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THE

# LAW AND PRACTICE

RELATING TO

# PATENTS, TRADE MARKS

AND

# DESIGNS

WITH A

## DIGEST OF COLONIAL AND FOREIGN PATENT LAWS

THE TEXT OF THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1901 (CONSOLIDATED)
THE RULES, FEES, FORMS, ETC.

BY

## DAVID FULTON

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# PREFACE TO THE SECOND EDITION.

THE convenience of having all three heads of the Patents, Designs, and Trade Marks Acts placed before the reader in separate and independent treatise form, and in one compact volume, has been so generally recognised and appreciated that another Edition of this work has been called for.

Although nominally a Second Edition, the present re-issue is practically a new book. The favourable reception of the First Edition could not blind the Author to its many defects and shortcomings, and a vigorous attempt has been made to remedy these in the present volume. The former convenient plan of arrangement has been retained, but the bulk of the original matter has been re-written at greater length, and the whole revised. Fifteen new Chapters have been added throughout the work, and the Procedure and Practice in Legal proceedings have been dealt with as fully as the prescribed limits of the book would allow. The Chapter on Opposition to the Grant of Patents has been carefully re-written and expanded to double its original length. As almost every case of any importance has been noted, this Chapter will now, it is hoped, be found to constitute a complete code of Practice in this important branch.

These additions and expansions have naturally increased the size of the volume, but its retention within even its present limits has only been attained by the exercise of studied brevity of expression and by a rigid exclusion of all unnecessary padding.

As in the First Edition, the Contents of the book are arranged in their relative order of importance: Part I. relates to PATENTS; Part II. to TRADE MARKS; and Part III. to DESIGNS. Part IV. presents, in alphabetical order, concise digests of all PATENT LAWS IN FOREIGN COUNTRIES AND IN THE COLONIES. These digests have been revised, so as to incorporate the latest changes in Law and Practice which have taken place. I have to thank many foreign correspondents for assistance in this revision.

The issue of this volume coincides with the coming into force of the Patent Act of 1901. This Act, which runs from the 1st of January, 1902, has reference solely to International arrangements, and extends from seven to *twelve* months the period within which the subjects or citizens of States which are parties to the Convention (or to other International or Colonial arrangements with Great Britain) may apply in the United Kingdom for Patents already applied for abroad. Patents applied for under this Act receive the same date as that of the original foreign or colonial application. The substance of the Act will be found consolidated with the original Statute at pages 521 and 522 of this volume.

The International Convention and Protocol of 1883, embodying and consolidating the amendments of December, 1900 (in pursuance of which the Patents Act of 1901 was passed), are set forth in Appendix A. Notes on the effects of the Convention in its altered form appear in the introductory remarks to Part IV. These notes should be carefully read by anyone proposing to rely on the terms of the Convention.

In order to obviate the danger of mistake or oversight in considering the respective sections affected, the Statute of 1883

has been codified and consolidated, by the introduction of the proper places and in different type of the amending Acts of 1885, 1886, 1888, and 1901. The Act in its consolidated form will be found in Appendix F. The corresponding Board of Trade Rules and Forms under the Acts, extending from 1890 to 1901 (also consolidated), are printed in Appendices G, H, and I.

The Forms of Agreements, Assignments, Licences, Mortgages, &c., which were incorporated in the First Edition, are included in Appendix B. They appear to have been generally useful, and are repeated with but slight modifications.

The Decisions quoted throughout the work extend up to the end of December, 1901, and these have been collected and arranged in three separate tables, giving in each case the date, the references to reports, the subject-matter, and the gist of the decision or of any noteworthy *obiter dicta* of the Court. It has been found that some mention of the subject-matter of a Patent, Trade Mark, or Design case often recalls the salient points of the decision more efficaciously than the mere title. For this reason a note of the subject-matter has been introduced.

To facilitate reference and avoid confusion, a separate and exhaustive Index has been prepared for each division of the work.

This Edition is published with the fullest knowledge of the proposals which have lately been made for certain minor alterations in the existing Law of Patents and Trade Marks; but even should the proposed Bill be drafted and introduced, the debateable character of the amendments, which are by no means unanimously approved, and the pre-occupation

of Parliament with other and more important matters, render it extremely improbable that the projected alterations will receive legislative sanction in anything like the immediate future.

My friend Mr. W. S. P. Skelding, of the Middle Temple and Oxford Circuit, has been good enough to relieve me of the labour of correcting the proofs, and has also rendered invaluable assistance in extracting and arranging the Table of Cases. I take this opportunity of thanking him for his kindness.

I have also to record my indebtedness to the learned Comptroller-General of Patents, Designs and Trade Marks, C. N. Dalton, Esq., C.B.; to his learned Secretary, Dr. William Martin; and to the Comptroller's Deputy, Mr. Chief Examiner Hatfield. The courteous readiness with which these gentlemen obliged me with any information they could with propriety impart, cannot be too cordially acknowledged.

DAVID FULTON.

1 Garden Court, Temple.

*February, 1902.*

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## PART I.—PATENTS.

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| ABEL'S Patent, *Re* ... | "Lawson on Patents," 3rd Ed. p. 73. | 114 | Gas engine | Amendment of faulty drawings. |
| Acetylene Co. *v.* Midland Acetylene Syndicate | 1900, 17 R. P. C. 531 | 142 | Metallic carbides and illuminating gas | Certificate of validity in absence of defendants. |
| Actien Gesellschaft *v.* Tembler | 1900, 18 R. P. C. 6 | 168 | Cardboard boxes | Equitable title to licence: foreign judgment. |
| Adair's Patent ... ... | 1881, L. R. 6 App. Ca. 176 | 164 | Pumps | Insufficient accounts in prolongation petition. |
| Adam's Patent ... ... | 1898, 16 R. P. C. 1 | 161 | Opening and closing fanlights &c. | Petition for prolongation not made in time. |
| Adams *v.* Stevens ... | 1898, 16 R. P. C. 225 | 72 | Opening and closing fanlights &c. | Disconformity. Essential feature not in Provisional included in combination claim. |
| African Gold Co. *v.* Sheba Gold Co. | 1897, 14 R. P. C. 660 | 173 | Cyanide gold extracting process | Licence for term of patent. Patent cancelled. Royalties payable to end of full term. |
| Ainsworth's Patent ... | 1895, 13 R. P. C. 76 | 117 | Hair curling apparatus | Amendment of specification. Law Officer's power to impose terms. |
| Airey's Patent, *Re* ... | 1888, 5 R. P. C. 348 | 91 | Height measuring machine | Opposition to grant. Disclaimer. Amendment of notice of opposition. |
| Allen *v.* Duckett ... | 1893, 10 R. P. C. 397 | 72 | Water closet pipe | Insufficiency of specification: non-utility and novelty. |
| Allen *v.* Oates ... | 1898, 15 R. P. C. 298 | 111 | Water closet flush pipe | No subject-matter: no new function in combination. |

