notwithstanding that there may be copyright in some representation of such scene or object."

A picture is protected from piracy by means of photography, although the photographs be taken from an engraving of the picture—*Ex p. Beal* (1868), 3 Q. B., 387; and on the same grounds it has been held in Ireland that multiplying copies by photography of living persons grouped similarly to those in a picture, is piracy—*Turner* v. *Robinson* (1860), 10 Ir. Ch. Rep., 510.

A mere licensee with power of limited production, *e.g.* by chromo-lithography, may sue in respect of infringement of the copyright in the original picture, and it is not necessary that he should rely on his rights in the plate and engravings under the Act of Geo. II—*Tuck* v. *Canton* (u.s.).

See also under "Engraving," p. 38.

The penalty under s. 6 attaches to every copy sold, and not merely to every sale—*Ex p. Beal* (u.s.).

"Unlawfully made." In was held in *Tuck* v. *Priester* (u.s.) that it must be shown that the imported copies were made in Great Britain, or in a country with which a copyright treaty exists. This does not apply to the other remedies given by the Act. See, further, p. 54, *et seq.*

Rights after Sale.—By s. 1 of the 1862 Act it is "provided that when any painting or drawing, or the negative of any photograph, shall, for the first time after the passing of this Act, be sold or disposed of, or shall be made or executed for or on behalf of any other person for a good or valuable consideration, the person so selling or

disposing of, or making or executing the same, shall not retain the copyright thereof, unless it be expressly reserved to him by agreement in writing, signed at or before the time of such sale or disposition, by the vendee or assignee, etc., or by the person for or on whose behalf the same shall be so made or executed; but the copyright shall belong to the vendee or assignee, etc., or to the person for or on whose behalf the same shall have been made or executed, nor shall the vendee or assignee thereof be entitled to any such copyright, unless, at or before the time of such sale or disposition, an agreement in writing, signed by the person so selling or disposing of the same, or by his agent duly authorised, shall have been made to that effect.

By s. 3, all assignments and licences must be made by some note or memorandum in writing signed by the proprietor of the copyright, or by his agent appointed for that purpose in writing. See p. 33. Where the copyright passes to the purchaser it would seem that the "author" would still have the right of disposing of replicas already made and of sketches used for the production of a picture, but the purchaser of a sketch or replica would have no right of reproduction any more than would the author.

Sculpture, etc.

The first Act protecting copyright in sculptures, etc., was 38 Geo. III, c. 71 (1798), which was virtually superseded by 54 Geo. III, c. 56 (1814), the effect whereof is as follows:—Every person who makes or causes to be made any new and original sculpture model, copy or cast of the human figure, or of animals or any part thereof, or "of any subject, being matter of

invention," has the sole copyright therein for fourteen years from first putting forth or publishing the same. (S. 1.)

At the expiration of the fourteen years, the copyright reverts to the original proprietor, if then living, for the further term of fourteen years. (S. 6.)

The infringer is liable to an action for damages and full costs. (S. 3.) 5 and 6 Vict., c. 97, s. 2.

Purchase of the copyright must be by deed, executed by the proprietor in the presence of and attested by two witnesses. (S. 4.)

All actions must be brought within six months after the discovery of the offence. (S. 5.)

It does not appear that the consent of the proprietor to copies being made need now be in writing, as this is not mentioned in the latter Act. Engravings, etc., of sculptures may be freely made without infringing the copyright.

Exhibiting is publishing, within this statute—*Turner* v. *Robinson* (1860), 10 Ir. Ch. Rep., 510. The Copyright of Designs Act 1850, contained special provisions for the registration of sculptures, etc.; but this was repealed by the Patents Act of 1883, which also, in s. 60, excepts from its own operation anything within the protection of the Sculpture Copyright Acts.

CHAPTER VII

DRAMATIC AND MUSICAL COPYRIGHT

It should be borne in mind that in these compositions there exist two rights—one of literary copyright, which is dealt with in Chapters IV and V, and the other of public performance or representation, sometimes called "the performing-right." This latter right was first conferred by 3 and 4 Will. IV, c. 15 (1833) s. 1, whereby the author of any dramatic piece or entertainment composed, but not printed or published, has the sole liberty of representing it at any places of dramatic entertainment.

The same section gives the authors of any such production, which has been printed and published, the same right for twenty-eight years from the publication or for the life of the author or surviving author.

By s. 2, any person who, without the previous consent in writing of the proprietor, represents or causes to be represented a protected piece, or any part thereof, at any place of dramatic entertainment, is liable to pay forty shillings for each representation, or the full benefit thereof, or the loss sustained by the plaintiff, together with full costs (5 and 6 Vict., c. 97, s. 2). The action must be commenced within twelve months of the offence.

By the Act of 1842, s. 20, the benefits of the above Act were extended to the authors of musical compositions,

performing-right extended to the term of copyright, and the provisions respecting the property of such copyright and of registration were applied. See p. 23. The first public representation or performance was made equivalent to the publication of a book.

S. 22 enacted that no assignment of copyright should convey the performing-right unless an entry should be made in the registry of the assignment, wherein the intention to pass such right is expressed.

The publication of a work as a book does not prejudice the performing-right, nor does public performance prejudice copyright. Any one has the right of dramatising a book and performing the drama, provided the copyright in the book be not infringed—*Warne* v. *Seebohm* (1888), 39 Ch. D., 73. See p. 15.

The performing-right is lost by prior representation abroad, unless in a country to which the International Conventions Act applies (see p. 57)—*Boucicault* v. *Chatterton* (1876), 5 Ch. D., 267.

An innocent infringer is liable—*Lee* v. *Simpson* (1847), 3 C. B., 871.

Author.—Where the score of an opera is composed by one and another arranges it for the pianoforte, the latter is the author of the arrangement—*Wood* v. *Boosey* (1868), L. R., 3 Q. B., 223. The consent in writing may be given by the author's agent; and when given includes not only the person licensed but his sub-licensees or assignees, unless the wording of the licence requires another construction—*Taylor* v. *Neville* (1878), L. J., 47 Q. B., 254. A performance is "contrary to the right of the author" even when the author has verbally agreed to assign, there being no "consent in writing" —*Eaton* v. *Lake* (1887), 20 Q. B. D., 378.

Place of Dramatic Entertainment.—Public perform-

ance, apart from the nature of the place, constitutes the offence—*Wall* v. *Taylor* (1883), 11 Q. B. D., 102. In *Duck* v. *Bates* (1884), 13 Q. B. D., 843, where *Our Boys* had been given at St. Mary's Hospital to persons connected therewith, a few tickets being given to friends of the performers and five being sent to the editors of theatrical newspapers, the entertainment was held private. It is immaterial to consider whether any charge is made for admission, or on what term admission is granted.

Infringement.—The taking of any material or substantial part is actionable; but an imitation, though extensive, is not necessarily wrongful. See *Chatterton* v. *Cave* (1878), 3 App. Cas., 483 (p. 12). In one case the jury found that singing two or three songs, the words only of which were the plaintiff's, was a representation of part of his play; and in another, the publication of the airs of *Lestocq*, in the form of dance music, was held an infringement. "It must depend on whether the air taken is substantially the same with the original. . . . . The ear tells you it is the same."

Registration, while proper, is not necessary for the protection of the performing-right—*Russell* v. *Smith* (1848), 12 Q. B., 217.

Cause to be represented.—In *Briant* v. *Russell* (1849), 8 C. B., 836, it was held that no one can be considered an offender in this respect "unless by himself, or his agent, he actually takes part in a representation." It was therefore decided that a man who merely let a place for the purpose of the representation, and made no other profit, although he supplied gas and coals and sold some tickets, was not liable; nor would those be liable in any case who merely supply the means of representation to him who actually represents. But where the proprietor and manager of a theatre let it to and for the benefit of

his son—one of his performers, who paid £30 for the use for one night of the theatre, together with the services of the artists, scene-shifters, etc.—he was held to have "caused the piece to be represented"; the Court considering that the proprietor had permitted the representation—*Marsh* v. *Conquest* (1864), 17 C. B., N. S., 418. This distinguishes the case from *Lyon* v. *Knowles* (1864), 5 B. & S., 751, where the hirer brought his own company, and the proprietor had no control over the performance or the persons employed, though he took half the gross receipts and provided everything except the company, even advertising, band, etc. There was no evidence to show whether or not the defendant knew what particular pieces were represented.

Music only.—By 45 and 46 Vict., c. 40 (1882, 10th August), where the proprietor of the copyright in a *musical composition*, first published after the passing of the Act, wishes to retain the right of public representation or performance, he must print on every copy a notice to the effect that the right is reserved. Where the ownership of the copyright and performing-right is in different persons, the latter may, before publication of any copy of the composition, give the former notice in writing requiring him to print on every copy the notice of the reservation. If the performing-right and copyright become vested in different persons after the publication of any copy, and the separate owner of the performing-right wishes to continue the reservation, he must promptly serve a like notice as regards future copies on the owner of the copyright.

The owner of the copyright is subjected to a penalty of £20 for neglecting to comply with any such notice. (S. 3.)

By 51 and 52 Vict., c. 17, the penalty or damages for

unauthorised representation or performance of a *musical composition* are left to the discretion of the Court or judge. The judge has also absolute discretion as to the costs.

By s. 3 of the same Act, no proprietor, tenant, or occupier of a place, where an unauthorised representation or performance takes place, is liable, "unless he shall wilfully cause or permit such unauthorised representation or performance, knowing it to be unauthorised."

The Act does not apply to operas or stage plays in any theatre or other place of public entertainment duly licensed in that respect.

CHAPTER VIII

COLONIAL COPYRIGHT

BRITISH copyright, where it exists in the United Kingdom, extends to all parts of the British dominions—*Routledge* v. *Low* (1868), L. R., 3 H. L., 100; and this although there may be colonial statutes dealing with the same subject. This applies to books, as defined by s. 2 of the Act of 1842 (p. 8), to musical compositions and dramatic representations.

Whatever his rights under his local laws, a colonist could, until lately, only obtain British copyright in any production—literary, artistic, etc.—by first publication in the United Kingdom. This state of the law has, however, been much modified by recent legislation.

In Canada a grievance was felt at the exclusion of foreign reprints made in the United States, and to meet this the Colonial Copyright Act (10 and 11 Vict., c. 95), commonly called the Foreign Reprints Act 1847, by which it was provided that, upon a British possession passing an Act or Ordinance "sufficient for the purpose of securing to British authors reasonable protection within such possession," it should be lawful for Her Majesty, by an Order in Council, to declare the prohibitions against importation of pirate books suspended.

In accordance with this Act most of the Colonies now

Colony.	Date of O. in C.	Reference to *London Gazette*, in which O. in C. is published.				Reference to Vol. and Page of Herts. State Pap. in which O. in C. is published.		Colonial Ordinance providing for Protection of British Authors.
		Month.	Day of the Month.	Year.	Page.	Vol.	Page.	
Antigua, . . .	June 19, 1850	June	25	1850	1782	38	590	Ordinance No. 601.
Bahamas, . . .	May 21, 1849	June	5	1849	1831	37	224	Act No. 1208.
Barbadoes, . . .	Dec. 16, 1848	Dec.	29	1848	4708	36	951	Act No. 936.
	Aug. 15, 1890	Aug.	19	1890	4497	—	—	Act No. 33 of 1889.
Bermuda, . . .	Feb. 13, 1849	Mar.	2	1849	709	37	172	Act No. 699.
British Guiana, . .	Oct. 23, 1851	Nov.	4	1851	2867	40	860	Ordinance No. 14 of 1851.
Canada, . . .	Dec. 12, 1850	Dec.	24	1850	8475	—	—	13 and 14 Vict., c. 6.
Cape of Good Hope, .	Mar. 10, 1855	Mar.	16	1855	1090	45	599	Act No. 4 of 1854.
Grenada, . . .	Dec. 29, 1853	Jan.	13	1854	108	44	903	Act No. 477.
	Dec. 29, 1858	—	—	—	—	44	901	
	June 25, 1857	—	—	—	—	47	570	
Jamaica, . . .	Apr. 23, 1859	Apr.	26	1859	1723	49	570	Act c. 21 of 1858.
Mauritius, . . .	Apr. 1, 1853	Apr.	15	1853	1097	42	253	No. 24 of 1851.
Natal, ...	May 16, 1857	May	22	1857	1804	47	568	Ordinance No. 14 of 1856.
Nevis, ...	Mar. 10, 1855	Mar.	16	1855	1089	45	597	Act No. 237.
New Brunswick, . .	Aug. 11, 1848	Sept.	8	1848	3318	36	946	Ordinance.
Newfoundland, . .	July 30, 1849	Aug.	7	1849	2449	37	226	Books Importation Act No. 74.
Nova Scotia, . .	Aug. 11, 1848	Sept	8	1848	3314	36	948	Ordinance.
Prince Edward's Island,	Oct. 31, 1848	Nov.	3	1848	3910	36	950	Act to protect British Authors.
St. Christopher, . .	Nov. 6, 1849	Nov.	20	1849	3471	37	230	Books Importation Act.
St. Lucia, . . .	Nov. 18, 1850	Nov.	19	1850	3039	38	593	Copyright Ordinance No. 8.
St. Vincent, . . .	Aug. 26, 1881	Sept.	2	1881	4531	—	—	Ordinance No. 34 of 1878.

The author is indebted for this to Mr. Alexander Pulling of the Inner Temple.

admit foreign reprints on payment of an *ad valorem* duty.

On the opposite page will be found a List of Ordinances passed in the Colonies.

The Canadian Law was altered by the Imperial Act, 38 and 39 Vict., c. 53 (1875), which applies to "books" as defined by the Act of 1842 (p. 8), and to musical and artistic works, and established a distinct Canadian copyright, dependent on local registration. The monopoly exists for twenty-eight years, which, in case the author be then living or be dead leaving a widow or child, is extended to fourteen years more. The author must be domiciled in a British possession, or be a citizen of a country having an international copyright treaty with the United Kingdom, and the work must be produced and published in Canada. Provision is made for an interim copyright, obtainable pending publication. Works protected by the Act may not be imported into the United Kingdom. The Act does not interfere with the Imperial Acts.

Many defects in the law, so far as it affects the Colonies, have now been remedied by the International Copyright Act 1886, 49 and 50 Vict., c. 33, s. 8 of which gives the protection of the British Copyright Acts to literary or artistic work first published in a British possession in as full a manner as if first published in the United Kingdom, and when so published relieves the author from the duty of registering the work in England, if the law of the possession provides for such registration, and from depositing copies where the work is a book.

Power is given to Her Majesty, by Order in Council, to modify the Copyright Acts, so far as they relate to any British possession, and to declare that the International Copyright Acts, etc., shall not apply.

International Copyright

1. *Apart from International Copyright Acts or Orders in Council*

It is clear that a foreign author, conforming to the laws of his own country, may assign to an Englishman the unpublished manuscript of his work, and may, by the assignment, bind the assignee, by conditions, only to publish in particular dominions. The Englishman would then, by first publication in England, become entitled to as full protection as if the work were his own original composition—*Buxton* v. *James* (1851), 5 De G. & Sm., 80. He could not by the assignment be restricted to publishing only, say, in England, as the British Copyright Acts extend to all British possessions, and to that extent it was said by Lord St. Leonards in *Jefferys* v. *Boosey* (1854), 4 H. L. C., 815, that "copyright is indivisible." In that case the English assignee purchased from Ricordi, who had only the Milanese copyright, and had no power to transfer the right of reproduction in England, or even the unpublished manuscript, as that right remained in the author, Bellini. See *Routledge* v. *Low* (1868), L. R., 3 H. L., 100, and p. 32.

It is essential for British copyright that the proprietor should, at the time of publication, owe allegiance, though only temporary, to the British Crown. So Oliver Wendell Holmes, who was in the course of contributing "The Guardian Angel," in a serial form, to *The Atlantic Monthly* (Boston, U.S.A.), went temporarily to reside in Canada, and during that stay his English publishers issued the whole of "The Guardian Angel" in London. It was held that he had secured copyright in the six chapters which were first published in London—*Low* v. *Ward* (1868), L. R., 6 Eq., 415. The House of Lords was

equally divided in *Routledge* v. *Low* (u.s.) on the question as to whether even allegiance was necessary, two out of the four judges holding that the benefit of the statute belongs to a non-resident alien friend. But see p. 339.

British copyright is not lost by simultaneous publication in another country, *Ex p. Davidson* (1856), 18 C. B., 297, provided the publications are at least on the same day, though not at the same hour. There is a legal maxim, often misleading but applicable here, to the effect that "the law takes no account of fractions of a day"—*Boosey* v. *Purday* (1849), 4 Ex. Rep., 145. But simultaneous publication will not secure copyright in the United States unless the author be a citizen of or resident in that country; and so in many cases, *e.g.* Professor Bryce's *History of the American Republic* and the *Encyclopædia Britannica*, portions of each work have been written by a citizen of the United States, so protecting those portions, though not other portions, from piracy.

N.B.—For the new International Copyright Act (u.s.) and notes thereon, see Appendix.

2. *Under Statutes and Orders in Council*

The International Copyright Acts are four in number—7 and 8 Vict., c. 12 (1844), 15 and 16 Vict., c. 12 (1852), 38 Vict., c. 12 (1875), and 49 and 50 Vict., c. 33 (1886), and apply only to works published out of Her Majesty's dominions. By the Act of 1844 power was given to Her Majesty in Council to order that the authors whose work should be first published in a foreign country should be entitled to the same British copyright as if the first publication had first taken place in the United Kingdom. The Act applies to literary and artistic productions, and to the performing-right in dramatic and musical

compositions. It includes paintings, drawings, and photographs (25 and 26 Vict., c. 68, s. 12). The Act of 1852 provided (s. 6) that "Nothing herein contained shall be so construed as to prevent fair imitations or adaptations to the English stage of any dramatic piece or musical composition published in any foreign country;" and this again was modified by the Act of 1875, under which Her Majesty, by Order in Council, may direct that s. 6 shall not apply to dramatic pieces the translation whereof is protected. The Order in Council under the 1886 Act directs that this s. 6 shall not apply to any dramatic piece to which protection is thereby extended. See p. 59.

By the Act of 1844, provision is made for registration and delivery of copies of works first published abroad; but by the 1886 Act, s. 4, where an Order in Council is made under this last Act, registration and delivery of copies are no longer required, except so far as is provided by the Order. See p. 53. But although registration is not provided for by the Order in Council, it is still necessary under the general Copyright Acts, and so a foreign painting must be registered here if the owner of the copyright wishes to protect it by legal proceedings—*Fishburn* v. *Hollingshead* (1891), 2 Ch., 371.

S. 7 of the Act of 1852 remains in force, and exempts from its operation, and from that of the 1844 Act, every article of political discussion published in a newspaper or periodical, if the source from which the same is taken be acknowledged, and exempts all other articles, if the source be acknowledged, unless the author reserves his copyright and right of translation in some conspicuous part of the periodical. "The right of reproduction is reserved" was held sufficient in *Cassell* v. *Stiff* (1856), 2 K. J., 279. See p. 62.

The principal Act is the Act of 1886 (49 and 50 Vict.,

c. 33), parts of which have already been referred to. This Act was passed in order to carry into effect the draft of an International Convention, made at Berne in September 1885; and it may be taken for granted that similar provisions have been made with regard to the rights of British authors in each of the countries to which Orders in Council made under the Act apply. The whole working of the details of the Act is left to Orders in Council, and for this reason it seems unnecessary to print here the Act itself, as most of its provisions reappear in the Order set out below, which was published in the *London Gazette* of 2nd December 1887; and for notes on the Act, see p. 71.

"*At the Court at Windsor, the 28th day of November* 1887.

"*Present*—The QUEEN'S Most Excellent Majesty; Lord President; Lord Stanley of Preston; Secretary Sir Henry Holland, Bart.

"WHEREAS the Convention of which an English translation is set out in the First Schedule to this Order has been concluded between Her Majesty the Queen of the United Kingdom of Great Britain and Ireland and the foreign countries named in this Order, with respect to the protection to be given by way of copyright to the authors of literary and artistic works:

"And whereas the ratifications of the said Convention were exchanged on the fifth day of September one thousand eight hundred and eighty-seven, between Her Majesty the Queen and the Governments of the foreign countries following, that is to say:

"Belgium; France; Germany; Hayti; Italy; Spain; Switzerland; Tunis.

"And whereas Her Majesty in Council is satisfied that

the foreign countries named in this Order have made such provisions as it appears to Her Majesty expedient to require for the protection of authors of works first produced in Her Majesty's dominions:

"Now, therefore, Her Majesty, by and with the advice of Her Privy Council, and by virtue of the authority committed to Her by the International Copyright Acts 1844 to 1886, doth order; and it is hereby ordered as follows:

"1. The Convention as set forth in the First Schedule to this Order, shall, as from the commencement of this Order, have full effect throughout Her Majesty's dominions, and all persons are enjoined to observe the same.

"2. This Order shall extend to the foreign countries following, that is to say:[1]

"Belgium; France; Germany; Hayti; Italy; Spain; Switzerland; Tunis; and the above countries are in this Order referred to as the foreign countries of the Copyright Union, and those foreign countries, together with Her Majesty's dominions, are in this Order referred to as the countries of the Copyright Union.

"3. The author of a literary or artistic work which, on or after the commencement of this Order, is first produced in one of the foreign countries of the Copyright Union, shall, subject as in this Order and in the International Copyright Acts 1844 to 1886, mentioned, have as respects that work throughout Her Majesty's dominions, the same right of copyright, including any right capable of being conferred by an Order in Council under section two or section five of the International Copyright Act 1844, or under any other enactment, as if the work had been first produced in the United Kingdom, and shall have such right during the same period;

[1] This Order in Council was extended to Luxembourg by an Order dated 10th August 1888, and to Monaco by an Order dated 15th October 1889.

"Provided that the author of a literary or artistic work shall not have any greater right or longer term of copyright therein, than that which he enjoys in the country in which the work is first produced. See p. 72.

"The author of any literary or artistic work first produced before the commencement of this Order shall have the rights and remedies to which he is entitled under section six of the International Copyright Act 1886.

"4. The rights conferred by the International Copyright Acts 1844 to 1886, shall, in the case of a literary or artistic work first produced in one of the foreign countries of the Copyright Union by an author who is not a subject or citizen of any of the said foreign countries, be limited as follows, that is to say, the author shall not be entitled to take legal proceedings in Her Majesty's dominions for protecting any copyright in such work, but the publisher of such work shall, for the purpose of any legal proceedings in Her Majesty's dominions for protecting any copyright in such work, be deemed to be entitled to such copyright as if he were the author, but without prejudice to the rights of such author and publisher as between themselves.

"5. A literary or artistic work first produced simultaneously in two or more countries of the Copyright Union shall be deemed for the purpose of copyright to have been first produced in that one of those countries in which the term of copyright in the work is shortest.

"6. Section six of the International Copyright Act 1852, shall not apply to any dramatic piece to which protection is extended by virtue of this Order.

"7. The Orders mentioned in the Second Schedule to this Order are hereby revoked;

"Provided that neither such revocation, nor anything else in this Order, shall prejudicially affect any right

acquired or accrued before the commencement of this Order, by virtue of any Order hereby revoked, and any person entitled to such right shall continue entitled thereto, and to the remedies for the same, in like manner as if this Order had not been made.

"8. This Order shall be construed as if it formed part of the International Copyright Act 1886.

"9. This Order shall come into operation on the sixth day of December, one thousand eight hundred and eighty-seven, which day is in this Order referred to as the commencement of this Order.

"And the Lords Commissioners of Her Majesty's Treasury are to give the necessary orders herein accordingly.

"C. L. PEEL."

"FIRST SCHEDULE

"*Copyright Convention*

"Convention for protecting effectively and in as uniform a manner as possible the rights of authors over their literary and artistic works. Made on the fifth day of September, one thousand eight hundred and eighty-seven, between Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, Empress of India; His Majesty the German Emperor, King of Prussia; His Majesty the King of the Belgians; Her Majesty the Queen Regent of Spain, in the name of His Catholic Majesty the King of Spain; the President of the French Republic; the President of the Republic of Haïti; His Majesty the King of Italy; the Federal Council of the Swiss Confederation; His Highness the Bey of Tunis.

"[The following is an English translation of the Convention, with the omission of the formal beginning and end.]

"ART. I. The Contracting States are constituted into an

Union for the protection of the rights of authors over their literary and artistic works.

"ART. II. Authors of any of the countries of the Union, or their lawful representatives, shall enjoy in the other countries for their works, whether published in one of those countries or unpublished, the rights which the respective laws do now or may hereafter grant to natives.

"The enjoyment of these rights is subject to the accomplishment of the conditions and formalities prescribed by law in the country of origin of the work, and cannot exceed in the other countries the term of protection granted in the said country of origin. See p. 72.

"The country of origin of the work is that in which the work is first published, or if such publication takes place simultaneously in several countries of the Union, that one of them in which the shortest term of protection is granted by law.

"For unpublished works the country to which the author belongs is considered the country of origin of the work.

"ART. III. The stipulations of the present Convention apply equally to the publishers of literary and artistic works published in one of the countries of the Union, but of which the authors belong to a country which is not a party to the Union.

"ART. IV. The expression 'literary and artistic works' comprehends books, pamphlets, and all other writings; dramatic or dramatico-musical works, musical compositions with or without words; works of design, painting, sculpture, and engraving; lithographs, illustrations, geographical charts, plans, sketches, and plastic works relative to geography, topography, architecture, or science in general; in fact, every production whatsoever in the literary, scientific, or artistic domain which can be published by any mode of impression or reproduction.

"ART. V. Authors of any of the countries of the Union, or their lawful representatives, shall enjoy in the other countries the exclusive right of making or authorising the translation of their works until the expiration of ten years from the publication of the original work in one of the countries of the Union.

"For works published in incomplete parts ('livraisons') the period of ten years commences from the date of publication of the last part of the original work.

"For works composed of several volumes published at intervals, as well as for bulletins or collections ('cahiers') published by literary or scientific societies, or by private persons, each volume, bulletin, or collection is, with regard to the period of ten years, considered as a separate work.

"In the cases provided for by the present Article, and for the calculation of the period of protection, the thirty-first December of the year in which the work was published is admitted as the date of publication.

"ART. VI. Authorised translations are protected as original works. They consequently enjoy the protection stipulated in Arts. II and III as regards their unauthorised reproduction in the countries of the Union.

"It is understood that, in the case of a work for which the translating right has fallen into the pul : domain, the translator cannot oppose the translation of the same work by other writers.

"ART. VII. Articles from newspapers or periodicals published in any of the countries of the Union may be reproduced in original or in translation in the other countries of the Union, unless the authors or publishers have expressly forbidden it. For periodicals it is sufficient if the prohibition is made in a general manner at the beginning of each number of the periodical. See p. 56.

"This prohibition cannot in any case apply to articles of

political discussion, or to the reproduction of news of the day or current topics.

"ART. VIII. As regards the liberty of extracting portions from literary or artistic works for use in publications destined for educational or scientific purposes, or for chrestomathies, the matter is to be decided by the legislation of the different countries of the Union, or by special arrangements existing or to be concluded between them.

"ART. IX. The stipulations of Art. II apply to the public representation of dramatic or dramatico-musical works, whether such works be published or not.

"Authors of dramatic or dramatico-musical works, or their lawful representatives, are, during the existence of their exclusive right of translation, equally protected against the unauthorised public representation of translations of their works.

"The stipulations of Art. II apply equally to the public performance of unpublished musical works, or of published works in which the author has expressly declared on the title page or commencement of the work that he forbids the public performance.

"ART. X. Unauthorised indirect appropriations of a literary or artistic work, of various kinds, such as *adaptations*, *arrangements of music*, etc., are specially included amongst the illicit reproductions to which the present Convention applies, when they are only the reproduction of a particular work, in the same form, or in another form, with non-essential alterations, additions, or abridgments, so made as not to confer the character of a new original work.

"It is agreed that, in the application of the present article, the tribunals of the various countries of the Union will, if there is occasion, conform themselves to the provisions of their respective laws.

"ART. XI. In order that the authors of works protected by the present Convention shall, in the absence of proof to the contrary, be considered as such, and be consequently admitted to institute proceedings against pirates before the courts of the various countries of the Union, it will be sufficient that their name be indicated on the work in the accustomed manner.

"For anonymous or pseudonymous works, the publisher whose name is indicated on the work is entitled to protect the rights belonging to the author. He is, without other proof, reputed the lawful representative of the anonymous or pseudonymous author.

"It is, nevertheless, agreed that the tribunals may, if necessary, require the production of a certificate from the competent authority to the effect that the formalities prescribed by law in the country of origin have been accomplished, as contemplated in Art. II.

"ART. XII. Pirated works may be seized on importation into those countries of the Union where the original work enjoys legal protection.

"The seizure shall take place conformably to the domestic law of each State.

"ART. XIII. It is understood that the provisions of the present Convention cannot in any way derogate from the right belonging to the Government of each country of the Union to permit, to control, or to prohibit, by measures of domestic legislation or police, the circulation, representation, or exhibition of any works or productions in regard to which the competent authority may find it necessary to exercise that right.

"ART. XIV. Under the reserves and conditions to be determined by common agreement,[1] the present Convention applies to all works which at the moment of its

[1] See paragraph 4 of Final Protocol.

coming into force have not yet fallen into the public domain in the country of origin.

"ART. XV. It is understood that the Governments of the countries of the Union reserve to themselves respectively the right to enter into separate and particular arrangements between each other, provided always that such arrangements confer upon authors or their lawful representatives more extended rights than those granted by the Union, or embody other stipulations not contrary to the present Convention.

"ART. XVI. An international office is established, under the name of the 'Office of the International Union for the Protection of Literary and Artistic Works.'

"This office, of which the expenses will be borne by the Administrations of all the countries of the Union, is placed under the high authority of the Superior Administration of the Swiss Confederation, and works under its direction. The functions of this office are determined by common accord between the countries of the Union.

"ART. XVII. The present Convention may be submitted to revisions in order to introduce therein amendments calculated to perfect the system of the Union.

"Questions of this kind, as well as those which are of interest to the Union in other respects, will be considered in Conferences to be held successively in the countries of the Union by delegates of the said countries.

"It is understood that no alteration in the present Convention shall be binding on the Union except by the unanimous consent of the countries composing it.

"ART. XVIII. Countries which have not become parties to the present Convention, and which grant by their domestic law the protection of rights secured by this Convention, shall be admitted to accede thereto on request to that effect.

"Such accession shall be notified in writing to the Government of the Swiss Confederation, who will communicate it to all the other countries of the Union.

"Such accession shall imply full adhesion to all the clauses and admission to all the advantages provided by the present Convention.

"ART. XIX. Countries acceding to the present Convention shall also have the right to accede thereto at any time for their Colonies or foreign possessions.

"They may do this either by a general declaration comprehending all their Colonies or possessions within the accession, or by specially naming those comprised therein, or by simply indicating those which are excluded.

"ART. XX. The present Convention shall be put in force three months after the exchange of the ratifications, and shall remain in effect for an indefinite period until the termination of a year from the day on which it may have been denounced.

"Such denunciation shall be made to the Government authorised to receive accessions, and shall only be effective as regards the country making it, the Convention remaining in full force and effect for the other countries of the Union.

"ART. XXI. The present Convention shall be ratified, and the ratifications exchanged at Berne, within the space of one year at the latest.

"*Additional Article*

"The Convention concluded this day in no wise affects the maintenance of existing Conventions between the contracting States, provided always that such Conventions confer on authors, or their lawful representatives, rights more extended than those secured by the Union, or contain other stipulations which are not contrary to the said Convention.

"*Final Protocol*

"1. As regards Art. IV it is agreed that those countries of the Union where the character of artistic works is not refused to photographs, engage to admit them to the benefits of the Convention concluded to-day, from the date of its coming into effect. They are, however, not bound to protect the authors of such works further than is permitted by their own legislation, except in the case of international engagements already existing, or which may hereafter be entered into by them.

"It is understood that an authorised photograph of a protected work of art shall enjoy legal protection in all the countries of the Union, as contemplated by the said Convention for the same period as the principal right of reproduction of the work itself subsists, and within the limits of private arrangements between those who have legal rights.

"2. As regards Art. IX it is agreed that those countries of the Union whose legislation implicitly includes choreographic works amongst dramatico-musical works expressly admit the former works to the benefits of the Convention concluded this day.

"It is, however, understood that questions which may arise on the application of this clause shall rest within the competence of the respective tribunals to decide.

"3. It is understood that the manufacture and sale of instruments for the mechanical reproduction of musical airs which are copyright, shall not be considered as constituting an infringement of musical copyright.

"4. The common agreement alluded to in Art. XIV of the Convention is established as follows:—

"The application of the Convention to works which have not fallen into the public domain at the time when it comes into force, shall operate according to the stipulations

on this head which may be contained in special conventions either existing or to be concluded.

"In the absence of such stipulations between any countries of the Union, the respective countries shall regulate, each for itself, by its domestic legislation, the manner in which the principle contained in Art. XIV is to be applied.

"5. The organisation of the International Office established in virtue of Art. XVI of the Convention, shall be fixed by a regulation which shall be drawn up by the Government of the Swiss Confederation.

"The official language of the International Office will be French.

