A COMPLETE TREATISE

UPON

THE NEW LAW OF PATENTS, DESIGNS AND TRADE MARKS

BEING

THE PATENTS, DESIGNS AND TRADE MARKS ACT, 1883,

WITH THE RULES AND FORMS,

FULLY ANNOTATED WITH CASES, &c.,

AND A

STATEMENT OF THE PRINCIPLES OF THE LAW UPON THOSE SUBJECTS;

WITH A TIME TABLE AND COPIOUS INDEX, AND AN ABRIDGMENT OF THE CUTLERS' CO. ACTS.

BY

EDWARD MORTON DANIEL,

OF LINCOLN'S INN, BARRISTER-AT-LAW; ASSOCIATE OF THE INSTITUTE OF PATENT AGENTS.

London:

STEVENS & HAYNES, 13, BELL YARD, TEMPLE BAR.

VACHER & SONS, 29, PARLIAMENT STREET, S.W.

1884.

S
UK
945
DAN

Tx
D184p

TACHER & SONS, PRINTERS,
29, PARLIAMENT STREET, AND 62, MILLBANK STREET,
WESTMINSTER, S.W.

APR 21 1913

PREFACE.

THE Patents, Designs and Trades Marks Act of 1883 is designed, according to its authors, to consolidate the law relating to those subjects into one statute. This, so far as the statute law was concerned, the new Act has accomplished, by the simple process of repealing all previous enactments, and repealing, amending, adding to, or omitting from their provisions. But that large and important body of law relating to the subjects of the Acts which exists in precedent, and is only to be found in the reports of decided cases, is left unaffected and undigested by it. The Act has therefore not done what some persons expected it would do, that which was accomplished by the Bills of Exchange Act of 1882—the codification of the law. And since all the principles of the law upon the important subjects of Patents and Trade Marks have been essentially not the creation of legislation, but of judicial decision, it is obvious that a large part of the law relating to these subjects is not to be found in the Act.

The writer, in designing the present work, has found it necessary to bear this strongly in mind. In order to prepare a book for the use of practitioners and patentees in working out the new Act, something more was necessary than the Act itself and annotations; such persons are entitled to expect that such a book should contain the whole law upon the subjects upon which it professes to

treat. The writer has, therefore, attempted to do that which the Act has left undone, and to digest the principles of the law upon the subject of Patents, Designs, and Trade Marks respectively, and to state them in a clear but concise manner in the three chapters with which the book commences. If he has succeeded in carrying out his intentions, a perusal of these chapters, or a reference to any particular point in them, will inform or remind the reader of the principles of the law, and enable him to understand and work out the Act itself.

In the Fifth Section of the First Chapter the all important subject of the preparation of the Title of the Patent and of the Provisional and Complete Specifications has been very fully dealt with, and an attempt has been made to formulate the rules which should govern the preparation of those documents.

In the annotations to the Act the first object of the writer has been to render them of practical utility. Where points of doubt arise as to the construction of particular sections it has been his object to solve them where it appeared possible to do so; and where not, to collect all the information material for their solution, and to suggest the reasons *pro* and *con* for their decision. The cases have been carefully examined, and all those of any importance reported up to the present will, it is believed, be found noted in their places.

One of the first subjects upon which a reader seeks information in a work upon a new Act of Parliament is as to the changes in the law. With the object of giving this information authoritatively, the writer has reprinted in this volume the Memorandum endorsed upon the Act upon its first introduction into the House of Commons, giving it a

chapter to itself. The changes in the law will there be found stated in the language of its authors.

It has been a subject for consideration whether, in addition to printing the Rules, which, of course, are essential to the practical working of the Act, it was worth while to increase the bulk and expense of the book by also printing the numerous Forms which have been issued by the Patent Office, considering that the latter are easily obtainable, and at a very cheap price. But forms issued by authority render so much assistance in understanding and carrying out a new Act of Parliament, throw so much light upon the intentions of the legislature, and, therefore add so much to the practical value of a book, that it has been decided to print them.

A Time-Table, or tabular statement of the times within which the various proceedings required by the Act and Rules must be taken, will be found printed immediately before the Index. This is divided into three parts relating to—(1) Patents; (2) Designs; and (3) Trade Marks respectively. By referring to it, the times for doing anything can be found at a glance, collected altogether, without the tedious process of referring to the scattered sections of the Act, and to the various rules governing the subject.

To facilitate reference, cross references to the Act and Rules have been given when it appeared desirable, and a full Index is appended, which will enable reference to any part of the book easy to be made.

To find the Forms it will be necessary to refer in the Index to the head of "Forms" where a complete list of them is set out with a reference to the page upon which they are respectively printed.

A Table of Cases with references to the pages upon which they are cited will be found at the commencement of the book.

The writer desires to say that this book is intended as a Manual of Practice or Practical Treatise upon the New Law introduced by the Act of last Session. It does not propose to compete with or supersede the numerous elaborate Treatises which have been published upon the Law of Patents —to some of which, especially to the excellent work of Messrs. Johnson, the writer desires to express his obligations—and upon the Law of Trade Marks.

In conclusion, may one observation be permitted: the critical examination of the Act and Rules, which the preparation of this work has required the writer to make, has convinced him, notwithstanding all that has been said to the contrary, that skilled assistance is as necessary as ever to the patentee and to the applicant for the registration of a design or a trade mark, to guide him safely through the process of acquiring the exclusive privilege he desires to obtain.

E. MORTON DANIEL.

GOLDSMITH BUILDING,
TEMPLE, *January*, 1884.

TABLE OF CONTENTS.

PAGE

TABLE OF CASES CITED xi

CHAPTER I.

PATENTS FOR INVENTIONS.

SECTION I.—THE NATURE OF A PATENT 1

II.—WHAT IS PROPERLY THE SUBJECT MATTER OF A PATENT 3

III.—TO WHOM PATENTS MAY BE GRANTED 11

IV.—THE NECESSARY INGREDIENTS OF AN INVENTION FOR WHICH A VALID PATENT MAY BE OBTAINED 14

1. Invention 14
2. Novelty 17

Prior publication (1) by description 19
(2) by use 21

Confidential disclosure 23

3. Utility 25

V.—THE TITLE, THE PROVISIONAL AND COMPLETE SPECIFICATIONS AND THE CLAIMS 28

1st. THE TITLE 29

Instances of bad titles 31

Instances of titles held good 32

2nd. THE PROVISIONAL SPECIFICATION 33

Distinction between, and Complete Specification 35

Rules for preparing ... ... *et seq.* 37

Must cover invention 38

Variance between it and Complete Specification 39

Point in, may be omitted from final 42

3rd. THE COMPLETE SPECIFICATION 44

1. Must disclose invention 45

Falsehood in 45

Concealment in 45

Ambiguous or misleading 46

Must not be equivocal 46

Should be definite 46

Full 46

Accurate 46

2. Should distinguish between new and old ... 47

3. Must keep within Provisional 48

4. Is addressed to competent persons 49

5. Must enable such to carry out invention ... 51

6. Should distinguish between application of a principle and combination 52

SECTION V.—3rd. THE COMPLETE SPECIFICATION—*continued.* PAGE

7. Will be construed favourably to inventor ... 60
8. Verbal errors do not render invalid... ... 61
9. Provisional not permitted to explain or enlarge 61

4th. THE CLAIMS 63
How to draft (catch the invention) 64
Grasping claims to be avoided 65

CHAPTER II.

PRINCIPLES IN THE LAW OF COPYRIGHT IN DESIGNS 68

Protection not to article manufactured but to design applied thereon 71
Must be new when registered 71
What Copyright is 72

CHAPTER III.

THE PRINCIPLES OF THE LAW OF TRADE MARKS—

History 74
Property in, distinguished from Patents and Designs 75, 76
Property in, defined 76, 77
Distinction between new and old marks 77, 78
Definition of "old" mark 78
Definition of "new" mark 79
Instances of "old" mark 80
Principles of protection of Trade Marks 81
Misrepresentation in Trade Marks 85
Marks become common or *publici juris* 89
Name of natural product 92
Trade Marks, part of which are common 94
Trade Marks can be claimed only for particular classes of goods 95
Trade Marks are assignable 95
But only with goodwill of business 96
Pass to Bankruptcy Assignee of owner 96
Formerly necessary to have transacted business in to complete title, now to register 97
Merchandise Marks Act ... ... *et seq* 99

CHAPTER IV.

CHANGES IN THE LAW BY NEW LEGISLATION SHOWN BY MEMORANDUM ON THE BILL 103

CHAPTER V.

THE PATENTS DESIGNS AND TRADE MARKS ACT, 1883, WITH ANNOTATIONS.

	PAGE
ARRANGEMENT OF SECTIONS	112
PART I.—PRELIMINARY	117
II.—PATENTS	117
Application for and grant of Patent	117
Provisional protection	134
Protection by Complete Specification	135
The Patent	135
Amendment of Specification or Disclaimer	139
Compulsory licenses	142
Register of Patents	144
Fees	145
Extension of Patent	146
Revocation of Patent	149
The Crown	151
Legal Proceedings	153
Miscellaneous...	166
III.—DESIGNS—	
Registration of Designs	178
Copyright in registered Designs	182
Register of Designs	184
Fees	185
Industrial and International Exhibitions	185
Legal proceedings	186
Definitions	189
IV.—TRADE MARKS	190
Registration of Trade Marks	190
Effect of registration	206
Register of Trade Marks	209
Fees	211
Sheffield Marks	211
V—GENERAL	215
Patent Office, and proceedings thereat	215
International and Colonial arrangements	227
Offences	228
Scotland, Ireland, &c.	230
Repeal, Transitional Provisions, Savings	232
Form of Patent	235
Enactments repealed	238

CHAPTER VI.

SECTION I.—THE PATENTS RULES	241
THE PATENTS FEES	255
THE PATENTS FORMS	257

	PAGE
SECTION II.—THE DESIGNS RULES	216
THE DESIGNS FEES	272
THE DESIGNS FORMS	273
THE DESIGNS, CLASSIFICATION OF ARTICLES OF MANUFACTURE AND SUBSTANCES	276
III.—THE TRADE MARKS RULES	277
THE TRADE MARKS FEES	288
THE TRADE MARKS FORMS	290
THE TRADE MARKS CLASSIFICATION OF GOODS	299
IV.—ABRIDGMENT OF THE CUTLERS' COMPANY ACTS ...	307
V.—THE TIME TABLE	313
Patents	313
Designs	317
Trade Marks	318
INDEX	323

CASES CITED.

Adair *v.* Young, 173
Adams *v.* Clementson, 180
Ainsworth *v.* Walmsley, 80, 193
Allen *v.* Rawson, 13
Allsopp *v.* Walker, 202
Amies *v.* Kelsey, 160
Axmann *v.* Lund, 164

Bailey *v.* Roberton, 36, 39, 49
Bakewell's Patent, *Re*, 147
Bambridge *v.* Wigley, 31, 32
Banks *v.* Gibson, 96, 97
Barley *v.* Walford, 189
Barrow & Co., *Ex parte*, 195, 202
Barrow's Trade Mark, *Re*, 193, 196, 202
Batley *v.* Kynoch, 155, 160
Bates, *Ex parte*, *v.* Redgate, 134
Batty *v.* Hill, 84
Beard *v.* Egerton, 118
Beckford *v.* Skewes, 49
Benbow *v.* Low, 194, 201
Betts's Pat., *Re*, 147, 219
Betts *v.* Menzies, 14, 19, 20
Betts *v.* De Vitre, 159, 162
Bewley *v.* Hancock, 9
Bewley's Case, 3
Blamond's Patent, *Re*, 221
Blanchard *v.* Hill, 74
Bloxam *v.* Elsee, 116
Boulton *v.* Bull, 13
Bovill *v.* Hadley, 162
Bovil *v.* Crate, 158
Bovill *v.* Moore, 45, 55, 160
Bodmer's Patent, *Re*, 148
Braby's Application, *Re*, 194, 196, 202
Braham *v.* Bustard, 80
Branchardiere *v.* Elvery, 187
Brandreth's Trade Mark, *Re*, 200
Bridson *v.* Benecke, 158
Brook, *Re*, 195
Burnett *v.* Tate, 165
Burgess *v.* Burgess, 193
Burgess *v.* Hateley, 80
Burgess *v.* Hill, 80
Bury *v.* Bedford, 96, 200

Caldwell *v.* Van Vlissengen, 173
Campion *v.* Benyon, 32
Carr's Patent, *Re*, 147, 148
Carter *v.* Carlile, 80
Carpenter *v.* Smith, 21, 48, 120
Clarke's Pat., *Re*, 148
Clark *v.* Adie, 59, 63
Closs, Reg. *v.*, 100
Chanter *v.* Dewhurst, 166
Chanter *v.* Johnson, 166
Cheaven *v.* Walker, 88
Chappel *v.* Purday, 118
Chollett *v.* Hoffmann, 145, 217
Churton *v.* Douglas, 200
Cockrane, Lord, *v.* Smethurst, 31
Condy *v.* Mitchell, 93
Cooper *v.* Hood, 200
Cook *v.* Pearce, 32, 33
Cotton *v.* Gillard, 200
Crane *v.* Price, 3, 8, 18
Crossley *v.* Tomey, 157
Crossley *v.* Potter, 53
Crossley *v.* Beverley, 50, 159
Croll *v.* Edge, 30
Curtis *v.* Platt, 54, 154, 155

Dangerfield *v.* Jones, 48
Dartmouth, Earl of, *v.* Darrell, 24
Davenport *v.* Rylands, 161, 162
Davenport *v.* Jepson, 158
Day *v.* Day, 74
Daw *v.* Eley, 157
Derosne's Patent, *Re*, 147
Derosne *v.* Fairie, 8, 62
De Vitre *v.* Betts, 161
Dicks *v.* Brooks, 165
Dilworth, *Re*, 185
Dixon *v.* London Small Arms Co., 152
Dolland's Case, 13, 17, 22
Downton's Pat., *Re*, 147, 148, 149
Dudgeon *v.* Thomson, 60, 141, 158
Dugdale's Trade Mark, *Re*, 194, 201
Dunnicliff *v.* Mallett, 218

Edelstein *v.* Edelstein, 80
Edelstein *v.* Vick, 88, 204
Edgeberry *v.* Stephens, 120, 122, 123
Electric Telegraph Co. *v.* Nott, 158
Elliott *v.* Turner, 62
Ellwood *v.* Christy, 145, 161, 218

Farina *v.* Silverlock, 80, 82
Feather *v.* The Queen, 152, 176

Felton *v.* Greaves, 32
Fisher *v.* Dewick, 32, 155
Flavell *v.* Harrison, 87
Flower *v.* Lloyd, 157
Frearson *v.* Loe, 159
Freeman *v.* Read, 127
Forsyth *v.* Riviere, 13
Foxwell *v.* Bostock, 42, 56
Ford *v.* Foster, 80, 89, 90

Galloway's Pat., *Re*, 147
Galloway *v.* Bleaden, 23, 46
Gibson and Campbell *v.* Brand, 46
Gibson *v.* Brand, 25, 46
Greaves *v.* Eastern Counties Railway Co., 157
Green's Patent, *Re*, 145, 220
Gillman *v.* Hunnewell, 77
Gillett *v.* Green, 157, 162
Gillet *v.* Wilbey, 162
Gout *v.* Aleploglu, 80

Hall *v.* Jarvis and Boot, 6
Hall *v.* Barrows, 76, 82, 83, 85, 92, 95
Halsey *v.* Brotherhood, 164, 165
Hancock *v.* Bewley, 118
Hargreave's Trade Mark, *Re*, 202
Harrison *v.* Taylor, 179
Harrison *v.* Anderston Foundry Co., 58
Hardy's Pat., *Re*, 148
Harmar *v.* Playne, 49
Hastings *v.* Brown, 46
Hassell *v.* Wright, 145, 218
Hesse *v.* Stevenson, 185
Higgs *v.* Goodwin, 9
Hill's Patent, *Re*, 147
Hills *v.* Evans, 61, 62
Hills *v.* The London Gas Co., 9.
Hill *v.* Thompson, 7, 19, 25, 66, 158
Hinks and Son *v.* Safety Lighting Co., 47, 65, 164
Hino *v.* Lart, 80
Hirsch *v.* Jonas, 84
Hirst *v.* Denham, 81
Hitchcock *v.* Coker, 200
Hogg *v.* Kirby, 204
Holloway *v.* Holloway, 193, 204
Holland *v.* Fox, 161
Holmes *v.* London and N. W. Ry. Co., 48, 54
Honiball *v.* Bloomer, 157
Honiball's Patent, *Re*, 148
Horsley and Knighton's Pat., *Re*, 145, 220
Household Company *v.* Neilson, 4, 20, 21, 50
Hudson *v.* Osborne, 96, 200
Hull *v.* Bolland, 156

Hyde's Trade Mark, *Re*, 97, 207
Hutchinson's Patent, Re, 147.

Jefferys *v.* Boosey, 73
Jelley's Application, *Re*, 194, 202
Jelley Son and Jones, *Re*, 195, 205
Jewitt *v.* Echhardt, 185
Johnson's Patent, *Re*, 147, 148, 221
Johnson & Co. *v.* Orr-Ewing & Co., 206
Johnston's Trade Mark, Re, 199
Jones *v.* Berger, 155
Jones *v.* Pearce (1 Webs. Pat. Cas. 112), 23.

Kay *v.* Marshall, 4, 56, 64
Kernot *v.* Potter, 161
Kinahan *v.* Bolton, 80
King *v.* Arkwright, 19

Lamb *v.* Nottingham Manufacturing Company, 155
Lamplough *v.* Balmer. 87, 204
Lang *v.* Gisborne, 20
Lawson *v.* Bank of London, 97
Lazarus *v.* Charles, 180
Leather Cloth Co. *v.* American Leather Cloth Co., Limited, 76, 86, 87, 88, 96, 204
Lewis *v.* Marling, 21, 27, 47
Lister and another *v.* Leather, 155.
Liebig's Extract of Meat Co. *v.* Hanbury, 91
Liardet *v.* Johnson, 47
Linoleum Manufacturing Co. *v.* Nairn, 93
Longman *v.* Tripp, 185
Losh *v.* Hague, 21, 157

Macnamara *v.* Hulse, 52
Mackelcan *v.* Rennie, 62
Maignen's Application, *Re*, 194
Mallett's Patent, *Re*, 148
Manton *v.* Manton, 47
Mallett *v.* Howitt, 187
Marsden *v.* Saville Street Foundry and Engineering Co., 167
Marshall *v.* Ross, 88
Mathers *v.* Green, 118, 124
Maxwell *v.* Hogg, 97, 206
McAndrew *v.* Bassett, 81, 97, 206
McCrea *v.* Holdsworth, 180, 187, 188
Meadows *v.* Kirkman, 160
Meikle, *Re*, 198
Milligan *v.* Marsh, 120, 122
Millington *v.* Fox, 75, 80, 83
Minter *v.* Mower, 62
Minter *v.* Wells, 13
Mitchell's Trade Marks, *Re*, 193

Morison *v.* Moat, 25
Morgan's Patent, *Re*, 145, 220
Morgan *v.* Seaward, 24, 27, 51, 160
Morgan *v.* McAdam, 86, 204
Morgan *v.* Fuller, 155
Monopolies, Case of, 3
Morey's Patent, *Re*, 145, 220
Moyle *v.* Jenkins, 131
Mullooney *v.* Stevens, 180
Muntz *v.* Foster, 6, 9, 10, 47
Muntz's Pat., *Re*, 147, 148
Myers *v.* Baker, 229

Needham *v.* Oxley, 154, 159
Newall *v.* Wilson, 158
Newall *v.* Elliott, 24, 40, 49
Newton *v.* Vaucher, 19
Neilson *v.* Betts, 160, 161
Neilson *v.* Harford, 29, 32, 50, 52, 156
Nickel's Patent, *Re*, 221
Nichols *v.* Haslam, 31
Nixey *v.* Roffey, 67
Normandy's Patent, *Re*, 148
Norton *v.* Nicholls, 180, 188
Norton's Patent, *Re*, 148

Orr-Ewing's Trade Mark, *Re*, 199
Orr-Ewing & Co. *v.* Johnston & Co., 203
Oxley *v.* Holden (8 C. B., N. S., 707), 32, 43, 127

Palmer's Trade Mark, *Re*, 97
Palmer's Application, *Re*, 207
Palmer *v.* Cooper, 155, 156
Palmer *v.* Wagstaffe and another, 27, 28, 156
Parkes *v.* Stevens, 58
Patent Type Foundry Co. *v.* Lloyd, 160
Patent Type Foundry Co. *v.* Walter, 160
Patterson's Patent, *Re*, 148
Patterson *v.* Gas Light and Coke Company, 118
Penn *v.* Jack, 161
Penn *v.* Bibby, 36, 157, 161
Pering, *Ex parte*, 152
Perry *v.* Truefitt, 82, 86, 204
Perry *v.* Mitchell, 155
Pidding *v.* How, 85, 204
Pierce *v.* Worth, 183
Piggott *v.* Anglo-American Telegraph Co., 160
Pitman's Patent *Re*, 147
Plimpton *v.* Malcolmson, 46, 158, 159
Plimpton *v.* Spiller, 20, 60, 65, 156

Ralph's Trade Mark, *Re*, 98
Ransome *v.* Graham, 194, 197
Rainhardt *v.* Spalding, 194
Renard *v.* Levinstein, 121, 122, 157, 158
Reg *v.* Bessell, 179
Reg *v.* Closs, 100
Reg *v.* Local Government Board, 144
Reg *v.* John Smith, 100
Rogers *v.* Driver, 179
Rex *v.* Arkwright, 19, 45
Rex *v.* Wheeler, 4, 31
Rex *v.* Metcalfe, 31
Robinson's Trade Mark, *Re*, 194, 197
Rollins *v.* Hinks, 163, 164
Rotherham's Trade Mark, *Re*, 194, 199
Rose *v.* Evans, 194
Russell, *Re*, 118
Russell *v.* Cowley, 9, 60
Russell *v.* Ledsam, 148

Saxby *v.* Easterbrook, 161
Saxby's Patent, *Re*, 147, 148
Schweitzer *v.* Atkins, 81
Seixo *v.* Provezende, 81, 203
Shipwright *v.* Clements, 200
Shaw *v.* Bank of England, 160
Shropshire Iron Co.'s Trade Mark, *Re*, 202
Simister's Patent, *Re*, 148
Siegert *v.* Findlater, 93
Simpson, Davies & Son's Trade Mark *Re*, 199
Simpson *v.* Halliday, 9, 62
Singer Co. *v.* Loog, 206
Singer Manufacturing Co. *v.* Wilson 83, 91, 160, 204
Smith, John, *v.* Reg., 100
Smith *v.* G.W.R. Co., 160
Smith *v.* Mason, 81
Stead *v.* Williams, 21
Stedman *v.* Marsh, 120
Steiner *v.* Heald, 9
Stephens, *Ex parte*, 192, 194
Stevens *v.* Peel, 81
Stevens *v.* Keating, 66
Stocker *v.* Rodgers, 162
Stoner *v.* Todd, 36
Sturtz *v.* De la Rue, 32
Soames' Pat., *Re*, 147, 148
Sykes' Trade Mark, *Re*, 195, 202, 205
Sykes *v.* Sykes, 74

Talbot *v.* Laroche, 154, 155
Tangye *v.* Stott, 159
Tennants' Case, 21
Tetley *v.* Easton and Amos, 48, 66
Thomas *v.* Welch, 42
Trotman's Pat., *Re*, 148
Trotman *v.* Wood, 161
Turner *v.* Winter, 28, 46

United Telephone Co. *v.* Harrison, Cox-Walker & Co., 39, 49, 129

Vidi *v.* Smith, 160, 161
Vincent's Patent, *Re*, 168

Walkden's Ærated Water Co., *Re*, 201
Wakefield *v.* Duke of Buccleugh, 159
Walton *v.* Lavater, 161, 218
Walton *v.* Bateman, 46
Webster *v.* Webster, 85
Westrupp and Gibbin's Patent, 148
Wheeler and Wilson Manufacturing Company *v.* Shakespeare, 91
Whiteley's Trade Mark, *Re*, 194, 195, 202, 205.
Whitehouse Patent, *Re*, 148
Windover *v.* Smith, 179
Worthington & Co.'s Trade Mark, *Re*, 194, 197
Wotherspoon *v.* Currie, 83
Wren *v.* Wield, 163, 164, 165
Wright *v.* Hitchcock and another (L. R., 5 Ex., 37), 41

Young *v.* Macrae, 92
Young *v.* Fernie (4 Giff., 611), 13
Young *v.* Higgon, 127

CHAPTER I.

Patents for Inventions.

SECTION I.

The Nature of a Patent.

Letters Patent are the instrument by which any grant from the Crown is made to a subject. In ancient times, when grants of land or revenues were made by the sovereign, they were generally made by Letters Patent. And from the earliest times down to the present, grants of privilege and dignity were and are always granted by these instruments. When a new peer is made, or a new dignity granted, it is always by Letters Patent.

In the times preceding the Protectorate, the sovereigns of this country, notwithstanding the opinions always held by constitutional lawyers that they were illegal, were in the frequent habit of granting Letters Patent to various persons and corporations, of the exclusive right or privilege of manufacturing and selling articles of ordinary commerce, to be exercised for the profit of the grantees, and securing it to them by giving the power to prosecute; by fine or imprisonment, the infringers of the privilege so granted. This practice reached to a great height during the reign of Queen Elizabeth, and was unsparingly exercised by her successor, until monopolies were granted for the exclusive privilege of manufacturing and selling even the commonest articles of commerce, without the smallest regard to the interests of the public, for the gratification of the favourites of the sovereign, or in return for sums of money paid by the grantees to the sovereign.

These monopolies were very oppressively exercised, and tended greatly in restraint of commerce, and towards the

raising of the prices of articles of everyday use to a very inconvenient degree. They naturally excited very great odium; and in one of the first Parliaments which the necessities of James I. compelled him to call, the subject was energetically taken up. The great Sir Edward Coke was a member of the House of Commons then assembled; and, under his leadership, the famous Statute of Monopolies (the 21 James I., cap. 3) was passed in the form of a declaratory Act, strongly and vehemently alleging the illegality of all monopolies in restraint of trade, and denying the assumed prerogative of the Crown to grant them, and declaring them to be against common law, and to be for ever afterwards null and void and without effect.

From the sweeping provisions of this Act, however, Letters Patent for inventions were expressly exempted, and this exception will be best understood by the words of the Statute itself—(Section 6 of 21 James I., cap. 3):—

"Provided also, and be it declared and enacted, that "any declaration before mentioned" (the declaration that all monopolies for the sole buying, selling, working or using of anything shall be void and of none effect, contained in sections 1 to 5) "shall not extend to Letters Patent and "grants of privilege for the term of fourteen years, or under, "hereafter to be made of *the sole working or making of any* "*manner of new manufactures within this realm to the true* "*and first inventor and inventors of such manufactures,* "which others, at the time of making such letters patent "and grants, shall not use, so as also they be not contrary to "the law, nor mischievous to the State by raising prices of "commodities at home, or hurt of trade, or generally incon- "venient: the said fourteen years to be accompted from the "date of the first letters patent, or grant of such privilege "hereafter to be made, but that the same shall be of such "force as they should be if this Act had never been made, "and of none other."

This section still remains in force, and all patents for

invention which are granted must come within its provisions.

Letters Patent are construed strictly and most favourably for the sovereign, contrary to the principle governing the grants of ordinary persons, which are construed most favourably to the grantee. If they can be interpreted in two ways they shall be taken in the sense the more favourable to the sovereign—(Bacon's Abridgt. Prerogative, F., pt. 2). But where the Letters Patent are capable of being read in different ways, by one of which they would be valid and the other invalid, the construction will be in favour of the validity, because it cannot be presumed that the sovereign intended to make a void and illusory grant—(Bewley's Case, 9 Rep. 131a).

2nd. There must be no misrepresentation to the Crown of the facts upon which the Letters Patent are granted. Thus, if any one of the statements in the application of the inventor for the grant of Letters Patent to him is untrue, the patent is invalid, because it was granted upon a false suggestion to the Crown—(Case of Monopolies, Webst., P. C. 1, 5). But where the mistake is on the part of the sovereign, or his advisers, the Letters Patent are not void.

SECTION II.

What is Properly the Subject Matter of a Patent.

We have seen that the 6th section of the Statute of Monopolies only excepted Letters Patent "for the sole "working or making of any manner of new manufactures," and therefore anything to be properly the subject of Letters Patent must be a new manufacture. The word "manufac-"ture" is, however, a very large term, and it has been construed to mean not only the article manufactured, but the method *Orane* v. *Price* (4 M. & G., 580), the process, or the machine by means of which the article is produced

—*Househill Company* v. *Neilson* (Webs. P. C., 683). It will be easily perceived that this construction of the word covers almost the whole ground of possible invention. In fact patents have been freely granted and upheld for machines, chemical and medical compounds, methods of treating various substances in order to manufacture them into articles of commerce, or to improve them when so manufactured; processes for treating articles while undergoing various stages of manufacture; applications of certain substances to specific purposes to which they have never hitherto been applied; combinations of known existing elements, machines, or parts of machines, so as to produce new effects; and improvements upon and additions to existing machines and processes. In fact, by far the greater portion of the novelty or improvement which the inventive faculty of mankind can produce is proper subject matter for protection for Letters Patent, and what may be patented will be more easily learned from a consideration of what may not be patented, than from a list of the various classes of invention for which Letters Patent may be obtained, which it would be hardly possible to render a perfect one.

Letters Patent will not be upheld for scientific principles not embodied into any practical form—*R.* v. *Wheeler* (2 B. & Ald. 349); L. J. C. Hope, *Househill Company* v. *Neilson* (W. P. C., 683).

Nor for a new use of an old invention, because there is no new art which can be made the subject of the patent privilege, the patentee having merely applied an old art to a new use—*Kay* v. *Marshall* (2 W. P. C., 21).

Nor is the application of an old contrivance proper subject matter for a patent, unless there be ingenuity in the application, because the art or invention is not new.

Nor is the application of a substance hitherto unapplied to a useful purpose, such as a newly discovered grain for

food, or natural substance for manure, proper subject for a patent, because there is no invention, no manner of new manufacture in doing so.

Nor can valid Letters Patent be obtained for schemes in which ingenuity very similar to that which produces inventions—using the word in its patentable sense—is displayed; such as methods of advertising, or calculating, or financial projects, nor for designs in which the novelty resides in mere ornamental effect; for the last of which another and appropriate protection is provided by means of registration of the copyright in the design, a subject which is dealt with in Part III. of the new Act, and the general principles of which are explained in chapter II.

But the above remarks must be taken with the qualification that if any process, method, or machine is, for the objects indicated above, not patentable, it is not on that account rendered incapable of protection by patent. The patents for these things will be perfectly valid if taken out for the method, the process, or the machine itself, and protection is not sought for the idea involved in its use. The method, or process, or machine, forms a new manufacture within the meaning, as construed by the courts, of the 6th section of the Statute of James, and as such is patentable.

For the sake of convenience, however, it may be well to endeavour roughly to classify the inventions for which valid Letters Patent may be granted, and the following is a useful list:—

1. New contrivances applied to new objects or purposes;
2. New contrivances applied to old objects or processes;
3. New combinations of old parts;
4. New methods of applying an old thing;
5. Processes or methods differing from old processes or methods only by the omission of something hitherto believed to be essential;
6. Chemical processes—(Johnson on Patents, 4th edition, p. 18);

To which the editor would add:—

7. The application of materials previously unapplied to any useful purpose, to specific useful purposes, where some ingenuity is required in the application

—C. J. Tindal in *Muntz* v. *Foster* (2 W. P. C., p. 103).

It is evident that the first class in this list satisfies the fullest requirements of novelty in the invention. If both the contrivance be new and the purpose be new, the result must be novel, and a new manufacture introduced to the world. The case of an invention for removing the downy fluff which covered cotton lace when it comes from manufacture will serve to illustrate this. The invention consisted in applying the flame of gas in a particular manner for the purpose, which it answered completely. Upon a patent being granted, its validity was contested, and at the trial it was proved (1) that gas had been never so applied before, and (2) that the fluff had never been removed from cotton lace before. So, both the contrivance and the purpose being proved to be novel, the patent was upheld—*Hall* v. *Jarvis and Boot* (1 W. P. C., 100).

With regard to the second class in the above list—a new contrivance applied to an object before known—it is evident there is a new manufacture, not indeed using the word in the sense of the article produced, but in the sense of the new manner of producing it, that is to say, the new manner of producing the old article is itself a new manufacture. It is doing something which has not hitherto been done; and if the object produced by it is better or cheaper than the same object produced by the means or contrivance before known, there is clearly an invention of value. In a case where the invention was for an improvement in the smelting of iron, and consisted only in the use and application of lime and mine rubbish, in addition to the means ordinarily adopted, the patent was held good, it being laid down "that there might be a valid patent for a "new method (*i.e.*, contrivance) of applying materials

"previously in use."—(L. C. Eldon, *Hill* v. *Thompson* (6 Mer., 626, 1 W. P. C., 237).

From the nature of things one would expect that inventions of this class would probably be the most numerous. Intelligent persons engaged in manufacture are naturally led to notice the imperfections in the methods or processes by which they work, and to endeavour to effect their removal. On reflecting upon the nature of the article which they are manufacturing they may conceive the idea of effecting its production by other contrivances or methods, and, after experimenting for a while, succeed in finding simpler means than those hitherto in use. And the fact coincides with the expectation, for, on examining the list of Letters Patent which have been granted, we find that inventions of this class appear most frequently; and any one acquainted with the subject would further tell us that not only are they the most numerous, but that in many instances they are the most important of all inventions.

Passing on to the next, or the third of the classes of inventions—new combinations of old parts—it will be seen that the claim to protection for inventions of this nature rests also upon the ground that by them also is a new manufacture introduced into the world. The old parts may be compared to the letters of the alphabet; the old combination to a word already in use, the new combination to a new word introduced into the vocabulary of the language. By a different arrangement of elements already existing something new is the result, and this is subject matter for a valid patent, provided the other great requirement of the law—*that it be useful to the public*—be satisfied. The case most generally cited as showing this doctrine upheld in our courts is certainly a strong one.

In the process of smelting iron the hot air blast had been used and the fuel known as stone coal had been used, but never together. A man obtained a patent for the use of them together, and it was found that a considerable

advantage resulted. The validity of the patent was contested on the ground that the alleged invention showed no novelty—the two things used were both as old as the hills. But the court held that the invention consisted in the combination, that the patent was granted for the combination, and, since the combination had been found to be useful, that the patent was a valid one—*Crane* v. *Price* (1 W. P. C., 408).

The next class of invention is for a new method of applying an old thing. Here, too, it is evident there is a new manufacture, provided the new method produces results different from and superior to those produced by the old. In this consists the test of invention. If the product of the new method of applying the old thing or process is better than that produced before there has been a benefit to the community; there is invention. The case in which a patent was taken out for using charcoal for refining sugar in a particular way when charcoal had long before been used in other ways, illustrates this doctrine. The patent was contested. It was proved at the trial that many advantages had resulted from the particular method of using the charcoal protected by the patent, and it was upheld—*Derosne* v. *Fairie* (1 W. P. C., 154).

The next class in our list is that of inventions of processes or methods differing only from processes previously known by the omission of a step or steps in them. In this case the claim to patent right rests upon the same ground as in all the others—that there is substantial invention disclosed by the specification.

By the omission of a step, believed before the invention to be essential, the process or method may be very greatly improved, simplified, or cheapened. This was the case with a patent which was taken out for welding iron tubes without the use of a mandril or internal support. Previously to this invention iron tubes were manufactured by turning up the edges of plates of iron round a mandril and hem-

mering them together. By the new process the tubes were produced by turning up the edges of plates until they almost met, and in then drawing them when heated through a die, by means of which the edges became welded together. But welding by means of pressure was old, and the patent was held to be good expressly on the ground of the dispensation with the use of the mandril, whereby tubes could be manufactured longer, more uniformly and cheaper than before—*Russell* v. *Cowley* (1 Webs. P. C., 457).

The next class is that of chemical processes. Instances in which patents were granted and upheld for them are the following:—

For mixing two or more substances in certain proportions resulting in a compound, useful for medicinal, manufacturing or other purposes, the cases of *Muntz* v. *Foster* (2 W. P. C., 103), and *Bewley* v. *Hancock* (6 De G. M. & G. 402).

For purifying coal-gas by a chemical process, the case of *Hills* v. *The London Gas Co.* (5 H. & N., 312). For the preparation of dyeing materials, the cases of *Steiner* v. *Heald* (6 Exch., 607), and *Simpson* v. *Halliday* (5 N. R., 340; L. R. 1 H. L., 315), and for extracting useful manure from sewage water, the case of *Higgs* v. *Goodwin* (E. B. & E., 529).

The last class in our list of inventions for which Letters Patent may be validly obtained is that comprised under the heading of "the application of materials previously "applied to any useful purposes to specific useful purpose, "where some ingenuity is required in its application."

The ground upon which the claim to protection for this class of invention rests is undoubtedly the introduction of a new manufacture to the world. A material has been in existence in the earth and no useful application has ever been made of it. It is the merit of some one to have conceived the idea of applying it to some specific purpose; he makes the experiment; he finds under what conditions the previously valueless material may be usefully employed;

surely he is entitled to a return from the community for the benefit he has conferred upon them, viz.: the bringing into the use, the commerce and the riches of the world, a new element, previously either unknown or disregarded, especially when this return takes the form of a monopoly of the use of the particular material for the purposes to which he has applied it for a limited period. This doctrine has received judicial sanction in the following words of Chief Justice Tindal, when charging the jury in the case of *Muntz* v. *Foster* (2 W. P. C., 103):—"I look upon it that there is as "much merit in discovering the hidden and concealed virtue "of a compound alloy of metal as there would be in dis- "covering an unknown quality which a natural earth or stone "possessed. We know by the cases which have been deter- "mined *that where such unknown quantities have from the* "*result of experiments been applied to useful purposes of life,* "*that such application has been considered the ground and* "*the proper ground of a patent.*"

We desire only to add to this section this one remark, that although as a general rule it will be found that all inventions for which Letters Patent have hitherto been granted, come within one of these heads, or perhaps several of them, according to the point of view from which they may be regarded, yet since inventive genius covers the whole ground of human thought and industry, it may not improbably happen that an invention will be made which cannot fairly be brought within any one of them. Now it must not from that circumstance be presumed that this invention is therefore unpatentable. Reference must be made back to the first principles and broad grounds upon which the law relating to Letters Patent rests, and which this classification has been attempting to elucidate but not to confine, and the invention must be examined, in order to see if it be the proper subject for Letters Patent, by these questions—Is it new? Is it useful? Is it a new manufacture? And when they can all be answered in the

affirmative, one may be sure that a valid patent may be obtained.

SECTION III.

To whom Letters Patent may be granted.

1. The person to whom Letters Patent may be granted must be the true and first inventor of the invention for which they are obtained.* The person who first introduced an invention within this country was long considered to be its first and true inventor here, and patents used to be indifferently granted to first inventors or first importers. Thus a system grew up of granting Letters Patent to persons upon their representing that they were in possession of a certain invention, and that it had been communicated to them from abroad by such a one, mentioning his name, and an examination of the list of patents, granted for very many years previously to the passing of the recent Act, would show a considerable proportion of the patents issued, granted as communications from abroad. It was the constant habit of patent agents to take out the patents in their own name as communications from their correspondents abroad, a course which possessed some advantages of convenience.

The object which induced our forefathers to construe first introducers of inventions as first inventors is obvious. It was their desire to foster manufactures in this country, and they thus encouraged a man, who from travel abroad had learned processes of manufacture unknown in this country, to introduce them here by giving him a monopoly of their use for a limited period. And this policy has been, to a great extent, successful. But it is evident that by permitting its existence the interests and the rights of the foreign inventors were overlooked.

Before the practice, which was only a comparatively

* See, however, section 5, sub-section 2 of the Act and note thereon.

recent one, of requiring the applicant for patent to state from whom he had received the communication arose, a man might obtain a patent by simply stating in effect that he had acquired a knowledge of the invention abroad; and after the practice of requiring the name of the communicant to be stated had become general, there was no guarantee that the communicant was himself the true and first inventor; indeed the applicant for patent was not even required to state his belief that his informant was so. Thus a foreign inventor might be robbed of his right to obtain patent in this country.

No doubt if a person obtained a patent for this country under such circumstances as would show that he did it on behalf of his communicant, the courts could and did compel him to execute his trust by using the privilege he had obtained for the interests of his communicant, or *cestui qui* trust, or to assign it to him when called upon to do so. It was under this protection that foreign communicants so largely made use of the practice of obtaining Letters Patent in the names of their patent agents in this country, and it is to the credit of that body that instances were so seldom heard of any difficulty resulting from it.

The new Act of 1883 has, to a very considerable degree, affected this practice, and the reader is referred to sections 4 and 5 thereof, and to the notes thereon, where he will find the subject fully discussed.

2. A patent may be granted to any number of joint inventors. The reader is referred to section 5, subsection 2, and to the note thereon, where he will find some important questions fully discussed.

3. So long as the person to whom the patent is granted is the true and first inventor, it does not matter whether he be a citizen of this country or a foreigner.

4. If a person has conceived the idea of an improvement, he may employ other persons to work out the details, paying them for their labour, and yet be entitled to take

out the patent in his own name alone; and the patent so obtained will not be afterwards avoided by evidence that the persons employed made suggestions of subsidiary improvements to the primary idea.—*Allen* v. *Rawson* (Tindal, C. J., 1 C. B., 567; *Minter* v. *Wells*, Alderson B. directing the jury (1 Webs. P. C., 127). It is evident that the merit of the invention is due to the person conceiving the idea and employing the others to carry it out.

5. If there be several simultaneous inventions both arriving at the same result in *bonâ fides* and in ignorance of each other's labours, the first who takes out the patent is entitled to bar the others from it. This rests upon the principle of public convenience. The object of protection to inventors by Letters Patent is to obtain for the public the benefit of the invention; therefore he who satisfies the other requirements of the law, and who first applies for Letters Patent, thereby making known his invention to the public, is preferred to the person coming afterwards—Dolland's Case, cited in *Boulton* v. *Bull* (2 H. Bl. 469; *Forsyth* v. *Riviere*, Chit. Prerog. Cas., 182).

6. It is no objection to the validity of a patent if, after it has been granted, it appears that some one had invented the thing before and kept it a secret. In order to avoid the patent there must have been a prior publication of the invention—Case of Dolland's Patent, cited in *Boulton* v. *Bull* (1 W. P. C., 43). Although it is clear that the patentee in this case is not the first inventor in the sense of the first finder out of the invention, yet he is the first to give the benefit of it to the world, so that the law gives him the benefit of the patent.

In pursuance of this principle it has been held that the person "is the inventor and discoverer who finds out and "introduces a manufacture which supplies the market, for "useful and economical purposes, with an article which was "previously little more than the ornament of a museum"—Stuart, V.C., in *Young* v. *Fernie* (4 Giff., 611).

Lord Westbury, L.C., in the House of Lords, in the case of *Betts* v. *Menzies* (10 H. L. Ca., 117), said:—"A barren "general description, probably containing some suggested "information or involving some speculative theory, cannot be "considered as anticipating, and as therefore avoiding, for "want of novelty, a subsequent specification or invention "which involves a practical truth productive of beneficial "results, unless you can ascertain that the antecedent publi- "cation involves the same amount of practical and useful "information. . . It is possible that a suggestion con- "tained" (in such a description) "may lead to the inven- "tion contained in the other. But it is this latter alone "which really does add to the amount of useful knowledge: "it is the latter alone which, by its practical operation, "confers a benefit upon mankind within the meaning of "the patent law."

SECTION IV.

What are the Necessary Ingredients of an Invention for which a valid Patent may be obtained.

There are three ingredients necessary to support patent granted for the protection of an inventor, and these are invention, novelty, and utility.

1. Invention.—The first of these, "invention," may be dismissed, after what will have been gathered from what has already been said on the subject, with the remark that to merit this term "invention" there must have been an exertion of the inventive faculty. This is apart from the question of novelty; it is quite possible, indeed it every day happens, that men by a process of reasoning of their own, by the exercise of their own constructive abilities, discover independently things which have been already known or used in the world, and this is "invention" in the sense in which the word is used here. It is not of itself sufficient

to support a claim to Letters Patent, because for that purpose, in addition to being actually found out by the claimant, the thing invented must be novel, that is previously unknown, and useful. This is essentially necessary as one of the ingredients of an "invention" used in its patent law sense. It is the actual discovery of something new, or the construction of something new by a ratiocinative process of the mind, aided by experiment and mechanical appliances.

Passing on now to the second ingredient, "novelty," it will be necessary to enter into an enquiry as to what amount of *novelty* is necessary to support Letters Patent. It is a trite remark "that there is nothing new under the sun"; *and no doubt this is perfectly true if* the newness referred to is meant to be something completely novel in its whole aspect, entirely new in its inception, execution, and detail. Such novelty does not exist in the world. The mind of man works more slowly; ideas completely carried out to perfection do not come from the human brain, like Minerva springing ready armed from the head of Jupiter; things in actual existence attain form and value by slow degrees and progressive steps, and in no condition can they be said to be in a state of perfection, for improvements are always possible. It is in this sense and this sense only that "there is "nothing new under the sun." Yet it is equally true that any intelligent man examining thoroughly any subject, and acquainting himself with all that is previously known about it, will in the vast majority of cases, at the end of his labours, be in a position to add many things to the knowledge relating thereto, already possessed by the world. His critical examination of a process or a machine will have shown him inconveniences in the one and imperfections in *the other, for which he perceives the remedy; and although* the improvements which may occur to him do not effect a revolution *in the* whole matter, yet frequently, more frequently than the reverse, it will be found, if his studies have been thorough and painstaking, that they possess

practical value. Some of these improvements, no doubt, are of infinitely greater value than others; some of them mark an epoch in the history of science and manufacture. Amid the numberless improvements and patents of which the steam engine has been the subject, and which have brought it to the highly efficient state in which we know it at the present time, that of James Watt stands out distinctly from all others. His name will be ever associated with the steam engine; and no one is ignórant that he effected the greatest improvements in it, though, comparatively but few, have any idea of what those improvements were; while the names of other numberless inventors, who have contributed in only a less degree than Watt to the perfection of the steam engine, are unknown or forgotten.

Thus it is with invention—a continual progress of improvements, comparatively small, but all tending towards ultimate perfection, and which, though with difficulty appreciated by the outsider, are yet found, upon candid examination by the expert, to be of a substantial character.

Regarded in this way, there is not found to be that clashing between inventors with regard to the same inventions which is sometimes represented as existing. A careful and candid examination of any invention well described will nearly always discover points, and substantial points, of novelty and distinction between them.

It is true that it is unfortunately the habit with inventors, in common with the rest of mankind, to believe themselves entitled to greater merit than they in fact possess, and to claim to have invented more than they have really discovered. It is owing to this tendency that the clashing, so far as it exists, is due.

But a knowledge of the principles upon which the law relating to this subject rests, and a careful study of the matter itself, will tend to obviate this altogether. It cannot be too strongly impressed upon those who are in the habit of advising inventors, that in the vast majority of

cases the person who believes himself to have discovered something has in fact, indeed, done so, and that the effort in preparing the specification, preparatory to obtaining the Letters Patent, should be to discover what this is, to clearly define it beyond the possibility of mistake in the description, and to strictly limit the claim to invention thereto. It should not be the object of a loose description and grasping claims, expressed in general language, to render the ground covered by the invention, and consequently by the patent, as great as possible. It is this that causes the difficulties in patent matters, and brings the protection to inventors by Letters Patent into disrepute with the general public.

2. NOVELTY.—The reasons why novelty is an essential requisite for an invention to be protected by patents are—(1) because no one can be deprived of the right to use a known art or trade; and (2) if an invention be known, there is no consideration from the patentee to the Crown to support the contract under which the Letters Patent are granted to him.

It is sufficient, however, that the invention be novel to the public, for we have seen that the patent will be properly granted to the first applicant, although the invention may be previously known to some one or more persons who may have invented it independently, and who have not made any public use of it—*Dolland's Case* (1 W. P. C., 463). And the circumstance that an invention for which a patent has been granted relates to the same subject, or seeks to attain the same object as another invention for which a patent has previously been obtained, is no objection to the subsequent patent on the gro[illegible]f want of novelty, so long as the means whereby the tw[illegible]inven[illegible]ns seek to attain the same end can be clearly distin[illegible]d from one another. Nor even if the exercise of o[illegible]nvention involves the use of another, for which a patent has previously been granted, in order to effect the object to attain which it is directed, is a

patent granted for the subsidiary invention invalid; because if there is an improvement upon the previous invention a patent may properly be granted for that improvement—*Crane* v. *Price* (1 W. P. C., 413). If the patent for the preceding invention be still in force it will, of course, not be open to the subsequent patentee to exercise his invention without the permission of the proprietor of that patent; but, on the other hand, the owner of the preceding patent cannot make use of the improvements protected by the subsequent patent without the permission of the patentee. Each patentee and his representative is limited to the use of his own monopoly—that is, what each has himself invented. The proposition of law upon the subject is, that it is open to any one to improve upon anything at present existing, and to obtain the privilege of exclusively using his improvements by a patent, but he cannot by so doing interfere with or abridge the rights already vested in others.

When a patent is in existence for a certain application of a known thing or appliance, which as we have already seen, is the proper subject for a patent, it does not prevent another and subsequent patent for a different application of the same thing or appliance, provided, of course, that the two applications are clearly distinct. The following example will illustrate this doctrine:—

A patent was obtained for packing hydraulic and similar machines, with the object of rendering them at the necessary parts air and water tight. The substance or thing used for the purpose was a lining of soft metal. A subsequent patent was taken out by another inventor for the application of the same substance or material to the purpose of diminishing the friction of parts of machinery in rapid motion, and obviating the generation of the heat excited by the friction. Here were two applications of the same thing—one to render machinery air and water tight, the other to render machinery frictionless. The first patentee maintained that the second patentee infringed his patent, and sued him

for doing so, but the Court held the two applications were substantially different; that the second patentee had made an independent invention, and that his patent was consequently valid—*Newton* v. *Vaucher* (6 Exch., 859).

The publication of an invention before the date of the Letters Patent by which it has sought to be protected, either (1) in a book or other work in circulation, or (2) by a public use of it anywhere, renders the patent void. The reason for this is, of course, that the public had a knowledge of the invention, or, at least, the means of knowing it, before the date of the patent. But it is necessary that there should have been substantial publication to vitiate the patent, and we will endeavour to ascertain what species of publication does and does not render a patent subsequently granted void—(1) when it takes place by description, and (2) by use.

1. DESCRIPTION.—Of course, if a description of the invention occurs in a specification, filed in pursuance of previously granted Letters Patent, or in a book in circulation in this country before the date of the patent, from which a sufficient knowledge of the invention could have been gained to enable its practice, it follows that there is no invention in the patent law sense of the word, and the patent is absolutely void—*King* v. *Arkwright* (Dav. P. C., 129); *Hill* v. *Thompson* (8 Taunt., 875). But a mere general description, whether contained in a prior specification or in a journal or book in actual circulation indicating or shadowing forth an invention which it does not practically explain, will not be sufficient to avoid a patent subsequently granted for the invention carried out in a practical, workable manner. This is the effect of the judgment of the highest tribunal in the kingdom, in the case of *Betts* v. *Menzies* (10 H. L. C., 117), and, indeed, it is only carrying out the principle upon which patents for inventions are granted. They are granted to reward the introduction into the country of a new manu-

facture. Now, an idea, however described or indicated as being capable of being carried out into actual use, is not a new manufacture; but when the practical carrying out of the idea is effected, a patent is granted and upheld to him who has practically carried it out into a manufacture.

It may be a question whether the principle on which the decision in *Betts* v. *Menzies* proceeded does not extend to those cases where, after a manufacture or art has been in use in past times, but its practice has been neglected, it is now altogether forgotten. If a man in such circumstances should re-invent the art or manufacture, and succeed in reducing it to a practicable shape, and a patent should be granted to him, would it be upheld if impeached on the ground of want of novelty? It is apprehended that the argument upon which the decision in *Betts* v. *Menzies* was rested goes to support the proposition that in such a case the patent would be upheld. The re-introduction of a lost manufacture may be as meritorious as the discovery of the new one; and it is difficult to distinguish between the establishment of an art which has been practised ages ago, and long lost to the knowledge of man, and the bringing into operation of one which has been found out for the first time—See Lord Brougham in *Household Coy.* v. *Neilson* (1 W. P. C., 717).

It is important also to notice that if the publication be a book, that it be actually published or sold here, or be in a place such as a public library, where reference can readily be made to it, the importation of a foreign book containing a description of an invention would not invalidate a patent subsequently granted for it, unless there had been an actual publication and offer of sale to the public—*Lang* v. *Gisborne* (Beav 81, 133); *Plimpton* v. *Spiller* (L. R. 6, Ch. D., 412).

It does not matter, of course, if the invention be described in the publication whether the patentee derived his

knowledge of the invention therefrom or not—*Stead* v. *Williams* (2 W. P. C., 142).

2. As to prior Publication by Use.—The public use of an invention at any time before the date of the Letters Patent by which it is sought to be protected, will render them void when granted. This is because the public use of an invention shows that there was a public knowledge of it; and, since any one seeing it in use might, in the absence of any exclusive privilege relating to it, have used it previously himself, he cannot, by the subsequent grant of a patent, be deprived of the right or privilege of which he is already in possession—*Tennant's Case* (Dav. P. C., 429); *Lewis* v. *Marling* (1 W. P. C., 490).

It is further not necessary that this use should have been general as well as public in order to avoid the patent. In a case where a man had constructed a peculiar kind of lock, and had it placed on a gate where it was in actual use, open to public inspection for years, and a patent was afterwards obtained for this lock, it was held, on these facts being proved, that the patent was void on the ground of prior use—*Carpenter* v. *Smith* (1 W. P. C., 530).

It is not necessary that the use of the invention should have been continued up to the time of the patent being granted. If the use at some period before the date of the patent be clearly proved, it will be void; so long as the use has not occurred so many years before, that the invention may be presumed to have been forgotten—*Household Company* v. *Neilson* (1 W. P. C., 709).

The prior use of an invention, evidenced by the sale of even one article manufactured according to it before the date of the Letters Patent by which it is sought to be protected, will render them void—*Losh* v. *Hague* (1 W. P. C., 202).

It is apprehended, however, that the prior secret use of an invention before the date of Letters Patent will not render them, when subsequently granted, invalid—*Dollands'*

Case (1 W. P. C., 43),—unless the use be of such a nature as to have enabled the public to have gained such a knowledge of the invention that anyone acquainted with the subject to which it relates could have exercised the invention himself. We have seen that one ground upon which the grant of Letters Patent rests is the full disclosure of the invention, so that anyone may at the conclusion of the period of protection put in practice for himself. In the case of a patent granted after such a limited prior secret use, as we are here speaking of, the public have not gained the knowledge; it is the disclosure of the invention made by the patentee in his specification which renders it public, so that the consideration, in respect of which the patentee is granted his patent, exists.

The fact that experiments have been made with an invention before the date of Letters Patent granted in respect of it does not render them void so long as the experiments have been conducted as such, and not to such a degree as may fairly be considered to constitute a public use of the invention.

In a case in which it was objected that the invention could not be considered as new at the date of the Letters Patent, because the invention had been published and come to the knowledge of the world in the course of experiments which had been made with it before the patent was taken out, it was judicially laid down "that a mere experiment, "or course of experiments for the purpose of producing "a result which is not brought to completion, but begins "and ends in experiments, will not, although known to "several persons, prevent a subsequent inventor, who "brings the invention to perfection, from maintaining a "patent for it." In this case there had been experiments made before the date of the patent, tending almost, if not entirely, to the same result as that for which the patent was granted, and they were known to many persons, but it was laid down "that if they rested in experiment, and

"experiment only, and had not obtained the object for "which the patent was taken out, the patent would not be "invalidated for want of novelty in the invention"—*Galloway* v. *Bleaden* (1 W. P. C., 529). And in a case in which it was a question whether a certain description of carriage wheels was novel at the date of the patent, and it was proved that another man had used similar wheels before the date of the patent, it was laid down "that "if the previous use was experimental and had been "abandoned, it was no ground for saying the patent was "not good"—*Jones* v. *Pearce* (1 W. P. C., 122).

Upon this question of previons experiment or partial use and subsequent abandonment, it has always been considered, and justly so, that the abandonment showed that the experiment was unsuccessful, and the invention incomplete; while the fact of the invention protected by the patent being in actual use and infringed, showed that it had taken a step further than the previous experiments had brought it, and suppiied the missing link by means of which it was rendered practically useful and successful.

A confidential disclosure of an invention to various persons before the date of the Letters Patent does not render them invalid. It would be hard indeed if this should be the case, and the law accordingly is very clear upon the point, giving ample protection in circumstances of this kind. The leading case establishing this doctrine is one where two pairs of paddle wheels constructed upon an improved method were made some months before the application for the Letters Patent, which were granted for them, by an engineer from the instructions of the inventor under an injunction of secrecy. The wheels were then sent abroad and used in steam boats belonging to a person who had paid the engineer for making them, and who was also in treaty with the inventor for a partnership or for an interest in the invention. On the patent being afterwards granted, it was contested on the ground that the invention at the date of

the patent was not new in consequence of this disclosure. But it was held that this was not such a publication of the invention as would defeat the patent—*Morgan* v. *Seaward* (1 W. P. C., 194); see also *Newall* v. *Elliott* (4 C. B., N. S., 269; 27 L. J., C. P., 337).

But it should be remembered that if an inventor incautiously communicates his invention without any conditions of secrecy to a stranger, through whom, without any intention of fraud upon his part, the invention gets into use, the patent subsequently obtained for it will be invalid —*Earl of Dartmouth* v. *Darrell* (3 Mod., 77). The reason for this is that then the public will have acquired a knowledge of the invention, and the inventor has nothing to give, no disclosure of anything before unknown to make, as a consideration for the Letters Patent conferred upon him. He has, however unwittingly, made a present of his invention to the public, who cannot be deprived of the rights they have already acquired by Letters Patent granted to the inventor after his invention has become known.

But the inventor is protected against the fraudulent publication (see section 35 of the Act) of his invention by persons who have been employed by him confidentially in carrying it out, and they cannot thus gain a knowledge of the invention and then set it up against their employer. If, indeed, through their conduct the invention has become publicly known to persons innocent of the fraud to any extent, the inventor cannot afterwards obtain a valid patent, except where such publication takes place after the application for a patent in fraud of the true inventor (see section 35 of the Act); nor can the fraudulent publishers derive any advantage. The invention passes into the "public "domain," and, as we have seen, the public cannot be deprived by Letters Patent of the right to use an invention, the knowledge of which they already possess; but the Courts are always ready to assist and protect an inventor under such circumstances so far as is possible, and

an injunction will be granted to prevent use or publication of an invention the knowledge of which has been gained under such circumstances—*Morison* v. *Moat* (15 Jur., 787; 9 Hare, 241, on appeal, 16 Jur., 321).

We would only further add now upon this question of novelty that in order for the patent to be valid it is necessary that all that is represented and claimed by the inventor as his own invention should be novel at the date of the Letters Patent. Most inventions are improvements, and many improvements are sometimes included in the same patent; but if any one of these be old, although all the others be new, the patent is invalid for the whole, the new parts as well as the old, until the patent has been amended by the elimination of the old parts—*Hill* v. *Thompson* (8 Taunt., 375); *Gibson* v. *Brand* (4 M. & G., 179).

The reason for this is somewhat technical: It is because the consideration for a grant of Letters Patent is what is legally called entire, and if a part fails the consideration cannot support the grant, and the whole fails. The patentee, too, on petitioning for the grant of patent to him, represents that his invention, as a whole, is new, while a portion of it is, in fact, old. He has, therefore, made an incorrect suggestion to the Crown, by whom the patent was granted to him, on the presumption that the representation he made was correct; and thus the patent fails by reason of the false suggestion.

There is a method of curing Letters Patent defective in this respect—new as to part of the subject matter described in the specification, and old as to the rest—by amendment by way of disclaimer and memorandum of alteration, as to which see sections 18 to 21 of the Act.

3. Utility.—Turning now to the third necessary ingredient in an invention for which Letters Patent may be properly granted, we find that it must be useful to the public; that is to say, that it must effect the object for which it is intended in a better manner than has been done

before. Questions turning upon the utility of an invention occur more rarely in litigation in patent cases than those turning upon novelty. The reason for this consists in the fact that if a patent is disputed upon this ground it is necessary to raise the matter upon the pleadings, and it requires to be found by the Court or jury as a fact that the invention for which the patent was granted is not useful in order to invalidate it upon this ground. But evidence upon a matter so purely one of opinion can always be found sufficient to satisfy the tribunal before whom the contention is being tried that there is some utility in the invention, and patents have so seldom being successfully contested on this ground that it is now generally hardly thought worth while seriously to insist upon it.

The reason why a patent is void if it does not possess utility is the one which we have so frequently mentioned—the failure of consideration.

The inventor in petitioning for his grant of Letters Patent, used to be required to represent that his invention is "of public utility" as well as novel, and the patent is granted to him in consideration of its being so; if, therefore, the invention was found afterwards to be devoid of utility the consideration upon which the patent was granted fails, and the Crown granted it upon an incorrect suggestion that the patent was novel.

The form of declaration prescribed by the new Act to be made by an inventor on applying for the grant of a patent no longer requires any representation as to utility.

The reason why this representation was required from the inventor, so that a patent would not issue without it, and if incorrectly made the patent granted was void, is to be found in the great principle, as old as the common law itself, that the Crown in an exercise of its prerogative, such as a grant of Letters Patent, must exercise it for the benefit of the public. It is for the benefit of the public that useful inventions be encouraged; it is to their detriment that monopolies

of useless things be granted. Patents for useless things tend to the obstruction and detriment of trade, and are therefore invalid on that ground. It was accordingly judicially laid down in a case where it appeared that a patent had never been worked and was only brought forward to obstruct another person in a course of improvement, that to do so was a fraud upon the Crown—Per Pollock, C.B., *Palmer* v. *Wagstaffe* (9 Exch., 494).

It is sufficient, however, if the invention is not devoid of utility and it is of some use to the public, provided the Crown has not been deceived as to the extent of its usefulness. It was judicially laid down that it was not for the jury to consider the extent to which the invention was useful, but whether it was of any use or not, and that it was sufficient if there was *some* use—Alderson B., *Morgan* v. *Seward* (1 W. P. C., 172).