| | | | | | |
|---|---|---|---|---|---|
| Allen's Patent ... . | Good. O. C. 64: Griff. A. P. C. 3 | 117, 122 | Water-closet flush pipe | Amendment of specification: no terms imposed by Law Officer. |
| Allison's Patent .. | 1898, 15 R. P. C. 408; 1900, 17 R. P. C. 513 | 117, 120, 121 | Copying process | Amendment: no terms imposed. Petition for revocation: leave to re-amend; terms on re-amendment. |
| American Braided Wire Co. *v.* Thomson | 1889, 6 R. P. C. 518; 1890, 7 R. P. C. 152; L. R. 44 Ch. D. 274 | 33, 36, 48, 49, 62, 139 | Ladies' bustles | Subject-matter: small invention: commercial success: patent upheld. |
| Anglo-American Brush Electric Co. *v.* King, Brown | 1892, 9 R. P. C. 313; A. C. 367 | 59 | Generation of electricity | Knowledge of prior specifications assumed: insufficient prior specification as anticipation. |
| Appleby's Twin Roller Chain *v.* Eadie | 1899, 16 R. P. C. 318 | 156, 158 | Driving chains | Threats action: due diligence: trade libel. |
| Armstrong's Patent ... | 1897, 14 R. P. C. 717: 77 L. T. N. S. 267 | 119 | Screw propeller | Revocation: leave to amend refused: nothing left of invention. |
| Ashworth's Patent . | Good. O. C. 66; Griff. A. P. C. 6 | 115 | Wire cards | Amendment allowed: specification clear, claim ambiguous. |
| Ashworth *v.* Roberts . | 1890, 7 R. P. C. 451; L. R. 45 Ch. D. 623; 60 L. J. Ch. 27 | 26, 136 | Wire cards | Interrogatories founded on specification: answers ordered. |
| Automatic Machine Co. *v.* Combined Machine Co. | 1889, 6 R. P. C. 367 | 157 | Automatic weighing machine | Threats action should be combined with infringement action. |
| Automatic Machine Co. *v.* Pearby | 1893, 10 R. P. C. 442 | 13 | Automatic weighing machine | "Quasi-principle" or "essence" in invention. |
| Automatic Machine Co. *v.* National Exhibitions Association, Limited | 1891, 9 R. P. C. 11, 315 | 31, 43, 143 | Automatic weighing machine | "Quasi-principle" or "essence" in invention. |
| Automatic Retort Co. *v.* Mayor of Salford | 1897, 14 R. P. C. 450 | 140 | Gas manufacture: sloping retorts | Damages preferable to account: subject-matter. |
| Automatic Weighing Machine Co. *v.* Knight | 1889, 6 R. P. C. 297 | 43, 85 | Automatic weighing machine | "Quasi-principle" or "essence" in invention. |
| Automatic Weighing Machine Co. *v.* International Hygienic Society | 1889, 6 R. P. C. 475 | 142 | Automatic weighing machine | "Subsequent action" re validity certificate. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Avery's Patent | 1887, 4 R. P. C. 152, 322 | 148, 150 | Generating gas | Revocation: alleged fraud: honest mistake: fraud must be done or insisted upon with intention. |
| BADISCHE Anilin Fabrik *v.* Levinstein | 1887, 4 R. P. C. 449 | 35, 39 | Producing dyes | Analogy not so apparent in chemistry: commercial success no measure of utility. Fresh evidence in House of Lords. |
| Badische Anilin Fabrik *v.* Société Chimique | 1897, 14 R. P. C. 875 | 132, 143 | Producing dyes | Amending particulars at trial. |
| Bailey, *Re* | Griff. P. C. 269; Good. O. C. 25 | 91, 95, 97 | Knobs for locks &c. | Opposition to grant. No opposition on Provisional. New grounds of opposition not admitted by Law Officer. |
| Bailey *v.* Roberton | 1878, 3 App. Ca. 1055: Good. P. C. 26 | 68 | Preserving meat | Disconformity between Provisional and Complete. |
| Baird *v.* Moule | 1876, L. R. 17 Ch. D. 139 | 133 | Earth closets | Conditions on amending particulars of objections. |
| Bairstow, *Re* | 1888, 5 R. P. C. 286; Good. O. C. 15 | 96 | Weaving velvet | Opposition to grant: person entitled to oppose: fraud abroad. |
| Bamlett *v.* Picksley | 1875, Griff. P. C. 10 | 35 | Reaping machines | Analogous use. |
| Barcroft *v.* Smith | 1896, 11 R. P. C. 172 | 137 | Drying and "ageing" machine | Fresh evidence in Court of Appeal: leave refused: surprise on trial. |
| Barff and Bower's Patent | 1895, 12 R. P. C. 383 | 165, 166 | Protection of metals | Prolongation petition. Accounts: profits on foreign patents. |
| Barrett *v.* Day | 1890, 7 R. P. C. 51 | 155 | Trigger bottle opener | Threats: letters: stay of action. |
| Bayer *v.* Connell | 1897, 14 R. P. C. 275 | 185 | Trade mark for corsets | Jurisdiction of Irish Court *re* rectification of Register. |
| Beavis *v.* Rylands | 1900, 17 R. P. C. 701 | 47 | Bottle stoppers | Mere adaptive skill not invention. |
| Beck and Justice's Patent | Good. O. C. 72; Griff. A. P. C. 10 | 115 | Exhaust steam nozzles | Amendment extending to gas engines not allowed. |