"The International Office will collect all kinds of information relative to the protection of the rights of authors over their literary and artistic works. It will arrange and publish such information. It will study questions of general utility likely to be of interest to the Union, and, by the aid of documents placed at its disposal by the different administrations, will edit a periodical publication in the French language treating questions which concern the Union. The Governments of the countries of the Union reserve to themselves the faculty of authorising, by common accord, the publication by the office of an addition in one or more other languages if experience should show this to be requisite.

"The International Office will always hold itself at the disposal of members of the Union, with the view to furnish them with any special information they may require relative to the protection of literary and artistic works.

"The administration of the country where a Conference is about to be held, will prepare the programme of the Conference with the assistance of the International Office.

"The Director of the International Office will attend

the sittings of the Conferences, and will take part in the discussions without a deliberative voice. He will make an annual report on his administration, which shall be communicated to all the members of the Union.

"The expenses of the office of the International Union shall be shared by the contracting States. Unless a fresh arrangement be made, they cannot exceed a sum of sixty thousand francs a year. This sum may be increased by the decision of one of the Conferences provided for in Art. XVII.

"The share of the total expense to be paid by each country shall be determined by the division of the contracting and acceding States into six classes, each of which shall contribute in the proportion of a certain number of units:

First class,	.	25 units.	Fourth class,	.	10 units.
Second class,	.	20 ,,	Fifth class,	.	5 ,,
Third class,	.	15 ,,	Sixth class,	.	3 ,,

"These co-efficients will be multiplied by the number of States of each class, and the total product thus obtained will give the number of units by which the total expense is to be divided. The quotient will give the amount of the unity of expense. Each State will declare, at the time of its accession, in which of the said classes it desires to be placed.

"The Swiss Administration will prepare the budget of the office, superintend its expenditure, make the necessary advances, and draw up the annual account, which shall be communicated to all the other Administrations.

"6. The next Conference shall be held at Paris between four and six years from the date of the coming into force of the Convention.

"The French Government will fix the date within these limits after having consulted the International Office.

"7. It is agreed that, as regards the exchange of ratifications contemplated in Art. XXI, each contracting party shall give a single instrument, which shall be deposited

with those of the other States, in the Government Archives of the Swiss Confederation. Each party shall receive in exchange a copy of the procès-verbal of the exchange of ratifications, signed by the Plenipotentiaries present.

"The present final Protocol, which shall be ratified with the Convention concluded this day, shall be considered as forming an integral part of the said Convention, and shall have the same force, effect, and duration.

"SECOND SCHEDULE

"*Orders in Council Revoked*

"Orders in Council of the dates named below for securing the privileges of copyright in Her Majesty's dominions to authors of works of literature and the fine arts and dramatic pieces, and musical compositions, first produced in the following foreign countries, namely :—

Foreign Country.	Date of Order.
Prussia,	27th August 1846.
Saxony,	26th September 1846.
Brunswick,	24th April 1847.
The States of the Thuringian Union,	10th August 1847.
Hanover,	30th October 1847.
Oldenburg,	11th February 1848.
France,	10th January 1852.
Anhalt, Dessau, and Analt Bernbourg.	11th March 1853.
Hamburgh,	25th November 1853 and 8th July 1855.
Belgium,	8th February 1855.
Prussia, Saxony, Saxe Weimar,	19th October 1855.
Spain,	24th September 1857 and 20th November 1880.
The States of Sardinia,	4th February 1861.
Hesse, Darmstadt,	5th February 1862.
Italy,	9th September 1865.
German Empire,	24th September 1886.

"The Order in Council of 5th August 1875, revoking the application of s. 6 of 15 and 16 Vict., c. 12, to dramatic pieces referred to in the Order in Council of 10th January 1852, with respect to works first published in France."

The protection of the 1886 Act applies to works published before the date of the Order in Council, saving the rights obtained by any lawful previous publication in the United Kingdom, s. 6. It has been decided that one who has lawfully produced or performed a foreign musical work before the Act came into operation may still do so —*Moul* v. *Groenings* (1891), W. N., 131.

S. 7 refers to evidence of the foreign copyright, and is as follows:—"Where it is necessary to prove the existence or proprietorship of the copyright of any work first produced in a foreign country to which an Order in Council under the International Copyright Acts applies, an extract from a register, or a certificate, or other document stating the existence of the copyright, or the person who is the proprietor of such copyright, or is for the purpose of any legal proceedings in the United Kingdom deemed to be entitled to such copyright, if authenticated by the official seal of a Minister of State of the said foreign country, or by the official seal or the signature of a British diplomatic or consular officer acting in such country, shall be admissible as evidence of the facts named therein, and all Courts shall take judicial notice of every such official seal and signature as is in this section mentioned, and shall admit in evidence, without proof, the documents authenticated by it."

Translations.—By s. 5, the copyright given to a foreign work includes the right of translation into other languages, provided that if an authorised English translation has not been produced within ten years, or any other term prescribed by the Order, the right to prevent an unauthorised translation in the United Kingdom ceases. See on next page, "Importation."

The conditions of the Acts and Orders must be strictly observed—*Cassell* v. *Stiff* (1856), 2 K. & J., 279. It

will be necessary, therefore, to conform to the British statutes regulating works first published in the United Kingdom, except in those particulars from which foreign works are expressly exempted. Thus each print of an engraving must bear the true date of the first publication —*Avanzo* v. *Mudie* (1854), 10 Ex. Rep., 203; and the work must be registered where registration is required for an English production. See *supra*, p. 56.

A plaintiff residing abroad, and having no sufficient assets in this country, will have to pay money into Court, or find security for costs, as a condition of suing or obtaining an injunction—*Troitsch* v. *Rees*, W. N., 1887, 150.

Importation.—The Act of 1844 (s. 10) prohibits the importation of all protected foreign books printed or reprinted in any country other than that in which such books were first published. The person who possesses such books for sale or hire is liable to an action for damages.

The Act of 1852 (s. 9) prohibits the importation of all protected foreign works of literature or art, and translations of any foreign book or dramatic piece, printed in any country but that in which such work was first published. See also p. 17.

Performing-right.—This is protected as well as the copyright—*Moul* v. *Groenings* (1891), W. N., 131.

Terms.—The term in France is the life of the author and 50 years; Belgium, life and 20 years; Germany, life and 30 years; Italy, life and 40 years, with a second term of 40 years protected only by royalties; Russia, life and 50 years; Spain, life and 50 years; Portugal, life and 50 years; Holland, life and 20 years—*Report of Copyright Com.*, s. 39. As to the United States, see Appendix.

CHAPTER IX

THE RIGHTS OF AUTHORS, EDITORS, AND PUBLISHERS, *INTER SE*

An author (see p. 27) who owns his unpublished work, or the copyright in a published composition, may, after sale, himself publish another work on the same subject, the sale whereof may interfere with the sale of the first, provided that the new work be not an infringement of the copyright in the first, and that he has not bound himself by express or implied contract not to publish a rival work — *Barfield* v. *Nicholson* (1824), 2 S. & S., 1, in which case his publisher, as well as himself, will be liable to an injunction.

An author's right to use his own name in connection with a work is assignable; and in the case of *Beeton's Christmas Annual*, where the author conveyed the right to use his name in connection with the serial, and agreed not to permit the use of his name for another publication without consent, he was restrained from breaking the agreement—*Ward* v. *Beeton* (1874), L. R., 19 Eq., 207. He would also be restrained from stating that the use of his name is unauthorised—*Bradbury* v. *Dickens* (1859), 27 Beav., 53.

If an author present a MS. to a publisher, with verbal permission to publish it, no injunction will be granted to restrain the publisher on the ground of the gift being

incomplete without writing, which it is submitted it is not—*Rundell* v. *Murray* (1821), Jac., 311.

The contract by which an author undertakes to write a work for a publisher is a strictly personal one, and ceases to be in force upon the death of the author, *i.e.* its benefits and liabilities do not survive to his representatives—*Marshall* v. *Broadhurst* (1831), 1 Tyr., 348; and, in case of his bankruptcy, his trustee cannot compel him to complete his contract for the benefit of the estate. See *Sir Walter Scott's* case, quoted in *Gibson* v. *Carruthers* (1841), 8 M. & W., at p. 343. And, for this reason, no decree for specific performance of the contract can be made, although the author may be restrained from writing the same work for any one else, if there is in the agreement a negative covenant to that effect; but this will not be imported from the positive covenant—*Clarke* v. *Price* (1819), 2 Wils. C. C., 157; *Stiff* v. *Cassell* (1856), 2 Jur., N. S., 348. The contract is personal also on the side of the publisher, and cannot, without the consent of the author, be assigned to another publisher, or to the successors of the firm—*Hole* v. *Bradbury* (1879), 12 Ch. D., 886; the case of Leech's *A Little Tour in Ireland.*

Where a contract is made by an author to write, and a publisher to publish, a right of action for damages arises on breach of the contract, and also an action for payment for work performed—*Gale* v. *Leckie* (1817), 2 St., 107; and it may be that an injunction will be granted in aid of a publisher who has partly performed a contract to publish a book, which the author has taken to another publisher—*Brook* v. *Ventnor* (1797), 3 Anst., 881. As to whether an agreement between author and publisher amounts to a partnership see *Venables* v. *Wood* (1839), 3 Ross, L. C., 529; and as between printer and publisher see *Wilson* v. *Whitehead* (1842), 10 M. & W., 503.

Care must be taken that an agreement between author and publisher is not "in restraint of trade," as the Courts are rightly jealous of contracts restraining authors from future work. The question of "reasonableness" is for the Court alone; and it is almost impossible to state beforehand, except by way of extreme examples, what would be reasonable and what not. Thus an agreement not to publish a new book on the same subject as the one sold might, under some circumstances, be good—*Ainsworth* v. *Bentley* (1866), 14 W. R., 630; but not an agreement forbidding the publication of any and all new books, unless this were closely limited in point of time.

In an agreement by which the net profits of *Peg Woffington* were to be divided between Charles Reade and his publisher Bentley,—nothing being said as to the number of editions, price, or appearance, or as to the termination of the agreement,—it was held that Bentley had the right of fixing the price, and might, if he chose, add illustrations; and that he might continue bringing out successive editions, until the partnership between him and Charles Reade should be dissolved, previous to the incurring of any expense on account of a future edition—*Reade* v. *Bentley* (1858), 4 K. & J., 656. In this case (p. 667) the Vice-Chancellor explained the meaning of the word "edition":—"An edition of a work is the putting of it forth before the public; and if this be done in batches at successive periods, each successive batch is a new edition; and the question whether the individual copies have been printed by means of moveable type or by stereotype, does not seem to me to be material. . . . A new edition is published whenever, having in his storehouse a certain number of copies, the publisher issues a fresh batch of them to the public." The purchaser of an

"edition" may restrain the publication of a new edition while any of his copies remain unsold, and he is *pro tanto* purchaser of the copyright—*Sweet* v. *Cater* (1841), 11 Sim., 572. But where there is no mention of editions or number of copies, and the publisher merely agrees to publish at a royalty, then, in the absence of words giving an exclusive licence to publish, the author can employ another to publish simultaneously with the first. In the absence of contract there is no implied condition to the contrary—*Warne* v. *Routledge* (1874), L. R., 18 Eq., 497. As to underselling, in contravention of agreement, see *Benning* v. *Dove* (1833), 5 C. & P., 427.

One man has no right to advertise or issue a publication as another's, or as the continuation of a serial of another, *e.g.* as a "New Series Improved"—*Hogg* v. *Kirby* (1803), 8 Ves., 215; *Prowett* v. *Mortimer* (1856), 2 Jur. N. S., 414, and see *ante*, p. 15: but he may, of course, publish or advertise another work, and may disparage his rival's book by pointing out the excellences of his own, but he must be careful to avoid libel.

It is allowable for an author, on dissolving partnership, or on ceasing to compose or edit a periodical or serial on behalf of another, to advertise the fact that he no longer has any connection with the publication in question; but he may not state that the publication has been discontinued, as in the one case it is the property of the partnership and must be sold as such, and in the other it belongs to the publisher—*Bradbury* v. *Dickens* (1859), 27 Beav., 53; in which case an injunction went against the late Charles Dickens in respect of *Household Words*, upon the severance of the partnership between himself and the plaintiff.

A contract to supply a "new" history is not satisfied by supplying a translation of an existing history, though

accompanied with new additions and a continuation —*Paton* v. *Duncan* (1828), 3 C. & P., 336.

To advertise a song as "written by G. L." is not incorrect if the words have in fact been written by him, although the music be composed by some one else— *Chappell* v. *Sheard*, *ib.* v. *Davidson* (1855), 2 K. & J., 117, 123.

The purchaser of a manuscript has, in the absence of agreement to the contrary, the right of modifying the manuscript, even against the will of the author, though it may, of course, be an implied term in the contract that the work should be published entire—*Cox* v. *Cox* (1853), 11 Hare, 118. No detriment to the author's reputation, which may possibly result, will give him a right to an action unless the publication is libellous of the author or injurious to him in his trade or profession. In *Archbold* v. *Sweet* (1832), 1 M. & R., 162, the plaintiff, a barrister, obtained a verdict against the defendant for publishing the third edition of a law-book originally written by the plaintiff, the defendant falsely alleging that the edition was edited by the plaintiff, such edition containing many inaccuracies and errors in law and reasoning. The name of the editor is not part of the title of a book. Where there is no contract that the name should be published, the editor cannot insist on its appearing. An injunction will not be granted where the publisher and proprietor unduly interferes with the functions of the editor, but the editor may recover damages—*Crookes* v. *Petter* (1860), 6 Jur. N. S. Ch., 1131. In articles written for reviews, etc., it is usual for authors to be restricted in length; and, where this is the case, it would be within the discretion of the editor to cut down the article to the required size. Of course, an editor may erase libellous or offensive expressions.

Encyclopædias, Periodicals, Serials, etc.—S. 18 of 5 and 6 Vict., c. 45, is important as defining the rights of proprietors and contributors, and is given in full as follows:—

"And be it enacted, that when any publisher or other person shall, before or at the time of the passing of this Act, have projected, conducted, and carried on, or shall hereafter project, conduct, and carry on, or be the proprietor of any encyclopædia, review, magazine, periodical work, or work published in a series of books or parts, or any book whatsoever, and shall have employed or shall employ any persons to compose the same, or any volumes, parts, essays, articles, or portions thereof, for publication in or as part of the same, and such work, volumes, parts, essays, articles, or portions shall have been or shall hereafter be composed under such employment, on the terms that the copyright therein shall belong to such proprietor, projector, publisher, or conductor, and paid for by such proprietor, projector, publisher, or conductor, the copyright in every such encyclopædia, review, magazine, periodical work, and work published in a series of books or parts, and in every volume, part, essay, article, and portion so composed and paid for, shall be the property of such proprietor, projector, publisher, or other conductor, who shall enjoy the same rights as if he were the actual author thereof, and shall have such term of copyright therein as is given to the authors of books by this Act, except only that in the case of essays, articles, or portions forming part of and first published in reviews, magazines, or other periodical works of a like nature, after the term of twenty-eight years from the first publication thereof respectively, the right of publishing the same in a separate form shall revert to the author for the remainder of the term given by this Act: Provided always that during the

term of twenty-eight years the said proprietor, projector, publisher, or conductor shall not publish any such essay, article, or portion separately or singly without the consent previously obtained of the author thereof or his assigns: Provided also that nothing herein contained shall alter or affect the right of any person who shall have been or who shall be so employed as aforesaid to publish any such his composition in a separate form, who, by any contract, express or implied, may have reserved or may hereafter reserve to himself such right; but every author reserving, retaining, or having such right shall be entitled to the copyright in such composition when published in a separate form, according to this Act, without prejudice to the right of such proprietor, projector, publisher, or conductor as aforesaid."

In the absence of agreement to the contrary, the copyright is in the author subject to a statutory licence to use the contribution for a particular purpose, and he may restrain the publication of the article in a separate form or otherwise than as part of the encyclopædia or periodical—*Hereford* v. *Griffin* (1848), 16 Sim., 190. Where the proprietor of the periodical, etc., has obtained the manuscript, and has actually paid for it "on the terms that the copyright therein shall belong to" him, he can sue for breach of contract on proof of those facts; but where he does not prove this, the author must be joint-plaintiff—*Walter* v. *Howe* (1881), 17 Ch. D., 708; *Richardson* v. *Gilbert* (1851), 1 Sim. N. S., 336, etc. It is probable that during the twenty-eight years the author might sue for infringement if he proved that his reversionary right had been damaged. The right of the author, as regards the proprietor of the periodical, is not founded on copyright, and so may be enforced without registration—*Mayhew* v. *Maxwell* (1860), 1 J. & H., 312: a case

which also decided that an extra (*e.g.* a Christmas) number of a periodical is part of the periodical and not a separate publication, but that a story written for the Christmas number could not be republished by the proprietor. Again, the publisher has no right to issue a story contributed as a serial to his periodical in a "supplemental" number which may be purchased without the current number—*Smith* v. *Johnson* (1863), 4 Giff, 632.

Where the publisher or proprietor has paid for the whole copyright, he posseses it both for the first and renewed terms, but an assignment in writing might be necessary to prove the transfer—*Rundell* v. *Murray* (1821), Jac., 311.

PART II

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PATENTS

CHAPTER I

INTRODUCTORY

THE Statute of Monopolies (21 Jas. I, c. 3), which was passed in 1624, forms the basis of all modern patent law, so much so that there is little beyond antiquarian interest, which can be satisfied by an inquiry as to the law previous to that date.

Any student of constitutional history will recollect the prerogative right of the Crown, claimed and exercised as early as the reign of Edward III, to grant letters-patent to persons inventing or at least introducing into the realm a new process or a new product of manufacture. He will recollect also the attempts made by the different sovereigns of the Tudor dynasty, urged by pecuniary difficulties, to extend the prerogative by granting monopolies for making and selling products that were of old and every-day use, and the protests made by the Commons with varying success. James I, after the decision in *Darcy* v. *Allein*, 11 Co. R., 84*b*, virtually gave up the contest by publishing in 1610 a book, entitled *A Declaration of His Majesty's Pleasure*, in which he declared monopolies to be against the law of the realm.

This declaration, coupled with the inconsistency of His Majesty's conduct with his professions, was the cause of the Statute of Monopolies, which commenced in s. 1, after

the manner of statutes of that time, with a recitation of the state of the law and the grievances which occasioned the necessity for the present enactment. This preamble made special mention of James' published declaration, and proceeded to declare and enact that all monopolies were "altogether contrary to the laws of the realm, etc.," and were thereafter to be tried by the common laws, and (inferentially) not by the Court of Star Chamber, a Court which had distinguished itself by upholding illegal monopolies to the great advantage of the influential monopolists and of the sovereign.

Sir Edward Coke (3 Inst., 181) defines a monopoly as "an institution or allowance by the King by his grant, commission, or otherwise to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of anything, whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade." [1]

The statute, if it had stopped with the first four sections, would have suppressed all monopolies, but in the fifth and subsequent sections certain letters-patent and privileges were saved.

These were :—

1. Letters-patent already made for new manufactures, not used by others at the time of making the letters-

[1] *a.* Municipal Corporations are still constituted by Royal Charter. Companies for trading and other purposes may be founded in the same way. See 7 Will. IV, c. 73 (1837).

b. Persons who sell "patent" medicines have to take out an annual licence and to affix to the medicines, before they are exposed for sale, labels impressed with the amount of duty payable. They must supply the Commissioners of Stamps with a note containing their name and address, and must obtain from him the requisite labels. Both buyer and seller are liable to a penalty if the medicines are sold without the label.

patent, such privileges not to last more than twenty-one years.

2. Future letters-patent and grants of privilege.
3. Grants to justices.
4. Charters to corporations.
5. Letters-patent concerning printing, saltpetre, gunpowder, great ordnance, shot, offices, alum, mines, the liberties of Newcastle-on-Tyne, tavern licences, and certain named patents to individuals.

With regard to 2, it appears from s. 6 that the grant must possess the following seven properties :—

(1) It must be for fourteen years or under (p. 103).

(2) It must be granted to the true and first inventor or inventors (p. 94).

(3) It must be of new manufactures, which any other at the time of making such letters-patent did not use (p. 89).

(4) It must not be contrary to law.

(5) Nor mischievous to the State by raising prices of commodities at home.

(6) Nor to the hurt of trade.

(7) Nor generally inconvenient.—Hindmarch, pp. 1–18.

To the above requirements it should be added that the invention must be *useful* to the public (p. 93).

An Act passed in 1835 (5 and 6 Will. IV, c. 83) enabled a patentee, who, as found by a verdict of a jury, was not the true inventor, but who believed himself to be so, to petition Her Majesty in Council for the confirmation of the patent, which might be granted on the Judicial Committee being satisfied that the invention "had not been publicly and generally used before the date" of the patent. This statute also contained provisions respecting the prolongation of the term, which provisions were sub-

sequently amended by 2 and 3 Vict., c. 67 (1839), and again by 7 and 8 Vict., c. 69 (1844).

The Patent Law Amendment Act, 1852 (15 and 16 Vict., c. 83), made extensive alterations. By it the Commissioners for Patents were constituted, provisional and complete specifications and investigation by a law-officer were made obligatory. Letters-patent were to be avoided on non-payment of fees, were to extend over the United Kingdom, the Channel Islands, and the Isle of Man. Provision was made for filing specifications, registering patents and proprietors, etc., etc. The payment of fees was altered in the next year 1853 (16 and 17 Vict., c. 5). The law was further amended, in points now immaterial to notice, by 16 and 17 Vict., c. 115.

In 1859 provision was made for assigning to the Secretary of State for War improvements in instruments or munitions of war (22 Vict., c. 13); and in 1865 it was enacted that exposition of inventions in certain industrial exhibitions certified by the Board of Trade should not prejudice the inventor's right to a patent (28 and 29 Vict., c. 3); and in 1870 the same right was given as regards international exhibitions.

The whole of the previous legislation was repealed, consolidated and amended by the Patents Act, 1883, which now follows, with notes.

In this Act, s. 46, the following definitions occur:—

"In and for the purposes of this Act—

"'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 privilege, within s. 6 of the Statute of Monopolies (that is, the Act of

the twenty-first year of the reign of King James the First, c. 3, intituled 'An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof'), and includes an alleged invention (p. 88).

"In Scotland 'injunction' means 'interdict.'"

Letters-patent, or, in common parlance, a patent such as forms the subject of this work, may be correctly defined an open record under the Great Seal, containing a grant of privilege in an invention made by the Crown to an inventor.—Hindmarch, p. 36.

CHAPTER II

THE INVENTION

It will be remembered that the Statute of Monopolies excepted from its operation "the privilege of the sole working or making of any manner of new manufacture;" from which it would appear that what is protected by a patent is not the product, but the process—the working or making; but this is not the real meaning, it having long ago been decided that both a product and a process may be the subject of patents. Great care should be taken in drawing the specification (p. 99) to make it clear whether a patent is claimed for a new manufactured article or a new process of producing a known article. Where the article itself is new, a monopoly in it should be claimed, and not necessarily in the process: for such a monopoly includes all possible processes of manufacture — *Badische, Anilin, etc.* v. *Levinstein* (1887); 12 App. Cas., 710. But the product or method being claimed, it is necessary to avoid claiming the principle which is applied. Thus a combination patent will protect a machine from all others substantially the same, not (directly) the principle of construction—*Automatic Co.* v. *Combined Co.* (1889), 6 R. P. C., 367; *Same* v. *Knight*, *ib.*, p. 297. No patent can be granted for an idea or principle, apart from the practical application of it to a

manufacture. It is not necessary that the article or process should have been actually produced or put into operation before the application for a patent; indeed, in the case of an imported invention, it is unusual to manufacture in this country before the application is made. Again, it is often dangerous to manufacture before protection is granted, for the invention may cease to be secret, and so may lose the essential merit of novelty.

If a process only is claimed, a rival manufacturer is at liberty to produce the same result by another process.

Novelty.—The manufacture must be new "within the realm"—*Jackson* v. *Needle* (1885), 2 R. P. C., 191. See s. 103, p. 297.

A process or product is not new if there previously exists within the realm, information, by using which a competent workman (see p. 111) can use the process or make the product. Actual previous manufacture is not necessary to disqualify the applicant. Information as to a result obtained is not anticipation of the process, which precedes the result—*Dowling* v. *Billington* (1890), 7 R. P. C., 191. The information may exist in picture form, or it may be in a book, pamphlet, etc., published in the ordinary way in which books, etc., are published, or which may be deposited in a place to which the public have access.

In a recent case—*Harris* v. *Rothwell* (1887), 35 Ch. D., at p. 431—the majority of Court of Appeal said, "*Prima facie*, a patentee is not the first inventor of his patented invention if it be proved that before the date of his patent an intelligible description of his invention, either in English or in any other language commonly known in this country, was known to exist in this country, either in the Patent Office or in any other library to which the public are admitted, and to which persons in search of information on the subject to which the patent relates

would naturally go for information. But if it be proved that the foreign publication, although in a public library, was not, in fact, known to be there, the unknown existence of the publication in this country is not fatal to the patent." See *United Horse Shoe Co.* v. *Stewart* (1888), 2 R. P. C., 122; *Pickard* v. *Prescott* (1890), 7 R. P. C., 361.

By s. 44, sub-s. 12, "The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorised by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same."

A new use for an old thing cannot be patented. "It would be a very extraordinary thing to say, that because all mankind have been accustomed to eat soup with a spoon, a man could take out a patent because he says you might eat peas with a spoon."

In *American Braided Wire Co.* v. *Thompson* (1888), 5 R. P. C., 113, it was held that prior applications of the same material, and a suggestion in the specification that the material might be applied to analogous articles, without any practical mode of so applying it being pointed out, was no anticipation.

An application of a known principle, material, or machinery to produce a novel result is good subject-matter for a patent—*Dowling* v. *Billington* (1890), 7 R. P. C., 191; but not the application of a known article, material, or machinery to a known or analogous purpose—*Morgan* v. *Windover* (1890), 7 R. P. C., 131; *Albo-Carbon Light Co.* v. *Kidd* (1887), 4 R. P. C., 535. So, manufacture of a known article in a new material cannot be protected unless the new material is itself protected.

But a new contrivance for producing an old object may be patented.

Ready and extensive sale is cogent evidence of novelty —*Ehrlich* v. *Ihlee* (1888), 5 R. P. C., 198.

Exhibitions.—By s. 39 of the Act of 1883, "The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely :—

"(*a.*) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so (Form O, p. 167); and

"(*b.*) The application for a patent must be made before or within six months from the date of the opening of the exhibition."

The notice must be in writing, accompanied by a brief description of the invention, and drawings, if necessary, and any other information required by the comptroller (Rule 15).

Her Majesty may, by Order in Council, declare that this section shall apply to any exhibition mentioned in the Order (whether held in the United Kingdom or not), and provide that the exhibitor shall be relieved from the conditions by giving notice to the comptroller (Act of 1886, s. 3).

Prior User.—The prior use which will defeat a patent must have been *in public;* so that a private manufacture, no articles being distributed or exhibited in public, or an exhibition under obligation of secrecy, or in the course of experiments, or as a scientific curiosity, will not prevent a subsequent discoverer obtaining a patent—*Edison* v. *Woodhouse* (1886), 32 Ch. D., 520. "User" includes "Sale," and this whether the article be manufactured in England or abroad; and a public sale in this country vitiates a subsequent patent whether the article is sold for home or foreign consumption. A single instance of prior public user is sufficient to invalidate a patent—*Brereton* v. *Richardson* (1884), 1 R. P. C., 165. And see Chap. III, at p. 95.

But the secret manufacture of articles *before*, for the purpose of sale *after*, the date of the patent is not publication—*Moss* v. *Malings* (1886), 3 R. P. C., 373.

Improvements and Combinations, etc.—There is now no question but that a patent for improvements in existing processes or products is good, except in so far as the working of it may infringe a prior patent. See *Moore* v. *Thomson* (1890), 7 R. P. C., 325. So also a patent may be valid which protects a new combination or a new simplification of known processes, or a new compound of known articles of manufacture. Care should be taken in describing the improvement or combination in the specification; for an improvement in a subordinate part of a combination is not the same as a new combination. Again, a "combination patent" may be framed to protect not only the new combination but the new additions (if any). And see *Cropper* v. *Smith* (1884), 26 Ch. D., 700; *Kelly* v. *Heathman* (1890), 45 Ch. D., 256.

"The introduction into an old combination of a new shape of one of the old elements, which invokes a law of

nature otherwise left on one side, is good subject-matter" —*Edison and Co.* v. *Woodhouse, etc.* (1887), 4 R. P. C., 79.

Utility.—One of the considerations for the grant of a patent is that the invention be useful to the public; and, as a corollary to this, that the articles manufactured be saleable. But this requirement is not of general importance, as any utility, however small, is sufficient. Where more than one invention is included in a patent, each must be useful. A patentee defending his patent should be prepared to show that it has been worked, and that the manufactured articles have been sold: if not, he must explain the non-working and prove utility in other ways. See *Edison Co.* v. *Holland* (1889), 6 R. P. C., 243. The Court is not very ready to listen to an allegation of non-utility from a defendant who finds it worth his while to infringe the patent. And see Hindmarch, pp. 132–142, and *United Horse Shoe, etc. Co.* v. *Stewart and Co.* (1888), Dec. Ct. Ses., 4th Ser., xv., p. 45 (H. L.).

Commercial success is important evidence of utility where the invention enables cheaper production—*Badische, Anilin, etc.* v. *Levinstein* (1887), 12 App. Cas., 710. Public demand is good evidence of utility of a new combination —*American Braided Wire Co.* v. *Thomson* (1889), 6 R. P. C., 518.

The decision of the judge as to utility will not be overruled on appeal—*Siddell* v. *Vickers* (1888), 5 R. P. C., 416.

CHAPTER III

THE APPLICANT

It should be remembered that the grant of a patent is considered the result of a bargain between the Crown, as representing the public, and the grantee. The public gain by a new invention and by the stimulus given to other inventors through the monopoly granted.

By the Act of 1883, s. 4, sub-ss.

(1) "Any person, whether a British subject or not, may make an application for a patent.

(2) "Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly."

And by 48 and 49 Vict. (1885), c. 63, s. 5, it is declared that "a patent may be lawfully granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor."

By s. 34, sub-ss.

(1) "If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative." See r. 20, p. 108.

(2) "Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention."

Where applicant dies *after* making the application, the patent will be sealed according to s. 12 (3*b*), p. 121.

The applicant must be "the first and true inventor," a phrase which covers wider ground than would appear. See "Novelty," p. 89.

"To be an actual inventor or discoverer of a manufacture, a person must himself make the discovery or invention, the idea of it must originate in his own mind; and must not be suggested to him by another, or taken from a book or anything else"—Hindmarch, p. 22. Of course, although the inventor may have made an independent discovery, still he is not entitled to a patent if his discovery has already been anticipated and published by another. But a secret discovery will not prevent a valid patent being granted to a subsequent inventor.

The inventor may be aided by persons in a subordinate position to himself, who are employed by him in experimenting or carrying out his ideas, such workers being viewed as the inventor's tools—*Homan's P.* (1889), 6 R. P. C., 104.

Substantial improvements or inventions suggested by a servant in the course of his employment belong to him and not to his employer, the question in each case being—Is there an independent invention due to the unaided genius of the master or of the servant?—*Siddell* v. *Vickers* (1890), 7 R. P. C., 292. Consider *Kurtz* v. *Spence* (1888), 5 R. P. C., 161, as to skilled assistance. The person who suggests an idea to one who procures another to carry it out is not the true and first inventor—*Elias* v. *Grovesend Tinplate Co.* (1890), 7 R. P. C., 455. But where there are joint inventors, or more than one person have independently made the same discovery, the patent will be granted to the inventors jointly, or a separate patent to each, subject to terms.

In the case of simultaneous applications, the inventions

being identical but independent, each inventor will be entitled to a grant and thereby become co-proprietor with the other, and this although one applicant is more expeditious than the other—*Dering's Patent* (1879), 13 Ch. D., 393.

And now it is provided by s. 13 of the Act of 1883, "that in the case of more than one application for a patent for the same invention the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application." See *infra*, p. 121.

A co-owner of a patent may manufacture and sell to any extent he pleases without accounting to another co-owner, and he may (it seems) grant licences without accounting for the income therefrom; but a joint owner, *e.g.* a partner, must account to his co-partners for all profit made from any invention which is an asset of the partnership. See Lindley on *Partnership*, 4th ed., p. 68.

See "Opposition to Grant," *infra*, p. 112.

By s. 35, "A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection."

Importation.—An alien resident abroad may obtain a patent in this country, or may assign the invention to a trustee for him; but an importer of a new process or product may, by expedition, himself obtain a patent to the exclusion of the foreign inventor. The dependencies and colonies are "within the realm," and no patent will be granted for any invention already published in any one of them. This statement of the law is now of comparative unimportance, as most civilised States have acceded to the International Convention for the protection of industrial property, as to which see *infra*, p. 297.

CHAPTER IV

THE APPLICATION

By the Act of 1883, s. 5, sub-ss.

"(1) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the patent office in the prescribed manner.

"(2) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

"(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.

"(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

"(5) A specification, whether provisional or complete, must commence with the title, and in the case of a com-

plete specification, must end with a distinct statement of the invention claimed."