Similarly, where a portion of what is described as the invention turns out to be unnecessary and useless, the inutility of this portion of the invention will not render the patent bad, provided it be not essential. This principle is illustrated by a case in which the invention was for shearing woollen cloths. A certain description of brush was described in the specification for raising the wool, but, in practice, this brush was found to be useless and it was abandoned. It was objected to the patent that, as part of the invention was useless, the whole patent was bad (as we have seen a patent is when one part of it is found devoid of novelty); but it was judicially determined that, as the patentee did not claim the brush as an essential part of the invention, its inutility did not invalidate the patent—*Lewis* v. *Marling* (5 M. & R., 66; 10 B. & C., 22).

But it is important to bear in mind that where several improvements, each capable of being considered as a distinct invention, are comprised within the same Letters Patent, each improvement or invention must be of some utility to the public or the patent will be void. And if any material

misrepresentation has been made when petitioning for the patent as to the utility of the invention, the patent is also void, because then the Crown was deceived when making the grant. Where a patent was granted for making three things, and use of them could not be made at all, the patent was held to be invalid—*Turner* v. *Winter* (Dav. P. C., 145).

It must also be remembered that it is not enough to satisfy the requirements of the law as to utility, that the article produced be useful, it must be the invention itself that effects the utility. The article produced must be better in quality or cheaper in price—*Palmer* v. *Wagstaffe* (9 Exch., 494).

Lastly. Patents will not be granted, or if granted by mistake, are invalid, when the invention for which they are taken out are for immoral or illegal purposes. A patent for "housebreaking implement, picking pockets or locks," is invalid. And this is on the ground of public policy.

SECTION V.

The Title, the Provisional and Complete Specification, and the Claims.

In applying for a patent (see section 5 of the Act), the applicant has to state (see the form of application in the 1st schedule to the Act) what it is that he is desirous of obtaining an invention for. And this he must do by stating, or by describing in a short and general form, the nature of his invention; this short statement will be repeated in the patent when granted, and becomes the "title" of the invention and patent. As will presently be seen, both care and skill are required in drafting this title.

Accompanying the application there must be left either a provisional or a complete specification. If a provisional specification be sent, it must describe the nature of the invention (section 5, sub-section 3), and subsequently (see section

8) the applicant must leave a complete specification. The complete specification, whether left together with the application, or the provisional specification be first left and the complete specification subsequently, must particularly describe and ascertain the nature of the invention and the manner in which it is to be performed (section 5, sub-section 4).

The new Act in these respects only adopts the practice existing long before, and a great many decisions are recorded, and large amount of learning exists upon the important subjects of the title and the specifications of the invention. It is proposed to shortly state as much of this as will form a practical guide to the practitioner in the preparation of these documents, taking them in their order; 1. The title; 2. The provisional specification; 3. The complete specification; and, 4. The claims.

1st. The Title.

The title is the short and general description in which the inventor, when applying for a patent, summarises, as it were, his invention.

It ought accurately to describe the nature of the invention; it must not be too large so as to include anything more than the patentee has actually invented, and it must not be too narrow so as to exclude any part of the invention—Hindmarch, p. 43. If it be too large, that is if it extends to matters not included in the invention, the patent will be bad, because granted for more than the patentee has invented; if it be too narrow, so as not to cover some portion of the invention, then it excludes by its very terms something which the patentee had a right to obtain protection for, because the scope and powers of the patent are limited by the title.

The title must correspond and agree with the invention described and claimed in the specification—its language may be explained and reduced to a certainty by the specification—*Neilson* v. *Harford* (1 W. P. C., 312-373);—but the

title must not claim one thing and the specification another —*Croll* v. *Edge* (9 C. B., 479). The title should give some idea, and, so far as it goes, a true idea of the invention; it is sufficient if it be consistent with it. Since the title, which was always, under, the old practice, and, will probably, under the new practice introduced by the new Act, be made public by advertisement before the granting of the application, it is obvious that it is highly inadvisable for the title to state what the invention is, even in those probably very few cases where it could be stated so shortly, as to do so would be to inform rivals thereof before any protection has been obtained; while it is necessary that the title should include or cover the invention: it is obvious, therefore, that a good deal of care and skill are required in drafting it. Nothing, perhaps, but the experience of a lawyer or patent agent versed in such matters will be a sufficient guide in doing so; but the above axioms, which are the result of a long series of authorities on the subject too numerous to set out, and the following instances where titles have respectively been held bad and good, will prove the best guide short of actual personal experience, being, as it were, the recorded experience of other persons on the subject.

Before stating these instances, however, it is proper to observe that section 6 of the new Act throws a duty upon the examiner to compare the provisional or complete specification, whichever may have been left with the application with the title, and to see whether the latter sufficiently indicates the subject matter of the invention. A similar duty has hitherto been performed by the law officers by deputy through their patent clerks, and it is apprehended that the work will be more strictly performed by the examiners. If these functionaries perform their duties well, it may be anticipated that but few imperfect and inaccurate titles will escape their vigilance, and that the Comptroller will exercise his powers of requiring amendments in the title when defects therein are brought to his attention by his examiner.

But should any defective title escape the attention of the examiner, or, even if amended, still remain inaccurate, the fact of its having passed the examination will not preclude the objection being taken to the validity of the patent in any subsequent legal proceeding, whether for infringement or otherwise.

The following are cases where the titles have been held defective and the patents bad on that account :—

Title—"An improved method of lighting cities, towns and villages." The invention in reality was for an improved street lamp—*Lord Cochrane* v. *Smethurst* (1 Stark. R., 205).

Title for "Tapering brushes." But the specification described a brush in which the bristles were of unequal length, and there was no tapering to a point—*The King* v. *Metcalf* (2 Stark. R., 249).

Title—"A new or improved method of drying and preparing malt." The specification described a process for producing a colouring matter for beer by submitting ordinary malt to a high temperature. The object of the invention, therefore, was not *preparing malt*, but *colouring beer*—*Rex* v. *Wheeler* (2 B. & Ald., 345).

Title—"Improvements in the flageolet whereby the fingering will be rendered more easy and notes produced that were never before produced." In fact only one new note was produced—*Bambridge* v. *Wigley* (Parl. Report on Patents, 1829, Appendix, p. 197; cited in "Hindmarsh on Patents," p. 183); but with this case must be read *Nichols* v. *Haslam* (8 Jur., 474), where the title was "*Improvements* in the manufacture of plated articles"; but the specification described *one* improvement only, and the patent was held good.

Title—"A machine for giving a fine edge to knives, razors, scissors and other cutting instruments."

but the invention described in the specification was inapplicable for sharpening scissors — *Felton* v. *Greaves* (3 C. and P., 611).

Title—"A new and improved method of making double canvas and sailcloth with hemp and flax, or either of them, without any starch whatever." The invention was really a new mode of preparing and twisting the hemp or flax for making the canvas and sailcloth—*Campion* v. *Benyon* (6 Moore, 71; 3 B and A., 5).

The following are cases where objections have been taken to the patents on the ground of defective titles, but the titles have been held good—*Nichols* v. *Haslam*, mentioned when citing *Bambridge* v. *Wigley*:—

Title—"Improved application of air to furnaces." The invention really being the use of a heated blast of air—*Neilson* v. *Harford* (1 W. P. C., 333, per Lord Abinger).

Title—"Certain improvements in copper and other plate printing." The invention being giving paper, by means of a glazing composition, a surface which rendered the lines of copper-plate engraving more distinct—*Sturtz* v. *De la Rue* (5 Russ., 322).

Title—"Improvements in making bobbin net lace." The invention being for a mode of making spots in it—*Fisher* v. *Dewick* (1 W. P. C., 264, stated by Sir F. Pollock, 8 Q. B., 1036).

Title—"Improvements in carriages." Invention improvements in adapting German shutters to carriages —*Cork* v. *Pearce* (8 Q. B., 1044).

Title—"Improvements in the doors of and sashes of carriages." The inventor stated his invention was applicable in any position where doors and windows are subject to jar and vibration, as well as to railway carriages—*Oxley* v. *Holden* (8 C. B., N.S., 707).

Before leaving the subject of the title it should be care-

fully noted that evidence of a design on the part of the inventor to choose *a vague and general title* in order to avail himself, at the time of filing his specification, of an invention not discovered at the date of his patent, such invention being different from that for which the patent was originally taken out, would be evidence of fraud upon the Crown, and avoid his patent—*Cook* v. *Pearce* (8 Q. B., 1064). It is necessary in advising intending patentees to bear this in mind, for choosing a vague and general title, perhaps, for the purpose above indicated, is a fault to which patentees are somewhat prone.

2ND. THE PROVISIONAL SPECIFICATION.

Section 5, sub-section 2 of the Act requires the applicant for a patent to leave with his application either a provisional or a complete specification; and sub-section 3 requires that a provisional specification must describe the nature of the invention. Section 14 enacts that where an application for a patent has been accepted, as it may be when accompanied by a provisional specification (see section 7, sub-section 4) the invention may, during the period between the application and the sealing of the patent, be used and published without prejudice to the patent to be granted for the same, and such protection from the consequences of use and publication is called "provisional protection."

Provisional specifications and provisional protections were introduced by the Act of 1852. Previously to that Act no description of the invention, other than the mere general reference thereto contained in the patent, was required. But, on the other hand, the date of the patent when granted was not that of the application but the date of the actual sealing, except when the sealing of a patent had been delayed by an opposition, when the Lord Chancellor, in the exercise of his discretion, used sometimes to order the patent, when sealed, to bear the date of the

earliest day upon which it would have been sealed if there had been no opposition (Hindmarch on Patents, p. 537). During all the period that the application for the patent was pending the applicant remained without protection for his invention. This system was found inconvenient, both to the inventor and to the Crown as representing the public, since the publication of the invention, prior to the date of the patent, invalidated it when granted, because, as we have seen, it is the essential element of an invention for which a valid patent can be granted, that it should not have been known before the date of the patent. In many cases it was very difficult for an inventor to experiment and work upon his invention so as to perfect it without great danger of other persons becoming aware of it, and of its thus becoming published, or of these persons in fraud of the real inventor applying for patents themselves. And the absurdity of the Crown granting a patent for the use of an invention of which a mere indication only of its nature had been given by the title was sufficiently obvious. Therefore, the Act of 1852, required, as does the present Act, that an inventor on applying for a patent should deliver, together with his application, a description or specification of his invention. He might, if he chose, as he may still do under the present Act, deliver a full and final description thereof, called the complete specification; or he might, as he may still do, if he chose, deliver a preliminary description, called the provisional specification. If he adopted, or still adopts, the latter course he was and is still, required to subsequently deliver a fuller and final description called the complete specification.

Upon the applicant delivering this provisional specification, the application for patent was, after examination by the law officer, allowed by him, and the applicant then became possessed of provisional protection by the practice under the Act of 1852. Under the present Act, upon the applicant delivering this provisional specification, his application

for patent will be, after examination by a special officer, called the examiner, be accepted by the Comptroller, and, upon such acceptance, the applicant will be possessed of provisional protection. What provisional protection is we have already seen by section 14 of the present Act cited above. It enables the inventor, during the period elapsing between his application and the time when it is necessary to file his complete or final specification (nine months, section 8), to labour to perfect his invention undisturbed by any fear lest the publication of it should interfere with the validity of his patent rights.

It is proposed to endeavour to explain what a provisional specification is or should be, as distinguished from a complete or final specification. The distinction between the two is clearly accentuated by section 5 of the Act. Sub-section 3 says: "A provisional specification *must describe the nature* " *of the invention.*" Sub-section 4 says: "A complete specifi- " cation must *particularly* describe the nature of the inven- " tion *and in what manner it is to be performed.*" The provisional is to describe the invention so that it may be understood, the complete specification is to describe the invention, not only so that it may be understood, but also carried practically into effect.

"The office of the provisional specification is to describe the " nature of the invention, not with minute particulars, but with " sufficient precision and accuracy to inform the law officer " (now it is apprehended the Comptroller and his examiners) " what is to be the subject matter of the patent. It is not " at all necessary that the provisional specification should " describe the mode or modes in which the invention is to be " worked or carried out. . . . The filing of the pro- " visional specification protects the invention for six " months " (now nine months) . . . "The object of " this protection evidently is to enable the patentee to " perfect his invention by experiments, which, although " open and known, will not be a user and publication to

" the prejudice of Letters Patent to be afterwards granted,
" so that he may be in a condition to describe in his com-
" plete specification, as the result of his experience, the
" best manner of performing the invention. It clearly
" appears, therefore, that the complete specification is in a
" sense supplemental to the provisional specification, not
" going beyond nor varying from it, as to the nature of the
" invention, but conveying additional information, which
" may have been acquired during the currency of the pro-
" visional specification, as to the manner in which the
" invention is to be performed," per Lord Chelmsford, L. C., in *Penn* v. *Bibby* (L. R. 2 Ch., 127).

" A provisional specification is not intended to contain a
" complete description of the thing so as to enable any
" workman of ordinary skill to make it, but only to disclose
" the invention, fully no doubt, but only in its rough state,
" until the inventor can perfect its details "—Sir Geo. Jessell, M. R., in *Stoner* v. *Todd* (L. R. 4 Ch. D., 58).

Lord Blackburn, in *Bailey* v. *Roberton* (L. R. 3 App. Cas., at p. 1075), said " Look at the nature of the inven-
" tion in the provisional specification and say whether that
" which you have been doing, and which you say was a part
" of the patent, is fairly within the nature of the invention
" you have described in the provisional specification; in that
" case you are protected, but if it is a new and separate in-
" vention, and a different one, then you are not protected.
" I cannot but think that when that is once looked at, it
" becomes pretty clear that when the nature of an invention
" has been described in the provisional specification in the
" way which has been mentioned, if something were found
" out during the six months to make the invention work
" better—or with respect to the mode in which the operation
" may be performed—a thing which is very likely to happen
" when in carrying out his invention the inventor finds that
" some particular bit will not work so smoothly as he ex-
" pected, and that it is necessary to add a little supplement

" to it—still the nature of his invention remains the same,
" as it is no objection that, in the complete specification
" which comes afterwards, the invention or application is
" described more particularly and in more detail, or even if it
" be shown that there has been more discovery made, and
" so as to make the invention which he has described in
" the provisional specification really workable. If nothing
" more is done than that, I think it is good, but as soon as
" it comes to be more than that, and the patentee says in
" the provisional specification I describe my invention as A ;
" and in the complete specification he says I hereby describe
" A and also B, then, as far as regards B, it is void, because
" the patent was granted for the invention that was de-
" scribed in the provisional specification and does not cover
" the invention that is described in the other."

The great rule or principle to bear in mind in preparing all specifications whether provisional or complete, is thus expressed in strong and accurate language by gentlemen who possess an experience second to none in preparing these documents—

"The first thing that a patentee about to specify should
" bear in mind is that he is bound to act with *good faith*.
" There must be no studied ambiguity or equivocal lan-
" guage, no attempt to keep anything secret ; he must make
" a full disclosure of his invention ; and his whole specifi-
" cation must be fair, open, explicit and honest. If he
" acts in any other manner it will bear hardly with him when
" his specification comes to be examined in a court of justice"
—*Johnson's Patentees Manual, 4th edition, pp. 112, 113.*

Next, and this is a point which requires particular attention when drafting a provisional specification, is the definition of the invention, that is the statement of what the inventor wishes to be understood he has himself newly invented, so as to distinguish it from that which he admits to have discovered before, and does not regard as due to his own labours.

The inventor, or any one called in to aid him, will frequently find some difficulty in doing this with sufficient accuracy. The endeavour must be made to carefully think this out. What is it in my method or contrivance that is new? What have I added to stock of knowledge already possessed upon the subject? When this has been ascertained, then the endeavour must be to express it in clear and accurate phraseology. The purpose or object of the inventor should be sought for. When found it will generally prove to be the object of his invention. And it will generally be advisable to begin the provisional specification by stating the object of the invention. Then it will generally add to the clearness of the description if a short statement of what is now chiefly used is made, and then should follow what the inventor proposes to substitute for it. This may be expressed in a provisional specification in a concise form, not going very greatly into details, which subsequent experiment in working out the invention may considerably modify, and which may safely be left, and is better left, to be explained on the complete specification.

It is also necessary to bear strongly in mind that if the invention, in other words the points of novelty claimed in the complete specification, are not comprehended or covered by the terms of the provisional specification the patent will be invalid. Great care should therefore be bestowed on the provisional specification, to use language which will comprehend all that is likely to work out as the invention proceeds to be developed, as the points of novelty. This is not so easy in many cases to do as at first sight may appear. Inventors very often proceed to apply for patents for inventions, which, for fear of experimenting upon publicly, are not very much worked out, so to speak, and which, in the interval between the application and the delivery of the complete specification, are apt to somewhat change their form. A good deal of consideration and a large amount of knowledge on the subject are required, in order that language may be

selected which will allow for this. In the case of *Bailey* v. *Roberton* (L. R. 3, App. Cases, 1055), affirming the Scotch Court of Session, the provisional specification described an invention for preserving animal substances in a fresh condition, as consisting in the application of a definite mixture of an aqueous solution of gelatine with an aqueous solution of bisulphite of lime. The complete specification claimed as well, for the same purpose, the application of an aqueous solution of bisulphite of lime alone. And this was held to be not covered by the provisional specification, and the patent therefore invalid. It is probable that had due consideration been given to the matter when preparing the provisional specification it would have been perceived that the solution of bisulphite of lime would probably alone have answered the purpose, and by the insertion of a few words therein, the mistake have been avoided.

Another strong and most unfortunate instance is that of Edison's patent for the telephone, held invalid by Fry, J., because the phonograph was described and claimed in the complete specification, but not disclosed in the provisional specification, although admittedly portions of the provisional specification explained, or might be held to refer to, an instrument like the phonograph. Mr. Justice Fry remarked:—

"I agree that the provisional specification need not "describe the manner in which an invention is to be carried "into effect. I agree that it need not describe the nature "of the invention otherwise than roughly; but it ought to "do so fairly and honestly; and if Mr. Edison was, at the "time at which this patent was granted, in the possession of "that very remarkable mechanical invention by which speech "could be reproduced, not necessarily at a distance, but in "the same room as that in which it was uttered, I do not think "the provisional specification was an honest statement of the "nature of that discovery"—*United Telephone Co.* v. *Harrison, Cox, Walker and Co.* (L. R. 21 Ch. D., 720, at pp. 747).

The point of the variance between provisional and

complete specifications is one that has been frequently raised as an objection to the validity of patents when they have been contested in courts of law. The following cases are selected, in addition to the above, as examples; and a consideration of them will enable any one whose duty it may be to draft a provisional specification to understand the view taken by courts of law upon the matter, and guide him sufficiently in his task.

Perhaps the leading case in favour of the validity of the patent, and against the objection is *Newall* v. *Elliott* (4 C. B., N. S., 269; 27 L. J., C. P., 337), decided in 1858. The title was "Improvements in apparatus employed in laying down "submarine electric telegraph wires." The provisional specification described the invention in these terms, so far as affects this portion of the question: "The cable or rope con- "taining the insulated wire or wires is passed round a cone, "so that the cable, in being drawn off the coil, is prevented "from kinking by means of the cone, and there is a cylinder "on the outside which prevents the coil from shifting in its "place." In the complete specification the description, after repeating the above description, proceeds:—"When "the wire is to be laid down, I place over the cone an apex, "or top, which is conoidal, or conical, and round this I "suspend several *rings* of iron or other metal by means of "cords so as to admit of adjustment at various heights over "the cone. The use of these rings is to prevent the bight "of the rope from flying out, when going at a rapid speed, "and the combination of these parts of the apparatus pre- "vents the wire from running into kinks." And the inventor claimed—"First, coiling the wire or cable round a "tube; second, the supports placed cylindrically outside the "coil round the cone; and thirdly, the use of *rings* in com- "bination with the cone as described." Thus the provisional specification having omitted all reference to rings to be used with the cone, the complete specification described and claimed the exclusive use of them. It was held that the

patent was not rendered invalid by the omission to mention these rings in the provisional specification. Mr. Justice Byles said: It was objected "that the provisional specifi-
"cation contained no mention of the rings claimed in the
"complete specification; but the office of the provisional
"specification is only to describe generally and fairly the
"nature of the invention and not to enter into all the
"minute details as to the manner in which the invention is
"to be carried out, otherwise the provisional specification
"must be as full as the complete specification and drawn
"with as much care and deliberation." It will, of course, be noticed that the winding of the cable round a cone and preventing the cable from kinking by means of something restraining it on the outside was the essential feature of the invention, and was described in the provisional specification, and that the addition of the rings for the latter purpose was a detail naturally growing out of the first idea, and suggested by actual use. This case, therefore, affords a good illustration of what may be added to the invention in the complete specification within the meaning of the letter and spirit of the law.

In *Wright* v. *Hitchcock and another* (L. R. 5 Ex., 37), decided in 1870, the title was "Improvements in the manu-
"facture of frills or ruffles, and in the machinery or appa-
"ratus employed therein." The provisional specification stated that "the invention relates to a peculiar manufacture
"of frills and ruffles, and to a peculiar combination of
"mechanism," and proceeded to describe it, but made no mention whatever of trimmings. The complete specification stated: "The invention relates to a peculiar manufacture
"of frills, ruffles *or trimmings*, and to a peculiar combina-
"tion of mechanism to be applied to a sewing machine for
"producing the same. The peculiarity is that the frills are
"crimped in one direction transversely to the cloth, in a
"perfectly even and regular manner, and are secured by
"stitches in lieu of the fabric being puckered or gathered
"in the ordinary way."

It was objected that the patent was invalid because the title and the provisional specification said only frills or ruffles, while the complete specification enlarged the invention to *trimmings*. But Kelly, C. B., overruled this objec- " tion, saying: " A point made is that there is an inconsist- " ency between the provisional and final specification, the " word *trimming* being added in the latter. But by " whatever name it is described the thing in substance is " identical."

In *Foxwell* v. *Bostock* (4 De G. J. and S., 298; 10 L. T., N. S., 144), decided in 1864, Lord Westbury, L. C., said that the provisional and complete specification of a patent ought not so to differ as that the nature of the invention as described in the one shall be materially different from the nature of the invention as described in the other.

A point or detail contained in a provisional specification may be omitted from, or abandoned in, the complete specification without injuring the validity of the patent; but, of course, another invention must not be substituted in its place. In the case of *Thomas* v. *Welch* (L. R., 1 C. P., 192; 35 L. J., C. P., 200), decided in 1866, Chief Justice Erle, in deciding this point, made this observation: " It is said " that the complete specification is void because it omits " some of the inventions put forward in the provisional " specification. The provisional specification describes an " instrument, and then says that 'this, or *another acting* " *therewith*, acts to hold the work during the insertion of " the needle.'" (The invention was for a sewing machine.) " It is said that the complete specification contains nothing " corresponding to this second alternative. Assuming this " to be so, I do not think the objection ought to prevail. " The difference is a slight one, and injured nobody; and " it may be that the patentee had something in his mind " *which he found afterwards would be useless.*"

By section 10 of the Act, on the acceptance of the

complete specification, the application and the specification, both provisional and complete, shall be open to public inspection. Up to the acceptance of the complete specification they are kept secret. A period of nine months is allowed (section 8) between the date of the application and the necessity for filing the complete specification. It may happen that after an application has been made, accompanied by a provisional specification, it may be advisable to abandon it, and to make another application with another provisional specification, including the whole or part of the same material as the first, in a different form. This may be done without danger of invalidating the patent obtained on the second application, if that be made before the publication of the invention described in the provisional specification, which will not take place until the expiration of the nine months allowed for filing the complete specification, when, if the complete specification be not filed, the application shall be deemed to be abandoned (section 8, subsection 2). Therefore, any time before nine months from the date of the first application, if the invention has not been otherwise published, a second application for the same invention may be made, and a valid patent obtained. This was decided in the case of *Oxley* v. *Holden* (8 C. B., N. S., 666; 30 L. J., C. P., 68), decided in 1860 upon the Act of 1852; but which will remain an authority upon the subject. In that case a provisional specification was filed on the 17th March, and afterwards abandoned by the inventor, who, on the 10th April, made another application for the same invention, and, on the 12th October, obtained a patent therefor, dated the 10th April. It was contended that the filing of the provisional specification of the 17th March, and his afterwards allowing it to expire, was a dedication to the public of the invention, and prevented his obtaining a valid patent for the same invention on the application of the 10th April. But the Court of Common Pleas decided otherwise. Erle, C. J., said: "We are of opinion that a

"provisional specification abandoned does not become "public by abandonment. The Act of 1852, section 29, "authorises the publication, but until that event it is not "public. Furthermore, although the first provisional "specification *may afford an objection, either to receiving a "second for the same invention, or to granting a patent after "the first specification has expired*, there is no principle of "law and no enactment making the patent void if it is so "granted. On the contrary, section 24 of the Act of "1852 enacts that the patent, dated as of the day the "provisional specification was delivered in, shall be of the "same force and validity as if it had been sealed on that "day." (Section 13 of the Act of 1883 contains the same provision—"Every patent shall be dated and sealed "as of the day of the application.") "The patent is "dated as of the 10th April. On that day the protection "given under the specification of the 17th March existed, "and the patent is valid by the operation of this section." All this reasoning is equally applicable to the Act of 1883.

3rd. The Complete Specification.

It has been already stated that, under section 5 of the Act, the applicant may, instead of a provisional specification, leave with his application a complete specification.

If, however, a provisional specification be left with the application, the applicant must, within nine months from the date of his application, leave a complete specification or it will be deemed to have been abandoned (section 8). And 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 (section 5, sub-section 4), and must end with a distinct statement of the invention claimed (section 5, sub-section 5).

Those who have read the section immediately preceding

will have gathered that the provisional specification is a document, the preparation of which requires careful attention, pains and skill. All these are in a still greater degree required for the drafting of the complete specification. It is the document upon which the validity and life of the patent principally depends, for it is the instrument in which the inventor, in return for the exclusive privilege of using his invention for a limited time conferred upon him by a patent, is bound to so describe and ascertain as his invention as to enable the public—that is all persons acquainted with the subject—to use his invention as well as he himself can use it, after the termination of the period of his exclusive privilege. It has been upon the form and matter of these documents that objections have chiefly been made to the validity of patents, and frequently upheld, and a long series of judicial decisions have been given upon the questions arising thereon, out of which a sort of code, or a series of rules regarding them, can be extracted. It is the subject of this section to state shortly and clearly the effect of these decisions, and the principles and rules which ought to guide the preparation of complete specifications.

1stly. The cardinal principle and rule is to make a frank and full disclosure of the invention, and a clear, accurate, and distinct description and definition thereof.

FALSEHOOD.—"If the specification, in any part of it, be "materially false and defective the patent is against law "and cannot be supported"—Mr. Justice Buller in *The King* v. *Arkwright* (Dav. Pat. Ca., 61; 1 Webs. Pat. Ca., 64) (A.D., 1785).

"If you think there is any fraudulent concealment in "the specification" the patent will be void—Gibbs, C. J., directing the jury in *Bovill* v. *Moore* (2 Coop. Ch. Ca., 56; Dav. Pat. Ca., 361).

CONCEALMENT.—"If there be any studied ambiguity in "the specification, so as to conceal from the public that of

"which the patentee is for a term enjoying the exclusive "benefit, no doubt the patent itself will be completely "void"—Tindal, C. J., directing the jury in *Galloway and another* v. *Bleaden* (1 Webs. Pat. Ca., 521).

AMBIGUOUS OR MISLEADING.—"It is incumbent on the "patentee to give a specification of the invention in the "clearest and most unequivocal terms of which the subject "is capable. If it appears that there is any unnecessary "ambiguity affectedly introduced into the specification, or "anything which tends to mislead the public, in that case "the patent is void"—Ashhurst, J., in *Turner* v. *Winter* (1 T. R., 602; 1 Webs. Pat. Ca., 77). "You must not "mislead people by telling them to do something wrong, "and leaving them to find out the mistake. . . . "You must not give people mechanical problems and call "them specifications"—Jessell, M. R., in *Plimpton* v. *Malcolmson* (L. R., 3 Ch. D., 531).

EQUIVOCAL.—"The specification, if it be equivocal, is "bad"—Lord Campbell, C. J. "If the specification "upon a fair interpretation be equivocal it is insufficient" —Coleridge, J., in *Hastings* v. *Brown* (1 E. & B., 450).

DEFINITE.—A patentee "is bound clearly to define in "his specification what it is he claims to be his invention, "in order that the public may know with certainty what "they may or may not do without incurring the risk of an "action for an infringement of the patent"—Cresswell, J., in *Gibson and Campbell* v. *Brand* (4 Scott N. R., 490).

FULL.—"The specification must give the best informa- "tion within the knowledge of the patentee"—Cresswell, J., directing the jury in *Walton* v. *Bateman* (1 Webs. Pat. Ca., 613).

ACCURATE.—"People are not to (be left to) make ex- "periments at great expense to themselves which shall turn "out to be bootless and fruitless; but they rely on an "honest and open and candid exposition by the patentee "of everything that is necessary for the easy and certain

"procurement of the commodity for which the patent was "granted. If the specification be not only difficult to "understand, but is actually false and incorrect (in the "statement of proportions of zinc and copper), there "would be an end at once of the patent"—Tindal, C. J., directing the jury in *Muntz* v. *Foster and others* (2 Webs. Pat. Cas., 92).

SUMMARY.—"To support a patent, it is necessary that "the specification should make a full disclosure to the "public. If the patentee suppresses anything, or if he "misleads, or if he does not communicate all he knows, his "specification is bad, but if he makes a full and fair com- "munication, so far as his knowledge extends, he has done "all that is required"—Bayley, J., in *Lewis* v. *Marling* (4 C. & P., 57; 10 B. & C., 26).

If the specification omit to mention anything essential for carrying the invention the patent will be invalid. In a patent for trusses the specification omitted to state that the metal of which they were made required tempering with tallow, and the patent was held bad—*Liardet* v. *Johnson* (1 Webs. Pat. Ca., 53; Bull. N. P., 76). The specification of a patent for a lamp burner omitted to state where the hole for the admission of air was to be. Jessell, M. R., held it insufficient and the patent void—*Hinks and Son* v. *Safety Lighting Co.* (L. R., 4 Ch. D., 607).

2ndly. The specification should clearly distinguish what is new from what is old, what the patentee has himself invented from what was known before or invented by others.

"It is necessary that the patentee should show that he "has accurately explained the nature of his invention in "his specification, *separating that which is new from that* "*which is old*, so as to enable a person of tolerable skill to "make the thing by means of his specification"—Gibbs, C. J., directing the jury in *Manton* v. *Manton* (Dav. Pat. Cas., 349).

"It is necessary in his specification that the patentee "should state what his invention is, what he claims to be "new and what he admits to be old, for if the specification "states simply the whole machinery he uses, and which he "wishes to introduce into use, and claims the whole of that "as new, and does not state that he claims either any "particular part, or the combination of the whole as new, "why, then his patent must be taken to be a patent for the "whole of each particular part, and *his patent will be void* "*if any particular part turns out to be old or the com-* "*bination itself not new.*"—Lord Abinger directing the jury in *Carpenter* v. *Smith* (1 Webs. Pat. Ca., 532).

A patent was obtained for "An improved turning lathe," all the parts of which, except one, had been anticipated, and the specification claimed "the improved turning lathe here-"inbefore described," without explaining that any part of it was old. On the trial, the jury found that the introduction of the one new part—suspending rods—made the lathe a new machine. But it was held that the patent was void because the specification did not distinguish what was new from what was old, and that the patentee had therefore claimed both—*Holmes* v. *London and N. W. Ry. Co.* (12 C. B., 831; Mac. Pat. Ca., 13).

Where the patented machine or apparatus is entirely new the patentee is not bound to describe and distinguish the different parts, but where the invention consists of a machine which is merely an improvement upon an old machine he must distinguish and describe all the parts which he claims as new—*Dangerfield* v. *Jones* (13 L.T., N.S., 144).

"If a specification includes what is old as well as what is "new the patentee must be taken to claim all unless he "makes it clearly appear that he does not claim that which is old"—Coleridge, J., in *Tetley* v. *Easton and Amos* (2 E. and B., 956).

3rdly. The complete specification must keep within the

limits of the provisional specification and must not introduce anything which is a larger or different invention (see the preceding section and the cases referred to therein upon this point, especially *Bailey* v. *Roberton*, *United Telephone Co.* v. *Harrison, Cox-Walker and Co.* (Edison's Pat.) and *Newall* v. *Elliott*).

4thly. The specification is to explain the invention, but it is, of course, impossible to make it intelligible to everyone. The rule, therefore, is that it should be intelligible to persons of ordinary skill and ability, competently acquainted with the particular subject to which the invention relates, so that, by following the directions contained in it, they can produce without difficulty what the patentee describes as his invention.

"When it is said that the meaning of the specification is "*that others might be taught to do the thing for which the* "patent was granted, it must be understood to enable persons "of reasonably competent skill in such matters to make it, for "no sort of specification would probably enable a plough-"man, utterly ignorant of the whole art, to make a watch"—Lord Ellenborough, C. J., in *Harmar* v. *Playne* (Dav. Pat. Cas., 318; 11 East, 101).

"The specification is addressed, not to persons entirely "ignorant of the subject matter, but to artists of compe-"tent skill *in that branch of manufacture to which it* "relates"—Lord Denman, C. J., in *Bickford* v. *Skewes* (1 Web. Pat. Cas., 218; 10 L. J., Q. B., 304).

"A specification is sufficient if it enables a person of "ordinary skill and knowledge of the subject to construct "the patented machine or carry on the patented process.

"You are not to ask yourselves the question whether "persons of great skill—a first-rate engineer, or a second-"class engineer, as described by Mr. Farey—whether they "could do it; because generally those persons are men of "great science and philosophical knowledge, and they would "upon a mere hint in the specification, probably invent a

"machine which would answer the purpose extremely well; "but that is not the description of persons to whom this "specification may be supposed to be addressed; it is "supposed to be addressed to a practical workman who "brings the ordinary degree of knowledge, and the "ordinary degree of capacity to the subject"—Parke, B., directing the jury in *Neilson* v. *Harford* (1 Webs. Pat. Cas., 314).

"The specification is to be read as addressed to artists "or persons of competent skill in the branch of manufacture "or process to which it is applicable. Hence, known "machines need not be described when the use of them "is to be made in carrying out the object of the patent. "For instance, if in an apparatus for improving the making "of gas, a patentee should not mention or allude to a con- "denser, yet, if in practice, that is a part of the apparatus "required for the making of gas it was held* that everyone "must know that a condenser must be used. . . . . "Workmen of ordinary skill mean those competent in the "ordinary business and conducting the particular trade— "to furnish and construct apparatus for the purpose "required. The patentee does not satisfy the condition of "the law if he says men of the greatest science—first-rate "engineers—could understand him, and would know what to "do or what direction to give; that is not enough. The speci- "fication must be for the benefit of the trade when the patent "is out; it is addressed to those engaged in particular depart- "ments of trade, and who are to be employed in order to "make apparatus for the purpose, those who are employed "to make similar apparatus for similar purposes—not com- "mon labourers or workmen employed under those who "furnish and construct such apparatus"—Lord Justice Clerk Hope directing the jury in *The Househill Company* v. *Neilson* (1 Webs. Pat. Cas., pp. 687 and 692).

---

* Tenterden, C. J., in *Crossley* v. *Beverley* (3 C. & P., 513; 1 Webs. Pat. Cas., 106).

5thly. The specification must be so full and distinct as to enable any person, competently acquainted with the subject of the invention, to construct the patented machine, or perform the patented process, without the necessity of performing experiments for himself.

"If the invention can only be carried into effect by "persons setting themselves a problem to solve, then they "who solve the problem become the inventors of the method "of solving it, and he who leaves persons to carry out his "intention by means of that application of their understand-"ing does not teach them in his specification that, which in "order to entitle him to maintain his patent, he should teach "them—the way of doing the thing, but sets them a problem, "which, being suggested to persons of skill, they may be "able to solve. That is not the way in which a specification "ought to be framed. It ought to be framed so as not to "call upon a person to have recourse to more than those "ordinary means of knowledge—not invention—which a work-"man of competent skill in his art and trade may be pre-"sumed to have. You may call upon him to exercise all the "existing knowledge common to the trade, but you cannot "call upon him to exercise anything more. You have no "right to call upon him to tax his ingenuity or invention" Alderson, B., directing the jury in *Morgan* v. *Seaward* (1 Webs. Pat. Cas., 174).

In an action for infringing a patent for blocks for pavement, the Plaintiff claimed as his invention that his block was bevelled both inwards and outwards on the same side as the block, and it was alleged that the Defendant's block was an imitation of the Plaintiff's, as two of the Defendant's blocks were equivalent to one of the Plaintiff's. The specification did *not state at what angle the bevels should be made.* Lord Abinger, C. B., directed the jury that if the specification left it to experiment to determine what was the proper angle for the bevels it was not good; but if any angle was a benefit it would. The jury having found for the

Defendant, the learned judge said that he thought the specification was insufficient—*Macnamara* v. *Hulse* (1 Carrington and Marshman, 477; 2 Webs. Pat. Cas., 129).

"If, in order to use the invention beneficially at all, "experiments were necessary, then the specification would "be bad. If it were necessary to use experiments in order "to have the benefit of the invention claimed by the "specification it would be void; but if in this case it is "only necessary to have recourse to experiments *in order* "*to have the full benefit that the subject is capable of*, it "appears to me that it would not void the patent . . . . If "the simplest form would be productive of benefit it "appears to me the specification is good"—Parke, B., directing the jury in *Neilson* v. *Harford* (1 Webs. Pat. Ca., 317, 318).

6thly. The specification should make it clear whether the invention consists *in the useful application of a principle*, or in a *particular arrangement or combination of parts*. The distinction is very great and must be clearly apprehended. When a man discovers something entirely novel, such as a new mechanical motion, he may be said to have discovered a principle, and he is entitled to protect that, not only in the methods by which he himself applies it, but also in all other methods of doing so. When, on the other hand, he has invented, not something entirely novel, but an improvement only upon what existed before, whether by the addition of something new, or by a new combination of parts, he is entitled to protection for that alone. In the latter case any one else may start from the same point, and, by adding something else new, or by another new arrangement of parts, may produce an independent invention which does not infringe the other. All this, of course, is perfectly obvious, and is the plainest common sense. But in preparing the specification it is necessary carefully to consider the invention, to ascertain if it belongs to the one class or the other, so as to impress the appropriate character upon

its description and especially to frame the proper claim. If the invention prove only to be for an improvement or new combination, and not for a principle in the sense above explained, yet the specification and claims are for an entirely novel invention or principle, the patent will be void, as granted for more than the inventor was entitled to. Many examples exist where patents have been held void in the courts of law through inadvertently claiming too much, some of which will be presently cited. If, on the other hand, the invention be really for something entirely novel, and yet, through excess of caution, the specification and claims only cover the applications of the principle actually used by the inventor and described in the specification, the inventor loses, probably, the greater part of what is his due, because, in such cases, it is generally comparatively easy to contrive a mechanical or other equivalent and so evade the patent. The task of thus distinguishing between these two classes of invention is one of some difficulty and delicacy, in which experience and knowledge of the subject are the only really adequate guides.

It will be safe, however, when approaching the consideration of the question as to which of these two classes an invention properly belongs to bear in mind: First, that from the nature of things, inventions of improvements or new combinations are considerably more numerous than those of entire novelties or principles; and, secondly, that inventors, not unnaturally, generally overrate the merit of their inventions. Another general axiom which it is also desirable to bear in mind was thus expressed by Pollock, C. B., in directing the jury in the case of *Crossley* v. *Potter* (Macr. Pat. Ca., 256):—"The safest course for patentees "to adopt in framing their specifications is, instead of "claiming everything, to confine themselves to one good "thing; and a jury will always take care that if he be a "real inventor no man, under colour of improvement, shall "be allowed to interfere with that which is the offspring of

"their genius." To show that such a course will secure adequate protection, the following remarks attributed to Lord Hathorley, then Vice-Chancellor Wood, when trying the case of *Curtis* v. *Platt*, cited in Johnson on Patents (4th Ed., p. 244) are given:—"Where the thing is "wholly novel, and one that has never been achieved "before, the machine itself which is invented, necessarily "contains a great amount of novelty in all its parts, "and one looks very narrowly and very jealously upon "any other machines for effecting the same object, to "see whether or not they are merely colourable contriv-"ances for evading that which has been done before." And an examination of the reports of patent cases will show that, while very few inventors have failed to secure justice to themselves by claiming too little, very many have been disappointed and defeated through claiming too much.

The case of Harrison's Patent—*Holmes* v. *London and N. W. Ry. Co.* (12 C. B., 831; Macr. Pat. Cas., 4)—already cited, may be taken as a good illustration of this—so good that it is worth while setting out the facts and judgment a little fully. The patent was for a railway turntable, constructed so that the weight of the load bore upon a central pin instead of upon rollers at the periphery of the table, as formerly in use, and the object was to diminish friction. A central pin had been used before, not for bearing the weight, but as a guide to keep the table in place. The platform was a rigid table, and the whole weight was thrown upon the central pin, and there were (*a*) an upright post terminating in a pivot supporting the table, (*b*) a massive ring encircling the base of the post and carrying friction rollers, (*c*) *vertical suspending* rods attaching the ring to the table, and (*d*) oblique struts carried from the ring to the periphery of the table. At the trial it appeared that of these four elements, three—(*a*), (*b*) and (*d*)—had been anticipated by Handcock's Patent. Jervis, C. J., directed the jury that *a*, *b*, and *d* appeared old, but

that *c* (the vertical suspending rods) was new and useful, and the combination of these old things with one new formed a new quality, and therefore there would be novelty. The jury found a verdict for the plaintiff in favour of the patent, but leave was reserved to enter judgment for the defendants on the ground that the specification was insufficient. And the Court of Common Pleas held that it was, and the patent therefore void. Jervis, C. J., said:—"*In order to make his specification good, Harrison should* "have said:—'My invention is to suspend the revolving "'platform on a post with braces, arms, and supports,' "and then, describing all that was old, should have said, "'To these I add suspending rods for the purpose of "'bringing the bearing on to the centre of the table.' No "one can read this specification without seeing the patentee "supposes the arms to be new as well as the suspending "rods; in short, that all is new except the table, the rails, "and the catches, which, by means of the suspending rods, "he converts into a new and improved suspended turn-"table. That being so, he does comply with the rule "which requires the patentee distinctly to state what is "new and what is old. The specification is insufficient."

In Brown's Patent, *Bovill* v. *Moore* (Dav. Pat. Cas., 361; 2 Marsh., 211), the specification claimed the whole machine, which was for the manufacture of bobbin lace or twist net. At the trial it was proved that up to the point at which the bobbin in the patentee's machine travelled round a longitudinal thread to form the twist, the operation was the same as in previous machines, but beyond that it was new. And it was objected that the patent should have been for an improvement only, and not for the whole machine. The patent was held void upon that ground. Gibbs, C. J., directed the jury as follows:—"If a "patentee has invented an improvement only, then his "specification by which he claimed the whole will be bad. ". . . If you think he has invented a machine which

" consists of a perfectly new conformation of parts, though " all the parts were used before, yet he will be entitled to " support his patent for a new machine. . . . If a " combination of a certain number of parts existed up to " a given point before, and his invention sprung from that " point, and added other combinations to it, then his specifi- " cation, stating the whole machine as his invention, is bad." This direction was questioned, but upheld by the full court.

The case of Kay's Patent, *Kay* v. *Marshall* (2 Webs. Pat. Cas., 36; 5 Bing., N. C., 492), and in the House of Lords (8 Cl. & F., 245) is also a very useful one to remember. The inventions claimed were two things—(1), machinery for macerating flax; and (2) machinery for spinning flax. The machinery, or method, of macerating flax was new, and the invention was valuable; but the patent was wrecked because it appeared the machinery claimed for spinning flax was old. If the claim for the spinning machinery had been omitted from the specification, the patent would have been good for the macerating machinery or process; or if the claim, instead of being for the spinning machinery, which was old, had been for the combination of the old spinning machinery with the new machinery or process for macerating, the patent being for what was a new combination would have been valid. Hence, it would seem in this case that a patent for a valuable invention was lost by the manner in which the specification was drafted.

In the case of *Foxwell* v. *Bostock* (4 De G. J. & S., 298) Lord Westbury, L. C., in holding a patent for an improved sewing machine, void on the ground of the specification being insufficient, made the following observations, which deserve to be studied carefully:—" The difficulty of the " plaintiff arises entirely from the manner in which he has " described his alleged invention. His counsel had no " difficulty at the bar in describing his improvement. They " stated it to consist of an arrangement of three cams upon " one shaft, by the direct action of which the three prin-

" cipal motions in a needle and shuttle machine, viz., the " needle movement, the shuttle movement, and the feed " movement, are effected; and the plaintiff's evidence was " directed to show that this arrangement formed the novelty " and utility of the patent. But this clear and simple " statement is not to be found anywhere in the specifica- " tion. The argument is, that this is not necessary when the " patent is for a combination. But I think that, both on " principle and authority, it is most necessary that the " specification should ascertain the improvement when the " patent is for an improved—that is for a new—combination. " If a combination of machinery for effecting certain results " has previously existed, and is well known, and an im- " provement is afterwards discovered, consisting, for example, " of the introduction of some new parts, or an altered " arrangement in some particular of the existing con- " stituent parts of the machine, such improved arrange- " ment or combination may be patented; but it would be " contrary to the spirit of the patent law, and of the " decided cases, to permit a patent to be taken out for a " new combination, and the whole machine to be described " and specified as a new invention, without, in any manner " distinguishing or marking the improvement by the intro- " duction or addition of which the improved arrangement " or combination is in reality produced. The term '*com-* " '*bination of machinery,*' which has become a favourite " word with patentees, is nothing but an extended expres- " sion of the word '*machine.*' It is the word 'machine' " writ large; and as a patent for an improved machine " in the specification of which, the improvement was not " particularly stated and described, would hardly be at- " tempted to be supported, so neither, in my judgment, " can the patent for an improved arrangement or com- " bination be supported in the specification of which there " is nothing to distinguish the new from the old."

Lord Justice James, when Vice-Chancellor, in *Parkes* v.

Stevens (L. R. 8, Eq. 358), affirmed on appeal (L. R. 5, Ch. 36), said, alluding to the above remarks of Lord Westbury:—"It "is obvious that a patentee does not comply, as he ought "to do, with the conditions of his grant, if the improve- "ment is only to be found, like a piece of gold, mixed up "with a great quantity of alloy, and if a person desiring to "find out what was new would have to get rid of a large "proportion of the specification by eliminating from it all "that was old and commonplace, all that was the subject of "other patents and other improvements, bringing to the "subject, not only the knowledge of an ordinary skilled "artisan, but of a patent lawyer or agent."

If, however, a combination only be claimed, a description of the items or elements thereof, and of the way in which the patentee combines them together, followed by a claim restricted to the combination described, will be a sufficient description of the invention, without specifically distinguishing new from old—*Harrison* v. *Anderston Foundry Co.* (L. R. 1 App. Cas., 574). In such a case the only thing the patentee asserts as new and claims to be his own is the combination, and it may, therefore, be assumed in reading his specification *that* all is old, except the combination. Such a mode of specifying in such a case, therefore, does not fall within the above remarks of Lord Westbury and Lord Justice James.

Before leaving this subject of combination, or rather of the necessity of clearly distinguishing in the specification whether the invention is for the application of a principle, or for a particular arrangement or combination of parts, there is one other remark to make.

It may, of course, and in fact very frequently does happen—perhaps inventions of these sort are more numerous than any others—that the *invention* consists, not merely of a new combination of all old parts, but of a combination of several old with some new parts. Then, of course, the patentee may, and ought to claim, not only the combination,

but the several new parts. But he must do this specifically and clearly. The following remarks of Lord Justice James, in *Clark* v. *Adie* (L. R., 10 Ch., 667), affirmed on appeal in the House of Lords (L. R., 2 App. Cas., 315), are upon this point:—"It has been strongly contended before us "that, whenever there is a patent for a combination, the "patent gives protection, not indeed to every distinct "thing that enters into the combination, *but to every com-* "*bination, arrangement, and aggregate of two or more of* "*those distinct things, even although subordinate combina-* "*tion is not expressly or impliedly claimed in the specifica-* "*tion.* This, in our opinion, is so startling a violation of "every principle of patent law, that we doubt whether we "could follow any authority short of the House of Lords in "applying such a doctrine. A patent for a new combination "or arrangement is to be entitled to the same protection, "and on the same principle, as every other patent. The "patent is for the entire combination, but there is, or may "be, an essence or substance of the invention underlying the "mere accident of form; and that invention may be pirated "by a theft in a disguised or mutilated form, and it will be "in every case a question of fact whether the alleged piracy "is the same in substance and effect, or is a substantially "new or different combination. The principle is really very "plain, as it seems to me. A combination or accumulation "of these improvements is a totally distinct thing from a "combination or accumulation of two of them—as distinct as "a partnership of A, B, and C is from a partnership of A and "B. If a man really wants to patent, not only the whole, "but something less than the whole of what he calls 'a new "'arrangement, construction, and combination of parts,' *he* "*must clearly show that he claims that something less*, of "course, perilling his patent if that something less is not "a novelty."

7thly. The preceding six rules or canons which have been discussed have all been to show that candour, accuracy, and

clearness must distinguish the specification of a patent to ensure its being held sufficient in a court of law. But if it possess those qualities *it will be construed by a court of law liberally, and in favour of the inventor.*

"The specification ought to be taken as a whole, and "fairly and candidly construed, without astuteness to pick "holes in it"—Alderson, B.; and—"In the construction "of a patent the Court is bound to read the specification "so as to support it, if it can fairly be done"—Parke, B., in *Russell* v. *Cowley* (1 Webs. Pat. Cas., 470).

"A specification should be construed in the sense which "the patentee intended, and if any expressions are ambi-"guous, we should endeavour to give effect to the inten-"tion; and, moreover, I think that every patent should "be expounded favourably to the patentee. But we ought "not to violate the obvious meaning of the language unless "it is quite clear that the patentee intended something "different from that which the expressions indicate—Pollock, B. (9 Exch., 501).

"It is the duty of the judge to construe a specification "fairly, with a judicial anxiety to support a really useful "invention, if it can be supported, upon a reasonable inter-"pretation of the patent, or, in other words, that a judge "is not to be astute to find flaws in small matters in a "specification with a view to overthrow it"—Jessell, M. R. (p. 422). "I agree with the Master of the Rolls that the Court "ought to be anything but astute to support such an "objection"—Brett, L. J., in Court of Appeal, in *Plimpton* v. *Spiller* (p. 423); *Plimpton* v. *Spiller* (L. R., 6 Ch. D., 412).

Lord Blackburn said, in the House of Lords, in *Dudgeon* v. *Thomson* (L. R., 3 App. Cas., at p. 53):—"The question "arises in the present case, whether the particular thing is "or is not within the specification. It is said that the tool "made by the respondents comes within the specification, "and is an infringement of the patent. In such a case, it

" is the interest of the patentee to give the specification as " wide a meaning as he can give to it, in order to make it " take in the thing done by the alleged infringer. It might " have been that it was the other way, and that the thing " was known to be old, and then, of course, the patent " might have been upset by showing that it included an " old thing. Then the position of the parties would have " been reversed, and the interest of the patentee would " then have been to argue that the true construction did " not include this. But whether it is for the interest of " one side or the other, I apprehend the duty of the Court " is fairly and truly to construe the specification—neither " favouring the one side or the other—neither putting an " unfair gloss or construction upon the specification for the " purpose of saving the patent if it said that the patent is " void, nor putting an unfair gloss or construction upon it " in order to extend the patent, and make it take in some- " thing, which you may think was an unhandsome taking of " the fruits of his invention from the patentee, if it is not " really an infringement of the patent."

" The construction of a specification, or the construction " of all other written documents, belongs to the Court; but " the explanation of the words or technical terms of art, the " phrases used in commerce, and the proof and results of the " processes which are described, and in a chemical patent the " ascertainment of chemical equivalents are matters of fact " upon which evidence may be given, contradictory testimony " may be adduced, upon which it is the province and right " of a jury to decide"—Lord Westbury, L. C., in *Hills* v. *Evans* (31 L. J., Ch. 457; 4 De G., F. & J., 288).

8thly. Following from the principle of construing specifications favourably to the validity of the patent, it has also been decided *that verbal errors in the specification, if, on reading it carefully the sense of the patentee can be discovered do not avoid a patent.* Thus, when a French patentee used the word "discolouring" to signify depriving of colour,

and the word "baked" instead of the word crystallized, his meaning being apparent, the specification was not held insufficient—*Derosne* v. *Fairie* (2 Cr., M. & R., 476; 1 Webs. Pat. Cas., 158); and in *Minter* v. *Mower* (1 Webs. Pat. Cas., 138), it was held that it was indifferent whether a word used in a specification is the correct description of the thing, provided it describes it so that no man can doubt what it is. But that these decisions do not authorise carelessness appears from the following remarks of Lord Westbury, in *Simpson* v. *Holliday* (13 W. R., 578; 12 L. T., N. S., 99):—"When it is stated that an error in a specifica-" tion, which any workman of ordinary skill and experience " would perceive and correct, will not vitiate a patent, it " must be understood of errors which appear on the face " of the specification or the drawings it refers to, or which " would be at once discovered and corrected on following " out the instructions given for any process of manufac-" ture; and the reason is that such errors cannot possibly " mislead. But the proposition is not a correct statement of " the law if applied to errors *which are discoverable only by* " *experiment and further inquiry*. Neither is the proposition " true of an erroneous statement, amounting to a false sug-" gestion, even though the error would be at once observed " by a workman possessed of ordinary knowledge of the " subject."

9thly. And in construing a specification it is not competent to the patentee to call in aid the provisional specification in order to explain or enlarge the meaning of the complete specification—*Mackelcan* v. *Rennie* (13 C. B., N. S., 52).

10thly. Words in a specification are to be construed in their ordinary and proper meaning, unless there be something in the context to show that a different construction ought to prevail, when they may be explained by evidence—*Elliott* v. *Turner* (2 C. B., 446; and see also *Hills* v. *Evans* (*supra* p. 61).

Drawings.—By section 5, sub-sections 3 and 4, of the

new Act, it is enacted that both provisional and complete specifications must be accompanied by drawings, if required. A great number of inventions cannot be described, at least in the detail required for a complete specification, without the aid of drawings. These drawings, when used, are a part of the specification as much as the verbal portion thereof; and the statement of the law and decisions set out above are equally applicable to them. With regard to drawings, it is necessary to bear in mind that they are subsidiary to the verbal part of the description and not the verbal part to them. Accordingly, it was held in *Clark* v. *Adie* (L. R. 10, Ch. 667); in the House of Lords (L. R. 2, App. Cas., 315) that a patentee cannot rely upon a drawing as describing a material part of his invention when there was no verbal reference whatever thereto in any other part of the specification.

4TH. THE CLAIMS.

Section 5, sub-section 5, of the new Act requires that "a "complete specification must end with a distinct statement "of the invention claimed"; in other words, with a claim or claims.

In thus compulsorily requiring claims, legislation has only adopted what had come to be the prevailing practice of summing-up the invention at the end of the complete specification, by adding a declaration that the patentee claimed certain specific points of novelty as being the essence and substance of his invention. It is, of course, obvious that "in "particularly describing and ascertaining inventions, and "in what manner the same are to be performed," which is what the law always required, as it does still; in most cases a great deal has to be described and referred to beyond what the patentee has himself invented, in order to make them intelligible. In describing a process or machine it would be impossible, or at least very confusing, to stop at every step and say whether it did or did not form part of

the invention. It was much more convenient, and much more perspicuous, at the beginning of the specification, to state the object of the invention, mentioning, perhaps, what had been ordinarily used before; then to describe the process or machine throughout; and finally to conclude by saying that what was claimed as the invention were certain named specific points of novelty. Hence, for many years, claims have been found in almost all well drawn specifications, and a number of legal decisions have taken place upon them.

The chief point to be attended to in drafting the claim, which, perhaps, among all those important matters—the title the provisional and the complete specifications—which the preceding pages have discussed, is the most important of all—is to catch the invention therein. If, in drafting the specification, it is necessary to have a clear idea of what is the exact invention—that is, of what this particular inventor has discovered in this particular instance—it is still more necessary to have it when drafting the claim, so as to be able to express it accordingly with precision. On the one hand, to avoid including anything beyond the boundary of the particular invention, and, on the other, to avoid restricting it to less than it really contains.

The following judicial decisions show the object and effect of the claim:—

"The claim," said Lord Cottenham, L. C., in *Kay* v. *Marshall* (2 Webs. Pat. Cas., 39; 1 My. and Cr., 383), "is introduced, lest, on describing and ascertaining the "nature of his invention, and by what means the same is "to be performed (particularly in the case of a patent for "an improvement), the patentee should have inadvertently "described something which is not new in order to render "his description of the improvement intelligible. The "claim is not intended to aid the description, *but to ascer-* "*tain the extent of what is claimed as new.* It is not to be "looked to as a means of making a machine according to

"the patentee's improvements. If, therefore, the specifi-
"cation, as containing the description, be sufficiently pre-
"cise, it cannot be of any consequence that expressions are
"used in the claim which would be too general if they pro-
"fessed to be part of the description." This was said in 1836, in the early days of claims; but it has always remained a correct exposition of the law. Comparatively quite recently, in 1877, Lord Justice James, in *Plimpton* v. *Spiller* (L. R. 6 Ch. D., p. 426), said:—"The real object "of the claim is not to claim anything which is not men-
"tioned in the specification, but to disclaim something. "A man who has invented something gives in detail the "whole of the machine in his specification. In doing that "he is of necessity very frequently obliged to give details "of things which are perfectly well known and in common "use; he describes new combinations of old things to pro-
"duce a new result, or something of that kind. Therefore, "having described his invention, and the mode of carrying "it into effect, by way of security he says:—'But, take "'notice, I do not claim the whole of that machine; I do "'not claim the whole of that *modus operandi*, but that "'which is new, and that which I claim is that which "'I am now about to state.' That is really the legitimate "object of the claim, *and you must always construe a claim* "*with reference to the whole context of a specification.*" Jessell, M. R., said, in *Hinks and Son* v. *Safety Lighting Co.* (L. R., 4 Ch. D., 612):—"It has long been the practice of "patent agents to insert in specifications the distinct "claim of what is said to be comprised in the patent—"meaning that nothing else is comprised, that everything "else is open to the public."

There is a tendency among inventors to make their claims grasping, or, as it were, speculative and anticipatory, arising from the fear of infringement, and lest the fruits of their labours should be appropriated by one who contrives to approach them nearly enough to do so,

but who manages to keep far enough off to avoid their patent.

But anyone whose duty it may be to draft specifications and claims, must avoid falling into this error. If there be a real invention the law is strong enough to protect it from all attempts at infringements and colourable imitations, and legal tribunals are anxious to apply it in favour of a meritorious inventor against anyone who thus tries to rob him. But if the claims prove to be for more than the patentee has invented, then the patent will be lost. Lord Eldon said, in *Hill* v. *Thompson* (1 Webs. Pat. Cas., 237; 3 Mer., 629):—"A specification must not attempt to "cover more than that which, being both matter of actual "discovery and of useful discovery, is the only proper subject "for the protection of a patent. And I am compelled to add "that if a patentee seeks, by his specification, any more than "he is strictly entitled to, his patent is thereby rendered in-"effectual, even to the extent to which he would be otherwise "fairly entitled."

In *Tetley* v. *Easton* (Macr. Pat. Cas., 48), Pollock, C.B., in directing the jury said:—"That the law will permit "an inventor to claim that which he has invented by "means of successful experiments or otherwise, and which "he has given to the public, but *not that which is the mere* "*subject of his speculation or imagination, or of his endeav-*"*ouring to grasp more than he is entitled to.* I think we "are bound to give, as far as possible, the fullest effect to an "invention; but, on the other hand, we are also bound to "oppose the endeavours to make a patent grasp at, and "embrace, a number of matters that were never in the head "of the inventor."

In *Stevens* v. *Keating* (2 Exch. R., 772), Pollock, C.B., in delivering judgment, said:—"The question is whether the "specification be good or not. Only one alkali (potash), "and one acid (sulphuric) are mentioned in the specification; "but manifestly the inventor does not confine himself to

"these; if he did the defendant would be entitled to a "verdict, for he has used neither. To what extent then "does the claim go beyond the alkali and acid named? If it "be a claim of all acids and alkalis, it is clearly bad as there "are some which will not answer the purpose. If it be a "claim for those only which will answer the purpose, it is "as clearly bad, in consequence of not stating those which "will answer the purpose, and distinguishing them from "those which will not, and so preventing the public from "being under the necessity of making experiments to "ascertain which of them will succeed, and which will not. ". . . . In any view, therefore, the specification is "defective."

CHAPTER II.

Principles of the Law of Copyright in Designs.

It is said that the French were the first to establish by law copyright in designs, and that, in the years 1737 and 1744, laws were enacted, giving a property in designs to the manufacturers of Lyons, and that, in the year 1787, the benefits of legal protection were fully established in France—Copinger on Copyright (2nd Ed., p. 410). And it is also asserted *(Ibid.)* that the pre-eminence of the French in the art of ornamentation, may be attributed to the efficient protection which natives of that country have so long enjoyed for designs for that purpose. However, this may be, the first Act of Parliament of Great Britain giving protection to the contriver of designs was passed in 1787 (27 Geo., c. 38); and was followed by the Acts 29 Geo. 3, c. 19; and 34 Geo. 3, c. 23, which related only to designs upon linen and cotton fabrics. In 1839, an Act was passed (2 Vic., c. 13), extending the protection of these Acts to designs upon fabrics of animal substances, or of mixed animal and vegetable substances.

But these Acts were all repealed by the Statute passed in the year 1842, the 5 & 6 Vic., c. 100, which, amended by the 6 & 7 Vic., c. 65; 13 & 14 Vic., c. 104; 21 & 22 Vic., c. 70, and the 24 & 25 Vic., c. 73, formed together the law of this country upon the subject. These Acts are now all repealed by the present Act of Parliament, and the provisions of the third part of this Act, contained in sections 47 to 57 inclusive, are substituted in their place.

Up to the coming into operation of the present Act there were two distinct rights of copyright in this country—one copyright in the application of designs for ornamental purposes, regulated by the Act of 1842 (5 & 6 Vic., c. 100),

and the other, copyright in the application of designs for the shape and configuration of articles of utility, regulated by the Act of 1843 (6 & 7 Vic., c. 65). This distinction between ornamental and useful designs is now abolished.