| | | | | |
|---|---|---|---|---|
| Bell's Patent ... ... | Good. O. C. 13; Griff. A. P. C. 10 | 118 | Vestas | Persons entitled to oppose: costs: terms. |
| Benno Jaffé *v.* Richardson | 1893, 10 R. P. C. 136 | 136 | Lanoline or wool fat | Interrogatories framed on plaintiff's specification. |
| Betts *v.* De Vitre ... | 1861-73, L. R. 3 Ch. 429; L. R. 6 H. L. 319; 31 L. J. Ch. 289, 291 | 121 | Metal capsules | Infringing acts of workman render employer liable. |
| Betts *v.* Menzies .. | 1857-62, 10 H. L. Cas. 117; Good. P. C. 15 | 51 | Metal capsules | Manufacture but no sale before date of patent. |
| Birch *v.* Harrop .. .. | 1896, 13 R. P. C. 615 | 29 | Sewing machine | Combination claim of old items construed strictly. |
| Birmingham Tyre Syndicate *v.* Reliance Tyre Co. | 1900, 17 R. P. C. 277 | 132 | Pneumatic tyres | Query if particulars enforceable of prior grant. |
| Bishop *v.* Inman . | 1900, 17 R. P. C. 749 | 157, 158 | Paper box making | Threats: presented with "due diligence": action not brought *bonâ fide*. |
| Blakey *v.* Latham | 1889, 6 R. P. C. 181 | 46, 48 | Boot protectors | Invention: analogous use: commercial success. |
| Bloxam *v.* Elsee | 1825-7, 1 C. & P. 558; 1 Web. P. C. 132 | 17 | Paper making | Alien enemy as British patentee. |
| Booth *v.* Kennard . | 1856-7, Good. P. C. 68; 26 L. J. Ex. 23, 305 | 42, 49 | Gas manufacture | Principle: not confined to method shown: claim too large. |
| Boulton *v.* Bull .. | 1795, 2 H. Bl. 463; 3 Ves. 140; Good. P. C. 70; Dav. Pat. Cas. 162 | 20, 40, 41 | Separate steam condenser | Principle combined with means for effecting working. |
| Bovill *v.* Crate ... | 1865, L. R. 1 Eq. 388 | 127 | Manufacture of flour | Delay bars right to interlocutory injunction. |
| Bower *v.* Hodges .. | 1853, 22 L. J. C. P. 194 | 172 | Pipe-making machine | Licence a personal right: not transferable. |
| Bown *v.* Sansom ... | 1888, 5 R. P. C. 510 | 136 | Bicycle and other bearings | Discovery of documents in former action. |
| Boyd *v.* Farrer ... .. | 1887, 5 R. P. C. 33 | 129 | Yarn winding and doubling | Sufficiency of particulars of objections. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Boyd *v.* Tootle Broadhurst | 1891, 11 R. P. C. 175 | 139 | Yarn winding and doubling | Damages must not be too remote: usually to be measured by loss of profits. |
| Brand's Application | 1895, 12 R. P. C. 102 | 92 | Galvanising tubes and bars | Opposition to grant. Disclaimer. Irrelevant declarations. |
| Bridge's Application | 1901, 18 R. P. C. 257 | 101 | Moveable partitions | Opposition to grant: quantum of invention: mere stringing together of old things. |
| Britain *v.* Hirsch | 1888, 5 R. P. C. 226 | 46 | Automatic dancing figure | Want of invention: obvious adaptation of old mechanism. |
| British Dynamite Co. *v.* Krebs | 1879, Good. P. C. 88; 13 R. P. C. 190 | 51, 85, 86 | Explosives | Subsidiary claim bad *per se*, may be held appendant to specified invention. |
| British Motor Syndicate, Limited *v.* Andrews & Co., Limited | 1901, 18 R. P. C. 85 | 87 | Gas motors | Essential part not in claim cannot be read into claim by Court. |
| British Motor Syndicate *v.* Taylor | 1900, 17 R. P. C. 723 | 123 | Gas motors | Infringement by importation: possession with view to sale. |
| British Mutoscope Co. *v.* Homer | 1901, 18 R. P. C. 177 | 124 | Mutoscopic device | Infringement: licensed machine taken in distress by landlord. |
| Brooks *v.* Lamplugh | 1897, 14 R. P. C. 597; 15 R. P. C. 33 | 69, 132 | Cycle saddles | Disconformity. Prior grant: rebuttal of prior grant. |
| Brooks *v.* Steele | 1896, 14 R. P. C. 46 | 137 | Cycle saddles | Functions of expert witnesses: not to construe specification. |
| Brunton *v.* Hawks | 1820, 4 B. & Ald. 541; Good. P. C. 97 | 27, 50 | Anchors and cables | Combination: one claim bad, the whole bad. |
| Bunge *v.* Higginbottom | 1901, 18 R. P. C. 201 | 31 | Sifting machine | Where feature referred to as essential in combination is not used by defendant, no infringement. |