A separate application should be made for each invention, although one invention may consist of more than one point of novelty. See r. 19, *infra*, p. 108.

The *Forms* for application are (A); (A1) to be used in applying for a patent for an invention communicated from abroad; (A2), to be used in applying for a patent under international and colonial arrangements.[1]

The Rules regulating the application are as follows:—

"8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the comptroller, and all attendances by the applicant upon the comptroller, may be made by or through an agent duly authorised to the satisfaction of the comptroller, and, if he so require, resident in the United Kingdom.

"9. The application shall be accompanied by a statement of an address, to which all notices, requisitions, and communications of every kind may be made by the comptroller, or by the Board of Trade, and such statement shall thereafter be binding upon the applicant, unless and until a substituted statement of address shall be furnished by him to the comptroller. He may, in any particular case, require that the address mentioned in this rule be in the United Kingdom.

"10. All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office, or otherwise furnished to the comptroller or to the Board of Trade, shall be written or printed in large and legible characters, and, unless otherwise directed, in the English language, upon strong wide-ruled paper (on one side only), of a size of thirteen inches

[1] "Forms," see p. 151. "Fees," see p. 151.

by eight inches, leaving a margin of two inches on the left hand part thereof; and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the comptroller." [1]

As to "declarations," see p. 294.

The *Title* of patent must sufficiently indicate the subject-matter of the invention, and must not materially differ from the claim made by the specification, either in claiming more or less. If it claims something different, the patent will be bad.

The *Provisional Specification* (in the absence of a complete specification) must accompany the application. This document must be supplemented by drawings, if required, and must describe roughly the *nature of the invention*. It is not necessary that it should set forth the way in which the invention can be carried into effect and operation, and if it does so, the applicant will not be closely held to this when he comes to file the complete specification, for in this it will be open to him to set forth another mode, disregarding that in the provisional specification. See *Woodward* v. *Sansum* (1887), 4 R. P. C., 166, and *Siddell* v. *Vickers* (1888), 5 R. P. C., 416.

But in describing the nature of the invention the complete specification must not go beyond the provisional and claim something more. It should be but an amplification of the earlier document, and explain, in greater detail, everything fairly included in the invention claimed by it —*Vickers* v. *Siddell* (1890), 7 R. P. C., 292. Any sub-

[1] By the Act of 1888, s. 1, any person who describes himself as a "Patent Agent" without being registered as such in the register established by the Board of Trade, is liable on summary conviction to a fine of £20.

statutial variation between the two documents will avoid the patent. See p. 111.

The question of indefiniteness is one for the examiner and comptroller (*infra*, p. 105), and no patent once granted will be avoided on this ground.

The Complete Specification

It is generally prudent to file a provisional specification. Where this is not done the complete specification must accompany the application; otherwise "the applicant may leave it within nine months from the date of the application" (see p. 106), which limit may be extended by the comptroller to ten months on payment of the fee. "Unless a complete specification is left within that time, the application shall be deemed to be abandoned." "Where an application for a patent has been abandoned, or become void," the specifications and drawings are not to be open to public inspection or to be published. Act of 1883, s. 8; Act of 1885, ss. 3 and 4.[1]

By s. 50, "An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary."[2]

As to enlargement of time generally, see r. 51, p. 293. Signature of the "complete" by one of several joint-applicants is enough—*Grenfell, etc., P.* (1890), 7 R. P. C., 151.

The Language.—It must describe not merely the nature of the invention, but the manner in which it must be performed and worked. The object is "the furnishing of sufficient and certain information to the public respect-

[1] Fees, p. 151. Form, p. 159. [2] Form U, p. 170.

ing what they are prohibited from doing whilst the privilege continues, and what they will be enabled to do after it is expired."—Hindmarch.

The main Rules to be attended to are as follows :—

1. The description must correspond with the title and the provisional specification, if any.

2. The language must minutely, fully and fairly describe the invention, so that an intelligent and educated person, conversant with the subject, may understand the manufacture and be capable of directing a competent workman in reproducing it on the expiration of the term —*King* v. *Anglo-American, etc., Co.* (1890), 7 R. P. C., 436. A patent is not invalid because some trial or experiment is needed before a competent person can reproduce it, provided no further invention is required—*Edison Co.* v. *Holland* (1889), 6 R. P. C., 243. Nothing material or known to be useful may be omitted. See *Thomson* v. *Batty* (1889), 6 R. P. C., 84.

3. It must claim the invention distinctly, and nothing more than what is new and essential, and what the applicant really invented—*Henderson* v. *Clippens Oil Co.* (1883), 4th Ser., Dec. Ct. Ses., x., p. 38, and *Cropper* v. *Smith* (1884), 26 Ch. D., 700, subsequently reversed on another ground. It should distinguish what is old, except where the old is well known to be such—*Watling* v. *Stevens* (1886), 3 R. P. C., 147 : or where a combination is claimed as a whole—*Kelly* v. *Heathman* (1890), 45 Ch. D., 256. It may contain statement by the applicant of prior knowledge, and may refer to existing specifications—*Atherton's P.* (1889), 6 R. P. C., 547.

4. It must not be misleading, puzzling, or ambiguous.

5. Having described the best method for carrying into effect the invention, it is not necessary to set forth others. Nor is it necessary to particularise immaterial points, *e.g.*

shape, when shape is not essential, nor things necessarily implied.

Where the language is susceptible of two constructions, one of which will uphold the patent and the other not, that will be adopted which is most favourable to the patentee—*Henderson* v. *Clippens Oil Co.* (*ante*, p. 101). Complete specification which claims a product after the provisional had claimed the process is bad—*Hutchinson and Co.* v. *Pattulo* (1888), Dec. Ct. Ses., 4th Ser., xv., p. 644, 5 R. P. C., 351, and so a complete which claims more than the provisional is bad—*Goulard and Gibb's P.* (1889), 6 R. P. C., 215; *King and Co.* v. *Anglo-American, etc., Co.*, *ib.*, p. 414. But the complete may describe improvements in detail, discovered after the provisional has been filed—*Lucas* v. *Miller* (1885), 2 R. P. C., 155, and the complete may amplify the provisional, although variance between the two is still fatal—*Vickers* v. *Siddell* (1890), 7 R. P. C., 292; see s. 11, p. 112.

The Claim.—Every complete specification must conclude "with a distinct statement of the invention claimed." This, of course, should correspond with the description set forth in the complete specification, and must not exceed it. It should be concise and should, by stating exactly what is claimed, show what is not claimed. The requirement, however, is directory only, and if a patent has been granted in the absence of the claim it will not be thereby invalid. See *Kelly* v. *Heathman* (1890), 45 Ch. D., 256; *Vickers* v. *Siddell* (*supra*).

As to "disclaimer," see p. 114.

The Drawings

The following are the Rules applicable to drawings :—

"30. The provisional or complete specification need not

be accompanied by drawings, if the specification sufficiently describes the invention without them; but if drawings are furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for letterpress should appear in the specification itself.

"31. Drawings (if any) must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

"They must be made on pure white, hot-pressed, rolled or calendered drawing paper of smooth surface and good quality, and, where possible, without colour or Indian ink washes.

"They must be on sheets of one of the two following sizes (the smaller being preferable), 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be half an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

"To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. Reference figures and letters must be bold, distinct, not less than one-eighth of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shown outside the

figure, and connected with the part referred to by a fine line.

"The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, etc., need be shown as effects this purpose. When the scale is shown on the drawing it should be denoted, *not* by words, but by a drawn scale.

"Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner*; and the signature of the applicant or his agent in the *right-hand bottom corner*.

"No written description of the invention should appear on the drawings.

"Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

"32. A *facsimile* of the original drawings, but *without* colour or Indian ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked 'true copy.'

"33. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those 'left with the provisional specification.'"

This Rule carries out the Act of 1886, which, by s. 2, renders drawings left with the provisional specification sufficient, provided the complete refers to them.

An inference from drawings will not control the

language of the specification, if this is clear—*Stewart* v. *Bell's Trustee* (1883), 4th Ser., Dec. Ct. Ses., xi., p. 236; and see *Fairburn* v. *Household* (1886), 3 R. P. C., 263.

Procedure subsequent to Application

Ss. 6–10 of the Act of 1883, as amended by the Acts of 1885 and 1888, prescribe this procedure, and are as follows :—

"6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

"7. (1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

"(2) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

"(3) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

"(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

"(5) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

Effect of Acceptance of an Application

By s. 14 (1883), after the acceptance the invention "may be used and published without prejudice to the patent to be granted." This protection is called "provisional." It appears only to save the applicant from what might otherwise be the consequences of the dissemination of the invention, viz. he might make it the property of the public, or the secret of the manufacture might become known to his prejudice.

S. 8. [As to the time for filing complete specification, see *ante*, p. 100.]

"S. 9. (1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

"(2) If the examiner reports that the conditions hereinbefore contained have not been complied with, the

comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

"(3) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

"(4) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void."

[The comptroller may extend this time by three months on payment of the prescribed fee—Act of 1885, s. 3.] [1]

"(5) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

"S. 15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

"S. 10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and

[1] Form V, p. 170.

the application and specification or specifications with the drawings (if any) shall be open to public inspection."

As to comptroller's discretion, etc., see pp. 100, 105, 289.

As to amendment, see pp. 117, 287.

The following Rules apply to the foregoing sections :—

"19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

"Every such application shall, if the applicant notify his desire to that effect to the comptroller, bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Acts and by these Rules, as if every such application had been originally made on that date.

"20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the comptroller may require. See p. 121.

"21. On the acceptance of a provisional or complete specification the comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

"22. Upon the publication of such advertisement of acceptance in the case of a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee."

Practice on Appeal to the Law Officers

By s. 38 "The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court."

The following Rules regulate the procedure :—

"1. When any person intends to appeal to the law officer from a decision of the comptroller in any case in which such appeal is given by the Acts, he shall, within fourteen days from the date of the decision appealed against, file in the Patent Office a notice of such his intention.[1]

"2. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

"3. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officer's clerk, at room 549, Royal Courts of Justice, London; and when there has been an opposition before the comptroller, to the opponent or opponents; and when the comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

"4. Upon notice of appeal being filed, the comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

"5. No appeal shall be entertained of which notice is

[1] Form T, 169.

not given within fourteen days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave upon application to the law officer.

"6. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal shall be given by the law officer's clerk, unless special leave be given by the law officer that any shorter notice be given.

"7. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

"8. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

"9. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer there is good ground for not making such order.

"10. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct-money.

"11. Where the law officer orders that costs shall be paid by any party to another he may fix the amount of such costs, and if he shall not think fit to fix the amount

thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

"12. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of s. 38 of the Act.

"13. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

"14. Any notice or other document required to be given to the law officer's clerk, under these Rules, may be sent by a prepaid letter through the post."

CHAPTER V

OPPOSITION TO GRANT

By the Act of 1883, s. 11 :—

"(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground.

"(2) Where such notice is given, the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

"(3) The law officer shall, if required, hear the appli-

cant and any person so giving notice, and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

"(4) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint."

As to joint inventors, see p. 94.

As to amendment, see p. 117.

As to appeal, see p. 108.

This s., as will be seen, allows only three grounds of objection. The first protects the real inventor or his estate from fraudulent appropriation (pp. 96, 134), except in the case of importation from abroad (p. 96). The second ground is that the invention has been previously patented *in this country* (see "Novelty," *ante*, p. 89); and the third is the claim in the complete of another invention from that claimed in the provisional (p. 102).

It will be seen that while any one may oppose before the comptroller, only a person "being, in the opinion of the law officer, entitled to be heard in opposition to the grant," can be heard before the law officer. This will include a person whose complete specification has been accepted (see s. 15), a prior patentee whose patent is still subsisting, and persons claiming through or under him, *e.g.* an assignee or licensee.

In cases of great difficulty (*e.g.* of disputed scientific anticipation) the practice is to grant the patent and allow the opponent to move in the regular tribunals for its revocation. But where the alleged invention has been obviously anticipated, the patent will not be granted; and, where there is doubt on the subject, a reference to the prior patent, though expired, may be ordered to be

inserted; or the applicant may be directed to disclaim the inventions covered by previous patents, naming them in the disclaimer. See numerous cases on the subject in 5 R. P. C. (1888), and 6 R. P. C. (1889).

The onus lies on the prior patentee to show that a disclaimer is necessary, in that the new patent will clearly include the invention protected by the prior patent, or that the public will be misled by the later specification without disclaimer—*Stell's P.* (1891), 8 R. P. C., 235.

On appeal to the law officer the appellant will be confined to the points raised by his notice of appeal.

Applicant should furnish the law officer with a note of the fees paid.

The practice on opposition to grants is laid down in Rules 34 to 44, which are as follows:—

"34. A notice of opposition to the grant of a patent shall be on Form D (p. 160), and shall state the ground or grounds on which the person giving such notice (hereinafter in Rules 37, 38, 41 and 43 called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

"35. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant.

"36. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number and date of such prior application shall be specified in the notice.

"37. Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of

his opposition, and on so leaving shall deliver to the applicant a list thereof.

"38. Within fourteen days from the delivery of such list the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within fourteen days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

"Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

"39. No further evidence shall be left on either side except by leave of the comptroller upon the written consent of the parties duly notified to him, or by special leave of the comptroller on application in writing made to him for that purpose.

"40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

"41. 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 shall give the parties ten days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the comptroller an application on Form E (p. 160). The comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard, the comptroller shall decide the case and notify his decision to the parties.

"42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice

of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

"43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

"44. The decision of the comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties."

CHAPTER VI

AMENDMENT OF SPECIFICATION

S. 18 of the 1883 Act prescribes the method of making material amendments in the specification, except in cases under sub-s. (10). The section as amended by the Act of 1888 is as follows :—

"(1) An applicant or a patentee may, from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment, and his reasons for the same.

"(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

"(3) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

"(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine

whether and subject to what conditions, if any, the amendment ought to be allowed.

"(5) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

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

"(7) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

"(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

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

"(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending.

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

The Rules under this section are as follows:—

"52. A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter in Rules 54, 55, and 58 called the applicant), and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication

of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct.

"53. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

"54. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant.

"55. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

"56. Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41, and 44 shall apply to the case; and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated, *ante*, p. 114.

"57. Where leave to amend is given, the applicant shall, if the comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31, *ante* pp. 98, 102, 103.

"58. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office.

"59. Every amendment of a specification shall be

forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct."

[As to amendment generally, see p. 287, and s. 90, p. 284; and when an action is pending, see ss. 19 and 20, p. 143.]

Previous to the 1883 Act a specification could only be amended by way of disclaimer, but now the amendment may be also by way of "correction or explanation." Of course, care must still be taken that the amended specification does not sin against sub-s. 8 (*ante*, p. 118); if it does, it may be questioned in a subsequent action—*Van Gelder's P.* (1889), 6 R. P. C., 22; and see *Kelly* v. *Heathman* (1890), 45 Ch. D., 256, where an amendment was approved by which the patentee claimed a "combination" more clearly than before.

A clerical error in a specification or other document which has become a public record may be amended by the Master of Rolls on petition.

CHAPTER VII

SEALING THE PATENT

By Act of 1883, s. 12, sub-ss.

"(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office.

"(2) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

"(3) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned; that is to say—

"(*a*) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

"(*b*) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant."

By the Act of 1885, s. 3, where the time has been extended for leaving and accepting the complete specification, "a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent."

By s. 13, "Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification."

"S. 16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man."

See s. 36, *infra*, p. 145.

"S. 27. (1) A patent shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject."

"(2) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested."

This s. only applies to patents granted after the passing of the Act. See s. 45, sub-s. 2, *infra*, p. 151.

And see s. 44, p. 150, as to inventions being assigned to the Secretary of State for War.

By s. 33, "Every patent may be in the form in the First Schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention."

By s. 37, "If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed."

For Form of patent, see p. 171.

CHAPTER VIII

THE TERM

By the Statute of Monopolies, 21 James I, c. 3, the term of the monopoly was limited to fourteen years. It was considered that, in general, the inventor would in that time be properly rewarded for his skill, and that the process of manufacture would be learned by a sufficiently large number of operatives to enable others to manufacture at the end of the term.

The duration is now limited by the Act of 1883, s. 17, and is fixed at fourteen years from the date of the application, but ceases on the patentee failing to make the prescribed payments, which, together with the forms that should be used, are set out on page 152. A certificate of payment is granted by the comptroller (r. 48), and registered in the Patents Register (r. 75, p. 148). If, by accident, mistake, or inadvertence, a patentee fails to make a prescribed payment, the comptroller has power to enlarge the time for payment, by not more than three months, on receiving the fee, not exceeding £10 (sub-s. 3).

By r. 49, "an application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee, by accident, mistake, or inadvertence, has failed to make such payment; and the comptroller may require the patentee to

substantiate, by such proof as he may think necessary, the allegations contained in the application for enlargement." As to enlargement of time generally, see r. 51, p. 293.

The Court may refuse to give damages for infringement occurring between the failure to pay and the enlargement of time.

As to international and colonial arrangements, see p. 297.

Extension of Term

A patentee (including persons claiming through him, as legal personal representatives, trustees, or assignees) may, not later than six months before the patent would expire, present a petition to Her Majesty in Council, praying that his patent may be extended for a further term (s. 25).

The Privy Council Rules made under 5 and 6 Will. IV, c. 83, are still in force, and are as follows:—

"1. A party intending to apply by petition, under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that

on or before such day notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and, having lodged such notice, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

"2. A party intending to apply by petition, under section 4 of the said Act, shall, in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

"[S. 4 of the Act of Will. IV provided that if a patentee 'shall advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture or where he lives, in case there shall not be any paper published in such town, that he intends to apply,' etc., the petition shall be heard.]

"3. Petitions under sections 2 and 4 of the said Act

must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

"4. All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act, and the first and second of these Rules, and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

"5. All persons entering caveats under section 4 of the said Act, and all parties to any former suit or action touching letters-patent, in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the first of these Rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

"6. All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

"7. Parties may have copies of all papers, lodged in respect of any application under the said Act, at their own expense.

"8. The Registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

"9. A party applying for an extension of a patent, under section 4 of the said Act, must lodge at the Council Office six printed copies of the specification, and

also four copies of the balance-sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

"All copies mentioned in this Rule must be lodged not less than one week before the day fixed for hearing the application.

"The Judicial Committee will hear the Attorney-General or other counsel on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf."

Any person whatsoever "may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension." S. 25, sub-s. 2.

By 1883 Act, s. 25, sub-s. 4, "The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

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

The fullest good faith is required in stating the facts connected with the patent in the petition.

Nature and Merits.—It will be remembered that in order to support a patent at all, it must be useful. Upon application for prolongation it is necessary to show more: it must be of exceptional merit and utility, and in the absence of proof of these points, extension will be refused in spite of the fact that the inventor has been poorly remunerated—*Beanland's P.* (1887), 4 R. P. C., 489. The patentee must also prove that everything in reason has been done to bring the invention to the knowledge of the public, and generally to push its sale and dissemination. The smallness of sale is some evidence to disprove utility. The committee will not enter into questions as to the novelty of an invention, unless it is manifestly bad—*Cocking's P.* (1885), 2 R. P. C., 151; or unless want of novelty is mentioned in opposer's particulars of objections —*Stewart's P.* (1886), 3 R. P. C., 7. See *Church's P.*, *ib.*, p. 95.

Remuneration of Inventor.—If the smallness of the profits has resulted from the neglect of the patentee to push the sale of the invention, the patent will not be extended. But where a large sum has been laid out in developing the trade, and from the nature of the case the sales must be limited, an extension will be granted—*Stoney's P.* (1888), 5 R. P. C., 518. There are many circumstances which in particular cases will explain why the inventor has not been sufficiently paid, *e.g.* prejudice or unfair opposition.

"We must ascertain," says the judgment in one case, "whether he has, in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration."

The fact that the patentee has taken out a subsequent

patent for an improved machine, and thereby virtually superseded the old machine, is a reason for not extending the old patent for want of remuneration—*Nussey and Leachman's P.* (1890), 7 R. P. C., 22.

Accounts.—The patentee should remember that the burden lies upon him of proving his case for consideration. He must, therefore, produce full and accurate accounts, without which the Judicial Committee could not possibly judge the merits of his application. The accounts should contain every particular of income that the patentee has had either in selling, working the patent or licensing others to work it; and foreign profits must be accounted for as well as British. Even when the foreign patents are not held by the applicant, the profits must be shown—*Newton's P.* (1884), 1 R. P. C., 177; *Deacon's P.* (1887), 4 R. P. C., 119.

Of course, on the other side of the account, the patentee may show expenses in experimenting and inventing the patent, registering and subsequently protecting it, outlay for manufacturing by another firm, his own remuneration, and other expenses which may be proper in particular instances—*Willacy's Patent* (1888), 5 R. P. C., 690; in which case, however, prolongation was refused, as the accounts did not deal specifically with the only claim in the specification that was held to be useful.

Where the patentee manufactures, he must bring into account the profits of his factory so far as they are caused or increased by the possession of a monopoly; but, on the other hand, he is entitled to charge fair manufacturing profit, such as any manufacturer not possessed of a monopoly would expect. See *Muntz's P.* (1846), 2 Web., 113, at p. 121. The accounts must be clear and perfect when presented, and may not afterwards be amended—*Lake's P.* (1891), A. C., 240; and they must be the result of the books, and not of an accountant's corrections.

Conditions in the Grant.—It should be remembered that an original inventor is more favourably considered than an assignee; and, where he is not applying, the Privy Council may make his further remuneration a condition of the extension of the term, though there is no general rule to this effect.

Conditions are frequently imposed limiting the price of the article, or the terms on which licences are to be granted, or in favour of the Crown. In giving a new grant of a patent first granted before the Act of 1883, the terms in that Act with regard to compulsory licences will not be inserted—*Cocking's Patent* (1885), 2 R. P. C., 151.

CHAPTER IX

COMPULSORY LICENCES

S. 22 of the 1883 Act enacts that, "If, on the petition of any person interested, it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

"(*a*) The patent is not being worked in the United Kingdom; or

"(*b*) The reasonable requirements of the public with respect to the invention cannot be supplied; or

"(*c*) Any person is prevented from working or using to the best advantage an invention of which he is possessed—

"The Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus."

The procedure by mandamus is too complicated and lengthy to be inserted here. Reference may be made to the Crown Office Rules, 1886.

The Rules under this s. are as follows:—

"60. A petition to the Board of Trade for an order upon a patentee to grant a licence shall show clearly the

nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.[1]

"61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits or statutory declarations and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

"62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

"63. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall, upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

"64. Within fourteen days after the day of such delivery, the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.[2]

"65. The petitioner, within fourteen days from such delivery, shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

"66. Subject to any further directions which the Board

[1] Forms H and H 1, p. 162. [2] Form I, p. 164.

of Trade may give, the parties shall then be heard at such time, before such person or persons, in such manner and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition."

CHAPTER X

LEGAL PROCEEDINGS

Revocation

The following persons may present a petition for revocation of a patent (1883 Act, s. 26, sub-s. 4):—

"(*a*) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

"(*b*) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

"(*c*) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims:

"(*d*) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee:

"(*e*) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business or manufacture, had publicly manufactured, used or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention."

"(5) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

"(6) Particulars delivered may be from time to time amended by leave of the Court or a judge.

"(7) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

"(8) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of, and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted."

By s. 109, proceedings in Scotland are to 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."

The petition should be based on fraud, absence of novelty or utility, improper conduct or dealing by the patentee after the granting of the patent, variance between the specifications, imperfections in the specifications, etc. Non-disclosure of the fact that the invention was a communication from abroad will not be ground *per se* for revocation—*Avery's Patent* (1887), 4 R. P. C., 322. A person qualified to petition in his own right may also rely on objections for which otherwise the authorisation of the Attorney-General would have been necessary—*Morgan's Patent* (1888), 5 R. P. C., 186.

The petition must be by one of the persons mentioned in the Act, in person, and not by his attorney appointed under a power of attorney.

The Attorney-General's authority may be obtained by

leaving the proper papers, addressed to the Patent Clerk, Room 549, Royal Courts of Justice, London.

Particulars of what should be stated in the memorial, and declaration of the form of the documents, and of the fees, will be given in response to a communication addressed to the Patent Clerk.

Infringement

The limits of this book will not allow of much more than printing the sections of the Act of 1883, which refer to legal proceedings. A very few notes are added. S. 28 gives power to the Court, and obliges it, on request of either of the parties, to hear the case with an assessor.

S. 29, "(1) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

"(2) The defendant must deliver with his statement of defence, or, by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

"(3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty must state the time and place of the previous publication or user alleged by him.

"(4) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

"(5) Particulars delivered may be from time to time amended, by leave of the Court or a judge.

"(6) On taxation of costs regard shall be had to the

particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case."

By s. 43, the use of a patented invention in a foreign vessel within the jurisdiction is permitted, provided it is not used "for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man." This permission is contingent on reciprocal treatment of British ships in the waters of the country to which the vessel belongs, if such country possesses patent laws.

The *intention to infringe* is not material; it is no defence for an infringer to say he did not know or did not intend to infringe. An innocent man is liable, and so are his employés.

Particulars.—Both plaintiff and defendant must give all material details in their particulars, and the defendant specially may be seriously prejudiced if he omits this precaution.

Plaintiff should give specific instances of breach, as well as a general allegation—*Tilghman's Co.* v. *Wright* (1884), 1 R. P. C., 103. These should be in a separate document, but it is sufficient if they are in the statement of claim—*Petman* v. *Bull* (1886), 11 App. Cas., 648. Plaintiff must state which of the claims in his specification he alleges to have been infringed—*Haslam & Co.* v. *Hall* (1887), 20 Q. B. D., 491; but in a simple case a more general allegation of infringement may be sufficient.

If defendant objects to plaintiff's specification, he must specify the parts objected to and the grounds of objection. So, too, if he objects on the ground of novelty, he must

give particulars of anticipation, pointing out not merely time and place, but "what the alleged anticipation is, and where it is to be found," what parts of the patents and specifications relied on were anticipations, and what parts of such specifications were claimed by the plaintiff's specification. In all but simple cases, the pages and lines should be referred to.

When the defendant relies on the state of public knowledge previous to the alleged invention, he should do so in general terms, and prove his allegation at the hearing —*Holliday* v. *Heppenstall* (1889), 41 Ch. D., 109; *Fowler* v. *Gaul* (1886), 3 R. P. C., 247, etc. It is sufficient if particulars of objections are delivered by one only of several defendants, if they are defending in the same interest—*Cropper* v. *Smith* (1885), 10 App. Cas., 249.

There is no infringement of a "combination" patent, unless all the essential and characteristic features of the combination are used—*Gwynne* v. *Drysdale & Co.* (1886), Dec. Ct. Ses., 4th Ser., xiii., p. 684, 3 R. P. C., 65; but a different method of combining the same elements may be an infringement, under the doctrine of "mechanical equivalents"—*Moore* v. *Thomson* (1890), 7 R. P. C., 325; and see *Miller & Co.* v. *The Clyde, etc.* (1891), 8 R. P. C., 198.

Where a patent is confined to substance or mechanism, as used for special purpose, it is not infringed by user of the same substance or mechanism for a dissimilar purpose —*Fletcher* v. *Glasgow Gas Commissioners* (1887), 4 R. P. C., 386; *Edison & Co.* v. *Holland* (1888), 5 R. P. C., 459.

The mere taking out of a patent is no infringement, if the patentee does not act under it—*Tweedale* v. *Ashworth* (1890), 7 R. P. C., 426.

N.B.—It has not been thought advisable, in an elementary book of this description, to insert particulars of cases on infringement, the tendency of which might be to mislead a person desirous of "sailing near the wind."

The Relief.—The plaintiff should, as a general rule, ask for (1) an injunction to prevent the defendant continuing his infringements; (2) damages—see *American Braided Wire Co.* v. *Thomson* (1890), 7 R. P. C., 152—or, in the alternative, an account and payment of the profits made by defendant.

The ordinary principles govern the Court in granting or withholding injunctions. See Kerr on "Injunctions."

Generally speaking, in order to obtain an interlocutory injunction, the plaintiff must be prompt in applying. But in any case it is wise to apply for it in order to protect the patent during the pendency of the action. The plaintiff must prove either a good *primâ facie* case of infringement, or that the defendant clearly intends to infringe. An interim injunction will be granted without previous notice to defendant in a very pressing case.

Long enjoyment of a patent affords good ground for granting an interlocutory injunction—*Rothwell* v. *King* (1886), 3 R. P. C., 379, and so does the fact that the patent has been upheld in a previous action—*United Telephone Co.* v. *St. George* (1886), 3 R. P. C., 33. Where the defendant shows a *primâ facie* case that the plaintiff's patent is bad, the Court may refuse an interlocutory injunction upon the defendant undertaking to keep accurate accounts of his sales—*Jackson* v. *Needle* (1884), 1 R. P. C., 174.

Mere possession of infringing articles without user or sale of them will expose the possessor to an injunction—*United Telephone Co.* v. *Sharples* (1885), 29 Ch. D., 164; and so, it seems, will importation by a steamship company, to the order of consignees—*Washburn* v. *Cunard Co.* (1889), 6 R. P. C., 398.

The plaintiff cannot have both damages and the profit made by defendant. He must choose one or the other at

the hearing. If he asks for an account, he can only obtain the profits actually made by the defendant, which may have been little or nothing. If they are likely to have been small, he should demand damages instead. A defendant, who has to account for profits, must show his profits previous to infringement as well as after, so that the two may be compared—*Siddell* v. *Vickers* (1889), 6 R. P. C., 464.

The certificate mentioned in s. 29, sub-s. 6, should be asked for at the trial, or at the cost of the applicant within a reasonable time after. It will not be given if the action is discontinued before trial, nor where the case is disposed of without hearing the defendant on his objections. Where a defendant succeeds in getting an adverse decision reversed in the House of Lords, he should apply for the certificate to the judge who heard the case—*Morgan* v. *Windover* (1890), 7 R. P. C., 446.

The Court has jurisdiction to order the offending articles to be destroyed or delivered to the plaintiff.

By s. 30, "In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit."

See books on the Judicature Acts, for further information as to inspection, interrogatories, discovery, etc.

S. 31. "In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge 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 have his full costs, charges and expenses as between solicitor and client, unless the

Court or judge trying the action certifies that he ought not to have the same."

This certificate can only be given to a patentee, and only where the question of validity was actually tried in Court.

There is no appeal from the decision of a judge to give or withhold a certificate.

Threats.—By s. 32, "Where any person claiming to be the patentee of an invention, by circulars, advertisements or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

This s. affords a ready method of obliging a patentee to substantiate his threats by an action founded on his patent, under penalty of being enjoined by the Court to desist from threatening, and to pay costs. The plaintiff should prove by affidavit that he is not in fact infringing defendant's patent (although it is not absolutely necessary for him to do so when applying for an interlocutory injunction), and if he seeks damages, that he has been damnified.

If the threatener commences and prosecutes an action for infringement with due diligence, the first plaintiff's right of continuing his action is taken away, except that

he will be entitled to his injunction if he succeeds in his defendant's action, and for this result his motion will be ordered to "stand over" until the hearing of the second action. But this would not prevent the plaintiff proceeding with his action, so far as it claims other relief than is given by this section, *e.g.* for damages for defamation of title with the proper allegations thereto belonging. An action for royalties by a licensor against his licensee who is using a rival patent stops the action for threats—*Day* v. *Foster* (1890), 7 R. P. C., 54. So does an unsuccessful action, if *bonâ fide*—*Colley* v. *Hart* (1890), 7 R. P. C., 101. The injunction will not be granted *ex parte*—*Wilson* v. *Church Engineering Co.* (1885), 2 R. P. C., 175; nor will an interlocutory injunction be granted where there is a conflict of testimony as to infringement, nor when the balance of convenience forbids.

It was held in *Challender* v. *Royle* (1887), 36 Ch. D., 425: 1st, that the action for infringement contemplated by s. 32 includes an action against any person threatened, whether the same as the party asking for an injunction or not; 2nd, that the time of issuing the threats is the time for consideration in ascertaining whether the action has been brought with due diligence. An action by a patentee who has agreed to assign to the threatener does not stop the action for threats—*Kensington, etc., Co.* v. *Lane Fox, etc., Co.* (1891), 2 Ch., 573.

Threats by solicitor's letter are within the section—*Day* v. *Foster* (*supra*). As to what is "due diligence," each case must be decided by its own circumstances.

Of course neither party to an action may issue circulars, etc., which tend to prejudice the fair hearing of the action, or the opinion of customers, or the public with regard to the merits.

Apart fror 32, a right of action for damages exists

against any one who falsely, maliciously, and without probable cause states that the plaintiff is infringing his patent or makes any other defamatory statement to the detriment of the plaintiff in his business, but in this case no injunction will be granted—*Colley* v. *Hart* (*supra*).

It seems that in an action under this section the validity of the defendant's patent may be questioned; also that the threats aimed at are threats relating to past acts only. A circular warning against infringement generally and not specifically referring to the plaintiff, does not appear to be within the section.

Amendment pending Proceedings.—By s. 19 of the 1883 Act :—

"(1) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed."