The best explanation of the objects of the legislature in so doing is to be found in the Memorandum printed upon the back of the Bill, which has since become the present Act, upon its first introduction into Parliament. In that Memorandum it was said:—"At present there is a two-
"fold classification of designs into ornamental and useful,
"and they are registered under separate Acts, which,
"however, in their main features are the same. It is often
"difficult to determine to which class—useful or ornamental
"—a design belongs, while a so-called useful design might
"frequently be the subject of a patent were it not for the
"cost. Inasmuch as, under the Bill, the first fee on Letters
"Patent is to be reduced from £25 to £1 (£10 being
"charged for the registration of a useful design), it is pro-
"posed to discontinue the distinction between ornamental
"and useful designs, and to accept for registration *any*
"novel design in the proper sense of the word. Such
"useful designs as embrace a mechanical action would be
"treated as subject matter for a patent."

The above marks out clearly the principal difference between the law in operation up to the commencement of the new Act, and under the new Act. Under the new Act, any novel design, whether for ornament or for use, will be entitled to registration without distinction.

The only other difference of any great practical importance, is that of the time during which protection was afforded. Under the old law the period of protection varied, in the case of ornamental designs, from nine months (designs applied by printing to shawls or yarn, thread, or warp; Classes VIII. and IX.); to five years (designs applied to articles composed of metal, Class I.); while, in the case of

utility, three years was allowed. Under the new Act, a uniform period of five years' protection from the date of registration (see section 50) is afforded to all designs without distinction of class or character.

Another difference between the old law and that which now supersedes it, which calls for remark, is that what was *called provisional registration, is abolished.*

Provisional registration was permitted under the Act 13 & 14 Vic., c. 104, now repealed, which provided that designs might be provisionally registered, and that such provisional registration should continue in force for one year (which might be extended to six months more) from the time of registration, during which the proprietor could sell or transfer the right to apply his design to an article of manufacture; but if he sold, exposed, or offered for sale any article to which his design had been applied, until after complete registration, the provisional registration was null and void. Such provisional registrations were granted on the payment of small fees, and could at once be turned into complete registrations by paying the larger fees required for the purpose. However, they are now abolished, and it is not apprehended that anyone will much regret their abolition.

Another alteration in the law requiring attention is that introduced by section 54, that if the registered design is used in a foreign country, and is not used in this country within six months after registration here, the copyright is to cease.

The principles of the law upon the copyright of design remain unchanged by the new legislation. They are very few in number and simple of application as, indeed, as those relating to patents for inventions. But differing from the latter, owing to the simplicity of designs as compared with inventions, and their generally great inferior commercial value, the legal questions which have arisen, or been litigated, about them are not numerous, and the

reported legal decisions relating thereto are but few in number.

The first principle to be noted is that the protection is given, not to the article of manufacture or the substance to which the design is applied, but to the design. The design is a different thing from the article to which it is applied, and it is the design, and the design only, which is protected (see the definition of "design" given in section 60 of the Act). This is the distinguishing feature in copyright in designs. The protection by patent is given to the article itself produced by the use of the invention patented. The protection afforded by a trade mark is to secure the reputation which has been gained by any manufacturer of particular goods, from being improperly made use of by another through copying his trade mark—the *business* of the owner of the trade mark is protected, not the article he manufactures. But in copyright in designs, it is the design—that is something extrinsic to the article to which it is applied—that is protected. Without the registered design, the article remains, and anyone may use it; with the design he may not. For instance, suppose the design is to be applied to "shawls." The "shawl" is not the design, but the article of manufacture to which the design is to be applied.

The next principle is one in which copyright in designs shares equally with patents for inventions. In order to be entitled to protection, the design, like the invention, must be new at the date of registration. If the design is registered, but it was not new when registered, then registration affords no protection. The authorities upon novelty and publication in patent cases are equally authorities upon questions of novelty and publication in cases relating to copyright in designs, and, it is believed, that there are no reported cases where the decision has turned specially upon the question of the novelty or previous publication of designs.

The next principle to be attended to, is that the proprietor of a design is entitled to be registered as the proprietor thereof, and that he need not necessarily be the inventor or author of the design. Section 61, which repeats the previous legislation on the subject (section 5 of 5 & 6 Vic., c. 100) enacts that "the author shall be considered the proprietor unless he executed the work on "behalf of another person for good and valuable considera- "tion, in which case such person shall be considered the "proprietor"; and section 47 enacts that "the *proprietor* is "the person who is entitled to register the design." This is different from the law as to patents, which requires that the patent (see section 5) must be granted to the true and first inventor; but which, however, sometimes regards the first importer of an invention into this country as the inventor. If I pay another to contrive a new design for me, I am the proprietor of what he produces, and entitled to register the design as such. If I pay a man to contrive an invention for me, I may, according to the agreement between us, be entitled to an assignment of the patent granted therefor from him when it is obtained, but I am not entitled to obtain the grant of the patent to me for the man's invention. He alone is; but I am entitled to obtain the registration of his design in my own name if I have paid him to make it for me.

And it is important to entertain a clear idea of what copyright in designs is. It is the sole and exclusive right of multiplying copies of a new design.

"When a new design has been created or contrived, its "author has an undoubted right in law to the piece of "paper or other material upon which the design is "delineated, and to the copies which he may make of it. "If he simply lends a copy of it to another person, he does "not lose his right; and if that person were to threaten to "publish it without his permission, he could obtain an in- "junction restraining such publication. The design is his,

"and he may choose whether he will publish it or not"—See Baron Parke, in *Jefferys* v. *Boosey* (4 H. L., C. 920). This, no doubt, is copyright; but it is not the copyright which is conferred by the law relating to the registration of copyright. If the design be published—that is, not merely lent to a private individual or individuals, but exhibited or sent into the world upon any article of commerce—then the design, no doubt, none the less remains the author's, but his control over it is lost. The public have become possessed of it; and although the author might obtain the assistance of the law to prevent another from claiming the merit of the design, by asserting that he was the contriver thereof; yet he cannot prevent the multiplication of the copies, nor can he claim the benefit of any profit which may have resulted from such multiplication. But here the law on the registration of designs steps in, and says in effect to the author of a design: Register your new design, so that there may be no doubt as to what it is; and in return for so registering it, you shall have the exclusive right of multiplying copies of it during the period of registration. If anyone during that time, without your consent, multiplies copies of your designs, or sells them, the law gives you immediate and convenient remedies. It is the privilege which the law confers on the condition of registering, which is the copyright in design to which the definition given above applies, and in which it is used in the Act. "Copy-"right" (says section 60 of the Act) "means the exclusive "right to apply a design to any article of manufacture, or "to any substance as aforesaid, in the class or classes in "which the design is registered."

In the notes to Part III. of the Act, comprising sections 47 to 61 inclusive, to which the reader is referred, a great number of points relating to copyright in designs are discussed, and all the more important of the reported cases upon the subject are cited.

CHAPTER III.

The Principles of the Law of Trade Marks.

The recognition of property in trade marks by law is comparatively of recent origin. We have seen the right of inventors to property in their invention for a limited period was formally acknowledged by Act of Parliament so long ago as the twenty-first year of the reign of James I.; while, in the year 1742, more than one hundred years later, Lord Chancellor Hardwicke refused the aid of the Court of Chancery to protect a trade mark—the Great Mogul stamp—from infringement, saying:—"It is alleged that the "defendant, in using the mark, prejudices the plaintiff by "taking away his customers; but there is no more weight "in this than there would be in an objection to one inn-"keeper setting up the same sign as another"—*Blanchard* v. *Hill* (2 Atk., 484), showing how little at that time the subject was understood, at least by lawyers. But, as commerce progressed and competition became keen it was perceived that the reputation of individual persons and firms had a great influence upon the value of the articles in which they dealt; and that a species of property did exist in the signs or means by which manufacturers and vendors of goods, indicated to the public that goods were made and sold by them with any reputation they had acquired pledged to them; and that such property required protection by law. In 1816, the defendant having placed on blacking sold by him labels in imitation of those placed on blacking sold by the plaintiffs, an injunction was granted to restrain the infringement—*Day* v. *Day* (Eden on Injunctions, Edition of 1821, p. 314). In 1824, the case of *Sykes* v. *Sykes* (3 B. & C., 541; 3 L. J., K. B., 46) was decided. The

plaintiff used to mark shot belts, powder flasks, and other such articles sold by him with the words "Sykes' Patent," and the defendants copied this mark upon their own goods, and it was held they had no right to do so. Abbott, C. J., said:—"It was established that the defendants marked the "goods manufactured by them in order to denote that they "were of the genuine manufacture of the plaintiff, and "although they did not themselves sell them as goods of "the plaintiff's manufacture, yet they sold them to retail "dealers for the express purpose of being resold as goods "of the plaintiff's *manufacture*. I *think that is substan-*"tially the same thing." And, in 1838, in *Millington* v. *Fox* (3 My. & Cr., 338), in which the defendants marked and sold steel with the same words as the plaintiff, although not fraudulently, and, as far as appeared, without any intention to appropriate the plaintiff's trade connection, Lord Cottingham, C., granted an injunction to restrain them from doing so, remarking that the fact of there being no fraudulent intention on the defendants' part did not deprive the plaintiff of the right to the exclusive use of the words in question.

These cases mark the history of the law, proceeding from the first, in which all property in a trade mark was denied; to the two intermediate ones where the plaintiffs were protected from the fraudulent attempts of the defendants to appropriate their trade; and then to the last, in which the right of property to a trade mark was absolutely acknowledged and upheld.

It is important for the clear apprehension of the subject to distinguish between property in invention or patents, in trade marks, and in copyright. These are all distinct in substance and in principle.

Property in invention is conferred upon persons who, having introduced something new into the world, are, upon the fulfilment of a condition—the obtaining of a patent from the Crown—given the exclusive right, during a limited

period, of manufacturing and selling the new thing which they have introduced.

Property in trade marks is the exclusive right, recognised and protected by law, of persons and firms engaged in trade, of using the marks which they have adopted for the purpose of identifying their goods as their own, so long as the manufacture of those goods is carried on by those persons and firms, or by their successors in the business.

Property in copyright is the exclusive right, recognised and protected by law, of authors, or other producers of literary compositions or works of art, to print or otherwise multiply copies of their works.

Property in invention or patents gives the exclusive right to manufacture and use; property in copyright gives the exclusive right to multiply. Property in a trade mark confers no such privileges; it consists in the exclusive right to apply a sign, or device, or *mark* to the article or articles dealt with by the persons who have adopted that mark with reference to those articles; it gives no exclusive right to manufacture, and it matters not how the mark is multiplied or applied so long as it be not applied to those particular articles.

The property in a trade mark consists in the exclusive right to the use of some mark as applied to a particular manufacture—Lord Westbury, L. C., in *Hall* v. *Barrows* (33 L. J., Ch. 207).

The same learned judge also said in another case:—"The right which a manufacturer has to the use of a trade "mark is the exclusive right to use it for the purpose of "indicating where or by whom, or at what manufactory, "the article to which it is applied was made"—*Leather Cloth Co.* v. *American Leather Cloth Co., Limited* (35 L. J., Ch. p. 61); and again, in the same case (33 L. J., Ch. 201):—"There is no exclusive ownership of the symbols which "constitute a trade mark apart from the use and applica-"tion of them; but the word 'trade mark' is the desig-

"nation of marks or symbols when applied to a vendible "commodity, and the exclusive right to make such use or "application is rightly called property."

One more judicial definition may be given, taken from a decision of a Court in the United States of America, a country where the law upon trade marks has been much discussed and considered:—"A trade mark may consist of "a name or a device, or a peculiar arrangement of words, "lines, or figures in the form of a label, which has been "adopted and used by a person in his business to designate "goods of a particular kind manufactured by him, and "which no other person has an equal right to use. The "right in a trade mark so applied is recognised as property "which the Court will protect by injunction"—The Supreme Court of Massachusetts, in *Gillman* v. *Hunnewell* (122 Mass., 8 Lathrop, 139).

Although property in inventions, trade marks, and copyright are thus distinct, they may all, of course, be united in one person for the protection of the same subject. A man may have invented a machine and obtained a patent therefor; he may adopt a trade mark for it, and register it, and he may, although not very probably, adopt so artistic a design for his trade mark as to be entitled to the copyright therein. His property in the invention will expire with the period of the patent, in the copyright with the period of copyright, but the property in the trade mark will continue so long as the machine is manufactured and sold by him or his successors in the business, if kept upon the register.

The above cited decisions, in stating in what property trade marks consists, also define what a trade mark is. As a distinction exists between what are called "old marks," those in use before the passing of the Trade Marks Registration Act, 1875, viz., the 13th August, 1875, and those first used after that date, it is necessary to endeavour to define what is an old trade mark; the definition of a

new trade mark is to be found in the Act of 1875, amended by the Act of 1883. A definition, or rather enactment, of what a trade mark is, for the purposes of that Act, is found in section 1 of the Merchandise Marks Act, passed in 1862, for the object of preventing the fraudulent use of trade marks, and is as follows:—

The expression "trade mark" shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description used to denote any article to be an article of manufacture, or to be sold by the person using the trade mark. This definition was purposely made very comprehensive for the purposes of that Act. Another definition is one suggested by a very learned writer on the subject, before the passing of the Act of 1875, in a work published in 1874. "A trade mark may be said to be any symbol or "name or other indication which, when affixed to goods "offered for sale in the market, would convey to the minds "of purchasers the impression that those goods were the "manufacture of some person or firm, or some particular "place. By the expression 'other indication,' is intended "such other modes of conveying this impression to the "public as may consist of, for instance, any peculiar tying "of bundles of goods, or of peculiarly shaped bottles or "boxes, or any circumstance connected with the sale of "goods which has been always exclusively associated with "the plaintiffs' manufacture or business"—Adams on Trade Marks, p. 8.

The definition thus suggested by Mr. Adams may be taken to be an exhaustive and correct definition of an "old "mark."

But the Act of 1875, passed for the purpose of establishing a register of trade marks, considerably modified and restricted the definition of a trade mark capable of being registered, and section 64 of the Act of 1883 repeats the definition contained in section 10 of the Act of 1375, with

some slight additions. The following is section 64 of the Act of 1883 (which is printed later on, with notes, to which the reader is referred), the words in the new section which were not in section 10 of the Act of 1875, being indicated by italics :—

"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 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 fancy word or words not in common use.*

"2. There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, *or of any of them* ;

"3. Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures, *or of letters and figures*, used as trade marks before the 13th day of August, 1875, may be registered as trade marks under this part of this Act."

Since, by section 77 of the Act of 1883, no proceedings can be taken against infringers of a trade mark, unless it has been registered under this Act or that of 1875, the definition of a trade mark, contained in section 64 above, is now conclusive, and in future nothing will be a trade mark which does not come within it, unless used before the 13th August, 1875. With regard to "old marks"—those in use before that date—the case is different, for section 77 provides that no proceedings are to be taken against infringers, unless the mark has either been registered under

the Acts of 1875, 1877, or 1883, or registration thereof has been refused.

It is, therefore, important to bear in mind this difference between "old marks"—those used before the 13th August, 1875—and "new marks"—those first used after that date.

The following, amongst others, were held to be trade marks before the Act of 1875, and, as such, subjects of property, and entitled to the protection of a court of law against infringers:—

A system of numbering spools so as to indicate the quality of the thread wound upon them—*Ainsworth* v. *Walmsley* (L. R., 1 Eq. 518).

The well-known label of Johan Maria Farina upon Eau de Cologne bottles—*Farina* v. *Silverlock* (1 K. & J., 509; 6 De G. M. & G., 214).

The words or label "Excelsior White Soft Soap"—*Braham* v. *Bustard* (1 Hem. & M., 447).

The letters "LJ." as applied to whiskey—*Kinahan* v. *Bolton* (15 Ir. R., Ch. 75).

The Turkish word "Possendede," meaning "Warranted"—*Gout* v. *Aleploglu* (6 Beav., 69).

The word "Eureka," applied to shirts—*Ford* v. *Foster* (L. R., 7 Ch. 611; 41 L. J., Ch. 682).

The letters and names "Crowley," "Crowley Millington," "J H," applied to steel—*Millington* v. *Fox* (3 My. & Cr., 338).

The word "Ethiopian," and six white lines upon black stockings—*Hine* v. *Lart* (10 Jur., 106; 7 L. T., 41).

The labels upon the bottles in which Burgess' Essence of Anchovies was sold—*Burgess* v. *Hateley* (26 Beav., 249); *Burgess* v. *Hill* (26 Beav., 244).

The mark of a cross, with the letters C B—*Carter* v. *Carlile* (31 Beav., 292; 8 Jur., N. S., 183).

The mark of an anchor, as applied to wire—*Edelstein* v. *Edelstein* (1 De G. J. & S., 185; 7 L. T., N. S., 768).

The word "Anatolia," as applied to liquorice—*McAndrew* v. *Bassett* (4 De G. J. & S., 380; 33 L. J., Ch. 566).

The mark of a crown and the name Seixo—*Seixo* v. *Provezende* (L. R., 1 Ch. 192; 14 L. T., N. S., 314).

The words "Stephens's Blue-black Writing Ink," in letters of one colour upon a ground of another colour—*Stephens* v. *Peel* (16 L. T., N. S., 145).

The words "Schweitzer's Cocoatina (registered)"—*Schweitzer* v. *Atkins* (37 L. J., Ch. 847; 19 L. T., N. S., 6).

The fancy names "Turin," "Sefton," "Leopold," "Liverpool," on tickets, as applied to patterns of woollen cloth—*Hirst* v. *Denham* (L. R., 14 Eq. 542; 41 L. J., Ch. 752).

The word "Pectorine," applied to a medicine—*Smith* v. *Mason* (Weekly Notes, 1875, p. 62).

The first principle upon which our courts of law exercise jurisdiction for the protection of trade marks, is that one dealer in goods shall not be allowed to represent that his goods are the goods of another. In other words, to prevent the reputation which one man may have gained from the excellence of the things he sells, to be made use of to his detriment, by another man adopting his name, or the peculiar marks or devices with which his goods have become associated, when dealing with similar goods not of his manufacture.

As a further principle, that the public be protected from the fraud which would be perpetrated upon them by being induced to purchase articles by the representation that they were the production of the person with whose reputation they are acquainted, when, in fact, they are the goods of another person altogether.

And that the person, whose trade mark is infringed, be protected from the injury he would sustain by the profits on the sale of the goods being lost to him through the misrepresentation of the infringer of his right, who would gain

them instead; and from the more serious injury to his reputation from having inferior goods palmed off upon the public as his own.

Lord Langdale, M. R., in *Perry* v. *Truefitt* (6 Beav., 66; 1 L. T., 384), said, in the year 1842:—"I think that the "principle on which the Courts proceed, in granting relief "and protection in cases of the sort, are well understood. "A man is not to sell his own goods under the pretence "that they are the goods of another man; he cannot be "permitted to practise such a deception, nor to use the "means which contribute to that end. He cannot, therefore, "be allowed to use names, marks, letters, or other indicia, "by which he may induce purchasers to believe that the "goods which he is selling are the manufacture of another "person."

Lord Cranworth, L. C., in *Farina* v. *Silverlock* (6 De G. M. & G., 217), in 1856, said:—"I apprehend that the law "is perfectly clear, that anyone who has adopted a par- "ticular mode of designating his particular manufacture, "has a right to say, not that other persons shall not sell "exactly the same article better or worse, or an article "looking exactly like it, but that they shall not sell it in "such a way as to steal (so to call it) his trade mark, and "make persons believe that it is the manufacture to which "that trade mark was originally applied."

In *Hall* v. *Barrows* (4 De G. J. & S., 150; 33 L. J., Ch. 204), Lord Westbury, L. C., said, in 1863:—"A trade "mark consists in the exclusive right to the use of some "name or symbol as applied to a particular manufacture "or vendible commodity, and such exclusive right is pro- "perty. Imposition on the public is necessary for the "plaintiff's title, but in this way only, that it is the test of "the invasion by the defendant of the plaintiff's right "of property; for there is no injury if the mark used by "the defendant is not such as is mistaken, or is likely "to be mistaken, by the public for the mark of the

"plaintiff; but the true ground of the Court's jurisdiction "is property."

In *Wotherspoon* v. *Currie* (L. R., 5 H. L., at p. 522), Lord Westbury said, in the House of Lords, in 1872:—"The "principle on which the jurisdiction is founded . . . is "to prevent a party from fraudulently availing himself of the "trade mark of another, which has already obtained "currency and value in the market, by whatever means he "may devise for the purpose, provided the means are "devised in order to give him a colourable title to the use "of the word, and provided it be shown, from the manner "in which he has employed those means, that his object was "from the beginning to invade the property of the other."

It is not necessary that there should have been a fraudulent use of the plaintiffs' mark by a defendant in order to enable him to obtain protection for it, the fact that the defendant innocently used it in ignorance of the plaintiffs' rights will not prevent the defendant from being restrained from using it. "I wish to state in the most distinct "manner that, in my opinion, fraud is not necessary to be "averred or proved in order to obtain protection for a trade "mark. . . . A man may take the trade mark of another "innocently, not knowing it was the trade mark of the "other; or he may take it in the belief, mistakenly 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 to be 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 plaintiffs is just the same"—Lord Cairns, L. C., in *Singer Manufacturing Co.* v. *Wilson* (L. R., 3 App. Cas., at p. 391), following *Millington* v. *Fox* (3 My. & Cr., 352), and *Hall* v. *Barrows* (4 De G. J. & S., 150; 33 L. J., Ch. 204).

But it is necessary that the plaintiff should show that

his property has been interfered with, it is not enough to prove that the public has been or may be imposed upon by the use of the trade mark.

In the case of *Batty* v. *Hill* (1 H. & M., 264; 8 L. T., N. S., 791) both parties were makers of pickles, but Batty had obtained a medal at an exhibition, and Hill had not. Batty used the words "prize medal" stamped on his bottles. Hill did the same, and Batty sought to restrain him from doing so. Wood, V. C., afterwards Lord Hatherley, refused to do so, saying:—"The defendant has "super-added then to his labels, this representation which "the plaintiff has added to his, the difference being that the "representation is true on the part of the plaintiff, false on "the part of the defendant. On that point there arises a "presumption against the defendant, but he must be held "entitled to use those labels, false though they be, if they *do* "*not interfere with the Plaintiff's rights.*"

It will be perceived that in this case no property of Batty's had been invaded, or any right of his infringed. He could not say that his were the only prize medal pickles, and therefore prevent anyone else from saying that theirs were also prize medal. He had no *property* in the nature of a trade mark in the words prize medal, since all prize medallists could use it.

In the case of *Hirsch* v. *Jonas* (L. R., 3 Ch. D., 584; 45 L. J., Ch. 364), the plaintiff was a London cigar merchant, who imported cigars made by Genir, of Havannah, in boxes labelled by the latter, at the plaintiff's desire, with a design of "Britannia," and the words "Gloria di "Inglaterra," to which Genir added the words "of Joseph "Genir, manufacturer of cigars, Havannah." Genir used to supply the plaintiff exclusively, but there was no contract to do so, and he had supplied boxes similarly labelled to the defendant. The plaintiff applied to restrain the defendant from selling boxes of cigars so labelled, but Jessel, M. R., refused to do so, holding that the above labels might be a

trade mark, yet the plaintiff had no *property* therein, since he had no contract with Genir securing him the exclusive sale of the latter's cigars.

Therefore, a private person cannot interfere, as of his own right, to prevent a fraud upon the public by the use of a trade mark, unless there has also been an infringement of his own rights. The remedy in such a case is pointed out by the following observations of Sir John Romilly in *Hall* v. *Barrows* (32 L. J., Ch. 551) :—"Lord Loughborough "refused the injunction (in *Webster* v. *Webster*), and stated "that fraud on the public is no ground for a plaintiff coming "to this Court; that is, as I understand it, by a person who "has no interest in the subject matter by which the fraud "is committed. And this is in accordance with the principle, "that, although the Courts will discountenance and do "nothing to assist any false representation, still they do not "deal with the general interest of the public at the suit of "persons having no property in the subject matter, or the "suit must be at the suit of the *Attorney-General.*" That is to say the Attorney-General, representing the Crown, will in a proper case, on being set in motion by some member of the public, bring his suit to restrain the fraud, and his suit will be entertained.

A trade mark must not contain any misrepresentation; if it contains exaggerated or false statement of the value of the goods or other palpable misrepresentation calculated to deceive the public, the protection of the Courts will not be afforded to it. The principle is that the Courts will not give a man protection against an injury when it cannot do so without affording him greater facilities for practising deception upon others.

In *Pidding* v. *How* (8 Sim., 477; 6 L. J., Ch., N. S., 345), decided in 1837, the plaintiff sold tea under the name of "Howqua's Mixture," in packages marked in a particular manner, and the defendant imitated them. The plaintiff applied to restrain him from so doing; but it appeared that

the plaintiff had, in his advertisement, made a number of false representations about the origin, composition, and value of his tea, and the injunction, which would otherwise have been granted, was refused.

In *Perry* v. *Truefitt* (6 Beav., 66; 1 L. T., 384), decided in 1842, the plaintiff was the maker and seller of "Perry's "Medicated Mexican Balm," and the defendant began to make up and sell another compound as "Truefitt's Medi- "cated Mexican Balm." The plaintiff applied to restrain the defendant from doing this, but the Court refused to do so, because the plaintiff, on his show cards, made gross misrepresentations as to the origin and substances contained in his composition.

In *The Leather Cloth Co., Limited*, v. *The American Leather Cloth Co., Limited* (4 De G. J. & S., at p. 148; 33 L. J., Ch., at p. 203), Lord Westbury, L. C., said:—"I "cannot receive it as a rule, either of morality or equity, "that a plaintiff is not answerable for a falsehood because "it may be so gross and palpable as that no one is likely "to be deceived by it. If there be wilful false statement, "I will not stop to inquire whether it be too gross to "mislead."

Similarly where the word "patent" has been used in such a manner as to lead the public to believe that there is a patent in existence, giving the exclusive right of manufacturing the articles to which the trade mark relates, when the fact is, that there is no such patent in force, it has been always held that such a misrepresentation took away the right to have the trade mark protected.

In *Morgan* v. *McAdam* (36 L. J., Ch. 228; 15 L. T., N. S., 348) the plaintiffs were manufacturers of plumbago crucibles, trading under the name of the Patent Plumbago Crucible Company. There was no patent for the plaintiff's method of manufacturing crucibles, it was a secret the plaintiffs had purchased from the United States. The defendants commenced business under the same name, and

the plaintiffs sought to restrain them from doing so, but the Court refused on the ground of the plaintiffs' *misrepresentation that there was a patent*. Wood, V. C., said :—"If the Court finds it to be a right founded upon a " fraud, and certainly this is such, the Court says it cannot " assist a person in carrying on such a fraud."

In *Flavell* v. *Harrison* (10 Hare, 467; 22 L. J., Ch. 866), the same judge had previously refused an injunction to restrain the use of the words "Flavell's Patent Kitchener," in fraud of the plaintiff, upon the same ground, although the kitchener in that case had been invented, although never patented, by the plaintiff's father and predecessor in business.

In *The Leather Cloth Co., Limited,* v. *The American Leather Cloth Co., Limited,* just cited, the plaintiffs were held disentitled to protection upon the same ground, and Lord Kingsdown said (11 H. L. C., at p. 544) :—" If the " trade mark represents the article as protected by patent, " when in fact it is not so protected, I cannot think that " it can make any difference whether the protection never " existed, or has ceased to exist."

In *Lamplough* v. *Balmer* (Weekly Notes, 1867, 293), the plaintiff sought to restrain an imitation of his well-known label, "Pyretic Saline," the defendant using the title, "Balmer's Pyretic Salts." The injunction was refused, because the plaintiff's labels contained the words, " Royal " Letters Patent," when he had no patent, although he paid duty, and used the Inland Revenue stamps for patent medicines. And in *Nixey* v. *Roffey* (Weekly Notes, 1870, 227), the plaintiff used distinctive labels, upon which were the words, "Manufacturer and Patentee," although he held no patent, and his labels were refused protection on that account.

On the other hand, where the word "patent" is used merely as part of the designation of an article known in the market under that name—"patent leather," for in-

stance—and not so as to indicate the existing protection of a patent, there is no misrepresentation, and the use of the word patent in the trade mark does not disentitle it to protection. "In such a case," said Lord Kingsdown, in *Leather Cloth Co.* v. *American Leather Cloth Co.*, "no one is "meant to be deceived, or is deceived."

In *Edelstein* v. *Vick* (11 Hare, 78; 1 Eq. Rep., 413), the plaintiff's successors in business to the original patentees of "Taylor & Co.'s Patent Solid-headed Pins," continued after the expiration of the patent, to use the word in their labels. The defendant imitated their labels, and was restrained from doing so.

In *Marshall* v. *Ross* (L. R., 8 Eq., 651; 39 L. J., Ch. 225), the plaintiffs sold thread, manufactured by them, with wrappers containing, amongst others, the words "patent thread." There was no patent for the thread, but the evidence showed that the word patent had, by long usage, come to denote in the trade the character of the thread, and did not imply the existence of any patent. James, V. C., said:—"The word patent may be used in such "a way as not to deceive the public. . . Here the term "patent has been used in the trade for many years past, "and is the name by which thread of a certain class is used "by manufacturers; it has, in fact, become a word of art. "Here there has been no such misrepresentation, designed "or undesigned, as to deprive the plaintiffs of their right "to protection."

It follows, of course, from these cases, that there is no reason why a trade mark should not state, in so many words or by implication, that the article is made according to a patent which has expired, so long as it does not suggest that it still enjoys the protection of a patent; and the law is so stated by Jessell, M. R., in *Cheaven* v. *Walker* (L. R., 5 Ch. D., at p. 862).

A misrepresentation which is only collateral to the trade mark will not, however, disentitle it to protection; as

where the advertiser of the shirts to which the trade mark "Eureka" was applied, called himself a "patentee," when he did not hold a patent, the word "Eureka" was still protected, because the trade mark itself contained no misrepresentation—*Ford* v. *Foster* (L. R., 7 Ch. 611; 41 L. J., Ch. 682).

The Trade Marks Registration Act of 1875 dealt with this subject of misrepresentation, and adopted the principle of the above decisions; and the provisions of that Act are repeated in the Act of 1883, in section 73, to which, and to the note thereon, the reader is referred.

Marks containing such misrepresentations are not capable of registration, and, if registered by mistake, can be removed from the register, upon the principle of the cases of *re* Hyde's Trade Mark and *re* Palmer's application, set out and discussed in the note to section 76 of the Act, *supra*.

A *mark*—including within that comprehensive term whatever might have been held capable of protection as an old mark, and whatever may come within the definition of section 64 of the Act of 1883—which might originally have been capable of protection as a trade mark, becomes incapable of being registered and protected in the Courts as such, when, for whatever reason, it has ceased to convey the meaning that the goods to which it is applied are of a particular manufacture—or rather manufactured by a particular firm—and has become merely indicative or descriptive of the particular article to which it is applied. Such *marks* have become mere terms of art, improper to be the exclusive property of anyone; they are, therefore, *publici juris*, open to every one to use.

Such marks may have been first used, and even invented, by someone for the express purpose of distinctively indicating his particular manufacture, and yet the exclusive right of using them may have been lost by his negligence

in not preventing their use by other people, or by his acquiescence in their doing so. It is evident that many names, by which articles are now known in trade, and manufactured and sold by everyone who cares to do so, without anyone being able to hinder him, were once, or might have been trade marks.

Mellish, L. J., said, in *Ford* v. *Foster* (L. R., 7 Ch. 611; 41 L. J., Ch. 682) :—"There is no doubt, I think, that a "word, which was originally a trade mark, to the exclusive "use of which a particular person, or his successor in trade, "may have been entitled, may subsequently become *publici* "*juris*, as in the case recently before us of 'Harvey's "'Sauce.'" It was admitted there, that, although that "had been originally the name of a sauce made by a "particular individual, it had become *publici juris*, "and that all the world were entitled to call sauce "'Harvey's Sauce,' if they pleased. What then is the "test by which it is to be decided whether a word, which "was originally a trade mark, has become *publici juris?* "I think the test to be this: whether the use of the word "still continues to deceive the public, or any part of the "public; whether the use of it by any other person than "the original user may still have the effect of inducing the "public to buy goods not made by him, under the sup-"position that they are his goods. If the word or mark "has become of such universal use that nobody can be "deceived by the use of it, then no one can be induced, "from the use of it, to believe that he is buying the goods "of the original owner. If it has become as public of "that, then, however hard it may seem to be on the trader, "yet practically as the right to a trade mark, is simply a "right to prevent the owner of it being cheated by other "persons goods being sold as his goods through the "fraudulent use of the trade mark; as that is the nature of "the right, if that has ceased to deceive anybody the right "itself must be gone."

In the case of *The Wheeler and Wilson Manufacturing Company* v. *Shakespeare* (39 L. J., Ch. 36), the plaintiffs, a company formed for the purpose of manufacturing sewing machines according to the invention of Messrs. Wheeler and Wilson, and which had acquired the patent rights of those gentlemen, attempted, after the expiration of the patents, to restrain the defendant, who had been their agent, but had ceased to be so, from selling machines, not manufactured by the plaintiffs, as "Wheeler and Wilson's "Sewing Machines." But the evidence established that the name, "Wheeler and Wilson," as applied to sewing machines, only meant in the trade, machines of a certain construction, according to the principle of Wheeler and Wilson's expired patents, and not that they were manufactured by them. James, V. C., said:—"It seems to me "that the name, 'Wheeler and Wilson,' has come to "signify the thing manufactured according to the principle "of the patent. That being so, I cannot restrain anybody "after the expiration of the patent from representing his "article as being the article which was so patented. A "man cannot prolong his monopoly by saying:—'I have got "'a trade mark in the name of a thing which was the "'subject of the patent.'"

The principle of this decision was approved throughout all the Courts in the case of the *Singer Manufacturing Co.* v. *Wilson*, reported in the Rolls Court (L. R., 2 Ch. D., 434), in the Court of Appeal (L. R., 2 Ch. D., 448), and in the House of Lords (L. R., 3 App. Cas., 376), in which the use of the word "Singer," as applied to sewing machines, was in question; although in the last tribunal the evidence as to whether the name was really indicative of the plaintiffs' manufacture or of a principle of construction was found insufficient, and the question remitted to the Court below to take further evidence thereon, which, however, it is believed was never done.

In *The Liebig's Extract of Meat Co.* v. *Hanbury* (17 L. T.,

N. S., 298), the plaintiffs were manufacturers and vendors of Liebig's Extract of Meat, and Baron Liebig had, in 1866, granted them the exclusive privilege of using his name in connection therewith. The defendant prepared meat according to Baron Liebig's recipe, and sold it under the same name as the plaintiffs. An injunction to restrain the defendant from doing so was refused by Wood, V. C., on the ground that the term "Liebig's Extract of Meat" had been in common use for a long time, as descriptive of an article prepared in a well-known manner, published by Baron Liebig so long ago as 1847.

The principle upon this question was very early stated, with his usual clearness, by Lord Westbury, L. C., in *Hall* v. *Barrows* (4 De G. J. & S., 150; 33 L. J., Ch. 204).

"A name, though originally the name of the first maker, "may, in time, become a mere trade mark, a sign of quality, "and cease to denote or be current as indicating that any "particular person is the maker. In many cases a name "once affixed to a manufactured article, continues to be "used for generations after the death of the individual who "first affixed it. In such cases the name is accepted in the "market as a brand of quality, or it becomes *the denomina-* "*tion of the commodity itself*, and is no longer a represen- "tation that the article is the manufacture of any particular "person."

When a man is the first to use a natural product, and under a patented process, the name of the natural product will not be a trade mark, although any original or fanciful appellation he may adopt would be.

In *Young* v. *Macrae* (9 Jur., N. S., 322), the plaintiff, Mr. Young, who had introduced the use of "Paraffin oil" under a patent obtained by him, sought to restrain the defendant from using the same name for an oil manufactured by him. The injunction was refused on the ground that the name was not a new one invented by the plaintiff, but was a natural title which must be inevitably applied to the

same article by whatever means produced. In the same case Wood, V. C., said :—"I have not the least doubt that "if the plaintiff had invented a fanciful and ridiculous name "—and the more ridiculous the better it is for his purpose— "and had used it for eight or ten years in his trade, the "Court would take care that nobody else should use that "absurd name, for such user could only be a user for the "express purpose of imitating the plaintiff, and so defraud- "ing the plaintiff by representing goods manufactured by "one person to be goods manufactured by another."

In *The Linoleum Manufacturing Co.* v. *Nairn* (L. R., 7 Ch. D., 834; 47 L. J., Ch. 430), Fry, J., held that the word "Linoleum," forming part of a trade mark registered under the Act of 1875, did not form an essential feature of the mark, and refused an injunction to restrain the use of it, holding that the fact that the word had been previously used by the plaintiffs alone, they being hitherto patentees, did not give the plaintiffs an exclusive right in it, and saying :—"Until some other person is making the same "article, and is at liberty to call it by the same name, there "can be no right acquired by the exclusive use of a name "as showing that the manufacture of one person is indicated "by it, and not the manufacture of another."

Similarly, in *Condy* v. *Mitchell* (37 L. T., N. S., 268 and 766 ; 26 W. R., 269), in an action by the plaintiff to restrain the defendant from using the word "Condy," an injunction was refused on the ground, amongst others, that the name, "Condy's Fluid," had come to be the name of an article of commerce under Condy's expired patent.

And in *Siegert* v. *Findlater* (L. R., 7 Ch. D., 801 ; 47 L. J., Ch. 233), Fry, J., held that the plaintiff was not entitled to the exclusive use of the term "Angostura Bitters," since that had become the name of an unpatented article, which anyone who could discover the secret recipe, might make and call by its name, although it had hitherto been made by only one firm, because they alone knew the secret ; al-

though he granted an injunction to prevent the defendant using the words in such a way as to be calculated to deceive, saying :—"No distinction can arise from using the name " of a class, so long as the class consists only of one species, " for then the name of the species and the name of the " class will be the same."

The subject of these common marks has received attention in the new Act. To prevent difficulty with regard to marks in which some item or particular is common, but which, taken as a whole, is not so, section 74 enacts that the Comptroller may enter on the register, *as an addition to any trade mark*: (*a*) in the case of an old mark—one used before 13th August, 1875—*any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures*; and, (*b*) in the case of a new mark—one not used until after 13th 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, providing, however, that the applicant disclaims all exclusive right to such common particular. The section also defines what is a common old mark, by enacting that any device, &c., used before by more than three persons on the same, or a similar description of goods, shall, for the purposes of the section, be deemed common to the trade in such goods. The object of the section is to enable, in the case of old marks, the mark which has been used to be put on the register, with such additions, whether before used or not, as shall render it clear that they are used by the particular person who registers and uses it. Thus, to take any of the above cases in which a device or mark has been held to be common, such as a triangle or an elephant. These may be registered by several persons as parts of, and in addition to, other distinctive elements which will identify each individual, person, or firm; and in regard to new marks, any distinctive word, or combination of words, such as "Linoleum," or

"Angostura Bitters," may be registered as additions to marks otherwise distinctive, always, whether in the case of old or new marks, with a disclaimer of any exclusive right to the common element, by the applicant.

The exclusive right to a trade mark can only be claimed for particular classes of goods.

This was decided long before the establishment of the Register of Trade Marks, and is obvious, from a consideration of the nature of a trade mark, the object and effect of which is to identify particular goods as being the production of particular persons or firms. "There can be no "*right to the exclusive ownership of any symbols or marks* "universally in the abstract. Thus, an ironfounder who "has a particular mark for his manufactures in iron, could "not restrain the use of the same trade mark when im- "pressed on cotton or woollen goods; for a trade mark "consists in the exclusive right to the use of some name "or symbol, as applied to a particular manufacture or ven- "dible commodity, and such exclusive right is property"— Lord Westbury, in the case of *Hall* v. *Barrows* (4 De G. J. and S., 150), so frequently cited before. Accordingly, when the register was established by the Act of 1875, section 2 of that Act provided that "a trade mark must be "registered as belonging to particular goods or classes "of goods"; and the new Act of 1883, amending and repealing the preceding Acts, repeats that provision in section 65, to the note upon which the reader is referred.

A trade mark, being property, is, like other property, assignable; but, following from the above principle that it can only be associated with particular classes of goods, is the further principle that it can only be assigned in connection with the goodwill of the business concerned with the goods to which it relates. This again is clear from a consideration of the nature of a trade mark, the object of which is to indicate to the public that the goods with which

they are used, are the product of some particular manufacture which has acquired reputation.

"The right to a trade mark may in general, treating it "as property, or an accessory of property, be sold and "transferred, upon a sale and transfer of the manufactory "of the goods on which the mark has been used to be "affixed, and may be lawfully used by the purchaser"—Lord Cranworth in *Leather Cloth Co.* v. *American Leather Cloth Co.* (11 H. L. C., 523).

This principle was adopted by the Act of 1875, section 2 of which provided that a trade mark, when registered, should be "assigned and transmitted only in connection "with the goodwill of the business concerned in the par-"ticular goods or classes of goods," as belonging to which it had been registered, and should be "determinable with "such goodwill," and section 70 of the new Act, to the note upon which section the reader is referred, repeats that enactment.

Upon the owner of a trade mark becoming bankrupt, the property in the trade mark passes, together with the goodwill in his business, to his trustee in bankruptcy, as forming part of his assets—*Hudson* v *Osborne* (39 L. J., Ch. 79); *Bury* v. *Bedford*, (33 L. J., Ch. 465; 4 De G. J. & S., 352).

If a man owning a trade mark goes into partnership with other persons for the purpose of carrying on business in the goods with respect to which a trade mark is associated, the trade mark will, if provision is not expressly made to the contrary, become part of the partnership property. Turner, L. J., in *Bury* v. *Bedford* (4 De G. J. & "S., 374):—"The whole trade is carried into the partner-"ship, and the trade mark is but an element of the trade."

On the dissolution of a partnership, the trade mark will follow the goodwill of the business. But if each of the partners merely divide the other partnership assets, and all carry on the business subsequently individually, each

may use the trade mark—*Banks* v. *Gibson* (34 Beav. 566; 34 *L. J.*, Ch. 591).

Previously to the establishment of the Register of Trade Marks, by the Act of 1875, it was necessary, in order to give anyone property in the trade mark, that is to say, the exclusive right of using it, that he should have actually transacted business on the goods to which it was applied, that the goods should be actually vendible articles in the market. Lord Westbury, in *McAndrew* v. *Basset* (4 De G. J. & S., 380; 33 L. J., Ch. 566). Following this, it was decided, in *Maxwell* v. *Hogg* (L. R., 2 Ch., 307; 36 L. J., Ch. 433), that no expense, in preparing for the market, or in advertising, would, without publication, give the right. And there is a previous decision, in the case of *Lawson* v. *The Bank of London* (18 C. B., 84; 25 L. J., C. P., 188) to the same effect. But the Act of 1875 rendered this unnecessary for the future, in the case of marks registered under that Act, by providing in section 2, that "registration of a trade mark should be deemed to be equivalent to "public use of such mark," and, section 75 of the new Act of 1883 repeats that enactment.

So that all that is necessary to acquire the exclusive right to a trade mark, which is properly a trade mark, and capable of registration under the Act, is to obtain the registration thereof. It has been already stated that registration is not conclusive of the right to a trade mark, or that the mark registered is properly a trade mark, but that the registration of a mark, which ought not to be on the register, can be expunged—*Re* Hyde's Trade Mark (L. R., 7 Ch. D., 724); *re* Palmer's Trade Mark (L. R., 21 Ch. D., 47), set out in the note to section 76.

But in order to prevent the exclusive right to use trade marks remaining vested in persons who do not use them, and the register remaining encumbered with a number of marks associated with goods in which business is not being done, a number of provisions are to be found in the Act of

1883. Section 79, which enacts the provisions of rules 30, 31, 32, and 33, under the Acts of 1875 and 1877, requires that a registered trade mark shall be removed from the register at the end of fourteen years from the date of the registration, unless a fee be paid for a renewal of the registration for another period of fourteen years, and so on, from time to time, at the expiration of every period of fourteen years. This provision secures that the registered owner of a trade mark shall, at all events, do something to keep up his property.

Rule 34 of the rules under the Acts of 1875 and 1877 contained another and more powerful remedy, which, curiously enough, has not been adopted in the new Act, or in the rules made by the Board of Trade under its authority, and, therefore, no longer remains in force. This rule provided, that where, after five years from the date of the registration of any trade mark, the registered owner was not engaged in any business concerned in goods within the same class as the goods with respect to which his trade mark is registered, the Court might, on the application of any person aggrieved, remove any trade mark from the register on that ground.

A very recent instance of the enforcement of this power, under rule 34, under the Acts of 1875 and 1877, occurred in the case of *re* Ralph's trade mark, before Mr. Justice Pearson, on the 17th Nov., 1883, reported in the "Times" of the 19th Nov., 1883; and the "Weekly Notes" of the 24th Nov., 1883, p. 181. It was a motion on the part of Messrs. Taylor and Wilson, that the register might be rectified by removing therefrom the trade mark "Home "Washer." It appeared that Mr. Ralph was the owner of a patent which expired in 1882, that he had not carried on the manufacture of the articles associated with the trade mark since his patent had expired, and that Messrs. Taylor and Wilson did, and could not sell it except under the title covered by the trade mark. Mr. Justice Pearson held that

Messrs. Taylor & Wilson were persons aggrieved within the rule, and allowed the motion. Since, under section 77 of the new Act, no proceedings can be taken against an infringer of a trade mark, unless, if a new mark, it has been registered in pursuance of the Act, or of an enactment repealed by this Act; or, if an old mark, it has either been registered or registration refused; it is clear that if the trade mark is not on the register, except in the few cases which will gradually disappear, of old marks not coming within the definition of a trade mark contained in the Act, no protection can be obtained for it. These provisions afford a means of preventing persons holding trade marks which they do not use, to the detriment of other persons.

What has been written in this chapter is for the purpose of stating those general principles of the law of trade marks, which do not appear in that portion of the new Act which relate to that subject, and which the framers thereof assumed would be understood. It does not render a careful perusal of the Act unnecessary to those who would understand the law, it rather renders it the more necessary, for the object of the writer has been to avoid all those subjects which are dealt with in the Act as far as possible, in order to avoid repetition. The Act explains itself, and in it and in the body of the rules will be found a complete exposition of the practice of registering trade marks, and of assigning them, rendering any explanation here unnecessary. In the notes to the various sections a number of highly important points, which, however, do not concern the first principles of the law, are dealt with in their places, and to them the reader is referred.

One other point, however, remains to be dealt with here, and that is, the Merchandise Marks Act of 1862 (25 & 26 Vic., c. 88). This Act, was the first Act of Parliament passed upon the subject of trade marks, and, while all the other Acts passed upon the subject are

repealed and codified in the new Act of 1883, this one is left unaffected.

It was an Act passed long before the establishment of any registry of trade marks, for the object, as its preamble states, of amending "the law relating to the fraudulent "marking of merchandise, and to the sale of merchandise "falsely marked for the purpose of fraud." It came to be passed principally in consequence of a decision of the Court of Crown Cases reserved, in the case of *Reg.* v. *John Smith* (D. & B., 566; 27 L. J., M. C., 225), in the year 1858, when it was held that a fraudulent imitation of a trade mark was not a forgery at common law. The prisoner, in that case, was indicted for forgery, and it was proved that he had printed and used a number of wrappers in imitation of those used on Borwick's Baking Powders and Egg Powders, with the name of Borwick in a prominent position, but omitting the signature of Borwick. Bramwell, J., said:—"In the present case, one of these documents is as "good as the other; the one asserts what the other does; the "one is as true as the other; but the one gets improperly "used. But the question is, whether the document itself is a "false document. It is said that the wrapper is so like "one used by somebody else that it may mislead; but that "is not material to the question which we have to decide. "The prisoner may have committed a gross fraud in using "the wrapper for that which was not the genuine powder, "and may possibly be indicted for obtaining money by "false pretences, but I think he cannot be convicted of "forgery."

It had shortly previously been held also by the Court of Crown Cases Reserved, in *Reg.* v. *Closs* (D. & B., 460; 27 L. J., M. C., 54), that imitating the signature of an artist of reputation, "J. Linnell," in the corner of a spurious picture, was also not a forgery.

No doubt in both these cases an indictment might have lain for obtaining money by false pretences; but it is

necessary, in such an indictment, to prove that the money was obtained from the belief in the false representation by the person parting with the money; and it was obvious that the person whose interests was most seriously affected —the person whose label or signature was imitated—was, in that view of the case, not the person defrauded, but the person whose money was obtained. And the difficulty in proving this was found so great that a change in the law was thought desirable.

The Merchandise Marks Act of 1862 made the following acts misdemeanours :—

By section 2—

1. Forging or counterfeiting any trade mark with intent to defraud ;
2. Applying any trade mark to articles not of the manufacture of the *person* intended to be denoted by such trade mark ;
3. Applying any trade mark, with intent to defraud, to articles not of the *particular manufacture* intended to be denoted by such trade mark.

By section 3—

4. Applying, with intent to defraud, any trade mark to any case or wrapper in which an article is sold ;
5. Placing, with intent to defraud, any article within a case or wrapper to which any genuine trade mark has been falsely, or any counterfeited trade mark, applied ;
6. Placing any article, with intent to defraud, in a case or wrapper having thereon a trade mark belonging to any other person ;

By section 4 a penalty of the value of the article, and from 10*s.* to £5, is imposed for—

7. Selling any article knowing that a false trade mark is applied thereto.

A similar penalty is imposed by section 7 for—

8. Making any false statement, with intent to defraud, upon any article to be sold;

9. Marking any article to be sold, with intent to defraud, with any statement that the article, or the manufacture thereof, or the ornamentation or configuration thereof, is the subject of any existing patent, privilege, or copyright.

A penalty of from 5*s*. to £5 is imposed by section 8 for—

10. Selling any article with any false statement of quantity, number, weight or measure, or of the place or country where such article was made or produced.

By section 6—

Any person who sells an article bearing a false trade mark is bound to give information where he procured it, under a penalty of £5.

By section 5—

Fraudulent alterations of, and additions to, trade marks are made false trade marks within the Act.

And by section 12, it is made unnecessary to allege in the indictment or to prove any intention to defraud any particular person.

CHAPTER IV.

MEMORANDUM ON BILL ON ITS FIRST INTRODUCTION INTO PARLIAMENT (POINTING OUT THE CHANGES IN THE LAW).

Object of Bill.

"This Bill is designed to amend and consolidate in a single measure the provisions of the numerous laws relating to patents, designs, and trade marks, and, at the same time, to simplify procedure, lessen its cost, and increase the protection afforded.

State of existing law.

The law regulating applications for, and the grant of, patents, is thirty years old, dating from 1852; and there are some half-dozen other statutes relating to patents, passed between 1835 and 1859.* The principal Acts which provide for the registration of ornamental and useful designs, and for conferring copyright therein, are forty years old, having been passed in 1842 and 1843; and there are amending Acts of 1850, 1858, 1861, and 1875. Some of the above statutes contain provisions which have become obsolete or unnecessary, and are confused in arrangement and form.

The Trade Marks Act is comparatively modern, having been passed in 1875; but it contains some unworkable provisions relating to the Cutlers' Company,†

---

* A list of all the Statutes will be found in the 3rd Schedule of the Act (Enactments Repealed).

† The Company of Cutlers of Hallamshire, in the County of York, was incorporated by Statute in the reign of James I. (1624), since which time the Company has exercised the privilege of assigning trade marks to persons engaged in the cutlery manufacture of the district. (see the Summary of the Cutlers' Companys Acts, at the end of the Book).

and the definition of a trade mark also requires amendment. The Trade Mark Acts of 1876 and 1877 are short amending Acts.

Acts relating to exhibitions.

In 1865 and 1870 two Acts were passed for the protection of unpatented inventions and unregistered designs from the consequences of user or publication at, or during the holding of, industrial or international exhibitions.

The Bill proposes to consolidate and repeal these Acts also.

Amendments of existing law.

As regards the provisions of the three divisions of the Bill relating respectively to—

Patents,
Designs, and
Trade Marks,

the principal alterations in the present system are as follow :—

I.—Patents.

Fees.

The fees payable at present in order to obtain a patent amount to £25, with further payments of £50 before the expiration of the third year, and £100 before the expiration of the seventh year of the patent. Under the Bill a patent will be obtainable for £4, and, while the amount of the further payments remains unaltered, the payment of the £50 is postponed to the fourth year; so that a four years' patent will only cost £4.

Under the existing Acts it is necessary for an intending patentee or his agent to apply personally at the Patent Office at least seven times, and make four separate payments, using four documents for the application.

Simplification of procedure

By this Bill an applicant or his agent will only have to call twice at the Patent Office, to use three documents, and to make two payments; but applicants may,

if they please, transact their business entirely by post, and thus avoid either personal attendance at the office or the payment of agency fees. This will be best illustrated by the following tabular comparison:— for obtaining grant.

Key to Procedure on an Unopposed Application, with Provisional Specification.*

(i.) *By Applicant or his Agent.*

Under old Acts.	Under Bill.
1. Petition, declaration, and provisional specification left at Patent Office.	1. Declaration and provisional specification left at or sent by post to Patent Office. Cl. 5.
2. Call for certificate of allowance of provisional protection.	2. Complete specification, with fee for sealing patent, left at or sent by post to Patent Office. Cl. 8.
3. Notice to proceed given.	
4. Call for certificate of notice to proceed.	
5. Warrant and Seal bespoken and paid for.	
6. Call for patent.	
7. Specification filed.	

* As the majority of applications for Letters Patent are by way of provisional protection, these observations refer to applications with provisional specifications in a correct form.

(ii.) *By Patent Office.*

Under old Acts.	Under Bill.
1. Provisional documents entered in register.	1. Provisional documents entered in register.
2. Application advertised in journal.	2. Provisional documents referred to examiner at Patent Office. Cl. 6.
3. Provisional documents sent to law officer.	3. Notification of acceptance sent to applicant or agent by post.
4. Provisional protection allowed by law officer.	4. Complete specification referred to examiner. Cl. 9. 1.
5. Provisional protection advertised.	5. Advertisement of acceptance of complete specification. Cl. 10.
6. Notice to proceed advertised.	6. Notification of acceptance of complete specification sent to applicant or agent by post.
7. Provisional documents again sent to law officer.	7. Patent prepared and sealed. Cl. 12.
8. Law officer's fiat for warrant received.	8. Patent sent to applicant or agent by post.
9. Warrant sent to law officer for signature.	
10. Warrant received from law officer.	
11. Patent prepared and sealed.	

It is also proposed to sell the new application and specification forms ready stamped at the Patent Office, or to send them by post at the price of the fee, *i.e.*, no charge to be made for the blank form itself. Only two stamped forms will be necessary, one a £1 declaration form, and another a £3 form, for the complete specification. The Inland Revenue Department will also arrange to sell these stamps at post offices in the principal commercial centres of the kingdom. At present, persons residing in the country must either employ an agent in London to obtain the stamped forms, or obtain them through a stamp office from the Inland Revenue Department by post.

Licenses. The Bill provides for enforcing the grant of licenses in certain cases, and subject to proper safeguards. Cl. 22.

Extension of Patents. It is proposed to lay down principles for the guidance of the Court, which has jurisdiction to extend the term of a patent. Cl. 25 (4).

Actions for infringement. In any action for infringement, either party will be empowered under the Bill to require a skilled assessor to be called in, cl. 28; and in any such action a patentee will be able, by leave of the Court to disclaim, and give his disclaimer in evidence, but not in such case to obtain damages without leave of the Court. Cl. 19, 20.

Scire facias. The proceeding, by *scire facias*, to repeal a patent is abolished, and power to obtain revocation on petition to the Court substituted. Cl. 26.

The following are the other principal new provisions:—

Other new provisions 1. Limitation of patent to one invention made statutory; with a proviso that it shall not be competent in an action or other proceeding to object to a patent on the ground that it comprises more than one invention. Cl. 33.

2. Extension of provisional protection from six to

fifteen months, or from application to sealing of patent. Cl. 14.

3. Extension of first term of a patent from three to four years. Cl. 17 (2). The duration of patents will continue to be fourteen years.

4. Complete specification to contain distinct statement of claims. This will be of very great service for the purposes of indexing and reference. Cl. 5.

5. Deposit of complete specification before the grant of the patent.

This must be made within *nine* months from the date of application with a provisional specification for patent. Cl. 8.

6. Appointment of examiners—

(*a.*) To examine applications for the purpose of seeing that the invention is subject matter for a patent, and that its nature has been fairly described. Cl. 6.

(*b.*) To compare complete with provisional specifications for the purpose of seeing that they correspond. Cl. 9.

(*c.*) To examine amendments and disclaimers. Cl. 18.

7. Appeal to law officer from examiners. Cl. 7, 9, 18.

8. Substitution of Seal of Patent Office for wafer seal now used in lieu of the Great Seal. Cl. 12.

9. Enlargement of time for payment of fees and renewal. Cl. 17 (3), (4).

10. Publication of an illustrated journal of patented inventions. Cl. 40.

11. Discontinuance of register of proprietors;—copies of deeds, &c., hitherto copied therein to be supplied by the parties interested at their own cost.

12. Discontinuance of sending to Edinburgh and Dublin transcripts of Letters Patent and deeds and

certified copies of specifications and disclaimers, but printed copies of the Patent Office publications will be sent to these cities.

13. Transfer of Patent Museum to Department of Science and Art, with power to require models on payment. Cl. 41, 42.

14. The provisions of the separate Acts relating to the protection of unpatented inventions exhibited at industrial and international exhibitions are repealed and re-enacted in the Bill. Cl. 39."

In addition to the points noticed in the Memorandum, the following very important changes in the law are made by the Act:—

Section 25 of the Act of 1852, enacting that a British patent should lapse on the expiration of any foreign patent granted before the date of the British patent is repealed and is not re-enacted. All British patents, therefore, granted after the coming into operation of the new Act will, therefore, be unaffected as to their duration by any foreign patent taken out before the date of the British patent.

Patents may be granted to another person, or other persons than the inventor, jointly with the inventor. Cl. 4.

A patent may be granted to the personal representatives of deceased inventors. Cl. 34.

The Channel Islands are no longer included in the grant of exclusive privilege of using the invention conferred by patent (see form of patent, first schedule D).

A penalty, not exceeding £5, is imposed upon any person representing an article sold by him as a patent article, when no patent has been granted for the same. Cl. 105.

A penalty, not exceeding £20, is imposed upon any person upon assuming or using the Royal arms without the authority of the Queen, Royal Family, or some Government Department. Cl. 106.

II.—Designs.

Amendments of law as respects Designs.

"1. At present there is a twofold classification of designs into ornamental and useful, and they are registered under separate Acts, which, however, in their main features are the same. It is often difficult to determine

to which class a design belongs, while a so-called useful design might frequently be the subject of a patent, were it not for the cost. Inasmuch as under the Bill the first fee on Letters Patent is to be reduced from £25 to £4 (£10 being now charged for the registration of a useful design), it is proposed to discontinue the distinction between ornamental and useful designs, and to accept for registration *any* novel design in the proper sense of the word. Such "useful" designs as embrace a mechanical action would be treated as subject matter for a patent.

2. Additional facilities are provided for the registration of designs, provisional registration being abolished, and complete registration provided for without the necessity of depositing actual specimens of the design on application; but such specimens must be deposited before sale and delivery of goods to which the design is applied. Cl. 47-51.

3. It is proposed to make uniform the various existing terms of copyright by the adoption of a fixed term of five years for all designs. Cl. 50.

4. The provisions of the separate Acts relating to the protection of unregistered designs exhibited at industrial and international exhibitions are repealed and re-enacted in the Bill. Cl. 57.

5. The existing power to register works of sculpture is omitted as unnecessary."

III.—Trade Marks

Amendments of law as to trade marks.

"1. The present definition of a trade mark has been extended to include—

(*a*) Fancy words not in common use,

(*b*) Brands; and

(*c*) Single letters as old trade marks. Cl. 64.

2. Power is taken to clear the list of applications for

trade marks of those applications which have not been proceeded with during a reasonable period. Cl. 63.

3. Provision is made for giving notice by advertisement of applications for registration, and for opposition to registration. Cl. 68, 69. These were regulated by rules.

4. Power is given to register a series of marks in every registration. Cl. 66.

5. No alteration will be made in the term for which a trade mark is registered, namely, fourteen years, with renewal; but the provisions for this purpose, now made by rules, are inserted in the Bill. Cl. 79.

6. The provisions of the existing Act regarding the registration of Sheffield (Cutlers' Company) marks have been amended, so as to bring the method of registering marks at Sheffield into harmony with the system of registration in London. Cl. 81.

General.

General Provisions

1. All proceedings relating to the grant of patents, and registration of designs and trade marks, will be under control of an officer, called the Comptroller, acting under the superintendence of Board of Trade. Cl. 83.

2. Power is taken to provide a new Patent Office. Cl. 82.

3. Power is taken to join the International Union for the reciprocal protection of patents, designs, and trade marks. Cl. 103."

CHAPTER V.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

[46 & 47 VICT. CH. 57.]

ARRANGEMENT OF SECTIONS.

PART I.

PRELIMINARY.

Sect.

1. Short title.
2. Division of Act into parts.
3. Commencement of Act.

PART II.

PATENTS.

Application for and Grant of Patent.

4. Persons entitled to apply for patent.
5. Application and specification.
6. Reference of application to examiner.
7. Power for Comptroller to refuse application or require amendment.
8. Time for leaving complete specification.
9. Comparison of provisional and complete specification.
10. Advertisement on acceptance of complete specification.
11. Opposition to grant of patent.
12. Sealing of patent.
13. Date of patent.

Provisional Protection.

14. Provisional protection.

Protection by Complete Specification.

15. Effect of acceptance of complete specification.

Patent.

16. Extent of patent.
17. Term of patent.

Sect. *Amendment of Specification.*
18. Amendment of specification.
19. Power to disclaim part of invention during action, &c.
20. Restriction on recovery of damages.
21. Advertisement of amendment.

Compulsory Licenses.
22. Power for Board to order grant of licenses.

Register of Patents.
23. Register of patents.

Fees.
24. Fees in Schedule.

Extension of Term of Patent.
25. Extension of term of patent on petition to Queen in Council.

Revocation.
26. Revocation of patent.

Crown.
27. Patent to bind Crown.

Legal Proceedings.
28. Hearing with assessor.
29. Delivery of particulars.
30. Order as to inspection, &c., in action.
31. Certificate of validity questioned, and costs thereon.
32. Remedy in case of groundless threats of legal proceedings.

Miscellaneous.
33. Patent for one invention only.
34. Patent on application of representative of deceased inventor.
35. Patent to first inventor not invalidated by application in fraud of him.
36. Assignment for particular places.
37. Loss or destruction of patent.
38. Proceedings and costs before law officer.
39. Exhibition at industrial or international exhibition not to prejudice patent rights.
40. Publication of illustrated journal, indexes, &c.
41. Patent Museum.
42. Power to require models on payment.
43. Foreign vessels in British waters.
44. Assignment to Secretary for War of certain inventions.