| | | | | |
|---|---|---|---|---|
| Burlingham's Patent ... | 1898, 15 R. P. C. 195 | 166 | Chaff machine | Prolongation: query, if one claim bad can patent be prolonged? |
| CAMPION *v.* Benyon ... | 6 B. Moo. 71; Good. P. C. 103 | 65 | Canvas and sail-cloth | Title too large. |
| Carter *v.* Leyson ... | 1901, 18 R. P. C. 508 | 69 | Candlesticks | Legitimate development of Provisional. |
| Cartwright *v.* Amatt ... | 1799, 2 Bos. & P. 43 | 168 | Wool combing | Executory assignment taking effect on event happening. |
| Case *v.* Crossy ... ... | 1901, 18 R. P. C. 119 | 47 | Shore groynes | Analogous application of old construction. |
| Cassel Gold Co. *v.* Cyanide Syndicate | 1895, 12 R. P. C. 232 | 51, 62 | Obtaining metals from ores | Claim too wide: subtraction in process may be new invention. |
| Castner-Kellner *v.* Commercial Development Co. | 1900, 17 R. P. C. 593 | 69 | Electric decomposition of metallic salts | Disconformity between Provisional and Complete. |
| Cera Light Co. *v.* Dobbie | 1892, 11 R. P. C. 10 | 69 | Ships' lamps | Disconformity between Provisional and Complete. Provisional invention anticipated. |
| Challender *v.* Royle ... | 1887, 4 R. P. C. 363; L. R. 36 Ch. D. 425 | 154, 155, 157, 158 | Tap union | Threats: general warning not a threat: due diligence: action, if taken, need not be against threatened person. |
| Chamberlain *v.* Mayor of Bradford | 1900, 17 R. P. C. 493, 762 | 85, 141, 143 | Electricity meters | Certificate of particulars referred to: costs on higher scale under Public Authorities Protection Act. |
| Chamberlain *v.* Mayor of Huddersfield | 1901, 18 R. P. C. 151 | 141 | Electricity meters | Leave to discontinue: terms: solicitor and client costs: costs of particulars. |
| Chambers *v.* Crickley ... | 1861, 33 Beav. 374; Good P. C. 112 | 138 | Stoves | Estoppel: defendant sold patent to plaintiff. |
| Chanter *v.* Dewhurst ... | 1844, 12 M. & W. 823; 13 L. J. Ex. 198 | 173 | Furnaces | Licence valid without seal. |
| Chatwood's Patent ... | 1899, 16 R. P. C. 370 | 120, 151 | Safes | Amending specification *pendente lite*: terms on granting leave. |
| Cheetham *v.* Nuthall ... | 1893, 10 R. P. C. 321 | 173 | Veneering hat bodies | Determination of licence: pleading in defence not proper notice to terminate. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Church's Patents, *Re* ... | 1886, 3 R. P. C. 95 | 111, 160, 161 | Steam-piston packing | Prolongation: position of mortgagee *re* prolonged patents. |
| Clark's Patent ... | 1899, 16 R. P. C. 133 | 161 | Coal distilling retorts | Prolongation: patentee not interested: company: insufficient accounts: prolongation refused. |
| Cochrane *v.* Smethurst | 1816, Good. P. C. 124 | 65 | Lighting cities &c. | Title too large: patent really for street lamp. |
| Cocking's Patent ... | 1895, 2 R. P. C. 151 | 165 | Material for splints | Prolongation petition: unless patent manifestly bad council will not debate questions of novelty. |
| Cold *v.* Bratby ... | 1884, 1 R. P. C. 209 | 120 | Bottle stoppers | Leave to amend *pendente lite*: leave granted on terms. |
| Cole *v.* Saqui | 1888, 5 R. P. C. 189 | 61 | Toy figures | "Useful" invention: damages founded on actual sales only. |
| Colley *v.* Hart | 1890, 7 R. P. C. 101 | 156, 158 | Toilet-paper rolls | Threats action: what constitutes "due diligence" depends on circumstances. |
| Combined Weighing Machine Co. *v.* Automatic Machine Co. | 1889, 6 R. P. C. 502 | 155 | Weighing machine | Threats: due diligence: staying threats action on terms. |
| Compagnie Générale &c. | 1891, 8 R. P. C. 116 | 185 | Trade Marks | Rectification of Register: service of notice of motion (or petition for revocation) on foreigner. |
| Continental Gas Glulicht Petition | 1898, 15 R. P. C. 727 | 178 | Gas mantle burner | Compulsory licence: petitioner must prove ability to manufacture here: costs in dismissed petition. |
| Cooper *v.* Baedeker ... | 1899, 16 R. P. C. 383 | 18 | Felt bicycle handles | No novelty or invention: action dismissed. |
| Cornish *v.* Keene ... | 1835-7, Good. P. C. 127 | 51 | Elastic fabrics | Prior publication: Tindal, C. J., on experimental or secret use. |

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| Cowie *v.* Herbert | 1897, 14 R. P. C. 136 | 185 | Trade mark | Scotch Courts claim jurisdiction re rectification of Register. |
| Crampton *v.* Patents Co. | 1888, 5 R. P. C. 382 | 155 | Electric beds | Threat by solicitor's letter held actionable. |
| Crane *v.* Price | 1842, 1 Web. P. C. 393; 12 L. J. C. P. 81; 4 M. & G. 580; Good. P. C. 131 | 20, 38, 47 | Manufacture of iron | Process good subject-matter for patent. |
| Cropper *v.* Smith | 1884, 1 R. P. C. 81; 26 Ch. D. 700; 10 App. Cas. 249; 2 R. P. C. 17 | 51, 79, 138 | Lace machines | Bad subsidiary claim: defendant patentee not estopped from disputing validity if patent purchased through his trustee in bankruptcy. |
| Crossley *v.* Beverley | 1829, 3 C. & P. 513; Good. P. C. 136; 9 B. & C. 63 | 71, 139 | Gas making apparatus | Sufficiency of description: development of invention: specification must be read with skilled intelligence. |
| Crossley *v.* Dixon | 1863, 10 H. L. Ca. 293 | 173, 174 | Looms for weaving | Estoppel of licensee from disputing validity. |
| Cumming, *Re* | Griff. P. C. 277 | 160 | Bracelet fasteners | Opposition to grant. Applicant's invention "very nearly the same" as opponent's, but grant allowed. |
| Currie and Timmis's Patent | 1897, 15 R. P. C. 63 | 161 | Locking railway signals | Petition for prolongation: importance of invention in securing public safety. |
| Curtis *v.* Platt | 1863-4, 35 L. J. Ch. 852; 11 L. T. N. S. 215; Good. P. C. 114 | 26, 29 | Spinning mules | Combination of known parts, generally restricted to particular combination specified. |
| DAVID and Woodley, *Re* | Griff. A. P. C. 26; Good. O. C. 32 | 99 | Sewing machines | Opposition to grant: master and workman: workman employed by inventor to perfect invention in detail, and suggesting improvements has no right to patent these: they belong to his employer. |
| Davies's Patent | 1893, 11 R. P. C. 27 | 166 | Feed water injector | Petition for prolongation: merit of invention: profits. Prolongation granted. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Daw *v.* Eley ... .. | 1865-7, L. R. 3, Eq. 496: Good. P. C. 160 | 55, 138 | Ball cartridges | Prior user might be clumsy infringement *after* patent, but no anticipation *before*. |
| Deeley's Patent .. . | 1895, 12 R. P. C. 192 | 26, 150 | Extractors for guns | Revocation: combination of old parts: no subject-matter: anticipation. |
| Deeley *v.* Perkes ... | 1896, 13 R. P. C. 581 | 121 | Extractors for guns | Amendment of specification *pendente lite*. Exceptional reasons for imposing severe conditions. |
| De Falbe, *Re*: Ward *v.* Taylor | 1901, 1 Ch. D. 523 | 140 | | Practice in costs of shorthand notes of Judgment in Court of Appeal. |
| Dege's Patent .. | 1895, 12 R. P. C. 448 | 147 | Riding breeches | Revoked for want of subject-matter: fiat of Attorney-General. |
| De la Rue *v.* Dickinson | 1857, 7 E. & B. 738; Good. P. C. 164 | 135 | Copyright Case | Rule in replies to interrogatories. |
| Dellwik's Patent ... | 1896, 13 R. P. C. 591 | 122 | Incandescent burners | Revocation: amendments *pendente lite* Court will not inquire into terms of amendment. |
| Dewrance *v.* Fletcher .. | 1899, 16 R. P. C. 150 | 54 | Water gauge for boilers | Prior user discontinued: evidence of anticipation depending wholly on witnesses' memory: anticipation [held. |
| Dick *v.* Ellam ... ... | 1900, 17 R. P. C. 196 | 81 | Copying writings &c. | Claim too wide. |
| Dolbear's Patent ... | 1896, 13 R. P. C. 203 | 166 | Electrical cables | Prolongation refused owing to delay in putting on market. |
| Dolland's Case ... ... | 1776, Good. P. C. 175 | 54 | Object glasses | Prior secret use not for profit no anticipation. |
| Douglas *v.* Pintsch ... | 1896, 13 R. P. C. 673 | 155 | Gas buoys | Threats: allusion to defendant's patents inferred though not expressed. |
| Dowling *v.* Billington ... | 1890, 7 R. P. C. 191 | 124 | Wire mattresses | Evidence of intention to infringe will justify injunction. |