By s. 20, "Where an amendment by way of disclaimer, correction, or explanation has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes, to the satisfaction of the Court, that his original claim was framed in good faith and with reasonable skill and knowledge."

If the liberty is given, the patentee must proceed to amend according to s. 18 (*supra*, p. 117); and see *In re Hall* (1888), 21 Q. B. D., 137, which decides that liberty

given in one proceeding is enough, notwithstanding that others are pending.

The terms imposed on the applicant are generally severe, including the payment by him of the costs of the action up to and occasioned by the disclaimer, and the foregoing of all claim to damages for infringement previous to disclaimer.

And see *Gaulard* v. *Lindsay* (1888), 38 Ch. D., 38, and cases there cited, and *Lang* v. *Whitecross Wire Co.* (1890), 7 R. P. C., 389. Drawings may be added by amendment.

As to disclaimer pending proceedings for revocation, see *Goulard & Gibb's Patent* (1888), 5 R. P. C., 189.

An action for infringement is no longer "pending" after judgment has been delivered, in spite of an appeal having been entered—*Cropper* v. *Smith* (1884), 1 R. P. C., 254.

As to who is a patentee, see s. 64, p. 86.

N.B.—As to clerical or immaterial amendments, see *infra*, s. 91, p. 287.

CHAPTER XI

REGISTER AND ASSIGNMENT OF PATENTS

By the Act of 1883, s. 23, sub-ss.

"(1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

"(2) The Register of Patents shall be *primâ facie* evidence of any matters by this Act directed or authorised to be inserted therein.

"(3) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters-patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office."

S. 36. "A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only." See s. 16, *supra*, p. 122.

See s. 85 as to "Trusts," p. 283; and generally s. 87, p. 283; and as to "inspection," p. 284, ss. 88, 89.

The case of *Heap* v. *Hartley* (1889), 42 Ch. D., 461, is an important decision under this section. It was there held that a licence which, though exclusive, did not amount to an assignment, could not entitle the licensee to bring an action for infringement in his own name. It was also held that a purchaser of the invention from the patentee, having no knowledge of the licence, was not liable to an action, and (in the Court below) that the registration of the licence was not sufficient to inform the purchaser of the licence having been granted.

Where an agreement is made by B with A for valuable consideration, that he will make and sell a patented machine and use his best endeavours to develop the sale, all future improvements, whether invented by A or B, to belong to the patent,—A is entitled to bring an action against B for selling the machine with improvements. Although the new machine might not be an infringement of the older patent, still, the object of the machines being the same, it was an "improvement" within the meaning of the agreement. The plaintiff was held entitled either to royalties or damages for breach of agreement to develop the sale—*Wilson* v. *Barbour* (1888), 5 R. P. C., 675.

On breach of the terms and conditions contained in it, a licence may be determined by the licensor by notice in writing—*Ward* v. *Livesey* (1888), 5 R. P. C., 102.

The owner of a patent who grants a licence does not thereby warrant that the patent is unimpeachable. The licensee, however, cannot impeach the patent except in a clear case of fraud. See *M'Dougall* v. *Partington* (1890), 7 R. P. C., 216.

As a rule, documents of earlier date than the patent will not be entered on the register.

The following are the Rules regulating registration :—

"67. Upon the sealing of a patent the comptroller shall

cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

"68. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the comptroller, and left at the Patent Office.[1]

"69. Such request shall, in the case of individuals, be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner.

"70. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

"71. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent, or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall be produced to the comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

Form L, p. 164.

"As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the comptroller.

"72. There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

"As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

"73. A body corporate may be registered as proprietor by its corporate name.

"74. Where an order has been made by Her Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent or the rectification of the register under s. 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be.[1]

"75. Upon the issue of a certificate of payment under Rule 48, the comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

"76. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

"77. An attested copy of every licence granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered

[1] Form S, p. 169.

in the register. The licensee shall cause the accuracy of such copy to be certified as the comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.[1]

"78. The Register of Patents shall be open to the inspection of the public on every week day between the hours of ten and four, except on the days and the times following:—

"(*a*) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

"(*b*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

"(*c*) Times when the register is required for any purpose of official use.

"79. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the comptroller on payment of the prescribed fee."

[1] Form M, p. 165.

CHAPTER XII

MISCELLANEOUS

In accordance with s. 40, the comptroller publishes every week the *Illustrated Official Journal* (*Patents*); he also keeps on sale back numbers, complete specifications and drawings of patents in force, and indexes, abridgments of specifications, catalogues, etc.

There are many places in the United Kingdom and abroad where a complete set of the publications of the Patent Office is received, and many more where abridgments of specifications only are received. A list of these places can be obtained from the Patent Office, 25 Cursitor Street, Chancery Lane, E.C.

The Patent Museum is now controlled and managed by the Department of Science and Art, s. 41, which may require any patentee to furnish models on payment of the cost thereof. S. 42.

S. 44 enables an "inventor of any improvement in instruments or munitions of war" to assign the same and any patents therefor to the Secretary of State for War, who may certify to the comptroller his opinion that the invention should be kept secret, in which case the application, specifications, etc., must be delivered to the comptroller in a sealed packet. This may only be shown or handed to a person authorised in writing by the Secretary of State. He may waive the benefit of this section with respect to any particular invention.

Patents existing at passing of 1883 Act

By s. 45 "(1) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

"(2) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences.

"(3) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed."

List of Fees payable on and in connection with Letters-Patent

Up to Sealing

1.	On application for provisional protection	£1	0	0		
2.	On filing complete specification	3	0	0		
	or				£4	0	0
3.	On filing complete specification with first application				4	0	0
4.	On appeal from comptroller to law officer. By appellant				3	0	0
5.	On notice of opposition to grant of patent. By opponent				0	10	0
6.	On hearing by comptroller. By applicant and by opponent respectively				1	0	0
7.	On application to amend specification :— Up to sealing. By applicant				1	10	0
8.	After sealing. By patentee				3	0	0
9.	On notice of opposition to amendment. By opponent				0	10	0
10.	On hearing by comptroller. By applicant and by opponent respectively				1	0	0
11.	On application to amend specification during action or proceeding. By patentee				3	0	0

12.	On application to the Board of Trade for a compulsory licence. By person applying .	£5	0	0
13.	On opposition to grant of compulsory licence. By patentee	5	0	0
14.	On certificate of renewal :— Before end of four years from date of patent	50	0	0
15.	Before end of seven years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act 1883," before the end of eight years from date of patent	100	0	0
	Or in lieu of the fees of £50 and £100, the following annual fees :—			
16.	Before the expiration of the 4th year from the date of the patent	10	0	0
17.	" " 5th " " .	10	0	0
18.	" " 6th " " .	10	0	0
19.	" " 7th " " .	10	0	0
20.	" " 8th " " .	15	0	0
21.	" " 9th " " .	15	0	0
22.	" " 10th " " .	20	0	0
23.	" " 11th " " .	20	0	0
24.	" " 12th " " .	20	0	0
25.	" " 13th " " .	20	0	0
	On enlargement of time for payment of renewal fees :—			
26.	Not exceeding one month	3	0	0
27.	" two months	7	0	0
28.	" three months	10	0	0
29.	For every entry of an assignment, transmission, agreement, licence, or extension of patent .	0	10	0
30.	For duplicate of letters-patent . . each	2	0	0
31.	On notice to comptroller of intended exhibition of a patent under s. 39	0	10	0
32.	Search or inspection fee . . . . each	0	1	0
33.	For office copies . . every 100 words (but never less than one shilling)	0	0	4
34.	" of drawings, cost according to agreement.			
35.	For certifying office copies MSS. or printed, each	0	1	0
36.	On request to comptroller to correct a clerical error . . . . . up to sealing	0	5	0
	after sealing	1	0	0
37.	For certificate of comptroller under s. 96 .	0	5	0
38.	For altering address in register . . .	0	5	0
39.	For enlargement of time for filing complete specification not exceeding one month .	2	0	0

40. For enlargement of time for acceptance of complete specification—

Not exceeding one month	. . .	£2	0 0
„ two months	. . .	4	0 0
„ three months	. . .	6	0 0

Forms

A.—Form of application for patent.
A 1.— „ „ „ communicated from abroad.
B.— „ provisional specification.
C.— „ complete „
D.— „ opposition to grant of patent.
E.— „ application for hearing by comptroller.
F.— „ application to amend specification or drawings.
G.— „ opposition to amendment of specification or drawings.
H.— „ application for compulsory grant of licence.
H 1.— „ petition for compulsory grant of licences.
I.— „ opposition to compulsory grant of licence.
J.— „ application for certificate of payment or renewal.
K.— „ application for enlargement of time for payment of renewal fee.
L.— „ request to enter name upon the register of patents.
M.— „ request to enter notification of licence in register.
N.— „ application for duplicate of letters-patent.
O.— „ notice of intended exhibition of unpatented invention.
P.— „ request for correction of clerical error.
Q.— „ certificate of comptroller.
R.— „ notice for alteration of an address in register.
S.— „ application for entry of order of Privy Council in register.
T.— „ appeal to law officer.
U.— „ application for extension of time for leaving a complete specification.
V.— „ application for extension of time for acceptance of complete specification.

N.B.—As to where these Forms may be obtained, see p. 317.

PATENT.

SECOND SCHEDULE

Patent, Designs, and Trade Marks Acts 1883 *to* 1888

FORM A (p. 98)

To be accompanied by two copies of Form B or of Form C

APPLICATION FOR PATENT

(*a*) Here insert name and full address and calling of applicant or applicants.

(*a*)

do hereby declare that in possession of an

(*b*) Here insert title of invention.

invention the title of which is (*b*)

(*c*) In the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors.

that (*c*)
the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of knowledge and belief; and humbly pray that a patent may be granted to for the said invention.

Dated day of 18

(*d*) To be signed by applicant or applicants.
In the case of a Firm, each member of the Firm must sign.

(*d*)

NOTE.—Where application is made through an agent (Rule 8), the authorisation should be signed by the applicant or applicants.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorisation to an agent and statement of address respectively are printed below.

(1.) *Where application is made through an Agent*
(*Rule* 8)

hereby appoint

of

to act as agent in respect of the within appli-

cation for a patent, and request that all notices, requisitions, and communications relating thereto may be sent to such agent at the above address.

day of 18

*

* To be signed by applicant or applicants.

(2.) *Where application is made without an Agent*
(*Rule* 9)

hereby request that all notices, requisitions, and communications in respect of the within application may be sent to
at

day of 18

†

† To be signed by applicant or applicants.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM A 1 (p. 98)

To be accompanied by two copies of Form B or of Form C

PATENT.

APPLICATION FOR PATENT FOR INVENTION COMMUNICATED FROM ABROAD

I (*a*)

of in the
county of do hereby declare
that I am in possession of an invention the title of which is (*b*)

(*a*) Here insert name and full address and calling of applicant.

(*b*) Here insert title of invention.

which invention has been communicated to me by (*c*)

(*c*) Here insert name, address, and calling of communicant.

that I claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my

knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

Dated day of 18

(*d*)

(*d*) To be signed by applicant or applicants.

NOTE.—Where application is made through an agent (Rule 8), the authorisation should be signed by the applicant or applicants.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorisation to an agent and statement of address respectively are printed below.

(1.) *Where application is made through an Agent*
(*Rule* 8)

hereby appoint
of
to act as agent in respect of the within application for a patent, and request that all notices, requisitions, and communications relating thereto may be sent to such agent at the above address.

day of 18

*

* To be signed by applicant or applicants.

(2.) *Where application is made without an Agent*
(*Rule* 9)

hereby request that all notices, requisitions, and communications in respect of the within application may be sent to
at

day of 18

†

† To be signed by applicant or applicants.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM A 2 (pp. 98, 300)

PATENT.

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS

(a)

(a) Here insert name and full address and calling of applicant, or of each of the applicants.

do hereby declare that I (or we) have made foreign applications for protection of my (or our) invention of (b)

(b) Here insert title of invention.

in the following foreign States and on the following official dates, viz.: (c)

(c) Here insert the names of each Foreign State followed by the official date of the application in each respectively.

and in the following British Possessions and on the following official dates, viz.: (d)

(d) Here insert the names of each British Possession followed by the official date of the application in each respectively.

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (e)

(e) Here insert the official date of the earliest foreign application.

to the best of knowledge, information, and belief, and humbly pray that a patent may be granted to for the said invention in priority to other applicants, and that such patent shall have the date (f)

(f) Here insert the official date of the earliest foreign application.

(g)

(g) Signature of applicant or of each of applicants.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

To be issued with Form A, A 1, or A 2

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM B (p. 99)

PROVISIONAL SPECIFICATION
(To be furnished in Duplicate)

(*a*) Here insert title as in declaration. (*a*)

(*b*) Here insert name and full address and calling of applicant or applicants as in declaration. (*b*)

do hereby declare the nature of this invention to be as follows :—(*c*)

(*c*) Here insert short description of invention.

NOTE.—No stamp is required on this document, which must form the commencement of the provisional specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The provisional specification and the "duplicate" thereof must be signed by the applicant or his agent, on the last sheet, the date being first inserted as follows:

Dated this day of 18

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

PATENT.

Where provisional specification has been left, quote No. and date.
No.
Date

Form C

Complete Specification (p. 100)

(To be furnished in Duplicate—one unstamped)

(*a*)

(*a*) Here insert title as in declaration.

(*b*)

(*b*) Here insert name and full address and calling of applicant or applicants as in declaration.

do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement :

(*c*)

(*c*) Here insert full description of invention, *which must end with a distinct statement of claim or claims, in the following form:—*

"Having now particularly described and ascertained the nature of my said Invention, and in what manner the same is to be performed, I declare that what I claim is . . . .

1.
2.
3.

(Here state distinctly the features of novelty claimed.)

Note.—This document must form the commencement of the complete specification; the continuation to be upon wide-ruled foolscap paper (but on one side only), with a margin of two inches on left hand of paper. The complete specification and the "duplicate" thereof must be signed by the applicant or his agent, on the last sheet, the date being first inserted as follows :

Dated this day of 18

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C. (p. 98).

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM D (p. 114)

FORM OF OPPOSITION TO GRANT OF PATENT
(To be accompanied by an unstamped copy)

* Here state name and full address.

* I

hereby give notice of my intention to oppose the grant of letters-patent upon application No. of , applied for by

† Here state upon which of the grounds of opposition permitted by section 11 of the Act the grant is opposed.

upon the ground †

‡ Here insert signature of opponent.

(Signed) ‡

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM E (p. 115)

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER
In Cases of Refusal to Accept, Opposition or Applications for Amendments, etc.

SIR,

(*a*) Here insert address.

of (*a*)

hereby apply to be heard in reference to and request that I may receive due notice of the day fixed for the hearing.

_____ Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM F (p. 117)

PAT.

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS

*

* Here state name and full address of applicant or patentee.

seek leave to amend the specification of letters-patent No. of 188 , as shown in red ink in the copy of the original specification hereunto annexed

My reasons for making this amendment are as follows †

† Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the letters-patent.

‡ To be signed by applicant.

(Signed) ‡

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM G (p. 117)

PATENT.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS

(To be accompanied by an unstamped copy)

*

* Here state name and full address of opponent.

hereby give notice of objection to the proposed amendment of the specification or drawings of letters-patent No. of 188 , for the following reason : †

† Here state reason of opposition.

(Signed)

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM H (p. 131)

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENCE

(To be accompanied by an unstamped copy)

* Here state name and full address of applicant.

† Here state name and address of patentee, and number and date of his patent.

*

hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a licence to me by †

(Signed)

NOTE.—The petition must clearly set forth the facts of the case, and be accompanied by an examined copy thereof. See form below.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM H 1 (p. 131)

FORM OF PETITION FOR COMPULSORY GRANT OF LICENCES

To the Lords of the Committee of Privy Council for Trade

(a) Here insert name, full address, and description.

(b) Here insert title of invention.

THE PETITION of (*a*) of ,
in the county of , being a person interested in the matter of this petition as hereinafter described :—

SHEWETH as follows :—

1. A patent dated No. ,
was duly granted to
for an invention of (*b*)

2. The nature of my interest in the matter of this petition is as follows :—(*c*)

(*c*) Here state fully the nature of petitioner's interest.

3. (*d*)

(*d*) Here state in detail the circumstances of the case under section 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licences on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licences on reasonable terms (*e*)

(*e*) Here state the ground or grounds on which relief is claimed in the language of section 22 sub-sections (*a*), (*b*), or (*c*), as the case may be.

Your petitioner therefore prays that an order may be made by the Board of Trade (*f*)
or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

(*f*) Here state the purport and effect of the proposed order and the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM I (p. 132)

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENCE

* Here state name and full address.

* hereby give notice of objection to the application of for the compulsory grant of a licence under Patent No. of 188 .

(Signed)

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM L (pp. 147 and 284)

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS

(*a*) *Or* We. Here insert name, full address, and description.

I (*a*)

(*b*) My *or* our.

(*c*) *Or* names.

(*d*) I *or* We.

(*e*) Here insert the nature of the claim.

(*f*) Here give name and address, etc., of patentee or patentees.

(*g*) Here insert title of the invention.

hereby request that you will enter (*b*) name (*c*) in the Register of Patents:—

(*d*) claim to be entitled (*e*) of the Patent No. of 188 , granted to (*f*) for (*g*)

by virtue of (*h*)

(*h*) Here specify the particulars of such document, giving its date and the parties to the same, and showing how the claim here made is substantiated.

And in proof whereof I transmit the accompanying (*i*) with an attested copy thereof (*j*)

(*i*) Here insert the nature of the document.

(*j*) Where any document which is a matter of record is required to be left, a certified or official copy in lieu of an attested copy must be left.

I am, Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888
FORM M (p. 148)

PATENT.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENCE IN THE REGISTER OF PATENTS

SIR,

I hereby transmit an attested copy of a licence granted to me by
under Patent No. of 188 , as well as the original licence for verification, and I have to request that a notification thereof may be entered in the register.

I am, Sir,
Your obedient Servant,

(*a*)

(*a*) Here insert full address.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM N

APPLICATION FOR DUPLICATE OF PATENT

Date

SIR,

I regret to have to inform you that the letters-patent dated * No.

granted to

for an invention of †

have been ‡

I beg therefore to apply for the issue of a duplicate of such letters-patent.§

[Signature of Applicant]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert date, No., name, and full address of patentee.

† Here insert title of invention.

‡ Here insert the word "destroyed" or "lost," as the case may be.

§ Here state interest possessed by applicant in the letters-patent.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM O (p. 91)

PATENT.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION

*

hereby give notice of my intention to exhibit a
of at the
Exhibition, which † of 18 ,
under the provisions of the Patents, Designs, and Trade Marks Acts of 1883.

‡ herewith enclose

(Signed)

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of applicant.

† State "opened" or "is to open."

‡ Insert brief description of invention, with drawings if necessary.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM P (p. 287)

PATENT.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR

SIR,

I hereby request that the following clerical error (*a*)

in the (*b*)
No. of 18 , may be corrected in the manner shown in red ink in the certified copy of the original (*b*)
hereunto annexed.

Signature
Full Address

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) or errors.

(*b*) Here state whether in application, specification, or register.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM Q (p. 290)

CERTIFICATE OF COMPTROLLER-GENERAL

Patent Office, London,

18

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

To *

* Here insert name and full address of person requiring the information.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM R

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER

SIR,

(*a*)

(*a*) Here state name or names and full address of applicant or applicants.

hereby request that address now upon the register may be altered as follows:—

(*b*) Here insert full address.

(*b*)

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25 Southampton Buildings
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM S (p. 148)

PATENT.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER

(a)
hereby transmit an office copy of an Order in Council with reference to (b)

(a) Here state name and full address of applicant.

(b) Here state the purport of the order.

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM T (p. 109)

PATENT.

FORM OF APPEAL TO LAW OFFICER

I, (a) of (a)
hereby give notice of my intention to appeal to the law officer from (b)
of the comptroller of the day of
18 , whereby he (c)
No. (d) of the year 18 (d)

(a) Here insert name and full address of appellant.

(b) Here insert "the decision" or "that part of the decision," as the case may be.

(c) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.

(d) Insert number and year.

Signature

Date

N.B.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888
FORM U (p. 100)

FORM OF APPLICATION FOR EXTENSION OF TIME FOR LEAVING A COMPLETE SPECIFICATION

SIR,

hereby apply for extension of time for one month in which to leave a complete specification upon application dated

The circumstances in and grounds upon which this extension is applied for are as follows (*a*) :—

(*a*) See Rule 50.

Sir,

Your obedient Servant,

(*b*)

(*b*) To be signed by applicant or applicants or his or their agent.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888
FORM V (p. 107)

FORM OF APPLICATION FOR EXTENSION OF TIME FOR ACCEPTANCE OF A COMPLETE SPECIFICATION

SIR,

hereby apply for extension of time for month for the acceptance of the complete specification upon application No. dated

The circumstances in and grounds upon which this extension is applied for are as follows (*a*) :—

(*a*) See Rule 50.

Sir,

Your obedient Servant,

(*b*)

(*b*) To be signed by applicant or applicants or his or their agent.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Form D in the Act of 1883

Form of Patent

"Victoria, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:

"Whereas *John Smith*, of *29 Perry Street, Birmingham*, in the county of *Warwick, Engineer*, hath by his solemn declaration represented unto us that he is in possession of an invention for '*Improvements in Sewing Machines*,' that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

"And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal letters-patent for the sole use and advantage of his said invention:

"And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

"And whereas we being willing to encourage all inventions which may be for the public good are graciously pleased to condescend to his request:

"Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and

Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters-patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters-patent shall forthwith determine, and be void to

all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters-patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters-patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters-patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this

one thousand eight hundred and and

to be sealed as of the one thousand eight hundred and ."

Seal of Patent Office.

PART III

DESIGNS

CHAPTER I

INTRODUCTION

THE protection of designs by law is akin both to the law of copyright and to that of patents, but has from the first been treated by distinct statutes, the earliest of which was passed in the year 1787. By this Act the proprietor of any new and original pattern for printing linens, cottons, calicoes, or muslins was given the sole copyright for two months from the first publishing thereof, every piece of such goods being truly printed with the name of the proprietor. This Act was temporary, but after being renewed in 1789 was made perpetual by 34 Geo. III, c. 23 (1794), which also extended the right to three months. In 1839 the Acts were extended to Ireland, and applied to fresh woven fabrics, viz. those composed of wool, silk, or hair, and to mixed fabrics composed of two or more of the following materials—linen, cotton, wool, silk, hair (2 and 3 Vict., c. 13).

In the same year, by chapter 17, copyright for the term of twelve months was given for new and original designs—(1) for patterns applied to tissues or textile fabrics (except lace and the articles comprised in the above Acts); (2) also for modelling, casting, embossment, chasing or engraving, or for any other kind of impression or ornament on any article of manufacture, not being a tissue or textile

fabric; (3) also for the shape or configuration of any article of manufacture (except lace and the articles comprised in the above Acts). Besides this, the proprietor of a design for modelling, etc., on any article of manufacture of metal was given the copyright for three years from registration, before publication, in a register thereby established under the control of the Privy Council.

In 1842 the former Acts were repealed, consolidated and amended by 5 and 6 Vict., c. 100, which until lately was the principal Act regulating the law of designs. The Act (which did not apply to sculpture or casts of sculpture) gave the proprietor of any new and original design, whether for pattern, shape, or ornament, and not previously published, a copyright varying from nine months to three years according to the class of article to which it should be applied, as detailed in s. 3. The design must have been registered before publication, and was only protected when "done" within the United Kingdom.

In the following year the Act was amended by 6 and 7 Vict., c. 65, and design for shape more specially defined and extended. Other goods, to which a design might be applied with protection, were added to the existing list.

In 1850, by 13 and 14 Vict., c. 104, a "provisional" registration was invented, further goods were included, power was given to the Board of Trade to extend copyright in ornamental designs, and several fresh provisions were made as to the registry.

In 1858 the Acts were further amended, and jurisdiction given to the County Courts (21 and 22 Vict., c. 70). Another amending Act was passed in 1861 (24 and 25 Vict., c. 73), dispensing with the necessity of the design being "done" within the United Kingdom, and extending protection to foreigners. In 1865 it was enacted that exposition at an industrial exhibition certified by

the Board of Trade should not prejudice the right to registration, and in 1870 the same right was given as regards international exhibitions (33 and 34 Vict., c. 27). In 1875 the powers and duties of the Board of Trade were transferred to the Commissioners of Patents. In 1883 the whole of the existing Acts were repealed, consolidated and amended by the Patents Act, 1883, the material portion of which now follows with notes.

CHAPTER II

REQUISITES FOR PROTECTION

"DESIGN" is defined in s. 60 of the Act as follows:—

"'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 (54 Geo. III, c. 56)."

Observe that, if it is desired to protect an article itself, the proprietor must proceed to obtain a patent; if the shape, ornament, or pattern, then he must register the design. Protection of a design may sometimes incidentally protect the article itself. But the fact that a patent could have been obtained is no objection to a design, otherwise good. A design may be registered for part of an article as well as for the whole. It need not be useful —*Walker* v. *Falkirk Iron Co.* (1887), 4 R. P. C., 390. See p. 182.

The following are the requisites for a valid registration:—

1. *Novelty.*—Slight alterations are not sufficient. "In order to justify the registration of a design, especially with reference to such matters as . . . are in constant and daily use, there must be some clearly marked and defined difference between that which is to be registered as a new design and that which has gone before"—*Le May* v. *Welch* (1884), 28 Ch. D., 24.

Novelty in material is not novelty in design, although the same design may be well registered by different proprietors, provided the class of goods and the purpose to which the design is applied are distinct—*Bach's Design* (1889), 42 Ch. D., 661. It would then, it seems, be "new and original" within the meaning of s. 47 (p. 185) —*Read & Cresswell's Design* (1889), 42 Ch. D., 260.

A combination of old designs will be protected if the result is a new design.

2. "*Not previously published,*" s. 47 (p. 185).—The author may show the design to his agent, may consult an expert, and so on; but if he go further, and show it to any member of the public, or show it and solicit orders, as in *Blank* v. *Footman* (1888), 39 Ch. D., 678, he has gone too far, and cannot register. The question is, "Was the communication essentially confidential or not?"—*Winfield* v. *Snow* (1891), 8 R. P. C., 15.

Industrial and International Exhibitions.—In favour of these useful expositions it is enacted by s. 57 that "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,—

"(*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."

By r. 36, the exhibitor, after obtaining from the Board of Trade a certificate that the exhibition is industrial or international, must give, under (*a*), seven days' notice to the comptroller, and must furnish him a brief description of the nature of the design, and with a sketch or drawing thereof. Form L should be used (see p. 207).

By the Act of 1886, s. 3, Her Majesty in Council may declare that s. 57 shall apply to any exhibition (abroad or not), and may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller.

N.B.—It is not at all essential that the design should be useful, although the result of the protection of the design may sometimes be to protect an article that is itself useful—*Hecla Foundry Co.* v. *Walker, Hunter, & Co.* (1889), 14 App. Cas., 550; Dec. Ct. Ses., 4th Ser., xvi., p. 27: a case which may also be consulted on the question as to whether an article should be patented or a design should be registered. It is immaterial to consider whether competing designs serve the same or any useful end.

By s. 73 (p. 241), no "scandalous" design may be registered; and, by s. 86, the comptroller may refuse to register a design the use of which would, in his opinion, be contrary to law or morality. See p. 283.

CHAPTER III

THE PROPRIETOR

By s. 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."

A person who purchases an article with a novel design does not, of course, thereby become entitled to the copyright in the design; and still less is he proprietor where he is merely an agent for sale, without any other right to the design.

V.-C. Malins has held, in an *obiter dictum*, that "where a person is engaged in an 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"—*Lazarus* v. *Charles* (1873), L. R.,

16 Eq., 117; but *quære* if this is not expressed too broadly. See the cases under "Patent," p. 95.

The Master of the Rolls, in *Jewitt* v. *Eckhardt* (1878), 8 Ch. D., 404, expressed the opinion that it is necessary that all transfers of the whole or partial interest after registration be in writing, and that the proprietor be registered before he can grant partial interests. This would not apply to the transfer of the whole interest before registration. See "Register" (p. 191, etc.).

CHAPTER IV

THE APPLICATION

By s. 47, sub-ss.

"(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 (p. 187).

"(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 (p. 190).

"(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."

By s. 48, sub-ss.

"(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.

"(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."

The application must be made by the proprietor (p. 183) or his duly authorised agent (p. 187), in the prescribed Form E (p. 203), which must be followed as closely as possible. Form O should be used when it is intended to apply the design to a set of articles (p. 208).

As to international and colonial arrangements, see s. 103 (p. 297).

The classes are given in the third schedule of the Rules of 1890 as follows:—

"*Classification of Articles of Manufacture and Substances*

"1. Articles composed wholly or chiefly of metal, not included in Class 2.

"2. Jewellery.

"3. Articles composed wholly or chiefly of wood, bone, ivory, papier-maché, or other solid substances not included in other classes.

"4. Articles composed wholly or chiefly of glass, earthenware or porcelain, bricks, tiles or cement.

"5. Articles composed wholly or chiefly of paper (except hangings).

"6. Articles composed wholly or chiefly of leather, including bookbinding, of all materials.

"7. Paper-hangings.

"8. Carpets and rugs in all materials, floorcloths, and oilcloths.

"9. Lace, hosiery.

"10. Millinery and wearing apparel, including boots and shoes.

"11. Ornamental needlework on muslin or other textile fabrics.

"12. Goods not included in other classes.

"13. Printed or woven designs on textile piece goods.

"14. Printed or woven designs on handkerchiefs and shawls."

The following Rules regulate the procedure :—

"6. All communications between an applicant for the registration of a design and the comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the comptroller.

"7. An application for the registration of a design shall, with the prescribed fee (p. 201), be left at the Patent Office (Designs Branch), or be sent prepaid by post, addressed to the Comptroller at the Patent Office (Designs Branch), 25 Southampton Buildings, Chancery Lane, London.

"8. An application for the registration of a design, and all drawings, sketches, photographs, or tracings of a design, and all other documents sent to or left at the Patent Office (Designs Branch), or otherwise furnished to the comptroller or to the Board of Trade, shall be written, printed, copied, or drawn upon strong, wide-ruled, foolscap paper

(on one side only), of the size of 13 inches by 8 inches, leaving a margin of not less than one inch and a-half on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand.

"The comptroller may, in any particular case, vary the requirements of this Rule as he may think fit.

"9. An application for the registration of a design shall be accompanied by a sketch or drawing, or by three exactly similar drawings, photographs, or tracings of the design, or by three specimens of the design, and shall, in describing the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable.

"When sketches, drawings, or tracings are furnished they must be fixed.

"When the articles to which designs are applied are not of a kind which can be pasted into books—drawings, photographs, or tracings of such designs shall be furnished.

"10. If the comptroller determines to register a design he shall, as soon as may be, send to the applicant a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office.

"11. 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 these Rules, 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.

"In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post."

As to the exercise of discretionary powers by the comptroller, see p. 289.

The following Instructions are issued by the Patent Office (Designs Branch):—

"*The Drawings or Photographs*

"7. The drawings, etc., accompanying an application, must be sent in triplicate, each representation of each design or set to be upon ordinary foolscap paper, and not on cardboard (on one side only), of the size of 13 inches by 8 inches.

"8. When sketches, drawings, or tracings are furnished, they should be in ink, or if in pencil they must be fixed. Drawings on tracing paper cannot be received, unless mounted on ordinary foolscap paper.

"9. Rough sketches cannot be accepted.

"10. When the design is to be applied to a set, each of the drawings accompanying the application, or the sketch, if a sketch is sent, should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

"11. When specimens of the design are furnished in lieu of drawings or photographs, they must be of such a nature as can be pasted into books; the dimensions of each specimen must not exceed 12 inches by 21 inches, and each must, when necessary, be mounted upon ordinary foolscap paper of the size above mentioned. Each representation of a design in Classes 13 and 14 should show the complete pattern and a portion of the repeat, and ought not to be of less size than 7 inches by 3 inches.

"12. Only two views of the same design can be accepted, unless in the case of a design for a set. Each view should be designated in writing, *i.e.* front view, side

view. Both views should be on one and the same half-sheet of foolscap paper."

Appeal

The following Rules apply :—

"15. Where the comptroller refuses to register a design, and the applicant intends to appeal to the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office (Designs Branch) a notice of such his intention. See Form F (p. 203).

"16. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

"17. The applicant shall forthwith on leaving such notice send a copy thereof to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London.

"18. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal for the Board of Trade.

"19. 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 of the appeal shall be given to the comptroller and the applicant."

CHAPTER V

THE REGISTER

"S. 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 from time to time be prescribed.

"(2) The register of designs shall be *primâ facie* evidence of any matters by this Act directed or authorised to be entered therein.

"S. 49 (1) The comptroller shall grant a certificate of registration to the proprietor of the design when registered. Form G (p. 204).

"(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." Form H (p. 204).

The following Rules regulate the keeping of the register:—

"20. Upon the sealing of a certificate of registration the comptroller shall cause to be entered in the register of designs the name, address, and description of the registered proprietor, and the date upon which the application for registration was received by the comptroller, which day shall be deemed to be the date of the registration.