Existing Patents.
45. Provisions respecting existing patents.

Definitions.
46. Definitions of patent, patentee, and invention.

PART III.

Designs.

Sect. *Registration of Designs.*
47. Application for registration of designs.
48. Drawings, &c., to be furnished on application.
49. Certificate of registration.

Copyright in Registered Designs.
50. Copyright on registration.
51. Marking registered designs.
52. Inspection of registered designs.
53. Information as to existence of copyright.
54. Cesser of copyright in certain events.

Register of Designs.
55. Register of designs.

Fees.
56. Fees on registration, &c.

Industrial and International Exhibitions.
57. Exhibition at industrial or international exhibition not to prevent or invalidate registration.

Legal Proceedings.
58. Penalty on piracy of registered design.
59. Action for damages.

Definitions.
60. Definition of "design," "copyright."
61. Definition of proprietor.

PART IV.

Trade Marks.

Registration of Trade Marks.

62. Application for registration.
63. Limit of time for proceeding with application.
64. Conditions of registration of trade mark.
65. Connection of trade mark with goods.
66. Registration of a series of marks.
67. Trade marks may be registered in any colour.
68. Advertisement of application.
69. Opposition to registration.
70. Assignment and transmission of trade mark.

Sect.
71. Conflicting claims to registration.
72. Restrictions on registration.
73. Further restriction on registration.
74. Saving for power to provide for entry on register of common marks as additions to trade marks.

Effect of Registration.

75. Registration equivalent to public use.
76. Right of first proprietor to exclusive use of trade mark.
77. Restrictions on actions for infringement, and on defence to action in certain cases.

Register of Trade Marks.

78. Register of Trade Marks.
79. Removal of trade mark after fourteen years unless fee paid.

Fees.

80. Fees for Registration, &c.

Sheffield Marks.

81. Registration by Cutlers' Company of Sheffield marks.

PART V.

GENERAL.

Patent Office and Proceedings thereat.

82. Patent Office.
83. Officers and Clerks.
84. Seal of patent office.
85. Trust not to be entered in registers.
86. Refusal to grant patent, &c., in certain cases.
87. Entry of assignments and transmissions in registers.
88. Inspection of and extracts from registers.
89. Sealed copies to be received in evidence.
90. Rectification of registers by Court.
91. Power for Comptroller to correct clerical errors.
92. Alteration of registered mark.
93. Falsification of entries in registers.
94. Exercise of discretionary power by Comptroller.
95. Power of Comptroller to take directions of law officers.
96. Certificate of Comptroller to be evidence.
97. Applications and notices by post.
98. Provision as to days for leaving documents at office.
99. Declaration by infant, lunatic, &c

Sect.
100. Transmission of certified printed copies of specifications, &c.
101. Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.
102. Annual reports of Comptroller.

International and Colonial Arrangements.

103. International arrangements for protection of inventions, designs, and trade marks.
104. Provisions for colonies and India.

Offences.

105. Penalty on falsely representing articles to be patented.
106. Penalty on unauthorised assumption of Royal arms.

Scotland, Ireland, &c.

107. Saving for Courts in Scotland.
108. Summary proceedings in Scotland.
109. Proceedings for revocation of patent in Scotland.
110. Reservation of remedies in Ireland.
111. General saving for jurisdiction of Courts.
112. Isle of Man.

Repeal, Transitional Provisions, Savings.

113. Repeal and saving for past operation of repealed enactments, &c.
114. Former registers to be deemed continued.
115. Saving for existing rules.
116. Saving for prerogative.

General Definitions.

117. General definitions.

The First Schedule.—Forms of Application, &c.

The Second Schedule.—Fees on instruments for obtaining Patents and Renewal.

The Third Schedule.—Enactments repealed

[46 & 47 Vic., Chap. 57.]

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. [25th August, 1883.]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.

Preliminary.

Sect. 1.

Short title.

1. This Act may be cited as the Patents, Designs and Trade Marks Act, 1883.

Division of Act into parts.

2. This Act is divided into parts, as follows:—

Part I.—Preliminary.
Part II.—Patents.
Part III.—Designs.
Part IV.—Trade Marks.
Part V.—General.

Commencement of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December, one thousand eight hundred and eighty-three.

Note.—The Patents Rules, printed *infra* in Chapter VI., p. 241, come into operation at the same time (Rule 1).

PART II.

Patents.

Application for and Grant of Patent.

Persons entitled to apply for patent.

4. (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.

Note. Sect. 4.

Note.—*Sub-section* 1. Letters Patent for inventions might always be granted to aliens or foreigners, subjects of countries with which this country is at amity—*Chappel* v. *Purday* (14 M. & W., 318); *Beard* v. *Egerton* (3 C. B., 129). The point was once raised whether a patent could be taken out in trust for an alien enemy—*Bloxam* v. *Elsee* (1 C. & P., 558; 6 B. & C., 169); but was never decided. Probably, in modern times, if objection were made to the grant of a patent to a native of a country with which this country was at war, on that ground it would be overruled; and a patent, if granted, to such a person would be valid.

A patent cannot be granted to a corporation aggregate (such as a public company), nor to a corporation sole (such as the vicar of a living), as such—Hindmarch on Patents, p. 357.

A patent can be granted to an infant under 21 years of age.

See, further as to who may or may not be grantees of anything, Co. Lit., 2*b*; Shep. Touch., 234, 235.

A patent taken out for an invention, which has been the result of knowledge obtained in discharge of public duties as a member of an official commission appointed by Government, and communicated to the other members of the commission, is not valid—*Patterson* v. *Gas Light and Coke Company* (L. R., 3 App. Cas., 239).

A patent may now be granted to the legal representative of a deceased inventor (see section 34).

Sub-section 2. Any number of persons who have all been actually concerned in producing an invention may jointly apply for a patent. And any number of persons, one of whom is the inventor (see section 5, sub-section 2, and note thereto).

When a patent is granted to two or more persons, anyone of them may use the invention without the consent of the others, and without accounting to them, or any of them, for the profits so obtained, in the absence of any special agreement to that effect—*Mathers* v. *Green* (L. R., 1 Ch. 29); see also *Hancock* v. *Bewley* (Johns., 601), and *re* Russell (2 De G. and J., 130). The present Act makes no change in the law in this respect.

Application and specification.

5. (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 (*a*), or in the case of a joint application, one or more of the applicants (*b*), 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. Sect. 5.

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

(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 (*d*).

(5.) A specification, whether provisional or complete, must commence with the title (*e*), and in the case of a complete specification must end with a distinct statement of the invention claimed (*f*).

Note.—*Sub-section* 1. By Patents Rules 5 and 6 the forms A, or A1 in the second schedule to the rules (p. 257), are the prescribed forms which must be followed. Rule 22 regulates the recording of applications. Refer to rules 8, 9, and 10 for details of application. It will be seen that the petition or document required up to this Act coming into operation, following the terms of the declaration, and praying for the grant of a patent to the applicant, is dispensed with. All that is required is to send the declaration in form **A**, schedule 1, stamped with £1, together with a provisional or complete specification to the Patent Office. The declaration is now, in effect the *application*.

Sub-section 2. See section 34, providing that where a person dies possessed of an invention without having applied for a patent therefor, the patent may be granted to his legal representative on application made within six months from his decease.

(*a*.) This sub-section raises the important question as to whether *patents of communication* have been abolished or not by the Act. Patents of communication were so called when the patents were obtained by persons being in this country, in their own names, for inventions communicated to them by persons residing abroad. Such patents used to be obtained on the applicant making a declaration that he was in possession of such an invention which had been communicated to him from abroad by such a person (naming him), residing at such a place

Note. Sect. 5.

(naming it) abroad. They were perfectly valid even if obtained without the authority or knowledge of the foreign inventor if not obtained in fraud of him—in which case he was protected by section 10 of the Act of 1852—since, from a very early period in the history of patents, the first introducer of an invention into this country was always held to be the first inventor thereof within these realms—*Edgeberry* v. *Stephens*—(2 Salkeld, 447); *Carpenter* v. *Smith* (9 M. and W., 300; 1 Webs. Pat. Ca., 7, 535, per Lord Abinger). This system of patents of communication was found very convenient, and has been largely used in taking out patents in this country for foreigners. When a foreigner desired an English patent, he would direct an agent to apply for it, and the agent would apply in his own name, at the same time handing his foreign employer a document acknowledging that he applied for the patent only as agent for the foreign inventor, and would hold it as trustee for him, and undertaking to assign the patent when granted as and when the foreign employer should direct.

The sub-section requires that, on the application for a patent, the declaration must state that the applicant, or one or more of the applicants, claims *to be the true and first inventor or inventors* of the invention. No patent can, therefore, be obtained without the signed declaration of the applicant to this effect, and the patent will be granted to the person or persons signing the declaration. It is a principle of patent law, that a patent which has been obtained upon an untrue representation is invalid upon that ground. And if a person to whom the invention has been communicated cannot truthfully claim to be the true and first inventor, it would seem that a patent obtained by a declaration to the effect required by sub-section 2, when, in fact, it had been communicated to the inventor from abroad, would be invalid, as having been granted upon an untrue representation.

The question was discussed in the year 1856, in the case of *Stedman* v. *Marsh* (2 Jur., N. S., 391), when Lord Hatherley, then Vice-Chancellor Wood, observed:—"I apprehend that "any person not being in a confidential position towards the "first inventor receiving from a person abroad an invention, "is entitled, perhaps, not in a strictly moral view, but at all "events according to law, to take out a patent on his own "account for the invention so communicated." The same learned judge had before him the case of *Milligan* v. *Marsh* (2 Jur., N. S., 1083) in the same year, arising out of the same litigation, in which the facts were as follows:—Thomas Milligan, the plaintiff, a British subject residing at Lima, in Peru, having conceived an improvement in making pianos, gave to

the son of his London agent, who was then on a visit at his house, a full description and drawings of the invention, marked "private," and requested the son, on his return to London, to take out a patent for him, Thomas Milligan. The son returned to London and delivered the drawings to his father, Thomas Milligan's agent. Thomas Milligan, about the same time, wrote a letter to Marsh, the defendant, his agent, not marked "pri- " vate," inquiring generally after the invention, and whether a patent for it was being taken out. Shortly afterwards Marsh took out a patent for the improvement in question *in his own name, as for an invention of his own.* Afterwards Thomas Milligan employed another person, Stedman, to make such pianos, on his account. Marsh brought an action for infringement against Stedman. Thereupon Thomas Milligan filed a bill to restrain the action and the use of the patent by Marsh. Marsh insisted that the invention described in Thomas Milligan's communication would not work. The learned judge, in deciding that the motion must stand over to await the result of the action, made the following observations :— Note. Sect. 5. —

"The plaintiff will have a full opportunity of defending "that action; and if the defendant succeeds in the action on "the ground that that communication was not the foundation "of the patent here, or not the foundation to such an extent as "to prevent him from being the true inventor of the patent "taken out in his own name (for I have observed, that though "the plaintiff's communication was useless in itself and inca- "pable of application, and although confidential, yet the "defendant might use it for his benefit in this way: it might "set him thinking, and lead to the discovery by him of a "practical way of carrying out the idea which he might law- "fully patent for his own benefit); in either of such cases the "plaintiff's case would be at an end. There could be no "trusteeship of that which the plaintiff says he invented, for it "would turn out in such a case that he had invented nothing. ". . . . The case made is that this was an invention of the "plaintiff's communicated to the defendant. In such a case the "*Letters Patent being taken out by the defendant, as for an* "*original invention, are void ab initio.*"

In a case of *Renard* v. *Levinstein* (10 L. T., N. S., 177), before Lord Justice Knight Bruce, in 1864, that learned judge made the following observations :—"One objection has been raised to "the patent, 'that the invention being stated to be partly "'original and partly communicated from a foreign country, it "'is not distinguished, either in the Letters Patent, or in the "'specification or otherwise—not distinguished, not defined, not "'explained what is the nature nor what are the particulars

Note. Sect. 5. —

" ' of the communication from abroad made by the gentleman " ' mentioned, M. Georges de Laire, of the Mint of Paris.' Now " considering the different consequences that may arise as to " the part of an invention communicated from a foreign " country, and as to the part of the same invention, or set of " inventions, which may be deemed to be in every respect new, " I consider it to be a very serious and arguable question " whether it is or is not incumbent upon the patentee to dis- " tinguish, to define, and to particularise what is new and what " is old, which here is not done. . . . . As far as I am con- " cerned the point is full of doubt and difficulty."

From these dicta (for they do not amount to decisions) of the two learned judges, it would appear that their opinion was that if a patent had been obtained on a representation that the applicant was the inventor when he was only the communicant of an invention, that the patent would be void. It would, therefore, follow that patents of communication have been abolished.

On the other hand, there are strong grounds in support of the contrary view. As already pointed out, it was long ago decided (*Edgeberry* v. *Stephens* and the other cases *supra*) that the first introducer of an invention into this country was the first inventor within this realm, within the meaning of the 6th section of the Statute of Monopolies; and by section 46 (p. 176) of this Act, the word "invention" is defined to mean " any manner of new manufacture the subject of Letters " Patent, and grants of privilege within section 6 of the Statute " of Monopolies," which, as we have already seen, has been held to include an invention introduced for the first time into this country. Suppose, therefore, an applicant for a patent for an invention which has been communicated to him from abroad, declares, as required by sub-section 2 above, that he is in possession of an invention of which he claims to be the true and first inventor, and obtains a patent therefor, will that patent be held invalid on the ground that it was granted on an untrue representation of the applicant that he was the true and first inventor, when, according to *Edgeberry* v. *Stephens*, he was so? The opinions of the judges in the case of *Mulligan* v. *Marsh* (2 Jur., N. S., 1083), and *Renard* v. *Levinstein* (10 L. T., N. S., 177), above cited, tend to show that a patent so obtained would be held to be invalid; but if those cases are carefully examined it will be seen that those opinions are merely dicta, not amounting to decisions. The Patents Rules deal with this question, but only indirectly. By rule 6 (1) an application for patent is to be made either in the forms A or A1 given in the second schedule thereto. Form A1 (p. 258) is the form of application when the invention has been communicated from abroad,

giving the name of the communicator, and goes on to say that the applicant claims to be the true and first inventor thereof, and rule 27 provides that it be adopted in the case of a communication from abroad. It is understood that the form has been settled with a great deal of care. The meaning, of course, is, that the applicant claims to be the inventor within the doctrine of *Edgeberry* v. *Stephens*, &c. But the question remains, can the applicant truthfully claim to be the true and first inventor—not the true and first inventor within these realms, for that will not satisfy the sub-section—when in fact he is not?

Note. Sect. 5.

The question must, therefore, be regarded as one of doubt until set at rest by judicial decision, and what that decision may be it is impossible to anticipate. It will depend upon which of the two conflicting set of reasons above indicated prevails. It is, of course, to be regretted that so important and practical a point should have been left in doubt. Attention was called to it during the passage of the Act through Parliament, but no alteration was made (see the report of a discussion upon the Bill by the Society of Arts, in the Journal of that Society of the 20th April, 1883), from which it will be seen that the opinion that patents of communication were not abolished, was the one which found most favour in the Society,

(*b.*) Another point in the above sub-section which requires particular notice, is that in the case of a joint application for a patent by two or more persons, it is only necessary for one at least of the applicants to declare that he claims to be the true and first inventor. Whether this effect was intended or not, it is the clear grammatical construction of the phrase, viz., "An "application must contain a declaration to the effect . . . . "in the case of a joint application that *one or more* of the appli- "cants *claims or claim* to be the true and first inventor or "inventors" of an invention of which the joint applicants are in possession. The effect of this clause will be very important, for it will enable persons who have had no share in making an invention to obtain equal patent rights with a person or persons who have actually made it, by making an application jointly with him or them; and since one of the joint parties of a patent can use it without the permission and without accounting to the others, as pointed out in the note to section 4 sub-section 2, the consequence may be that a person who has had no merit in making the invention may derive the greater part, or possibly the whole of the advantages derived from the patent. This effect will be very convenient where one member of a firm has made the invention, and it is desired that the patent should be granted to the whole firm; but the draftsman of

Note. Sect. 5. —

the clause had probably not the doctrine of *Mathers* v. *Green* (L. R., 1 Ch. 29) in his recollection when he inserted the words, "In the case of a joint application, one or more of the "applicants." The point will probably be litigated whether such an effect of the section was intended; and although the grammatical construction is clear, it may be well to exercise a little caution in advising until it has been decided.

The prescribed form A (p. 257) can easily be adopted to such a case.

(*c.*) *Sub-sections* 3 *and* 4. Refer to Chapter I., section 5, 2nd., p. 33, as to the principles which should regulate the drafting and preparation of the provisional specification. Form B (p. 258) is prescribed Pat. Rules 6 (2).

(*d.*) *Sub-section* 4. Refer *ibid* p. 44, as to the preparation of the complete specification. Form C (p. 259) is prescribed Rule 6 (2). Refer to Rule 31 (p. 246), which requires a concise explanatory statement of the features of novelty to accompany the complete specification. *Drawings.* Refer to Chapter I., pp. 62, 63. The Pat. Rules 28, 29, and 30 (p. 245) regulate the sizes of, and the method of preparing, the drawings. Rule 31 (p. 246) requires an additional drawing of small size illustrating the feature of novelty to be left with the complete specification for the purpose of the illustrated journal required to be published by section 40 (p. 171).

(*e.*) *The Title.* Although the duty is thus cast upon the Patent Office of examining whether the title sufficiently indicates the subject matter of the invention, yet the fact of the title having satisfied the office will not preclude the objection being taken in any proceedings for the infringement of the patent that the title is misleading, or inaccurate, and therefore void upon that account (see also Chapter I., section 5, p. 29, as to title).

(*f.*) *Sub-section* 5. Refer *ibid* p. 63, as to the drafting of preparation of the distinct statement of the invention or claims or claim. The provision requires that complete specifications shall end with a distinct statement of the invention claimed as new.

In the first draft of the Bill, which has resulted in this Act, it was proposed to render a claim or claims obligatory in the provisional specification; but this was abandoned, principally upon the representations of the inconvenience and difficulty which would be occasioned by such a provision, made by the Institute of Patent Agents to the President of the Board of Trade.

Hitherto, while not obligatory, it has been the custom, in most well drafted complete specifications, to end them by a

claim or claims, in which the distinctive features of the invention were summarised; and the inventor pointed out what he considered himself to have invented, and therefore "claimed."

Note. Sect. 5.

The provision requiring that the complete specification shall end "with a distinct statement of the invention claimed," therefore only renders that obligatory which was the prevailing practice before. The intention is to render the examination of specifications more easy and certain. The practical effect of this new provision will be to render the claims of greater importance than ever, and even more care than before will be necessary to be used in drafting them.

By section 33, *infra*, more than one claim is permitted in a specification.

6. The Comptroller shall refer every application to an examiner (*a*), 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 (*b*).

Reference of application to examiner.

Note.—(*a.*) This provision is new. In the first draft of the Bill it was proposed that the examiner should report also whether "The invention was subject matter for a patent;" but this was abandoned on the representations of the Institute of Patent Agents, as to the inexpedience of such an officer as an examiner, deciding upon a question of such difficulty as what was the subject matter for a patent, and the inconvenience likely to be occasioned by such an examination.

A similar examination, to the one now provided for, was, previously to the Act, made by the Patent Clerks of the Attorney and Solicitor-Generals.

See also section 33 *infra* (p. 166), requiring that a patent shall be granted for one invention only.

As to the appointment, duties, and powers of the Comptroller and examiners (see Part V., sections 82, 83, 85, 91, 94, and 95).

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 require that the application,

Power for Comptroller to refuse application or require amendment.

Sect. 7. specification, or drawings be amended before he proceeds with the application (*a*).

(2.) Where the Comptroller requires an amendment, the applicant may appeal from his decision to the law officer (*b*).

(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 an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification, bearing the same or a similar title, it shall be the duty of the examiner to report to the Comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the Comptroller shall give notice to the applicants that he has so reported (*c*).

(6.) Where the examiner reports in the affirmative, the Comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant (*d*).

Note.—Rules 11, 12, 13, 14, and 15, *infra* (p. 242), must be read with this section; also rule 18.

(*a.*) *Sub-section* 1. A similar power to that here conferred on the Comptroller, used, under the old practice, to be exercised by the Attorney and Solicitor-Generals. It is to be anticipated that the Comptroller and his examiners will be much more severe than it has been the custom of the law officers hitherto to be.

Section 33 (p. 166) enacts that a patent shall be granted for one invention only. It will be the examiner's duty to carry out this enactment. Refer to Pat. Rules 11 and 14 (p. 242) as to the notice required to be given by the Comptroller.

(*b.*) *Sub-section* 2. Under the old practice there was practically no appeal from the decision of the Attorney or Solicitor-General upon these points.

By the Definition Clause 117, "Law Officer" means Her Majesty's Attorney-General, or Solicitor-General for England. As to the method of appealing, see the rules regulating appeals to the law officers (p. 253). The form of appeal is T (p. 265).

Sub-section 3. No provision being made for any mode of

questioning the law officer's decision, his determination as to amendments, and as to conditions upon which the application shall be accepted, will be final.

Note. Sect. 7.

(c.) *Sub-section* 5. This provision is new. It will be well, however, for inventors not to rely exclusively upon the examiner and Comptroller, but to watch either themselves, or by their agents, the lists of patents newly applied for, in order to oppose if necessary. See Pat. Rules 15 and 16, p. 243. See also section 13, and note thereon, *infra* p. 133.

(d.) *Sub-section* 6. This provision is new. It appears to cast upon the Comptroller the duty of forming an opinion as to whether the two applications conflict, and to refuse a patent to the second applicant if he should think that they do, and this, whether the first applicant takes any steps upon the notice provided for in sub-section 5 or not. For the method of appeal to law officers, see the rules of those officers (p. 253), made under section 38, *infra* p. 169.

Time for leaving complete specification.

8. (1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time (*a*) *within nine months from the date* of application (*b*).

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned (*c*).

Note.—(*a.*) *Sub-section* 1. *i.e.*, the applicant may leave a complete specification immediately after receiving notice from the Comptroller, pursuant to section 7, sub-section 4, that his application has been accepted; or he may not do so until nine calendar months from the date of his application. Refer also to Pat. Rule 37 (p. 247.)

(*b.*) "*Within nine months from the date.*" "Month" means calendar month (13 & 14 Vic., c. 21, section 4). "In computing "a month, the day of the month corresponding with that from "which the computation began is excluded, so that two days "of the same number are not comprised within it"—*Freeman* v. *Read* (4 B. & S., 174; 32 L. J., M. C., 226). "The rule is to "exclude the first and include the last day"—*Young* v. *Higgon* (6 M. & W., 48; Maxwell on the Interpretation of Statutes, p. 310).

(*c.*) *Sub-section* 2. Since no publication of the provisional specification will take place until after such abandonment, and no patent will be granted for the invention described in the abandoned provisional specification, it is apprehended that the decision in the case of *Oxley* v. *Holden* (8 C. B., N. S., 666),

Note. Sect. 8.

under the Act of 1852, "that if a patentee files a provisional "specification which he abandons, and afterwards files another "provisional specification before the time for provisional pro- "tection has expired, the abandonment itself will not be a "publication, although it may be a ground of objection to the "grant of a patent subsequently for the same invention, yet, "if the patent is granted, it is not void," still applies. Therefore, if a patent be granted in a subsequent application for the same invention within the nine months mentioned in this subsection, it would not be invalid upon that ground. "*The "application shall be deemed to be abandoned*"—*i.e.*, *that application.*

Comparison of provisional and complete specification.

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.

(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, other than an appeal to the law officer under this Act, 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.

Note.—These provisions are all new. **Note. Sect. 9.**

Important questions will probably arise under the clause in sub-section 1 requiring the examiner to report "whether the "invention particularly described in the complete specification "is *substantially* the same as that which is described in the "provisional specification." Inventions under the old practice (under 1852 Act) have sometimes developed or altered considerably during the period of six months, and a longer period by three months is now allowed. It is obvious, also, that the term "substantially" is an elastic one. Much will, therefore, depend upon the administration by the Comptroller of this clause. The Comptroller (see Pat. Rules, 11, *et seq.* p. 242) is required to hear the applicant for patent, or his agent, upon the question before finally deciding. The method of appealing to the law officer is regulated by the rules for the purposes (p. 253). The law officer, by the terms of sub-section 3, is bound to hear both the applicant (either by himself, or his agent, or counsel) and the Comptroller upon the question.

The decision of the law officer is, by the terms of sub-section 3, final as against the applicant and the Comptroller; but there is nothing in this or any other section in the Act to prevent the same objection (*i.e.*, that the complete specification covers much more than the provisional) being raised against the validity of a patent in any proceedings taken against an infringer, as was done under the old practice almost invariably. Bearing in mind what a pitfall to inventors this has proved, a very notable instance of which lately is the decision of Mr. Justice Fry upon Edison's Patent for Telephones, in the case of *United Telephone Company* v. *Harrison, Cox-Walker & Co.* (L. R. 21, Ch. D., p. 721), that that patent was void on the ground that the nature of part of the invention, described in and claimed by the complete specification, had not been sufficiently described in the provisional specification, it appears to be a regretable omission in the present Act that, since it has provided for such an examination, it was not also provided, that no objection to the validity of a patent on the ground of variance between the provisional and complete specification should be taken in any proceedings against alleged infringers thereof.

The only remark which arises upon sub-section 5 is, that at present, it is difficult to see how the "production or inspection" of the reports of examiners in legal proceedings will ever be "desirable" in the interests of justice.

10. On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the **Advertisement on accep-**

Sect. 10. — tance of complete specification.

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

Note.—The advertisement mentioned in this section is the first notification to the public that a patent has been applied for provided for in this Act. The Illustrated Journal of Patented Invention, provided for in section 40, *infra* p. 171, is for the publication of inventions after they have been completely patented. But by Pat. Rule 25 the advertisement is to be in the Official Journal of the Patent Office. Pat. Rule 26 (p. 245) provides for the public inspection; the search or inspection fee is one shilling, No. 32 in the first schedule to the Pat. Rules (p. 256).

The provision that the specification shall be open to public inspection before the grant of patent is new. It is of the greatest importance, because it will enable oppositions to be conducted with "open documents," as it has been called. The policy of this alteration of the law has been very much questioned (see discussion of Society of Arts, reported in their Journal of the 20th April, 1883), and it is obvious it will give the opponent to the granting of a patent a great advantage of which it may be feared improper use will be taken. He may oppose on the ground that he, and not the applicant, is the true inventor of the invention for which the patent he opposes is applied for. Under the now abolished system the provisional specification was kept secret, and if the opponent could not describe the invention disclosed therein, it was obvious at once that he could not be the inventor. Under the new system he need not oppose until he has seen and studied the applicant's complete specification for a period of two months. If he be fraudulently inclined, the opponent has thus every opportunity for the exercise of such inclination. If he alleges he made the invention it will be difficult to disprove, because it is impossible to look into the condition of his mind. No doubt the Comptroller in deciding cases of opposition, and the law officers in deciding those brought before them on appeal, will bear these considerations strongly in mind.

After the acceptance of the complete specification the patentee cannot abandon his application and apply again in respect of the same invention, because it will have been published, *i.e.*, open to public inspection—See note (*c*) to section 8, *supra*.

Opposition to grant of patent.

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 of an examiner having reported to the Comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application, but on no other ground. Sect. 11.

(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 applicant 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.

Note.—Pat. Rules 32 to 41 (p. 246) regulate to practice oppositions to grants of patents.

Sub-section 1.—Compare section 12 of the repealed Act of 1852. Under that section any grounds of opposition might be taken. Here the grounds of opposition are limited to the three above specified. The section does not specifically say that the notice must be in writing, as in the repealed section, but by analogy to similar provisions in other Acts (*e.g.*, The Employers Liability Act, 1880, section 7; see *Moyle* v. *Jenkins* (8 Q. B. D., 116), there can be no doubt a written notice will be held necessary. Pat. Rule 32 requires it to be signed.

Sub-section 2.—Under this sub-section it will be advisable for the applicant, on receiving notice from the Comptroller of opposition having been entered to his application for patent, to apply to that officer for an appointment to hear him upon the matter; and it will be necessary to follow the directions in Pat. Rule 36. If, however, the applicant does not move in the

Note. Sect. 11.

matter, it will, nevertheless, be the Comptroller's duty to consider and decide the question.

It will be the duty of the person dissatisfied with the decision of the Comptroller to appeal to the law officer. This he should do as provided by the rules made by the law officers (p. 253). The form of notice is Form T (p. 265).

By section 117, "Law Officer" means the Attorney-General or Solicitor-General for England.

The Act contains no provisi on as to how these officers are to regulate the performance of the duties cast upon them by this Act between them; neither is there any provision as to their remuneration. Compare section 107 of repealed Act of 1852. But, by section 38, *infra*, power is given to the law officers to make rules of procedure and to order costs to be paid by either party, and some rules have been made (p. 253). No. 11 of such rules empower the law officer to fix the amount of such costs.

Sub-section 3.—By the terms of the sub-section, the law officer can decide without hearing the parties, but he is required to hear either or both of them if they desire it. It will, therefore, be necessary for the party if he desires to be heard to indicate his desire to the law officer.

The decision of the law officer will be final upon the point whether the patent shall be sealed to the applicant or not. There is nothing in the Act to prevent the same points which have been urged in opposition to the grant of a patent being raised as objection to the validity of the patent when granted on proceedings being taken for an infringement thereof.

The power of opposing the grant of a patent at two opportunities, at the notice to proceed, and the application for seal under the repealed Act of 1852 (see sections 14 and 15), is abolished.

Sub-section 4.—Compare section 22 of repealed Act of 1852. This provision was practically a dead letter under that Act. It does not appear by whom the remuneration to the expert shall be paid, but the law officer apparently has power to order either party to pay it as part of the costs (see section 38, *infra*).

Sealing of patent.

12. (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 (*a*) 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. Sect. 12.

(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 (*b*).

Note.—(*a.*) For the form of patent see Schedule D to the Act, p. 235.

Sub-section 3.—(*b.*) This provision is adopted from section 21 of the repealed Act of 1852. The practice under that section was to petition the Lord Chancellor, and the production of Probate or Letters of Administration was required. It is presumed, under this Act, application must be made to the Comptroller, supported by an affidavit setting out the facts, and that the production of Probate or Letters of Administration will still be required. Pat. Rule 24 requires this to be done in the case of an application for a patent by the legal representative of a person who has died possessed of an invention under section 31.

13. Every patent shall be dated and sealed as of the day of the application (*a*) : Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification (*b*) : Provided also, that in 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 (*c*). Date of patent.

Note.—(*a.*) Compare sections 23 and 24 of the Act of 1852.

(*b.*) Compare section 24 of same.

These two clauses introduce no change into the law, with the exception that the time during the life of a patent, in which

Note. Sect. 13.

no proceedings could be taken for an infringement, was, under the old law, only six months, while it may now be fifteen months, or, in cases of opposition to the grant of patent, even longer.

(*c.*) This clause is inserted to obviate the effect of the decision of Lord Hatherley, C., in *ex parte Bates* v. *Redgate* (L. R. 4 Ch. 577; 38 L. J., Ch. 501; 17 W. R., 900; 21 L. T., N. S., 410), upon the practice under the repealed Act of 1852, that the existence of a prior provisional specification was not a ground, in the absence of fraud, on which the Attorney-General ought to refuse to allow a second provisional protection to be granted; and in the event of the later applicant for provisional protection being the first to obtain a grant of patent, his patent was a bar to the grant of a patent for the same invention to the earlier applicant for patent.

This decision, the doctrine of which is now abolished by the above clause, introduced a practice among applicants for patents of "racing for the seal," as it was called, by which later applicants endeavoured to get a patent sealed to them before earlier applicants, and so secured the patent to the exclusion of the latter. The clause was not contained in the first draft of the Bill, and was introduced into the Act principally in consequence of the representations of the Institute of Patent Agents (see the reported transactions of that body).

Provisional Protection.

Provisional protection.

14. Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is, in this Act, referred to as provisional protection.

Note.—Compare section 8 of the repealed Act of 1852.

This provision introduces no change into the law, except the time between the application for patent and the date of sealing may now be so much as fifteen months (see section 9, sub-section 4, *supra*) or more, in the case of an opposed patent; while, under the Act of 1852, it could never be, except in the case of opposed patents, more than five and a half months. And the period between application and acceptance may be so much as twelve months (see section 9, sub-section 4, *supra*); while, under the repealed Act of 1852, the time between the application and the issue of certificate of provisional protection

by the law officer (section 8 of Act of 1852) was rarely so much as one month.

Note. Sect. 14.

Having regard to the much greater length of time allowed for passing a patent through the office under the new procedure, and that the life of the patent (fourteen years) remains the ame, it will most likely be found to the interest of inventors not to avail themselves of the full time allowed by the Act, but to file their complete specifications as shortly as convenient after the acceptance by the Comptroller, of their applications.

Protection by Complete Specification.

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.

Effect of acceptance of complete specification.

Note.—Compare section 9 of the repealed Act of 1852.

Under the Act of 1852, by filing a complete specification with his application for patent, the inventor obtained full patent rights. Under this section he does not, until his complete specification has been accepted by the Comptroller. Under the Act of 1852, also, the inventor might, in the case of his depositing a complete specification with his application, institute proceedings for infringement for the period between the date of application and date of sealing: under this clause not. This latter proviso was not in the first draft of the Bill.

Patent.

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

Extent of patent.

Note.—Compare section 18 of repealed Act of 1852.

The Channel Islands are omitted from this section, and in the form of patent given in the First Schedule, *infra* p. 235, form D. Therefore, patents under this Act will confer no privileges on the Channel Islands, as, under the old law, they did.

In the first draft of the Bill, and in the second draft of the Bill as amended by the Standing Committee on Trade, &c., of

Note. Sect. 16. the House of Commons, patents were made to extend to the Channel Islands. If protection be desired in the Channel Islands, application must be made to the proper authorities for a patent therefor, as in the case of the colonies and other dependencies of Great Britain.

Term of patent.

17. (1.) The term limited in every patent for the duration thereof shall be fourteen years from its date (*a*).

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times (*b*).

(3.) If, nevertheless, in any case, by accident, mistake or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the Comptroller for an enlargement of the time for making that payment (*c*).

(4.) Thereupon the Comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:—

(*a.*) The time for making any payment shall not in any case be enlarged for more than three months;

(*b.*) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

Note—(*a*). In spite of the strongest representations, to the effect of the desirability of extending the time of a patent, it remains the same as ever (fourteen years). It will have been noticed that the new Act, by lengthening the time taken to obtain the sealing of patent after the grant, practically lessens, by a not inconsiderable period, the life of a patent.

Sub-section 2.—(*b*). See for the prescribed payments and times the first schedule of the Patents Rules, *infra* p. 255.

The Pat. Rules as to "Certificates of Payment or Renewal"

(p. 247), make an important change in the law to which attention must be paid. Before the coming into operation of the Act the patent itself had to be stamped with an Inland Revenue stamp of the proper amount at Somerset House and left at the Patent Office on or before the last day for so doing; but no notice whatever to the Patent Office was required. Under the new rules (rule 42) the patentee must, *seven* days before the last day for paying the duties or extension fees, give notice to the Comptroller of Patents of his intention to do so. He is no longer required to stamp the patent itself, but a form of certificate of renewal to be obtained, it is presumed, from the Patent Office. **Note. Sect. 17.**

The changes in the fees payable, are—

Under Act of 1853 (16 Vic., c. 5).	£	Under this Act.	£
On application	5	On application	1
On notice to proceed ...	5	On complete specification ..	3
On application for seal ...	10		—
On complete specification ..	5		£4
	—	On filing complete specification with application ...	£4
	£25		—

Act of 1853, section 2.	£	This Act.	£
At expiration of 3rd year	50	At expiration of 4th year	50
At expiration of 7th year	100	At expiration of 8th year, if patent granted in 1884 and after ...	100
		If patent granted before 1884, at end of 7th year	100

Or as regards all patents in force on the coming into operation of this Act, or granted thereafter, the annual payments set out in the schedule.

(*c.*) This is an important and welcome amelioration in the law. Under the now superseded practice, if the last day for payment was allowed to slip, the patent lapsed to the public, and there existed no power short of a special Act of Parliament to enable the payment to be received, and the patent renewed. In one instance, at least, such an Act of Parliament was obtained for the purpose—Gardiner's Patent for Railroad Car Springs, dated 1st December, 1863. The Act

Note. Sect. 17.

of Parliament, then specially passed, received the Royal Assent 29th May, 1868 (31 & 32 Vic.).

The practice of obtaining enlargement of time, under the circumstances mentioned in the section, is provided for in Pats. Rules 46 and 47 (p. 248). The fees payable for such enlargement of time are—one month £3, two months £7, and three months £10—Nos. 26, 27, 28, in first Schedule to Pat. Rules (p. 255). The application must be in writing. By analogy to previous practice the Comptroller will probably require proof by affidavits. It should be noticed that the power of the Comptroller is strictly limited to cases of accident, mistake, or inadvertence, and does not include *neglect*.

Amendment of Specification.

Amendment of specification.

18. (1.) An applicant or a patentee (*a*) 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 (*b*), 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 (*c*), 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 (*d*) the case, subject to an appeal to the law officer (*e*).

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice (*f*), 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 (*g*), 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 (*h*), 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 (*i*).

(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 (*j*). Sect. 18.

(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 (*k*).

(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 (*l*).

(10.) The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending (*m*).

Note.—This section introduces no practical change in the law.

Compare section 1 of Act of 1835 (5 & 6 Will. IV., c. 83). } Repealed by Act of 1883.
" " 5 " 1844 (7 & 8 Vic., c. 69). } Repealed by Act of 1883.
" " 39 " 1852 (15 & 16 Vic., c. 83). } Repealed by Act of 1883.

The rules for working out this section are Pat. Rules 48 to 56 (p. 248). For fees on Disclaimer, &c., see first Schedule to Pat. Rules (p. 255).

(*a.*) "An applicant or patentee." The meaning of "applicant," is the person to whom the patent was granted; the meaning of "patentee" is the person or persons to whom the patent may have been assigned by the "applicant." This is clear on a reference to section 5 of the Act of 1844, which was specially passed to enable the assignee or assignees, from the original patentee of a patent, to file a disclaimer and memorandum of alteration. The Act of 1883 does not profess to change the previously existing law in this respect, but only to codify it (see Memorandum indorsed upon the Bill at the introduction, repeated at Chapter IV. *supra* p. 103). In Act of 1844, where the original patentee had only partially assigned his patent, he was required to join in the application for disclaimer or memorandum of alteration. This will be still necessary under the present Act, when leave is sought to amend the specification.

(*b.*) "*By way of disclaimer, correction, or explanation.*" The words of the now repealed section 1 of the Act of 1835

Note. Sect. 18. —

were "a disclaimer of any part of either the title of the inven- "tion or of the specification," or "a memorandum of any altera- "tion in the said title or specification, not being such disclaimer "or alteration as shall extend the exclusive right granted" by the patent. The power to amend by way of "*explanation*" conferred by this section is therefore new. Although the words are "by way of disclaimer, correction, *or* explanation," yet it is apprehended the pronoun "or" will not be construed disjunctively, but that leave will be given when necessary to disclaim, and correct, and amend. In the repealed section 1 of the Act of 1835, the words were disclaimer *or* memorandum of alteration, and the practice of the law officer was to permit a disclaimer *and* memorandum of alteration, to be filed in one document, upon the same application, and in no case has the propriety of that practice ever been challenged.

(*c.*) The manner prescribed by Pat. Rule 48 (p. 248). Directions as to advertisement must be applied for at the Patent Office. The law officers, under the old practice, required advertisements, stating that leave had been requested to file a disclaimer and memorandum of alteration to the patent in question, and that any person desiring to oppose such leave being granted should, before a certain date, give notice to the law officer of his intention to do so, to be inserted in two London papers, and in the district where the invention was worked. The nature of such proposed amendment, however, was not required to be advertised, so that in this respect a change in the practice has to be attended to.

(*d.*) The Comptroller must, therefore, judicially hear the parties upon an opposition to an amendment. The parties, no doubt, will be entitled to be heard by their agents or counsel.

(*e.*) *Appeal to law officer.* For procedure as to, see the law officers' rules (p. 253). See No. 11 of those rules as to costs.

(*f.*) *i.e.*, by themselves or by their agents or counsel.

(*g.*) Note that, while no power is conferred upon the Comptroller in a case of opposition to impose conditions, the law officer has such power. The law officer having, under section 1 of the repealed Act of 1835, a discretion as to granting or withholding leave to file disclaimer, &c., used to occasionally to impose terms upon patentees as conditions upon which they gave their leave. An instance of this occurred in the Medlock's Patent, the facts of which are reported in an article in Newton's London Journal, Vol. 22, N. S., p. 69, and at Nos. 598 and 604 of Higgin's Digest of Patent Cases. Such exercise of discretion was, in that case, endeavoured to be questioned; but without success (see No. 604, Higgin's Digest). The decision of the law officer will be final.

A patentee disclaiming after he has obtained an injunction against an infringement cannot enforce the injunction after disclaimer—*Dudgeon* v. *Thomson* (L. R., 3 App. Cas., 34). **Note. Sect. 18.**

(*h.*) In an unopposed case the Comptroller has power to impose conditions.

(*i.*) If, therefore, the Comptroller in an unopposed case imposes conditions which the patentee is unwilling to accept, he may appeal to the law officer, because, in effect, his application is refused.

(*j.*) In such an appeal to the law officer, the law officer's rules as to procedure, &c. (p. 253), must be followed. The decision of the law officer will be final.

(*k.*) This is a re-enactment of the previously existing law (section 1 of the Act of 1835) prohibiting the disclaimer or alteration from extending the rights granted by the patent.

(*l.*) This is also a re-enactment of the previously existing law (section 39 of Act of 1852).

(*m.*) This sub-section must read together with sections 19 and 20 *infra*. The previously existing provision contained in section 39 of the 1852 Act, was, that no action should be brought upon any patent in respect of which a disclaimer had been filed for any infringement committed prior to the filing of any disclaimer, unless the law officer should certify such action might be brought, notwithstanding the filing of the disclaimer.

19. (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. **Power to disclaim part of invention during action, &c.**

Note.—This section appears contradictory to sub-section 10 of section 18; if so, however, it overrides it. The utility and importance of the enactment are obvious. It was made a point of by the introducers of the Bill into Parliament. In the Memorandum upon the Bill when introduced into the House of Commons, which is printed in extenso in this volume, at p. 103, it is stated: "In an action for infringement, a patentee "will be able, by leave of the Court, to disclaim and give his "disclaimer in evidence, but not in such a case to obtain "damages without leave of the court."

This, and the following section 20, are important additions to

Note. Sect. 19.

the power of the Court to do complete justice between the parties. They should, however, be not too much relied upon to excuse any carelessness or negligence in the preparation of a specification or in bringing an action, as the Courts will, of course, exercise the large discretion conferred upon them in a very careful manner, and take care that a defendant is not prejudiced by their doing so. As much caution and care is therefore necessary now, as before the enactment of these provisions, to carefully examine into the validity of a patent before commencing proceedings against infringers. It will be as much more advisable now as before the Act, to amend the specification before the commencement of an action, than during its progress.

Restriction on recovery of damages.

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.

Note.—See note to section 19, and note (*m*) to section 18. "That his original claim was framed in good faith and "with reasonable skill and knowledge." This appears to be a well meant, but unworkable proviso. And it will puzzle the Courts not a little, to know why a man should be mulcted in damages for infringing (*l*) a patent, which he has been rightly advised is invalid owing to defects in the specification, because the patentee did not make the mistake in bad faith, and he or his advisers were not more than usually stupid in drafting it. And how are the Courts to decide what is reasonable skill and knowledge in framing a claim or drafting a specification? Except as providing ingenious counsel with matter for argument, the proviso appears likely to become a dead letter.

Advertisement of amendment.

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

Note.—In the Official Journal of the Patent Office, and as the Comptroller may direct—Pat. Rule 56 (p. 249).

Compulsory Licenses.

Power for Board to order

22. If on the petition of any person interested (*a*) it is proved to the Board of Trade (*b*) that by reason of

the default of a patentee to grant licenses on reasonable terms (*c*)— Sect. 22. grant of licenses.

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

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

(*c.*) Any person is prevented from working or using to the best advantage (*e*) an invention of which he is possessed (*f*),

the Board may order the patentee to grant licenses 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 (*g*).

Note.—These provisions are quite new and mark a considerable change in the law. They are of the barest possible character, and afford no indication of the manner in which they are to be worked—The Pat. Rules Nos. 57 to 63 (p. 249) prescribe the procedure as to compulsory licenses.

(*a.*) It will be for the Board of Trade to decide who is a "person interested." No definition is given.

(*b.*) "Board of Trade." Pat. Rule 59 provides for a reference to the Comptroller, or to some other person or persons to be appointed by the Board.

(*c.*) What are "*reasonable terms*"? That is again left to the absolute discretion of the Board of Trade.

(*d.*) What are the "*Reasonable requirements of the public*"? That is left entirely to the discretion of the Board of Trade.

(*e.*) "*Best advantage*," the same.

(*f.*) This proviso is introduced for the purpose of preventing what it has been stated has sometimes occurred:—Where a patentee cannot work his invention by reason of its involving the use of another patented invention, and where the owner of the latter will not grant his license to use it at all, or only on exorbitant or prohibitive terms.

(*g.*) The duty cast upon the Board of Trade by this section is a judicial one, and must, in consequence, be exercised judicially. Therefore, it will be incumbent upon the "Board "of Trade" to afford the parties interested an opportunity of being heard, and of adducing evidence upon the matter, and to hear and consider the representations of the parties, and the evidence they adduce, and rule 63 so provides. It is apprehended if they act otherwise they can be com-

Note. Sect. 22.

pelled to act judicially (*i.e.*, to hear and determine) by mandamus from the Queen's Bench Division of the High Court of Justice. It is the constant practice to grant the writ (of mandamus) to command the performance by any inferior jurisdiction of any public duty, for which there is no specific remedy—Tapping on Mandamus (chap. 3, p. 12), and cases there cited. See also observations in Brett, L. J., in *Reg.* v *Local Government Board* (reported L. R., 10 Q. B. D., at pp. 321, 322).

This is no appeal from the judicial decision of the "Board "of Trade." The power above mentioned is only to compel the Board to hear and decide judicially.

It is left to the entire discretion of the Board of Trade, whether they will hear the parties by their agents or counsel, or only by themselves.

It is to be anticipated that further rules will shortly be made for working out the powers conferred by this section.

Register of Patents.

Register of patents.

23. (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 licenses 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 (*a*).

(2.) The register of patents shall be *primâ facie* (*b*) evidence of any matters by this Act directed or authorised to be inserted therein.

(3.) Copies of deeds, licenses, and any other documents affecting the proprietorship in any Letters Patent or in any license thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office (*c*).

Note.—Refer to Pat. Rules 64 to 76 (p. 250).

Sub-section 1.—(*a.*) Compare sections 34 and 35 of the Act of 1852, requiring two registers—one (section 34), "The "Register of Patents"; and the other (section 35), "The "Register of Proprietors." Under the new Act there will be but one register, called "The Register of Patents," which is to do the duty of both the former registers.

Section 35 of the 1852 Act contained an important pro-

vision :—"That until entry (in the Register of Proprietors) the "grantee or grantees of the Letters Patent shall be deemed and "taken to be the sole and exclusive proprietor or proprietors of "such Letters Patent." Under that provision it was held that an assignee could not bring an action for an infringement against third parties until his assignment had been registered—*Chollett* v. *Hoffman* (7 E. & B., 686; 26 L. J., Q. B., 249). Upon points arising upon the doctrine of this case, the further cases of *Hassell* v. *Wright* (L. R., 10 Eq., 509); *Ellwood* v. *Christy* (17 C. B. N. S., 754; 34 L. J., C. P., 130); *re* Green's Patent (24 Bea., 145); *re* Morey's Patent (25 Bea., 581); *re* Horsley and Knighton's Pat. (L. R., 8 Eq., 475; L. R., 4 Ch. 786); *re* Morgan's Patent (24 W. R., 245) have been decided. **Note. Sect. 23.**

This section of the present Act must read with sections 87, 88, 89, and 90, *infra*, which see. Especially note the clause in section 87, giving the person, for the time being entered in the Register of Patents as proprietor, power absolutely to assign, grant licenses of, or otherwise deal with, the patent rights, and give effectual receipts.

(*b.*) "*Primâ facie* evidence" means that production of the register is conclusive of everything appearing therein, in the absence of evidence impeaching it. By section 89, copies or extracts from the register, sealed with the seal of the Patent Office, are made evidence. It will, therefore, only be necessary, in order to give the *primâ facie* proof referred to in the clause, to obtain a copy of the part of the register desired authenticated with the Patent Office seal.

(*c.*) This sub-section is in substitution for the provision in section 35 of the Act of 1852, which required all such documents to be entered in the Register of Proprietors. In practice, under this provision, the documents were copied into the Register of Proprietors. Now copies must be supplied by the parties, and are filed in the Patent Office. They will be open to public inspection.—Pat. Rule 75 (p. 252), on payment of 1s.; Schedule of Fees (p. 256) No. 32.

Fees.

24. (1.) There shall be paid in respect of the several instruments described in the second schedule to this Act, the fees in that schedule mentioned; and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and **Fees in schedule.**

Sect. 24. paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

(2.) The Board of Trade may, from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

Note.—See the first schedule to Pat. Rules (p. 255).

Extension of Term of Patent.

Extension of term of patent on petition to Queen in Council.

25. (1.) A patentee (*a*) may, after advertising in manner directed by any rules made under this section (*b*) his intention to do so, present a petition (*c*) to Her Majesty in Council, praying that his patent may be extended for a further term (*d*); but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2.) Any person may enter a caveat (*e*), addressed to the Registrar of the Council, at the Council Office, against the extension.

(3.) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same; and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself, or by counsel, on the petition.

(4.) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention (*f*) in relation to the public, to the profits (*g*) made by the patentee as such, and to all the circumstances of the case (*h*).

(5.) 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 (*i*), conditions (*k*) and provisions that the Judicial Committee may think fit.

(6.) It shall be lawful for Her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and, subject thereto, such proceedings shall be regulated according to

the existing procedure and practice in patent matters of the Judicial Committee (*l*). Sect. 25.

(*i.*) The costs of all parties of, and incident to, such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice (*m*).

Note.—This section introduces no change into the law, but, simply codifies the previously existing legislation on the subject, contained in the now repealed statutes of 1835 (5 & 6 Will. IV., chap. 83, sec. 4); of 1839 (2 & 3 Vic., chap. 67, sec. 2); and of 1844 (7 & 8 Vic., chap. 69, secs. 2 and 3).

(*a.*) The word patentee includes assignee or assignees from the person to whom the patent is granted (see section 46, *infra*, p. 176).

(*b.*) See sub-section 6.

(*c.*) All facts relating to the patent and to the title of the person applying for an extension of a patent must be fully and fairly stated in the petition; if not so stated, the application runs the risk of being refused—*Re* Pitman's Patent (8 Moore's P. C. C., N. S., 293; L. R., 4 P. C., 84)—or postponed—*Re* Hutchinson's Patent (14 Moore's P. C., 364); see also *re* Johnson's Patent (8 Moore's P. C. C., N. S., 282; L. R., 4 P. C., 75).

(*d.*) See sub-section 5.

(*e.*) A "caveat" is a notice of objection.

(*f.*) "*Nature and merits of the invention.*" There must be inventive merit and a benefit to the public—Lord Brougham *in re* Derosne's Patent (4 Moore's P. C. C., 416; 2 Webster's Pat. Cases, 1); *re* Soames' Pat. (1 Webster's Pat. Cases, 735); *re* Muntz's Pat. (2 Webster's Pat. Cases, 113); *re* Betts's Pat. (1 Moore's P. C. C., N. S., 49; 7 L. T. Rep., N. S., 577); *re* Hill's Patent (1 Moore's P. C. C., N. S., 258). Non-user of a patent is a presumption against utility—Lord Chelmsford *in re* Bakewell's Patent (15 Moore's P. C. C., 385); see also *re* Saxby's Patent, per Lord Cairns (7 Moore's P. C. C., N. S., 82).

(*g.*) "*Profits.*" Meritorious invention, large expenses, and no return—*Re* Bates's Pat. (1 Webster's P. C., 739). Inadequate returns for meritorious invention—*Re* Downton's Pat. (1 Webster's P. C., 565). Expense of litigation, cost of patents, expense of bringing invention into use, and manufacturer's fair remuneration to inventor for his personal loss of time, may be deducted in estimating profit—*Re* Galloway's Pat. (1 Webster's P. C., 724; 7 Jur., 453); *re* Carr's Patent

Note. Sect. 25.

(4 L. R., P. C., 539). Accounts must be clear, or application refused—*Re* Clarke's Pat. (7 Moore's P. C. C., N. S., 255). Profits resulting from manufacturing considered—*Re* Muntz's Pat. (2 Webster's P. C., 121); *re* Saxby's Pat. (7 Moo. P. C. C., N. S., 82). Profits made in foreign countries considered—*Re* Johnson's Pat. (8 Moore's P. C. C., N. S., 291). Question, not merely what patentee has received, but what patentee has gained, or ought to have gained with proper management—*Re* Trotman's Pat. (L. R., 1 P. C., 118: 3 Moore's P. C. C., N. S., 488).

(*k.*) "*All the circumstances of the case.*" Difficulty in introducing invention from want of capital—*Re* Downton's Pat. (1 Webster's P. C., 565). Delay in working—*Re* Patterson's Pat. (6 Moore's P. C. C., 469); *re* Norton's Pat. (1 Moore's P. C., N. S., 339). Negligence in restraining infringement—*In re* Sinister's Patent (4 Moore's P. C. C., 164; 1 Webster's P. C., 721). Whether applicant assignee from inventor—*Re* Whitehouse's Pat. (2 Moore's P. C. C., 496; 1 Webster's P. C., 473); *Russell* v. *Ledsam* (14 M. & W., 574; Exch. Ch. 16 M. & W., 633; 1 H. L. Cas., 687). In these cases extensions granted to assignees on terms of paying annuity to inventor. Whether imported inventions—*Re* Soames' Pat. (1 Webster's P. C., 733).

(*l.*) *Restrictions.* The Crown is always represented by the Attorney-General at the hearing of applications for extensions of Letters Patent, and occasionally, on his representations, extensions have been granted on the terms of the Crown having a free use of the invention. Section 27, *infra*, may have an effect upon this practice, and other restrictions have sometimes, although rarely, been imposed.

(*k.*) "Conditions and Provisions." Such as that noticed above in Note (*h*), when extension granted to assignee on condition of his paying the inventor an annuity during the extended term; that the patented articles should be sold to the public at a certain price—*Re* Hardy's Pat. (6 Moore's P. C. C., 441):—that licenses should be granted on certain terms—*Re* Mallett's Patent (4 Moore's Pat. C. C., N. S., 175; L. R., 1 P. C., 308); see also *re* Bodmer's Pat. (8 Moore's P. C. C., 282); *re* Normandy's Pat. (9 Moore's P. C. C., 452).

(*l.*) *Rules of Procedure.* No rules have, as yet, been issued by the Privy Council under this section. The existing rules consequently remain in force. They can be obtained on application to the Privy Council Office.

(*m.*) "Costs" are given to successful opposer—Westrupp and Gibbins' Patent (1 Webster's P. C., 554); but not if opposition needlessly prolonged—*Re* Muntz's Pat. (2 Webster's P. C., 122); *re* Honiball's Pat. (9 Moore's P. C. C., 378).

Costs are given to applicant where the opposition has been groundless—*Re* Downton's Pat. (1 Webster's P. C., 567). Note. Sect. 25.

Revocation.

26. (1.) The proceeding by *scire facias* (*a*) to repeal a patent is hereby abolished. Revocation of patent.

(2.) Revocation of a patent may be obtained on petition to the Court (*b*).

(3.) Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

(4.) A petition for revocation of a patent may be presented by—

(*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 (*e*).

(5.) The plaintiff must deliver with his petition particulars (*f*) 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.

Sect. 26.

(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 (*e*).

Note.—The proceeding by *scire facias* to repeal a patent, has been practically disused for a great number of years. Letters Patent were granted by the sovereign; and the sovereign could and ought to repeal his grant of anything which should not have been granted. Therefore, we find it laid down by Coke "That "when the King granteth anything that is grantable upon a false "suggestion, the King by his prerogative *jure regio*, may have a "*scire facias* to repeal his own grant," and that "when the "King doth grant anything which by law he cannot grant, he "*jure regio*, for advancement of justice and right may have a "*scire facias* to repeal his own Letters Patent" 4 Institute, 88. A patent for an invention was always granted upon the representation that the applicant was the true and first inventor; if he were not, the patent was granted upon a false suggestion. A patent could only be granted for a new invention. If the invention were not new the patent was granted for that, which by law, the King could not grant. The proceeding by *scire facias* was one taken in the name of the Crown by leave of the Attorney-General, and the writ was issued out of the Court of Chancery, because it was to cancel an instrument sealed by the Lord Chancellor. The learning upon the subject will be found in Hindmarch on Patents, chap. X., section 6. The proceedings were antiquated and cumbrous, and numerous conditions were required from the prosecutor such as requiring him to obtain the fiat of the Attorney-General, and to give security for the payment to the defendant of his costs in the event of the latter succeeding. And since the pending of a *scire facias* was no objection to a disclaimer being filed, since the Act of 1835, authorising disclaimer the proceeding was always liable to be defeated by a disclaimer being allowed and filed before the suit could be brought to trial. The form of proceeding fell, therefore, into complete disuse, and it is now at length abolished and another and simple one substituted for it by the present section. No change, however, is made in the principles of law, it is the procedure, and the procedure only, which has been altered.

(*b.*) The Court is Her Majesty's High Court of Justice in England—(section 117, *infra*). Note. Sect. 26.

In Scotland the Court is any Lord Ordinary of the Court of Session—(section 111); and the proceeding shall be in the form of an action of reduction at the instance of the Lord Advocate, or of a person having interest, with the concurrence of the Lord Advocate—(section 109). In Ireland "the Court" is the High Court of Justice in Ireland.

(*c.*) The proceeding by revocation being created by this section, no person except those named in it will be able to avail themselves of it. The class of persons who appear most likely to avail themselves of the proceeding are those named by clauses (*c*) and (*d*), because of the provision in sub-section 8.

(*d.*) This repeats section 41 of 1852 (Act 15 & 16 Vic., c. 83); see also as to particulars of objection the notes to section 29, *infra*.

(*e.*) This is an improvement upon section 10 of the Act of 1852. It will render the proceeding by petition for the revocation of a patent the appropriate remedy for an inventor whose invention has been robbed from him by another, who has obtained a patent therefor; for it enables the former, upon succeeding in obtaining the revocation of a patent granted to the latter upon that ground, to become the owner of the patent, in the place of the fraudent patentee.

Crown.

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 (*a*). Patent to bind Crown.

(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 (*b*), 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.

Note.—(*a*) This is an important change in the law.

For many years the impression prevailed that a patent did bind the Crown, and the Letters Patent themselves always contained a proviso that, if the patentee or his assigns should

Note. Sect. 27.

not supply for the service of the Crown such articles as might be required upon such reasonable terms as should be settled by the officers requiring the same, the patent should cease, and become void. But, in 1833, in the case of a patent for anchors, the Admiralty used the invention, but did not take the article from the patentee, or pay him any remuneration. He applied to the Queen's Bench for a mandamus to the Admiralty to settle the terms according to the patent; but his application was refused, the judges holding they had no jurisdiction to grant it—*Ex parte Perry* (1 A. & E., 919; 3 N. & M., 472). And in 1865, it was held that the Crown might use a patented invention without the assent of, and without remuneration to, the patentee, on the grounds the grant of a patent (1) was simply an exercise of the prerogative; and (2) that the infringement of a patent was a wrongful act or tort, and that no wrongful act can be alleged against the Crown—*Feather* v. *The Queen* (6 B. & S., 257; 35 L. J., Q. B., 200). But, in 1875, it was held that the right of the Crown did not extend to contractors supplying the patented article to, and indemnified against, the patentee by the Crown—*Dixon* v. *London Small Arms Co.* (L. R., 10 Q. B., 130; 31 L. T., N. S., 830). This decision was reversed in the Court of Appeal (L. R., 1 Q. B., 384), but was afterwards affirmed, overruling the Court of Appeal, by the House of Lords (L. R., 1 App. Cas., 632), who considered *Feather* v. *The Queen* rightly decided, but not to be extended.

The decision of *Feather* v. *The Queen*, above cited, was much canvassed, and created great satisfaction among the inventors, and it was not the practice of the Government to frequently avail themselves of it; its doctrine is now definitely abolished by the above section, with the qualification contained in sub-section 2. This section was not in the first draft of the Bill, and was inserted principally, it is believed, in consequence of the representations made by the Society of Arts.

Section 116, which enacts that nothing in the Act shall abridge or prejudicially affect the prerogative of the Crown in relation to the granting or withholding of any Letters Patent, must be considered in relation with the above section. The principle regulating Crown grants that that which appears from its wording to be a general privilege and a general prohibition, must be read with an exception in favour of the Crown itself—Lord Cairns in *Dixon* v. *London Small Arms Co.* (L. R., 1 App. Cas., 641), is, by the above section, declared to be no longer applicable to patents for inventions, so that a patent when granted in ordinary terms will bind the Crown. But there is nothing to prevent the Crown from inserting in

the patent a condition that the Crown shall use the invention without payment, or any other restrictive clause.

Note. Sect. 27. —

Subsection 2. "*On terms to be before or after the use thereof*" *agreed on.*" The effect of this is that the officers or authorities in the sub-section referred to, may use the invention without having first agreed with, or obtained the leave of the patentee. If it be so used, the remuneration is to be agreed subsequently with the patentee, or, in default of agreement by the Treasury after hearing all parties interested. This provision will provide for the case of an emergency in which the delay of negotiation might be prejudicial to the public service. Security is provided for the inventor by requiring the Treasury to hear his representations.

Legal Proceedings.

Hearing with assessor.

28. (1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor (*a*), specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury (*b*) unless the Court shall otherwise direct.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act (*c*).

Note.—(*a.*) This provision is in addition to the powers already possessed by the Court under section 57 of the Judicature Act of 1873.

(*b.*) The intention appears to be to have patent cases tried without a jury, except in exceptional circumstances. It is apprehended a strong case will have to be made out to induce the Court to order a trial with a jury. Still cases, where the issue is one of fraud, such as may occasionally arise in patent cases, such as whether A stole the invention from B, and fraudulently obtained a patent for it, the appropriate tribunal will still be a jury. Since the coming into operation of the Judicature Rules of 1875, the usual course has been to try patent cases before a judge without a jury.