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| Dowson *v.* Drosophore... | 1894, 11 R. P. C. 536; 1895, 12 R. P. C. 95 | 155, 156 | Humidifying machines | Threats may be to principals or customers: action must be on all patents alluded to in threats. Plaintiffs may attack validity of patents in their reply. |
| Dredge *v.* Parnell ... | 1899, 16 R. P. C. 625 | 34 | Cutting necktie linings | Found to be analogous use of known tools. |
| Duckett *v.* Whitehead ... | 1895, 12 R. P. C. 187, 376 | 49 | Water closets | Anticipations proved useless held to make out utility and invention in plaintiff's patent. |
| Dunlop *v.* British Car Co. | 1901 18 R. P. C. 313 | 124 | Pneumatic wheel tyres | Infringement by exhibition without intention to sell. |
| Dunlop *v.* Buckingham & Adams | 1901, 18 R. P. C. 423 | 176 | Pneumatic wheel tyres | Licensee adhering to essence of patent does not infringe by varying details. |
| Dunlop *v.* Cresswell .. | 1901, 18 R. P. C. 473 | 176 | Pneumatic wheel tyres | Licensee adhering to essence of patent does not infringe by varying details. |
| Dunlop *v.* Excelsior Rubber Co. | 1901, 18 R. P. C. 209 | 124 | Pneumatic wheel tyres | A repairer infringes if he renews essential part. |
| Dunlop *v.* Holborn Tyre Co. | 1901, 18 R. P. C. 222 | 124 | Pneumatic wheel tyres | A repairer infringes if he renews essential part of invention. |
| Dunlop Co. *v.* Neal ... | 1899, 16 R. P. C. 247; 1899, 1 Ch. 807; 80 L. T. 746 | 124 | Pneumatic wheel tyres | A repairer infringes if he renews essential part of invention. |
| Dunnicliffe *v.* Mallet .. | 1859, 7 C. B. N. S. 209, 227 | 168, 171 | Weaving lace | An assignment of part of patent is valid. |
| EASTERBROOK *v.* Great Western Railway Co. | 1885, 2 R. P. C. 201 | 61 | Railway signals | Inutility: Invention proved untrustworthy. |
| Edison-Bell, Limited *v.* Columbia Phonograph Co. | 1900, 18 R. P. C. 1 | 130 | Phonographs and phonograms | Defendants alleging that all parts of anticipating specification are relied on cannot be compelled to give pages, lines, and figures. |
| Edison-Bell Phonograph Co. *v.* Smith | 1894, 11 R. P. C. 389 | 85, 137, 139 | Phonographs | In order for delivery up, infringing parts only need be delivered up. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Edison-Swan *v.* Woodhouse | 1887, 4 R. P. C. 99 | 19, 55 | Electric lamps | Modification of one element in old arrangement: filament in electric lamp: held subject-matter. |
| Edison Telephone Co. *v.* India Rubber Co. | 1881, L. R. 17 Ch. D. 137 | 133 | Telephones | Conditions on defendant amending his particulars of objections. |
| Edlin *v.* Pneumatic Tyre Agency | 1893, 10 R. P. C. 311 | 158 | Pneumatic wheel tyres | Threats action: "due diligence" to be construed by surrounding circumstances: three years' delay admitted. |
| Edmond's Patent .. | 1889, 6 R. P. C. 355 | 150 | Tool holder | Revocation: analogous application of old machinery. |
| Edmunds, *Re* | Griff. P. C. 281; Good. O. C. 27 | 98 | Telephones | Opposition to grant. First importer: fraud abroad: Comptroller only takes cognisance of what happens in the United Kingdom. |
| Edwards, *Re* ... .. | 1894, 11 R. P. C. 461 | 107 | Pneumatic tyres | Opposition to grant on third ground of opposition: held to be proper development of Provisional. |
| Ehrlich *v.* Ihlee .. | 1887, 4 R. P. C. 115; 1888, 5 R. P. C. 37, 198, 137 | 35, 49, 62, 133 | Musical instrument | Terms on amendment *pend ate lite*: interrogatories: commercial success: subject-matter: patent sustained. |
| Electric Construction Co. *v.* Imperial Tramway Co. | 1899, 16 R. P. C. 631; 1900, 17 R. P. C. 537 | 52, 58, 79, 86 | Spring suspended car motor | Anticipation by published drawing. |
| Electrolytic Co. *v.* Holland | 1901, 18 R. P. C. 521 | Index | Electroplating | No anticipation by prior experimental user. |
| Elmslie *v.* Boursier ... | 1869, L. R. 9 Eq. 217; 39 L. J. Ch. 328; Good. P. C. 190 | 38 | Tinfoil | Process which cheapens production of old product is good subject-matter. |