"21. Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design either exclusively or otherwise, a request (Form K, p. 206) 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 (hereinafter called the claimant), shall be addressed to the comptroller, and left at the Patent Office (Designs Branch).

"22. Every such request shall, 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 their agent authorised in like manner.

"23. Every such request shall state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law, by virtue of which the request is made, so as to show the manner in which, and the person or persons to whom, the design has been assigned or transmitted, or the person or persons who has or have acquired such right as aforesaid, as the case may be.

"24. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the design or the right to apply the same, as the case may be, as claimed by such request.

"25. The claimant shall furnish to the comptroller

such other proof of title as he may require for his satisfaction.

"26. A body corporate may be registered as proprietor by its corporate name.

"27. Four clear days' notice of every application to the Court under s. 90 of the Patents, Designs, and Trade Marks Acts 1883 to 1888, for rectification of the Register of Designs, shall be given to the comptroller.

"28. Where an order has been made by the Court, under s. 90 of the said Acts (p. 284), the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the register, as the case may be."

As to the assignment being in writing, see p. 184.

It is extremely important that an assignment should be promptly registered in view of future proceedings to protect the design, which must be taken by the "registered proprietor."

The want of registration would not leave the design "within the order and disposition" of the assignor, so as to pass to his trustee in bankruptcy—*Colonial Bank* v. *Whinney* (1885), 11 App. Cas., 426.

As to "Inspection," etc., see pp. 199, 200.

Effect of Registration

By s. 50, sub-ss.

"(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."

By s. 60, "'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."

By s. 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."

Under the last clause, a proprietor was held not to have lost his copyright in a case where he directed his manufacturer to apply the mark prescribed by the comptroller, but by inadvertence the manufacturer applied the mark of an expired design. The result would have been the same if no mark had been applied—*Wittman* v. *Oppenheim* (1884), 27 Ch. D., 260.

By r. 32, "Before the delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in any of the classes one to twelve in the third schedule hereto, cause each such article to be marked with the abbreviation 'R^{D}' and the number appearing on the certificate of registration, and shall, if such article is included in the classes thirteen or fourteen in the third schedule hereto,

cause each such article to be marked with the abbreviation 'REGD.'".

It is sufficient if the labels or wrappers in which the goods are sold are marked; but each parcel sold, however small, must be marked—*Blank* v. *Footman, etc.* (1888), 39 Ch. D., 678.

By s. 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."

CHAPTER VI

INFRINGEMENT

Legal Proceedings.—S. 58, as altered by the Act of 1888, gives to the registered proprietor, in addition to the equitable remedy of an injunction, a right of suing for penalty. The words of s. 58 are as follows:—

"During the existence of copyright in any design—

"(*a*) It shall not be lawful for any person, without the licence 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 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."

It will be noticed that these sections leave it open for any one to copy a design, provided the copy is not meant for sale. It may lawfully be made for private use or giving away, and this in spite of the more extensive definition of copyright in s. 60 (*supra*). An injunction would not be granted in such a case, as it would probably be held that the copyright is co-extensive only with the statutory remedy.

In *Sherwood* v. *Decorative Art Tile Co.* (1887), 4 R. P. C., 207, a design was held a "fraudulent," though not an "obvious," imitation.

The plaintiff in an action under this section must prove that the defendant knew of the registration of the design and afterwards applied such design, or at least intended to apply it—*Smith* v. *Lewis, Roberts, & Co.* (1888), 5 R. P. C., 611.

S. 59 gives as an alternative to the action for penalties an action for damages, subject to proof that the offender knew "that the proprietor had not given his consent to such application." So that both under s. 58 (*b*) and s. 59 it will be necessary to prove knowledge of infringement on the part of the defendant. Therefore it will generally be advisable to give written notice to the alleged infringer of the proprietor's rights, and take proceedings only upon continuance of the infringement.

A person whose design is registered in respect of one class cannot proceed against one who is infringing in other classes only—*Read & Cresswell's Design* (1889), 42 Ch. D., 260.

See further as to "Injunction," Part II, Chap. X, p. 139.

The evidence of infringement, as in the case of trade marks, is ocular. "The eye must be the judge in such a case as this, and 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"—*Hecla Foundry Co.* v. *Walker, Hunter, & Co.* (1889), 14 App. Cas., 550; and see under "Novelty," *supra*, p. 181.

The defendant infringer has a right to call upon the proprietor to state the purpose for which the design is registered, whether pattern, shape, or ornament—*Hunter, Walker, & Co.* v. *Falkirk Iron Co.* (1887), Dec. Ct. Ses., 4th Ser., xiv., p. 1072. The purpose may be proved by evidence.

As to foreign and colonial arrangements, see pp. 297–303.

Copyright in designs is purely territorial, and it is no infringement for a British subject to make a design in this country and apply it to goods in a foreign State where only they are sold—*Potter & Co.* v. *Braco P., etc., Co.* (1891), 8 R. P. C., 218.

CHAPTER VII

MISCELLANEOUS

INSPECTION, ETC., OF THE DESIGN

By s. 52 it is enacted that "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, 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) 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."

The days for inspection are posted up at the Patent Office; the hours are 10 A.M. to 4 P.M. The applicant must produce the number of the design. (R. 33.)

As to "inspection of the register," see p. 284, ss. 88, 89.

Information as to Existence of Copyright

By s. 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."

Form N should be used. See p. 208.

By r. 35, "The comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the Patent Office, and inform any person requesting him so to do whether a particular design produced by such person, 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 request must be accompanied by two representations of the design to be searched for.

This information is not evidence in an action, except for showing *bonâ fides*.

Certificate

"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 said Act or these Rules to make or do, the comptroller may, on a request in writing and on payment of the prescribed fee, give such certificate, which shall also specify

on the face of it the purpose for which it has been requested as aforesaid." (R. 34, and see pp. 204, 205 for Forms to be used.)

FEES

1. On application to register one design to be applied to single articles in each class, except Classes 13 and 14	£0 10 0	
2. On application to register one design to be applied to single articles in Classes 13 and 14	0 1 0	
3. On application to register one design to be applied to a set of articles for each class of registration.	1 0 0	
4. On notice of appeal to Board of Trade against refusal of comptroller to register	1 0 0	
5. Copy of certificate of registration, each copy	0 1 0	
6. On request for certificate of comptroller for legal proceedings or other special purpose	0 5 0	
7. On request to enter name of subsequent proprietor	Same as registration fee.	
8. On notice to comptroller of intended exhibition of an unregistered design	0 5 0	
9. Inspection of design in any case in which inspection is permitted by the Patents, Designs, and Trade Marks Acts 1883 to 1888, and the Designs Rules thereunder, for each quarter of an hour	0 1 0	
10. Copy of one such design	Cost according to agreement.	
11. On request to correct clerical error	0 5 0	
12. On request for search under s. 53	0 5 0	
13. On request to enter new address	0 5 0	
14. For office copy, every hundred words	0 0 4 (but never less than 1s.)	
15. For certifying office copies, MSS. or printed	0 1 0	

NOTE.—The term "set" to include any number of articles ordinarily on sale together, irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article.

Forms

E.—Form of Application to register.
F.— „ Appeal to Board of Trade.
G.— „ Certificate of registration.
H.— „ Application for copy of certificate of registration
I.— „ Request for certificate for use in legal proceedings.
J.— „ Certificate for use in legal proceedings.
K.— „ Request to enter name of subsequent proprietor.
L.— „ Notice of intending exhibition of unregistered design.
M.— „ Request for correction of clerical error or for entry of new address.
N.— „ Request for search under s. 53.
O.— „ Application to register for a set of articles.

N.B.—As to where these Forms can be obtained, see p. 319.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

DESIGNS.

E (p. 186)

APPLICATION FOR REGISTRATION OF DESIGN IN CLASSES

You are hereby requested to register the accompanying design in Class , in the name of (*a*) of who claims to be the proprietor thereof, and to return the same to

(a) Here insert legibly the name, address, and description of the individual or firm.

Statement of nature of design (*b*)

(b) Such as whether it is applicable for the pattern or for the shape.

(*c*)

(c) To be signed by the applicant.

(Signed)

Dated the day of 189

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

DESIGNS.

F (p. 190)

APPEAL TO BOARD OF TRADE ON REFUSAL OF COMPTROLLER TO REGISTER A DESIGN

(To be accompanied by an unstamped copy)

SIR,

I hereby appeal against your decision upon my application to register and beg to submit my case (*a*) for the decision of the Board of Trade.

I am, Sir,
Your obedient Servant,

(a) The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

SEAL OF PATENT OFFICE.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

G (p. 190)

CERTIFICATE OF REGISTRATION OF DESIGN

(R^D. No.)

Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

This is to certify that the design of which this is a copy was registered this day of 188 , in pursuance of the Patents, Designs, and Trade Marks Acts 1883 to 1888, in respect of the application of such Design to articles in Class , for which a copyright of five years is granted.

DESIGNS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

H (p. 190)

APPLICATION FOR COPY OF CERTIFICATE OF REGISTRATION OF DESIGN

SIR,

I hereby request you to furnish me with a Copy Certificate of Registration of Design No. in Class .

(Signed)

Dated the day of 189

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

DESIGNS.

I (pp. 200, 290)

REQUEST FOR CERTIFICATE FOR USE IN LEGAL PROCEEDINGS

SIR,

I hereby request you to send me for the purpose of use in the suit of (*a*)

(*a*) Here state the title of the legal proceeding or the other purpose for which the Certificate is required.

a certificate that the design of which a copy is herein enclosed was (*b*)

(*b*) Here state the entry, matter or thing which the writer wishes certified.

(Signed)

day of 189 .

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

SEAL.

J (pp. 200, 290)

CERTIFICATE FOR USE IN LEGAL PROCEEDINGS

In the matter of

No.

I, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that

Witness my hand and seal this day of 189

Comptroller.

Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

DESIGNS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

K (pp. 192 and 284)

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF DESIGN, WITH DECLARATION IN SUPPORT THEREOF

I, (*a*)

(*a*) or We. Here insert name, full address, and description.

hereby request that you will enter (*b*) name (*c*) in the register of designs as proprietor of the Design No. in Class .

(*b*) My or our.

(*c*) or Names.

(*d*) I am, or We are. (*d*) entitled as to the said design

(*e*) Here state whether design transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof as, *e.g.*, "by deed dated the ____ day of ____ 188_ made between So-and-so of the one part." (*e*)

(*f*) This paragraph is not required when the declaration is made out of the United Kingdom.

(*f*) And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said design as above claimed.

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.

(*g*) To be signed here by the person making the declaration. (*g*)

Declared at

this day of 189

Before me,

(*h*) Signature and title of the authority before whom the declaration is made. (*h*)

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

L (p. 182)

DESIGNS.

NOTICE OF INTENDED EXHIBITION OF AN UNREGISTERED DESIGN

(*a*)

hereby give notice of my intention to exhibit a
of at the
Exhibition, which (*b*)
of 189 , under the provisions of the Patents, Designs, and Trade Marks Acts of 1883 to 1888 (*c*)

herewith enclose a

(Signed)

Dated the day of 189

(*a*) Here state name and address of applicant.

(*b*) State "opened" or "is to open."

(*c*) Insert brief description of design, with drawing.

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

M (p. 287)

DESIGNS.

REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR ENTRY OF NEW ADDRESS

SIR,

I hereby request that

(Signed)

Dated the day of 189

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

DESIGNS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

N (p. 200)

REQUEST FOR SEARCH UNDER SECTION 53

Sir,

I hereby request that a search may be made in class

(Signed)

Dated the day of 189

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

DESIGNS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

O (p. 186)

APPLICATION FOR REGISTRATION OF DESIGN TO BE APPLIED TO A SET

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, and to return the same to

Statement of nature of design (*c*)

(Signed) (*d*)

Dated the day of 189

(*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 description of the individual or firm.

(*c*) Such as whether it is applicable for the pattern or for the shape.

(*d*) To be signed by the applicant.

To the Comptroller,
Patent Office, Designs Branch,
25 Southampton Buildings,
Chancery Lane, London, W.C.

PART IV

—o—

TRADE MARKS

CHAPTER I

INTRODUCTION

Up to the year 1862 the law relating to trade mark was the same as that relating to trade name, viz. a branch of the law of fraud. The plaintiff had a right to obtain an injunction against a man passing off his goods as the plaintiff's, or the plaintiff's goods as his own, whether he did this by adopting the plaintiff's trade name, mark, or by means of any other misrepresentation. He had, further, a right to obtain damages from a defendant who was wilfully fraudulent. Both these rights exist to the present day in respect to trade name and unregistered trade mark. See pp. 307–312.

In the year 1862 was passed the first Merchandise Marks Act (25 and 26 Vict., c. 88), a statute which contained a definition of trade mark, and made the forging of a mark, or falsely applying it with intent to defraud, a misdemeanour. This Act has now been superseded by the Merchandise Marks Act 1887 (*infra*, p. 320).

In 1875 the Trade Marks Registration Act (38 and 39 Vict., c. 91) established a register of marks under the control of the then commissioners of patents, and defined (s. 10) a trade mark as follows:—

"A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"A written signature or copy of a written signature of an individual or firm; or

"A distinctive device, mark, heading, label, or ticket;

"And there may be added to any one or more of the said particulars—

"Any letters, words or figures, or combination of letters, words or figures; also

"Any special and distinctive word or words or combination of figures or letters used as a trade mark before" 13th August 1875 "may be registered as such under this Act."

This Act was amended in 1876 and 1877, and was repealed by the Patents Act 1883, particulars of which and of the general law on the subject now follow

CHAPTER II

DEFINITION

One main difference between trade marks and trade names is that the trader has a right of property in the former if registered, but not in the latter, except where used as trade mark.

Since the Act of 1883 (46 and 47 Vict., c. 57) trade marks have been divided into two classes: 1st, Those which have been registered under the Act; 2nd, Those in use before 13th August 1875, whose registration has been refused. Only in these two cases may proceedings be taken to prevent infringement. (S. 77, p. 251.)

By the same Act (s. 64), as amended by 51 and 52 Vict., c. 50, s. 10, certain trade marks only may be registered. The s. is as follows:—

"64. (1) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars—

"(*a*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"(*b*) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

"(*c*) A distinctive device, mark, brand, heading, label, or ticket; or

"(*d*) An invented word or invented words; or

"(*e*) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words or figures, or combination of letters, words or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"(3) Provided as follows:

"(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

"(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the 13th day of August 1875, may be registered as a trade mark under this part of this Act."

By s. 74. (1) "Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

"(*a*) In the case of an application for registration of a trade mark used before the 13th day of August 1875—

"Any distinctive device, mark, brand, heading, label, ticket, letter, word or figure, or combination of letters, words or figures, though the same is common to the trade in the goods with respect to which the application is made;

"(*b*) In the case of an application for registration of a trade mark not used before the 13th day of August 1875—

"Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

"(2) The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register;

"(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words or figures, which was or were, before the 13th day of August 1875, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods."

For rules 28–31, restricting registration, see p. 235.

Notes.—Registration of a mark for long time in use will sometimes be granted, subject to conditions, *e.g.* that the mark shall only be applied as in the past, etc.; but, as a rule, conditions will not be imposed except where a similar mark is used by another trader for similar goods, and where the facts for the opposition are not strong enough to warrant the comptroller in refusing registration altogether.

No mark, whether old or new, can be registered which is calculated to deceive, or which is combined with deceptive words. So the words "patent," "registered," "royal," etc., have been held deceptive, where not representing a fact, and *infra* (*c*) and 3 (ii.), s. 73 (p. 241), and r. 29 (p. 235).

The trade mark must be used in connection with the goods, either by being actually impressed on or affixed to the goods or at least printed on the wrappers and labels.

(*d*) This has taken the place of "fancy word or words, not in common use" of the Act of 1883, a phrase which occasioned great difficulty and many legal conflicts, and which still applies to applications made but not perfected before the Act of 1888—*Apollinaris Co.'s T. M.* (1891), 2 Ch. 186. It seems that many words will be capable of registration as "invented" that were excluded as "fancy" and *vice versâ*. For definitions of "fancy" words, see *Van Duzer's T. M.* (1887), 34 Ch. D., 623.

(*c*) "Letters" cannot be registered as essential particulars of a trade mark, unless used so as to come within this s.-s. As to "brand," see *Pirie* v. *Goodall* (1891), 8 R. P. C., 261.

(*c*) and (*e*) Where the word used is descriptive, not merely of the goods of the applicant, but of all goods of the same pattern, it cannot be registered, as it is not distinctive and it does refer to the character of the goods—*Arbenz T. M.* (1887), 35 Ch. D., 248.

As to a geographical name, see *Apollinaris Co.'s T. M.* (1891), 2 Ch., 186.

(*c*) and 3 (ii.) No mark can be distinctive which by itself or by reason of added words is calculated to deceive; so "Eton," as a trade mark for cigarettes, was refused registration, as words were added indicative of foreign manufacture, which was untrue—*Wood's T. M.* (1886), 32 Ch. D., 247. The onus lies on the applicant to show that his mark is *not* calculated to deceive. See Chapter IV, at p. 241. *In re Fuente's T. M.* (1891), 2 Ch., 166, decided that a trade mark which has been used in combination with fraudulent words may not be registered alone.

Red, white, and blue stripes, or stripes of any colour, are not distinctive. Colour will not be registered—*Hanson's T. M.* (1887), 37 Ch. D., 112; see s. 67, p. 222.

The mark must be such as to distinguish the goods as those of the applicant—*Apollinaris Co.'s T. M.* (u.s., p. 160).

A firm has been held entitled to register the figure of a black dome, one of the shapes in which they sold their black-lead, the evidence showing that the black-lead of the plaintiffs, of whatever shape, was known in the trade as "dome black-lead," and from that the Court inferred that the mark was distinctive. The mark was always stamped on the goods in whatever shape sold—*James' T. M.* (1886), 33 Ch. D., 392. The words "Parchment Bank," as applied to notepaper, are descriptive—*Pirie* v. *Goodall* (1891), 8 R. P. C., 261. A label with the name of the firm and the article manufactured is not distinctive —*Price's, etc., Co.* (1884), 27 Ch. D., 681; nor when combined with the obverse and reverse of a medal—*Bryant & May's T. M.* (1891), 8 R. P. C., 69.

The question whether a new mark is calculated to deceive from its similarity to a mark already on the register will be decided by comparison of the new mark with the old mark, as registered and not as used, when, as in some cases, a difference exists; but the newer mark may be looked at *as used*, even if *as registered* it is not calculated to deceive. Other evidence besides ocular comparison is, of course, admissible.

A mark used for wines, being the same as that for spirits sold by another firm is calculated to deceive; so is "demotic" stamped on racquets, the plaintiff's mark being a demon's face and the words "The Demon" for the same goods; so is "Monobrut" as applied to champagne, the plaintiff's trade mark (registered abroad only) being "Monopole;" so is a buffalo, an existing mark for the same class of goods being a bull's head; so a winged cross within concentric circles is too like a lighthouse on a rock within concentric circles—*Baker* v. *Rawson* (1890), 45 Ch. D., 519.

3 (ii.) The device or words must have been used alone,

not in combination—*Meeus' Appn.* (1891), 1 Ch., 41; *Perry, Davis, & Son* v. *Harbord* (1890), 15 App. Cas., 316.

Even where the mark has been used in combination with the name of the firm only, *e.g.* on labels, it cannot be registered. The latest case is *Richards* v. *Butcher* (1891), 2 Ch., 522. But the label may be registered as a whole; see next page. After registration the mark may be used in combination—*Melachrino & Co.* v. *Melachrino Cigarette Co.* (1887), 4 R. P. C., 215; and see under s. 77, p. 251.

Words used as an old mark must be "special and distinctive"; and, if so, do not fail because they are also descriptive. They must be words which suggest that the article to which it is applied is manufactured or sold by a particular firm. See *Bodega Co.* v. *Owens* (1889), 6 R. P. C., 236; so that the name of an article cannot be registered alone, even where the name was originally coined for application to the article, for it is descriptive only and not "special and distinctive."

"Pain Killer" has been held merely descriptive of the quality of a patent medicine, and not "special and distinctive"—*Perry, Davis, & Son* v. *Harbord* (*supra*). So "Granolithic" in *Stuart & Co.* v. *Scottish Val de Travers Co.* (1885), Dec. Ct. Ses., 4th Ser., xiii., p. 1. Nor can names be registered, which from being distinctive have by use become descriptive of the articles, no longer being used to indicate a particular maker or seller, *e.g.* "Harvey's Sauce." And a word which has remained on the register five years unchallenged will be expunged if used not as a trade mark, but to specify a pattern or design. So where a manufacturer used the word "Albion" to denote not his manufacture, but a particular design of machine, the name was expunged—*Harrison's T. M.* (1889), 42 Ch. D., 691. The design should have been registered and not the name. See "Design," chap. ii. p. 182.

"Emollio," meaning "I soften," is a descriptive word, when applied to substances which soften. "Washerine," as applied to a washing preparation, is descriptive. So is "Electroid," when denoting the presence of electric action. "Satinine," as applied to a washing preparation, is descriptive of the effect, etc.

Disclaimer—even in the case of an "old" mark—must be made in the application. It is too late to disclaim in Court. And the disclaimer must be of something common to the trade. So that a mark which cannot be registered in consequence of having been used in combination with a firm name, cannot be made fit for registration by disclaimer of the firm name. See *Goodall's T. M.* (1889), 42 Ch. D., 566, and *Meeus' Appn.* (1891), 1 Ch., 41. Where it is sought to register a label containing "common" words, as a whole, and not as containing a trade mark and something else, it is not necessary to disclaim—*Apollinaris Co.'s T. M.* (1891), 2 Ch., 186; *Pinto* v. *Badman*, 8 R. P. C., 191.

"Common" to the trade means "open" to the trade —*Burland's T. M.* (1889), 6 R. P. C., 482.

As to what is "*user*" within s. 74—see *Jackson* v. *Napper* (1886), 4 R. P. C., 45. Exposure for sale of goods, essentially the same, though passing by a different name, is sufficient.

Searches

See s. 88. A person desiring to adopt a trade mark should make a search at the Trade Mark Branch of the Patent Office in order to discover if the mark is already registered, or whether, from its similarity to a registered mark, it would be calculated to deceive. The fee is one shilling for each quarter of an hour. The comptroller only undertakes to make searches in connection with applications for registration.

CHAPTER III

APPLICATION

THE mode of application is regulated by s. 62 of the Act of 1883, as amended by the Act of 1888. The s. is as follows:—

"(1) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark.

"(2) The application must be made in the form (Form F, p. 265) 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, such place and in such manner as may be prescribed (p. 222).

"(3) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered (p. 225).

"(4) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who 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 (p. 231).

"(5) The Board of Trade may, however, if it appears

expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid. Form T, p. 275.

"(6) Where an applicant for the registration of a trade mark, otherwise than under an international convention, is out of the United Kingdom at the time of making the application, he shall give the comptroller an address for service in the United Kingdom; and if he fails to do so, the application shall not be proceeded with until the address has been given." See pp. 297–303.

It seems that importation by a foreigner, for the purpose of transhipment, gives him no title to register a trade mark here—*Meeus' Appn.* (1891), 1 Ch., 41; *Jackson* v. *Napper* (1887), 35 Ch. D., 162. And see "Disclaimer," p. 219.

By s. 63, "Where registration of a trade mark has not been or shall not be 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 of the non-completion to the agent employed on behalf of the applicant; and if, at the expiration of fourteen days from that notice, the registration is not completed, shall give the like notice to the applicant; and if, at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned."

But in special cases, where the applicant is not guilty of laches or conduct disentitling him, he may, after abandonment, make a fresh application for registration—*Jackson* v. *Napper* (1886), 35 Ch. D., 162.

By s. 65, "A trade mark must be registered for particular goods or classes of goods.

"66. When a person claiming to be the proprietor of

several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (*a*) the statement of the goods for which they are respectively used or proposed to be used, or (*b*) statements of numbers, or (*c*) statements of price, or (*d*) statements of quality, or (*e*) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole; but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

"67. A trade mark may be registered in any colour or colours, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour or colours." See pp. 216 and 235.

A mark applies only to goods, not *e.g.* to a place of business where the goods are sold—*Bogeda Co.* v. *Owens* (1889), 6 R. P. C., 236. A mark should only be registered for the particular goods in the class for which it is used—*Harrison's T. M.* (1890), 7 R. P. C., 25; and not for the whole class, unless actually used for the whole. Where registered for the whole, but used for particular goods only, it will be treated as confined to the latter—*Hargreaves* v. *Freeman* (1891), 8 R. P. C., 237.

The following Rules have been made regulating the procedure:—

"7. An application for registration of a trade mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be.[1]

[1] After the signature of a member of a firm should be the words, "A member of the firm"; in the case of a company, "for the company" should be added.

"If the application be made by a body corporate, it may be signed by the secretary or other principal officer of such body corporate.

"8. Where a trade mark, for registration of which application is made, is in Classes 23, 24, or 25 of the third schedule to these Rules, the applicant shall address and send his application to the Manchester Trade Marks Branch, 48 Royal Exchange, Manchester. Other applications (except applications which, under s. 81 of the said Acts, should be made to the Cutlers' Company) shall be addressed and sent to the Patent Office, Trade Marks Branch, 25 Southampton Buildings, Chancery Lane, London, W.C.

"9. An application for registration, and all other communications between the applicant and the comptroller, may be made by or through an agent duly authorised to the satisfaction of the comptroller.[1]

"10. On receipt of the application, the comptroller shall furnish the applicant with an acknowledgment thereof.

"11. Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application.

"12. Subject to any other directions that may be given by the comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the comptroller or to the Cutlers' Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

[1] After an agent's signature, "Agent" should appear.

"13. Subject to any other directions that may be given by the comptroller, three representations of each trade mark, except in the case of marks applied for in Classes 23 to 35 inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade marks exceeding the limits of the foolscap paper of the size aforesaid, such marks may be pasted and folded upon the sheets of foolscap. Form G, p. 267.

"In the case of marks applied for in Classes 23 to 35 inclusive, the applicant shall supply four representations of each mark for each class.

"Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the comptroller may think most convenient.

"The comptroller may, if dissatisfied with the representation of a trade mark, require a fresh representation, either before he proceeds with the application or before he registers the trade mark.

"The comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer thereto in the register in such manner as he may think fit.

"14. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in s. 66 of the said Acts, a representation of each trade mark of the series shall be made or affixed upon the form of application, and also upon each of the separate half-sheets of paper aforesaid.

"15. Wherever a mark consists of or includes words

printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent.

"16. Any application, statement, 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 these Rules, 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.

"In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post."

Classification of Goods

(*Rules* 1890. *Schedule* 3)

(A guide to this classification can be obtained at the Patent Office, Trade Marks Branch, Cursitor Street, E.C.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the comptroller (r. 6, and p. 289).

General Note.—Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the comptroller may desire.

Goods are mentioned by way of illustration, and not as an exhaustive list of the contents of a class.

Class 1.

Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives—Such as acids (including vegetable acids), alkalies, artists' colours, pigments, mineral dyes.

Class 2.

Chemical substances used for agricultural, horticultural, veterinary and sanitary purposes—Such as artificial manure, cattle medicines, deodorisers, vermin destroyers.

Class 3.

Chemical substances prepared for use in medicine and pharmacy—Such as cod-liver oil, medicated articles, patent medicines, plasters, rhubarb.

Class 4.

Raw or partly prepared vegetable, animal and mineral substances used in manufactures, not included in other classes —Such as resins, oils used in manufactures and not included in other classes, dyes (other than mineral), tanning substances, fibrous substances (*e.g.* cotton, hemp, flax, jute), wool, silk, bristles, hair, feathers, cork, seeds, coal, coke, bone, sponge.

Class 5.

Unwrought and partly wrought metals used in manufacture —Such as iron and steel, pig or cast; Iron—rough; bar and rail, including rails for railways; bolt and rod; sheet, and boiler and armour plates; hoop. Lead—pig, rolled and sheet; wire; copper; zinc; and gold in ingots.

Class 6.

Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7— Such as steam engines, boilers, pneumatic machines, hydraulic machines, locomotives, sewing machines, weighing machines, machine tools, mining machinery, fire engines.

Class 7.

Agricultural and horticultural machinery, and parts of such machinery—Such as ploughs, drilling machines, reaping machines, thrashing machines, churns, cider presses, chaff cutters.

Class 8.

Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching—Such as mathematical instruments, gauges, logs, spectacles, educational appliances.

Class 9.

Musical instruments.

Class 10.

Horological instruments.

Class 11.

Instruments, apparatus and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals—Such as bandages, friction gloves, lancets, fleams, enemas.

Class 12.

Cutlery and edge tools—Such as knives, forks, scissors, shears, files, saws.

Class 13.

Metal goods not included in other classes—Such as anvils, keys, basins (metal), needles, hoes, shovels, corkscrews.

Class 14.

Goods of precious metals (including aluminium, nickel, Britannia metal, etc.) and jewellery, and imitations of such goods and jewellery—Such as plate, clock cases and pencil cases of such metals, Sheffield and other plated goods, gilt and ormolu work.

Class 15.

Glass—Such as window and plate glass, painted glass, glass mosaic, glass beads.

Class 16.

Porcelain and earthenware—Such as china, stoneware, terra-cotta, statuary porcelain, tiles, bricks.

Class 17.

Manufactures from mineral and other substances for building or decoration—Such as cement, plaster, imitation marble, asphalt.

Class 18.

Engineering, architectural and building contrivances—Such as diving apparatus, warming apparatus, ventilating apparatus, filtering apparatus, lighting contrivances, drainage contrivances, electric and pneumatic bells.

Class 19.

Arms, ammunition and stores, not included in Class 20—Such as cannon, small-arms, fowling-pieces, swords, shot and other projectiles, camp equipage, equipments.

Class 20.

Explosive substances—Such as gunpowder, gun-cotton, dynamite, fog signals, percussion caps, fireworks, cartridges.

CLASS 21.

Naval architectural contrivances and naval equipments not included in Classes 19 and 20—Such as boats, anchors, chain cables, rigging.

CLASS 22.

Carriages—Such as railway carriages, waggons, railway trucks, bicycles, bath chairs.

CLASS 23.

(*a*) Cotton yarn and sewing cotton not on spools or reels.
(*b*) Sewing cotton on spools or reels.

CLASS 24.

Cotton piece goods of all kinds—Such as cotton shirtings, long cloth.

CLASS 25.

Cotton goods not included in Classes 23, 24, or 38—Such as cotton lace, cotton braids, cotton tapes.

CLASS 26.

Linen and hemp yarn and thread.

CLASS 27.

Linen and hemp piece goods.

CLASS 28.

Linen and hemp goods not included in Classes 26, 27, and 50.

CLASS 29.

Jute yarns and tissues, and other articles made of jute not included in Class 50.

CLASS 30.

Silk—spun, thrown or sewing.

CLASS 31.

Silk piece goods.

CLASS 32.

Other silk goods not included in Classes 30 and 31.

CLASS 33.

Yarns of wool, worsted, or hair.

CLASS 34.

Cloths and stuffs of wool, worsted, or hair.

CLASS 35.

Woollen and worsted and hair goods not included in Classes 33 and 34.

CLASS 36.

Carpets, floor-cloth, and oil-cloth—Such as drugget, mats and matting, rugs.

CLASS 37.

Leather, skins unwrought and wrought, and articles made of leather not included in other classes—Such as saddlery, harness, whips, portmanteaus, furs.

CLASS 38.

Articles of clothing—Such as hats of all kinds, caps and bonnets, hosiery, gloves, boots and shoes, other ready-made clothing.

CLASS 39.

Paper (except paper-hangings), stationery and book-binding —Such as envelopes, sealing wax, pens (except gold pens), ink, playing cards, blotting cases, copying presses.

CLASS 40.

Goods manufactured from india-rubber and gutta-percha not included in other classes.

CLASS 41.

Furniture and upholstery—Such as paper-hangings, papier-mâché, mirrors, mattresses.

CLASS 42.

Substances used as food, or as ingredients in food—Such as cereals, pulses, olive oil, hops, malt, dried fruits, tea, sago, salt, sugar, preserved meats, confectionery, oil cakes, pickles, vinegar, beer clarifiers.

CLASS 43.

Fermented liquors and spirits—Such as beer, cider, wine, whisky, liqueurs.

CLASS 44.

Mineral and aerated waters, natural and artificial, including gingerbeer.

CLASS 45.

Tobacco, whether manufactured or unmanufactured.

CLASS 46.

Seeds for agricultural and horticultural purposes.

CLASS 47.

Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches and starch, blue and other preparations for laundry purposes—Such as washing powders, benzine collas.

CLASS 48.

Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).

CLASS 49.

Games of all kinds, and sporting articles not included in other classes—Such as billiard tables, roller skates, fishing nets and lines, toys.

CLASS 50.

Miscellaneous (such as coopers' wares), including—

(1) Goods manufactured from ivory, bone, or wood, not included in other classes.
(2) Goods manufactured from straw or grass, not included in other classes.
(3) Goods manufactured from animal and vegetable substances, not included in other classes.
(4) Tobacco pipes.
(5) Umbrellas, walking-sticks, brushes, and combs.
(6) Furniture cream, plate powder.
(7) Tarpaulins, tents, rick-cloths, rope, twine.
(8) Buttons of all kinds, other than of precious metal or imitations thereof.
(9) Packing and hose of all kinds.
(10) Goods not included in the foregoing classes.