(*c.*) Apparently by the Treasury.

Sect. 29.

Delivery of particulars.

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 (*a*).

(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 (*b*).

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it (*c*), 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 (*d*).

(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 (*e*).

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

(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 (*g*).

Note.—This section simply re-enacts the provisions contained in sections 5 and 6 of the Act of 1835 (5 & 6 Will. IV., chap. 83), and 41 and 43 of that of 1852 (15 & 16 Vic., chap. 83).

(*a.*) *The Particulars of breaches* should give defendant full and fair notice of the complaint made against him—*Needham* v. *Oxley* (1 H. & M., 248); see also *Curtis* v. *Platt* (8 L. T., N. S., 657). Patent for obtaining pictures or representations of objects. Particulars of breaches charged infringement generally by selling pictures; and further, "that one of such pictures was "made and sold by defendant to A. H. C., on 27th April, 1854," but plaintiff said that he stated this by way of example only, and not so as to preclude himself at trial from insisting on other infringements. These particulars were held sufficient—*Talbot* v. *Laroche* (15 C. B., 310). Where action for infringement of patent for cartridges, the patented cartridge was made an

exhibit to the particulars of breaches; they were held sufficient—*Batley* v. *Kynoch* (L. R., 10 Eq., 229; 44 L. J., Ch. 219). Patent for manufacture of pens: the specification described thirteen improvements, referring to them by numbers; the Court ordered plaintiff to give defendant particulars of the number of the improvements of which infringements were alleged—*Perry* v. *Mitchell* (1 Webster's P. C., 269). **Note. Sect. 29.** —

The Plaintiff's particulars of breaches cannot be called in aid of the defects in defendant's particulars of objections—*Palmer* v. *Couper* (9 Exch., 231).

The plaintiff may be ordered to point out, by reference to the pages and lines thereof, the parts of the specification he alleges to be infringed—*Lamb* v. *Nottingham Manufacturing Company* (Seton on Decrees, 4th Ed., Vol. I., 349).

(*b.*) In the defendant's *particulars of objection* a considerable degree of particularity is required, greater even than that required in the plaintiff's particulars of breaches. Under a plea of want of novelty, the Court requires the particulars of objections to give particular instances, because the defendant must know whether, and in what respect, he has infringed—per Jervis, C. J., *Talbot* v. *Laroche* (15 C. B., 310). Their object is to limit expense to parties, and more especially to prevent patents being upset by some unexpected turn of the evidence—*Fisher* v. *Dewick* (4 Bing., N. C., 706; 1 Webs. Pat. Ca., 264); the particulars in this case were held insufficient. In *Jones* v. *Berger* (5 M. & G., 208; 1 Webs. Pat. Ca., 544), the particulars delivered alleged prior user at Nottingham *and elsewhere*. Held insufficient. In *Curtis* v. *Platt* (8 L. T., N. S., 657), the particulars delivered were:—1. Prior user by certain persons specified and others not named; 2. Prior user by thirteen persons or firms, from 1825 downwards, giving merely the places of residence of the persons referred to; 3. Prior publication in books, &c., with a general reference. Further and better particulars of the second and third heads were ordered to be delivered.

In *Lister and another* v. *Leather* (8 E. & B., 1004), the particulars alleged that the patent sued upon was not new, having been anticipated by other patent previously granted to the plaintiffs themselves, between 1*st January*, 1840, *and the* 20*th March*, 1850. At the trial the judge refused, under these particulars, to admit in evidence against the plaintiffs a patent granted to them in 1849.

In *Morgan* v. *Fuller* (L. R., 2 Eq., 296), the particulars were:—

1. Prior user by carriage builders generally;
2. . . . By various carriage builders in or near London,

Note. Sect. 29.

Liverpool, Manchester, Southampton, and various other principal towns in Great Britain and amongst other carriage builders, by Messrs. Thorn, of Great Portland Street, London ;

3. Prior user of the mode described in the specification in various mechanical combinations, applied to various matters and purposes ;
4. That "parts" of the combination claimed had not been invented by the plaintiff ;
5. That "parts" of the said combination, if so invented, were not particularly described.

On application made, the defendant was ordered to deliver further and better particulars of objection.

In *Palmer* v. *Waystaffe and another* (8 Exch., 840), the particulars alleged a prior user of the invention by plaintiff and other persons mentioned at certain places specified, and by candle makers generally, in London and its vicinity ; and were held sufficient. Baron Alderson said :—"A defendant may rely "either on a specified user by certain persons named, or on a "general user, by all persons at a particular place ; in the former "case, if he proves a user by any one of the persons named that "will support his objection ; but if he rests his case on a general "user, proof of a user by one person will not do. The more "general the statement is the more the defendant must prove "under it."

In *Plimpton* v. *Spiller* (20 Solicitor's Journal, 859), by Field, J., an objection alleged the surrender of a previous United States patent, and a previous publication of the invention in certain journals of specified dates, and in sketches and drawings in the library of the Patent Office. This held insufficient, and the defendant was required to set out the date of the United States patent, the name of the patentee, the date of the alleged surrender, the pages of publication, and to identify the drawings.

In *Palmer* v. *Cooper* (9 Exch., 231) the defendant pleaded that the patent was obtained by fraud and misrepresentation. It was held he ought to state in his particulars of objection what the fraud and misrepresentation was.

If the particulars of objection are not sufficiently full, the plaintiff should apply at Chambers for an order for the delivery of fuller and better particulars of objection. If he omits to do so, he cannot object to their generality at the trial. The only question then will be whether the particulars actually delivered include the evidence tendered by the defendant—*Neilson* v. *Harford* (8 M. & W., 806 ; 1 Webs. P. C., 331) ; *Hall* v. *Bolland* (1 H. & N., 134).

(*c.*) That is—insufficiency of specification, obtained by fraud, &c. **Note. Sect. 29.**

(*d.*) In *Crossley* v. *Tomey* (L. R., 2 Ch. D., 533); and *Flower* v. *Lloyd* (20 Solicitors' Journal, 860, by Field, J.); it was held that an order, under the same words, in section 41 of the Act of 1852, was not sufficiently complied with, by giving merely the places of the user, without giving also the names and addresses of the persons alleged to have used the invention. Under that section, the date of the alleged infringement was not required to be given. This omission is now corrected.

(*e.*) *Leave of the Court or a Judge.* The leave would only be granted, in all probability, upon the terms of having to pay the costs of an adjournment to enable the plaintiff to prepare to meet the amended objections. The Courts always exercised the discretion to amend the particulars—See *Renard* v. *Levinstein* (13 W. R., 229; 11 L. T., N. S., 505), where payment of the costs of the motion to amend the particulars, and of any extra costs occasioned to the plaintiff by the introduction of the fresh evidence whatever might be the result of the trial were the conditions imposed; and *Daw* v. *Eley* (L. R., 1 Eq., 38) where permission was refused.

(*f.*) A defendant was always permitted at any time before trial to amend his particulars of objections upon terms as to payment of costs—*Penn* v. *Bibby* (L. R., 1 Eq., 548).

(*g.*) The judge has no power to grant such a certificate after taxation—*Gillett* v. *Green* (7 M. & W., 347).

The defendant will not be entitled to the costs of his particulars of objections, even in the case of a nonsuit, if the judge has not certified for them—*Honiball* v. *Bloomer* (10 Exch., 538). The certificate should be as to the determination of each objection of which notice has been given, and not as to the issues—*Lush* v. *Hague* (5 M. & W., 387).

If plaintiff gives notice of trial, which is afterwards abandoned, the defendant is entitled to the costs of preparing the particulars of objection, and the evidence in support of them, without the certificate of the judge, as section 43 of the Act of 1852, of which the above sub-section is a copy, referred only to cases where there had been a trial—*Greaves* v. *Eastern Counties Railway Co.* (1 El. & El., 961).

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 (*a*) inspection (*b*) or account (*c*), and impose such terms and give such directions respecting the same, and the proceedings thereon, as the Court or a judge may see fit (*d*). Order for inspection, &c., in action.

Note. Sect. 30.

Note.—This section repeats section 42 of the Act of 1852. (*a.*) *Injunction* (interim or interlocutory). The principle on which the Court acts is: that where a patent has been granted and there has been an exclusive possession of some duration under it, the Court will interpose its injunction without putting the party previously to establish the validity of his patent. But where the patent is but of yesterday, and upon an application being made for injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will require the plaintiff to establish the validity of his patent before granting him the benefit of an injunction—Lord Eldon, *Hill* v. *Thompson* (3 Mer., 622).

"The Court can grant an injunction before the hearing when "the patent is an old one, and the patentee has been in long "and undisturbed enjoyment of it, or when its validity has "been established elsewhere, and the Court sees no reason to "doubt the propriety of the result; or when the conduct of "the defendant is such as to enable the Court to say that, as "against him, there is no reason to doubt the validity of the "patent"—Sir Geo. Jessell, M. R., *Dudgeon* v. *Thomson* (30 L. T., N. S., 244); *Renard* v. *Levinstein* (10 L. T., N. S., 177). Knight Bruce, L. J.:—"I think the sufficiency and validity of "the specification is matter of serious doubt. The consequence "is that, with a patent no older than the present, though its "age is no objection to an interlocutory injunction of itself, in "the present stage of the cause there ought to be no injunction."

In order to obtain an interlocutory injunction on the ground that the patent has not been infringed for many years, the patentee must show actual public user by him of the invention—*Plimpton* v. *Malcolmson* (L. R., 20 Eq., 37).

Where a patent has been upheld in former litigation, an interlocutory injunction will be granted, notwithstanding fresh facts are brought forward to impeach its validity—*Davenport* v. *Jepson* (4 De G. F. & J., 440); *Newall* v. *Wilson* (2 De G. M. & G., 282).

If plaintiff has been negligent in prosecuting his rights, even though a strong case otherwise is made out, an interlocutory injunction will not be granted—*Bridson* v. *Benecke* (12 Beav., 1); *Boril* v. *Crate* (L. R., 1 Eq. 388).

If the alleged infringement be doubtful, an interlocutory injunction will be refused—*Electric Telegraph Co.* v. *Nott* (2 Coop. C. C., 41).

In cases, however, where the Court refuses an interlocutory injunction—that is, an injunction restraining the defendant from the use of the invention pending the trial of the Act—it orders the defendant to keep an account of the profits obtained by the defendant from using the invention; and if an interlocutory injunction be granted, an undertaking is required by the Court to abide by any order the Court may make as dan ges, if it should appear that defendant has sustained any in consequence of the injunction—*Wakefield* v. *Duke of Buccleugh* (11 Jur., N. S., 523). **Note. Sect. 30.**

The practical result of the authorities is, that interlocutory injunctions restraining the defendant from using the invention he is alleged by the plaintiff to have infringed, will rarely now be granted unless the infringement is absolutely without colour of excuse, or the validity of the patent has been previously established. In an application for an interlocutory injunction the Court usually orders it to stand over until the trial of the action; requiring the defendant meanwhile to keep an account of his receipts and profits—*Vide* Sir Geo. Jessell, *Plimpton* v. *Malcolmson* (L. R., 20 Eq., 37).

It is none the less advisable for the plaintiff to apply for such an interlocutory injunction nevertheless, because the order usually made is very much in his favour. After a trial resulting in the plaintiff's favour, an injunction restraining the defendant from infringing the plaintiff's patent will follow almost as a matter of course, upon application being made for it.

Although it is a rule of the Court not to interfere unless the patentee's rights has been actually violated, yet, where the defendant evinces an intention and claims the right to infringe, the Court will grant an injunction, although no actual infringement may be shown—*Frearson* v. *Loe* (L. R., 9 Ch. D., 48); *Crossley* v. *Beverley* (1 W. P. C., 119).

Final Injunction. If at the trial the plaintiff succeeds, he will be entitled to an injunction restraining the defendant from infringing his patent, and this in addition to his right to recover damages for the infringement, or to have an account of the profits made by the defendant from the infringement. The Court may also order the destruction of machines made in infringement of a patent—*Betts* v. *De Vitre* (34 L. J., Ch. 289-291); *Tangye* v. *Stott* (14 W. R., 386); see also *Needham* v. *Oxley* (8 L. T., N. S., 604); *Plimpton* v. *Malcolmson* (Seton, on Decrees, 4th Ed., p. 354); *Frearson* v. *Loe* (L. R., 9 Ch. D., per Sir Geo. Jessell, p. 67).

(*b.*) *Inspection.* It must be shown, upon an application for an inspection, that it is material and really wanted for the purposes of the cause. If that be shown, the application may

Note. Sect. 30.

be made at any time after action, but it is not a matter of right —*Amies* v. *Kelsey* (22 L. J., Q. B., 84); *Morgan* v. *Seaward* (1 Webs. P. C., 167); *Bovill* v. *Moore* (2 Cooper C. C., 56 n.). It was decided, upon the construction of section 42 of the 1852 Act, which was in precisely similar terms to the present section, that the inspection therein mentioned is an inspection of the instruments or machinery manufactured by the parties with a view to evidence of infringement, and does not refer to an inspection of books, as that is provided for otherwise—*Udall* v. *Smith* (3 El. & B., 969; 23 L. J., Q. B., 342); see also *Smith* v. *G. W. R. Co.* (3 W. R., 69).

The affidavits in support of the application must be distinct to show that the defendant is using the plaintiff's invention. If they are not distinct, and the defendant swears positively that he does not use the invention, the application will be refused—*Meadows* v. *Kirkman* (29 L. J., Exch., 265); *Shaw* v. *Bank of England* (22 L. J., Exch., 26).

Inspection will be granted only where the Court is satisfied that this is really a case to be tried, and that inspection is necessary to enable the plaintiff to prove his case—*Piggott* v. *Anglo-American Telegraph Co.* (19 L. T., N. S., 46); *Bailey* v. *Kynoch* (L. R., 19 Eq., 90).

In *Patent Type Foundry Company* v. *Walter* (Johns. 727), Wood, V. C., ordered the defendant, a printer, who used types alleged to be made in infringement of the plaintiffs' patent, to deliver a sample of his type to the plaintiffs for analysis. But a similar application was refused by the Court of Exchequer, since it entertained doubts as to whether section 42 of the Act of 1852 enabled them to order articles to be given up for analysis—*Patent Type Foundry Co.* v. *Lloyd* (5 H. & N., 192).

On an application to inspect *all machines* upon defendant's premises, the Court refused, but ordered the defendant to verify, on affidavit, the *several kinds* of machines sold by him, and to produce one of each class for inspection by the plaintiffs—*Singer Manufacturing Co.* v. *Wilson* (5 N. R., 505; 13 W. R., 560).

An order for inspection cannot be granted where the alleged piracy has taken place abroad—*Neilson* v. *Betts* (L. R., 5 H. L., 1).

Laches sufficient to defeat the plaintiffs' right to an interlocutory injunction is no ground for refusing an order for inspection—*Patent Type Founding Co.* v. *Walter* (Johns., 727).

(*c.*) *Account.*—Interlocutory. On reasonable evidence of the validity of the patent, and of its having been infringed, being given, the Court will order the defendant, pending the action, to keep an account of all the articles that he sells or

makes upon the principle alleged to be an infringement of the plaintiff's patent, and of the profits arising therefrom, until further order of the Court, on condition that if, in case the verdict and judgment in the action be in favour of the defendant, the plaintiff will pay the defendant the expense of keeping such account—*Tidi* v. *Smith* (3 El. & Bl., 969). **Noto. Sect. 30.**

Final Account. The plaintiff may sue, at his option, for either the damages he has sustained by the infringement of his patent by the defendant, in which case such damages will be assessed by the Court, or for an account of the profits which the defendant has made by selling the patented article, in which case the defendant will be ordered to pay over the amount of such profits to the plaintiff—*Neilson* v. *Betts* (L. R., 5 H. L., 1); *De Vitre* v. *Betts* (L. R., 6 H. L., 319); *Saxby* v. *Easterbrook* (L. R., 7 Exch., 207); *Holland* v. *Fox* (23 L. J., Q. B., 357); *Elwood* v. *Christy* (18 C. B., N. S., 494); *Walton* v. *Lavater* (8 C. B., N. S., 162); *Davenport* v. *Rylands* (L. R., 1 Eq., 302).

The account extends over the six years immediately preceding the commencement of the action, and there must be no delay in applying for same—*Kernot* v. *Potter* (3 De G. F. & J., 447). If the plaintiff be an assignee, the account will only be taken from the date of the complete assignment to him—*Elwood* v. *Christy* (5 N. R., 312).

It is apprehended that, if the action be in form for damages, yet the plaintiff may, at any time before the actual assessment of the damages, convert his claim for damages into one for an account.

If a person adopts a part only of the patentee's invention, he will be liable to account—*Trotman* v. *Wood* (16 C. B., N. S., 479).

The account may be taken notwithstanding the pendency of an appeal—*Saxby* v. *Easterbrook* (L. R., 7 Exch., 207).

Where separate proceedings have been taken against the *manufacturer* and the *user* of the patented article, the plaintiff may have an account of profits against the manufacturers, and also damages against the user—*Penn* v. *Bibby* (L. R., 3 Eq., 308). As to the way profits are reckoned, see *Penn* v. *Jack* (L. R., 5 Eq., 81).

(*d.*) The words "impose such terms" are not in section 49 of 1852 Act. The Courts, however, have always imposed such terms as seemed just.

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 Certificate of validity questioned,

Sect. 31. — and costs thereon.

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.

Note.—This section practically re-enacts the powers conferred by section 3 of the Act of 1835, and section 43 of the Act of 1852, now repealed.

Under section 3 of the Act of 1835 it was held that where the defendant pleaded that the invention was not new, and a verdict was given for the plaintiff, that the validity of the patent might be considered to have come in question under the plea, and the plaintiff was entitled to the certificate to that effect—*Gillet* v. *Wilbey* (9 C. & P., 334).

Where the defendant, at the trial, consented to a verdict for the plaintiff, without any evidence being given by the former, the Judge refused to certify that the validity of the patent came in question before him, since such certificate might affect third parties, and might, in that manner, be collusively obtained —*Stocker* v. *Rodgers* (1 C. & K., 99).

A patentee, who has obtained this certificate, is entitled to his full costs, if successful, in any subsequent action for *infringement*, although the *validity* of his patent may not be questioned in such action—*Davenport* v. *Rylands* (L. R., 1 Eq., 302; 35 L. J., Ch. 204).

The judge has no power to grant this certificate after taxation—*Gillett* v. *Green* (7 M. & W., 347). It should be applied for at, or immediately after, the trial.

As to what is a sufficient certificate, see *Betts* v. *De Vitre* (11 Jur., N. S., 11); *Buill* v. *Hadley* (17 C. B., N. S., 435; 10 L. T., N. S., 650).

Remedy in case of groundless threats of legal proceedings.

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. Sect. 32. —

Note.—This provision is not to be found in any preceding Act of Parliament. It is intended to settle the law upon a question as to which the cases have been somewhat conflicting.

In 1869, in the case of *Wren* v. *Weild* (L. R., 4 Q. B., 730), some plaintiffs had brought an action, alleging that the defendant wrote to and told persons who had bought machines of the plaintiffs, that such machines were infringements of the defendant's patents; that he, the defendant, claimed royalties for the use of the machines, and that if the plaintiffs used the machines without paying royalties he should take proceedings against them. The plaintiffs, at the trial, offered to prove that the defendant's patent was invalid, by giving in evidence various specifications and machines existing before the date of the defendant's patent, in order to show that the defendant's specification claimed matters that were not new, and by showing also that the defendant had used them. The judge, at the trial, ruled that as the defendant's patent was still subsisting, and not set aside by *scire facias* or otherwise, the evidence was immaterial and inadmissible, and directed a nonsuit. On a motion for a new trial, the Court of Queen's Bench held, in a very elaborate and learned judgment, delivered by Lord Blackburn, that the judge was right; that where a person claims a right in himself, which he intends to enforce against a purchaser, he is entitled to give the latter warning of his intention, and that no action lies for giving such preliminary warning, unless it can be shown either that the threat was made *mala fide* with intent to injure the vendor, and without the purpose to follow it up by an action against the purchaser, or that the circumstances were such as to make the bringing an action altogether wrongful.

In 1872, the case of *Rollins* v. *Hinks* (L. R., 13 Eq., 355), was decided by Vice-Chancellor Malins. The plaintiff, in September, 1871, purchased a number of lamps, manufactured with a burner according to a United States patent, dated 1869, published in this country in August, 1861, and advertised them, as "The American Double Wick Lamp Burner," largely. The defendants were the owners of an English patent, dated 1865, for an invention called "The Duplex Lamp," which also contained a double wick. The defendants published advertisements and notices as follows:—"Duplex Lamps.—Our attention "has been directed to an announcement that an infringement "of our patent is being made in America for sale in this country.

Note. Sect. 32.

"Constant threats of these infringements have been held out "to us for some time past, to induce us to make arrangements "with our rivals. . . . Whenever an actual sale does occur "we shall at once proceed by injunction against the offender, "and also sue for damages." Such circulars were repeated. The plaintiff sold the lamps and invited the defendants to proceed against him for infringement, but they refused to do so. The plaintiff's customers would not buy his lamps in consequence of the defendants' circulars. The plaintiff applied for an injunction restraining the defendants from publishing this circular. Malins, V. C., held that there is no presumption in law in favour of a patent, and, therefore, a patentee is not entitled to publish statements of his intention to institute legal proceedings in order to deter persons from purchasing alleged infringements of his patents, if he has no *bonâ fide* intention to follow up his threats by taking such proceedings, and that the Court will, in such case, restrain him from making such publication; and that a person alleging the invalidity of a patent is not bound to assert his claim by *scire facias*, in order to obtain an injunction restraining the publication of such circulars. This decision was not appealed from, although the correctness of the grounds upon which it was decided were much criticised at the time.

In 1874, in the case of *Aemann* v. *Lund* (L. R., 18 Eq., 330), Vice-Chancellor Malins, following his decision in *Rollins* v. *Hinks*, decided that the Court will restrain a patentee from issuing circulars threatening legal proceedings against infringers unless he will undertake to commence proceedings to assert the validity of his patent, and further held that the fact of the plaintiff having been a licensee of the defendants, and had concurred in issuing similar notices, did not prevent the Court from granting the injunction.

In 1876, the patent of Hinks & Son, the defendants in the suit of *Rollins* v. *Hinks*, above noted, was held invalid by Sir Geo. Jessell, M. R.—*Hinks & Son* v. *Safety Lighting Co.* (L. R., 4 Ch. D., 607).

In 1880, in the case of *Halsey* v. *Brotherhood* (L. R., 15 Ch. D., 514), Sir Geo. Jessell, M. R., declined to follow the decision of Malins, V. C., in *Rollins* v. *Hinks*, following *Wren* v. *Weild*, *supra*, and held that a patent so long as it exists is *primâ facie* good, and therefore a patentee who issues notices against purchasing from a vendor is not bound to follow up his notices by taking legal proceedings; and provided he issues the notices *bonâ fide*, in assertion of what he believes, although erroneously, to be his legal rights under his patent, he does not render himself liable to an action by the vendor for damages

for injury caused by issuing them : though he may be liable, notwithstanding his *bonâ fides*, to be restrained by injunction from continuing to issue the notices if it be proved in the action for an injunction that his allegation of infringement is untrue. Note. Sect. 32.

This decision was appealed from—*Halsey* v. *Brotherhood* (L. R., 19 Ch. D., 386) and was affirmed.

In 1883, in the case of *Burnell* v. *Tate* (45 L. T., 743), it was held by Mr. Justice Kay that when a plaintiff brings an action to restrain a defendant from issuing notices to the plaintiff's customers, that the plaintiff, in selling goods, is infringing the defendant's patent rights, it is for the plaintiff to prove that the defendant's statements are false, and if no *malâ fides* is proved, and no damages could be obtained, the Court will not grant the injunction. If, in a judicial proceeding, the statements are found to be false in fact, an injunction would be granted against continuing them, as that would be acting *malâ fide*.

Another case which may be referred to is *Dicks* v. *Brooks* (L. R., 15 Ch. D., 22).

The new enactment (section 32 above), as will be noticed, adopts the decision of *Halsey* v. *Brotherhood*, with an important qualification, which must be carefully noted. According to *Halsey* v. *Brotherhood*, especially in the judgments in the Court of Appeal, the issue of the circular cannot be restrained if the defendant issued them *bonâ fide*, although erroneously, believing his patent to be valid. This rendered a difficult inquiry into the state of his mind necessary, and the necessity for this inquiry is by section 32, abolished. If he issues such circulars, and his patent is not in fact valid ("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"), the injunction against continuing such threats may be granted, and damages recovered.

It is apprehended that since, from the above cases, it must be taken to be clear law that a patent is *primâ facie* to be regarded as valid, the onus of showing that the patent is invalid will rest upon the person who alleges its invalidity, that is to say upon the plaintiff in such an action as is authorised by the above section. So much in *Wren* v. *Weild*, above noted, as decided that the invalidity of the patent was immaterial, is also overruled by the above section, which makes it a defence to show that the patent is invalid.

What is "*due diligence*" will depend upon the circumstances of each particular case, and will be a question of fact for the judge, or for the jury if the trial be by a jury. It is apprehended that it will not be difficult to determine what, in the circumstances of each case, is due diligence or otherwise.

Miscellaneous.

Sect. 33. — Patent for *one invention* only.

33. Every patent may be in the form (*a*) in the first schedule to this Act, and shall be granted for one invention only (*b*), 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.

Note.—(*a.*) See the form *infra* at p. 235. This form is different from the form which has hitherto been used, but the differences do not appear to be of any substantial importance.

With regard to licenses, the old cases will continue to be authorities, and notwithstanding those of *Chanter* v. *Dewhurst* (12 M. & W., 823), in which some of the judges were of opinion without, however, deciding the point, that a simple license without covenants need not be under seal, and *Chanter* v. *Johnson* (14 M. & W., 408), that if a license were not by deed it would require no stamp, it will still be necessary that licenses shall be granted by deed, that is under seal—Hindmarch, p. 239. The words in the form of patent are "consent, license, or agree-" ment of the said patentee under his hand and seal."

(*b.*) It was formerly the duty of the law officer to see that patent was granted for one invention only, but their practice has varied as to what they have considered to be one invention, and, no doubt, patents have occasionally been granted for more than one invention, but it was never any ground of objection to the validity of a patent when granted, that such was the case. The present enactment makes no change in the law.

It will render it the duty of the examiner and Comptroller (see sections 6 and 7 *supra*), to see that the provisional and complete specification do not contain more than one invention, and if they do, this section will give the Comptroller authority to require the amendment of the specification, so that it shall not contain more than one invention; but should they omit to do so, and the patent be granted for more, it will be no ground of objection to the patent when granted.

It is apprehended that the practice of the examiners, whose exclusive duty it will be to look after the specification, will be stricter than that of the law officers has been upon this point, and that the Comptroller will support them. This may give rise to a little difficulty in practice, as it is by no means an easy matter to determine whether what is included in a specification is only one *invention* or more. Take for instance an application for a patent for improvements in an existing machine, or a process. Here the improvements may be numerous, and except as all applied to one machine or process unconnected;

and capable of use, either separately or in combination: are they *one* invention, or more than one within the meaning of the section? The examiners and Comptroller may not unnaturally take a narrow view. But, since when the Comptroller requires an amendment of a provisional specification (section 7, sub-section 2), or where he refuses to accept a complete specification unless amended to his satisfaction (section 9, sub-section 2), an appeal is provided to the law officer, and the law officers may be expected to take the same view as at present, it may be anticipated that no great practical inconvenience will result.

Note. Sect. 33.

34. (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 (*a*).

Patent on application of representative of deceased inventor.

(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 (*b*) that he believes such person to be the true and first inventor of the invention.

Note.—(*a.*) This provision is a new one. It obviates the hardship of the old law, under which it was decided, in the case of *Marsden* v. *Saville Street Foundry and Engineering Company* (L. R., 3 Ex. D., 203), that even in the case of a patent granted to the widow and administratrix of an inventor who had died after completing his invention, but before applying for a patent, leaving his invention described among his papers, that the patent so granted was void.

(*b.*) *Legal representative* means either the person who has obtained Letters of Administration to the estate and effects of the deceased; or if Letters of Administration have not been obtained, the person entitled to them. As to who are the persons entitled to obtain Letters of Administration to the estate and effects of a deceased person, see Williams on Executors, and Coote's Probate Practice.

Sub-section 2, modifies in the case mentioned section 5, *supra*, which enacts that an application for patent must be made in the form set out in the first schedule; and that every application must contain a declaration that the applicant claims to be the inventor of the invention for which he desires to obtain a patent. No form for such an application is provided in the Pat. Rules, but rule 24 (p. 244) requires that the application shall be accompanied by an official copy of the deceased's Will or of Letters of Administration.

Sect. 35. Patent to first inventor not invalidated by application in fraud of him.

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.

Note.—This section re-enacts the provisions of section 10 of the repealed Act of 1852.

In *re* Vincent's Patent (L. R., 2 Ch, 341), the sealing of a patent was opposed on the ground of previous public use of the invention. The applicant in reply alleged that such use had been obtained by fraud on him within the meaning of section 10 of the Act of 1852. It was held that the patent ought to be sealed, because the allegation of fraud was one which ought to be tried by a jury, and, by refusing to seal the patent, a trial by a jury would be precluded; while, if sealed, it would not.

Assignment for particular places.

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.

Note.—Section 35 of the Act of 1852 provided "That "the grantee or grantees of Letters Patent may assign "the Letters Patent for England, Scotland, or Ireland respec- "tively, as effectually as if the Letters Patent had been originally "granted to extend to England, or Scotland, or Ireland only." This section was introduced into the Act of 1852 because, up to the passing of that Act, separate patents were granted on separate applications for:—(1) England and Wales; (2) Scotland; and (3) Ireland. Now the provision is, the patentee may assign for any "place or a part of," upon the principle that the greater includes the less. A patentee possessing the sole privilege for the United Kingdom, might always have assigned his right to exercise it in any particular place or places in a part or parts of the United Kingdom. The above section somewhat unnecessarily affirms that right.

Loss or destruction of patent.

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.

Note.—This section re-enacts sectio 22 of the repealed Act of 1852, which related, however, only to the case of the

loss or destruction of the patent. The new provision also extends to the case of non-production accounted for to the satisfaction of the Comptroller. **Note. Sect. 37.**

By No. 30 in the List of Fees given in the first schedule to the Pat. Rules (p. 256), the fee payable for a duplicate patent is £2.

Proceedings and costs before law officer.

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.

Note.—"*Costs.*" Section 11 of the Act of 1852 contained a similar provision as to costs. Section 47 of that Act entitled the law officers to be paid, as part of the costs provided by section 14, such fees for the hearings in cases of opposition and disclaimer, as the Lord Chancellor and the Master of the Rolls should appoint. By an order of Lord St. Leonards, C., and Sir John Romilly, M.R., dated 1st Oct., 1852, certain fees were appointed; and these fees have continued to be paid to the Crown, and not directly to the law officers, since the payment of fixed salaries. No provision is to be found in the present Act for the fees payable in proceedings before the law officers, unless it be in that part of the above section authorising the law officer to make rules regulating the practice and procedure before them. The law officers have made some rules which will be found printed at p. 253, but they have not up to the present published any list of the fees payable to them.

Exhibition at industrial or international exhibition not to prejudice patent rights.

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade (*a*), 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 (*b*), 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 (*c*), shall not prejudice the right of the inventor or his legal personal

Sect. 39. 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 (*d*); and

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

Note.—Refer to Pat. Rules No. 17 (p. 243).

This section re-enacts and amends the provisions of section 3 of 28 & 29 Vic., c. 3 (the Industrial Exhibitions Act, 1865); and section 2 of 33 and 34 Vic., c. 27 (the Protection of Inventions Act, 1870), both of which are repealed in the third schedule of the present Act.

It will require careful attention on the part of inventors who propose to exhibit unpatented inventions to ascertain that the exhibition is certified by the Board of Trade as an industrial exhibition. This can be done by application to the Board of Trade. Probably the Comptroller of Patents will be the proper officer to apply to.

(*b.*) This enactment will cover any description of the invention, no matter how or where published, "*during the period of the holding of the exhibition only.*" If, therefore, the exhibition be closed before six months from the opening, and a publication of the invention be made between the date of closing and the application for patent, such publication will be fatal to the patent.

(*c.*) The protection to the inventor is only in the case of the user of the invention without his consent or privity elsewhere than in the exhibition, *i.e.*, if the inventor uses the invention himself elsewhere than at the exhibition, such user will be fatal to the validity of the patent afterwards obtained.

(*d.*) This notice is imperative, and must be given before exhibiting the invention. Rule 17 of the Pat. Rules (p. 243) prescribes the procedure. The notice required is seven days and a brief description of the invention, with drawings if necessary. The obvious intention of the enactment is to obtain a record at the Patent Office by means of this notice and description.

(*e.*) *i.e.*, if the patent be not applied for within six months from the opening of the exhibition, the inventor abandons and loses his right to a patent.

40. (1.) The Comptroller shall cause to be issued periodically an illustrated journal (*a*) of patented inventions, as well as reports of patent cases decided by courts of law (*b*), and any other information that the Comptroller may deem generally useful or important.

(2.) Provision shall be made by the Comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any (*c*).

(3.) The Comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

Sect. 40. — Publication of illustrated journal, indexes, &c.

Note.—(*a.*) "*Illustrated Journal.*" The nature of this journal is intentionally left very much to the discretion of the Comptroller. It is intended to contain all that has hitherto been published in the "Commissioners of Patents "Journal," and a great deal more.

(*b.*) "*Reports of Patent Cases.*" The publication of these reports is made compulsory upon the Comptroller. Reporters in the law courts will therefore become a necessary part of the staff in his office.

(*c.*) The Act of 1852 contained (section 30) a very useful provision, requiring the printing, publication, and sale of all specifications, disclaimers and memoranda of alteration deposited under that Act. Under this provision, printed copies of the specifications and drawings of almost all patents, not only of those in force, but of those which had expired, could be purchased, for a small sum, at the office of the Commissioners of Patents. The convenience and advantage of such a privilege to inventors and to others interested in inventions and patent rights, has been very great. The provision was omitted from the first draft of the Bill, and was only inserted in consequence of strong representations made; but it has been somewhat grudgingly done, and only relates to "patents for the time being in force," instead of to all patents, whether in force or expired. Inventors and patentees requiring exact information as to the subject matter of expired patents will henceforth be unable to procure printed copies of the specifications of such expired patents, but will have to depend, practically, upon the illustrated journal of patented inventions above mentioned.

Sect. 41. Patent Museum.

41. The control and management of the existing Patent Museum, and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as Her Majesty in Council may see fit to give.

Note.—The "existing Patent Museum" is contained in a building or shed forming an annexe to the South Kensington Museum. It consists of a somewhat heterogeneous collection of machines and models, which have, from time to time, been presented to it, and is under the care of a curator, appointed and paid by the Government.

Power to require models on payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

Note.—This provision is new. It appears to be borrowed from a provision in the law of the United States which requires the applicant for a patent to deposit a model or specimen of the invention at the time he lodges his application for patent. This section differs, because it only empowers the Department of Science and Art to require the patentee to furnish a model on being paid its cost price. It appears very likely to become a dead letter, as no provision is made as to where the money to pay for the models is to come from.

Foreign vessels in British waters.

43. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein 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.

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorise subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such

inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state. Sect. 43.

Note.—This section re-enacts section 26 of the Act of 1852. It was introduced into that Act in consequence of decision in the Court of Chancery, in 1851—*Caldwell* v. *Van Vlissengen* (9 Hare., 415; 21 L. J., Ch. 97; 16 Jur., 115). In that case the foreign owners of a ship made and attached to their vessel in their own country a screw propeller, unpatented there, but patented in England. The vessel came to England with a cargo, and the owners of the patent obtained an injunction restraining the use of the propeller within the waters covered by the English patent.

As to the case of the use of a patented invention in an English ship in foreign waters see *Adair* v. *Young* (L. R., 12 Ch. D., 13), decided in 1879.

Assignment to Secretary for War of certain inventions.

44. (1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration), assign to Her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of Her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the Comptroller his opinion that, in the interest of the

Sect. 44. public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications, with the drawings, if any, and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand of the Secretary of State to receive the same, and shall, if returned to the Comptroller, be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the Secretary of State to receive it.

(8.) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification, or specifications, with the drawings, if any, shall be forthwith placed in a packet sealed by authority of the Comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in

this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid. Sect. 44.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any 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.

Note.—This section re-enacts the provisions of the patent for Instruments and Munitions of War Act, 1859 (22 Vic., c. 13), which is repealed by this Act (see the third schedule); see also section 27, and the note thereto, *supra*, p. 151.

Existing Patents.

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. Provisions respecting existing patents.

(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 licenses.

(3.) In all other respects (including the amount and time of payments 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.

(4.) All instruments relating to patents granted before the commencement of this Act, required to be left or filed in the Great Seal Patent Office, shall be deemed to be so left or filed, if left or filed before or

Sect. 45. after the commencement of this Act in the Patent Office.

Note.—This is not a happily worded section. Its meaning is, however, clear:—1st. Every patent, for which application is made before the 1st January, 1884 (no matter when granted), remains liable to the right of the Crown to use it without remuneration to the patentee, *i.e.*, liable to the doctrine of *Feather* v. *Queen* (see note to section 27), and unaffected by section 27. 2nd. No patent applied for before 1st January, 1884 (no matter when granted), shall be liable to the obligation imposed by section 22 (*supra* p. 142), of granting compulsory licenses. 3rd. With regard to all applications for patents made up to and including the 31st December, 1883, the proceedings and the fees payable up to the filing of the complete specification are under the old law. After the filing of the complete specification those patents come under the new law, except in the two respects (liability to use by the Crown, and freedom from liability to compulsory license) above pointed out. 4th. With regard to all applications for patents made upon and after the 1st January, 1884, the new law, of course, applies exclusively.

The words in brackets, in sub-section 3—"(including the amount and time of payment of fees)"—appear to have suggested a doubt to some persons as to whether the Act intended to abolish the fees payable for notices to proceed (£5), and for the warrant and seal (£10), and to alter the fee on the final specification from £5 to £3, upon applications made before the 1st January, 1884, where those payments had not been made before that date. It is, however, clear that this is not the true construction of the section. The words in the brackets are governed by the words preceding: "in all other respects," and those words clearly refer to the two preceding sub-sections, and except from the operation of sub-section 3 the preceding provisions of sub-sections 1 and 2, the first of which is, that "the provisions of this Act, relating to applications for patents "and the proceedings thereon, shall have effect in respect only "of applications made after the commencement of this Act."

Definitions.

Definitions of patent, patentee, and invention.

46. In and for the purposes of this Act—

"Patent" means Letters Patent for an invention:

"Patentee" (*b*) 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 section six of the Statute of Monopolies (*c*) (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act "concerning monopolies and dispensations with penal "laws and the forfeiture thereof"), and includes an alleged invention (*d*). Sect. 46.

In Scotland "injunction" means "interdict."

Note.—(*b.*) "Patentee," that is includes the assignee or other legal representative of the person to whom the patent was granted.

See note (*a*) to section 5, sub-section 2, *supra* p. 119.

(*c.*) The Statute of Monopolies declared all monopolies however or by whomsoever granted, to be illegal and void, excepting by section 6:—"Letters Patent and grants of privilege "for the term of fourteen years or under hereafter to be made "of the sole working or making *of any manner of new manu-* "*factures within this realm* to the true and first inventor or "inventors of such manufactures, *which others at the time of* "*making such Letters Patent and grants shall not use*, so as "also they be not contrary to the law nor mischievous to the "state, by raising the prices of commodities at home, or hurt "of trade, or generally inconvenient, the said fourteen years to "be accounted from the date of the first Letters Patent or "grants of privilege hereafter to be made, but that the same "shall be of such force as they should be as if this Act had "never been made, and of none other.

(*d.*) That is, that the word "Invention," used in this Act, for the purposes of this Act only, includes "alleged invention."

PART III.

Designs (*a*).

(*a.*) For the scheme of the legislation enacted in this part of the Act, the reader is referred to p. 109, where will be found that part of the Memorandum indorsed upon the Bill upon its first introduction into Parliament relating to designs.

The Acts of Parliament relating to Copyright of Designs, and repealed by this Act, are:—

1. The Act of 1842, relating to Ornamental Designs, 5 & 6 Vic., c. 100.

Note. Part III.

2. The Act of 1843, relating to Useful Designs, 6 & 7 Vic., c. 69.
3. The Act of 1850, amending the two previous ones, 13 & 14 Vic., c. 104.
4. The Act of 1858, amending the Act of 1842, 21 & 22 Vic., c. 70.
5. The Act of 1861, amending the previous Act, 24 & 25 Vic., c. 73.

This part of the Act practically codifies and re-enacts the practical parts of the old legislation, other parts of which had become obsolete from disuse. The only alterations in the law beyond matters of detail, are (1) Equalisation of the period of protection for all designs to a period of *five* years, in the place of periods varying, in the case of ornamental designs from nine months to three years, according to the class in which they were registered; and in the case of useful designs, a period of ten years; and (2) The abolition of the distinction between ornamental and useful designs; and (3) The abolition of provisional registration.

See also Chapter II., p. 68, for principles of the law.

Registration of Designs.

Application for registration of designs.

47. (1.) The Comptroller may, on application by, or on behalf of, any person (*a*) claiming to be the proprietor (*b*) of any new or original design (*c*) 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 (*d*), 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 (*e*).

(3.) The application must contain a statement of the nature of the design (*f*), and the class or classes of goods in which the applicant desires that the design be registered (*g*).

(4.) The same design may be registered in more than one class (*h*).

(5.) In case of doubt as to the class in which a design ought to be registered, the Comptroller may decide the question (*i*).

(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 (*k*). Sect. 47.

(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 (*l*).

Note.—(*a.*) "*Any person,*" including a foreigner residing abroad (see repealed Act, 24 & 25 Vic., c. 73).

(*b.*) "Proprietor," *i.e.*, the author, or the person for whom the design was executed (see section 61), and who has given consideration for it.

(*c.*) "*New and original design*" (see section 60).

The following were held not to be proper subjects for registration as useful designs under the Act of 1843 (6 & 7 Vic., c. 65) :—A design for ventilation by opening a hinged pane of a window by means of a screw, in which the utility was not produced by the shape of the parts, but by the mode of putting them together. Another Court quashed a conviction for pirating such design for want of jurisdiction—*Reg.* v. *Bessell* (16 Q. B., 810; 20 L. J., M. C., 177). A protector label, which consisted in making in the label an eyelet hole, and lining it with a ring of a metallic substance, through which a string attached to the packages passed—*Rogers* v. *Driver* (16 Q. B., 102; 20 L. J., Q. B., 31). A design for a dog-cart, specifying as the purpose of utility, that higher front wheels could be used, and closer couplings effected, consisting of parts 1, 2, 3, and 4, of which 1, 2, and 3 had nothing to do with front wheels, or closer couplings, and No. 4 was old—*Windover* v. *Smith* (32 L. J., Ch. 561; 32 Beav., 200).

But the following was held to be a proper subject for registration as a useful design under that Act (6 & 7 Vic., c. 65) :—A brick so shaped, that when several bricks were laid together in building, a series of apertures were left in the wall, by which air was admitted to circulate, and a saving in the number of bricks required was effected.

The following were held proper subjects for registration as ornamental designs under the Act of 1842 (5 & 6 Vic., c. 100) :—A new combination of old patterns. The design was applied to a fabric woven in cells, called "The Honeycomb "Pattern," and it consisted of a combination of the large and small honeycomb, so as to form a large honeycomb stripe, or a small honeycomb ground. The large honeycomb was not new, but had never been used in combination before; other fabric had been woven with a similar combination of a large and small pattern—*Harrison* v. *Taylor* (4 H. & N., 815; 29 L. J.,

Note. Sect. 47.

Exch. 3). A new combination of several old and known designs so as to constitute one design, and not a multiplicity of designs—*Norton* v. *Nicholls* (1 El. & El. 761; 27 L. J., Q. B., 225). A particular collection of shaded and bored stars upon an ornamental chain surface, forming the ornamentation of a woven fabric; the stars and surface were old, but the combination was new—*McCrea* v. *Holdsworth* (5 B. & S., 495; 33 L. J., Q. B., 329). Affirmed on appeal (35 L. J., Q. B., 123; L. R., 1 Q. B., 264).

The following were held not to be proper subject for registration as ornamental designs, under the latter Act, 5 & 6 Vic., c. 100:—Four old designs respectively applied to three ribbons and to a button, and the three ribbons were then united by the button, so as to form a badge—*Mulloney* v. *Stevens* (10 L. T., N. S., 190). The portrait of a well-known public character, copied from a photograph, and applied as a design, upon earthenware—*Adams* v. *Clementson* (L. R., 12 Ch. D., 714).

A double card basket, forming a combination of two baskets, both old in design—*Lazarus* v. *Charles* (L. R., 16 Eq., 117; 42 L. J., Ch. 507). An article of manufacture (see section 60), to which a new design is applied, is not in itself a design within the meaning of 5 & 6 Vic., c. 100 (the language of which was similar to that used in section 60 of this Act—*Norton* v. *Nicholls* (1 El. & El., 761; 27 L. J., Q. B., 225).

(*d.*) Rule 4 of the Designs Rules requires Form E in the second schedule to these rules (p. 273). See Designs Schedule of Fees (p. 272).

(*e.*) "*Prescribed manner*," *i.e.*, by section 48, and the Designs Rules 6 to 15 (see p. 266).

(*f.*) "*Statement of the nature of the Design.*" This statement is in addition to copies of drawings or specimens required by section 48. The Act requires both a statement of the nature of the design, and drawings or specimens of the design itself. This statement is not required to be like the specification of a patent, but should be sufficiently full and explicit to make the design intelligible to enable the Comptroller to give the information required to be given by him by section 53 (which see), and to fully explain all matters pertinent to the registration which cannot be gathered from looking at the representation or specimen of the design filed with the application. It will be advisable, when registering useful designs, to make these statements particularly full.

(*g.*) "*Class or classes of goods.*" The classification prescribed by the Designs Rules made by the Board of Trade under section 101, sub-section 2, appear in the third schedule

to those rules printed at p. 276. The application (see Form E) must state in which of the classes enumerated in that schedule the design is to be registered. Note. Sect. 47.

(*h.*) It will be necessary to register in as many classes as the design is capable of application to if it be desired to obtain complete protection. The proprietor possesses copyright in the design only in that class or those classes in which the design is registered.

(*i.*) The decision of the Comptroller as to the class will be apparently final, as no means of appealing from his decision upon that point are provided.

(*k.*) The procedure for appealing to the Board of Trade is regulated by the Designs Rules, Nos. 16 and 20, (p. 268). The form of notice of appeal is Designs Form F (p. 273).

(*l.*) The decision of the Board of Trade as to the refusal to register will be apparently final. The Court, however, possesses a general controlling power over the Register of Designs under section 90 of the Act.

48. (1.) On application for registration of a design, the applicant shall furnish to the Comptroller the prescribed number of copies of drawings, photographs, or tracings of the design sufficient, in the opinion of the Comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design (*a*). Drawings, &c., to be furnished on application.

(2.) The Comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records (*b*).

Note.—(*a.*) See Designs Rules 8 and 9 (p. 266), as to the drawings, &c., required.

(*b.*) No means are provided for questioning the Comptroller's refusal.

49. (1.) The Comptroller shall grant a certificate of registration to the proprietor of the design when registered (*a*). Certificate of registration.

(2.) The Comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

Note.—(*a.*) Refer to section 51 as to the prescribed mark. The certificate of registration will be in Designs Form G (p. 273).

Note. Sect. 49.

(*b.*) The application for copy certificate will be Designs Form H (p. 274). The fee will be 1*s.* No. 5 in Schedule of Designs Fees (p. 272).

Copyright in Registered Designs.

Copyright on registration.

50. (1.) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2.) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration), furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

Note.—The provision in sub-section 2 is new, and requires great attention. The only safe way of complying with its provisions is, whenever the articles to which the design is applied are manufactured, to send the prescribed number (see Designs Rule 9, p. 267) of the articles themselves to the Comptroller before issuing any of them for sale. In the case of impossibility or great inconvenience in sending the articles themselves, exact representations (by photograph or drawings, &c.) of the articles to which the design is applied, showing the design, should be sent. It is apprehended that in the case of neglect to do this, it would be the Comptroller's duty, on such neglect being brought to his attention, to cancel the registration in the way provided.

Marking registered designs.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered (*a*); 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 (*b*).

Note.—(*a.*) "*The prescribed mark, or with the prescribed word or words or figures denoting the design is registered.*"

Note. Sect. 51.

See the Designs Rule 32 (p. 270), which prescribes the mark which is the abbreviation "R$^{D.}$" for classes 1 to 12 (see Designs Classification, p. 276), and "REG$^{D.}$" for Classes 13 and 14. The provision is taken from section 4 of 5 & 6 Vic., c. 100; and section 3 of 6 & 7 Vic., c. 65. The wording, however, is materially different, and the alteration is in favour of the proprietor of the design. Section 4 of 5 & 6 Vic., c. 100 (ornament), required that, *after publication*, every *article to which the registered design had been applied*, should bear the mark prescribed. Section 3 of 6 & 7 Vic., c. 65 (utility), required that, after publication, every article *made by the proprietor* should have thereon the word "registered," with the date of registration. Under these Acts, therefore, even if the proprietor had fixed the mark and word, and it subsequently was removed, he lost his copyright. But under the above section, if he has "caused each article to be marked with the prescribed mark" before delivery or sale, he has fulfilled his obligation, and the subsequent removal of the mark will not affect his copyright.

(*b.*) "*Unless he shows he took all proper steps to ensure the "marking of the article.*" This proviso is new, and is intended to meet the case whereby some accident or some neglect for which the proprietor is not fairly responsible, articles to which the design has been applied are delivered on sale without the mark. It will, however, still be necessary to be very careful. The provision as to marking will be construed strictly —*Pierce* v. *Worth* (18 L. T., N. S., 710).

Inspection of registered designs.

52. (1.) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the Comptroller or by the Court, and furnishing such information as may enable the Comptroller to identify the design, nor except in the presence of the Comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

Information as to existence

53. On the request of any person producing a particular design, together with its mark of registration,

Sect. 53. — of copyright.

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.

Note.—See Designs Rules 33 and 35 as to inspection.

These provisions are adopted from section 17, of 5 & 6 Vic., c. 100. The power to the Court to authorise an inspection of a design, during the period of copyright, now conferred, was not contained in that section, nor the obligation now imposed upon the Comptroller to furnish details after the period of copyright has expired of the design to a person furnishing information sufficient to identify the design.

Cesser of copyright in certain events.

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.

Note.—This provision is new, and requires careful attention. It is somewhat curious that it should be introduced for the first time into the law in the same Act of Parliament which repeals, without re-enacting, section 25 of the Patent Act of 1852, which made the duration of a patent for the United Kingdom dependent on the continued existence of a prior foreign patent for the same invention.

Register of Designs.

Register of designs.

55. (1.) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments, and of transmissions of registered designs, and such other matters as may 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.

Note.—See Designs Rules 21 to 28 (p. 268) as to the register and as to assignments.

Assignments of the copyright of and license to use a design must be in writing. It was held by Sir Geo. Jessell, M. R., in the case of *Jewitt* v. *Eckhardt* (L. R., 8 Ch. D., 404; 26 W. R., 415)—upon the construction of section 3 of 5 & 6 Vic., c. 100, that an assignment of a license to use a design must be in writing, and can only be made by the registered proprietor. The reasoning of this decision remains the same under the present Act and the case will still remain an authority. No time should be lost in registering an assignment, for in the case of the bankruptcy of the assignor after assignment, and before registration thereof, the proprietorship of the design would probably be held to be in his order and disposition, and as such would pass to his trustee—*Longman* v. *Tripp* (2 Bos. & Pull. N. R., 67; *Hesse* v. *Stevenson* (3 Bos. & Pull. 565); *re* Dilworth (1 Dea. & Chitt., 411).. Note. Sect. 55. —

Fees.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct. Fees on registration, &c.

Note.—See schedule of fees for designs (p. 272).

Industrial and International Exhibitions.

57. The exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with, namely:— Exhibition at industrial or international exhibition not to prevent or invalidate registration.

(*a.*) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the Comptroller the prescribed notice of his intention to do so; and

(*b.*) The application for registration must be made

Sect. 57.

before or within six months from the date of the opening of the exhibition.

Note.—These provisions were taken from section 4 of 28 & 29 Vic., c. 3 and section 3 of 33 & 34 Vic., c. 27, both of which are repealed in the schedule to the present Act.

The Designs Rules 36 and 37 regulate the procedure of notice to the Comptroller of intention to exhibit. The exhibitor must give seven days' notice to the Comptroller, and, for the purpose of identifying his design, furnish that officer with a brief description and a sketch of the design. The form of notice is Designs Form L (p. 275).

Legal Proceedings.

Penalty on piracy of registered design.

58. During the existence of copyright in any design (*a*)—

(*a.*) It shall not be lawful for any person without the license or written consent (*b*) of the registered proprietor to apply such design, or any fraudulent or obvious imitation thereof (*c*), 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 (*d*).

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds (*e*) 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.

Note.—(*a*) These provisions are adopted from section 7 of 5 & 6 Vic., c. 100. Under that section, the words of which were, "No person shall either do or cause to be done," the acts therein mentioned including the application of any such design for the purpose of sale; Sir Geo. Jessel, M. R., held

Note. Sect. 58.

that a lace merchant, who had received a pattern of lace sent him by letter of the plaintiff's registered design and had sold one parcel only, came within it, and had been guilty of a piracy, because he had caused the plaintiff's design to be applied—*Mallett* v. *Howitt* (Weekly Notes, 1879, p. 107). The words now are to "apply" merely.

(*b.*) "*License or written consent.*" The fact of an author of new designs which have been registered, publishing them in a book, containing a notice that persons wishing to manufacture them for purposes of sale must have the author's permission, does not amount to a license to sell articles to which the designs have been applied—*Branchardiere* v. *Elvery* (4 Exch., 380; 18 L. J., Exch., 381).

(*c.*) "*Fraudulent or obvious imitation thereof.*" A. registered as a design a pattern consisting of a combination of distinct designs; B. slightly altered the combination, but not so as to affect the general appearance of the pattern. Held that this was an infringement of the copyright in the pattern—*McCrea* v. *Holdsworth* (6 L. R., Ch. 418; 23 L. T., 444; 19 W. R., 36 C.).

(*d.*) "*Knowing that the same has been so applied without the consent of the registered proprietor.*" The words of the old Act, 27 Geo. III., c. 38, repealed by the 5 & 6 Vic., c. 65, rendered it necessary that the proprietor should prove that he had not given his consent, and great difficulty was experienced in proving this knowledge. Section 7 of 5 & 6 Vic., c. 65 did not contain this provision, but required that the offender should have notice that the proprietor had not given his consent. The present Act returns nearly to the original form of words, and it will now be necessary to prove that the offender knew that the proprietor had not given his consent. Sir Geo. Jessell, in the case of *Mallett* v. *Howitt* (Weekly Notes, 1879, p. 107), expressed his opinion that a manufacturer of an article within the provisions of the Designs Acts was bound to inquire whether the article was already registered.

The effect of this proviso will be to render it advisable in all cases, to give notice to the proposed defendant before proceeding against him, that the design applied to the article he is publishing or exposing for sale, had been applied without the consent of the proprietor. Such a notice will fix him with knowledge, and if he does not stop then, he will be liable to the penalty, in an action for damages (section 59). On the question of notice, it was held that a notice given under section 7 of 5 & 6 Vic., c. 65, was not sufficient unless it expressly stated that the proprietor had not given his consent to the application of the design, and whether he intended to use it either (*a*) for the *application* of the design; or (*b*) for the *sale*

Note. Sect. 58.

of articles with the design applied—*Norton* v. *Nicholls* (5 Jur., N. S., 1203). It will, therefore, be not only advisable to give a notice, but to take care to render the notice sufficiently specific.

(*e.*) "*Fifty Pounds.*" The limit of penalty under the repealed Act (5 & 6 Vic., c. 100, section 8), was £30 only. And the means provided by that section for recovering the penalty by summary proceedings before justices are not re-enacted. Henceforth it will be necessary to proceed by action in the superior or county courts, to recover the same. Section 12 of repealed Act (5 & 6 Vic., c. 100), limited the time within which proceedings should be taken to twelve months from the commission of the offence. This provision is not re-enacted.

Action for damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale, or exposure for sale by any person of any article or substance to which such design, or any fraudulent or obvious imitation thereof, shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

Note.—The Designs Rule 34 (p. 270) enables the Comptroller to give certificates for use or legal proceedings.

This section re-enacts section 9 of the repealed Act 5 & 6 Vic., c. 100. Under the repealed Acts (see note to section 58), the action must have commenced within twelve months from the infringement, but this provision has been repealed, and is not re-enacted. The action will be for the actual damages to be assessed by the Court (or by a jury, if the case be so tried) sustained by the plaintiff in consequence of the infringement. An injunction restraining the defendant from a repetition or continuance of the infringement may also be claimed and granted in such an action, or the action may be brought for an infringement alone—*McCrea* v. *Holdsworth* (2 De G. & S., 496; 12 Jur., 820). For a form of injunction under the repealed Acts see *Norton* v. *Nicholls* (4 K. & J., 475; Pemberton's Judgment, 297). See the remarks in note to section

58 upon knowledge of the defendant that application of the design was unauthorised. **Note. Sect. 59.**

For an instance of an action for falsely representing that a particular design has been registered, whereby the plaintiff has been injured, see *Barley* v. *Walford* (9 Q. B., 197).

Definitions.

60. In and for the purposes of this Act— Definition of "design," "copyright."

"Design" means any design applicable to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

"Copyright" means the exclusive right to apply a design to any article of manufacture, or to any such substance as aforesaid, in the class or classes in which the design is registered.

Note.—The definition of designs, is taken *ipsissima verba*, from the repealed Act of 1862 (5 & 6 Vic., c. 65, section 3). This definition of copyright renders it necessary, as pointed out in the note (*h*) to section 47, to register a design in as many classes as it is capable of application to, in order to secure complete protection. The exclusive right conferred by the Act is limited to the "class or classes in which the design "is registered." Anyone may apply the design in any other class or classes with impunity.

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 Definition of proprietor.

Sect. 61

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.

Note.—This definition of "proprietor" is taken, *ipsissima verba*, from the repealed Act of 1842 (5 & 6 Vic., c. 100, section 5).

PART IV.

TRADE MARKS.

Registration of Trade Marks.

Application for registration.

62. (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 set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed (*a*), and must be left at, or sent by post to, the Patent Office, in the prescribed manner.

(3.) The application must be accompanied by the prescribed number of representations of the trade mark (*b*), and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered (*c*).

(4.) The Comptroller may, if he thinks fit, refuse to register a trade mark (*d*), 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 (*e*).

(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 (*f*). Sect. 62.

Note.—(*a.*) The Trade Marks Rules 7 to 16 (p. 277) regulate the procedure on the application to register. For fees payable see first schedule to Trade Marks Rules (p. 288). The forms prescribed as those in the second schedule to the Trade Marks Rules (p. 299), rules 4 and 5 (p. 277). A corporation or partnership may register a trade mark (rule 7).

(*b.*) The prescribed number is three (rule 13).

(*c.*) The classes of goods in which the registration is to be effected are stated in the third schedule to the Trade Marks Rules (p. 299), rule 6 (p. 277).

(*d.*) The Trade Marks Rules 17 to 19 (p. 279) provide that the applicant have an opportunity of being heard by the Comptroller before he refuses to register (see section 94, p. 222).

(*e.*) The procedure on appeal to the Board of Trade is regulated by the Trade Marks Rules 20 to 24 (p. 280).

(*f.*) The decision of the Board of Trade is final, unless the Board shall refer the appeal to the Court. The mode of reference to the Court is unprovided for. By section 117 the Court is defined. See rule 29 (p. 281) for mode of bringing matter before the Court in cases of opposition.

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 application shall be deemed to be abandoned. Limit of time for proceeding with application.

Note.—This section is new. Its object is to clear the list of applications for trade marks of those applications which have not been proceeded with during a reasonable period. It will require careful attention. The leading point in the section is "default on the part of the applicant," but there is nothing in the Act to define what shall be considered to be such default. No doubt the "default" in contemplation of the draftsman of the section is failure to comply with some requisition of the office.

"*Deemed to be abandoned*," that is, the application is at an end; but there appears to be nothing to prevent a fresh application being made upon the same material as the abandoned application, subject, of course, to the risk of having been anticipated, pending the second application.

Sect. 64.

Conditions of registration of trade mark.

64. (*a.*) (1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars (*b*):

(*a.*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner (*c*); or

(*b.*) A written signature, or copy of a written signature, of the individual or firm *applying for registration thereof as a trade mark* (*d*); or

(*c.*) A distinctive device, mark, *brand*, heading, label, ticket, *or fancy word or words not in common use* (*e*).

(2.) There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, *or of any of them* (*f*).

(3.) Provided that 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 thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act (*g*).

Note.—(*a.*)-This section is a re-enactment of section 10 of the Trades Marks Registration Act, 1875 (38 & 39 Vic., c. 91), repeating the words thereof exactly, with the important additional words *in italics* above. The Bill, upon its first introduction into Parliament, contained the above section in the exact words in which it now stands, and it has, therefore, become law, without alteration. The Memorandum indorsed thereupon (printed in extenso at Chapter IV., p. 103) stated that the definition of a trade mark has been extended to include, in addition, what was covered by section 10 of the Act of 1875—

1. Fancy words not in common use.
2. Brands.
3. Single letters as *old* trade marks (used before 13th August, 1875).

The above, therefore, are capable of registration as trade marks from and after the 1st January, 1884.

Fancy words were held not within section 10 of the Act of 1875, when not used before the coming into operation of that Act, in the case of *ex parte Stephens* (L. R., 3 Ch. D., 659; 46 L. J., Ch. 46). The word in that case was "AEILYTON." The words in clause (*c*) of the above section—"fancy word or

"words not in common use"—are inserted to meet such a case, and such words are now capable of registration. Note. Sect. 64.

Single letters, as old trade marks, used before the coming into operation of the Act of 1875, were held not to be within section 10 of the Act of 1875, in the case of *re* Mitchell's Trade Mark (L. R., 7 Ch. D., 36; 46 L. J., Ch. 876). Messrs. Mitchell were steel-pen manufacturers, who, long before 1875, had used single letters of the alphabet, from A to W, raised in relief upon different kinds of pens manufactured by them. It was held that the words of section 10, "combi-"nation of words or *letters*," did not include the case of a single letter. The law is now amended by sub-section 3 of the above section, enacting that "any special and distinctive *word* "or words, *letter*, *figure*, &c., used before 13th August, 1875, "may be registered as a trade mark."