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| Evans and Otway, *Re* ... | Griff. P. C. 279 | 99 | Steam engines | Opposition to grant: patent may be issued jointly to opponent and applicant. |
| Everitt, *Re* ... ... | Griff. A. P. C. 28 | 97 | Automatic electric battery | Opposition to grant: foreign grantee of antedated patent not entitled to oppose. |
| FABRIQUES Chimiques *v.* Caspers | 1897, 15 R. P. C. 91 | 112 | Artificial musk | Action on two patents: one abandoned by plaintiff at hearing: defendant held entitled to costs in respect of abandoned patent, and to a certificate of his particulars in respect of same. |
| Fawcett *v.* Homan .. | 1896, 13 R. P. C. 398 | 29 | Fireproof flooring | Subject-matter: novel combination of old parts: infringement held: patent sustained. |
| Fawcett, *Re* ... ... | 1889, Good. O. C. 10 | 91 | Fireproof flooring | Opposition to grant: phrase "or material parts thereof" struck out of notice of opposition. |
| Felton *v.* Greaves .. | 1829, Good. P. C. 193 | 65 | Sharpening knives, scissors, &c. | Insufficiency of specification: no proper means described for sharpening scissors. |
| Ferranti's Patent ... | 1901, 18 R. P. C. 518 | 161, 167 | Electric railways | Prolongation refused: non-disclosure of material facts in petition. |
| Finch's Patent, *Re* ... | 1898, 15 R. P. C. 671 | 165 | Bottle stoppers | Petition for prolongation: dismissed: patentee not deriving any benefit from prolongation. |
| Fletcher's Patent . | 1893, 10 R. P. C. 252 | 168, 183 | Labelling bottles | Rectification of Register: incomplete agreement: entry expunged. |
| Fox *v.* Dellestable ... | 1866, 15 W. R. 191; Good. P. C. 198 | 23 | Umbrella frames | Improvements on existing patent valid. |
| Foxwell *v.* Bostock .. | 1863-4, 4 De G. J. & S. 77 & 298; 9 L. T. N. S. 362, 528; 10 L. T. N. S. 111; Good. P. C. 200 | 30, 77 | Sewing machine | Patent bad: no differentiation of old from new. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Frearson *v.* Loe | 1878, L. R. 9 Ch. D. 48; 26 W. R. 138 | 123, 124 | Manufacture of screws | Injunction may be obtained without proving actual infringement if intention to infringe can be reasonably shown. |
| Fusee Vesta Co. *v.* Bryant & May | 1887, 4 R. P. C. 71 | 120 | Wax vestas | Application to amend *pendente lite*: terms on leave being given. |
| GADD *v.* Mayor of Manchester | 1892, 9 R. P. C. 219, 516 | 35, 48, 70 | Gas holders | Alleged analogous application: alleged publication by prior confidential disclosure: patent upheld. |
| Gale's Patent | 1891, 8 R. P. C. 138 | 148, 151 | Boiler tube stopper | Revocation petition: fraud: party having right to begin should file his evidence-in-chief first. |
| Gandy *v.* Reddaway | 1885, 2 R. P. C. 49 | 83 | Driving belts | Insufficient specification. True meaning of vague claim might be deduced from evidence. |
| Garnett, *Re* | 1899, 16 R. P. C. 151 | 105 | Rubber tyres | Opposition to grant: extensive amendments not encouraged. |
| Garthwaite, *Re* | Griff. P. C. 281 | 89 | Dog and poultry food | Opposition to grant: patent may be granted jointly to opponent and applicant. |
| Germ Milling Co. *v.* Robinson | 1884, 1 R. P. C. 217; 1886, 3 R. P. C. 251 | 53, 134 | Manufacture of meal &c. | Sale of goods made by patented apparatus before date of application invalidates patent. |
| Gibson *v.* Brand | 1841-2, Good. P. C. 211; 1 Web. P. C. 627; 11 L. J. C. P. 177 | 38, 76 | Manufacture of silk | Process good subject-matter: specification must be clear and explicit. |
| Glossop, *Re* | Griff. P. C. 285; Good. O. C. 12 | 96 | Valve motion for steam hammer | Opposition to grant: opponent, assignee, and manufacturer under lapsed patent held entitled to oppose. |