The following Rules regulate procedure on—

APPEAL TO THE BOARD OF TRADE

"20. When any person intends to appeal to the Board of Trade from a decision of the comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office (Trade Marks Branch), a notice of such his intention. Form H, p. 268.

"21. Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

"22. A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London; and where there has been an opposition before the comptroller, to the opponent or applicant as the case may be.

"23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

"24. Where the Board of Trade intend to hear the appeal, 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 to the comptroller and to the appellant, and where there has been an opposition before the comptroller to the opponent or applicant as the case may be.

"25. 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.

"26. Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the comptroller."

Advertisement of Application

By s. 68, "Every application for registration of a trade mark under this part of this Act shall, as soon as may be after its receipt, be advertised by the comptroller, unless the comptroller refuse to entertain the application."

The following Rules apply:—

"27. Every application shall be advertised by the comptroller in the official paper, during such times and in such manner as the comptroller may direct, unless he refuse to entertain the application.

"If no representation of the trade mark be inserted in the official paper, in connection with the advertisement of an application, the comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trademark is deposited for exhibition.

"28. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.[1]

[1] "Sale of Official Publications

"The Patents, Designs, and Trade Marks Acts 1883–1888, and the Trade Marks Rules 1890, should be carefully studied. Copies of the Acts and of the Rules can be purchased at the Sale Branch of the Patent Office, 38 Cursitor Street, Chancery Lane, London, E.C. The price of the Acts and Rules together is 2s. 6d., postage 2d.; of the Acts alone 2s., postage 1½d.; and of the Rules alone 6d., postage 1d.

"29. For the purposes of such advertisement the applicant may be required to furnish a wood-block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the comptroller, or with such other information or means of advertising the trade mark as may be required by the comptroller; and the comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before proceeding with the advertisement.

"30. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in s. 66 of the said Acts, the applicant may be required to furnish a wood-block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; and the comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another."

It appears from the instructions issued by the Patent Office that:—

"20. A trade mark cannot in any case be entered upon the register until one month after its advertisement in the official paper.

"21. A wood-block or electrotype must be furnished for each mark in each class claimed, except in the case of Class 23A (cotton yarn and sewing cotton, not on spools or Sums exceeding 1s. should be remitted by postal order or post-office order.

"Copies of the *Trade Marks Journal* may also be obtained from the Sale Branch of the Patent Office, 38 Cursitor Street, Chancery Lane, London, E.C.

"The price of the *Trade Marks Journal* is:—

Nos. 1 to 509 (years 1876 to 1887) . .	1s. per number.
Nos. 510 to 561 (year 1888)	1s. 6d. ,,
No. 562 and following Nos. from 1st January 1889,	6d. ,,

reels), and Classes 24 and 25, for which no blocks or electrotypes are required.

"A wood-block or electrotype will be required for an application in Class 23 whenever it is in respect of, or covers, sewing cotton on spools or reels.

"No block or electrotype should be forwarded until a formal demand for it is sent by the comptroller.

"22. In the case of a series of trade marks differing only in respect of the particulars mentioned in s. 66 of the Acts, a wood-block or electrotype must be furnished for each mark in the series, for each class claimed.

"23. The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

"24. The largest space available for the insertion of any single block or electrotype is five and a half inches broad by seven and a half inches deep.

"When a block or electrotype *exceeds two inches in depth or breadth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch in depth or breadth beyond the two inches.

"25. The number given by the comptroller should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure its identification.

"26. All blocks or electrotypes should be sent to the Patent Office (Trade Marks Branch), together with the paper marked 'Form 2,' and with the representation of the mark sent for the guidance of the applicant in preparing the block or electrotype.

"27. The blocks or electrotypes supplied for the

advertisement of trade marks cannot in any case be returned to applicants.

"*Restrictions on Registration*

"28. Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork be included within the mark by some border or lines.

"29. The words 'Registered,' 'Registered Design,' 'Copyright,' 'Entered at Stationers' Hall,' 'To counterfeit this is forgery,' will not be registered under the Acts, and should not, therefore, appear upon the representations of trade marks forming part of an application. See p. 215.

"30. The following will not be registered as trade marks, or as prominent parts of trade marks, unless the marks have been used before 13th August 1875:—The Royal Arms, or arms so nearly resembling them as to be calculated to deceive; representations of Her Majesty the Queen, or of any member of the Royal Family; representations of the Royal Crown; the national arms or flags of Great Britain.

"31. When there appears on the face of a trade mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of *those goods only*."

User for part only of a class does not support a claim for entire class, although the registration extends to the whole. It should be confined to the articles with which the mark is used—*Hargreaves* v. *Freeman* (1891), 8 R. P. C. 237.

As to procedure subsequent to the advertisement of the application, see *infra*, p. 242.

CHAPTER IV

OPPOSITION

[See "Rectification," p. 285.]

By s. 69, as amended, sub-ss.

"(1) Any person may, within one month or such further time, not exceeding three months, as the comptroller may allow of the advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

"(2) Within one month after receipt of such notice, or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so shall be deemed to have abandoned his application.

"(3) If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted (p. 231).

"(4) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5) If the applicant abandons his application, after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

"(6) Where the opponent is out of the United Kingdom, he shall give the comptroller an address for service in the United Kingdom."

The following Rules apply :—

"31 (1) A notice of opposition to the registration of a trade mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J in the second schedule to these Rules, with such variations as circumstances may require (p. 269).

"(2) Where the ground, or one of the grounds, of opposition is that the applicant is applying for the registration of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the register of such trade mark already on the register.

"(3) Within two months after the expiration of one month, or such further time, not exceeding three months, as the comptroller may allow from the date of the advertisement of the application, the opponent shall leave at the Patent Office (Trade Marks Branch), such evidence

by way of statutory declaration as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.

"(4) Within one month from the delivery of the opponent's copies of his statutory declarations, the applicant shall leave at the Patent Office (Trade Marks Branch) his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof; and, within seven days from such delivery, the opponent shall leave at the Patent Office (Trade Marks Branch) his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply.

"(5) No further evidence shall be left on either side, except by leave of the comptroller upon the written consent of the parties duly notified to him, or by special leave of the comptroller given on an application made to him.

"(6) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

"(7) On the completion of the evidence the comptroller shall, upon application by either party, upon Form E (p. 265) in the second schedule to these Rules and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

"(8) On the hearing of the case, no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade mark identical with one already on the register with respect to the same goods or description of goods, or having such resemblance to a trade mark already

on the register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the register of the said trade mark already on the register have been duly specified in the notice of opposition.

"(9) The decision of the comptroller in the case shall be notified to the parties."

The counter-statement must be delivered by the applicant within one month from the receipt of the opponent's notice of opposition, and may be in the following Form :—

"*Patents, Designs, and Trade Marks Acts* 1883 *to* 1888

"TRADE MARKS

"In the Matter of an Application No. .
and of the Opposition thereto No. .

"In reply to the Notice of Opposition in this matter by of , I give notice by way of Counter-statement that I rely for my Application on the following grounds :—

"(To be dated and signed by the *Applicant* or his *Solicitor*)

"To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London."

By s. 71, "Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court."

There are two cases in which it is not uncommon that there should be conflicting claims under s. 71:—1st, Where more than one person succeed to the goodwill of a business, and 2nd, Where there is a dissolution of partnership.

In the absence of special terms, in the documents or agreements forming the base of the claims, both claimants would be entitled to be registered in respect of the same trade mark.

Where a trader innocently uses the mark of another and has it registered, and in using it has done a large business, his mark will not be removed, at any rate at the suit of a rival who has for a long time ceased to use the mark, although he may not have abandoned it. See s. 72 —*Mouson* v. *Boehm* (1884), 26 Ch. D., 398. In this case both marks were retained on the register. Where two persons have *bonâ fide* used the same trade mark before 13th August 1875, both will be registered—*Re Powell* (1878), Johnson's Trade Marks, 237.

A trader who had used a mark before 13th August 1875, by which time it had become well known in the trade, was allowed to register it, although a similar mark was registered in 1877 in connection with similar goods—*White Rose T. M.* (1885), 30 Ch. D., 505.

The application to the Court should be by special case, if it is a simple point of law, but there is jurisdiction to hear the case, on motion, if facts are in dispute.

The opposition may be based on any of the grounds mentioned in ss. 71, 72, 73, or on the ground of the existence of a previous and similar mark, or on the ground of fraud. The Court may entertain other objections besides those stated in the notice—*Sanitas Co.'s T. M.* (1887), 4 R. P. C., 533; *Arbenz' Appln.* (1887), 35 Ch. D., 248.

The Court has no jurisdiction to give to a successful opponent the costs of proceedings before the comptroller —*Australian Wine, etc.* (1889), 41 Ch. D., 278.

The comptroller has an absolute discretion to refuse registration, and has also power to amend a notice of opposition—*Moët's T. M.* (1890), 7 R. P. C., 226.

By s. 72, sub-ss.

"(1) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the register, with respect to such goods or description of goods.

"(2) Except as aforesaid, the comptroller shall not register with respect to the same goods or description of goods a trade mark having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive."

This s. is for the protection of traders.

"73. It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design."

And see s. 86, p. 283.

This. s. is for the protection of the public.

The comptroller has jurisdiction to refuse to register until the opinion of the Court has been obtained—*Price's Patent Candle Co.* (1884), 27 Ch. D., 681.

Calculated to deceive (see Chap. II, at p. 217, and Chap. VI, at p. 253).—Even where the goods differ, as wines from spirits, registration may be refused—as, though the goods may not be of "the same description," they are

similar, and the mark may be calculated to induce the public to believe that both sorts of goods are sold by the same person. *In re The Australian Wine Importers, Limited* (1889), 41 Ch. D., 278—a decision based on analogy, but not strictly within the wording of s. 72, sub-s. 2, or s. 73, and the principle of which was carried further by *Eno* v. *Dunn* (1890), 15 App. Cas., 252, where Eno, who had for many years used as his trade mark the words "Fruit Salt," which were descriptive of a powder used for making an effervescing drink, succeeded in preventing Dunn from registering the same words as additional matter and as applied to baking-powder, Lord Herschell saying, "I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived." It was considered also that the public might believe that the baking-powder had among its ingredients some proportion of the drink-powder. Dunn might well have used "Fruit Salt," words in which there is no property, if he had so used them as to exclude the suggestion of any connection with Eno's Fruit Salt.

As to registering common marks, etc., as additions to trade marks and as to "old marks," see s. 74, p. 214.

Procedure for Registration

The following Rules regulate the procedure subsequent to the advertisement of the application:—

"32. As soon as may be after the expiration of one month from the date of the advertisement of the application, the comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee (Form I, p. 268), enter the name, address, and description of the applicant in the

Register of Trade Marks as the registered proprietor of the trade mark in respect of the particular goods or classes of goods described in his application.

"33. In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the register, the comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the comptroller.

"34. Upon registering any trade mark the comptroller shall enter in the register the date on which the application for registration was received by the comptroller, and such other particulars as he may think necessary.

"35. The comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper.

"36. Where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, a request for the entry of his name in the register, as proprietor of the trade mark, shall be addressed to the comptroller, and left at the Patent Office (Trade Marks Branch).[1]

"37. Such request shall, 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

[1] Form K, p. 270.

the case of a body corporate by their agent, authorised in like manner.

"38. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered.

"39. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request.

"40. The claimant shall furnish to the comptroller such other proof of title, and of the existence and ownership of such goodwill as aforesaid, as he may require for his satisfaction.

"41. A body corporate may be registered as proprietor by its corporate name.

"42. The term 'applicant' in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark.

"43. Whether all such persons so claiming require to be heard before the comptroller or not, he may, before exercising the discretion vested in him by s. 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him,

or to attend before him and make oral explanations with respect to such matters as the comptroller may require.

"44. Where each of several persons claims to be registered as proprietor of the same trade mark, and the comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the comptroller, or, if the comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

"45. Where the special case is to be submitted by the parties it may be agreed to by them, or, if they differ, may be settled by the comptroller on payment of the prescribed fees. Form T, p. 275.

"46. Where an order has been made by the Court in either of the following cases, viz.:—

"(*a*) Allowing an appeal under s. 62 of the said Acts;

"(*b*) Disallowing an opposition to registration under s. 69; or,

"(*c*) Under the provisions of ss. 72, 90, or 92 of the said Acts,—

"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 leave at the Patent Office (Trade Marks Branch), an office copy of such order. The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register, as the case may be.[1]

"47. Where a trade mark has been removed from the register for non-payment of the prescribed fee or other-

[1] See Form N, p. 272.

wise, under the provisions of s. 79 of the said Acts, the comptroller shall cause to be entered in the register a record of such removal and the cause thereof (p. 249).

"48. If the registered proprietor of a trade mark send to the comptroller, together with the prescribed fee, notice of an alteration in his address, the comptroller shall alter the register accordingly.[1]

"49. Four clear days' notice of every application to the Court under s. 90 of the said Acts, for rectification of the register, shall be given to the comptroller[2] (p. 284).

"50. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the register, the comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register.

"51. Whenever the registered proprietor of any trade mark intends to apply for the leave of the Court to add to or to alter such trade mark, under s. 92 of the said Acts, the notice to be given to the comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the comptroller such a number of representations of the trade mark, as altered, as he may deem sufficient" (p. 288).

[1] Form M, p. 271.

[2] Form O, p. 272.

CHAPTER V

THE REGISTER

By s. 78, "There shall be kept at the Patent Office a book called the *Register of Trade Marks*, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed."

By s. 75, "Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall, for the purposes of this Act, be deemed to be, and as from the 1st day of January 1876 to have been, the date of the registration."

There is no jurisdiction to order an unsuccessful applicant to pay an opponent's costs before the comptroller, unless by this s. it can be obtained in an action for damages for "public use" of the trade mark by applying for registration—*Australian Wine Co.* (1889), 41 Ch. D., 278.

By s. 76, "The registration of a person as proprietor of a trade mark shall be *primâ facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act."

The last few words of this s. are very important, for under them it has been decided that a mark which never ought to have been registered does not become valid by the expiration of five years. It may even then be removed from the register on proper application—*Wragg's T. M.* (1885), 29 Ch. D., 551, and *Baker* v. *Rawson* (1890), 45 Ch. D., 519; but it seems that a mark is good so long as it is on the register. A proper application should be made to remove it, if a defendant intends to defend infringement on this ground. And see *Compania, etc.*, v. *Rehder* (1888), 5 R. P. C., 61; and s. 77 (p. 251).

Damages may be given for the use of a mark before it is registered, in an action brought subsequently—*Barlow and Jones* v. *Johnson* (1890), 7 R. P. C., 395.

"70. A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill." See s. 87, p. 283.

This s. crystallises the former law, that trade marks cannot exist by themselves, but only in connection with the goodwill of a business. A trade mark, even before registration, cannot be assigned apart from the particular business to which it is attached, not even to the proprietor of a similar business. This is so although the assignment be made by a foreign owner and be good by foreign law—*Pinto* v. *Badman* (1891), 8 R. P. C., 181. When goodwill is assigned or transmitted, the marks will pass therewith although not mentioned—*Wellcome's T. M.* (1886), 32 Ch. D., 213. When the business is discontinued, the trade mark is abandoned with it, but the mere disuse of a mark, the business continuing, is not of itself sufficient evidence of an intention to abandon the

mark—*Mouson* v. *Boehm* (1884), 26 Ch. D., 398. A trade mark is a partnership asset, and so, on dissolution of partnership, each partner may continue to use the mark, if there is no agreement to the contrary. See s. 71, p. 239.

As to rectification of register, correction of errors and alteration generally, see ss. 90–92, pp. 284, 288.

As to inspection of the register, see p. 284, ss. 88, 89.

Removal from Register

By s. 79, sub-ss.

"(1) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

"(2) If such fee be not paid before the expiration of such fourteen years the comptroller may, after the end of three months from the expiration of such fourteen years, remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.[1]

"(3) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.[2]

[1] Form X, p. 278.

[2] Form Y, p. 279.

"(4) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register, on payment of the prescribed additional fee.

"(5) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

See r. 47, p. 245.

As to "rectification," see ss. 90–92, pp. 284, 288.

[1] Form Z, p. 279.

CHAPTER VI

LEGAL PROCEEDINGS

Infringement

By s. 77, "A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the 13th of August 1875, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request and on payment of the prescribed fee, grant a certificate that such registration has been refused."[1]

And by 77 A, added in 1888, "In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and, if the Court or a judge 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 have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

[1] Form L, p. 271.

As to the necessity of registration prior to action, see *Goodfellow* v. *Prince* (1887), 35 Ch. D., 9.

If a mark has once been registered it is not necessary, although it is proper, to register subsequent assignments in order to enable the assignee to sue—*Ihlee* v. *Henshaw* (1885), 31 Ch. D., 323. No one who is not the proprietor can bring an action for infringement—*Richards* v. *Butcher* (1890), 7 R. P. C., 288.

The sections relating to "registration" are designed to protect the proprietor of a mark by preventing the registration by another person of the same mark, or of another so closely resembling as to be calculated to deceive. S. 77 goes further, and gives the proprietor of a registered mark power to prevent future infringement by an order of the Court, and to obtain compensation for past infringement on the part of another, whether claiming to own a registered trade mark or not. It is often necessary to claim rectification of the register, under O 90 (p. 284), at the same time as damages or an injunction. The right to sue survives to the legal personal representatives of the proprietor.

In order to support a plaintiff's claim to injunction and costs it is necessary to prove infringement, it being immaterial whether or not the defendant knew he was doing wrong; as Lord-Chancellor Cairns said in "*Singer*" *Machine Manufacturers* v. *Wilson* (1877), 3 App. Cas., at p. 391: "A man may take the trade mark of another ignorantly, not knowing it was the trade mark of the other; or he may take it in the belief, mistaken but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it knowing it is the trade mark of his neighbour, and intending and desiring to injure his neighbour by so doing. But in all these

cases it is the same act that is done, and in all these cases the injury to the plaintiff is just the same. The action of the Court must depend upon the right of the plaintiff, and the injury done to that right. What the motive of the defendant may be, the Court has very imperfect means of knowing."

But in order to support an action for damages for past infringement it would, it is submitted, be necessary to prove that the defendant *knew* he was doing wrong; and in some cases it would be wise to draw his attention to the fact by a written notice, and only proceed to an action in case he persist in his wrong-doing. Where the plaintiff proves that the defendant has sold much of the goods wrongly marked, he will be entitled at his option to an account of profits in lieu of damages.

An action for infringement is based upon fraud and deceit; but in order to obtain an injunction it is not necessary, if an application is made promptly, to prove that any one has been actually misled, provided the defendant's dealings are calculated to mislead. If the defendant has been for a long period using the trade mark complained of, it might then be necessary to prove that it had misled some of the public—as, if there had been no misleading, there would be no infringement, and the Court would not, except in a strong case, act upon its own view as to whether the mark was calculated to mislead. As to "Injunction," see Part II, Chap. X, p. 139. Printed notice used by defendants when selling tea, stating that their mark is only for coffee, will not exempt them from the consequences of infringing the plaintiff's mark for tea—*Upper Assam Tea Co.* v. *Herbert & Co.* (1890), 7 R. P. C., 183.

Calculated to deceive (see Chap. IV, at p. 241).—Regard should be had not only to English buyers, but to

those who may become ultimate purchasers of the goods, *e.g.* natives of India, where the goods are intended for the Indian market—*Orr-Ewing* v. *Johnston* (1882), 7 App. Cas., 219; a case which decided also that a rival trader is not entitled to use a trade mark which is likely to attract to his goods the name by which the plaintiff's goods are known in the trade.

In the *Singer Manufacturing Co.* v. *Loog* (1882), 8 App. Cas., 15, there occur some important passages. "The imitation of a man's trade mark, in a manner liable to mislead the unwary, cannot be justified by showing, either that the device or inscription upon the imitated mark is ambiguous, and capable of being understood by different persons in different ways, or that a person who carefully and intelligently examined and studied it might not be misled" (p. 18). Then, at p. 26, Lord Selborne intimated that representations made to wholesale customers had no natural or necessary connection, in intention or fact, with any deception of retail customers; though in other cases this might be different. This case and some cited in the judgments are useful in illustrating the fact that a name which once designates a particular manufacturing firm of special goods may, in time, come to designate the special class of goods by whomsoever manufactured. Another manufacturer is at liberty to refer in his advertisements, etc., to the plaintiff's goods, to make others like them, where not protected by patent, and to state that his goods are made upon the plaintiff's system.

In *Dunnachie* v. *Young* (1883), Dec. Ct. Ses., 4th Ser., x., p. 874, the Court granted an interdict restraining the defender from stamping bricks with the name of a locality, which name formed part of the plaintiff's trade marks; as the defender's bricks, though of exactly the same clay, were actually made two miles from the place named.

In *Anglo-Swiss Co.* v. *Metcalf* (1886), 3 R. P. C., 28, it was held that the proprietor of a figured trade mark, known as "the dairymaid," was entitled to an injunction to restrain the defendant from selling similar goods under a label comprising the word "dairymaid," and to rectification of the register.

It seems that it is no infringement to use another's trade mark on a price list or otherwise, so that it is not used on the goods—*Talbot* v. *Webley* (1886), 3 R. P. C., 276: *sed quære.* At any rate, use by a customer, in ordering goods from defendant, of words which form part of plaintiff's mark, is not infringement by the defendant—*Rugby, etc., Co.* v. *Rugby, etc., Co.* (1891), 8 R. P. C., 241.

See also *Eno* v. *Dunn* (1890), 15 App. Cas., 252, where Lord Herschell said: "If it were proposed so to employ the words 'Fruit Salt' that no reasonable person could suppose that they had reference to the appellant's preparation, such a use would be perfectly unobjectionable. I think it is enough to say that I am not satisfied that there would be no reasonable danger of the public being so deceived."

When plaintiff uses his trade mark in combination with other marks, capable of registration but not registered, he may succeed in an action to prevent fraudulent imitation of goods—*Great Tower Street Tea Co.* v. *Langford & Co.* (1888), 5 R. P. C., 66.

A pipe is not likely to be confounded with a pipe and a dart—*Lambert's T. M.* (1889), 6 R. P. C., 344.

And see the notes under s. 73, p. 241.

It is no infringement to use the plaintiff's trade mark for goods of a totally different character, provided a representation be not thereby made that the goods are the plaintiff's goods—*Hart* v. *Colley* (1890), 7 R. P. C., 93; but trade marks in use before 13th August 1875, the

registration whereof has been refused (see *supra*, p. 213), are dependent, like trade names, on the general principles of the commercial law, and are protected from fraud and deceit on the part of rivals. There is strictly no right of property in trade names or these trade marks, but no rival may pass his goods off as the goods of another or another's goods as his own. Whether this is done directly or indirectly is a matter of no consequence. See *Somerville* v. *Schembri* (1887), 12 App. Cas., 453, and the cases and notes under s. 77 which apply. Plaintiff must be prepared to prove that his goods have obtained a reputation in connection with the trade mark or name—*Jay* v. *Ladler* (1888), 40 Ch. D., 649, and see p. 307.

CHAPTER VII

SHEFFIELD MARKS

"81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:—

"(1) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register).

"(2) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the 1st day of January 1889, in respect of metal goods either in the register established under the Trade Marks Registration Act 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire, or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the 1st day of January 1884, but which have not been entered in either

of the said other registers. [There can be no opposition to an application to register under this section—*Lambert's T. M.* (1889), 6 R. P. C., 344.] And see Form, p. 280.

"(3) An application for registration of a trade mark used on metal goods shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company.

"(4) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner.

"(5) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court.

"(6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day.

"(7) The provisions of this Act and of any general Rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general Rules shall, so far as applicable, be construed accordingly, with the substitution of the

Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the comptroller, the Patent Office, and the Register of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.

"(8) Where the comptroller receives from any person not carrying on business in Hallamshire, or within six miles thereof, an application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company.

"(9) At the expiration of five years from the commencement of this Act, the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned.

"(10) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks.

"(11) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks.

"(12) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm, reverse,

or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court.[1]

"(13) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks—that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791—shall apply to any mark entered in the Sheffield register.

"(14) For the purposes of this section the expression 'metal goods' means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

"(15) For the purpose of legal proceedings, in relation to trade marks entered in the Sheffield register, a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller."

The following are the Rules applying to Sheffield marks:

"56. All applications to the Cutlers' Company for registration of a trade mark, under s. 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

"57. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

"58. (1) The time within which the comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registra-

[1] Form W, p. 278.

tion made to the said Company, shall be one month from the date of the receipt by the comptroller of the notice from the said Company of the making of the application.

"(2) If no such objection is made by the comptroller, the Cutlers' Company shall require the applicant to send the comptroller a wood-block or electrotype as the comptroller may direct, and the comptroller shall, if satisfied with such wood-block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

"(3) The manner in which the comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-s. 8 of s. 81 of the said Acts, shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

"59. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon."

According to the instructions issued by the Patent Office, "applications made to the Cutlers' Company, in pursuance of s. 81 of the Acts, should be made on Form F, the address in the left hand corner to be, 'To the Cutlers' Company, Sheffield,' instead of 'To the Comptroller,' and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

"Each application should be accompanied by an unstamped copy on foolscap paper. See Rule 56.

"Applications sent by post should be addressed—

"The Law Clerk to the Cutlers' Company,
"The Cutlers' Hall, Sheffield."

FEES

THE following fees are payable by virtue of s. 80, and the orders of the Board of Trade made thereunder :—

1. On application to register a trade mark for one or more articles included in one class . .	£0	5	0
2. For registration of a trade mark for one or more articles included in one class . . .	1	0	0
3. For registering a series of trade marks, for every additional representation after the first in each class	0	5	0
4. On appeal from comptroller to Board of Trade —by appellant	1	0	0
5. On notice of opposition for each application opposed—by opponent	1	0	0
6. On hearing by comptroller—by applicant and by opponent respectively	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
8. For every additional mark assigned or transmitted at the same time	0	2	0
9. For continuance of mark at expiration of fourteen years	1	0	0
10. Additional fee, where fee is paid within three months after expiration of fourteen years .	0	10	0
11. Additional fee for restoration of trade mark where removed for non-payment of fee .	1	0	0
12. For altering address on the register for every mark	0	5	0
13. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
14. For cancelling the entry or part of the entry of a trade mark upon the register, on the application of the owner of such trade mark	0	5	0
15. On request to comptroller to correct a clerical error, or permit amendment of application under s. 91	0	5	0
16. For certificate of refusal to register a trade mark under s. 77	1	0	0
17. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first . . .	0	10	

18.	For certificate of registration to be used in legal proceedings	£1	0	0
19.	For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
20.	For certificate of comptroller under s. 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country	0	5	0
21.	For copy of notification of registration	0	2	0
22.	Settling a special case by comptroller	2	0	0
23.	For inspecting register, for every quarter of an hour	0	1	0
24.	For making a search amongst the classified representations of trade marks, for every quarter of an hour	0	1	0
25.	For office copy of documents for every hundred words (but never less than one shilling)	0	0	4
26.	For certifying office copies, MS. or printed	0	1	0
27.	In cases where the wood-block or electrotype of the trade mark exceeds 2 inches in breadth or depth, or in breadth and depth—For every inch or part of an inch over 2 inches in breadth	0	2	0
	For every inch or part of an inch over 2 inches in depth	0	2	0
28.	Manchester Trade Marks Office	Same as above		
29.	Sheffield Marks	Same as above		
30.	On appeal from Cutlers' Company, Sheffield, to comptroller	1	0	0

N.B.—The fees in relation to *registration* will not be received at the Patent Office. They should be paid in exchange for the stamped forms required, which may be obtained as stated on p. 319.

Forms

E.—Form of application for hearing by comptroller.
F.— „ application for registration.
G.— „ additional representation of trade mark.
H.— „ appeal to Board of Trade.
I.— „ transmission of registration fee.
J.— „ notice of opposition.
K.— „ request to enter name of subsequent proprietor of trade mark.
L.— „ request for certificate of refusal.
M.— „ notice of application for alteration of address.
N.— „ notice of order of Court for rectification of register.
O.— „ application to cancel entry on register.
P.— „ declaration in support of application to cancel entry.
Q.— „ request to comptroller for correction of clerical error, or for permission to amend application under s. 91.
R.— „ request for certificate of registration for use in obtaining registration abroad.
S.— „ request for certificate of registration for use in legal proceedings.
T.— „ application for settlement of a special case.
T 1.— „ request for general certificate of comptroller.
U.— „ general certificate of comptroller.
V.— „ request for copy of notification of registration.
W.— „ appeal from Cutlers' Company.
X.— „ application for continuance on register.
Y.— „ transmission of additional fee.
Z.— „ application for restoration to register.
„ application for registration of old corporate trade mark.

N.B.—As to where these Forms may be obtained, see p. 319.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

TRADE MARKS.

FORM E (p. 238)

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER

In cases of Opposition, etc.

SIR,

of (*a*)

(*a*) Here insert full address.

hereby apply to be heard in reference to

and request that I may receive due notice of the day fixed for the hearing.

Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

TRADE MARKS,

FORM F (p. 220)

APPLICATION FOR REGISTRATION OF TRADE MARK

One representation to be fixed within this square, and two others to be sent on separate half sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

You are hereby requested to register the accom-

panying trade mark in Class , in respect of (*a*)

(*a*) Only goods contained in one and the same class should be set out here. A separate application form is required for each separate class.

in the name of (*b*)

(*b*) Here insert legibly the full name, address, and description of the individual firm or company. Add trading style (if any).

who claims to be the proprietor thereof (*c*).

(*c*) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

The essential particulars of the trade mark are the following (*d*)

(*d*) See sub-ss. 2 and 3 of s. 64 of the Acts.

and disclaim any right to the exclusive use of the added matter.

(Signed) (*e*)

(*e*) To be signed by the applicant or by an agent duly authorised.

Dated the day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

(Or where the application is for a mark in Classes 23, 24, or 25.)

To the Comptroller,
Manchester Trade Marks Branch,
48 Royal Exchange, Manchester.

NOTE.—If the trade mark has been in use in respect of the goods since before August 13th, 1875, state length of such user.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM G (p. 224)

ADDITIONAL REPRESENTATION OF TRADE MARK, TO ACCOMPANY APPLICATION FOR REGISTRATION

One representation of the trade mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto.

Two of these ADDITIONAL REPRESENTATIONS of the trade mark must accompany *each* form of application.

In the case of a trade mark claimed in one of the Classes 23 to 35, THREE of these ADDITIONAL REPRESENTATIONS of the mark must accompany the form of application.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM H (p. 231)

FORM OF APPEAL FROM THE COMPTROLLER TO THE BOARD OF TRADE

I, (*a*)
of (*a*)
hereby give notice of my intention to appeal to the Board of Trade from (*b*)

of the comptroller of the day of 18 ,
whereby he (*c*)

(a) Here insert full name and address of appellant.

(b) Here insert "the decision" or that part of the decision as the case may be.

(c) Here insert the decision complained of.

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

(Signed)

Dated day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.
And to
(Name of Respondent to Appeal.)

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM I (p. 242)

FEE FOR REGISTRATION OF A TRADE MARK

SIR,

IN reply to your request, I hereby transmit the prescribed fee for the registration of the trade mark No. in Class .

I am, Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM J (p. 237)

TRADE MARKS.

NOTICE OF OPPOSITION TO APPLICATION FOR REGISTRATION

(To be accompanied by an unstamped duplicate)

In the matter of an application,
No. by
of

* I,

* Here state full name and full address.

hereby give notice of my intention to oppose the registration of the trade mark advertised under the above number for Class in the *Trade Marks Journal* of the day of , 18 , No. , page .

The grounds of opposition are as follows:—

(Signed)

Dated the day of , 18

Address for service:—

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM K (p. 243)

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF TRADE MARK UPON THE REGISTER, WITH DECLARATION IN SUPPORT THEREOF

I, (*a*)

(*a*) *Or* We. Here insert name, full address and description.

hereby request that you will enter (*b*) name (*c*) in the Register of Trade Marks as proprietor of the trade mark No. in Class .

(*b*) My, *or* our.

(*c*) *Or* names.

(*d*) I am, *or* We are.

(*d*) entitled to the said trade mark, and to the goodwill of the business concerned in the goods with respect to which the said trade mark is registered.

(*e*)

(*e*) Here state whether trade mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof, as *e.g.*, "by deed dated the day of 18 , made between So-and-so of the one part."

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said trade mark as above claimed.

(*f*) 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.

(*f*) This paragraph is not required when the declaration is made out of the United Kingdom.

(*g*)

(*g*) To be signed here by the person making the declaration.

Declared at }
this day of 18 }

Before me,

(*h*)

(*h*) Signature and title of the authority before whom the declaration is made

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

TRADE MARKS.

FORM L (pp. 251 and 284)

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A TRADE MARK IN USE BEFORE AUGUST 13, 1875

In the matter of an application for registration of an old Trade Mark, No. in Class

SIR,

I,

of

the applicant in the above matter, hereby request you to furnish me with your Certificate of Refusal to register the said trade mark.

*

* Signature of applicant.

Dated this day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

TRADE MARKS.