The introduction of the word *brand* seems to have been due to the necessity for meeting the tendency of the Court to adopt the very strict construction of the definition of a trade mark capable of registration, illustrated by the above cases. It is difficult to conceive any case where a *distinctive brand* would not also be a *distinctive mark*.

(*b.*) *Essential particulars.* As to what are *essential*, as distinguished from *non-essential*, particulars of a trade mark, the case of *in re* Barrows (L. R., 5 Ch. D., 353; 46 L. J., Ch. 450 and 725), especially the order made by the Court of Appeal, may be consulted. The particulars comprised in sub-section 1 are essential; those mentioned in sub-section 2 are non-essential.

(*c.*) That is to say, the name distinguished in a particular manner. The registered trade mark will not, therefore, consist of the name merely, but of the name with the characteristic printing, impressing, or weaving. The name of an individual or a firm may be a trade mark; but another person of the same name cannot be prevented from using his own name, if it is done *bonâ fide* and not fraudulently, so as to represent himself as being the other person, and so obtaining his trade—*Holloway* v. *Holloway* (13 Beav., 209); *Burgess* v. *Burgess* (3 De G. M. and G., 896); *Ainsworth* v. *Walmsley* (L. R., 1. Eq., 518). Such being the law, the intention is not to permit the registration of the name merely, but the name with such a characteristic way of printing, impressing, or weaving it, that an imitation of such characteristic way, would afford clear evidence of the fraudulent attempt to appropriate trade.

(*d.*) The written signature, or copy of the written signature, is, of course, the name of the individual or firm "printed, "impressed, or woven in some particular or distinctive

Note. Sect. 64.

"manner," and the remarks of the above note equally apply. Where M. applied to register as his trade mark, his signature in combination with the descriptive words, "Filtre Rapide," he was allowed to do so, but had to pay the costs of the Registrar of Trade Marks—*Re* Maignen's application (28 W. R., 759, M. R.).

(e.) The words "Family Salve" were held to be a distinctive heading within section 10 of Act of 1875—*Reinhardt* v. *Spalding* (49 L. J., Ch. 57; 28 W. R., 300). It was doubted whether the scientific name of a tree, "Limetta," was a sufficiently distinctive word to be capable of registration as an old mark in respect of lime juice—*Rose* v. *Evans* (48 L. J., Ch. 618).

A word in foreign characters (Arabic) was held to be a distinctive device, overruling the direction of the Commissioners of Patents—*Re* Rotherham's Trade Mark (L. R., 14 Ch. D., 585; 49 L. J., Ch. 511).

(*f.*) The word "figures" in sub-section 2 means numerals—Jessell, M. R., *ex parte* Stephens (L. R., 3 Ch. D., 660).

The matters mentioned in sub-section 2 are *non-essential* particulars; those in sub-section 1 are essential particulars.

(*g.*) See Note (*a*), *supra*. A trade mark, used as such before 13th August, 1875, is an "old" trade mark. The following cases, in addition to those above noted, have been decided upon section 10 of the Act of 1875, of which the above section is a re-enactment, with certain additions already pointed out—*Ransome* v. *Graham* (51 L. J., Ch. 897; 47 L. T., 218); see the note to section 66, *infra*; *re* Worthington and Co.'s Trade Mark (L. R., 14 Ch. D., 8); *re* Robinson's Trade Mark (29 W. R., 31), both shortly stated in the note to section 67, *infra*; *Benbow* v. *Low* (44 L. T., 875; 29 W. R., 837, V. C. B.); *re* Jelley's application (51 L. J., Ch. 639 n.; 46 L. T., 381 n.); *re* Braby's application (L. R., 21 Ch. D., 223; 51 L. J., Ch. 637); *re* Dugdale's Trade Mark (49 L. J., Ch. 303): see note to section 72, *infra*; *re* Whiteley's Trade Mark (43 L. T., 627 n.; 29 W. R., 235 n.); see note to section 65, *infra*.

Connection of trade mark with goods.

65. A trade mark must be registered for particular goods or classes of goods.

Note.—This re-enacts the first clause of section 2 of the repealed Act of 1875.

The classes of goods are regulated by the Trade Marks Rules, No. 6 (p. 277), and are set out in the third schedule thereto, printed at p. 299.

The trade mark when registered is a trade mark for the particular goods or classes of goods only for which it has been registered. Trade marks may be registered for as many classes of goods as may be desired, if no mark so closely resembling them as to be likely to deceive (section 72) is already on the register in respect of any of the goods or classes of goods. **Note. Sect. 65.**

A trade mark may be registered for part of a class only.

In *re* Bury & Co. (cross-summons to *re* Rabone Brothers & Co.) before the Master of the Rolls, 15th February, 1879, registration was allowed for part of a class, and user was confined to certain colonies; in *re* Brook (26 W. R., 791) registration was allowed for cotton thread only; *in re* Jelley, Son & Jones, before the Master of the Rolls; 18th May, 1878 (51 L. J., Ch. 639 n.; 46 L. T., 381), where the application was to register a trade mark in class 5 as a new mark for wire fencing, in class 12 as a new mark in respect of files and many other articles, in class 13 in respect of screw wrenches and many other articles; and it being opposed, it was, after argument held, upon the evidence, that the applicants were entitled to register it as an old mark in class 13 in respect of all the articles; and as a new mark in class 5 in respect of wire fencing, but not as a new mark in Class 12, as the applicants had not applied the mark to articles in that class, and the mark resembled that of their opponents, who had on the register a trade mark which they had applied to similar articles in class 12, and, therefore, to allow the applicants to register it in that class would be calculated to deceive the public (Mr. Rigby, *arguendo*, 11 Ch. D., 673); see also *ex parte* Barrow & Co. (Weekly Notes, 1877, p. 119; Notes of Cases, L. J., 1877, p. 110). In the case of *re* Whiteley's Trade Mark (43 L. J., 627 n.; 29 W. R., 235 n.) W. applied for the registration of an old trade mark for goods in Classes 11, 12, and 13, having used the mark in connection with the goods comprised in those classes in a particular manner. His application was opposed by a firm, who had for many years used, and had obtained registration of a similar mark, which, however, they used in a different manner from that in which W. used his mark, but upon the same classes of goods; and it was held that registration should be granted to W. on his undertaking (to be noted on the register) not to use his mark in the manner in which the opposing firm used their mark, nor otherwise than in the manner in which he had previously used it.

This case was followed *in re* Sykes' Trade Mark (43 L. T., 626; 29 W. R., 235), the circumstances of which were as follows:—Sykes & Co., of Edgeley, a firm of calico bleachers, having applied for registration as cotton marks, of two marks

Note. Sect. 65.

long used by them, consisting of (1) a shield in outline, containing the figure of a swan, and the letters "S. & Co., E"; it also contained three other letters, subject to variation, indicating the date of pac' ing; and (2), a shield in outline, with the letters "R. S. E.," indicative of the former title of the firm, and varying letters as in the other mark. Bleachers' marks are used in a particular mode, being stamped within the fold of the calico before the parcel is stitched up. The Committee of Experts on Cotton Marks (now abolished) considered those marks were not trade marks within the Act, on the grounds that the letters were not quality marks, that swans were common in the trade, and that borders must be regarded. On application to the Court, it was held that registration of both marks ought to be proceeded with, and that with the registration there should be entered on the register a note of an undertaking by the applicants not to use the marks otherwise than in the limited mode in which they had formerly applied them. *In re* Braby & Co.'s application, decided in 1882 (L. R., 21 Ch. D., 223; 51 L. J., Ch. 637) Mr. Justice North held that a new mark may be registered for some of the goods in a class, even although an old mark of similar kind has been already registered for other goods in the same class, provided that the goods and the trade of the proprietors are sufficiently distinct for no confusion to take place.

Registration of a series of marks.

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.

Note.—This is a new and useful provision.

It is intended to meet the difficulty which arose *in re* Barrow's Trade Marks (L. R., 5 Ch. D., 353), and in several other cases. Hitherto such varying marks have sometimes been considered separate marks, and resembling each other in their essential particulars, more than one could not be registered

without infringing the rule re-enacted by section 72 of the present Act, that there should not be registered in respect of same description of goods, trade marks so nearly resembling another as to be calculated to deceive. Now such marks can be registered with their non-essential variations mentioned in the above section in a series as one registration, *i.e.*, as one mark with the variations. Note. Sect. 66.

Vice-Chancellor Bacon held, in *Ransome* v. *Graham* (51 L. J., Ch. 897; 47 L. T., 218), that where a manufacturer placed on his goods a series of combinations of letters as trade marks, each of which served to indicate to purchasers (1) that the goods are made by the person using the mark; and (2) the quality of the goods, as compared with the goods respectively bearing the other marks in the series, the marks being exclusively used by the manufacturer—such series of letters were valid trade marks, and might be registered, notwithstanding that they were indicative of the quality of the goods to which they are applied.

The above section adopts and amplified this decision.

Refer to Trade Marks Rules 14 and 28 (pp. 279, 281), as to the registration of a series of marks.

Refer to Schedule of Trade Marks Fees, No. 4 (p. 288), for fees payable.

67. A trade mark may be registered in any colour, 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. Trade marksmay be registered in anycolour.

Note.—This is a new and important provision. Under the Act of 1875 no notice was taken of colour, and yet colour, in many marks, was a very distinctive feature, such as Messrs. Bass & Co.'s triangular red mark, but no protection could be obtained therefor. This defect in the Act was much discussed in the case of *re* Worthington & Co.'s Trade Mark (L. R., 14 Ch. D., 8), where it was held by the majority of the Court of Appeal, that a triangle, with a double outline, with the words "Beccles Brewery," inscribed within the outline, and having within the triangle the figure of a church, would be so similar to Bass & Co.'s plain red triangle as to be calculated to deceive, because Worthington & Co. would be able to use it in any colour they pleased. But *in re* Robinson's Trade Mark (29 W. R., 31, M. R.), where he applied to register a gold mohur, and D., who was proprietor of a cotton trade mark, consisting of a silver rupee, opposed, it was held that his mark was not calculated to deceive, because in such cases the mark protected is the

Note. Sect. 67.

registered mark, which has been deposited, and of which the representation can be seen at the places mentioned in the advertisement. Now the above section enables the proprietor of the trade mark to register it in any colour, but by doing so he obtains the exclusive right to use it in any other colour (*i.e.*, all other colours) as well.

Advertisement of application.

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.

Note.—This section adopts and enacts as law the provisions contained in rule 13 of the rules under the Trade Marks Registration Acts of 1875 and 1877. On that rule there has been the decision of, *in re* Meikle (46 L. J., Ch. 17 ; 24 W. R., 1067). The Registrar of Trade Marks had refused to advertise an application for a trade mark of which the word "Registered" formed a part. On a summons by the applicant it was held that the Court could not order the trade mark to be registered, as there had not been the necessary advertisement, and that it could not interfere with the refusal of the Registrar to advertise.

Refer to Trade Marks Rules 25 to 28 (p. 280) as to the advertisement, and as to power of the Comptroller to require a wood block or electrotype of the mark for the purposes of the advertisement.

Opposition to registration.

69. (1.) Any person may within two months of the first 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 two months 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 require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be awarded

respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn. Sect. 69.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.

Note.—This section adopts and enacts as law the provisions contained in rule 16 of the rules under the Trade Marks Registration Acts of 1875 and 1877. The time within which the notice of opposition was to be given, was not provided in that rule. It is now fixed at two months from the first advertisement of the application by the Comptroller. The time within which, after his receipt of the notice of opposition, the applicant was to send him his counter-statement, was three weeks under the old practice. It is now two months, or such further time as the Comptroller may allow. In all other respects, the above section and rule 16, are identical.

For regulations as to, and form of, *Notice of Opposition* see Trade Marks Rules 29 (p. 281), and Trade Marks Form J (p. 292). For fees payable with Notice of Opposition (see Trade Marks Fees No. 5 (p. 288). The rules are silent as to the method of giving security for costs, but the Comptroller will, in each case, give directions. The ordinary mode of giving security is by bond; any form of bond, satisfactory to the Comptroller, may be adopted. As to entry in register of disallowance of opposition (see Trade Marks Rule 44 p. 284).

No form of counter-statement is provided by the rules, so that any form may be adopted, *e g.*, "By way of counter-" statement I rely upon the following grounds:"—

For mode of bringing the matter before the Court, see rule 29 (p. 281): see *re* Simpson, Davies & Son's Trade Mark (15 Ch. D., 525); *re* Johnston's Trade Mark (43 L. T., 672, Fry, J.).

As to Registrars (Comptroller's costs), *re* Rotherham's Trade Mark (14 Ch. D., 585; 49 L. J., Ch. 511; 43 L. T., 1) where it was held that the Court had no jurisdiction to give costs against him—*Re* Orr-Ewing's Trade Mark (28 W. R., 412, V.-C. H.).

The Court has no jurisdiction to order the payment of costs incurred before the case stands for the determination of the Court, but it has with regard to the costs incurred after; and,

Note. Sect. 69.

in a proper case, will give them to the successful party—*Re* Brandreth's Trade Mark (L. R., 9 Ch. D., 618; 47 L. J., Ch. 816).

Assignment and transmission of trade mark.

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.

Note.—This section re-enacts, in the identical words, a portion of section 2 of the Act of 1875.

For regulations as to the assignment and transmission of trade marks, see Trade Marks Rule 34, *et seq.* (p. 282). In case of death, see rule 31 (p. 282).

For forms applicable thereto, see Trade Marks Forms (p. 290), &c.

In connection with the goodwill of the business see *Cooper* v. *Hood* (26 Beav., 293); *Churton* v. *Douglas* (Johns., 174); *Shipwright* v. *Clements* (19 W. R., 599); *Cotton* v. *Gillard* (44 L. J., Ch. 90).

Goodwill according to Lord Hatherley, then Wood, V.-C., in *Churton* v. *Douglas* (Johns., 174), means "Every advantage that "has been acquired by the old firm in carrying on its business, "whether connected with the premises in which the business was "previously carried on, or with the name of the late firm, or "with any other matter carrying with it the benefit of the "business."

Tindal, C. J., in *Hitchcock* v. *Coker* (6 Ad. & E., at p. 454), said:—"The goodwill of a trade is a subject of value and price. "It may be sold, bequeathed, or become assets in the hands of "the personal representative of a trader." It may be sold by the trustee of a bankrupt owner—Bankruptcy Act, 1869, sec. 25, par. 6; Bankruptcy Act, 1883, sec. 56, par. 1). And the trade mark passes to a trustee in Bankruptcy and, together with the goodwill of the business, may be dealt with and sold by him—*Hudson* v. *Osborne* (39 L. J. Ch. 79); *Bury* v. *Bedford* 33 L. J., Ch. 465).

In the sale of a business, including the goodwill thereof, a trade mark will pass to the purchaser without special mention—*Shipwright* v. *Clements* (19 W. R., 599).

Rule 25 under the Trade Marks Registration Acts, 1875-77, provided that any transmittee may assign his interest in the mark, notwithstanding that he has not been registered as proprietor thereof. This rule is not, however, repeated by the new rules.

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. Sect. 71. — Conflicting claims to registration.

Note.—This section re-enacts the provisions of the second clause of section 5 of the Act of 1875. Refer to Trade Marks Rules 41 to 43 (p. 283), as to procedure, &c., and to Trade Marks Fees (p. 288).

72. (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. Restrictions on registration.

(2.) The Comptroller shall not register with respect to the same goods or description of goods a trade mark so nearly resembling a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

Note.—This section re-enacts in slightly varying phraseology the provisions of the first clause of section 6 of the Act of 1875 and of rule 19 under the Acts of 1875 and 1877. Upon that section and rule, the following decisions have been given :—

The Court would, under this rule 19, direct a trade mark to be registered if satisfied of its dissimilarity to marks already registered, without inquiring whether it be distinguishable from other marks the subjects of pending applications to register—*Re* Dugdale's Trade Mark (49 L. J., Ch. 303; 28 W. R., 436, Vice-Chancellor Hall).

The rule of the Court was to permit registration, under section 6 of the Act of 1875, of identical trade marks up to three, although, if more than three applications are made for similar trade marks, notwithstanding such trade marks are old (in use before 13th August, 1875), registration will be refused on the ground that such mark is common property—*Benbow* v. *Low* (44 L. T., 875; 29 W. R., 837, Vice-Chancellor Bacon).

In the case of *re* Walkden's Aerated Water Co., heard on the

Note. Sect. 72.

8th June, 1877, the late Master of the Rolls, Sir Geo. Jessel, said that "the Lord Chancellor was of opinion that the number "of times which a *new* device or emblem might be registered as "a trade mark for articles of the same class, ought, for the sake "of distinctiveness, in no case to exceed three."

In *re* Jelley's application (51 L. J., Ch. 639 n.; 46 L. T., 381 n.), decided in 1878, it was held that old marks, whether cutlers marks or not, may be registered up to the number of *three* by different persons in respect of the same goods, even if identical; but this does not apply to new marks (query, see *re* Walkden, *supra*), and if the same old mark has been used in respect of the same goods by more than three different persons, it is a common mark.

In *re* Hargreave's Trade Mark (L. R., 11 Ch. D., 669; 27 W. R., 450), where there were four trade marks including an anchor, registered in respect of goods in class 42 (substances used as food) the Court refused to give leave to the Registrar to register a new trade mark, including an anchor, in respect of goods in the same class, but different in character from those goods in which the four trade marks had been registered.

In *re* Braby's application, *in re* Shropshire Iron Co.'s Trade mark (L. R., 21 Ch. D., 223; 51 L. J., Ch. 637), it was decided a new mark may be registered in respect *of some of the goods in a class*, although an old mark of a similar kind has been already registered *for other goods in the same class*, provided that the goods and the trades of the proprietors are sufficiently distinct for no confusion to take place. This case followed, and was decided upon the authority of, *in re* Jelley's application, reported as above, which had already decided the same point.

See also the cases of *re* Whiteley's Trade Mark (43 L. T., 627 n.; 29 W. R., 235, n.); and *re* Sykes' Trade Mark (43 L. T., 626; 29 W. R., 235), shortly stated in the note to section 65, *supra*.

See also *ex parte* Barrow & Co. (Weekly Notes, 1877, p. 119), when Sir Geo. Jessel held that the proprietor of an old trade mark might have it registered for part of a class only, and gave leave to a firm applying to register in the class for metal goods to have it registered for tin and terne plates only; see also *in re* Barrow's Trade Mark (L. R., 5 Ch. D., 353).

"*Calculated to deceive.*" The late Master of the Rolls, Sir Geo. Jessell, in the case of *Allsopp* v. *Walker*, decided upon the 10th April, 1877, refused to register a female hand, printed horizontally, as being too similar to a man's hand held upwards.

Note. Sect. 72.

The observations of Lord Cranworth, L. C., in giving judgment in the case of *Seixo* v. *Provezende* (reported L. R., 1 Ch., 196), appear to afford a rule as to what will be considered calculated to deceive. "What degree of resemblance is "necessary, from the nature of things, is a matter incapable of "definition, *à priori*. . . . It is a mistake to suppose that "the resemblance must be such as would deceive people who "should see the two marks side by side. The rule so restricted "would be of no practical use. If a purchaser looking at the "article offered to him would naturally be led, from the mark "upon it, to suppose it to be the production of the rival manu- "facturer, and would purchase it in that belief, the Court con- "siders the use of such a mark to be fraudulent" (therefore calculated to deceive). "But I go further; I do not consider "the actual physical resemblance of the two marks to be the "sole question for consideration. If the goods of a manu- "facturer have, from the mark or device he has used, become "known in the market by a particular name, I think the "adoption of any mark which would cause a rival trader's "goods to bear the same name in the market, may be as much "an invasion of the rights of the other as an actual copy of his "device."

In the case of *Orr-Ewing & Co.* v. *Johnston & Co.* (L. R., 13 Ch. D., 434), it was held by the Court of Appeal, that if one trader appropriates a material and substantial part of a trade mark which belongs to another trader, he is bound to use such precautions as to avoid the reasonable probability of error and deception, and the *onus* is upon him to show that purchasers of the goods will not be deceived. And that where the goods of a trader have acquired in the market a name derived from a part of the trade mark which he affixes to them, a rival trader is not entitled to use a ticket which is likely to lead to the application of the same name to his goods, even though that name is not the only name by which the goods of the first trader have been known, or though it has been always used in conjunction with some other words. This decision was affirmed in the House of Lords (L. R., 7 App. Cases, 219), the decision of which is shortly summarised as follows:—No trader has a right to use a trade mark so nearly resembling that of another trader as to be likely to mislead incautious purchasers.

The rules are silent as to the procedure for getting the decision upon the questions arising upon the above section, but the mode will be that pointed out by rule 29 (p. 281), by summons at Chambers, to be adjourned into Court. Refer to rule 44 (p. 284), as to entry in register of order of Court.

Sect. 73.

Further restriction on registration.

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 reasou of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

Note.—This section re-enacts, in the same words precisely, the last clause of section 6 of the Act of 1875.

As to what may be calculated to deceive see the note to section 72.

"*Be deemed disentitled to protection in a court of justice.*" —Any false statement or misrepresentation on the part of the plaintiff of a nature calculated to deceive the public, will, in a Court of Equity (and now all Courts are Courts of Equity), deprive him of his right to protection.

In *Perry* v. *Truefitt* (6 Beav., 66), the plaintiff sold a substance as "Perry's Medicated *Mexican* Balm," and represented in the label "this admirable composition was made from an original "recipe of the learned Von Blumenbach, and was presented to "the proprietor by a near relative of that illustrious physio- "logist." The balm did not come from Mexico, and the state- ment as to recipe was untrue. Held the plaintiff was not entitled to an injunction against an infringer of his labels or marks on the ground of the misrepresentations therein.

In *Edelstein* v. *Vick* (11 Hare, 78), it was laid down by the Court—"I am particularly anxious that it should be under- "stood by all persons applying to the Court . . . . . that "they should show that they themselves have not been guilty of "any fraud or misrepresentation, and that if they have made "any representations to the public, they must shew that such "representations have not been made without foundation or "with fraudulent intent."

In *Leather Cloth Co.* v. *American Leather Cloth Co.* (11 H. L. C., 523), it was decided the Court would not protect plaintiffs, who used a label or advertisement containing false statements about their goods; see also *Pidding* v. *How* (8 Sim. 477); *Hogg* v. *Kirby* (8 Ves., 215); and as to the untrue use of the word "patent," the judgment of Vice-Chancellor Wood, in *Morgan* v. *McAdam* (36 L. J., Ch. 228), and Lord Justice Mellish, in *Singer Co.* v. *Wilson* (L. R., 2 Ch. D., 434-56); *Lamplough* v. *Balmer* (Weekly Notes, 1867, p. 293); see also Chapter III., p. 85, *et seq. supra.*)

The principle does not apply, apparently, to mere puffing advertisements—*Holloway* v. *Holloway* (13 Beav., 209).

Sect. 74.

Saving for power to provide for entry on register of common marks as additions to trade marks.

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 (1)—

(*a.*) In the case of an application for registration of a trade mark used before the thirteenth day of August, one thousand eight hundred and seventy-five—

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 (2);

(*b.*) In the case of an application for registration of a trade mark not used before the thirteenth day of August, one thousand eight hundred and seventy-five (3)—

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 thirteenth day of August, one thousand eight hundred and seventy-five, 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 (4).

Note.—This section is new. In effect it gives legislative affirmation to, and carries out the principle of the decision in *re* Braby's application, and *re* Jelley, Son and Co.'s application (*see note to section 72*); *re* Whiteley's Trade Mark, and *re* Sykes' Trade Mark (see note to section 65), viz., to permit the registration of marks, although already used by others, when it can be done without injuring the latter.

Note. Sect. 74.

(1.) "*An addition to any trade mark*;" *i.e.*, there must be a substantive trade mark, to which the common mark is to be registered as an addition. The common mark is not the trade mark, but only part thereof.

(2.) Compare the definitions in clauses (*b*) and (*c*) of section 64.

(3.) Note the distinction in this section as between *old* (in use before 13th May, 1875), and *new* (first used after that date) marks.

(4.) See note to section 72.

Effect of Registration.

Registration equivalent to public use.

75. Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.

Note.—This section is taken from and re-enacts the chief provision of section 2 of the Act of 1875. Before that enactment it was necessary to entitle the owner of a trade mark to obtain the protection of the Courts against an infringement of it, that goods, to which it related, should actually have been sold or on sale in the market with it attached, which alone was held to be "public use" thereof. Advertisement with actual sale, or offering for sale, was insufficient, *McAndrew* v. *Bassett* (33 L. J., Ch. 561), where Lord Chancellor Westbury stated, p. 568, that the article marked with the trade mark being "actually a vendible article in the "market" was essential to property in a trade mark; and *Maxwell* v. *Hogg* (L. R., 2 Ch. 307), when it was held by Turner and Cairns, L.J.J., that advertisements and expenditure on the part of the plaintiff in announcing a new magazine with the title of "Belgravia," did not, before the actual issue of such magazine, give him the exclusive right (*i.e.*, trade mark) thereto. But see *Johnson & Co.* v. *Orr-Ewing & Co.* (L. R., 7 App. Cas., 219), decided in 1882, where the House of Lords held that the use of a trade mark might be restrained by injunction, although no purchaser *had been actually misled*, for the very life of a trade mark depends upon the promptitude with which it is vindicated; see also *Singer Co.* v. *Looy* (L. R., 8 App. Cas., 15), decided December, 1882, where the House of Lords held that a trader has a right to make and sell machines similar in form and construction to those made and sold by a rival trader, and in describing and advertising his own machines, to refer to his rival's machines and name, provided he does this in such a way as to obviate any reasonable possibility of misunderstanding or deception.

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.

Sect. 76. — Right of first proprietor to exclusive use of trade mark.

Note.—This section is taken from, and re-enacts section 3 of the Act of 1875. Upon that section there have been the following important decisions—*re* Hyde & Co.'s Trade Mark (L. R., 7 Ch. D., 724; 38 L. T., 777), where it was held, upon an application under section 5 of the Trade Marks Registration Act of 1875 (the powers of which, in this respect, are re-enacted by section 90 of the present Act) to remove from the register a trade mark of H. & Co., who had registered it as a trade mark after duly advertising it as prescribed by the Act, claiming 41 years user; but it appeared that, for the greater part of that time the mark had been a common mark, and for about six years had been so to the knowledge of H. & Co., and that the applicants, who had long used the same trade mark, were not aware of the advertisement, and had not opposed the registration;—that the trade mark must be removed from the register as having been improperly registered, and that there had been no laches on the part of the applicants, and that H. & Co. must pay the costs of the application to remove their mark from the register; and,

Re Palmer's application (L. R., 21, Ch. D., 47; 51 L. J., Ch. 673; 46 L. T., 787), in which Palmer had registered under the Act of 1875, the words "Braided fixed stars," as a trade mark for matches. After the expiration of five years another firm of manufacturers (Bryant and May) applied to cancel the registration, on the ground that the words could not be registered as a trade mark, for that "fixed stars" was a name well known in the trade for a particular description of matches before Palmer used the alleged trade mark, and that the words "braided fixed stars" were only a proper description of a kind of matches made by Palmer, under a patent which had recently expired, and which matches were, at the time of the registration, well known in the trade by that name, and differed from the fixed stars formerly known by having a braided stem, which was the subject of the patent. Chitty, J., held that even if section 3 of the Act of 1875 did not make registration after lapse of five years therefrom conclusive evidence that the alleged trade mark was a proper trade mark (which he thought it did), it, at all events, excluded evidence to show that the words which, *primâ facie*, appeared to be fancy words,

Note. Sect. 76.

and proper to constitute a trade mark, were not capable of constituting one. He, therefore, declined to hear evidence on the subject, and refused the application. But on appeal, held by Jessell, M. R., and Cotton and Lindley, L.J.J., *that a mark which is not authorised to be registered as a trade mark, cannot acquire the character of a trade mark by being on the register for five years, and may be removed from the register, although that period has elapsed*, and the evidence ought therefore to have been admitted which went to show that at the time of the registration the words "braided fixed stars" were merely descriptive of a kind of matches well known in the trade. Although not necessary for their decision, and, therefore, not so deciding, the Court also appeared to be of the opinion (see Judgment of Jessel, M. R., pp. 59, 60; L. R., 21 Ch. D.) that a person sued for infringing a registered trade mark which had been on the register for more than five years, might defend himself successfully by showing that the trade mark, although registered, was not a trade mark within the Act, and, therefore, never ought to have been registered. It is understood that this decision has been appealed from to the House of Lords. Its correctness, however, is not doubted by the profession generally.

The obvious effect of these two decisions is, (first) that any mark which was not a fit subject for registration, will be removed from the register on the application to the Court; (secondly), whether it has been so registered for less or more than five years, and (three) that, while such mark remains on the register the registration confers no rights upon the person in whose name it has been registered.

Restrictions on actions for infringement, and on defence to action in certain cases.

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 (*a*), it has been registered in pursuance of this Act, or of an enactment repealed by this Act (*b*), or, in the case of any other trade mark in use before the thirteenth of August, one thousand eight hundred and seventy-five, 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.

Note.—This section is taken from, and re-enacts, the similar provision contained in sections 1 and 2 of the Act of 1876 (the

Trade Marks Registration (Amendment) Act (39 and 40 Vic., c. 33). No action can be brought unless the trade mark has been registered, or, in the case of an old mark, registration refused, and certificate of refusal obtained. There may be, and probably are, many cases where a trade mark which does not come within the definition contained in the Act of 1875, or the present Act has, by user before the Trade Marks Register was established, and a restrictive definition of a trade mark legislatively adopted, become exclusively the property of the persons using them. In such cases, since the object of the Act was not retrospective, these marks are not deprived of the protection of the law against infringement; but to secure the registration of all marks coming within the definition, the provision is made that no action be brought until registration has been refused, and, to secure clear evidence of such refusal, the obtaining the certificate of refusal is made imperative. Refer to Trade Marks Rule 57 (p. 286), to Form L (p. 293), and to No. 8 Fees (p. 288) as to certificate of refusal.

Note. Sect. 77.

(*a.*) See definition of a trade mark under this Act, section 64; and of "additions," section 74.

(*b.*) For definition of trade marks under former Acts, see section 10 of Act of 1875.

Register of Trade Marks.

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.

Register of Trade Marks.

Note.—The register to be kept under this section will be a continuation of the register established by section 1 of the Act of 1875. Refer to Trade Marks Rules 30 to 43 (p. 282) as to Register of Trade Marks.

79. (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

Removal of trade mark after fourteen years unless fee paid.

Sect. 79. (naming the date at which the same will expire) the prescribed fee (*a*); 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.

(3.) If, before the expiration of the said three months, the registered proprietor pays the said fee, together with the additional prescribed fee (*b*), 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.

(4.) Where, after the said three months, a trade mark has been removed from the register for non-payment of the prescribed fee (*c*), 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 the five years next after the date of such removal, be deemed to be a trade mark which is already registered (*d*).

Note.—This section is taken from, and re-enacts in the precise words, rules 30, 31, 32, and 33 of the rules of September, 1876, under the Trade Marks Registration Acts of 1875 and 1877. Fourteen years not having elapsed since the establishment of the Trade Marks Register, in 1876, there are no cases upon the interpretation of this section. The Comptroller will probably read the word *may* as must, and will deem it his duty to remove the marks from the register if the renewal fee be not paid within the time limited.

(*a.*) The prescribed fee is £1; see Trade Marks Fees (p. 288).

(*b.*) The additional prescribed fee is 10*s.*

(*c.*) The prescribed additional fee is £1.

Refer to Trade Marks Rule 45 (p. 284), and 52 (p. 285),

giving power to Comptroller to enlarge the time for doing any act. Note. Sect. 79.

(*d.*) So as to prevent the registration of a same, or similar mark, during the five years.

Fees.

80. There shall be paid, in respect of applications and registration, and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees for Registration, &c.

Note.—By the Trade Marks Rule 3 (p. 277), the fees payable are those specified in the first schedule thereto, which is printed at p. 288, *infra*.

Sheffield Marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire (*a*), 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:— Registration by Cutlers' Company of Sheffield marks.

(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 cutlery, edge tools, or raw steel, and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel, and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof; and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually

Sect. 81

used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875;

(3.) 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, 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 (*b*); 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 (*c*);

(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 application for registration in the Register of Trade Marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark, shall apply in the case of applications and registration in the Sheffield register; and notice of every entry made in the Sheffield register must be given to the Comptroller by the Cutlers' Company, save

and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow (*d*) 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; Sect. 81.

(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 (*e*), 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 (*f*);

(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;

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that

Sect. 81.

is to say, the fifth section of the Cutlers' Company's Act of 1814 (*g*), 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 (*h*), shall apply to any mark entered in the Sheffield register.

Note.—(*a.*) The Company of Cutlers of Hallamshire, in the County of York, was incorporated by statute in the reign of James I. (1624), since which time the Company has exercised the privilege of assigning trade marks to persons engaged in the cutlery manufacture of the district.

An abridgment of the Acts of Parliament relating to the Company is printed at p. 307.

The above section is adopted from, but alters very considerably, the provisions relating to Sheffield marks, contained in section 5 of the Act of 1875, which, it is stated on the Memorandum upon the Bill which has become the present Act, upon its introduction into the House of Commons, were unworkable. The Cutlers' Company are now to establish a new registry for trade marks used in cutlery, edge tools, raw steel, goods made of steel, or steel or iron combined, whether with or without a cutting edge, by persons carrying on business in Hallamshire, or within six miles thereof. All applications for trade marks in respect thereof are to be made to the Cutlers' Company, at Sheffield, and not to the office in London. And, to make the register complete, all trade marks which have been registered under the Act of 1875, relating to such goods, and belonging to persons carrying on business in Hallamshire, or within six miles thereof, are to be entered in the new register. Upon registration by the Cutlers' Company of a new mark, they are to give notice thereof to the Comptroller at the London office, who is to immediately enter the same on the Register of Trade Marks, such registration to bear date the day of application to the Cutlers' Company.

The Trade Marks Rules 53 to 56, regulate the procedure with regard to applications for register to the Cutlers' Company.

(*b.*) By Trade Marks Rule 54.

(*c.*) The rules are silent as to the mode of appealing. The proper method would be by motion that the Company should proceed to register.

(*d.*) By section 23 of the Cutlers' Company Act of 1791, the widow of any freeman of the Cutlers' Company may use the mark of her deceased husband during her life, or may

sell the right to use it. to any person entitled to carry on the trade; and section 2 of the Cutlers' Company's Act of 1801 enables a freeman to devise his mark by will, subject to the life interest of his widow therein; and by section 3, if he made no will, the mark is to be the property of such of his family or relatives, as may be entitled to use it. Note. Sect. 81.

(*e.*) By Trade Marks Rule 55 (3) p. 286.

(*f.*) It will be necessary, therefore, that the owners of all Sheffield corporate marks should apply for registration of their marks in the Sheffield register within five years from 1st January, 1884, or they will lose their rights in them.

(*g.*) £20 for each offence, half to go to the company, and half to the person whose mark was infringed—See Abridgment, p. 307.

(*h.*) By sections 26 and 27 of the Act of 1791, the penalties can be sued for in any Court of Record, and, by summary proceeding, before justices of the West Riding of Yorkshire or of Derbyshire—See Abridgment, p. 307.

PART V.

GENERAL.

Patent Office and Proceedings thereat.

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office. Patent Office.

(2.) Until a new Patent Office is provided, the offices of the Commissioners of patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the Comptroller may, in his absence, be done by or to

Sect. 82. any officer for the time being in that behalf authorised by the Board of Trade.

Note.—The offices of the Commissioners of Patents are situated at 25, Southampton Buildings, London.

Officers and Clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the Comptroller-General of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of Patent Office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied, or constructive.

Note.—This section is adopted from rule 22 of the rules under the Trade Marks Registration Acts of 1875-1877. It makes an alteration in the law as regards patents. There was nothing in section 35 of the repealed Act of 1852 to prevent the entry of any deed assigning or dealing with a patent containing a trust of any kind in the Register of Proprietors of Patents required to be kept by that section.

Refusal to grant patent, &c., in certain cases.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Note.—As for housebreaking implements or machinery for coining false money.

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 (*a*). The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, license, or dealing (*b*). 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 (*c*).

Sect. 87. Entry of assignments and transmissions in registers.

Note.—The Trade Marks Rules, 34 to 43 (p. 282), regulate the procedure for the entry upon the register of any assignment or other transmission of the property in a trade mark. The Trade Marks Forms J, N, and O, in the second schedule to the Trade Marks Rules (p. 290) are the forms prescribed. The Trade Marks Fees, Nos. 6, 7, 15, and 20 (p. 288), are those payable.

(*a.*) If the Comptroller were not satisfied with proper evidence the Court, under section 90, would order the entry to be made.

(*b.*) Under section 35 of the Patent Law Amendment Act of 1852 (repealed by this Act) the terms of which were:—"Provided always that such entry (of assignment, or license in "the Register of Proprietors) shall have been made, the grantee "or grantees of the Letters Patent shall be deemed and taken "to be the sole and exclusive proprietor or proprietors of such "Letters Patent, and of all the licenses and privileges thereby "given and granted," it was held that an assignee of a patent could not bring an action for an infringement until his assignment had been registered—*Chollett* v. *Hoffman* (7 E. & B., 686; 26 L. J., Q. B., 249). But that it was no ground of objection to the title of an assignee of a patent that the assignors, the executors of the grantee, omitted to register the probate until after the date of the assignment, although it might be an obstacle to the maintenance of an action by the assignee for an

Note. Sect. 87.

infringement if commenced before the registration of the probate—*Ellwood* v. *Christy* (17 C. B., N. S., 754; 34 L. J., C. P., 130).

An assignee of a patent may maintain an action for an infringement, even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee. And an action is maintainable, although there has been no infringement since the defendant has received notice that the entire interest in the patent has become vested in the assignee—*Walton* v. *Lavater* (8 C. B., N. S., 162; 29 L. J., C. P., 275).

An assignee of a separate and distinct portion of a patent may sue alone for an infringement of that part without joining one who has interest in another part; the damages recovered in the action accruing to the former alone—*Dunnicliff* v. *Mallett* (7 C. B., N. S., 209; 29 L. J., C. P., 70).

The assignee of a patent may maintain a suit against the assignor and subsequent licensees of the assignor, with notice of the assignment, to restrain them from using the patent, although, at the time of the institution of the suit, the assignment had not been registered, and the registration of the assignment dates back to the date of the assignment so as to entitle the assignee to maintain an action to restrain an infringement committed between the dates of the assignment and the registration—*Hassall* v. *Wright* (L. R., 10 Eq., 509; 40 L. J., Ch. 145).

(*c*) *Equities may be enforced.* Notice of trusts are not to be entered on the register (section 85), and the person entered on the register as proprietor, who alone can assign or grant licenses, may be a trustee for some other person who is beneficial owner, or in other respects; the patent may be affected with other equities. The clause is to make clear that these provisions are not to do away with those trusts or other equities, but they are to be enforced. For instance, suppose the registered proprietor of a patent is so as trustee for other persons who are beneficial owners, the Court would compel the trustee to grant licenses or to assign the patent for the benefit of his *cestuis qui trust.*

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed (*a*); and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (*b*).

Note.—This section is taken from sections 34 and 35 of *the Patent Act of 1852.* Note. Sect. 88.

(*a.*) See Trade Marks Rule 49 (p. 285), and Trade Marks Fees (p. 289), Nos. 21 and 22.

(*b.*) See Trade Marks Rule 49 (p. 285), and Trade Marks Fees (p. 289), Nos. 23 and 24.

89. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals. Sealed copies to be received in evidence.

Note.—This section is taken from section 4 of 16 and 17 *Vic., c.* 115, *repealed by the present Act.*

The grant of Letters Patent by a foreign country is an act of state, within 14 & 15 Vic., c. 99, section 7 (which makes foreign and colonial acts of state provable by certified copies), and is therefore provable by a copy of the Letters Patent purporting to be sealed with the seal of such foreign state, without proof of the seal or signature or judicial character of the person signing the same—*Re* Betts' Patent (1 Moore P. C. C., 49; 7 L. T., N. S., 577).

90. (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit. Rectification of registers by Court.

(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.

Note. Sect. 90.

Note.—Refer to Trade Marks Rules 43, 46 and 47 (p. 284), and to Form N (p. 294). This section is adopted from 38 of the Patent Law Amendment Act of 1852, and section 4 of the Trade Marks Registration Act, 1875.

The Master of the Rolls by virtue of his office used to exercise a jurisdiction over the entries in the Register of Patents and proprietors of patents, kept under sections 34 and 35 of the Patent Act of 1852. *Re* Horsley & Knighton's Patent (L. R., 8 Eq., 475), but, by the Judicature Acts, 1873 and 1875, such jurisdiction passed to the High Court of Justice—*Re* Morgan's Patent (24 W. R., 245). By section 117 the Court is still the High Court of Justice.

It was held that under section 38 of the Act of 1852, the Court could expunge an entry fraudulently made, and could direct any facts relating to the proprietorship to be entered on the register, but not the legal inferences to be drawn from them. A patentee assigned half a patent to A., and afterwards he assigned the whole to B., by a deed reciting he had already granted a license to work and use it to B. B.'s assignment was first registered. Held that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register that the license referred to in B.'s assignment was the deed of assignment to A. subsequently noticed—*Re* Morey's Patent (25 Beav., 581).

A patentee in 1853 assigned his patent, but the assignees omitted to register it. Afterwards, in August, 1855, the patentee assigned the patent to another person, who registered it the same day. The first assignees registered their assignment a week afterwards. The Court in 1857, on the motion of the first assignees, ordered the register of the second assignment to be expunged and with costs—*Re* Green's Patent (24 Beav., 145).

The Court will, on the motion of the persons aggrieved, correct an entry in the register of proprietors of patents which purports to affect the rights of persons not parties to the deed affected. One of two joint patentees by deed, assigned his interest in the patent to a third person, and released to him all the rights of action against him of both the patentees. Held that the other joint patentee was entitled to have the entry struck out—*Re* Horsley & Knighton's Patent (39 L. J., Ch. 157).

Power for Comptroller to correct

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

Sect. 91. — clerical errors.

(*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.

Note.—See Patents Form P (p. 264) and Trade Marks Form Q (p. 296), and Fees No. 14, as to correction of clerical error, and to Forms O and P (p. 294), and Fees No. 25 as to cancellation of registration.

(*b.*) The Master of the Rolls had power before the Act to correct clerical errors in the Letters Patent—*Re* Nickel's Patent (4 Beav., 563) but the application to do so was required to be promptly made—*Re* Blamond's Patent (3 L. T., N. S., 800), or in the filed engrossment of a specification—*Re* Johnson's Patent (L. R., 5 Ch. D., 503).

By rule 9 of the patent commissioners, under the Act of 1852, of the 15th Oct., 1852, the law officers had power to amend "clerical errors or omissions made *per incuriam*" in provisional specifications. But the above provisions are a great improvement in the law. Clause (*c*) appears to be new.

92. (1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit. Alteration of registered mark.

(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, caused the register to be altered in conformity with the order of leave.

Note. Sect. 92.

Note.—This provision is new, and will prove very useful. For essential particulars see section 64. Refer to Trade Marks Rule 48 (p. 284). The Rules are silent as to the mode of applying to the Court. The best mode will probably be motion and serving a notice thereof on the Comptroller. It might also be made by summons, in analogy to rule 29 (p. 281).

Falsification of entries in registers.

93. If any person made 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.

Note.—This section is adopted from section 37 of the Patent Act of 1852.

Exercise of discretionary power by Comptroller.

94. Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Note.—For prescribed time see Patent Rules 11 and 12 (p. 242), Designs Rules 13 and 14 (p. 267), and Trade Marks Rules 17 and 19 (pp. 279 and 280).

Power of Comptroller to take directions of law officers.

95. The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for direction in the matter.

Note.—The law officers will be bound to give such directions, and apparently, since they will be "directions," the Comptroller will be bound to obey them. The law officers will thus guide the practice under the Act.

Certificate of Comptroller to be evidence.

96. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made

thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone. Sect. 96.

Note.—*Primâ facie evidence* is conclusive evidence in the absence of other and stronger evidence rebutting it. For instance, if a certificate purporting to be signed (under the hand) of the Comptroller were produced, the Court, in the absence of any evidence impeaching it, would be bound to act upon it, but would be bound to hear such evidence if tendered, and if such evidence proved that the certificate was not under the hand of the Comptroller, or that the statements therein were erroneous in any respect, the certificate would not be acted upon.

97. (1.) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and, if so sent, shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. Applications and notices by 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.

Note.—The section is altogether new. To prove the posting of a letter, it is necessary to call the person who actually put it into the post. It is advisable to keep a record of the posting of such letters, and of the persons posting them.

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 (*a*), 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. Provision as to days for leaving documents at office.

Note.—(*a.*) If the last day fixed is a Saturday, the thing may be done on the Monday following.

Sect. 99.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act, or by any rules made under the authority of this Act, then the guardian or committee, if any, of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, (*a*) 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.

Note.—This section is taken from rule 67, under the Trade Marks Registration Acts of 1875 and 1877. Under this section a person may be appointed to make an application for a patent, or take other necessary proceedings in the name of an inventor, who, since making his invention, but before applying for, or completing the patent, has become insane. And similarly with regard to designs and trade marks.

(*a.*) *Any Court or judge possessing jurisdiction in respect of the property of such incapable persons.* The Lord Chancellor is, *ex officio*, the guardian of all insane persons, and his powers are exercised under statute by the Lords Justices of Appeal, or any one of them.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of, or extracts from, any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland, and in

the Isle of Man, without further proof or production of the originals. Sect. 100.

Note.—This section is new.

101. (1.) The Board of Trade may, from time to time, make such general rules, and do such things as they think expedient, subject to the provisions of this Act— Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

(*a.*) For regulating the practice of registration under this Act;

(*b.*) For classifying goods for the purposes of designs and trade marks;

(*c.*) For making or requiring duplicates of specifications, amendment, drawings, and other documents;

(*d.*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade thinks fit, of specifications, drawings, amendments, and other documents;

(*e.*) For securing and regulating the making, printing, publishing, and selling of indexes to, and *abridgments of, specifications and other documents* in the Patent Office; and providing for the inspection of indexes and abridgments and other documents;

(*f.*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad;

(*g.*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2.) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same

Sect. 101.

effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then, next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules, or any of them, ought to be annulled, the same shall, after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule, or to the making of any new rules or rule.

Note.—Section 3 of the Patent Act of 1852 conferred a similar power upon the Commissioners of Patents to make rules; and upon the Lord Chancellor by section 7 of the Trade Marks Act of 1875. The power of making all rules, whether for patent, trade marks or designs is now conferred by the above section upon the Board of Trade. For the Patents Rules made under the powers conferred by this section see p. 241. A list of fees and the forms to be used will be found in the schedules to those rules. For the Designs Rules, List of Fees and Forms, and Classes of Goods, see p. 266. For the Trade Marks Rules, List of Fees and Forms, and Classes of Goods, see p. 277.

Annual reports of Comptroller.

102. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by, or under him, of this Act, to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Note.—Section 3 of the Patent Act of 1852 required the Commissioners of Patents to report annually to Parliament all proceedings under that Act; and section 51 of the same Act required an account of all salaries, fees, and compensation allowances to be laid before Parliament within fourteen days next after they should have been paid or granted.

International and Colonial Arrangements.

Sect. 103. Inter-national arrange-ments for protection of inven-tions, de-signs, and trade marks.

103. (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark;

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark, the registration of which has been duly applied for in the country of origin may be registered under this Act (*a*);

(4.) The provisions of this section shall apply only in

Sect. 103 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.

Note.—(*a.*) "*Any trade mark, the registration of which has "been duly applied for in the country of origin, may be registered "under this Act.*" This apparently means, whether it comes within the definition of a trade mark, contained in section 64, or not. So that any foreign trade mark, registered as such in its country of origin, will be entitled to registration here, on proof of registration in such foreign country without further question, if such foreign country is one to which Her Majesty has, by Order in Council, declared the provisions of the section shall apply.

Provisions for colonies and India.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the

article with the word "patent," "patented," "regis- Sect. 105.
"tered," 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.

Note.—Section 7 of the repealed Act of 1835 (5 & 6 Will. IV., c. 83), imposed a penalty of £50 for each offence—(1) upon any unauthorised person using the name of a patentee; and (2) upon anyone using the words patent, or any word or words of the like kind, to imitate the patentee, or who should, in any other way, imitate the stamp, mark, or device of the patentee. The section concluded with a proviso, that no person should be subject to a penalty for using the word "patent" in respect to anything for which any patent "before obtained shall have "expired."

The only reported case in which the penalty appears to have been sued for, is *Myers* v. *Baker* (3 H. & N., 802; 28 L. J., Ex. 90), which decided that it was no defence to an action under this section, that the invention was not new, and the patent, therefore, invalid; but that it was necessary for the plaintiff to prove that the intention of the defendant was to imitate the plaintiff's stamp or mark. The section being now repealed, the protection it gave the patentee is removed, but very little use was ever made of it.

The above section does not apply to a person infringing a patent or copyright by selling goods protected thereby. The remedy for that is by action for infringement. Nor does the section apply to a person using the words mentioned to describe an article, which has been (but is no longer) protected by a patent or a registered copyright, or by a design which has expired.

Section 7 of the Merchandise Marks Act, 1862, imposes a penalty of £5 for every offence, for falsely indicating that any article or the mode of manufacturing the same, or the ornamentation or configuration thereof, is the subject of any existing patent, privilege, or copyright. The continuance of the use of the word patent upon articles after the expiration of a patent if for the purpose of falsely indicating that the article in question is the subject of an existing patent, would come within this provision.

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 Penalty on unauthorised assumption

Sect. 106. — of Royal arms.

any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable, on summary conviction, to a fine not exceeding twenty pounds.

Note.—This provision is new. It has apparently a very sweeping operation, as it renders liable to a fine of £20, to be recovered summarily before a police magistrate or magistrates at Petty Sessions, any person who uses the Royal arms, or any arms in imitation of the Royal arms "*in connection with any trade, business, calling, or profession*," unless they can prove the authority of Her Majesty or some member of the Royal Family, or of some Government Department, to do so. Probably very few, indeed, out of the numbers of persons who use the Royal arms are in a position to prove such authority. The sweeping operation of the section is probably controlled by the provision that the person charged must do so in such a manner as to be calculated to lead other persons to believe he is carrying on his trade, &c., under such Royal authority. The putting up the Royal arms over a shop is usually understood to mean that the shopkeeper claims to have had the honour of having been patronised by royalty; and if this view be taken by the magistrates they are not likely to hold that such a use of the Royal arms is calculated to make reasonable people believe the business is being carried on by any special Royal authority. In one sense, of course, everyone carries on his lawful calling by "Royal authority," because he is entitled to the protection of the executive power, which is the "Royal authority" acting through the Ministers of the Crown, to enable him to do so.

Scotland, Ireland, &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Sect. 108. Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Note.—The provision of sub-section 2 is taken from sections 35 and 43 of the Patent Act of 1852.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

Note.—This is taken from section 29 of the Patent Act of 1852.

General saving for jurisdiction of Courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the register accordingly.

Sect. 112.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts;

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man, which would in England be punishable on summary conviction, may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction, may for the time being be prosecuted.

Repeal, Transitional Provisions, Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the third schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*a.*) Affect the past operation of any of those enactments, or any patent or copyright, or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or,

(*b.*) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or,

(*c.*) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Sect. 114. — Former registers to be deemed continued.

114. (1.) The Registers of Patents and of Proprietors kept under any enactment repealed by this Act, shall respectively be deemed parts of the same book as the Register of Patents kept under this Act (*a*).

(2.) The Registers of Designs (*b*) and of Trade Marks (*c*) kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of Designs and the Register of Trade Marks kept under this Act.

Note.—(*a.*) The Register of Patents, kept under section 34, and the Register of Proprietors, kept under section 35 of the Patent Act of 1852.

(*b.*) The Register of Designs, kept under the Designs Act of 1842 (Ornamental, 5 & 6 Vic., c. 100); and 1843 (Useful, 6 & 7 Vic., c. 65).

(*c.*) The Register of Trade Marks, kept under the Trade Marks Act of 1875 (38 & 39 Vic., c. 91).

Saving for existing rules.

115. All general rules made by the Lord Chancellor, or by any other authority, under any enactment repealed by this Act, and in force at the commencement of this Act, may, at any time after the passing of this Act, be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with, and are not superseded by, this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any Letters Patent, or to the withholding of a grant thereof.

Note.—This re-enacts the first clause of section 16 of the Patent Act of 1852.

Notwithstanding section 27, which enacts that a patent shall have the like effect against the Crown as against a subject, the above section would enable the insertion in a patent of a clause requiring the patentee to permit the Crown the free use of the invention, without payment, or any other restrictive clause.

General Definitions.

Sect. 117.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires—

"Person" includes a body corporate;

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England;

"Law officer" means Her Majesty's Attorney-General or Solicitor-General for England;

"The Treasury" means the Commissioners of Her Majesty's Treasury;

"Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks;

"Prescribed" means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act;

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act;

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary "conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORM OF APPLICATION, &c.

FORM A.

FORM OF APPLICATION FOR PATENT.

[Superseded by Forms A and A1 in the Schedules to the Patent Rules, pp. 257, 258.]

FORMS B & C.

FORMS OF PROVISIONAL AND COMPLETE SPECIFICATIONS.

[Superseded by Forms B and C in the Schedules to the Patents Rules, pp. 258, 259.]

FORM D.

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 Seiving 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 license, 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, license, 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 may 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 licenses 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 .

FORM E.

FORM OF APPLICATION FOR REGISTRATION OF DESIGN.

[Superseded by Form E in the Second Schedule to the Designs Rules, p. 273.]

FORM F.

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

[Superseded by Form F in the Schedule to the Trade Marks Rules, p. 290.]

THE SECOND SCHEDULE.

Fees on instruments for obtaining Patents, and Renewal.

[Superseded by the List of Fees in the Schedule to Patent Rules, p. 255.]

THE THIRD SCHEDULE.

Enactments repealed.

21 James I., c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. IV., c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. IV., c. 83. [1835.]	An Act to amend the law touching Letters Patent for inventions.
2 & 3 Vic., c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An "Act to amend the law touching "Letters Patent for inventions."
5 & 6 Vic., c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of

	designs for ornamenting articles of manufacture.
6 & 7 Vic., c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.
7 & 8 Vic., c. 69. (*a*) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled "An Act for "the better administration of justice "in His Majesty's Privy Council, "and to extend its jurisdiction and "powers." In part; namely,— Sections two to five, both included.
13 & 14 Vic., c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vic., c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vic., c. 5. [1853.]	An Act to substitute stamp duties for fees on passing Letters Patent for inventions, and to provide for the purchase, for the public use, of certain indexes of specifications.
16 & 17 Vic., c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of Letters Patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vic., c. 70. [1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of

(*a*.) NOTE.—Sections 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

	designs for ornamenting articles of manufacture.
22 Vic., c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vic., c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vic., c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vic., c. 27. [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vic., c. 97. [1870.]	The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the Schedule the words and figures. "Certificate of the registration of a "design . . . £5 0 0. And see "section 65."
38 & 39 Vic., c. 91. [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vic., c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vic., c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vic., c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vic., c. 10. [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vic., c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

CHAPTER VI.

SECTION I.

PATENTS RULES.

By virtue of the provisions of the Patents, Designs and Trade Marks Act, 1883, the Board of Trade do hereby make the following rules:—

1. These rules may be cited as the Patents Rules, 1883. Short title.

2. These rules shall come into operation from, and immediately after, the 31st day of December, 1883. Commencement.

3. In the construction of these rules, any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively. Interpretation.

4. The fees to be paid under the above-mentioned Act, in addition to the fees mentioned in the second schedule thereto, so far as it relates to patents, shall be those specified in the list of fees in the first schedule to these rules. Fees.

Forms.

5. The forms A, B, and C in the first schedule to the said Act shall be altered or amended by the substitution therefor respectively of the forms A, A1, B, and C in the second schedule hereto. Forms. Alterations.

6. (1.) An application for a patent shall be made either in the form A or the form A1 set forth in the second schedule hereto, as the case may be. Application.

(2.) The form B in such schedule of provisional specification, and the form C of complete specification, shall respectively be used. Specification.

(3.) The remaining forms set forth in such schedule may, as far as they are applicable, be used in any proceedings under these rules. Other forms.

General.

7. The Patent Office shall be open to the public every week-day during the hours of ten and four, except on the days and times following:— Hours of business.

Christmas Day.
Good Friday.

The day observed as Her Majesty's birthday.

The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Agency. 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.

Statement of address. 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.

Size, &c., of documents. 10. All documents and copies of documents 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 in the English language, upon strong, wide, ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of 2 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 copies shall at any time be left, if required by the Comptroller.

Exercise of discretionary power by Comptroller. Notice of hearing. 11. Before exercising any discretionary power given to the Comptroller by the said Act adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally, or by his agent, before the Comptroller.

(See section 91.)

Notice by applicant. 12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

Comptroller may require statement, &c. 13. Whether the applicant desires to be heard or not, the Comptroller may, at any time, require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

14. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby. Decision to be notified to parties.

15. The term "applicant" in rules 11, 12, and 13 shall include an applicant whose specification bears a title the same as, or similar to that of the specification of a prior applicant, and has been reported on by the examiner. Definition of "applicant."

16. Such prior and second applicant respectively may attend the hearing of the question whether the invention comprised in both applications is the same, but neither party shall be at liberty to inspect the specification of the other. Prior and second applicant may attend hearing.

17. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after having obtained from the Board of Trade a certificate that the exhibition is an industrial or international one, give to the Comptroller seven days' notice of his intention to exhibit, publish, or use the invention, as the case may be. Industrial or International Exhibitions.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the applicant shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

18. Any document 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 and on such terms as the Comptroller may think fit. Power of amendment, &c.

19. 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. Documents by post.

In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

Affidavits.

20. Affidavits may, except where otherwise prescribed by these rules, be used as evidence in any proceedings thereunder when sworn to in any of the following ways, viz. :—

(1.) In the United Kingdom before any person authorised to administer oaths in the Supreme Court of Judicature or before a justice of the peace for the county or place where it is sworn or made;

(2.) In any place in the British dominions out of the United Kingdom before any court, judge, or justice of the peace, or any person authorised to administer oaths there in any court;

(3.) In any place out of the British dominions before a British minister, or person exercising the functions of a British minister, or a British consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a judge or magistrate.

Statutory declarations.

21. Where any statutory declaration prescribed by these rules, or used in any proceedings thereunder, is made out of the United Kingdom, the words, "and by virtue of the "Statutory Declarations Act, 1835," must be omitted, and the declaration shall (unless the context otherwise requires) be made in the manner prescribed in rule 20, sub-section (3).

Application with Provisional or Complete Specification.

Order of recording applications.

22. Applications for a patent sent by prepaid letter through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Applications left at the Patent Office otherwise than through the post shall be, in like manner, numbered in the order of their receipt at the Patent Office.

Application for separate patents by way of amendment.

23. 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 bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Act and by these rules as if every such application had been originally made on that date for one invention only.

Application by

24. 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. Representative of deceased inventor.

25. On the acceptance of an application with 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. Notice and advertisement of acceptance.

26. Upon the publication of such advertisement of acceptance, in the case of an application with 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. Inspection on acceptance of complete specification.

Application on communication from Abroad.

27. An application for a patent for an invention communicated from abroad shall be made in the form A1 set forth in the second schedule hereto. Communication from abroad.

Sizes and Methods of Preparing Drawings accompanying Provisional or Complete Specifications.

28. The drawings accompanying provisional or complete specifications shall be made upon half-sheets or sheets of imperial drawing paper, to be within a border line of 19 inches by 12 inches, or 27 inches by 19 inches, with a margin of half an inch all round. Size of drawings.

29. A copy of the drawings will be required upon *rolled* imperial drawing paper, or upon thin Bristol board of the same dimensions as the original drawing or drawings. All the lines must be absolutely black, Indian ink of the best quality to be used, and the same strength or colour of the ink maintained throughout the drawing. Any shading must be in lines clearly and distinctly drawn, and as open as is consistent with the required effect. Section lines should not be too closely drawn. No colour must be used for any purpose upon the copy of the drawings. All letters and figures of reference must be bold and distinct. The border line should be one fine line only. The drawings must not be folded, but must be delivered at the Patent Office either in a perfectly flat state or rolled upon a roller, so as to be free from creases or breaks.* Copies of drawings.

---

* As the drawings accompanying the provisional and complete specification respectively are copied at the Patent Office for publication by the process of photo-lithography, this rule must be strictly observed, in order that correct copies may be made.

30. Where a complete specification is left at the Patent Office after a provisional specification has been accepted, the complete specification and drawing or drawings accompanying the same, as well as the copy thereof, must be prepared in accordance with rules 10, 28, and 29.

Illustrated Journal.

Additional drawing to be furnished.

31. Every applicant for the grant of a patent shall, in addition to the drawings to be furnished with his complete specification, furnish the Comptroller with a drawing illustrative of the feature or features of novelty constituting his invention. Such drawing must be prepared in the manner prescribed for the copy of the original drawing or drawings accompanying the specification, but must not cover a space exceeding 16 square inches. The drawing must be accompanied by a concise explanatory statement on foolscap paper, and legibly written or printed.

Opposition to Grants of Patents.

Notice of opposition.

32. A notice of opposition to the grant of a patent shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the grant, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

Copy for applicant.

33. On receipt of such notice, a copy thereof shall be furnished by the Comptroller to the applicant.

Particulars of prior patent.

34. 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 title, number, and date of the patent granted in such prior application shall be specified in the notice.

Opponent's evidence.

35. Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent shall leave at the Patent Office statutory declarations in support of his opposition, and deliver to the applicant a list thereof.

Applicant's evidence.

36. Within fourteen days from the delivery of such list, the applicant shall leave at the Patent Office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the

Evidence in reply.

opponent shall leave at the Patent Office his statutory declarations in reply, and 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.

Closing of evidence.

37. 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 made to him for that purpose.

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

Notice of hearing.

39. On the completion of the evidence, the Comptroller shall appoint a time for the hearing of the case, and shall give to the parties seven days' notice at the least of such appointment.

Disallowance of opposition in certain cases.

40. 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 title, number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition.

Decision to be notified to parties.

41. The decision of the Comptroller in the case shall be notified by him to the parties.

Certificates of Payment or Renewal.

Payment of fees of £50 and £100 for continuance of patent.