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| Goddard *v.* Lyon ... | 1891, 11 R. P. C. 351 | 22, 29, 78 | Disinfecting apparatus | Small amount of invention: causing apparatus before used with low pressure steam, to be capable of being used with high pressure steam. |
| Gormully and Jeffrey, *re* Dunlop's Patents | 1899, 16 R. P. C. 611 | 179 | Pneumatic tyre | Compulsory licence: existence of exclusive licences no ground for refusing petition. |
| Goucher *v.* Clayton | 1861, Good. P. C. 214 | 138 | Corn thrashing machine | Estopped as to new partners of licensed firm. Essential parts renewed are infringements. |
| Goulard and Gibbs's Patent | 1888, 5 R. P. C. 189 | 151 | Distributing electricity | Petition for revocation: leave to amend specification *pendente lite*: terms of leave given. |
| Graham *v.* Eli | 1898, 15 R. P. C. 259 | 189 | Patent Agents | The intention of the Patent Act of 1888 may be evaded by anyone who stops short of calling himself a "Patent Agent." |
| Green, *Re* | Griff. P. C. 286 | 106 | Fuel economisers | Former liability of inventors to be deprived of their invention by prior applicants. Now cured by Act of 1888. |
| Greenhalgh, *Re* | 1897, 14 R. P. C. 387 | 104 | Garment shapes on cloth | Opposition to grant: no reference to concurrent application. |
| Guest and Barrow, *Re* .. | 1888, 5 R. P. C. 313; Good. O. C. 38 | 101, 102 | Velocipedes | Opposition to grant: reluctance of Law Officer to order special references. |
| Guilbert-Martin *v.* Kerr and Jubb | 1887, 4 R. P. C. 18 | 55 | Steam gauge glasses | Anticipation by prior use and sale. |
| Guyot *v.* Thomson . | 1894, 11 R. P. C. 541 | 171, 176 | Water circulation in steam boilers | An irrevocable and exclusive licence is not a conveyance under The Conveyancing Act, 1881. |
| HADDAN'S Patent ... | 1885, 2 R. P. C. 218; Good. O. C. 62; Griff. A. P. C. 12 | 114, 119 | Infants' food | Petition for revocation: joinder of respondent: prior publication. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Haggenmacher *v.* Watson | 1897, 14 R. P. C. 319, 631 | 55, 138 | Sifting and separating meal &c. | Patent declared invalid: prior user: leave to adduce further evidence on appeal refused. |
| Hall *v.* Conder ... ... | 1857, 2 C. B. N. S. 22, 533; Good. P. C. 216 | 169 | Preventing boiler explosions | In assignment of patent no implied warrant of validity. |
| Hall and Hall, *Re* | 1888, 5 R. P. C. 283 | 101 | Manufacture of leather | Opposition to grant. Reference may be ordered to an expired patent. |
| Hampton and Facer's Patent | Griff. A. P. C. 13; Good. O. C. 71 | 91, 116 | Casting steel ingots | Amendment of specification. Applicant must not impute disadvantages to opponent's patent. If Comptroller's decision is accepted in terms, new evidence cannot be given on appeal |
| Hancock *v.* Somervell ... | 1851, 39 Newton's London Journal 158 | 54 | Rubber shoe | Circulation of sample prior to application invalidated the patent. |
| Harmar *v.* Playne ... | 1807, Good. P. C. 219; 11 Ves. 130 | 73 | Raising and cropping cloth | Specification addressed to skilled persons: "not to ploughmen." |
| Harrild and Parkins, *Re* | 1900, 17 R. P. C. 617 | 105 | Guard for platen printing machine | *Per* Carson, S.-G., that in a proper case, patent may be sealed on a claim entirely different from original claim. |
| Harris *v.* Rothwell ... | 1886, 3 R. P. C. 213; 1887, 4 R. P. C. 225; L. R. 35 Ch. D. 116 | 58, 129 | Knitting machine | Prior publication by German specification: further and better particulars ordered. |
| Harrison *v.* Anderston Foundry Co. | 1876, L. R. 1 App. Cas. 574; Good. P. C. 221 | 30, 77, 81 | Looms for weaving | Sufficiency of specification: discrimination of old from new. |
| Harwood *v.* G. N. R. Co. | 1860-65, 2 B. & S. 191, 222; 11 H. L. Cas. 654; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27; Good. P. C. 224 | 31, 47 | Fish-plate for rails | Analogous application of old thing. |

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| Haslam Foundry Co. *v.* Goolfellow | 1887, 5 R. P. C. 28; L. R. 37 Ch. D. 118 | 120 | Preservative refrigerator | Terms on obtaining leave to amend specification *pendente lite*. |
| Haslam *v.* Hall ... ... | 1887, 4 R. P. C. 203; 5 R. P. C. 1 | 50, 128, 143 | Preservative refrigerator | Inspection of documents in former proceedings: anticipation. |
| Haslett *v.* Hutchinson ... | 1891, 8 R. P. C. 457 | 111, 182, 183 | Patents for motors *et al.* | Equitable interest: expunging incorrect entry from Register. |
| Haythornthwaite, *Re* ... | 1890, 7 R. P. C. 70 | 100, 103 | Automatic sprinklers | Opposition to grant: Law Officer may consider doctrine of mechanical equivalents: disconformity not considered. |
| Hayward *v.* Hamilton ... | 1881, Griff. P. C. 115 | 26, 47 | Pavement lights | Subject-matter: combination of old things upheld. |
| Hazeland's Patent ... | 1894, 11 R. P. C. 467 | 164 | Wood planing machine | Petition for prolongation: accounts: insufficient remuneration: prolongation granted. |
| Hazlehurst *v.* Rylands ... | 1891, 9 R. P. C. 1 | 47 | Top for bottles and jars | Analogous use of old thing: patent held invalid. |
| Heald *Re* ... ... | 1891, 8 R. P. C. 429; Good. O. C. 25 | 99 | Gas lamps | Opposition to grant. Master and servant: master not necessarily entitled to servant's invention. |
| Heath and Frost ... | Griff. P. C. 288; Good. O. C. 13 | 96 | Blasting cartridges | Patent Agent of principal not a person entitled to oppose. |
| Heath *v.* Smith .. .. | 1851, Good. P. C. 238 | 54 | Steel making process | Anticipation by prior user alleged to be secret or merely experimental. |
| Heathfield *v.* Greenway | 1893, 11 R. P. C. 17 | 129, 130 | Coating Metals with alloy | Practice in ordering further particulars of objections. |
| Hedge, *Re* .. .. | 1895, 12 R. P. C. 136 | 101 | Bottle stoppers | Opposition to grant: patent refused, nothing patentable being left after eliminating old matter. |
| Heidemann *v.* Smokeless Powder Co. | 1898, 15 R. P. C. 305 | 143 | Explosives | Anticipation: costs on higher scale owing to difficulty of inquiry. |
| Henderson's Patent ... | 1901, 18 R. P. C. 449 | 161, 166 | Manufacture of aluminium | Petition for prolongation refused: accounts: delay in working invention. |
| Henser *v.* Hardie ... | 1891, 11 R. P. C. 421 | 129 | Cycle training machine | Action limited by particulars of breaches: replies to interrogatories. |