FORM M (p. 246)

NOTICE OF APPLICATION FOR ALTERATION OF ADDRESS ON REGISTER OF TRADE MARKS

In the matter of the trade mark, No. registered in Class .

SIR,

NOTICE is hereby given that I

of

the registered proprietor of the trade mark numbered as above, desire that my address on the Register of Trade Marks be altered to

Dated this day of 18

*

* Signature of proprietor.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM N (p. 245)

NOTICE OF ORDER OF COURT FOR ALTERATION OR RECTIFICATION OF REGISTER OF TRADE MARKS

In the matter of the trade mark, No. , registered in Class in the name of

SIR,

NOTICE is hereby given that by an Order of the Court made on the day of 18 , it was directed that the entry on the Register of Trade Marks in respect of the trade mark numbered as above should be rectified in the manner therein specified.

An Office Copy of the Order of Court is enclosed herewith.

Dated this day of 18

*

* To be signed by the person interested or his agent.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM O (p. 246)

FORM OF APPLICATION BY PROPRIETOR OF REGISTERED TRADE MARK TO CANCEL ENTRY ON REGISTER

Trade Mark No. Class advertised in *Trade Marks Journal*, No. , page .

Name of Registered Proprietor or Firm

Place of Business

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 upon the Registry of the Trade

Marks in Class of the trade mark No.
may be cancelled.

The day of 18

(Signed)

This is the statement marked "O" referred to in the Declaration of made before me the of 18

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM P (p. 246)

FORM OF DECLARATION IN SUPPORT OF APPLICATION FOR CANCELLATION OF TRADE MARK BY OWNER

I, of ;
(*or* I, a member of the firm of
of
) do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows:—

(1) The application signed by me, and dated the day of 18 , and marked with the letter "O," and shown to me at the time of making this declaration, is true.

(2) I am the person whose name appears on the Register of Trade Marks as the proprietor of the trade mark referred to in the said application marked with the letter "O."
(*or* my said firm is the firm whose name appears on the Register of Trade Marks as the proprietor of the trade mark referred to in the said application marked with the letter "O.")

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.

(Signed)

Declared at
this day of 18
Before me,

If the declaration be made before a Commissioner to administer oaths it will require to be stamped with a 2s. 6d. impressed Inland Revenue stamp.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM Q (p. 287)

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR PERMISSION TO AMEND APPLICATION UNDER S. 91

SIR,

I HEREBY request that

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM R (p. 290)

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK FOR USE IN OBTAINING REGISTRATION ABROAD

In the matter of the trade mark,
No. , registered in
Class , in the name of

SIR,

I,
of
the registered proprietor of the above trade mark, hereby request you to furnish me with your Certificate of Registration for use in obtaining registration of the same in *

* Here state name of country in which registration is to be sought.

† Signature.

†

Dated this day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM S (p. 290)

TRADE MARKS.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK TO BE USED IN LEGAL PROCEEDINGS

In the matter of the trade mark,
No. , registered in
Class , in the name of

SIR,

I,
of
the registered proprietor of the above trade mark, hereby request you to furnish me with your Certificate of Registration to be used in legal proceedings

*

Dated this day of 18

* Signature.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM T (p. 275)

TRADE MARKS.

APPLICATION FOR SETTLEMENT OF A SPECIAL CASE ON APPLICATION TO REGISTER A TRADE MARK

In the matter of the application
of and
of the application of

SIR,

NOTICE is hereby given that I,
, of ,
and I, ,
of , are unable
to agree upon the facts on which the opinion of the

Court is to be taken, and that we request you to fix a day on which we may attend before you and obtain your finding on the matters of fact to be submitted to the Court as settled.

Dated this day of 18

* To be signed by both parties.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM T 1 (p. 290)

REQUEST FOR GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).

In the matter of the trade mark, No.
in Class

SIR,

I,

of hereby request you to furnish me with your certificate that (a)

(a) Here set out the particulars which the comptroller is requested to certify.

(b)

(b) Signature.

Dated this day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM U (p. 290)

TRADE MARKS.

GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD)

Patent Office, Trade Marks Branch,
London,
18

I,
Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

---

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

TRADE MARKS.

FORM V

REQUEST FOR COPY OF OFFICIAL NOTIFICATION OF REGISTRATION OF TRADE MARK

In the matter of the trade mark,
No. , registered
in Class

SIR,

I,
of the
registered proprietor of the trade mark above named, hereby request that you will furnish me with a copy of the official notification of the registration of the same

* * Signature.

Dated this day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM W (p. 260)

FORM OF APPEAL FROM CUTLERS' COMPANY AT SHEFFIELD TO COMPTROLLER

(To be accompanied by an unstamped duplicate)

SIR,

I HEREBY give notice of appeal against the decision of the Cutlers' Company of Sheffield in regard to my application for registration of a trade mark, No. in Class for and I beg to submit my case * for your decision accordingly.

* The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

† Signature.

†

Dated this day of 18

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

TRADE MARKS.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

FORM X (p. 249)

CONTINUANCE OF MARK AT EXPIRATION OF FOURTEEN YEARS FROM THE DATE OF REGISTRATION

SIR,

IN pursuance of the notice received from you, I hereby transmit the prescribed fee of £1 for continuance on the Trade Marks Register of the trade mark No. , in Class .

Dated the day of 18

* Signature of proprietor.

*

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

TRADE MARKS.

FORM Y (p. 249)

ADDITIONAL FEE OF 10s. TO ACCOMPANY "CONTINUANCE FEE" (FORM X), WITHIN THREE MONTHS AFTER EXPIRATION OF FOURTEEN YEARS

SIR,

IN pursuance of the notices issued by you, and of the provisions of s. 79 (3) of the above Acts, I hereby transmit the additional fee of 10s. (along with Form X) for the continuance on the Trade Marks Register of the trade mark No. , in Class .

Dated the day of 18

*

* Signature of proprietor.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

TRADE MARKS.

FORM Z (p. 250)

RESTORATION OF TRADE MARK WHERE REMOVED FOR NON-PAYMENT OF FEE

(To accompany Form X)

SIR,

IN pursuance of the notices issued by you, and of the provisions of s. 79 (4) of the above Acts, I hereby transmit the additional fee of £1 (along with Form X) for restoration to the Trade Marks Register of the trade mark No. , in Class .

Dated the day of 18

*

* Signature of proprietor.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London, W.C.

Patents, Designs, and Trade Marks Acts 1883 *to* 1888

CORPORATE TRADE MARK.

Application for Registration of Old Corporate Trade Mark (p. 258)

You are hereby requested to register the accompanying old corporate trade mark in Class
in respect of
in the name of
who claims to be the proprietor thereof.

(Signed)

Dated the day of 18

To the Cutlers' Company,
Cutlers' Hall, Sheffield.

PART V

GENERAL

CHAPTER I

GENERAL

Ss. 82 and 83 of the 1883 Act provide for the establishment and maintenance of the Patent Office and the staff, and by s. 101 the Board of Trade have power to make general Rules for regulating the business of the office, etc.

"S. 84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence (*infra*, ss. 88, 89).

"S. 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." [But the Court may order an undertaking limiting the use of the registered property, as in *Mitchell & Co.'s T. M.* (1885), 28 Ch. D., 666.]

"S. 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.

"S. 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 the provisions of this Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, 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."

N.B.—The sections are printed as amended by Act of 1888.

Request.—For a patent, Form L (p. 164), for a design, Form K (p. 206), for a trade mark, Form L (p. 271) should be used.

Assignment.—See s. 16, p. 122, and ss. 23 and 36, p. 145, s. 70, p. 248.

This section does not take away a mortgagor's right of suing for infringement without making his mortgagee party—*Van Gelder & Co.* v. *Sowerby, Bridge, etc.* (1890), 44 Ch. D., 374. A mortgagee is not a "proprietor."

An assignee of a registered trade mark may bring an action without registering the assignment—*Ihlee* v. *Henshaw* (1886), 31 Ch. D., 323.

By ss. 88, 89 any person may inspect any register kept, and may obtain certified and sealed copies or extracts, which are evidence in all Courts in Her Majesty's dominions. For rules, see p. 293.

Rectification.—By s. 90, sub-ss.

"(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."

No Rules have been made under this and the following sections, except as regards trade marks (p. 246). By these Rules (r. 49) four clear days' notice must be given to the comptroller of every application under s. 90. This application, in the case of refusal to register a trade mark, can only be made after the hearing of the appeal by the Board of Trade, or when referred to the Court by the Board—"*Normal*" (1887), 35 Ch. D., 231. In other cases the appeal is direct from the comptroller.

By s. 111 (2), A copy of the order or decree for rectification, made in a Scotch or Irish Court, must be served on the comptroller.

There is no jurisdiction under this section to insert in the register the name of the real owner, the wrong name having been registered by mistake, although the wrong entry may be expunged. The real owner should proceed by a fresh application for registration—*Kingsford & Son's Appln.* (1889), 6 R P C., 413.

"*Person aggrieved.*"—In *Apollinaris Co.'s T. M.* (1891), 2 Ch. 186, the Court of Appeal said:—"The words 'person aggrieved' appear to us to have been introduced into the statute to prevent the action of common informers or of persons interfering from merely sentimental notions, but that they must not be so read as to make evidence of great and serious damage a condition precedent to the right to apply. Whenever one trader, by means of his wrongly registered trade mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, that rival is an 'aggrieved person.' Again, if the effect produced or likely to be produced by the wrongful trade mark is not the exclusion but the hampering of a rival trader, that rival trader is a 'person aggrieved.' A man in the same trade as the one who has wrongfully registered a trade mark, and who desires to deal in the article in question, is *primâ facie* an 'aggrieved person.' This may be rebutted by showing that, by reason of some circumstances entirely independent of the trade mark, the person complaining could never carry on any trade in the article; but the burden of tendering such proof is on the man who claims the mark. . . . When one trader uses the fact of registration as any part of his case against another trader in any legal proceedings, that second trader is aggrieved, and this is not the less so because that trader has other means of defending himself."

It seems that a person who applied for and obtained the entry can hardly complain of its inaccuracy under this section, but a trade agent of the other party to the action may—*Ainslie & Co.'s T. M.* (1887), 4 R. P. C., 212.

Material misrepresentation, even when innocent, will

cause registration to be expunged — *Baker* v. *Rawson* (1890), 45 Ch. D. 519.

Where a change of ownership has taken place, or new interests have been acquired by persons not on the register, the application should be made under s. 87 (*supra*), and not under s. 90.

Amendment Generally.—By s. 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 ;

"(*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 connection with which he has desired the design or trade mark to be registered."

Request.—For a patent, Form P (p. 167) should be used ; for a design, Form M (p. 207) ; for a trade mark, Form Q (p. 274).

By No. 16 of the Patent Rules, No. 30 of the Designs, and No. 54 of the Trade Marks, any document, drawing, sketch, etc., "for the amending of which no special provision is made by the said Act 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 upon such terms as he may direct."

As to the jurisdiction of the Master of the Rolls to amend clerical errors in documents that have become records, see p. 120.

As to amendment of clerical errors in a specification after a patent has been granted, see p. 117.

As to amendment after litigation commenced, see p. 143.

Trade Mark only.—By s. 92, sub-ss.

"(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."

By trade mark Rule No. 51, the proprietor must give the comptroller fourteen days' notice at least. See p. 246.

Whenever the Court makes an order for making, expunging, or varying an entry of a trade mark, the comptroller may advertise the order at the expense of the person applying for it. (R. 50.)

Colman's T. M. (1891), 2 Ch. 402, the words "trade mark" were omitted from a label on terms as to the entry in the register. They had apparently applied to a portion only of a label, thereby designating that portion as essential, and the rest unessential.

As to using the mark with additions, leave of the Court not having been obtained, see p. 218.

The addition of the word "limited" is not an essential particular—*Burke's T. M.*, W. N., 1891, p. 2. Nor is the name of the firm (generally), *Murphy's T. M.* (1890), 7 R. P. C., 163.

Discretionary Power.—By s. 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."

See Patent Rules, 11–13; Designs, 12–14; Trade Marks, 17–19.

The effect of these Rules is that applicant must "require" the opportunity within one month from the date of the comptroller's objection. The comptroller must then give applicant ten days' notice of the hearing. Within five days from the date when such notice would be delivered in the ordinary course of post the applicant must notify the comptroller in writing whether or not he intends to be heard.

In the case of a patent the comptroller may require a statement in writing, or personal attendance, or oral explanations.

His decision must be notified to the applicant.

By s. 95, the comptroller may, in any case of doubt or difficulty, apply to the law officers for directions.

Certificate.—By s. 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."

Patents Certificate, Form Q (p. 168); Designs Form of Request, I (p. 205); Certificate, Form J (both for use in legal proceedings). Trade Marks Form of Request and Certificate for Use in Legal Proceedings, R and S respectively (pp. 274, 275); for General Certificate, T 1 and U respectively (see pp. 276, 277). Trade Mark Rule 60 is as follows:—"The comptroller, when required to give a certificate as to any entry, matter or thing which he is authorised by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate; but every certificate of registration shall have specified on the face thereof, whether the same is to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country."

According to the instructions issued by the Patent Office, "In every case where a certificate is required in respect of a cotton mark, or in respect of any trade mark of which the representations or specimens forming part of the application for registration are *coloured*, or in respect of an application made, or in respect of an application refused, two unmounted copies of the mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the comptroller."

Service.—By s. 97, sub-ss.

"(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."

Patents Rule 16A, Designs 11 (p. 188), Trade Marks 16 (p. 225), are made under this section, and are in the same words. Letters, etc., for the comptroller should be addressed, "The Patent Office, 25 Southampton Buildings, Chancery Lane, W.C." See "Enlargement of Time," p. 293.

Excluded Days.—By s. 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."

Incapacity.—By s. 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."

By s. 100, the Patent Office are to supply copies of accepted specifications, etc., to the Edinburgh Museum of Science and Art, the Enrolments Office of the Chancery Division in Ireland, and the Rolls Office in the Isle of Man within twenty-one days of the acceptance.

Under s. 102, the comptroller publishes an annual report including all general rules made in the year, a classification of the applications, an account of fees, etc.

Board of Trade.—By s. 102A, sub-ss.

"(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."

Dispensing with Evidence.—By Patents Rules 80, Designs 29, Trade Marks 53, "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 of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the Patent 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, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration or evidence."

Enlargement of Time.—By Patents Rules 51 and Trade Marks 55, "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."

Designs Rule 31 is similar.

Inspection of Registers.—By Patents Rules 78, Trade Marks 52, "The Register of Trade Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week-day, between the hours of ten and four, except on the days and at the times following:—

"(*a*) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

"(*b*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

"(*c*) Times when the register is required for any purpose of official use."

Declarations.—By Patents Rules 11, Trade Marks 61, "The statutory declarations required by the Acts and these Rules, or used in any proceedings thereunder, 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 Her 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 Her 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."

By Patents Rule 17 (A), "Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall, so far as possible, be confined to one subject."

By Trade Marks Rule 62, "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 or 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."

By s. 107, the provisions with respect to the aid of

an assessor and trial without a jury are applied to Scotland.

By s. 108, summary proceedings in Scotland may be prosecuted in the Sheriff's Court.

S. 112 preserves the jurisdiction of the Manx Courts, and makes the maximum punishment for a misdemeanour in the Isle of Man imprisonment with hard labour for two years, with a fine of £100.

By s. 112*a*, the Court of Chancery of the County Palatine of Lancaster is given jurisdiction "with respect to any action or other proceeding in relation to *trade marks*, the registration whereof is applied for in the Manchester office." Except in this case there is no jurisdiction to try an action in the Court of the County Palatine—*Proctor* v. *Sutton Lodge, etc., Co.* (1888), 5 R. P. C., 184, nor in a County Court—*Reg.* v. *Judge of Halifax, etc.* (1891), 2 Q. B., 263.

Offences.—By s. 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 misdemeanour."

S. 105, sub-ss.

"(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 £5.

"(2) A person shall be deemed, for the purposes 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.

"S. 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 £20."

And see the Merchandise Marks Act 1887, in Appendix.

A person who has applied for a patent is liable to be fined if he sells an article as patented before the patent is granted—*Reg.* v. *Wallis* (1886), 3 R. P. C., 1; *Reg.* v. *Crampton* (1886), 3 R. P. C., 367.

CHAPTER II

INTERNATIONAL AND COLONIAL ARRANGEMENTS

THE Act of 1883, as amended by that of 1885, enacts as follows :—

"S. 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 application 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."

"S. 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."

The International Convention for the Protection of Industrial Property was signed in Paris on the 20th of March 1883, and was assented to by the Government of Great Britain on the 17th of March 1884.

The above s. 103, by limiting the time within which the foreign monopolies may be registered in England, excluded a large number from protection (see *In re Californian Fig Syrup Co.'s Trade Mark* (1888), 40 Ch. D., 620) in consequence of the delay which took place before the accession of Great Britain. In other respects the Act carries out the terms of the Convention.

A foreign patentee has two rights: either that under s. 103, in which case his patent will be dated as on the day of the foreign application; or as an importer under the general law. In the latter case he risks prior publication in this country, and s. 103, sub-s. 2, does not protect him. The date of his English patent will be conclusive as to which right he has adopted—*British Tanning Co.* v. *Groth* (1891), 8 R. P. C., 113.

Date.—The date of the renewed application abroad (if any), and not of the original, is the proper date for the English patent—*Van de Poele's P.* (1890), 7 R. P. C., 69.

Applicant is entitled to have his patent dated as on the day of the foreign application, although his country had not then acceded to the Convention—*Main's P.* (1890), 7 R. P. C., 13.

It should be noticed that the foreign patentee is the only person who can apply under s. 103 for a patent in Great Britain. He cannot part with the right to another. A corporation may apply, see *Carez' Appln.* (1889), 6 R. P. C., 552. See "Importation," pp. 96, 221.

The following are the Rules referring to applications under ss. 103, 104.

"24. The term 'foreign application' shall mean an application by any person for protection of his invention in a foreign State or British possession to which, by any Order of Her Majesty in Council for the time being in force, the provisions of s. 103 of the Patents, Designs, and Trade Marks Act 1883 have been declared applicable.

"25. An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify all the foreign States or British possessions in which foreign applications have been made and the official date or dates thereof respectively. The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

"26. The application in the United Kingdom shall be made in the Form A^2 in the second schedule to these Rules,[1] and in addition to the specification, provisional or complete, left with such application must be accompanied by :—

"(1) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign State or British possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such foreign State or British Possessions

[1] See p. 157.

as aforesaid, or otherwise verified to the satisfaction of the comptroller.

"(2) A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made; and if the specification or document corresponding thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

"27. On receipt of such application, together with the prescribed specification and the other document or documents accompanying the same, required by the last preceding Rule, and with such other proof (if any) as the comptroller may require of or relating to such foreign application, or of the official date thereof, the comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

"28. All further proceedings in connection with such application shall be taken within the times, and in the manner prescribed by the Acts or Rules for ordinary applications.

"29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

"S. 117 contains *inter alia* the following definitions:—

"'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."

The author is indebted to Mr. Alexander Pulling of the Inner Temple for the following list of arrangements and Orders in Council made under s. 103:—

(*a*) Colonial Arrangements

1885, Sept. 17.—O. in C. applying the provisions of 46 and 47 Vict., c. 57, s. 103, to Queensland *Lond. Gaz.* Sept. 22, 1885, p. 4429.

1890, Feb. 8.—O. in C. applying the provisions of 46 and 47 Vict., c. 57, s. 103, to New Zealand *Lond. Gaz.* Feb. 11, 1890, p. 727.

(*b*) International Arrangements

The following is a List of the O. in C. issued under these powers and now (Nov. 1, 1890) in force applying the provisions of 46 and 47 Vict., c. 57, s. 103, to foreign States:—

Foreign State	Date of O. in C.	Reference to *Lond. Gaz.* in which O. in C. is published				Reference to Horts. Treaties where O. in C. is published	
		Month	Day of the Month	Year	Page	Vol.	Page
Belgium	June 26, 1884	July	1	1884	2993	17	504
Brazil	June 26, 1884	July	1	1884	2993	17	504
Dominican Republic	Oct. 21, 1890	Oct.	28	1890	5661	—	—
France	June 26, 1884	July	1	1884	2993	17	504
Guatemala	June 26, 1884	July	1	1884	2993	17	504
Italy	June 26, 1884	July	1	1884	2993	17	504
Mexico	May 28, 1889	May	31	1889	2954	—	—
Netherlands	June 26, 1884	July	1	1884	2993	17	504
Netherlands, East Indian Colonies	Nov. 17, 1888	Nov.	23	1888	6412	—	—
Netherlands (Curaçoa, Surinam, etc.)	May 17, 1890	May	20	1890	2891	—	—
Paraguay	Sept. 24, 1886	Sept.	28	1886	4725	17	859
Portugal	June 26, 1884	July	1	1884	2993	17	504
Servia	June 26, 1884	July	1	1884	2993	17	504
Spain	June 26, 1884	July	1	1884	2993	17	504
Sweden and Norway	July 9, 1885	July	—	1885	3173	17	108
Switzerland	June 26, 1884	July	1	1884	2993	17	504
Tunis	June 26, 1884	July	1	1884	2993	17	504
United States	July 12, 1887	July	15	1887	3827	17	1071
Uruguay	Sept. 24, 1886	Sept.	28	1886	4725	17	859

(c) Places under British Jurisdiction

(i.) *Africa.* 1889, Oct. 15.—O. in C. (Art. 55) imposing penalties on British subjects committing offences in Madagascar and certain parts of Africa against the Patents, etc., Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Oct. 22, 1889, p. 5557.

(ii.) *Morocco.* 1889, Nov. 28.—O. in C. (Art. 112), imposing penalties on British subjects committing offences in Morocco against the Patents, etc., Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Dec. 13, 1889, p. 7163.

(iii.) *Persia.* 1889, Dec. 13.—O. in C. (Art. 292) imposing penalties on British subjects committing offences in Persia against the Patents, etc., Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Dec. 24, 1889, p. 7417.

(iv.) *Persian Coast.* 1889, Dec. 13.—O. in C. (Art. 50) imposing penalties on British subjects committing offences within the Persian Coast and islands against the Patents, etc., Acts, 1883-1888, and the O. in C. issued thereunder *Lond. Gaz.* Dec. 24, 1889, p. 7459.

(v.) *Somali Coast.* 1889, Dec. 13.—O. in C. (Art. 4) imposing penalties on British subjects committing offences on the Somali Coast against the Patents Acts, 1883-1888, and the O. in C. issued thereunder . . . *Lond. Gaz.* Dec. 24, 1889, p. 7467.

N.B.—It is doubtful whether the Orders in Council, which apply to "places under British Jurisdiction," are valid, as there seems no power to make them either under this Act or the Foreign Jurisdiction Acts. The power seems to have been assumed under s. 2 of the Act of last session, 53 and 54 Vict., c. 37.

The eighth report of the Comptroller-General (c. 6359) states that—

"A Conference of Delegates from States forming the Union was held in Madrid in the month of April, upon which occasion draft projects were agreed to relating—(1) to the repression of false indications of origin; (2) to the establishment of an international register of trade marks; and (3) to the interpretation to be placed upon certain Articles of the International Convention of 1883.

"These projects were subsequently submitted for the consideration of the Governments of the respective States."

PART VI

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TRADE NAME
TRADE SECRETS

CHAPTER I

TRADE NAME

No man may sell his goods as the goods of another, or another's goods as his own; but, subject to qualifications mentioned below, there is no law to prevent a man trading in his own or an assumed name next door to the establishment of another trader who deals in the same class of goods. See the Merchandise Marks Act 1887, Appendix.

But where a trader has acquired a reputation—see *Goodfellow* v. *Prince* (1887), 35 Ch. D., 9—for his goods, in connection with his name or firm name, other considerations apply—*Jay* v. *Ladler* (1888), 40 Ch. D., 649. Then, if a man without leave sells similar goods in such a way as to induce reasonable people to believe that his goods are manufactured by the established trader, or that he is his successor in business, or that his is the only genuine article, or that the articles made by the other firm are spurious, he is liable to an injunction. Such a sale is fraudulent.

A wholesale vendor cannot escape from an injunction by showing that he cautioned his shop assistants and agents to say that the goods sold by him are not those of the plaintiff, for the retail dealers would sell to the public without any such qualification—*Chappell* v. *Davidson*

(1855), 2 K. and J., 123. In each case evidence must be produced from which the fraudulent intent may be inferred, *e.g.* the assumption of a name the same as or similar to that of the established trader, the trading in the same neighbourhood, the advertising of the goods, the colour, design, and shape of packages.

In *Thomas Turton & Sons* v. *Turton* (1889), 42 Ch. D., 128, Thomas Turton & Sons sought to prevent the defendants from trading as John Turton & Sons. It was proved that the defendant's firm did in fact consist of John Turton and his two sons, and no allegation of fraudulent use of the name was made. Lord Esher, M.R., said: "It is perfectly clear that if all that a man does is to carry on the same business, and to state how he is carrying it on, that statement being the simple truth, and he does nothing more with regard to the respective names, he is doing no wrong."

In the case of an assumed name, the very assumption of a name likely to be confused with the plaintiff's is good evidence of fraud; and it is not in a strong case necessary to wait and see if the assumption of the name does in fact injure the plaintiff's; for, if the Court can see from the nature of the case that injury is probable, an injunction will be granted, but not damages, unless injury is proved to have actually occurred. If the defendant continues the offending name or mark after being warned of the similarity, this would be strong evidence of fraud.

It often happens that goods have a distinctive name attached to them other than the name of the manufacturing firm, by which the public know by whom they are manufactured or sold. In this case the man whose goods have so acquired a reputation, in connection with the distinctive trade name attached to them, has a right to protect himself from the fraudulent appropriation of that trade name by

another trader in the same or similar class of goods. See *Goodfellow* v. *Prince* (1887), 35 Ch. D., 9. But mere similarity of name is not sufficient ground for an injunction, unless damage to the plaintiff be clearly proved, or the name is so closely similar as to be a colourable imitation of the plaintiff's—*Borthwick* v. *The Evening Post*, 37 Ch. D., 449.

The trade name must be proved to have been used in connection with the business and with the goods. Where the name to be protected is used in connection with special goods, proof should be adduced that it was affixed to the goods, or at least impressed on the wrappers or labels of the goods. Even a geographical name, *e.g.* "Stone" ale, used for ale manufactured by the plaintiff at Stone, will be protected from a similar name, adopted by the defendant, a new brewer at the same place—*Joule's T. M.*, *Thompson* v. *Montgomery* (1891), A. C., 217.

But where this trade name is merely descriptive of the article, whether originally a descriptive name or not, and does not designate manufacture by any particular firm, it cannot longer be exclusively retained by the original maker, but may be adopted by any other trader. See, *inter alia*, *Native Guano Co.* v. *Sewage Manure Co.* (1887), 4 R. P. C., 473.

Lever v. *Goodwin* (1887), 4 R. P. C., 492, is instructive in showing that a defendant adopting the trade name and imitating the "get up" of the plaintiff's goods, may be liable on the ground of fraud, though the plaintiff has no exclusive right to the name. See, too, *Great Tower, etc., Co.* v. *Langford* (1888), 5 R. P. C., 66; and *Hart* v. *Colley* (1890), 7 R. P. C., 93.

The name of a place of business may denote that it belongs to the plaintiff, and, if so, will be protected. Of

course, evidence of reputation must be given to show the connection in the mind of the public between the name and the plaintiff—*Bodega Co.* v. *Owens* (1890), 7 R. P. C., 31.

A manufacturer living outside the jurisdiction of English municipal law may protect his trade name from fraud committed in England—*Somerville* v. *Schembri* (1887), 12 App. Cas., 453.

On the sale of the goodwill of a business, the right to use the trade name attached to the class of goods sold passes to the purchaser in the absence of special agreement; and it seems that the right to use the firm name passes also, subject to this reservation, that the purchaser must not lead the public to believe that the vendor is still carrying on the business. It must be remembered that goodwill can only be assigned in connection with a place of business—*Levy* v. *Walker* (1879), 10 Ch. D., 436.

In *Thynne* v. *Shove* (1890), 45 Ch. D., 577, Stirling (J.) decided that the purchaser can use the seller's name only "so long and so far as he does not, by so doing, expose him to any liability, but no further."

On the other hand, the vendor, in the absence of special agreement, has the right of setting up a similar business in the same neighbourhood, and may solicit old customers, but may not hold himself out as continuing the business which he has sold. Of course, he may not use the trade names with which he has parted—*Vernon* v. *Hallam* (1886), 34 Ch. D., 748.

A man may advertise the fact that he has been in the employ of a certain firm, but he has no right to induce the public to believe that he is carrying on the business of that firm, or is conducting a branch of it, if such is not the fact. Nor, it seems, may he advertise that he has been a manager when he has held only a subordinate

position. See *Boswell* v. *Mathie* (1884), Dec. Ct. Ses., 4th Ser., xi. p. 1072.

The Court will not protect from mere inconvenience, where there is no attempt to interfere with trade, and no legal injury done. Messrs. Street & Co. were unable to get an injunction against the Union Bank of Spain and England for using as a telegraphic address, "Street, London," they not representing themselves to be Street and Co., or carrying on the same or any business that could interfere with the plaintiff's trade. It is like the case of several people being called by the same name—*Street* v. *Union Bank* (1885), 30 Ch. D., 156.

It was apparently held in *Bass* v. *Laidlaw* (1886), Dec. Ct. Ses., 4th Ser., xiii. p. 898, that "Bass" was so much a synonym for ale, that the keeper of railway refreshment rooms, doing a quick trade, would not be liable to an interdict for supplying other ale when "Bass" was demanded. And in another public-house case—*Thomson & Co.* v. *Robertson* (1888), Dec. Ct. Ses., 4th Ser., p. 880—where other Irish whisky had been served when the plaintiff's was asked for, Lord Young said: "A case of this kind is not to be established by evidence of a few petty instances of the wrong use of a dealer's name, but upon proof of a continued and systematic course of fraudulent representation and dealing."

N.B.—Trade marks, which cannot be registered as not fulfilling the conditions of s. 64, may be protected on the same ground as trade name.

By the Companies' Act 1862 (25 and 26 Vict., c. 89), s. 20, it is enacted that "No company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being

dissolved, and testifies its consent in such manner as the registrar requires." Power is given to a company to change its name, if inadvertently registered.

The most recent case under this section was one in which the proprietors of Madame Tussaud's Waxwork Exhibition were plaintiffs, they trading as a company under the name of "Madame Tussaud & Sons, Limited." Louis Tussaud and his friends promoted a company which they proposed to register as "Louis Tussaud, Limited," for the purpose of starting and carrying on a business similar to that of the plaintiff company. An injunction was granted. It seems, however, that if Louis Tussaud had actually traded under his own name, and transferred his business to the company, the Court would not have interfered—*Tussaud* v. *Tussaud* (1890), 44 Ch. D., 678. A name, apart from a business, is not saleable. See *Melachrino & Co.* v. *Melachrino Cigarette Co.* (1887), 4 R. P. C., 215.

CHAPTER II

TRADE SECRETS

THERE are some manufactures that are better protected by their processes being kept secret than by being the subject of a patent. Thus quack medicines, cordials, special concocted beverages, etc., usually bring profit to their owner by secrecy of their composition. It is probable that in most cases no patent could be obtained for them.

A trade secret is protected by the injunction of the Court of Chancery whenever a person, in breach of contract or of confidence, threatens to disclose the secret, or to utilise the knowledge of it for his own advantage, by manufacturing the article. Thus an employé who surreptitiously obtained a recipe, as in *Yovatt* v. *Winyard* (1820), 1 J. & W., 394; a partner and his innocent assignee for value, as in *Morison* v. *Moat* (1851), 9 Hare, 241, have been restrained. And in *Green* v. *Folyam* (1823), 1 S. & S., 398, one of several beneficiaries under a will was ordered to account for profits made through breach of confidence towards the other beneficiaries. It should be remembered that anyone may discover a trade secret, and use it to his own advantage, so that it be done honestly, *i.e.* not in breach of confidence or contract, expressed or implied. Not even a partner or ex-partner can be

restrained in the absence of these essentials; and the existence of the partnership is no ground for implying a contract of secrecy, at any rate after its dissolution—*Morison* v. *Moat* (*supra*).

But a person becoming innocently possessed of a trade secret must not use means to induce the public to believe that his production is made by the inventor, or that it is the only genuine article, or that he is the successor in business of the inventor. Similarity in name, in advertisements, in packages, etc., are all to be taken into consideration in determining whether the law has been broken by the newer trader. See *Massam* v. *Thorley's Cattle Food Co.* (1880), 14 Ch. D., 748.

As to "patent medicines," see p. 84.

PART VII

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APPENDIX

PATENT FORMS

THE following information is circulated by the Patent Office :—

Forms A, A1, A2, B, and C are not supplied by the Patent Office, but may be obtained at a few days' notice, through any Money Order Office in the United Kingdom, upon prepayment of the value of the stamp. Forms A, B, and C are kept on sale at the under-mentioned places :—

The Inland Revenue Office, Royal Courts of Justice (Room No. 6).

The following Post Offices.

London General Post Office, E.C.
District Post Office, 226 Commercial Road, E.
" " 9 Blackman Street, Borough, S.E.
" " Charing Cross, W.C.
" " Lombard Street, E.C.
" " 28 Eversholt St., Camden Town, N.W.
Post Office, 12 Parliament Street, S.W.