42. If a patentee intents, at the expiration of the fourth or eighth year from the date of his patent, to make the prescribed payment for keeping the same in force, he shall seven days at least before such expiration give notice to the Comptroller of such intention, and shall, before the expiration of such fourth or eighth year, as the case may be, leave at the Patent Office a form of certificate of payment, duly stamped, subject as hereinafter provided, with the prescribed fee of £50 or £100, as the case may be.

As to patents granted before commencement of Act.

43. In the case of patents granted before the commencement of the said Act, the above rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."

Payment of annual fees in lieu of £50 and £100.

44. If the patentee intends to pay annual fees in lieu of the above-mentioned fees of £50 and £100, he shall, seven days at least before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the thirteenth year thereof, give notice to the Comptroller of such intention, and shall, before the expiration

of such respective periods as aforesaid, leave at the Patent Office a form of certificate of payment, duly stamped with the fee prescribed to be paid at such periods respectively.

Certificate of payment.

45. On due compliance with those rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall give to the patentee a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

46. 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.

In other cases.

47. 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.

Amendment of Specification.

Request for leave to amend.

Advertisement.

48. A request for leave to amend a specification shall be signed by the applicant or patentee and accompanied by a 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.

Notice of opposition.

49. 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 shall be signed by him. Such notice shall state his address for service in the United Kingdom.

Copy for the applicant.

50. On receipt of such notice a copy thereof shall be furnished by the Comptroller to the applicant or patentee, as the case may be (hereinafter called the applicant).

Opponent's evidence.

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

Further proceedings.

52. Upon such declarations being left, and such list being delivered, the provisions of rules 36, 37, 38, and 39 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Decision to be notified to parties.

53. The decision of the Comptroller in the case shall be notified by him to the parties.

Requirements thereon.

54. 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, 21, and 29.

Leave by Order of Court.

55. 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.

Advertisement of amendment.

56. 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.

Compulsory Licenses.

Petition for compulsory grant of licenses

57. A petition to the Board of Trade for an order upon a patentee to grant a license 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.

To be left with evidence at Patent Office.

58. 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.

Directions as to further proceedings unless petition refused.

59. 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.

Procedure.

60. 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

Petitioner's evidence.

petition and of the affidavits, or statutory declarations and other documentary evidence, if any, tendered in support thereof.

Patentee's evidence.

61. 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.

Evidence in reply.

62. 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 petitioner; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

Further proceedings.

63. Subject to any further directions which the Board 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.

Register of Patents.

Entry of grant.

64. 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.

Request for entry of subsequent proprietorship.

65. 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.

Signature of request.

66. 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.

Particulars to be stated in request.

67. 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.

68. 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. Production of documents of title and other proof.

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.

69. There shall also be left with the request an examined copy of the assignment or other document above required to be produced. Copies for Patent Office.

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 examined copy.

70. A body corporate may be registered as proprietor by its corporate name. Body corporate.

71. 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 section 90 of the said Act, 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. Entry of Orders of the Privy Council or of the Court.

72. Upon the issue of a certificate of payment under rule 45, 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. Entry of payment of fees on issue of certificate.

73. 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. Entry of failure to pay fees.

74. An examined copy of every license granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the Comptroller may direct, and the original license shall, at the same time, be produced and left at the Patent Office, if required, for further verification. Entry of licenses.

Hours of inspection of register.

75. 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 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.

Certified copies of documents.

76. Certified copies of any entry on 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.

Power to Dispense with Evidence, &c.

77. 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 anybody 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.

Repeal.

Repeal.

78. All general rules made by the Lord Chancellor, or by any other authority, under the Patent Law Amendment Acts, and in force on the 31st day of December, 1883, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to any application then pending.

Dated the 21st day of December, 1883.

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

Rules Regulating the Practice and Procedure on Appeals to the Law Officers.

I. 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 Act, he shall, within fourteen days from the date of the decision appealed against file in the Patent Office, a notice of such his intention.

II. 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.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' 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.

IV. 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.

V. No appeal shall be entertained of which notice is 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.

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

VII. 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.

VIII. 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.

IX. 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.

X. 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.

XI. 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.

XII. 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 sect[illegible] of the Act.

XIII. 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.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.G.
FARRER HERSCHELL, S.G

FIRST SCHEDULE.

LIST OF FEES PAYABLE ON AND IN CONNECTION WITH LETTERS PATENT.

Up to Sealing.

	£	s.	d.	£	s.	d.
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 license. By person applying	5	0	0			
13. On opposition to grant of compulsory license. By patentee	5	0	0			
14. On certificate of renewal :— Before end of 4 years from date of patent	50	0	0			
15. Before end of 7 years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act, 1883," before the end of 8 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. Before the expiration of the 5th year from the date of the patent	10	0	0			

		£	s.	d.
18.	Before the expiration of the 6th year from the date of the patent	10	0	0
19.	Before the expiration of the 7th year from the date of the patent	10	0	0
20.	Before the expiration of the 8th year from the date of the patent	15	0	0
21.	Before the expiration of the 9th year from the date of the patent	15	0	0
22.	Before the expiration of the 10th year from the date of the patent	20	0	0
23.	Before the expiration of the 11th year from the date of the patent	20	0	0
24.	Before the expiration of the 12th year from the date of the patent	20	0	0
25.	Before the expiration of the 13th year from the date of the patent	20	0	0
	On enlargement of time for payment of renewal fees :—			
26.	Not exceeding 1 month	3	0	0
27.	„ 2 months	7	0	0
28.	„ 3 months	10	0	0
29.	For every entry of assignment, transmission, agreement, license 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 section 39 . . .	0	10	0
32.	Search or inspection fee . . . . each	0	1	0
33.	For office copies . . . every 100 yards (but never less than one shilling)	0	4	0
34.	„ of drawings, cost according to agreement.			
35.	For certifying office copies, M.SS. or printed each	0	1	0
36.	On request to Comptroller to correct a clerical error	0	5	0
37.	For certificate of Comptroller under section 96	0	5	0
38.	For altering address in register . . .	0	5	0

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

21st December, 1883.

Approved : (Signed) CHARLES C. COTES,
HERBERT J. GLADSTONE,
Lords Commissioners of
Her Majesty's Treasury.

4th December, 1883.

THE SECOND SCHEDULE.

FORMS.

Form A.

Application for Patent.

(*a*.)

, do solemnly and sincerely declare that in possession of an invention for (*b*)

that 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 for the said invention.

And make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*c*)

Declared at (*d*) in the this day of 18 .

Before me,

(*e*)

[Declared at (*d*) in the this day of 18 .

Before me,

(*e*)

(*f*)]

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

(*b*) Here insert title of invention.

(*c*) Signature of applicant or applicants.

(*d*) If declared by more than one applicant, and at different times or places, insert after "Declared" the words "by the above-named."

(*e*) Signature and title of the person before whom the declaration is made.

(*f*) If not required as in note (*d*), strike out part within brackets.

NOTE.—Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory "Declarations Act, 1835," must be omitted, and the declaration must be made before a British Consular Officer, or, where it is not reasonably practicable to make it before such officer, then before a public officer duly authorised in that behalf.

Form A1.

Application for Patent for inventions communicated from Abroad.

I (*a*)

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

of in the County of do solemnly and sincerely declare that I am in possession of an invention for

(*b*) Here insert title of invention.

(*b*)

which invention has been communicated to me from abroad 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 this realm 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.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*d*) Signature of applicant.

(*d*)

Declared at in the County of this day of 18 .

Before me,

(*e*) Signature and title of the officer before whom the declaration is made.

(*e*)

NOTE.—Where the above declaration is made out of the United Kingdom the words "and by virtue of the Statutory "Declarations Act, 1835," must be omitted; and the declaration must be made before a British consular officer, or, where it is not reasonably practicable to make it before such officer, then before a public officer duly authorised in that behalf.

To be issued with Form A or A1.

Form B.

Provisional Specification (To be furnished in Duplicate).

(*a*) Here insert title, as in declaration.

(*a*)

(*b*) Here insert name, full address, and calling of applicant or applicants, as in declaration.

(*b*)

do hereby declare the nature of said invention for 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 ."

Form C.

Complete Specification (To be furnished in Duplicate—one unstamped).

(*a*)

(*b*)

do hereby declare the nature of invention for and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (*c*) :—

(*a*) Here insert title, as in declaration.

(*b*) Here insert name, full address, and calling of applicant or applicants, as in declaration.

(*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 ."

Form D.

Form of opposition to grant of patent (to be accompanied by an unstamped copy).

*I

hereby give notice of my intention to oppose the grant of

* Here state name and full address.

Letters Patent upon application No. of ,
applied for by
upon the ground†

† Here state upon which of the grounds of opposition permitted by section 11 of the Act the grant is opposed.

(Signed)‡

‡ Here insert signature of opponent or agent.

To the Comptroller, Patent Office.

Form E.

Form of Application for hearing by the Comptroller.

In Cases of Refusal to Accept, Opposition, or Applications for Amendments, &c.

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.

Sir, Your obedient Servant,

To the Comptroller, Patent Office.

Form F.

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.

(Signed)

To the Comptroller, Patent Office.

Form G.

Form of Opposition to Amendment of Specification or Drawings (To be accompanied by an unstamped copy).

* Here state name and full address of opponent.

† Here state reason of opposition.

*

hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. of 188 for the following reason: †

(Signed)

To the Comptroller, Patent Office.

Form H.

Form of Application for Compulsory Grant of License (To be accompanied by an unstamped copy).

*

hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a license to me by †

* Here state name and full address of applicant.

† Here state name and address of patentee, and number and date of his patent.

(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.

Form H1.

Form of Petition for Compulsory Grant of Licenses.

To the Lords of the Committee of Privy Council for Trade.

The petition of (*a*) of in the County of , being a person interested in the matter of this petition as hereinafter described,

(*a*) Here insert name, full address, and description.

Sheweth as follows:—

1. A patent dated No. was duly granted to for an invention of (*b*)

(*b*) Here insert title of invention.

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 licenses 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 licenses 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.

Form I.

Form of Opposition to Compulsory Grant of License.

*
hereby give notice of objection to the application of for the compulsory grant of a license under Patent No. of 188 .

* Here state name and full address.

(Signed)

To the Comptroller, Patent Office.

Form J.

Application for Certificate of Payment or Renewal.

hereby transmit the fee prescribed for the continuation in force of Patent No. , of 18 , for a further period of .

* Here insert name and full address of patentee or his agent.

Name*
Address

To the Comptroller, Patent Office.

Certificate of Payment or Renewal.

Letters Patent No. of 188 .

18 .

This is to certify that did this day of 18 , make the prescribed payment of £ in respect of a period of from , and that by virtue of such payment the rights of remain in force.*

* See section 17 of the Patents, Designs, and Trade Marks Act, 1883.

[Seal.]

Patent Office, London.

Form K.

Form of Application for Enlargement of Time for Payment of Renewal Fee.

SIR,

I hereby apply for an enlargement of time for

month in which to make the payment of
£ upon my Patent No. ,
of 188 .

I am,
Sir,
Your obedient Servant,

(a)

To the Comptroller, Patent Office.

(a) Here insert full address, to which receipt is to be sent.

Form L.

Form of Request to Enter Name upon the Register of Patents, and of Declarations in support thereof.

I (a),

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)

(a) *Or* We. Here insert name, full address, and description.
(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, &c., of Patentee or Patentees.
(g) Here insert title of the invention.
(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 examined copy thereof (j).

I am, Sir, your obedient Servant,

To the Comptroller, Patent Office.

(i) Here insert the nature of the document.
(j) Whereany document which is a matter of record is required to be left, a certified or official copy in lieu of an examined copy must be left.

Form M.

Form of Request to enter Notification of License in the Register of Patents.

SIR,

I hereby transmit an examined copy of a license

granted to me by
under Patent No. of 188 , as well as the original license 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.

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‡

* 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.

I beg therefore to apply for the issue of a duplicate of such Letters Patent.§

[Signature of Applicant.]

To the Comptroller, Patent Office.

Form O.

Notice of Intended Exhibition of an Unpatented Invention.

* Here state name and full address of applicant.

*

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 Act of 1883.

† State "opened" or "is to open."

‡ Insert brief description of invention, with drawings if necessary.

‡ herewith enclose

(Signed)

To the Comptroller, Patent Office.

Form P.

Form of Request for Correction of Clerical Error.

Sir,

I hereby request that the following clerical error

(*a*) may be corrected in (*b*)
Signature
Full Address
To the Comptroller, Patent Office.

(*a*) *Or* errors.
(*b*) Here state whether in application, specification, or register.

Form Q.

Certificate of Comptroller-General.

Patent Office,
London, 188 .

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

---

Form R.

Form of Notice for Alteration of an Address in Register.

Sir,

(*a*)
hereby request that address now upon the Register may be altered as follows :—
(*b*)

Sir,
Your obedient Servant,

To the Comptroller, Patent Office.

(*a*) Here state name or names and full address of applicant or applicants.
(*b*) Here insert full address.

Form S.

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*)

Sir,
Your obedient Servant,

To the Comptroller, Patent Office.

(*a*) Here state name and full address of applicant.
(*b*) Here state the purport of the order.

Form T.

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
188 , whereby he (*c*)
No. (*d*) of the year 188 (*d*)
Signature
Date

N.B.—This notice has to 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.

(*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.

SECTION II.

Designs Rules.

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, the Board of Trade do hereby make the following rules:—

1. These rules may be cited as the Designs Rules, 1883, and shall come into operation from and immediately after the 31st day of December, 1883.

Interpretation. 2. In the construction of these rules, any words herein used defined by the said Act, shall have the meanings thereby assigned to them respectively.

Fees. 3. The fees to be paid under the said Act, so far as it relates to applications for and registration of designs, shall be the fees specified in the first schedule hereto.

Forms.

Forms. 4. An application for the registration of a design shall be made in the Form E in the second schedule hereto. The remaining forms in such schedule may be used in all cases to which they are applicable.

Classification of Goods.

Classification of goods. 5. For the purposes of the registration of designs and of these rules, goods are classified in the manner appearing in the third schedule hereto.

Application for Registration.

Agents. 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.

Address of Comptroller. 7. An application for the registration of a design shall, with the prescribed fee, 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.

(In schedule of fees, see p. 272.)

Size of papers. 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.

Sketches and drawings. Nature of design.

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.

Acknowledgment to applicant.

10. On receipt of an application for registration, the Comptroller shall send to the applicant an acknowledgment thereof.

Notice of registration.

11. 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.

Applications may be sent by post.

12. 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.

Hearing by Comptroller.

13. Before exercising any discretionary power given to the Comptroller by the said Act adversely to an applicant for registration of a design, the Comptroller shall give him ten days' notice of the time when he may be heard personally or by his agent before the Comptroller.

(See section 94, p. 222.)

Hearing by Comptroller.

14. Within five days from the date when such notice would be delivered in the ordinary course of post, the

applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

Notification of Comptroller's decision.

15. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Appeal to the Board of Trade.

Notice of appeal to Board of Trade.

16. 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. 273.)

Statement on appeal.

17. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

Notice to Secretary of Board of Trade.

18. 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.

Directions by Board of Trade.

19. 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 of the Board of Trade.

Notice of time of hearing.

20. 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.

Register of Designs.

(See section 55, p. 184.)

Registering design.

21. 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.

Subsequent proprietors.

22. 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 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.

(See section 55, and note thereto.)

23. 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. Signature to request.

24. 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. Particulars in request.

25. 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. Statutory declaration with request.

(The Form of Request is Design Form K, p. 274.)

26. The claimant shall furnish to the Comptroller such other proof of title as he may require for his satisfaction. Proof of title if required.

27. A body corporate may be registered as proprietor by its corporate name. Corporate name.

28. Where an order has been made by the Court, under section 90 of the said Act, 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. Notice of order of Court.

Power to Dispense with Evidence.

29. Where under these Rules any person is required to do any act or thing, or to sign any document, or 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 Comptroller's discretion as to evidence.

such other evidence and subject to such terms as they may think fit, to dispnse with any such act or thing, document, declaration, or evidence.

Amendments.

Amendments.

30. Any document, drawings, sketches, or tracings 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.

Enlargement of Time.

Enlargement of time.

31. 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 terms as he may direct.

Marking Goods.

Registration mark.

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 "REG^{D}".

(See section 51, p. 182.)

Inspection.

Office hours.

33. On such days and during such hours as the Comptroller shall from time to time determine and notify by a placard posted at the Patent Office, any person paying the prescribed fee may, on production of the number of any design of which the copyright has ceased, inspect such design, and any person paying the prescribed fee may take a copy or copies of such design.

(See section 52, sub-section 2. Fee for inspection, 1s. per quarter of an hour, see Design Fees p. 272.)

Certificate by Comptroller.

Certificate in legal proceeding.

34. 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.

(See Schedule of Fees, p. 272.)

Searches on Production of Sketch of Design.

Search. 35. The Comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the Patent Office after the commencement of the Act, 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 design applied to such goods and registered since the commencement of the Act.

(See section 52, sub-section 1, p. 183.)

Industrial and International Exhibitions.

Notice of exhibition. 36. Any person desirous of exhibiting a design, or any article to which a design has been applied, at an industrial or international exhibition, or of publishing a description of a design during the period of the holding of the exhibition, shall, after having obtained from the Board of Trade a certificate that the exhibition is an industrial or international one, give to the Comptroller seven days' notice in writing of his intention to exhibit the design or article, or to publish a description of the design, as the case may be.

For the purpose of identifying the design in the event of an application to register the same being subsequently made, the applicant shall furnish to the Comptroller a brief description of the nature of the design, accompanied by a sketch or drawing thereof, and such other information as the Comptroller may in each case require.

(See Form L, p. 257.)

Repeal.

Repeal of previous rules. 37. All general rules and regulations made by any authority under the Acts relating to the Copyright of Designs, and in force on the 31st December, 1883, shall be, and they are hereby repealed as from that date without prejudice nevertheless to any application then pending.

J. CHAMBERLAIN,
President of the Board of Trade.

21st December, 1883.

SCHEDULES.

FIRST SCHEDULE.

Fees.

	£	s.	d.
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 of which the copyright has expired . . 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 section 53 . .	0	5	0
13. On request to enter new address . . .	0	5	0
14. For office copy . . . . every 100 words (but never less than one shilling)	0	0	4
15. For certifying office copies, M.SS. 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.

J. CHAMBERLAIN,
President of the Board of Trade.

Approved:

Charles C. Cotes,
Herbert J. Gladstone,
Lords Commissioners of
Her Majesty's Treasury.

4th December, 1883.

SECOND SCHEDULE.

FORMS.

Form E.

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

Statement of nature of design (*b*)

(*a*) Here insert legibly the name, address, and description of the individual or firm.

(*b*) Such as whether it is applicable for the pattern or for the shape.

(*c*) To be signed by the applicant.

(*c*) (Signed)

Dated the day of 188 .

To the Comptroller, Patent Office, Designs Branch.

Form F.

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,

The Comptroller, Patent Office, Designs Branch.

(*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.

Form G.

Certificate of Registration of Design.

(Rᴰ 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 Act, 1883, in respect of the application of such design to articles in class , for which a copyright of five years is granted.

Form H.

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 188 .

To the Comptroller, Patent Office, Designs Branch.

Form I.

Request for Certificate for use in Legal Proceedings.

SIR,

I hereby request you to send me for the purposes 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.

(*b*) Here state the entry, matter, or thing which the writer wishes certified.

a certificate that the design of which a copy is herein enclosed was (*b*)

(Signed)

day of 188 .

To the Comptroller, Patent Office, Designs Branch.

Form J.

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 188 .

Comptroller.

Patent Office, Designs Branch.

Form K.

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.

[*b*] My or our.

[*c*] Or names.

[*d*] I am, or We are.

hereby request that you will enter (*b*) name (*c*) in the Register of Designs as proprietor of the Design No. in Class .

(*d*) entitled as to the said design

(*e*)

[*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."

(*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.

[*f*] This paragraph is not required when the declaration is made out of the United Kingdom.

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*)

[*g*] To be signed here by the person making the declaration.

Declared at
this day of 188 .
Before me,

(*h*)

[*h*] Signature and title of the authority before whom the declaration is made.

To the Comptroller, Patent Office, Designs Branch.

Form L.

Notice of Intended Exhibition of an Unregistered Design.

(*a*)

(*a*) Here state name and address of applicant.

hereby give notice of my intention to exhibit a
of at the
Exhibition, which (*b*)
of 188 , under the provisions of the Patents, Designs, and Trade Marks Act of 1883
(*c*)
herewith enclose a

(*b*) State "opened" or "is to open."

(*c*) Insert brief description of design, with drawing.

(Signed)
Dated the day of 188 .
To the Comptroller, Patent Office, Designs Branch.

Form M.

Request for Correction of Clerical Error or for Entry of New Address.

SIR,

I hereby request that
(Signed)
Dated the day of 188 .
To the Comptroller, Patent Office, Designs Branch.

THIRD SCHEDULE.

Classification of Articles of Manufacture and Substances.

Classes.		
1.	Articles composed wholly or partly of metal, not included in class 2.	
2.	Jewellery.	
3.	Articles composed wholly or partly of wood, bone, ivory, papier maché, or other solid substances not included in other classes.	
4.	,, ,,	glass, earthenware or porcelain, bricks, tiles, or cement.
5.	,, ,,	paper (except hangings).
6.	,, ,,	leather, including binding, of all materials.
7.	Paper hangings.	
8.	Carpets and rugs in all materials, floorcloths, and oil-cloths.	
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.	,, ,,	handkerchiefs and shawls.

21st December, 1883.

J. CHAMBERLAIN,
President of the Board of Trade.

SECTION III.

TRADE MARKS RULES.

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, the Board of Trade do hereby make the following rules :—

1. These rules may be cited as the Trade Marks Rules, 1883, and shall come into operation from and immediately after the 31st day of December, 1883.

2. In the construction of these rules any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively. Interpretation.

(Refer to section 117, *supra*, for Definition.)

3. The fees to be paid in pursuance of the said Act, so far as it relates to trade marks, shall be the fees specified in the first schedule relating hereto. Fees.

(*Infra*, p. 288.)

4. The Form F in the first schedule to the said Act shall be altered or amended by the substitution therefor of the Form F in the second schedule to these rules. Forms.

5. (1) An application for registration of a trade mark shall be made in the form F in the second schedule to these rules; (2) The remaining forms in such schedule may be used in all cases to which they are applicable.

(For second schedule, see p. 290, *infra*.)

Classification of Goods.

6. For the purposes of trade marks registration and of these rules goods are classified in the manner appearing in the third schedule hereto. Classification of goods.

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller.

(For third schedule, see p. 299, *infra*.)

Application for Registration.

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. Application by firm.

If the application be made by a body corporate, it may be signed by the Secretary or other principal officer of such body corporate.

Agency.

8. 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.

(See section 62, p. 190, *supra*.)

Acknowledgment of application.

9. On receipt of the application, the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

10. 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.

(See section 64, p. 192, *supra*.)

Size, &c., of documents.

11. 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 Act 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.

Qualification of metal goods.

12. In the case of an application for the registration of a trade mark used on any metal goods, other than cutlery, edge tools, and raw steel, the applicant shall state in the specification of goods in the form of. application of what metal or metals the goods in respect to which he applies are made.

(See section 81, p. 211, *supra*.)

Representations of trade mark.

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.

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.

Representations of a series of trade marks.

14. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 66 of the said Act, 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.

Translation of foreign characters.

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.

Mode of sending notices, &c.

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.

Exercise of Discretionary Powers.

Hearing by Comptroller.

17. Before exercising any discretionary power given to the Comptroller by the said Act adversely to the applicant for registration of a trade mark, the Comptroller shall give him ten days' notice of the time when he may be heard personally or by his agent before the Comptroller.

Notice of wish to be heard before Comptroller.

18. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter.

Notification of decision.

19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

(See section 94, p. 222, *supra*. Rule 40, *infra*.)

Appeal to the Board of Trade.

Appeal to Board of Trade.

20. Where the Comptroller refuses to register a trade mark, 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, Trade Marks Branch, a notice of such his intention.

Statement of grounds of appeal.

21. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

Copy of notice to Board of Trade.

22. 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.

Directions by Board.

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.

Notice of time of hearing.

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 the applicant.

Advertisement of Application.

Advertisement of application.

25. Every application shall be advertised by the Comptroller in the official paper, during such times, and in such manner as the Comptroller may direct.

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 trade mark is deposited for exhibition.

Definition of official paper.

26. 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.

27. 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.

Means of advertising trade mark to be supplied to official paper.

28. When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in section 66 of the said Act 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.

Advertisement of series.

Opposition to Registration.

29. (1.) Where a case stands for the determination of the Court, under the provisions of section 69 of the said Act, the Comptroller shall require the applicant within one month, or such further time as the Comptroller may allow, to issue a summons in the chambers of a judge of Her Majesty's High Court of Justice for an order that notwithstanding the opposition of which notice has been given the registration of the trade mark be proceeded with by the Comptroller, or to take such other proceeding as may be proper and necessary for the determination of the case by the Court.

Manner of bringing case before Court.

(2.) The applicant shall thereupon issue such summons, or take such other proceedings as aforesaid, within the period of one month above named, or such further time as the Comptroller may allow, and shall also within the like period give notice thereof to the Comptroller.

(3.) If the applicant shall fail to issue such summons, or to take such other proceedings, of which failure the non-receipt by the Comptroller of the said notice shall be sufficient proof, the applicant shall be deemed to have abandoned his application.

(4.) Such notice to the Comptroller shall be given by delivering at or sending to the Patent Office a copy of the summons or other initiatory proceeding bearing an endorsement

Mode of giving notice that the matter

has been brought before the Court.

of service signed by the applicant or his solicitor, or an endorsement of acceptance of service signed by the opponent or his solicitor.

Register of Trade Marks.

Time of registration of trade marks.

30. As soon as may be after the expiration of two months from the date of the first advertisement of the application, the Comptroller shall, subject to any such summons or other proceeding as aforesaid and the determination of the Court thereon, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, 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.

(Section 78, p. 209, *supra*, provides for the register, and section 79, p. 209, for the removal of the mark therefrom.)

Where applicant dies before registration, the trademark may be registered for successor to goodwill of business.

31. 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.

Entries to be made in register.

32. 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 (which day shall be deemed to be the date of the registration) and such other particulars as he may think necessary.

Notice of registration.

33. 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.

Request by subsequent proprietor.

34. 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.

Signature of request.

35. 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, 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.

36. 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. Contents of request.

37. 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. Declaration to accompany request.

38. 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. Further proof of title if required.

39. A body corporate may be registered as proprietor by its corporate name. Body corporate.

40. 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. Definition of applicant.

41. Whether all of such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by section 71 of the said Act, 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. Comptroller may require statement from rival claimants.

(See section 71, p. 201, *supra*.)

42. 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. Submission to Court of conflicting claims.

Settlement of special case.

43. Where the special case is to be submitted to 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.

44. Where an order has been made by the Court in either of the following cases, *viz.* :—

(*a.*) Allowing an appeal under section 62 of the said Act;

(*b.*) Disallowing an opposition to registration under section 69; or,

(*c.*) Under the provisions of sections 72, 90, or 92 of the said Act,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office 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.

(See section 72, p. 201, *supra*.)

Removal of mark from register.

45. Where a trade mark has been removed from the register for non-payment of the prescribed fee or otherwise, under the provisions of section 79 of the said Act, the Comptroller shall cause to be entered in the register a record of such removal and the cause thereof.

(See section 79, p. 209, *supra*.)

Alteration of address in register.

46. 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.

Publication of rectification or variation of register.

47. 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.

Notice to Comptroller of Order of Court for alteration of trade mark under section 92 of Act.

48. 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 section 92 of the said Act, 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.

(See section 92, p. 221, *supra*.)

Inspection of Register.

49. 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 :— Hours of inspection.

(*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.

Power to Dispense with Evidence.

50. 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. Dispensing with evidence.

Amendments.

51. Any document or drawing or other representation of a trade mark 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 on such terms as he may direct. Amendment of documents.

Enlargement of Time.

52. 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. Comptroller may enlarge time.

Cutlers' Company.

53. All applications to the Cutlers' Company for registration of a trade mark, under section 81 of the said Act, shall be in Sheffield applica-

tions in duplicate. duplicate, accompanied by the prescribed fees and representations.

Notice to Comptroller. 54. 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.

Time within which Comptroller may object to application made at Sheffield. Advertisement of application made at Sheffield. 55. (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 registration 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.

Manner of notifying to Cutlers' Company application received by Comptroller. (3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in sub-section 8 of section 81 of the said Act 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.

Similarity of proceedings at London and at Sheffield. 56. 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.

(See section 81, p. 211, *supra*.)

Certificates.

Certificate by Comptroller. 57. The Comptroller, when required for the purpose of any legal proceeding or other special purpose to give a certificate as to any entry, matter, or thing which he is authorised by the said Act 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, and shall specify on the face of it the legal proceeding or other purpose for which such certificate is granted.

Declarations.

58. The statutory declarations required by the said Act and these rules, or used in any proceedings thereunder, shall be made and subscribed as follows:— Manner in which, and persons before whom, declaration is to be taken.

(*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.

59. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration. Notice of seal of officer taking declaration to prove itself.

Repeal.

60. All general rules as to the registration of trade marks heretofore made by the Lord Chancellor under the Trade Marks Registration Act, 1875, and in force on the 31st day of December, 1883, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to any proceeding which may have been taken under such rules. Previous rules repealed.

J. CHAMBERLAIN,

President of the Board of Trade.

21st December, 1883.

SCHEDULES.

FIRST SCHEDULE.

Fees.	£	s.	d.
1. On application to register a trade mark for one or more articles included in one class . .	0	5	0
2. On appeal to Board of Trade on refusal of Comptroller to register	1	0	0
3. For registration of a trade mark for one or more articles included in one class . . .	1	0	0
4. For registering a series of trade marks, for every additional representation after the first in each class	0	5	0
5. For entering notice of opposition, for each trade mark, whether in one or more classes . .	1	0	0
6. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
7. For every additional mark assigned or transmitted at the same time	0	2	0
8. For certificate of refusal to register a trade mark under section 77	1	0	0
9. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first	0	10	0
10. For continuance of mark at expiration of 14 years	1	0	0
11. Additional fee where fee is paid within three months after expiration of 14 years . .	0	10	0
12. Additional fee for restoration of trade mark where removed for non-payment of fee . .	1	0	0
13. For altering address on the register, for every mark	0	5	0
14. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0
15. 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
16. On request to Comptroller to correct a clerical error	0	5	0
17. For certificate of registration to be used in legal proceedings	0	10	0

		£	s.	d.
18.	For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
19.	For copy of notification of registration . .	0	2	0
20.	Settling a special case by Comptroller . .	2	0	0
21.	For inspecting register, for every quarter of an hour	0	1	0
22.	For making a search amongst the classified representations of trade marks, for every quarter of an hour	0	1	0
23.	For office copy of documents, for every 100 words (but never less than one shilling). .	0	0	4
24.	For certifying office copies, MS. or printed .	0	1	0
25.	For certificate of Comptroller under section 96 .	0	5	0
26.	In cases where a trade mark requires a greater space than two inches of the depth of the page of the Trade Marks Journal, for each additional inch or part of an inch . . .	0	2	0
27.	Manchester Trade Marks Office . .	Same as above		
28.	Sheffield Marks	Same as above		
29.	On appeal from Cutlers' Company, Sheffield, to Comptroller	0	2	0

J. CHAMBERLAIN,
President of the Board of Trade.

Approved:

CHARLES C. COTES,
HERBERT J. GLADSTONE,
Lords Commissioners of
Her Majesty's Treasury.

4th December, 1883.

SECOND SCHEDULE.

FORMS.

(These are all to be obtained ready stamped at the Patent Office, and it is proposed to sell them at the Chief Post Offices of the great commercial centres.)

Form F.

Application for Registration of Trade Mark.

One representation to be fixed within this space, and two others to be sent on separate sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed thereto.

You are hereby requested to register the accompanying trade mark in class , in respect of (*a*)

(*a*) Only goods contained *in one* 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 business of the individual, firm, or company. In the case of an individual, 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.

To the Comptroller, Patent Office,
Trade Marks Branch.

(Signed)

(*d*) To be signed by the applicant; or, in the case of a firm, by a partner, adding, "A member of the firm"; or, in the case of a company, by the secretary or other principal

Dated this day of 1883.

NOTE.—If the trade mark has been in use in respect of

the goods since before August 13, 1875, state length of such user.

officer, adding, "For the Company."
Or, *in any case*, an agent may sign, adding "Agent."

Form G.

Additional Representation of Trade Mark to Accompany Application for Registration.

One representation of the trade mark to be affixed within this space.
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.

Form H.

Form of Appeal to Board of Trade on Refusal of Comptroller to Register a Trade Mark.

SIR,

I hereby give notice of my intention to appeal against your decision upon my application to register a trade mark No. in class for and I beg to submit my case* for the decision of the Board of Trade.

I am, Sir, your obedient servant,

To the Comptroller, Patent Office,
Trade Marks Branch.

* 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.

Form I.

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.

Form J.

Notice of Opposition to Application for Registration (to be accompanied by an unstamped duplicate).

In the matter of an Application, No. by of

SIR,

Notice is hereby given that I of oppose the registration of the trade mark advertised under the above number for class in the Trade Marks Journal of the day of 188 , No , p.

The grounds of opposition are as follows :—

[To be dated and signed at the end by the opponent or his solicitor.]

To the Comptroller, Patent Office,
Trade Marks Branch.

Form K.

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*) of 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*) Here state whether trade mark transmitted by death, marriage, bankruptcy, or other operation of law; and, if entitled by assign-

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.

ment, state the particulars thereof, as, *e.g.*, "by deed dated the day of 188 , made between So-and-so of the one part."

(*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*)

Declared at
this day of 188 .

(*g*) To be signed here by the person making the declaration.

Before me

(*h*)

(*h*) Signature and title of the authority before whom the declaration is made.

To the Comptroller, Patent Office,
Trade Marks Branch.

Form L.

Request for Certificate of Refusal to Register a Trade Mark in use before 13*th August*, 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 188 .

To the Comptroller, Patent Office,
Trade Marks Branch.

Form M.

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 188 .

(Signature of proprietor.)

To the Comptroller, Patent Office,
Trade Marks Branch.

Form N.

Notice of Application 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 188 , 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 the Court is enclosed herewith.

Dated this day of 188 .

(Signature of applicant.)

To the Comptroller, Patent Office,
Trade Marks Branch.

Form O.

Form of Application by Proprietor of Registered Trade Mark to Cancel Entry on Register.

Trade Mark No. , class , advertised in "Trade Marks Journal," No. , p.
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 Register of the Trade Marks in class of the trade mark No. may be cancelled.

The day of 188 .

(Signed)

This is the statement marked "O" referred to in the declaration of made before me the of 188 .

Form P.

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
188 .

Before me,

If the declaration be made before a Commissioner to administer oaths, it will require to be stamped with a 2*s.* 6*d.* impressed Inland Revenue stamp.

N.B.—This appears to be an error. The 2*s.* 6*d.* is the Commissioner's fee for taking the declaration and exhibit. There is no Inland Revenue duty on declarations.—Ed.

Form Q.

Form of Request for Correction of Clerical Error in Regard to a Trade Mark.

SIR,

I hereby request that

To the Comptroller, Patent Office,
Trade Marks Branch.

Form R.

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 188 .

To the Comptroller, Patent Office,
Trade Marks Branch.

Form S.

Request for Certificate of Registration of Trade Mark for use 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 for use in the following legal proceedings [here state exact title of legal proceedings].

(Signature)

Dated this day of 188 .

To the Comptroller, Patent Office,
Trade Marks Branch.

Form T.

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,

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 188 .

(To be signed by both parties.)

To the Comptroller, Patent Office,
Trade Marks Branch.

Form U.

General Certificate of Comptroller-General as to Application for or Registration of a Trade Mark.

Patent Office, Trade Marks Branch,
London,
188 .

I,

Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

---

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 188 .

To the Comptroller, Patent Office,
Trade Marks Branch.

Form W.

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. †

Dated this day of 188 .

To the Comptroller, Patent Office,
Trade Marks Branch.

* 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.

THIRD SCHEDULE.

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 Registrar may desire.

CLASSIFICATION OF GOODS.

	Illustrations.
	NOTE.—Goods are mentioned in this column 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 cases. 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. „ sheet. Wire. Copper. Zinc. 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. Cyder 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,	Such as— Plate.

Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.	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. Cotton yarn and thread.	Such as— Sewing cotton on spools or reels. Sewing cotton not on spools or reels. Dyed cotton yarns.
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 bookbinding.	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. Cyder. Wine. Whiskey. Liqueurs.

CLASS 44. Mineral and aërated waters, natural and artificial, including ginger-beer.	
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, 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.	Such as— Coopers' wares.

(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.

J. CHAMBERLAIN,
President of the Board of Trade.

21st December, 1883.

SECTION IV.

THE CUTLERS' COMPANY ACTS.

Abridgment of their Provisions.

The Cutler's Company, or, to give the title in full, "The Company of Cutlers in Hallamshire, in the County of York," was incorporated by the Act of Parliament 21 Jac. I., c. 31 (A.D. 1623), which recites that it was necessary to provide for the government of persons exercising the art of cutlers, or making knives, blades, scissors, shears, sickles, cutlery wares, and other wares made of wrought iron and steel within Hallamshire and six miles thereof. Powers for such government were vested in the Company; and no person, not being a freeman thereof, was allowed to carry on the art of cutlers within that district, and no person was permitted to use more than one mark upon his goods, and that was to be such a mark as should be assigned to him by the master and

The Cutlers' Company Act of 1623.

other officers of the Cutler's Company, under the penalty of forfeiting the goods and a fine of 40*s.* for each offence. The Company were to elect a master, two wardens, six searchers, and twenty-four assistants, to carry out the provisions of the Act, who had power given them to make bye-laws for regulating the trade of cutlers, and to impose fines for breaches thereof. The penalties and fines were to be recovered by the Company in any Court of Record.

The Cutlers' Company Act of 1791.

The Act of Parliament 31 Geo. III., c. 58 (A.D. 1791), repealed this Act except so much thereof as related to the incorporation of the Company. The master manufacturers exercising the arts or trades of makers of knives, sickles, shears, scissors, razors, files and forks within the District of Hallamshire and six miles' compass of the same were to meet annually and to nominate twenty-five persons exercising the said arts, from whom the master, wardens, searchers, and assistants of the Company were to select twelve to act as assistants for the year ensuing, who, with the remaining twelve of the assistants, and the master, wardens, and searchers to be elected under the former Act, were to be the master, wardens, searchers, and assistants for the year ensuing. Persons voting at such nomination who had not been master manufacturers in some of the said trades for the preceding twelve months were to forfeit the sum of £5. The persons nominated were to take upon them their offices under a penalty of £30. After the 26th June, 1791, every person who had served an apprenticeship for the term of seven years to any member of the Company exercising any of the said trades within the district was entitled, after attaining the age of twenty-one years, to the freedom of the Company, and to have a mark assigned to him to be struck, engraved, or used by him upon such goods as he was entitled to make. The sons of freemen who had worked under their fathers

were to be considered as apprentices, although not formally bound as such.

Every person entitled to the freedom was to apply for a mark, which the master and other officers were to assign to him before taking an apprentice, and was to pay a yearly sum of 6*d.* as mark rent. No mark was to be assigned which consisted in part or wholly of a surname. Any person counterfeiting a mark assigned by the Company was to forfeit a sum not exceeding £20, nor less than £4, one-half to go to the person whose mark was counterfeited.

If two or more persons who might have carried on different branches of some of the said trades, and who might have had the same mark assigned to them, began another branch of trade different to that for which the mark had been assigned to them, they were obliged to apply for another mark before being allowed to carry on such new trade.

Section 19 of the Act regulated the fees to be taken: on enrolling indenture of apprenticeship of son of member of Company, 2*s.* 6*d.*; on the binding of any other apprentice, 11*s.* 6*d.*; for searching and assigning a mark, 8*s.* 2*d.*

By section 20, no person whomsoever was to "set up, "exercise, or carry on for himself, or in partnership, or "work as journeyman in any of the arts or trades of "makers of knives, sickles, shears, scissors, razors, files, "and forks, within the liberty of Hallamshire, or six "miles' compass of the same," without being first admitted to the freedom of the Company, and continuing a member thereof, under a penalty not exceeding £10, or less than 10*s.*, for every month of exercising such trade.

By section 21 this restriction was not to apply to the exercise of new inventions, upon a license for that purpose being obtained from the Company.

By section 23 the widow of any freeman might carry on the trade of her deceased husband during her life, or

might sell the right of using her deceased husband's mark to any person entitled to carry on the trade. By section 24 non-freemen were to have marks assigned to them upon paying £20 over and above ordinary fees.

By sections 26 and 27 the penalties could be sued for in any Court of Record, and a summary jurisdiction over offences under this Act was given to the justices for the West Riding of the County of York, or for the County of Derby.

The Cutlers' Company Act of 1801.

The Act of Parliament 41 Geo. III., c. 97, enabled (section 2) a freeman of the Company to give or devise his mark by will, subject to the life interest of his widow therein; if he made no will, the mark (section 3) was to be the property of such of his family or relatives as might be entitled to use it. By section 4, if persons acquiring marks in this way did not pay mark rent for five years, the mark was to be considered surrendered to the Company.

The Cutlers' Company Act of 1814.

By the Act of Parliament 54 Geo. III., c. 119 (A.D. 1814), it was recited that, whereas by the restrictions contained in the before-mentioned Acts the manufactures of the district were made wholly dependent for the supply of journeymen and workmen upon the freemen of the said Corporation, and the number of journeymen was consequently always very limited; And whereas it was expedient that the freemen should be exonerated from other restrictions and annual payments imposed upon them; the Act accordingly repealed the various provisions of the preceding Acts above set forth, and enacted instead of them:—

Section 1. That any person might carry on business in any of the arts or trades of makers of knives, sickles, shears, scissors, razors, files, and forks, within Hallamshire, or six miles' compass thereof, although he should not have obtained the freedom of the Company, or have continued a member thereof, and might have any number

of apprentices, and for any terms of years he might think proper.

Section 2. Any person, whether freeman of the Company or not, exercising any of the said trades within the district might have a mark assigned to him on payment of 40*s*. But this mark might not—

1. Be the property of any other person within the district;

2. Nor consist of a surname.

If the mark was one previously assigned and afterwards surrendered to the Company, an extra fee of £3 was to be paid.

Section 5. If any person carrying on any of the said trades within the district "struck, engraved, impressed, "or used, or caused to be stricken, engraved, impressed, "or used upon his goods, wares, or manufactures, any "mark, device, stamp, or impression, with intent to "counterfeit or imitate any mark assigned" to any other person of the Company, such person, for every such offence, should forfeit any sum not exceeding £20, one-half to go to the Company, and one-half to the person whose mark had been counterfeited. The provisions in the Act 31 Geo. III., c. 58, as to the recovery of the penalties set out above were to remain in force.

Section 6. Every mark assigned by the Company might be devised, or, in case of no devise, should be enjoyed by the widow and family of any person dying possessed of any such mark, but no such mark was to be used by more than one person of such family at the same time.

The last Act of Parliament is the 23 Vict., c. 43 (A.D. 1860), which enacts:— The Cutlers' Company Act of 1860.

Section 1. That the several provisions of the above Acts in force relating to persons manufacturing knives, sickles, shears, scissors, razors, files, and forks within Hallamshire, or six miles' compass thereof, should hence-

forth extend to persons exercising the arts or trades of *manufacturers of steel and makers of saws and edge tools, and other articles of steel, or of steel and iron combined, having a cutting edge.*

Section 2. Any persons carrying on any of the arts or trades mentioned in the last section within Hallamshire, or six miles' compass of the same, shall be admitted to the freedom of the Company, and have a mark assigned to them, upon paying £20 over and above the other fees.

TIME TABLE.

I. PATENTS.

Amendment of application or specification required by Comptroller.	Comptroller must give *ten* days' notice to applicant of appointment for hearing upon question.	Pat. Rules 11, p. 242.
	Within *five* days, or longer time stated by Comptroller, applicant must notify whether he requires to be heard.	Pat. Rules 12, p. 242.
Appeals from Comptroller to law officer.	Within *fourteen* days of decision appealed against, notice of appeal to be filed in Patent Office.	Law Officers' Rule 1, p. 253; Form T, p. 265.
	Comptroller and Law Officer may allow further time.	Law Officers' Rule 5, p. 253.
	Comptroller to transmit to Law Officers' clerk all papers.	Law Officers' Rule 4, p. 253.
	Seven days' notice of appointment for hearing to be given by Law Officer.	Law Officers' Rule 6, p. 253.
Application for patent.	To be made before publication of invention.	Sec. 5, p. 118; Form A, p. 257.
	To become void unless complete specification accepted within *twelve months* from application, unless delayed by appeal.	Sec. 9, p. 128.
Application for patent by representative of deceased inventor.	To be made within *six* months from date of decease.	Sec. 34 (2), p. 167; Pat. Rule 24, p. 244.
Assignment of patent.	May be entered on register at any time, but title to patent not secure until registered.	Pat. Rule 65, p. 250.
Completion of patent by representative of deceased inventor.	If applicant dies within *fifteen* months of application patent may be sealed to his legal representative within *twelve* months from date of applicant's decease.	Sec. 12 (3), p. 133.

Compulsory licenses.	Petition for grant of, may be filed at any time after grant of patent.	Sec. 22, p. 142.
	To be left at Patent Office with evidence.	Pat. Rules 57 and 58, p. 249.
	Board of Trade will requïre petitioner to attend Comptroller, &c., on day appointed to receive directions.	Pat. Rule 59, p. 249.
	Petitioner to deliver patentee copies of petition and evidence before day appointed by Board of Trade.	Pat. Rule 61, p. 250.
	Patentee, within *fourteen* days from such delivery, to file evidence in reply and serve petitioner with copy thereof.	Pat. Rule 61, p. 250.
	Petitioner, within *fourteen* days, to file evidence in reply and serve patentee with copy thereof.	Pat. Rule 62, p. 250.
	Parties to be heard on appointment made by Board of Trade.	Pat. Rule 63, p. 250.
Disclaimer or Amendment of specification.	Leave to amend specification may be applied for at any time after complete specification accepted. The request to be advertised in Official Journal and as Comptroller may direct.	Sec. 18, p. 138. Pat. Rule 48, p. 248. Pat. Rule 48, p. 248.
	Notice of opposition to amendment to be given within *one* month from first advertisement.	Sec. 18 (2), p. 138.
	Within *fourteen* days after expiration of month opponent to file his evidence and serve applicant with list thereof; and then same proceedings and times as in opposition to the grant of patent.	Pat. Rule 51, p. 248. Pat. Rule 52, p. 249.
	If disclaimer allowed applicant to leave new specification and drawings at Patent Office if required within time appointed by Comptroller.	Pat. Rule 54, p. 249.
Duration of patent.	Fourteen years from date of application if renewed by the payments required.	Sec. 17 (1), p. 136. Pat. Rules 46 and 47, p. 248.
Enlargement of time for payment of renewal fees.	Within *one* month of prescribed time.	Schedule of Pat. Fees, Nos. 26, 27, and 28, p. 256.
	Within *two* months of prescribed time.	
	Within *three* months of prescribed time.	

Exhibition—industrial or international.	Before exhibiting unpatented invention at, inventor must obtain certificate from Board of Trade;	Sec. 39, p. 169. Pat. Rule 17, p. 243.
	And give Comptroller *seven* days' notice of his intention to exhibit.	
	Must file description of invention at Patent Office.	
	Patent must be applied for within *six* months from opening of exhibition.	Sec. 39, p. 170.
Extension of patent.	Petition to Privy Council for, to be filed at least *six* months before patent expires.	Sec. 25, p. 146.
Holidays . . .	Christmas Day, Good Friday, any day kept as, by Bank of England, or any public fast or thanksgiving, when last day, thing may be done on day next following such, or days if more than one occur consecutively.	Sec. 98, p. 223.
Infringement . .	No proceedings can be taken for infringement committed before publication of complete specification.	Sec. 13, p. 133.
International patents.	To be applied for within *seven* months from date of application in foreign country.	Sec. 103, p. 227.
Opposition to grant of patent.	Notice to be given within *two* months from date of advertisement of acceptance of complete specification.	Sec. 11, p. 130.
	Within *fourteen* days from end of the *two* months, opponent must file his evidence and serve applicant with list thereof.	Pat. Rule 35, p. 246.
	Within *fourteen* days from service of list of opponent's evidence, applicant to file his evidence in answer, and serve opponent with list thereof.	Pat. Rule 36, p. 246.
	Applicant to file evidence in reply and serve list within *seven* days.	Pat. Rule 36, p. 246.
	On completion of evidence, Comptroller to give *seven* days' notice of appointment for hearing.	Pat. Rule 39, p. 247.

Particulars of breaches.	To be delivered with statement of claim, and afterwards if ordered by Court or judge.	Sec. 29 (1), p. 154.
Particulars of objection.	To be delivered with statement of defence, and afterwards if ordered by Court or judge.	Sec. 29 (2), p. 154.
Patent	To be sealed f no opposition at expiration of *two* months from advertisement of acceptance of complete specification;	Sec. 12 (1), p. 132.
	And before expiration of *fifteen* months from date of application.	Sec. 12 (3), p. 133.
	To be dated and sealed as of day of application.	Sec. 13, p. 133.
Protection by complete specification.	To exist from acceptance of complete specification until sealing.	Sec. 15, p. 135.
Provisional protection.	To exist from date of application until sealing of patent if application accepted.	Sec. 14, p. 134.
Renewal fees . .	*Seven* days before expiration of fourth year, patentee to give notice to Comptroller of his intention to keep up patent.	Pat. Rule 42, p. 247. Pat. Form J, p. 262.
	Before end of fourth year, patentee to stamp certificate of payment with £50 stamp, and leave at Patent Office.	Pat. Form J, p. 262. Schedule of Patent Fees, p. 255.
	Same at end of seventh year for patents dated before 1st Jan., 1884, and at end of eighth year for patents granted on and after 1st Jan., 1884, with £100 stamp.	
	Same with £10 and increasing fees if annual payments be adopted.	Pat. Rule 44, p. 247
Seal	Patent to be sealed within *fifteen* months from application except appeal be pending or applicant has died.	Sec. 12, p. 133.
Specification, provisional.	To be left with application.	Sec. 5 (2), p. 118.

Specification, complete	To be left with application, or within *nine* months from *application*.	Sec. 8, p. 127.
	Must be accepted within *twelve* months from application.	Sec. 9 (4), p. 128.
	To be advertised upon acceptance.	Sec. 10, p. 129.
Sunday . . .	Where last day falls upon, thing may be done on day following.	Sec. 98, p. 223.
Saturday . . .	Where Saturday last day, thing may be done on Monday following.	Sec. 98, p. 223.

II. DESIGNS.

Application to register.	May be made at any time before publication of the design.	Sec. 47, p. 178; Design Rule 4, p. 266; Form E, p. 273.
	On receipt of, Comptroller to send applicant acknowledgment.	Designs Rule 10, p. 267.
	If Comptroller determines to register, he is to send certificate of registration.	Designs Rule 11, p. 267.
	If Comptroller objects to register, he is to give applicant *ten* days' notice of appointment to be heard upon question.	Designs Rule 13, p. 267.
	Within *five* days the applicant to notify Comptroller whether he intends to be heard.	Designs Rule 14, p. 267.
	Decision of Comptroller to be notified to applicant.	Designs Rule 15, p. 268.
Appeal from Comptroller to Board of Trade.	Within *one* month of decision appealed from, applicant to leave at Patent Office notice of intention to appeal;	Designs Rule 16, p. 268.
	With statement of ground of appeal, and his case;	Designs Rule 17, p. 268.
	And to send copy of notice to the Secretary to the Board of Trade.	Designs Rule 18, p. 268.
	Board of Trade to give directions for hearing of appeal.	Designs Rule 19, p. 268
	Board of Trade to give *seven* days', or shorter notice, as they direct, of appointment for hearing appeal.	Designs Rule 20, p. 268

Assignment of copyright.	May be made at any time, but should be registered as soon as completed.	Designs Rule 22, p. 268.
Copyright. . .	The owner of a registered design has copyright therein for *five* years from date of registration.	Sec. 50, p. 182.
Delivery on sale. .	Before delivering for sale any article with registered design applied, each article must be marked with the prescribed mark.	Sec. 51, p. 182. Designs Rule 32, p. 270.
Duration of copyright in a registered design.	Five years from date of registration.	Sec. 50, p. 182.
Exhibition, international or industrial.	Before exhibiting unregistered design, or publishing same during period of exhibition, the owner must obtain certificate from Board of Trade, and give Comptroller *seven* days' notice of intention to do so. And must furnish description and sketch of design to Comptroller.	Designs Rule 36, p. 271.
	Registration of design so exhibited must be effected within *six* months from date of opening exhibition.	Sec. 57, p. 185.
Foreign country .	If registered design be used in foreign country, and not in this country, within *six* months after registration here, copyright to cease.	Sec. 54, p. 184. Sec. 103, p. 227.
Holidays . . .	See Time Table Patents.	Sec. 98, p. 223.
Inspection. . .	Design open to, when copyright has expired.	Sec. 52 (2), p. 183.
Saturday and Sunday.	See Time Table Patents.	Sec. 98, p. 223.

III. Trade Marks.

Additions to and alterations of Registered Trade Mark.	*Fourteen* days' notice of application to Court to be given to the Comptroller. If application granted by Court notice thereof to be at once given to Comptroller and	Sec. 92, p. 221; Trade Marks Rule 48, p. 284. Trade Marks Rule 48, p. 284.

	such number of altered representations of marks to be supplied him as he may desire.	
Appeal from Comptroller to Board of Trade.	Within *one* month from decision appealed from appellant to leave notice of appeal at Patent Office;	Sec. 62 (4), p. 190; Trade Marks Rule 20, p. 280; Trade Marks Form H, p. 291; Trade Marks Fees 2, p. 288.
	With statement of case;	Trade Marks Rule 21, p. 280;
	And to send copy to the Secretary of the Board of Trade.	Trade Marks Rule 22, p. 280.
	Board of Trade to give directions as to evidence and as to hearing the appeal;	Trade Marks Rule 23, p. 280.
	And *seven* days' notice of hearing.	Trade Marks Rule 24, p. 280.
Application to register.	May be made at any time	Sec. 62, p. 190.
	Should be made as early as possible.	Trade Marks Rules 7 to 16, pp. 277, 278; Trade Marks Forms F, G, and H, pp. 290, 291; Trade Marks Fees 1 and 3, p. 288.
	To be advertised by Comptroller,	Sec. 68, p. 198; Trade Marks Rules 25 to 28, pp. 280, 281.
	As soon as may be.	Sec. 94, p. 222.
	Before refusing to register the Comptroller must give the applicant *ten* days' notice of the appointment for the hearing.	Trade Marks Rule 17, p. 279.
	Applicant within *five* days to notify to Comptroller whether he intends being heard.	Trade Marks Rule 18, p. 279.
	The decision of the Comptroller to be notified to the applicant.	Trade Marks Rule 19, p. 280.
Cutlers' Company.	At expiration of *five* years, from 1st Jan., 1884, Cutler's Co. to close Cutlers' Register of Corporate Trade Marks; and all marks therein unless entered in Sheffield Register to be deemed abandoned.	Sec. 81 (9), p. 213.
Conflicting applications to register.	Comptroller may refuse to register at all, until rights have been legally determined, and may submit or require the claimants to submit the question to the Court.	Sec. 71, p. 201.
	Comptroller may require claimants to submit written	Trade Marks Rule 41, p. 283.

Conflicting applications to register. —*continued.*	statements by a time to be named by him or to attend before *him* at *an appointment* fixed by him.	
	Mode of submitting question to Court by Comptroller or by claimants—Special case.	Trade Marks Rule 42, p. 283.
	Special case to be settled by parties, or, if they disagree, by Comptroller.	Trade Marks Rule 43, p. 284; Trade Marks Form T, p. 297; Trade Marks Fee 20, p. 289.
Cutlers' Company, application to, to register.	All applications to, to register, to be in duplicate, and to be in the same form as application to Patent Office.	Sec. 81, p. 211; Trade Marks Rule 53, p. 285; Trade Marks Fee 1, p. 288.
	Cutlers' Co. to send notice of application to Comptroller within *seven* days of application.	Trade Marks Rule 54, p. 286.
	Comptroller to give notice of objection to, within *one* month from receipt of notice from Comptroller.	Trade Marks Rule 55, p. 286.
	If no objection by Comptroller, Cutlers' Co. to require applicant to send wood block to Comptroller.	Trade Marks Rule 55, p. 286.
	Comptroller to send Cutlers' Co. a copy of Official Paper, containing applications to register in respect of steel and cutlery goods.	Sec. 81 (8), p. 213.
Enlargement of time.	Comptroller has general power to enlarge the time of doing any act.	Trade Marks Rule 52, p. 285.
Foreign country .	Owner of international trade mark to apply in this country within *four* months from his application to register abroad.	Sec. 103, p. 227.
Holidays . .	See Patents Time Table.	*Ante.*
International trade marks.	Applicant to apply for registration in this country within *four* months from his application in foreign country.	Sec. 103, p. 227.
New mark . . .	One first used since 13th August, 1875.	
Old mark . . .	One first used before 13th August, 1875.	

Opposition to Registration.	Notice of, must be given within *two* months from first advertisement of application.	Sec. 69, p. 198.
	Comptroller to send copy of notice of opposition to applicant.	Sec. 69, p. 198.
	Within *two* months of receipt of such notice, or such further time as Comptroller shall allow, applicant to send counter statement in duplicate to Comptroller.	Sec. 69. p. 198.
	Comptroller to send copy of counter statement to *opponent, and to require him to* give security.	Sec. 69, p. 198.
	Security for costs must be given by opponent within *fourteen* days from the requisition thereof by the Comptroller, or within such further time as he shall allow.	Sec. 69, p. 198.
	When the security is given the Comptroller is to inform the applicant.	Sec. 69, p. 198.
	Comptroller to require the applicant within *one* month, or such further time as he shall allow, to issue a summons at Chambers of Judge of High Court of Justice for an order that the registration be proceeded with.	Trade Marks Rule 29, p. 281.
	Applicant to issue the summons within *one* month after receipt of requisition of the Comptroller, or within time named by him.	Trade Marks Rule 29, p. 281.
	Copy of the summons to be served upon the Comptroller upon its issue.	Trade Marks Rule 29 p. 281.
Register, mark removed therefrom for non-payment of renewal fees or otherwise.	To be deemed a registered trade mark for *five* years from removal for the purposes of fresh applications to register.	Sec. 79 (3), p. 210.
Registration becomes conclusive.	After *five* years from date of registration.	Sec. 76, p. 207; but see Note thereto.
Renewal of Registration.	Not less than *two* and not more than *three* months before end of every fourteen years from date of registration; and, after the expiration of every succeeding fourteen years, the Comptroller is to send notice	Sec. 79, p. 209.

Renewal of Registration —*continued.*	to applicant requiring renewal of registration, and at end of *one* month from first notice to send a *second* notice.	
	Proprietor to pay fee before end of fourteen years.	Sec. 79, p. 209; Trade Marks Fee 10, p. 288.
	If renewal fee be not paid before the end of fourteen years, Comptroller, at end of *three* months, to remove mark from register.	Sec. 79, p. 209.
	If before end of *three* months from end of fourteen years proprietor pays renewal fee and additional fee, Comptroller may accept same, and restore mark to the register.	Sec. 79, p. 210. Trade Marks Fee 11, p. 288.
	Comptroller has power to restore the mark to the register on payment of additional fees.	Sec. 79, p. 210. Trade Marks Fee 12, p. 288.
Saturday . . .	See Patents Time Table.	*Ante.*
Sheffield Register .	All marks in Cutlers' Register to be entered in Sheffield Register within *five* years from 1st January, 1884.	Sec. 81 (9), p. 213.
Sunday . . .	See Patents Time Table.	*Ante.*

INDEX.

ACCOUNT,
Court may order, in patent case (section 30), 157
ACCOUNT, FINAL, IN PATENT CASES,
plaintiff may sue for either damages or an account of profits, 161
extends over six years preceding action, 161
action for damages may be turned into one for account, 161
persons adopting part only of invention liable to account, 161
may be taken notwithstanding appeal pending, 161
plaintiff may have damages against manufacturer, and account against user of invention, 161
way profits are reckoned, 161
ACCOUNT, INTERLOCUTORY, IN PATENT CASES,
when, and principles upon which, granted, 160, 161
ACCURATE,
specification must be, 47
ACQUIESCENCE
in infringement or negligence may forfeit right to trade mark, 89, 90
ACT
divided into parts, 117
ACTION
for damages for using registered design (section 59), 188
for infringement, parties empowered to require assessors, 107
patentee to be able to disclaim during, 107
ADDITIONS TO TRADE MARKS, 221
common marks may be registered as additions to, 205
ADDRESS,
statement of, to be entered at Patent Office, 242
ADVERTISING,
methods of, not patentable, 5
ADVERTISEMENT
of acceptance of complete specification, 129
of application to register trade mark (section 68), 198
misrepresentation in, as concerned with trade marks, 204
AGENT
alleged infringements of trade mark by plaintiff's agent, 84
business with Patent Office may be conducted through an, 242
AFFIDAVITS
evidence in patent proceedings, 244
how to be sworn, 244
ALTERATIONS
of registered trade marks, 221
AMBIGUOUS OR MISLEADING,
if specification be, patent void, 46
AMENDMENT
of documents, &c. (designs), 270
of documents (patents), 243
of irregularity in procedure (patents), 243
in trade mark proceedings, &c., 285.
of patent to be entered on register, 144

AMENDMENT OF SPECIFICATION, 25, 138, 139
appeal to Law Officer from refusal of Comptroller to allow, 138
Court power to grant leave to file during action for infringement or revocation of patent (section 19), 141
disclaimer after injunction, injunction cannot be enforced, 141
"disclaimer, correction or amendment, how construed," 140
during action, 141
damages not to be allowed except in certain cases (section 20), 142
if Comptroller impose conditions, patentee may appeal, 141
Law Officer's decision final, 141
Law Officer may impose conditions on application for, 140
leave to file shall be conclusive, except in case of fraud, 139
provisions of section 18 not to apply when action for infringement pending, 139
owner of patent must apply for leave; if more than one, all must concur, 139
powers in Act same as old (section 18), except as to explanation, 139, 140
procedure for, 248
request to be advertised, 138
to be deemed to form part of specification, 139
to be advertised (section 21), 142
opposition to, procedure &c., 138
Comptroller to decide, subject to appeal to Law Officer, 138
"ANATOLIA," word held trade mark, 81
"ANCHOR," the mark of, held trade mark, 80
"ANGOSTURA BITTERS"
name of product is not trade mark standing by itself, 95
APPEAL
from Comptroller to Board of Trade as to registration of trade marks (section 62), 190
from Cutlers' Company to Comptroller, 213
APPEAL FROM COMPTROLLER TO LAW OFFICER
practice and procedure, 253
applicant and Comptroller to be heard, 126
from Comptroller on applications for leave to amend specification (see Amendment of Specification), 138
on refusal to allow patent, 131
person dissatisfied to appeal, 132. costs in, 254
APPLICATION
of materials previously unapplied, patents for, 9
APPLICATION FOR PATENT, 117
abandoned before leaving complete specification, and fresh application made (note c), 127
amendment of, when more than one invention included, 244
appeal to Law Officer, applicant and Comptroller to be heard, 126
appeal to Law Officer, costs in, 254
appeal to Law Officer, decision of final, as to amendments, &c., o specification, 126
appeal to Law Officer, evidence upon, 253
appeal to Law Officer from decision of Comptroller that applications are for same invention, 126
appeal to Law Officer from refusal of Comptroller to accept complete specification, 126
appeal to Law Officer, procedure upon, 253
applicant may appeal from Comptroller to Law Officer (section 7), 126
before patent sealed, examiner to report all applications with similar titles, and notice to be given thereof to applicants, 126
by representative of deceased inventor, 244, 245
Complete specification be compared with provisional (section 9) 128
Comptroller to determine if applications are for same invention, 126.

Comptroller to give notice of acceptance, 126
must be signed by applicant, other communications with office may be made by an agent, 242.
notice of, and advertisement of acceptance, 245
order of recording, 244
power of Comptroller to dispense with evidence, 252
size, &c., of documents, 242
to be referred to Examiner (section 6), 125
when Comptroller may refuse complete specification. 128
when Comptroller may refuse or require amendment in (section 7), 125
when open for inspection, 245
when required to be amended as containing more than one invention, separate patents may be granted to bear date as of first application. 241
ASSESSORS
parties empowered to require assessors in trial of action for infringement, 107, 153
remuneration to, 153
ASSIGNMENT OF COPYRIGHT IN DESIGN
To be in writing, 185
ASSIGNMENT OF PATENT
may be for any part or place in kingdom. 168
to Secretary for War, 173
to be entered on register (section 23), 144
ASSIGNMENT OF TRADE MARK (section 78), 209
must be in connection with goodwill (section 79), 200
principles of law upon, 95, 96
ASSIGNEE OF PATENT,
Cases as to, 217
cannot bring action until his assignment registered, 145
ASSISTANCE,
inventor may receive, in details of invention, 13
ASTUTE,
Courts will not be astute to find flaws in specification, 60
ARRANGEMENT OF SECTIONS OF ACT, 112
BANKRUPT,
trade marks of, pass to Trustee, 96
BATES *v.* REDGATE,
doctrine of, abolished (section 13), 134
BATTY'S PRIZE-MEDAL PICKLES (Batty *v.* Hill), 81
BLACKING
injunction to restrain *infringement of labels* granted, A.D. 1816, 74
BOARD OF TRADE,
appeal to, from Comptroller as to registration of designs, 178
application to, for compulsory licenses, procedure before, 249
decision of, as to registration of design, whether final, 181
has power to order compulsory licenses of patents (section 22), 143
no appeal from th ir order for compulsory licenses of patent, 144
should exercise power to grant licenses for patent judicially, 143
to decide appeals from Comptroller as to registration of trade marks, may refer to Court, 190
to give patentee opportunity to be heard before ordering compulsory license, 143
to appoint Comptroller, Examiners, and Clerks, 216
to prescribe fees for trade marks, 211
power to make rules (section 101), 225
BOOK, FOREIGN
importation no anticipation unless actually published, 20
must be actually sold or in public library to be publication of invention, 20

BROWN'S PATENT FOR BOBBIN LACE
bad for claiming too much, 55
BRUSH
for raising wool, described but useless; patent held not bad, 27
BURGESS' ESSENCE OF ANCHOVIES,
labels upon held trade marks, 80
CALCULATED TO DECEIVE
mark not to be registered for same goods as are already registered 201
trade mark: What is a? 202
words, 204
CALCULATING,
method of not generally patentable, 5
CANCELLING,
entry, or part of entry, of trade mark upon register, 221
CERTIFICATE
of Comptroller, to be evidence, 222
of trade marks, 286
of Judge that validity of patent came in question in action (section 31 and note), 161
of Judge that validity of patent came in question, refused where defendant consented to verdict for plaintiff, 162
of Judge that validity of patent came in question, plaintiff entitled to full costs in second action, although validity not then questioned, 162
of Judge that validity of patent came in question, Judge no power to grant after taxation, 162
of Judge that validity of patent came in question, what is sufficient, 162
CERTIFIED COPIES
or extracts from documents and registers left at Patent Office to be evidence, 219
of specifications, where to be kept, 224
CHANNEL ISLANDS,
no longer covered by British patent, 109, 136
CHANGES IN THE LAW
shown by the Memorandum upon Bill, 103
CHARCOAL
using in particular way for refining sugar, 8
CHEMICAL PROCESSES,
instances of patents for, 9
CLAIMS,
all points of, must have been covered by provisional specification, 38
compulsory in complete specification, 63
disclaimed during action, no damages unless claim framed in good faith and skilfully (section 20), 142
loose, grasping, speculative, or anticipatory, to be avoided, 17 65
if for more than patentee invented patent bad, 66
how to avoid claiming too much and too little, 53
must catch invention, 64
points to be attended to in drafting, 64
object and use of, 63, 64
real object to disclaim, not claim, 65
restricted to combination, 58
to ascertain what is alleged is new, 64
to be construed with context of specification, 65
to mark boundaries of invention, 64
CLAIMING
advisable to claim one good thing rather than everything, 53
too much, Foxwell's Patent for Sewing Machines, 56
too much, Kay's Patent for Treating Flax, 56

too much, Harrison's Patent for Turn Tables; Brown's Patent for Bobbin Lace, 54
CLASHING
between inventors, 16
CLASSES OF GOODS
trade mark must be registered for particular, 194
a trade mark may be registered for as many as desired, 195
or for part of a class only although same mark, already on register if classes are distinct, 195, 196
a mark may be registered for some of the goods in a class although similar old mark already registered, 202
for trade marks (section 62), 190, 299
the exclusive use of a trade mark can only be for particular, 95
trade marks only assignable in connection with particular, 95
CLASSIFICATION OF GOODS
designs, 266, 276
trade marks, 277, 299
CLASSIFICATION of patentable inventions, 5
CLERICAL ERRORS,
power to correct, 220
"COCOATINA" (SCHWEITZER'S), words held trade mark, 81.
COLOGNE, EAU-DE, Johan Maria Farina's, labels held trade marks, 80
COLOUR,
trade marks may be registered in any (section 67), 197
COLONIES,
arrangements with, for protection of inventions, designs, and trade marks, 228
COMBINATION,
claims to, 58
claiming less than whole of, 59
hot-air blast, with use of anthracite coal, patent for, 7
several old, with some new parts, 58
subordinate, 59
inventions more numerous for than for principles. 53
new, of old parts, 7
specification should state whether for. or for application of a principle. 52
COMMUNICATIONS FROM ABROAD,
patents for, whether abolished. 11, 12, 119
COMMENCEMENT OF ACT,
time of, 117
COMMISSIONERS OF PATENTS, offices of, where situated, 215, 216
COMMON MARK,
any device, &c., used by more than three persons for similar goods before August, 1875, 205
may be registered as part of trade mark, 205
applicant must disclaim right thereto, 205
what is a, 205
COMMON MARK, OR PUBLICI JURIS,
does anyone suppose he is buying article manufactured by particular person, 90
COMMON OLD MARK,
one used by more than three persons for similar description of goods, 94
COMMON TRADE MARKS
disentitled to protection, 89
COMPANY OF CUTLERS,
provisions as to (section 81), 211
COMPLETE SPECIFICATION
must be filed within nine months from application, 44. See also Specification, Complete

COMPTROLLER,
certificate of, to be evidence, 222
certificates of, in trade mark matters, 286
certificate of refusal to register a trade mark, 208
costs of an application to Court by, in trade mark matters, 194
decision of, to be notified to parties, 243
duty of, when conflicting claims to register a trade mark (section 71), 201
appeal from, to Board of Trade, from decision as to registration of design, 178, 179
appeal to, from Cutlers' Company., 213
exercise of discretionary power by, 222, 242, 267, 279
in case of doubt or difficulty, may apply to Law Officers, 222
may correct clerical errors, 220
may require application for patent to be amended (section 7), 125
may refuse application for patent (section 7), 125
must be furnished with specimens of design before sale of article, 182
not to register as part of a trade mark words disentitled to protection in a Court of Justice, 204
not to register same or similar mark in respect of same goods more than once unless ordered by Court, 201
Patent Office to be under control of, 215
possesses general power to enlarge time in patent procedure, 248. See also enlargement of time
power of, to dispense with evidence, Designs, 269, Patents, 252, Trade Marks, 285
power of, to enlarge time of payment of renewal fees, 136
powers and duties of, as regards registration of trade marks (section 62), 190
to decide class in which designs are to be registered, may refuse to register, 178
to hear applicant for patent before refusing to accept complete specification, 129
to hear oppositions to patents, 131
to make annual reports to Parliament, 226
to notify to Cutlers' Company application to register trade marks for cutlery, &c., from Hallamshire, and within six miles thereof, 213
to refuse to grant patents or register designs or trade marks which are contrary to law or morality, 216
to send notice requiring renewal of trade mark (section 79), 209
COMPULSORY LICENSE, PATENTS (section 22), 142
no appeal from order of Board of Trade, 144
power of Board of Trade over, 142, 143
procedure to obtain, 249
CONCEALMENT
in specification avoids patent, 45
"CONDY'S" FLUID
name become *publici juris*, 93
CONFIDENTIAL
disclosure of invention before patent, 23
CORRECTION OF SPECIFICATION (Section 18), 138. See Amendment of Specification
CONSIDERATION
for a grant of patent, entire, 25
CONSTRUCTION OF SPECIFICATION
favourably to inventors, 60
province of Court, 61
of technical terms and phrases, matters of evidence and fact for jury, 61
CONTRIVANCE
application of old, not patentable, 4
new, applied to old purpose, 6
new, applied to new purposes, 6
new, applied to old purpose, most numerous class of inventions, 7

COPYRIGHT
in designs, 68. See Designs, Copyright in
definition of, 72, 189
of designs, Acts relating thereto repealed by this Act, 177
in designs, assignment of, to be in writing, 185
in design, during, no one to use or imitate registered design without license of owner, penalty for doing so, 186
in design, legal proceedings, 186
in registered designs (section 50), 182
period of, 182
in design, to cease if used in foreign country and not in this, 184
in design, vests in trustee in bankruptcy of owner, 185
CORPORATIONS
patents cannot be granted to, 118
COSTS
Law Officers may order, 169
in cases of opposition to registration of trade marks, 199
in patent cases, in taxing regard to be had to particulars delivered, 154
of Comptroller in trade mark cases (*Re* Maignen), 194
COUNTERFEITING
a trade mark a misdemeanour, 101
COURT,
construction of specification for the, 61
may rectify registers kept under the Act, 219.
power of, to add to or alter registered trade mark, 221
saving of jurisdiction of, in Scotland or Ireland, 231
"CROWLEY,"
name and letters, &c., held trade mark, 80
CROSS,
the mark of, and letters held trade marks, 80
CROWN,
mark of, with name "Seixo" held trade mark, 81
patent to bind (section 27), 151
but officers of, may use patent on terms to be settled by Treasury, 151
perogative of, 152, 153, 233
nothing to prevent insertion of clause in patent enabling free use of invention by, 152
CUTLERS' COMPANY,
what it is, 214
abridgment of their Acts of Parliament, 307
appeal from, to Comptroller, 213
all applications to register marks to be notified to Comptroller, 212
at expiration of five years from 1st January, 1884, to close their Register of Corporate Trade Marks, 213
procedure on application to, to register a trade mark, 285 *et. seq.*
provisions relating to, in Act of 1875 unworkable, 103
registration of Sheffield marks, 211
marks, law on registration of, amended, 111
CUTLERY
edge tools or raw steel, Sheffield Register, 211
DECEASED INVENTOR
patent granted to representative of, 118, 133, 167
within six months of decease, 167
DECLARATION
to be made by applicant for patent (section 5), 118
in trade marks matters how to be made, 287
DEFECTIVE titles of invention, instances of, 31

DEFAULT
of applicant for registration of trade mark, 191
DEFINITE,
if specification be not, patent void, 46
DEFINITION
clause of Act (section 117), 234
of copyright in designs (section 60), 189
difficulty of, defining invention in provisional specification, 38
of proprietor of design, 189
of invention in provisional specification, 37, 38
Part II. of Act, Patents (section 46), 176
of property in trade marks, 76
of trade mark (section 64), 192
of trade mark extended, 110
of old trade mark, 78
DELIVERY OR SALE
of articles to which registered design is applied, 182
DESCRIPTION,
prior publication of invention by, in published work, 19
DESIGNS. See Registration of Design
action for falsely representing design is registered, 189
amendments of law respecting, 109, 110
application for registration of (section 47) 178
assignment if registered, to be entered upon Register, 217
contrary to law or morality, Comptroller to refuse to register, 216
definition of (section 60), 189
definition of proprietor of, 189
is extrinsic to article to which it is applied, 71
may be registered in more than one class, 178
classes of goods for (section 47), 178
inspection of registered, when copyright expired, 270
notice of intention to exhibit unregistered design, 271
Part III. of Act, 177
provisional registration of, abolished, 110
Register of (section 55), to be evidence, 184
Registered, searches on production of sketch of design, 271
rules, 266
scandalous are not to be registered, 204
whether useful or ornamental, entitled to copyright, 69
DESIGNS, COPYRIGHT IN,
what it is, 72
design must be new at date of registration, 71
distinguished from patents and trade marks, 71
if design used in foreign country, and not used in United Kingdom within six months after registration here, copyright ceases, 70
history of law of, 68
ornamental and useful, formerly distinct, 68
principles of law upon, unaffected by Act of 1883, 70
protection is not for article to which design applied, but to the *design*, 71
proprietor not author entitled to, 72
provisional registration abolished, 70
under old law, period of, varied according to class, now five years, 69, 70, 110
DESIGNS FOR ORNAMENT
not patentable, 5
DESTROYED PATENT, 168
DETERMINATION OF TRADE MARK,
with goodwill of business, 200

DISCRETION OF COMPTROLLER,
only to be exercised adversely to applicant after opportunity for being heard, 222
DISCLOSURE
if confidential, of invention before patent, 23
unconfidential of invention before patent, whether a publication, 24
DISCLAIMER. See Amendment of Specification
curing defective patent by, 25, 138, 249
during action, 107, 141
DISTINCTIVE DEVICE, HEADING, &c.
what held to be under Act of 1875, 194
DOCUMENTS, &c.,
amendment of in trade mark matters, 285
copies of all, affecting proprietorship of patents must be supplied to Comptroller, 144
may be delivered at Patent Office by post, 243
DOWNY FLUFF
from cotton lace, removing, patent for, 6
DRAWINGS
are part of specifications, 63
cannot be relied upon as describing part of invention unnoticed in verbal part of specification, 63
must accompany complete specification if required, 119
accompanying specification, referred to Examiner (section 6), 125
subsidiary to verbal part of specification, 63
DRAWINGS, PATENTS,
copies of, 245
for illustrated journal, 246
size of, 245
DURATION OF PATENT (section 17), 136
EDGE TOOLS,
cutlery or raw steel, Sheffield Register, 211
EDINBURGH
transmissions of specification, &c., to be sent to, 221
EDISON'S, Mr.
Patent for Telephone, 39
ENACTMENTS REPEALED, 230
ENLARGEMENT OF TIME,
in designs matters, 270
for renewing patent, 136, 247
general power of Comptroller to grant, 248
in trade mark matters, 285
EQUIVOCAL,
if specification is, patent bad, 46
ERRORS
verbal in specification, 61
ESSENTIAL
particulars of trade marks, 79, 193
"ETHIOPIAN"
and white lines upon black surface a trade mark, 80
"EUREKA"
shirts held trade mark, 80
EVIDENCE,
certificate of Comptroller to be, 222
certified copies or extracts from documents, &c., and registers kept at Patent Office, 219
power of Comptroller to dispense with, 252, 269, 285
primâ facie, what it is, 223

EVIDENCE—*continued.*
Register of Patents, *primâ facie*, 144
registration of trade mark when *primâ facie* and when conclusive of right, 207
EVIDENCE IN PATENT CASES
confined to particulars of breaches and objections, 154
EXAMINER
applications for patents referred to, 125
appointment and duties of, 108
to see application is for one invention only, 126
duty to compare title with specification, 30
and complete with provisional specification, 128
likely to be strict in enforcing that provisional specifications shall contain only one invention, 166
reports of, to be secret and exceptions to rule, 128
to report on all applications with similar titles, and to give notice to applicants, 126
EXCELSIOR
white soft soap held trade mark, 80
EXHIBITION
at industrial or international, not to prejudice right to subsequently obtain patent if certain conditions fulfilled, 104, 169
industrial, &c., inventions, rules, 243
of unregistered design at industrial or international, 185
EXISTING PATENTS
before Act (section 45), 175
patent for improvement of, 18
EXPERIMENT,
complete specification must be intelligible without, 51
before patent does not invalidate, 22
if publication of invention, 22
EXPERIMENTAL
previous use abandoned, 23
EXPLANATION OF SPECIFICATION (section 18), 138
See amendment of specification
EXTENSION OF PATENT (section 25), 146
accounts of patentee must be clear, 148
Act contains principles for granting an, 107
cases on applications for, collected in note to section 25, 147
caveat against, 146
circumstances, delay in working, 148
circumstances, difficulty in introducing invention, 148
conditions and provisions; annuity to inventor, 148
costs given to successful opposer or applicant, 147, 148
petition for, all material facts must be candidly stated in, 147
petition for, Crown attends hearing, 148
Privy Council to make rules of procedure, 146
petition for, to be presented six months before expiration of patent, 146
profits: expenses of patentee will be considered, 147
profits, made in foreign countries, and from manufacturing, 148
profits; question is what ought patentee to have obtained by proper management, 148
restrictions, 148
to be granted only if patentee has been inadequately remunerated (section 25, sub-section 5), 146
to obtain, there must be meritorious invention, 147
what Privy Council are to consider on petition for (section 25), 146
FALSEHOOD, if specification contain, patent void, 45

FANCY
names, Turin, Sefton, &c., held trade mark, 81
words held not trade mark within Act of 1875, now are (section 64), 192
FEES
alterations in fees payable for patents, in Act, 104
enlargement of time for paying, 108
designs, list of, 272
patents, list of, 145, 255
trade marks, list of, 211, 288
on applications for patents made before Act, 175, 176
FINANCIAL PROJECTS
not generally patentable, 5
"FLAVELL'S PATENT KITCHENER,"
trade mark of; refused protection for unauthorised use of word "patent," 87
FORMS
of patent, 235
where obtainable, 107
FORMS, DESIGNS
application for registration, 273
appeal to Board of Trade from refusal of Comptroller to register, 273
certificate of registration, 273
application for copy thereof, 274
request for certificate for legal proceedings, 274
certificate for legal proceedings, 274
request to enter subsequent specification on register, 274
declaration in support, 274
notice of intended exhibition of unregistered design, 275
request to correct clerical error, 275
of entry of new address, 275
FORMS, PATENT, 257
application for patent, 257
when invention communicated from abroad, 258
provisional specification, 258
complete specification, 259
opposition to grant of patent, 259
application for hearing by Comptroller, 260
application for amendment of specification or drawings, 260
opposition thereto, 260
application for compulsory license, 261
petition for compulsory license, 261
opposition thereto, 262
application for certificate of payment or renewal, 262
application for enlargement of time for payment of renewal fee 262
request to enter name on Register of Patents, 263
declaration in support, 263
request to enter notification of license on Register of Patents, 263
application for duplicate patent, 264
notice of intended exhibition of unpatented invention, 264
request to correct clerical error, 264
certificate of Comptroller, 265
notice of alteration of address in register, 265
application for entry of order of Privy Council on register, 265
appeal to Law Officer, 265
FORMS, TRADE MARKS, 290
application to register, 290
additional representations to accompany, 291
appeal to Board of Trade, 291

FORMS, TRADE MARKS—*continued.*
transmitting fee, 291
notice of opposition to registration of trade mark, 292
request to enter subsequent proprietor in register, 292
and declaration to accompany, 292
request for certificate of refusal to register, 293
notice of application to alter address in register, 293
notice of application to alter or rectify register, 294
application to cancel entry in register, 294
declaration in support thereof, 295
request to correct clerical error, 296
request for certificate of registration for use abroad, 296
request for certificate of registration for use in legal proceedings, 296
application for settlement of special case, 297
general certificate of Comptroller, 297
request for copy of official notification of registration, 297
appeal from Cutlers' Company to Comptroller, 298
FOXWELL'S PATENT
for Sewing Machines, bad for claiming too much, 56
FRAUD
on public does not entitle owner of trade mark to relief unless his property infringed, 84
patent obtained by true inventor not invalidated by previous patent obtained by, 168
principle of law of trade marks to protect from, 81
upon public by forged trade mark, relief obtained at suit of Attorney-General, 85
when patent revoked for fraud, another in lieu thereof may be granted to the true inventor, 150
FRAUDULENT
entry in register will be expunged by the Court, 220
publication of invention, inventor protected against, 24
use of trade mark unnecessary to prove in action, 83
use of words, "patent," "patented," "registered," 228
FOREIGN
book, importation of, no anticipation unless actually published, 20
country, effect of use of design in, upon registration in United Kingdom, 70
countries, arrangement with, for protection of inventions, designs, and trade marks, 227
country, registered design used in and not in this, 184
patents, British patents no longer expire with previously dated, 109
vessels in British waters, use of patented inventions by, 172
FOREIGNERS
entitled to apply for patents, 118
FORGING
or counterfeiting a trade mark a misdemeanour, 101
entries, or copies of entries, in registers a misdemeanour, 222
GOODS. Same trade mark not be registered more than once for same goods, 201.
See classes of goods.
GOODWILL,
in sale of, trade mark passes, although not mentioned, 200
trade marks assignable only in connection with, of business in goods to which they relate, 95, 200
what it is, 200
GRANT OF PATENT, 117
GRASPING CLAIMS to be avoided, 17, 66
GREAT MOGUL
stamp refused protection, A.D., 1742, 74

GREAT SEAL
seal of Patent Office substituted for, 108
HARRISON'S PATENT
for turntables bad for claiming too much, 55
HOT-AIR BLAST,
patent for combination with anthracite coal, 7
HOLIDAYS,
provisions as to (section 98), 223
"HOWQUA'S MIXTURE"
trade mark bad, because of misrepresentation in, 85
IDEA,
mere, not patentable, but method, process or machine for carrying out is, 5
publication of, not anticipation of invention, 20
IDENTICAL TRADE MARKS
not be registered for same goods unless by order of Court, 201
ILLEGAL
or immoral purposes, patents for, are invalid, 28
patents for monopolies, 1
IMMORAL
or illegal purposes, patents for, are invalid, 28
IMPROVEMENTS,
inventions for, more numerous than for principles, 53
where patent for several improvements, each must be of some utility, 27
IMPORTER
of invention considered inventor, 11
INDIA
arrangements with, for protection of invention, designs and trade marks, 228
INDUSTRIAL AND INTERNATIONAL EXHIBITION
notice of intention to exhibit unregistered design, 271
exhibition of unregistered design at, 185
inventions (rules), 213
INFANTS,
lunatics, &c. (section 99), 224
patent can be granted to, 118
INFRINGEMENT OF PATENT,
action for, Assessor to be called in, 153
action for, Court may order injunction, inspection, or account, 157
action for. Delivery of particulars of Objections, 154. See Particulars of Breaches and Particulars.
action for, power of Court to allow amendment of specification during, 141
during interval between failure to pay renewal fees and enlargement of time (section 17), 136
trial to be without jury unless ordered, 153
judge may certify validity of patent came in question, and in subsequent action plaintiff to have costs as between solicitor and client, 162
INFRINGEMENT OF TRADE MARK,
proceedings for (section 77), 208
INGREDIENTS,
of valid patent, 15
INJUNCTION,
Court may order in patent case, 157
final in patent cases when and principles upon which granted, 159
interlocutory, in patent cases when and principles upon which granted, 158
advisable to apply for, 159
to restrain threats of proceedings for alleged infringement of patent, 162
cases upon, 163 *et seq.*
INNOCENT USE OF TRADE MARK no excuse, 83

INSPECTION
when, and principles upon which granted, in patent cases 157, 159
of registered designs, 183
INSTANCES OF OLD TRADE MARKS
held entitled to protection, 80, 81
INSTRUMENTS AND MUNITIONS OF WAR,
assignment of patents for, to Secretary for War, 173
INTERNATIONAL
exhibition of unregistered design at, 185
and colonial arrangements, 227
or industrial exhibition, showing unpatented invention at, not to prevent patent being afterwards obtained if certain conditions fulfilled, 169
union, power to join, 111
INVENTION,
all represented and claimed as, must be novel, 25
apt to change form between provisional and complete specifications, 38
definition of, in provisional specification, 37
definition of (section 46), 176
partly original and partly communicated, 121
instances of defective titles of, 31
inventors overrate merits of, 53
law protects agninst colourable imitations, 66
list of subjects patentable, 5
novelty and utility necessary to support patent, 14
one involving use of another, 17
patent limited to one, 107
patented ; use of, by British ship in foreign waters, 173
prior publication of, in book or by use, 19
subsidiary, patent for, 18
titles of, instances of, held good, 32
title ought to describe, 29
what is, 14
INVENTORS,
clashing between, 16
first introducers of inventions held to be first, 120
may be assisted in details of invention, 12
overrate merits of invention, 53
patent granted to true, not invalidated by previous patent obtained by fraud, 168
they are, who first practically introduce a manufacture, 13
tendency among, to make grasping claims, 65
tendency of, to claim more than their due, 16
true and first, proper grantees of patents, 11
IRELAND,
provisions as to Courts in, 230, 231
transmission of specifications, &c., to, 224
ISLE OF MAN,
Act extends to, jurisdiction of Courts in, punishment of misdemeanour in, 232
British patent covers, 135
JOINT
applications for patent, 117, 123
inventors, 12, 118
JOURNAL
illustrated, of patented inventions, 108 ; to be kept on sale by Comptroller, 171
JURY advisable in patent cases when issue one of fraud, 153
meaning of technical terms for the, 61
trial of patent case to be without a, unless specially ordered, 153

KAY'S PATENT for Treating Flax lost through bad claims, 56
LAW existing previously to Act, 103
LAW OFFICERS. See Application for Patent, Appeal to Law Officer.
may examine witnesses on oath, 169
may make rules, 169
may order costs (section 38), 169
rules of, 253
to hear appeals from Comptroller on opposition to patents, 131
may obtain assistance of expert, 131
to give directions to Comptroller in cases of doubt or difficulty, 222
LEGAL PROCEEDINGS, assessors to be called in (section 28), 153
for infringement (section 77), 208
LEGAL REPRESENTATIVES, who are, 167
LIEBIG'S EXTRACT OF MEAT, trade mark become *publici juris*, 91
LICENSES under patents must be by deed, 166
granting of compulsory, 107. See also Compulsory Licenses
under patents to be entered on register, 144
"LINOLEUM," not trade mark in, 93
LIST of subjects of patentable inventions, 5
"LL" WHISKEY held trade mark, 80
LOOSE description, to be avoided, 17
LOST PATENT, 168
LUNATICS, INFANTS, &c. (section 99), 224
MANDAMUS,
order of Board of Trade, enforceable by, 143
MANUFACTURE,
forgotten and re-invented, whether subject of patent, 20
patent must be for a new, 3
word in section 6 of Stat. of Monopolies, and what included therein, 3
MANURE, extracting, from sewage, patent for, 9
MARKING GOODS
to which registered design has been applied, 182, 270
MASTER OF THE ROLLS,
jurisdiction over Register of Patents, 220
now abolished, 220
MERCHANDISE MARKS ACT, 1862, 99, 100, 101
definition of trade mark in, 76
fraudulent imitation of trade mark is not forgery at common law, 100
offences constituted by, 101, 102
penalty for marking, with intent to defraud, &c., any article so as to make it appear to be protected by patent, 102
to prevent fraudulent marking of goods, 100
MEMORANDUM UPON BILL when introduced in Parliament, 103
METHOD, new, of applying old thing, 8
"MEXICAN BALM" (MEDICATED), false statements in trade mark, 86
MINE RUBBISH, patent for application of, to smelting, 6
MISDEMEANOUR, forging or uttering false entries in registers, 222
MISLEADING OR AMBIGUOUS SPECIFICATION, 46
MISREPRESENTATION
as to utility, avoids patent, 28
of facts upon which patent granted renders it void, 3
MISREPRESENTATION IN TRADE MARKS, 85
effect of, 89, 204
containing misrepresentation cannot be registered, and if registered by mistake can be removed from register, 89
by misuse of word "patent," 86
immaterial, whether wilful or not, 86
no excuse if too gross to deceive, 86

MISTAKE, patent not void for mistake of advisers of the Crown, 3
MIXING substances in proportions to form compound, patent for, 9
MODEL patentee may be required to furnish, of invention, 172
MONOPOLIES,
Statute of, invention means new manufacture within, 176, 177
Statute of (section 6), 2, 177
MUSEUM, Patent (section 41), 172
NAME of individual or firm may be a trade mark, 192, 193
NATURAL PRODUCT, name of, cannot be trade mark, 92
NEGLIGENCE or acquiescence may forfeit right to trade mark, 89, 90
NEW USE of old invention not patentable, 4
NOVEL,
all that is claimed as invention must be, otherwise patent bad, 25
if invention wholly, Courts anxious to protect from colourable infringement, 54
all points of novelty intended to be claimed, must be covered by the complete specification, 38
design must be new at date of registration, 71
reasons why, essential to patentable invention, 17
to public, sufficient to support patent, 17
novelty, invention and utility necessary to support patent, 14
what is novelty as regards patents, 15
NUMBERING spools, system of, held to be trade mark, 80
OBJECT OF ACT, 103
OBJECT same, of two or more independent inventions, 17
OFFENCES under Act (section 105), 228
falsely representing articles to be patented, or design or trade mark registered, 228; falsification of Registers (section 93), 222
wrongful assumption of Royal arms, 229
OLD MARKS,
no proceedings can be taken for infringement of, unless registered or registration refused, 208
OLD TRADE MARKS, definition of, 78
distinction between, and *new*, 77
used before 13th August, 1875, 79
OMISSION OF A STEP,
patent for processes, differing only from old processes by the, 5
OPPOSITION TO AMENDMENT OF SPECIFICATION,
notice of, and procedure upon, 246, 249
OPPOSITION TO GRANT OF PATENT
opponent's evidence, 246
applicant's evidence in answer, 246
opponent's evidence in reply, 246
closing of evidence, 247
decision of Comptroller to be notified to parties, 247
decision of Law Officer final, but not binding in subsequent proceeding, 132
further evidence, 247
grounds of (section 11), limited to three, 130, 131
hearing of, 247
notice of, 246
notice of hearing, 247
notice of, to applicant, 131
notice of, to be in writing, 131
opportunity of opposing at the seal abolished, 132
when ground of, prior patent, particulars thereof must be given in notice, 246, 247
when to be made, 130
OPPOSITION TO REGISTRATION OF TRADE MARK (section 69), 198
costs in case of, 199

mode of bringing matter before the Court, 199
time and procedure for, 199
ORDER IN COUNCIL, arrangement with foreign countries and colonies, 227, 228
ORNAMENTAL DESIGN, copyright in, formerly distinct from useful, 68
distinction abolished, 69
PATENT AGENTS and patents of communication, 11
PATENT. See also Patents, *infra*.
all claimed as invention must be novel at date of, 25
form of, 235
application for and grant of (section 4), 117, 118
assignee of, cannot sue for infringement unless registered as proprietor, 217
assignment of, to be entered upon register, 217
consideration for grant of, entire, 25
definition of (section 46), 176
duration of (section 17), 136
existing for one application of known thing, does not prevent another for another application, 18
extension of (section 25), 146 See Extension of Patent.
failure to pay renewal fees, relief from (section 17), 136
failure to pay renewal fees, no power to enlarge time when arising from neglect, 138
failure to pay renewal fees, subsequent enlargement of time, effect of an action for infringement (section 17), 136
first term of patent extended from three to four years, 108
for improvement of existing patent, 18
for subsidiary invention, 18
fraudulently marking goods with word "patent," 102
granted for invention, result of knowledge obtained in discharge of public duties, 118
granted for three things, and one proved useless, held void, 28
if any part of invention claimed be old, whole invalid, 25
if use of word in trade mark calculated to deceive, owner loses his remedy, 86
but may be used where no patent in existance so as not to deceive, 88
instrument by which grant made from Crown, 1
invention, novelty, and utility necessary to support, 14
invalid if for illegal or immoral purposes, 28
lapses if not kept in force by payments at prescribed times (section 17), 136
lost or destroyed, 168
may be sealed to legal representative of deceased applicant, 133
may contain more than one claim (section 33), 166
must be for a new manufacture, 3
not to prevent use of invention by foreign vessel for purposes of navigation in British waters (section 43), 172
not to extend to vessels of countries where reciprocal privilege not granted, 172
not void for mistake of Crown, 3
primâ facie, valid, onus to prove not so upon person alleging invalidity, 165
object of, to secure benefit of invention to the public. 13
opposition to grant of (section 11), 130
revocation of, 149 See Revocation of Patent.
sealing of a, for one application not to prevent sealing of another for an earlier application, 133
to avoid, must have been prior publication, 13
to bind Crown (section 27), 151
to be dated and sealed as of day of application, 133
to be for one invention only (section 33), 166
to be limited to one invention, 107
to be sealed within 15 months from application except appeal pending or applicant dies, 133

PATENT—*continued.*
trade mark may state that article made according to, expired. Cheavin *v.* Walker, 88
unauthorised use of word, in trade mark disentitles latter to protection, 86
void if granted upon untrue representation or false suggestion, 3
where to have effect (section 16), 135
where word is used in trade mark as part of designation of article known by that name, 87, 88
PATENTS. See also Patents, *supra.*
all matters affecting ownership or validity of, to be entered on Register, 144
alterations of law and fees payable with regard to, in Act, 104
are granted to foreigners, 12
assignment of, to Secretary for War, 173
British, no longer cover Channel Islands, 135
construed strictly, but in favour of validity, 3
contrary to law or morality, Comptroller to refuse to grant (section 86), 216
copies of all documents affecting proprietorship must be supplied Comptroller (section 23), 144
of communication, 11, 12, 119
existing, before Act (section 45), 175
for instruments or munitions of war, 173
granted on applications made before Act, 175
not liable to compulsory licenses, &c., but do not bind the Crown, 175
may be granted to any number of joint inventors, 12
may be granted to other persons than inventor jointly with him, 109
obtained upon untrue representations are invalid, 120
obstructive, 27
Register of (section 23), 144
to whom may be granted, 11
PATENT CLERKS,
Law Officers, 30
PATENT JOURNAL
(section 40), 171
PATENT MUSEUM, 109, 172
PATENT OFFICE,
attendances at, number of, reduced by Act, 104
and proceedings thereat (section 82), 215
hours of business, 241
seal of, 108, 132, 216
will sell forms under Act ready stamped, 107
"PATENT PLUMBAGO CRUCIBLE COMPANY,"
trade mark of, held disentitled to protection for unauthorised use of word patent, 86
PATENTEE. *See also Patentees, infra.*
definition of (section 46), 176
includes assignee or other representative of grantee of patent, 177
may assign for part or place of kingdom, 168
may be assisted in working out details of invention, 12
may be required to furnish model of invention, 172
meaning of (section 18, note *a*), 139
no longer required to represent his invention as of public utility, 26
receiving invention from person abroad, may take out patent in his own name, when, 120
unauthorised use of word, disentitles trade mark to protection, 86
PATENTEES. See also Patentee, *supra.*
one only need be inventor, 123
joint, each may use invention without accounting to others, 118
PATENTED, *falsely representing article as, penalty for,* 109, 228

"PARAFFIN OIL,"
no trade mark in the name of, 92
PARTIAL USE
and abandonment thereof, 23
PARTICULARS OF BREACHES
may be amended by leave of Court, 154
on what terms probably, 157
to be delivered with Statement of Claim. 154
regarded in taxation of costs, 154
what they should contain, 154
PARTICULARS OF OBJECTION, 154
certificate of Judge is essential as to, should be as to each particular, 157
cannot be given after taxation, 157
if insufficient, plaintiff should obtain order at Chambers for further and better ones, 156
may be amended by leave of Court. 154
on what terms probably, 157
must state grounds upon which validity of patent is disputed, 154
must state time and place of alleged prior user, 154
regarded in taxation of costs, 154
to be delivered by plaintiff in proceeding for revocation of a patent. 149
may be amended, 149
to be delivered with Statement of Defence. 154
what they should contain, 155
PARTICULARS,
essential of trade mark (section 64), 192
PARTNERSHIP,
trade marks are *prima facie* part of. property. 96
"PECTORINE,"
word, held trade mark. 81
PENALTY
for falsely representing article as patented, 109, 228
for using Royal arms without authority, 109, 229
for using registered design without consent of owner. 186
PERSONS entitled to apply for patent, 117
PHONOGRAPH,
Edison's Patent for Telephone invalid. variance between provisional and complete specification, 39
PROBLEM,
complete specification must not merely suggest, but must explain solution of, 51
POINTS OF NOVELTY
claimed in complete must have all been covered by provisional specification, 38
P
documents may be delivered at Patent Office by, 243
communications with Patent Office on trade mark matters may be by post, 279
PREROGATIVE OF CROWN.
Act not to abridge, 233
law as to, affected by section 27, 152
PREVIOUSLY TO ACT,
law existing, 103
PRIMA FACIE EVIDENCE,
what is, 145, 223
PRIMARY IDEA,
patentee may receive subsidiary improvements to, 12. 13
PRINCIPLE,
specification should state whether invented for application of, or for combination. 52
inventions less numerous for. then for improvements or combinations. 53

PRIOR PUBLICATION
by use, 21
avoids subsequent patent, 21
PRIVY COUNCIL
petition for extension for patent, what to be considered, 146
PROCEEDING
against infringers of trade marks cannot be taken, unless mark registered or registration refused, 79
for infringement of trade mark (section 77), 208
PROCEDURE
as to patents simplified by Act, comparative table of under Act, 105, 106
PROPERTY
in trade marks, patent, and designs may be combined for one subject, 77
in trade marks, distinguished from in patents and designs, and defined, 75, 76
plaintiff must show his, in trade mark has been interfered with to obtain protection, 83, 84
PROPRIETOR OF DESIGN,
definition of, 189
is entitled to register, not the author, 72
PROPRIETOR OF PATENTS, DESIGNS, AND TRADE MARKS,
person entered upon register as, to have power to deal with, 217
PROPRIETOR OF TRADE MARK
to renew registration every fourteen years, 209
PROPRIETORS,
register of, now merged in Register of Patents, 144, 233
PROPRIETORSHIP OF PATENTS,
all matters affecting, to be entered on Register, 144
PROTECTION
by complete specification (section 15), 135
by copyright in design, is to the *design* not to article to which it is applied, 71
by patent, object to secure benefit of invention for public, 13
for trade mark, plaintiff must show his property in, has been interfered with, to obtain protection (Batty *v.* Hill), 84
provisional, what it is, 33, 35
PROVISIONAL. See also specification provisional.
registration of designs abolished, 70
protection, what it is, 33, 35, 134
protection abandoned (note *e*), 127
period of, fifteen instead of six months, 107, 108
protection, application for patent may be abandoned within period of, and fresh application containing same and additional materials made
specification, 43
"POSSENDEDE,"
Turkish word, held trade mark, 80
POST,
all documents under Act may be sent by, 223
application for patent may be sent by (section 5), 118
offices in chief towns to sell patent forms and stamps, 107
'PUBLIC DOMAIN," invention passed into, 24
PUBLICI JURIS names, "Paraffin Oil," "Linoleum," "Condy's Fluid," "Angostura Bitters," 92, 93
test whether trade mark has become (Mellish, L.J.), 90
trade marks disentitled to protection, 89
PUBLIC USE of trade mark, 206
PUBLICATION,
cases upon, with regard to patents, also authorities upon, copyright in designs, 71
confidential disclosure of invention before patent is not, 23
by use, not necessary to be general, 21

immaterial whether patentee derived his knowledge therefrom or not, 20
in book; book must have been accessible to be an anticipation, 20
mere general description in book not, 19
of invention fraudulent, inventor protected against, 21, 168
of invention by description, 19; by use, 21
of unpatented invention during period of international or industrial exhibition not to prevent (section 39) patent being afterwards granted, if condition fulfilled, 169
previous, of invention in book, 19
unconfidential disclosure of invention before patent, whether, 24
PURIFYING
coal gas by a chemical compound, 9
"PYRECTIC SALINE,"
trade mark in, disentitled to protection because of owners' unauthorised use of word "patent," 87
RACING FOR THE SEAL abolished (section 13), 134
RECTIFICATION of registers by the Court, 219
REFUSAL TO REGISTER a trade mark, certificate of, 208
REGISTERS
Court will expunge fraudulent entry in, 220
entries in, affecting third parties will be corrected by the Court, 220
falsification of entries, or copies of, in, a misdemeanour, 222
kept under Act to be open to inspection, 218
rectification of, by the Court, 219
REGISTER OF DESIGNS
entry upon, of particulars of ownership, 268
entry upon, of subsequent proprietors, &c., procedure upon, 268
to be evidence, 184
under old Acts, 233
REGISTER OF SHEFFIELD MARKS, 211
REGISTER OF TRADE MARKS (section 78), 209
alteration in address, 284
Comptroller to remove mark from register if not renewed every fourteen years, 210
entry of subsequent proprietor, 282
procedure for, 282, 283
rival claimants, 283
entry of trade mark in, 282
entry of representative of applicant in case of his death before registration completed, 282
inspection of, 285
order of Court affecting, 284
publication of rectification of, or variation in, 284
removal of mark from register, 284
under old Acts, 233
REGISTERED DESIGN
action for damages, 188
injunction may be also claimed, 188
before proceeding for using, advisable to give notice to defendant, 18
Comptroller to inform if registration still exists, 183, 184
inspection of, 183
knowledge that use was without consent of proprietor, 187
no one to use, without license of owner, 186
penalty for doing so, 186
used in foreign country and not in this, 184
what is fraudulent or obvious imitation of, 187
what is using, 187
REGISTRATION OF DESIGNS (section 47), 178

REGISTRATION OF DESIGNS—continued.
application for, Comptroller to decide as to class of goods, 178
application for, drawings, &c., must be furnished, 181
Comptroller may refuse insufficient ones, 181
application for, must contain statement of design and class of goods, 178
amendment of documents, &c., 270
appeal to Board of Trade, procedure upon, 268
appeal from Comptroller to Board of Trade, 178, 179
application for, &c., may be made through agent, 266
procedure upon, 266
where to be made, 266
classification of goods, 266, 276
certificate of Comptroller for legal proceedings, 270
certificate of, 181; copies of, 181
Comptroller to hear party before exercising discretion adversely, 267
Comptroller to state whether still in force, 183, 184
drawings, 267
fees for (section 56), 185, 272
goods must be marked before sale, 182
industrial and international exhibitions, 185
instances of designs held proper for registration, useful, 179
ornamental, 179
instances of designs held improper for registration useful, 179
ornamental, 180
marking goods to which registered design is applied, 270
meaning of "proprietor," 178, 179
necessary to register in all classes of goods to which design is to be applied, 181
provision as to marking, strictly construed, 183
statement of the nature of design, 180
specimen of articles must be furnished to Comptroller before sale, 182
to cease if design used in foreign country and not in this, 184
REGISTRATION OF TRADE MARKS
applicant for registration of common mark as part of trade mark, must disclaim right thereto, 205
could be expunged if no use made thereof, under rules of 1875-7, 98
equivalent to public user of, 97, 206
if not completed in twelve months to be deemed abandoned, 191
must be renewed every fourteen years, 97, 98
not conclusive as to title to, even after five years, 97
renewal of, 209
REGISTER OF PATENTS (section 23), 144
and proprietors under old Acts, 233
assignment to, entered in, 250
contents, *primâ facie* evidence, 144
copies of deeds, &c., affecting proprietorship of patents, must be supplied to Comptroller, 144
Designs and Trade Marks, person entered as proprietor to have power to deal with, 217
entries, certified copies of, 252
entry in, of failure to pay renewal fees, &c., 251
entry in, of licenses, 251
entry in, of orders of Court or Privy Council, 251
entry in, of payments of renewal fees, 251
particulars to be entered in, upon sealing of patent, 250
procedure to enter assignment therein, 250
when open to public, 252
REGISTER OF DESIGNS AND TRADE MARKS, no trust to be entered upon, 216

REGISTER OF PROPRIETORS OF PATENTS
discontinued, 108
RE-INTRODUCTION
of forgotten invention whether subject of patent, 20
RENEWAL OF PATENTS
procedure for, 247
changes in fees payable, 137
certificate of payment or renewal, 247
enlargement of time for, 248
by prescribed periodical payments (section 17), 136
REPEAL
of previous Acts, 232
not to affect past operation of, 232
of previous designs rules, 271
of previous trade mark rules, 287
of statutes, 235
REPRESENTATIONS of articles to which registered designs has been applied, must be furnished Comptroller before sale thereof, 182
REPORTS
annual to Parliament, 226
of patent cases in *Patent Journal*, 171
REPUTATION of persons manufacturing goods protected by trade mark, 74
trade marks protect, 81
RESTRAINING
threats of proceedings for alleged infringement of patent (section 32), 162
cases upon, 163 *et seq*
RESTRICTED MEANING, when interest of patentee to give, to specification, 61
REVOCATION OF PATENT (section 26), 149
action for, assessors to be called in, 153
on the ground of fraud, patent may be granted to true inventor in lieu of that revoked, 150
proceeding for, appropriate remedy for inventor whose invention has been stolen, 151
proceedings for, plaintiff must delivered particulars of objection, 149
proceedings for in Scotland, 234
proceeding for, substituted for *scire facias*, 107
power of Court to allow amendment of specification during action for, 141
to be entered on register, 144
trial to be without jury unless ordered, 153
who may present petition for, 149
ROYAL ARMS, penalty for using, without authority, 109, 229
RULES
designs, 266
patents, 241
trade marks, 277
Law Officers, 253
Law Officers may make, 169
past operation of, under previous Acts, 233
repeal of previous trade mark, 287
repeal of previous design, 270
repeal of previous patent, 252
SALE, prior use evidenced by, 21
SALARIES of *officers* under the Act, 216
SATURDAY, when last day for doing anything (section 98), 223
SCANDALOUS designs, not to be registered, 204
SCHEMES, not generally patentable, 5
SCIRE FACIAS,
proceeding by, abolished (section 26), 149. See next page.

SCIRE FACIAS—continued.
proceeding by, to repeal patent, abolished, petition for revocation substituted, 107, 150
SCOTLAND, provision as to Courts in, 230, 231
SCULPTURE, power to register works of, abolished, 110
SEAL OF PATENT OFFICE, 216
SEALING OF PATENT,
not to prevent sealing of another patent on an earlier application, 133
SECRET USE prior secret, will not invalidate patent 27
SECRETARY FOR WAR, assignment of patents to, 173
SCIENTIFIC PRINCIPLE not subject for patent, 1
SECRET INVENTION, no objection to subsequent patent for same invention, 13
SECURITY FOR COSTS, in cases of opposition to registration of trade marks, 199
"SEIXO," name with mark of a Crown held trade mark, 81
SERVICE of all documents at Patent Office may be by post, 223
proof of, 223
SERIES OF TRADE MARKS, registration of (section 66), 196
how assignable, 196
SHEFFIELD MARKS, law as to registration of, amended, 111, 211
procedure to register, 285, *et seq*
SHEFFIELD REGISTER,
one person may register two or more marks in, 213
Corporation or Company may register a trade mark in, 213
summary punishment of infringements of trade mark in, 213
SKILL,
complete specification must enable persons of ordinary, to construct invention, 49
SOFT METAL, patent for, application of, for packing machinery, 18
SHORT TITLE OF ACT, 117
SIMULTANEOUS inventions, patents for, 13
"SINGER'S" SEWING MACHINES,
name whether become *publici juris*, 91
SINGLE LETTERS as old trade marks not within Act of 1875, 193
SPECIFICATIONS
are addressed to persons acquainted with subject, 49. See also Specification Complete and Specification Provisional.
all, must contain title (section 5), 119
all, must be open, explicit, and honest, 37
amendment of (section 18), 138. See Amendment of Specifications.
construction of, belongs to the Court, 61
if candid and accurate, construed in favour of inventor, 60
must distinguish between new and old, 58
not sufficient if only capable of being understood by persons of extraordinary knowledge, 50
not to be construed astutely to find flaws therein, 60
referred to Examiner (section 6), 125
should state whether invention for application of a principle or for a combination, 52
to be construed fairly, 60
use of drawings with, 63
when interest of patentee to give wide and restricted meanings thereto, 61
SPECIFICATION, COMPLETE, 28
appeal to Law Officer from refusal to accept, 128
advantageous to file, quickly, 135
after acceptance of, application cannot be abandoned and fresh one made, 130
claims to be construed, with context of, 65
claims compulsory in, 63
concealment in, avoids patent, 45
danger of fraudulent opposition with, open, 130

decision of Comptroller or Law Officer in favour of, not binding in future proceedings, 129
essentials of (section 5), 119
even greater care than with provisional, required for drafting, 45
if it omits to mention anything essential to invention, patent void, 47
if invention be an improvement in old machine, the new parts must be distinguished from the old, 48
if old and new, new not separated, patentee taken to claim all, and patent void, 48
on acceptance to be open to inspection, 130
policy of provision discussed, 130
publication of (section 10), 129, 130
provisional cannot be called in to aid, 62
protection by (section 15), 135
matter contained in provisional may be abandoned in, but matter must not be substituted for it, 42
must be accepted within twelve months from application, unless appeal pending, 128
must be accurate, 47
must be filed before patent granted, 108
must be so full as to enable competent person to construct invention without experiment, 51
must contain claims (section 5), 108, 119
must make frank and full disclosure of invention, 45
must not be ambiguous or misleading, 46
must not be equivocal, 46
no proceeding to be taken for infringement before publication of, 133
patent void if it be false, 45
rules as to preparing, 45, *et seq.*
should be definite, 46
should be full, 46
should clearly distinguish between new and old, 47
should contain clear and accurate description and definition of invention, 45
to be advertised on acceptance, 129
to be compared with provisional, by Examiner, 128
to explain invention so that persons of ordinary skill acquainted with subject, can construct it, 49
to be filed within nine months from application, 108
to be kept on sale by Comptroller while patent in force, 171
variance between provisional and complete, 40
when Comptroller may refuse, 128
when to be left (section 8), 127
SPECIFICATION, PROVISIONAL, 28, 33
advisable to begin by stating object of invention, 38
advisable to state in it what the invention proposes to supersede, 38
before publication of, the application for patent may be abandoned and fresh one made, 43
cannot be called in aid of complete, 62
necessary to include therein all that it may become necessary to claim, 38
distinction between it and complete, 35
essentials of (section 5), 119
instances of inventions claimed in complete, not covered by, 39
introduced by Act of 1852, reasons for, 33
invention described in, should not be different from that described in complete, 42
need not contain complete description, 36
matter contained in, may be abandoned in complete, but new matter must not be substituted for it, 42

SPECIFICATION, PROVISIONAL—*continued.*
must define invention, 37
must include the points claimed in the complete, 36, 38
to state subject matter of patent, 35
variance between provisional and complete specification, cases upon, 40
what it should be, 35
SPECIAL CASE
to be submitted to Court when conflicting claims to register a trade mark, 283
settlement of, 284
SPECIMENS
of articles to which registered design is applied must be furnished Comptroller before sale thereof, 182
SPECULATIVE THEORY,
previous publication of, does not avoid patent for practically working invention, 14
STATUTE OF MONOPOLIES, section 6 of, 2, 177
STATUTES REPEALED, 238
STATUTORY DECLARATIONS, 244
STEEL RAW, edge tools or cutlery (Sheffield Register), 211
"STEPHEN'S BLUE-BLACK WRITING INK" held trade mark, 81
SUBJECT
matter of a patent, 3
same, if two or more independent inventions, no objection, 17
SUBORDINATE COMBINATION 79
SUBSIDIARY IMPROVEMENTS, patentee may receive suggestions of, 13
SUBSTANCE, hitherto unapplied, application of, 4
SUGAR, refining by using charcoal in particular way, patent for, 8
TELEPHONE, Edison's Patent, held invalid, 39
TERM OF PATENT first, extended from three to four years, 108
TEST of subject matter for patent, new, useful, new manufacture, 10
TIME, 285. See also enlargement of time.
holidays, Sunday, Saturday, &c., 223
TIME TABLE
patents, 313
designs, 317
trade marks, 318
TIME, rule as to computation of time (note *h*), 127
TITLE OF INVENTION, 28
applications with similar, 126
duty of Comptroller's Examiners to compare with specification, 30
Examiners having allowed, not conclusive, 124
instances of defective titles, 31
instances of, titles held good, 32
is published immediately, 30
must correspond with specification, 29
must give true idea of invention, 30
must not be too large or too narrow, 29
requires skilful drafting, 30
specification must contain (section 5), 119
what it is, 29
TRANSMISSIONS OF PATENTS to be entered on register, 144
TRADE MARK
additions to, common marks (section 74), 94. See also trade marks.
alleged infringement of, by plaintiffs' agent (Hirsch v. Jonas), 84.
any person selling article bearing false trade mark bound under penalty to give information where he procured it, 102
assignment of, to be entered upon register, 217
becomes *publici juris* when it has become the denomination of the commodity itself, 92

before Act of 1875 actual user of, necessary for complete title to, 97
calculated to deceive, 201, 202
calculated to deceive, likely to mislead incautious purchasers, 203
Comptroller may cancel entry, or part of entry, in register relating to, 221.
conditions of registration of (section 64), 192
containing word patent when none in existence disentitled to protection, 86
contrary to law or morality, Comptroller to refuse to register, 216
definition of trade mark (section 64), 192
cases upon, 194
extended, 110
in Merchandise Marks Act, 1862, 78
TRADE MARK. See also Trade Marks, *infra*.
determinable with goodwill of business in goods to which they relate, 200
distinctive device, mark, brand, &c., 192
essential particulars of (section 64), 192
fancy name not in common use, 192
forging or counterfeiting, is misdemeanour, 101
figures in section 64, sub-section 2, mean numerals, 194
fraud on public not enough to enable plaintiff to obtain protection, 84
fraud upon public by use of forged, relief obtained at suit of Attorney-General, 85
fraudulent use of, not necessary to entitle owner of, to protection, 83
injunction to restrain infringement refused unless plaintiff has property in, 84
improperly registered may be removed from register, 207
notwithstanding five years have elapsed since registration, 207
innocent or ignorant use of, no excuse, 83
letters, words, or figures, or combinations thereof, 192
may be registered in any colour (section 67), 197
may state the article made according to expired patent (Cheaven v. Walker), 88.
misrepresentation, collateral to, does not disentitle to protection, 88, 89
must be registered for particular classes of goods, 194. See classes of goods.
must have been used, or registration thereof could be expunged under rules of 1875-7, 98
must not contain misrepresentation, 85
name of individual, 192
name of natural product cannot be, 92
name of product, cannot be essential feature in trade mark, 92
no proceedings for infringement of, can be taken unless registered or certificate of refusal obtained, 208
no right to exclusive ownership of, in the abstract, 95
not authorised to be registered, cannot become so by being five years on register, 208
only assignable with goodwill of business, 200
plaintiff must show his property in, has been interfered with, to obtain protection for, 83, 84
power of Court to alter or add to registered trade mark, 221
right to, may be lost by negligence or acquiescence, 89, 90
renewal of registration (section 79), 209, 210
removed from register to be deemed registered for five years after for purposes of fresh applications, 210
signature as, 192
test whether it has become *publici juris*, 90
the exclusive use of a, can only be claimed for particular classes of goods, 95
the fraudulent imitation of, is not forgery at common law, 100
used before 13th August, 1875, 192
words calculated to deceive not to be registered as part of a trade mark, 204

TRADE MARKS APPLICATION TO REGISTER (section 62), 190
procedure and practice, 277, *et seq*
advertisement of, 280
Comptroller may refuse, 190
appeal from Comptroller to Board of Trade, procedure and practice, 280
conflicting claims, 201
how made, 190
if not completed within twelve months to be deemed abandoned, 191
metal goods must state what metal, 278
mode of sending notices, &c., 279
may be by post, 279
must state class of goods, 190
opposition to (section 69), 198
procedure and practice, 281, *et seq*
representations of marks, 278, *et seq*
series of marks, representations of, 279
Sheffield marks, Cutlers' Company, procedure to register, 285, *et seq*
size of documents, &c., 278
to be advertised (section 68), 198
TRADE MARK REGISTRATION OF, 190
conflicting claims as to, 201
conflicting claims to same marks, 283
Comptroller may refuse to register, 283; or submit, or require claimant to submit, special case to Court, 283
common mark may be registered as part of trade mark, 205
in colours, 197
Comptroller to give certificate of the refusal of, 208
equivalent to public user of, 97, 205
for five years conclusive evidence of right, 207
but does not prevent trade mark improperly registered being expunged from register, 208
must be renewed every fourteen years, 97, 98
notice of application for leave of Court to alter registered marks, 285
not conclusive as to title to, even after five years, 97
primâ facie evidence of right, 207
restrictions and limitations, 195, 196, 201
same mark not be registered for same goods more than once, unless by order of Court, 201
series of marks (section 66), 196
similar mark not to be registered for same goods as are on the register, 201
improper to be registered confers no rights, 208
words disentitled to protection in Court of Justice, not to be registered as part of trade mark, 204
TRADE MARKS, Part IV. of Act, 190. See also trade mark, *supra*
Act of 1875 modified definition of trade mark, 78
are part of assets of bankrupt, 96
are assignable, but only in connection with "goodwill" of business in goods associated therewith, 95
certificate of Comptroller, 286
containing misrepresentation cannot be registered, and, if registered by mistake, can be removed from register, 89
common or *publici juris* disentitled to protection, 89
definition of old, 78
definition of new (section 60 of Act of 1883), 79
distinction between *old* and *new*, 77
exaggerated or false statements in, 85
exercise of discretionary power by Comptroller, 279
fees (section 80), 211

history of law of, 74
instances of old, held entitled to protection, 80, 81
must be registered as belonging to particular goods or classes of goods, 95
no exclusive ownership in, apart from their application, 77
non-essential particulars or additions to (section 64, sub-section 2), 192
not within definition clauses of Acts of 1875 and 1883, 209
on dissolution of partnership, follow goodwill of business, but if all partners continue business, all have right to use, 96, 97
power to dispense with evidence, 285
principles of the law of, Chapter III., 74
principle of law to protect public from fraud, 81
principle of law of, one dealer in goods shall not represent his goods as the goods of another, 81
principle of law to prevent loss to owner of trade mark by infringement, 81
principles of law for protection of, 82, 83
are *primâ facie* part of partnership property, 96
property in, distinguished from in patents and designs, 75
property in, judicially defined, 76
protect reputation, 74
recognition of property in recent, 74
Register of (section 78), 209, 282. See Register of Trade Marks
series of, may be registered, 111
similar, Court under Act of 1875 used to permit registration of, up to three, 201
similar, registered for some of the goods in a class, although similar old mark already registered, 202
some item of which is common, 94
what are, 76, 77
TRADE MARKS, CLASSIFICATION OF GOODS, 277, 299
agricultural and horticultural machinery, 300
arms, ammunition, &c., 302
building or decorating manufactures, 302
candles, soap, and such domestic articles, 306
carriages, 303
carpets, &c., 304
chemical substances, 299
clothing, 304
clothes, 304
cotton, 303
cutlery and edge tools, 301
earthenware and porcelain, 302
engineering, architectural, &c., contrivances, 302
explosives, 302
food, 305
furniture, 305
games, 306
glass, 302
horological instruments, 301
indiarubber, &c., 305
jute, 304
leather, &c., 304
linen, 303
liquors and spirits, 305
machinery, 300
metal goods, 301
metals unwrought or partly wrought, 300
miscellaneous, 306
mineral and aerated waters 306
musical instruments, 301

TRADE MARKS, CLASSIFICATION OF GOODS—*continued.*
naval architectural contrivances and equipments, 303
paper, 305
perfumery, 306
philosophical instruments, 301
precious metals, goods of, 301, 302
raw or partly prepared substances, 299
seeds, 306
silk, 304
surgical instruments, 301
tobacco, 306
yarns, 304
woollen goods, 304
TREASURY
must hear patentee before settling terms upon which Crown may use invention (section 27), 153
to be paid trade mark fees, 211
to settle terms upon which officers of Crown may use patent, 151
TRIAL OF PATENT CASE to be without a jury unless specially ordered, 153
TRUST not to be entered upon register kept under Act, 216
TRUSTS OR EQUITIES in respect of patents, designs, and trade marks to be enforced, 217
TRUSTEE IN BANKRUPTCY, trade marks pass to, 96
"TURIN," "SEFTON," "LEOPOLD," &c., fancy names held trade marks, 81
USE
prior, evidenced by sale, 21
prior publication by, 21
prior secret, of invention, 21
USEFUL DESIGN
copyright in, formerly distinct from ornamental, 68
abolished, 69
USELESSNESS of part of invention will not make patent void, 27
UTILITY
necessary ingredient of patentable invention, 25
novelty and invention, necessary to support patent, 14
patent good if invention of some, 27
the invention itself must effect the, 28
where patent for several improvements, each must be of some, 27
VALIDITY OF PATENTS, all matters affecting, to be entered on register, 144
VARIANCE, between provisional and complete specification, 40, *et seq.*
VERBAL ERRORS do not render specification bad if obvious, 61
WELDING IRON TUBES without mandril, patent for, 8
"WHEELER AND WILSON'S"
Sewing Machines name become common, or *publici juris*, 91
WIDE MEANING, when interest of patentee to give, to specification, 61
WITNESSES, law officers may examine on oath, 169
WORDS
calculated to deceive, 204
disentitled to protection in a Court of Justice not to be registered as part of a trade mark, 204
in specification construed in ordinary sense, as a rule, 62

VACHER & SONS, Printers, 29, Parliament Street, and 62, Millbank Street, Westminster.

Ex 108
4 | 21 | 13