ENGLAND AND WALES

Accrington.
Altrincham.
Ashton-under-Lyne.
Barnsley.
Barrow-in-Furness.
Bath.
Bedford.
Beverley.
Birkenhead.
Birmingham.
Blackburn.
Bolton.
Bradford.
Brighton.
Bristol.
Bromsgrove.
Burnley.
Burslem.
Burton-on-Trent.
Bury.
Cambridge.
Cardiff.
Carlisle.
Chatham.
Chester.
Clitheroe.
Congleton.
Coventry.
Crewe.
Croydon.
Darlaston.
Derby.
Dewsbury.
Doncaster.
Dorchester.
Driffield.
Droitwich.
Dudley.
Durham.

Exeter.
Gateshead.
Goole.
Greenwich.
Guildford.
Halifax.
Hartlepool.
Huddersfield.
Hull.
Ipswich.
Keighley.
Kendal.
Kidderminster.
Knaresbro'.
Knutsford.
Lancaster.
Leamington.
Leeds.
Leicester.
Lichfield.
Lincoln.
Liverpool.
Macclesfield.
Manchester.
Middlesborough.
Nantwich.
Newcastle.
Newport (Mon.).
Northallerton.
Northampton.
Nottingham.
Nuneaton.
Oldbury.
Oldham.
Patrington.
Plymouth.
Pontefract.
Portsmouth.
Prescot.
Preston.
Reading.
Redditch.
Richmond (Yorks).
Ripon.
Rochdale.
Rotherham.
Rugby.
Salford.
St. Helens.
Scarborough.
Sedgeley.
Sheffield.
Southampton.
Stafford.
Stalybridge.
Stockport.
Stoke-on-Trent.
Stourbridge.
Stourport.
Sunderland.
Swansea.
Tamworth.
Truro.
Tunstall.
Wakefield.
Walsall.
Warrington.
Wednesbury.
West Bromwich.
Whitby.
Widnes.
Wigan.
Wolverhampton.
Wolverton.
Woolwich.
Worcester.
York.

SCOTLAND

Aberdeen.
Dumbarton.
Dundee.
Edinburgh.
Glasgow.
Greenock.
Inverness.
Lanark.
Leith.
Paisley.
Perth.
Renfrew.

IRELAND

Belfast.
Cork.
Dublin.
Dundalk.
Galway.
Limerick.
Londonderry.
Waterford.
Wexford.

In addition to Forms A, A1, B and C, the following Patent Forms can be purchased at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), or they can be obtained at a few days' notice through any Money Order Office in the United Kingdom upon prepayment of the value of the stamp (pp. 151–152):—

D, E, F, G, H, I, J, K, L, M, N, O, P, Q, R, S, T, U, V.

These Forms are set out on pp, 153–170.

Trade Mark and Designs Forms,

ready stamped, can be obtained at the same offices as patent forms, with the exception of Worcester.

NOTE.—*Arrangements have also been made by which any of the Forms required may be ordered at any Money Order Office in the United Kingdom not included in the above list.*

The following is a list of the stamped Forms under the Patents, Designs, and Trade Marks Acts, 1883–1888, which relate to trade marks and designs:—

TRADE MARKS: Forms E, F, G, H, I, J, K, L, M, N, O, Q, R, S, T, T[1], V, W, X. Y, Z.

Of the above Forms, those bearing the letters F, G, I, X, Y, and Z are kept in stock at the various offices named above. Any of the others when required must be bespoken. These Forms are set out on pp. 264–280; the Fees on p. 262.

DESIGNS: Forms E, E, F, H, I, K, K, L, M, N, O.

N.B.—Forms E and O are kept on sale at the places above. The other Forms must be bespoken of the postmasters at those places. These Forms are set out on pp. 202–208; the Fees on p. 201.

MERCHANDISE MARKS ACT 1887

CHAPTER 28

An Act to consolidate and amend the Law relating to Fraudulent Marks on Merchandise [23*rd August* 1887]

(*N.B.*—Immaterial sections are omitted)

Short title.

1. This Act may be cited as the Merchandise Marks Act, 1887.

Offences as to trade marks and trade descriptions.

2.[1] (2) Every person who—

(*a*) forges any trade mark; or

(*b*) falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive; or

(*c*) makes any die, block, machine, or other instrument for the purpose of forging, or of being used for forging, a trade mark; or

(*d*) applies any false trade description to goods; or

(*e*) disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade mark; or

(*f*) causes any of the things above in this section mentioned to be done;—

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

(3) Every person who sells, or exposes for, or has in

[1] Under this section it was held, in *Slarey* v. *Chilworth Gunpowder Co.* (1889), 24 Q. B. D., 90, that the defendants were liable to conviction for having supplied the Government with German powder instead of powder of their own manufacture, and in spite of the substituted powder being of as good quality. The offence consists in supplying an article of different description (*d*) from that ordered. In *Wood* v. *Burgess* (1889), 24 Q. B. D., 162, the same point was raised, and it was decided that the defendant could not be held to have "acted innocently" in sending out for sale his own mineral waters in bottles which were the property of and moulded with the name of Wood, although he did not in fact intend to defraud.

his possession for, sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark or mark so nearly resembling a trade mark as to be calculated to deceive is falsely applied, as the case may be, shall, unless he proves—

(*a*) That having taken all reasonable precautions against committing an offence against this Act, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(*b*) That on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or

(*c*) That otherwise he had acted innocently;—

be guilty of an offence against this Act.

(3) Every person guilty of an offence against this Act shall be liable—

(i) on conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and

(ii) on summary conviction to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding £20; and in the case of a second or subsequent conviction to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding £50; and

(iii) in any case, to forfeit to Her Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

(4) The Court before whom any person is convicted under this section may order any forfeited articles to be destroyed or otherwise disposed of as the Court thinks fit.

(5) If any person feels aggrieved by any conviction made by a Court of summary jurisdiction, he may appeal therefrom to a Court of quarter sessions.

(6) Any offence for which a person is under this Act liable to punishment on summary conviction may be prosecuted, and any articles liable to be forfeited under this Act by a Court of summary jurisdiction may be forfeited,

42 and 43 Vict., c. 49.

in manner provided by the Summary Jurisdiction Acts: Provided that a person charged with an offence under this section before a Court of summary jurisdiction shall, on appearing before the Court, and before the charge is gone into, be informed of his right to be tried on indictment, and if he requires be so tried accordingly.

Definitions. 46 and 47 Vict., c. 57.

3. (1) For the purposes of this Act—

The expression "trade mark" means a trade mark registered in the Register of Trade Marks kept under the Patents, Designs, and Trade Marks Act 1883, and includes any trade mark which, either with or without registration, is protected by law in any British possession or foreign State to which the provisions of the 103rd section of the Patents, Designs, and Trade Marks Act 1883 are, under Order in Council, for the time being applicable:

The expression "trade description" means any description, statement, or other indication, direct or indirect,—

(*a*) as to the number, quantity, measure, gauge, or weight of any goods; or

(*b*) as to the place or country in which any goods were made or produced; or

(*c*) as to the mode of manufacturing or producing any goods; or

(*d*) as to the material of which any goods are composed; or

(*e*) as to any goods being the subject of an existing patent, privilege, or copyright;—

and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the above matters, shall be deemed to be a trade description within the meaning of this Act:

The expression "false trade description" means a trade description which is false in a material respect as regards the goods to which it is applied, and includes every alteration of a trade description, whether by way of addition, effacement, or otherwise, where that alteration makes the description false in a material respect; and the fact that a trade description is a trade mark, or part of a trade mark, shall not prevent such trade description being a false trade description within the meaning of this Act:

The expression "goods" means anything which is the subject of trade, manufacture, or merchandise:

The expressions "person," "manufacturer, dealer, or trader," and "proprietor," include any body of persons, corporate or unincorporate:

The expression "name" includes any abbreviation of a name.

(2) The provisions of this Act respecting the application of a false trade description to goods shall extend to the application to goods of any such figures, words, or marks, or arrangement or combination thereof, whether including a trade mark or not, as are reasonably calculated to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose manufacture or merchandise they really are.

(3) The provisions of this Act respecting the application of a false trade description to goods, or respecting goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in like manner as if such name or initials were a trade description; and, for the purpose of this enactment, the expression false name or initials means, as applied to any goods, any name or initials of a person which,—

(*a*) are not a trade mark, or part of a trade mark; and

(*b*) are identical with, or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of such name or initials; and

(*c*) are either those of a fictitious person or of some person not *bonâ fide* carrying on business in connection with such goods.

Forging trade mark.

4. A person shall be deemed to forge a trade mark who either—

(*a*) without the assent of the proprietor of the trade mark, makes that trade mark, or a mark so nearly resembling that trade mark as to be calculated to deceive; or

(*b*) falsifies any genuine trade mark, whether by alteration, addition, effacement, or otherwise ;—

and any trade mark or mark so made or falsified is in this Act referred to as a forged trade mark.

Provided that in any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.

Applying *marks and* descriptions.

5. (1) A person shall be deemed to apply a trade mark or mark or trade description to goods who—

(*a*) applies it to the goods themselves ; or

(*b*) applies it to any covering, label, reel, or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade, or manufacture ; or

(*c*) places, encloses, or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade, or manufacture, in, with, or to any covering, label, reel, or other thing to which a trade mark or trade description has been applied ; or

(*d*) uses a trade mark or mark or trade description in any manner calculated to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark or mark or trade description.

(2) The expression "covering" includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper ; and the expression "label" includes any band or ticket.

A trade mark, or mark, or trade description, shall be deemed to be applied whether it is woven, impressed, or otherwise worked into, or annexed, or fixed to the goods, or to any covering, label, reel, or other thing.

(3) A person shall be deemed to falsely apply to goods a trade mark or mark, who, without the assent of the proprietor of a trade mark, applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive ; but in any prosecution for falsely applying a trade mark or mark to goods, the burden of proving the assent of the proprietor shall lie on the defendant.

Exemption of certain persons employed in ordinary course of business.

6. Where a defendant is charged with making any die, block, machine, or other instrument for the purpose of forging, or being used for forging, a trade mark, or with falsely applying to goods any trade mark, or any mark so nearly resembling a trade mark as to be calculated to deceive, or with applying to goods any false trade description, or causing any of the things in this section mentioned to be done, and proves,—

(*a*) That in the ordinary course of his business he is employed, on behalf of other persons, to make dies, blocks, machines, or other instruments for making, or being used in m. .ing, trade marks, or as the case may be to apply marks or descriptions to goods, and that in the case which is the subject of the charge he was so employed by some person resident in the United Kingdom, and was not interested in the goods by way of profit or commission dependent on the sale of such goods; and

(*b*) That he took reasonable precautions against committing the offence charged; and

(*c*) That he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(*d*) That he gave to the prosecutor all the information in his power with respect to the persons on whose behalf the trade mark, mark, or description was applied;—

he shall be discharged from the prosecution, but shall be liable to pay the costs incurred by the prosecutor, unless he has given due notice to him that he will rely on the above defence.

Application of Act to watches.

7. Where a watch case has thereon any words or marks which constitute, or are by common repute considered as constituting, a description of the country in which the watch was made, and the watch bears no description of the country where it was made, those words or marks shall *primâ facie* be deemed to be a description of that country within the meaning of this Act, and the provisions of this Act with respect to goods to which a false trade description has been applied, and with respect to selling or exposing for, or having in possession for sale, or any purpose of trade or manufacture, goods with a

false trade description, shall apply accordingly, and for the purposes of this section the expression "watch" means all that portion of a watch which is not the watch case.

Mark on watch case.

8. (1) Every person who after the date fixed by Order in Council sends or brings a watch case, whether imported or not, to any assay office in the United Kingdom for the purpose of being assayed, stamped, or marked, shall make a declaration declaring in what country or place the case was made. If it appears by such declaration that the watch case was made in some country or place out of the United Kingdom, the assay office shall place on the case such a mark (differing from the mark placed by the office on a watch case made in the United Kingdom), and in such a mode as may be from time to time directed by Order in Council.

(2) The declaration may be made before an officer of an assay office, appointed in that behalf by the office (which officer is hereby authorised to administer such a declaration), or before a justice of the peace, or a commissioner having power to administer oaths in the Supreme Court of Judicature in England or Ireland, or in the Court of Session in Scotland, and shall be in such form as may be from time to time directed by Order in Council.

(3) Every person who makes a false declaration for the purposes of this section shall be liable, on conviction on indictment, to the penalties of perjury, and on summary conviction to a fine not exceeding twenty pounds for each offence.

Trade mark, how described in pleading.

9. In any indictment, pleading, proceeding, or document, in which any trade mark, or forged trade mark, is intended to be mentioned, it shall be sufficient, without further description and without any copy or facsimile, to state that trade mark, or forged trade mark, to be a trade mark or forged trade mark.

Rules as to evidence.

10. In any prosecution for an offence against this Act—

(1) A defendant, and his wife or her husband, as the case may be, may, if the defendant thinks fit, be called

as a witness, and, if called, shall be sworn and examined, and may be cross-examined and re-examined in like manner as any other witness.

(2) In the case of imported goods, evidence of the port of shipment shall be *primâ facie* evidence of the place or country in which the goods were made or produced.

Punishment of accessories.

11. Any person who, being within the United Kingdom, procures, counsels, aids, abets, or is accessory to the commission, without the United Kingdom, of any act, which, if committed in the United Kingdom, would under this Act be a misdemeanour, shall be guilty of that misdemeanour as a principal, and be liable to be indicted, proceeded against, tried, and convicted in any country or place in the United Kingdom in which he may be, as if the misdemeanour had been there committed.

Search warrant.

12. (1) Where, upon information of an offence against this Act, a justice has issued either a summons requiring the defendant charged by such information to appear to answer to the same, or a warrant for the arrest of such defendant, and either the said justice, on or after issuing the summons or warrant, or any other justice, is satisfied by information on oath that there is reasonable cause to suspect that any goods or things by means of, or in relation to which such offence has been committed are in any house or premises of the defendant, or otherwise in his possession or under his control in any place, such justice may issue a warrant under his hand, by virtue of which it shall be lawful for any constable named or referred to in the warrant, to enter such house, premises, or place at any reasonable time by day, and to search there for and seize and take away those goods or things; and any goods or things seized under any such warrant shall be brought before a Court of summary jurisdiction for the purpose of its being determined whether the same are or are not liable to forfeiture under this Act.

(2) If the owner of any goods or things which, if the owner thereof had been convicted, would be liable to forfeiture under this Act, is unknown or cannot be found, an information or complaint may be laid for the purpose

only of enforcing such forfeiture, and a Court of summary jurisdiction may cause notice to be advertised stating that, unless cause is shown to the contrary at the time and place named in the notice, such goods or things will be forfeited; and at such time and place the Court, unless the owner or any person on his behalf, or other person interested in the goods or things, shows cause to the contrary, may order such goods or things or any of them to be forfeited.

(3) Any goods or things forfeited under this section, or under any other provision of this Act, may be destroyed or otherwise disposed of, in such manner as the Court by which the same are forfeited may direct; and the Court may, out of any proceeds which may be realised by the disposition of such goods (all trade marks and trade descriptions being first obliterated), award to any innocent party any loss he may have innocently sustained in dealing with such goods.

Extension of 22 and 23 Vict., c. 17, to offences under this Act.

13. The Act of the session of the twenty-second and twenty-third years of the reign of Her present Majesty, chapter seventeen, intituled "An Act to prevent vexatious indictments for certain misdemeanours," shall apply to any offence punishable on indictment under this Act, in like manner as if such offence were one of the offences specified in section one of that Act, but this section shall not apply to Scotland.

Costs of defence or prosecution.

14. On any prosecution under this Act the Court may order costs to be paid to the defendant by the prosecutor, or to the prosecutor by the defendant, having regard to the information given by and the conduct of the defendant and prosecutor respectively.

Limitation of prosecution.

15. No prosecution for an offence against this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the first discovery thereof by the prosecutor, whichever expiration first happens.

Prohibition on importation.

16. Whereas it is expedient to make further provision for prohibiting the importation of goods which, if sold,

would be liable to forfeiture under this Act; be it therefore enacted as follows:—

(1) All such goods, and also all goods of foreign manufacture bearing any name or trade mark being or purporting to be the name or trade mark of any manufacturer, dealer or trader in the United Kingdom, unless such name or trade mark is accompanied by a definite indication of the country in which the goods were made or produced, are hereby prohibited to be imported into the United Kingdom, and, subject to the provisions of this section, shall be included among goods prohibited to be imported as if they were specified in s. 42[1] of the Customs Consolidation Act 1876. 39 and 40 Vict., c. 36.

17. On the sale or in the contract for the sale of any goods to which a trade mark or mark, or trade description has been applied, the vendor shall be deemed to warrant that the mark is a genuine trade mark and not forged or falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the vendor and delivered at the time of the sale or contract to and accepted by the vendee. Implied warranty on sale of marked goods.

18. Where, at the passing of this Act, a trade description is lawfully and generally applied to goods of a particular class, or manufactured by a particular method, to indicate the particular class or method of manufacture of such goods, the provisions of this Act with respect to false trade descriptions shall not apply to such trade description when so applied: Provided that where such trade descrip- Provisions of Act as to false description not to apply in certain cases

[1] By this section importation of the following goods is forbidden:—
"Articles of foreign manufacture, and any packages of such articles bearing any names, brand, or mark, being or purporting to be the name, brand, or mark of manufacturers resident in the United Kingdom, or any name, brand, or mark which states or implies that such articles were manufactured at any place in the United Kingdom.
"Any name, brand, or mark which states or implies that any such articles were manufactured at a town or place having the same name as a place in the United Kingdom, shall, unless accompanied by the name of the country in which such place is situate, be deemed for the purposes of this section to state or imply that such articles were manufactured at a place in the United Kingdom."

tion includes the name of a place or country, and is calculated to mislead as to the place or country where the goods to which it is applied were actually made or produced, and the goods are not actually made or produced in that place or country, this section shall not apply unless there is added to the trade description, immediately before or after the name of that place or country, in an equally conspicuous manner, with that name, the name of the place or country in which the goods were actually made or produced, with a statement that they were made or produced there.

Savings.

19. (1) This Act shall not exempt any person from any action, suit, or other proceeding which might, but for the provisions of this Act, be brought against him.

(2) Nothing in this Act shall entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any action, but such discovery or answer shall not be admissible in evidence against such person in any prosecution for an offence against this Act.

(3) Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in the United Kingdom who *bonâ fide* acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master.

False representation as to Royal Warrant.

20. Any person who falsely represents that any goods are made by a person holding a Royal Warrant, or for the service of Her Majesty, or any of the Royal Family, or any Government Department, shall be liable, on summary conviction, to a penalty not exceeding £20.

Application of Act to Scotland.

21. In the application of this Act to Scotland the following modifications shall be made:—

The expression "Summary Jurisdiction Acts" means the Summary Procedure Act 1864, and any Acts amending the same.

The expression "justice" means sheriff.

The expression "court of summary jurisdiction" means the Sheriff Court, and all jurisdiction necessary for the purpose of this Act is hereby conferred on sheriffs.

22. In the application of this Act to Ireland, the following modifications shall be made:—

The expression "Summary Jurisdiction Acts" means, so far as respects the police district of Dublin metropolis, the Acts regulating the powers and duties of justices of the peace of such district, and as regards the rest of Ireland means the Petty Sessions (Ireland) Act 1851, and any Act amending the same. Application of Act to Ireland.

The expression "court of summary jurisdiction" means justices acting under those Acts. 14 and 15 Vict., c. 93.

MERCHANDISE MARKS ACT 1891

Chapter 15

An Act to amend the Merchandise Marks Act 1887

[11*th May* 1891] A.D. 1891.

1. The customs entry relating to imported goods shall, for the purposes of the Merchandise Marks Act 1887, be deemed to be a trade description applied to the goods. Customs entry to be trade description. 50 and 51 Vict., c. 28.

2. (1.) The Board of Trade may, with the concurrence of the Lord Chancellor, make regulations providing that in cases appearing to the Board to affect the general interests of the country, or of a section of the community, or of a trade, the prosecution of offences under the Merchandise Marks Act 1887 shall be undertaken by the Board of Trade, and prescribing the conditions on which such prosecutions are to be so undertaken. The expenses of prosecutions so undertaken shall be paid out of moneys provided by Parliament. Official prosecutions.

(2.) All regulations made under this section shall be laid before Parliament within three weeks after they are made if Parliament is then sitting, and if Parliament is not then sitting, within three weeks after the beginning of the next session of Parliament, and shall be judicially noticed, and shall have effect as if enacted by this Act, and shall be published under the authority of Her Majesty's Stationery Office.

(3.) Nothing in this Act shall affect the power of any person or authority to undertake prosecutions otherwise than under the said regulations.

COPYRIGHT ACT (UNITED STATES)

[The following are the material sections of the Code, as amended by Statute No. 166 of this year 1891. The numbers of the Code are given, except the last three, 11–13.]

"SEC. 4952. The author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and, in case of dramatic composition, of publicly performing or representing it or causing it to be performed or represented by others; and authors or their assigns shall have exclusive right to dramatise and translate any of their works for which copyright shall have been obtained under the laws of the United States."

[By the statute of 18th June 1874 "the words 'engraving,' 'cut,' and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts; and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office."]

"S. 4953. Copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof in the manner hereinafter directed.

"S. 4954. The author, inventor, or designer, if he be still living, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before

the expiration of the first term; and such persons shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers printed in the United States for the space of four weeks.

"S. 4955. Copyrights shall be assignable in law by any instrument of writing, and such assignmert shall be recorded in the office of the Librarian of Congress within sixty days after its execution; in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.

"S. 4956. No person shall be entitled to a copyright unless he shall, on or before the day of publication in this or any foreign country, deliver at the office of the Librarian of Congress, or deposit in the mail within the United States, addressed to the Librarian of Congress, at Washington, District of Columbia, a printed copy of the title of the book, map, chart, dramatic or musical composition, engraving, cut, print, photograph, or chromo, or a description of the painting, drawing, statue, statuary, or a model or design for a work of the fine arts for which he desires a copyright, nor unless he shall also, not later than the day of the publication thereof in this or any foreign country, deliver at the office of the Librarian of Congress, at Washington, District of Columbia, or deposit in the mail within the United States, addressed to the Librarian of Congress, at Washington, District of Columbia, two copies of such copyright book, map, chart, dramatic or musical composition, engraving, chromo, cut, print, or photograph, or in case of a painting, drawing, statue, statuary, model, or design for a work of the fine arts, a photograph of same: *Provided*, That in the case of a book, photograph, chromo, or lithograph, the two copies of the same required to be delivered or deposited as above shall be printed from type set within the limits of the United States, or from plates made therefrom, or from negatives, or drawings on stone made within the limits of the United States, or from transfers made therefrom. During the existence of such copyright the importation

into the United States of any book, chromo, or lithograph, or photograph, so copyrighted, or any edition or editions thereof, or any plates of the same not made from type set, negatives, or drawings on stone made within the limits of the United States, shall be, and it is hereby, prohibited, except in the cases specified in paragraphs five hundred and twelve to five hundred and sixteen, inclusive, in section two of the Act entitled 'An Act to reduce the Revenue and equalise the Duties on Imports, and for other purposes,' approved October first, eighteen hundred and ninety; and except in the case of persons purchasing for use and not for sale, who import subject to the duty thereon, not more than two copies of such book at any one time; and except in the case of newspapers and magazines, not containing in whole or in part matter copyrighted under the provisions of this Act, unauthorised by the author, which are hereby exempted from prohibition of importation: *Provided, nevertheless,* That in the case of books in foreign languages, of which only translations in English are copyrighted, the prohibition of importation shall apply only to the translation of the same, and the importation of the books in the original language shall be permitted."

[S. 4957 provides that the Librarian of Congress shall record the name, etc., of the copyright book or other article, and give a copy of the title or description, under his seal, to the proprietor whenever he shall require it.]

"S. 4958. The Librarian of Congress shall receive from the persons to whom the services designated are rendered the following fees:—

"First. For recording the title or description of any copyright book or other article, fifty cents.

"Second. For every copy under seal of such record actually given to the person claiming the copyright, or his assigns, fifty cents.

"Third. For recording and certifying any instrument of writing for the assignment of a copyright, one dollar.

"Fourth. For every copy of an assignment, one dollar.

"All fees so received shall be paid into the Treasury of the United States: *Provided*, That the charge for recording the title or description of any article entered for copyright, the production of a person not a citizen or resident of the United States, shall be one dollar, to be paid as above into the Treasury of the United States, to defray the expenses of lists of copyrighted articles as hereinafter provided for.

"And it is hereby made the duty of the Librarian of Congress to furnish to the Secretary of the Treasury copies of the entries of titles of all books and other articles wherein the copyright has been completed by the deposit of two copies of such book printed from type set within the limits of the United States, in accordance with the provisions of this Act and by the deposit of two copies of such other article made or produced in the United States; and the Secretary of the Treasury is hereby directed to prepare and print, at intervals of not more than a week, catalogues of such title-entries for distribution to the collectors of customs of the United States and to the postmasters of all post-offices receiving foreign mails, and such weekly lists, as they are issued, shall be furnished to all parties desiring them, at a sum not exceeding five dollars per annum; and the Secretary and the Postmaster-General are hereby empowered and required to make and enforce such rules and regulations as shall prevent the importation into the United States, except upon the conditions above specified, of all articles prohibited by this Act.

"S. 4959. The proprietor of every copyright book or other article shall deliver at the office of the Librarian of Congress, or deposit in the mail, addressed to the Librarian of Congress, at Washington, District of Columbia, a copy of every subsequent edition wherein any substantial changes shall be made: *Provided, however*, That the alterations, revisions, and additions made to books by foreign authors, heretofore published, of which new additions shall appear subsequently to the taking effect of this Act, shall be held and deemed capable of being copyrighted as above provided for in this Act, unless they form a part of the series

in course of publication at the time this Act shall take effect.

"S. 4960. For every failure on the part of the proprietor of any copyright to deliver or deposit in the mail either of the published copies, or description or photograph, required by ss. 4956 and 4959, the proprietor of the copyright shall be liable to a penalty of twenty-five dollars, to be recovered by the Librarian of Congress, in the name of the United States, in an action in the nature of an action of debt, in any district Court of the United States within the jurisdiction of which the delinquent may reside or be found.

"S. 4961. The postmaster to whom such copyright book, title, or other article is delivered, shall, if requested, give a receipt therefor; and when so delivered he shall mail it to its destination.

"S. 4962 [as altered by the Act of 18th June 1874]. No person shall maintain an action for the infringement of his copyright unless he shall give notice thereof by inserting in the several copies of every edition published, on the title-page or the page immediately following, if it be a book; or if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words: 'Entered according to Act of Congress, in the year , by A. B., in the office of the Librarian of Congress, at Washington'; or at his option the word 'Copyright,' together with the year the copyright was entered, and the name of the party by whom it was taken out, thus, 'Copyright, 18 , by A. B.'

"S. 4963. Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, dramatic, or musical composition, print, cut, engraving, or photograph, or other article, for which

he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty, and one-half to the use of the United States.

"S. 4964. Every person, who after the recording of the title of any book and the depositing of two copies of such book, as provided by this Act, shall, contrary to the provisions of this Act, within the term limited, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, print, publish, dramatise, translate, or import, or knowing the same to be so printed, published, dramatised, translated, or imported, shall sell or expose to sale any copy of such book, shall forfeit every copy thereof to such proprietor, and shall also forfeit and pay such damages as may be recovered in a civil action by such proprietor in any Court of competent jurisdiction.

"S. 4965. If any person, after the recording of the title of any map, chart, dramatic or musical composition, print, cut, engraving, or photograph, or chromo, or of the description of any painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, as provided by this Act, shall within the term limited, contrary to the provisions of this Act, and without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses, engrave, etch, work, copy, print, publish, dramatise, translate, or import, either in whole or in part, or by varying the main design with intent to evade the law, or, knowing the same to be so printed, published, dramatised, translated, or imported, shall sell or expose to sale any copy of such map or other article as aforesaid, he shall forfeit to the proprietor all the plates on which the same shall be copied and every sheet thereof, either copied or printed, and shall further forfeit one dollar for every sheet of the same found in his possession, either printing, printed, copied, published, imported, or exposed for sale, and in case of painting, statue, or statuary, he shall forfeit ten dollars for every copy of the same in his posses-

sion, or by him sold or exposed for sale; one-half thereof to the proprietor, and the other half to the use of the United States.

"S. 4966. Any person publicly performing or representing any dramatic composition for which a copyright has been obtained, without the consent of the proprietor thereof, or his heirs or assigns, shall be liable for damages therefor, such damages in all cases to be assessed at such sum, not less than one hundred dollars for the first, and fifty dollars for every subsequent performance, as to the Court shall appear to be just.

"S. 4967. Every person who shall print or publish any manuscript whatever without the consent of the author or proprietor first obtained, shall be liable to the author or proprietor for all damages occasioned by such injury.

"S. 4968. No action shall be maintained in any case of forfeiture on penalty under the copyright laws, unless the same is commenced within two years after the cause of action has arisen.

"S. 11. That for the purpose of this Act each volume of a book in two or more volumes, when such volumes are published separately, and the first one shall not have been issued before this Act shall take effect, and each number of a periodical shall be considered an independent publication, subject to the form of copyrighting as above.

"S. 12. That this Act shall go into effect on the first day of July, Anno Domini eighteen hundred and ninety-one.

"S. 13. That this Act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens; or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copy-

right, by the terms of which agreement the United States of America may, at its pleasure, become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States by proclamation made from time to time as the purposes of this Act may require."

Note.—Several points must be observed :—

1. Delivery of a printed copy of the title of the book, etc., or a description of the work of art, "on or before the day of publication in this or any foreign country." (S. 4956.)

2. Delivery of two copies of the book, etc., or of the photograph of the work of the fine arts, "not later than the day of the publication thereof in this or any foreign country." (S. 4956.)

3. The publication in the United Kingdom must not precede, though it may be contemporaneous with, that in the United States.

4. In the case of a book, photograph, chromo, or lithograph, the two copies must be from type set, plate, negative, or drawing made, within the United States. (S. 4956.)

5. During the copyright, importation is forbidden, except of not more than two copies of a book at any one time, for use and not for sale, and except newspapers and magazines not containing unauthorised reprints, and except books in a foreign language, whereof the English translation only is protected. (S. 4956.)

6. The fees must be paid according to s. 4958.

7. Alterations, revisions, and additions made to books already published, by foreign authors may be copyrighted. (S. 4959.)

8. The words set out in s. 4962 must be inserted in every copy published.

9. Penalties are imposed on any one wrongfully inserting those words (s. 4963), and on persons infringing ss. 4964–4966.

10. An unpublished MS. is protected by s. 4967.

11. The United States Government has acted on the assumption that temporary allegiance even is superfluous

for the acquirement of British copyright, and by proclamation of President Harrison, dated 1st July, has extended the benefit of the above Act to citizens or subjects of Great Britain, France, Belgium, and Switzerland.

The following regulations have been made by the United States Treasury :—

"1. Copyrighted books and articles of importation which are prohibited by s. 4965 of the Revised Statutes, as amended by s. 8 of the said Act, shall not be admitted to entry. Such books and articles, if imported with the previous consent of the proprietor of the copyright, shall be seized by the Collector of Customs, who shall take proper steps for the forfeiture of the goods to the United States under s. 3082 of the Revised Statutes.

"2. Copyrighted books and articles imported contrary to the said prohibition without the previous consent of the proprietor of the copyright, being primarily subject to forfeiture to the proprietor of the copyright, shall be detained by the collector, who shall forthwith notify such proprietor in order to ascertain whether or not he wishes to institute proceedings for the enforcement of the right to forfeiture. If the proprietor institutes such proceedings, and obtains a decree of forfeiture, the goods shall be delivered to him on payment of the expenses incurred in the detention, storage, and duties accruing thereon. If such proprietor fails to institute proceedings within sixty days from the date of notice or declaration in writing, he abandons his right to forfeiture, and the collector shall proceed as in the case of articles imported with the previous consent of the proprietor.

"3. Copyrighted articles of importation which are not prohibited, but which, by virtue of s. 4965 of the Revised Statutes, as amended by s. 8 of the said Act, are forfeited to the proprietor of the said copyright when imported without his previous consent, and, moreover, subject to the forfeiture of one dollar or ten dollars per copy, as the case may be, one half thereof to the said proprietor, and the other half to the United States, shall be taken possession of by the collector, who shall take the necessary steps for securing to the United States half the sum forfeited, and shall keep the goods in his possession until

the decree of forfeiture has been obtained and half of the sum so forfeited, as well as the duties and charges accruing, are paid, whereupon he shall deliver the goods to the proprietor of the copyright. In case of a failure to obtain a decree of forfeiture the goods shall be admitted to entry."

These regulations, unless altered, will very materially prejudice the importation of serial publications into the United States if not altogether prevent them, for the seizure is to take place of books and articles "if imported with the previous consent of the proprietor of the copyright." The seizure may be justified under the Customs Act, but it is a distinct derogation from the rights apparently conferred by s. 8 of the Copyright Act.

GENERAL INDEX

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