| Name of Case | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Herrburger *v.* Squire | 1888, 5 R. P. C. 581; 1889, 6 R. P. C. 191 | 58, 151, 155, 156, 157 | Pianoforte actions | Threats: due diligence: patent anticipated by prior publication of drawing. |
| Hetherington, *Re* | 1890, 7 R. P. C. 419 | 106 | Flexible bend of carding engine | Opposition to grant on third ground: introduced matter struck out. |
| Higgins, *Re* | 1891, 9 R. P. C. 71: Good. O. C. (1st App.) 33 | 98 | Type setting | Opposition to grant: fraud abroad: disconformity alleged: patent sealed. |
| Hill, *Re* | 1888, 5 R. P. C. 599: Good. O. C. 15, 12 | 96, 101, 102 | Wire ropes | Opposition to grant: licensees of prior patent entitled to oppose: references in public interest. |
| Hill *v.* Evans | 1862, Good. P. C. 248: 31 L. J. Ch. 457 | 59 | Gas manufacture | Lord Westbury on sufficiency of paper anticipations: account or damages. |
| Hill *v.* Thompson | 1817, Good. P. C. 241: 8 Taunt. 375; 1 Web. P. C. 220 | 38, 50 | Smelting iron | If part of invention claimed should fail, then the whole fails. |
| Hinde *v.* Osborne | 1885, 2 R. P. C. 15 | 145 | Hair curling pins | Fresh evidence on appeal refused. |
| Hinks *v.* Safety Lighting Co. | 1876, L. R. 1 Ch. D. 607; 46 L. J. Ch. 185; Good. P. C. 252 | 69, 75 | Lamp | Change of form of wick held good: small advance: imperfect drawing: patent bad. |
| Hoffmann *v.* Postill | 1869, L. R. 4 Ch. 673 | 135 | —— | Interrogatories not to be used to amplify particulars. |
| Hoffmann *v.* Salsbury | 1899, 16 R. P. C. 375 | 159 | Bicycle lamp | Threats: loss of profits under repudiated contract, held damages. |
| Holliday *v.* Heppenstall | 1889, 6 R. P. C. 320 | 130 | Dyeing yarns | Particulars of common knowledge never ordered. |
| Hookham *v.* Johnson | 1897, 14 R. P. C. 525 | 78 | Electricity meters | Patentee in his specification not bound to distinguish between old and new. |

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| Hopkinson's Patent ... | 1896, 13 R. P. C. 114; 14 R. P. C. 5 | 160, 161, 165, 166, 167 | Distributing electricity | Petition for prolongation refused: patentee well remunerated and having no further interest: assignees not favoured. |
| Hopkinson *v.* St. James Lighting Co. | 1892, 10 R. P. C. 46 | 121 | Distributing electricity | Damages given for infringements before amendment of specification: specification held to show reasonable skill and knowledge: costs on higher scale. |
| Horsley, *Re* ... ... | 1869, L. R. 8 Eq. 475; 39 L. J. Ch. 157; | 112 | — | Rectification of Register where entry affects rights of third parties. |
| Hoskins, *Re* ... ... | Griff. P. C. 291 | 102 | Folding cots | Opposition to grant: improvement on opponent's patent: special reference. |
| Household *v.* Neilson ... | 1842-3, Good. P. C. 265; 9 Cl. & F. 788 | 55 | Manufacture of iron | Prior public user vitiates patent. |
| Howes *v.* Webber ... | 1895, 12 R. P. C. 165 | 139 | Carriage lamps | Delivery up and destruction: where part only infringes, that part only need be destroyed. |
| Huddart *v.* Grimshaw .. | 1868, 1 Web. P. C. 85; Good. P. C. 266 | 50 | Manufacture of cables | If part bad the whole bad: evidence of infringement. |
| Hulton and Bleakley's Petition. | 1898, 15 R. P. C. 749 | 178, 179 | Setting up late news type | Compulsory licence: rival newspaper entitled to be licensed to use invention. |
| INCANDESCENT CO. *v.* Brogden | 1899, 16 R. P. C. 179 | 121 | Incandescent mantles | Conditions of user: must be known to purchaser at time of purchase. |
| Incandescent Co. *v.* Cantelo | 1895, 12 R. P. C. 262 | 121 | Incandescent mantles | Conditions of user must be made known to purchaser at time of purchase. |
| Incandescent Co. *v.* New Incandescent Co. | 1898, 15 R. P. C. 81 | 123 | Incandescent mantles | Non-appearance of defendants: surprise: judgment set aside: infringement by non-observance of conditions. |
| Institute of Patent Agents *v.* Lockwood | 1894, 11 R. P. C. 374; 1894, App. Cas. 371 | 189 | Patent Agents' rules | Defendant describing himself as "Patent Agent." Refusal to pay registration fees. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent | Chief Points affected by Decision, and *obiter dicta*. |
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| JOHNSON'S Patent .. | 1896, 13 R. P. C. 659 | 115, 116 | Sweet compound | Application to amend specification: an insufficient specification cannot be turned into a sufficient one: obvious mistake by translator might be cured. |
| Johnson *v.* Edge ... | 1892, 9 R. P. C. 112 | 151 | Filter blue bag | Threats: circular for wrapping goods: due diligence. |
| Jones, *Re* ... ... | 1885, Griff. A. P. C. 33; Good. O. C. 11, 21 | 21, 91 | Slate frame | Opposition to grant: "substantially the same" wrong in notice of opposition: applicant may refer to prior knowledge. |
| Jones *v.* Pearce .. . | 1832, Good P. C. 269 | 55 | Carriage wheels | Mere unsuccessful experiments no anticipation. |
| Jupe *v.* Pratt . | 1837, 1 Web. P. C. 115; Good. P. C. 271 | 42, 85 | Expanding table | Patent for principle: means for operating principle. |
| KANE *v.* Boyle ... | 1901, 18 R. P. C. 325 | 122, 143 | Manufacture of candy | Amended specification: no order for damages before amendment. |
| Kay's Patent ... ... | 1839, Good. P. C. 516; 1 Web. P. C. 568 | 6, 166 | Spinning flax | Petition for prolongation: practice to grant prolongation in cases of doubtful validity. |
| Kay *v.* Marshall... ... | 1836-41, 2 W. P. C. 36, 71, 79; 8 L. J. C. P. 261 | 25 | Spinning flax | Mere improved adjustment of parts no invention. |
| Kelly *v.* Heathman ... | 1890, 7 R. P. C. 313 | 81 | Telescopic ladder | The addition of a clear and distinct claim is directory only, not obligatory. |
| Kensington Electric Light Co. *v.* Lane-Fox Co. | 1891, 8 R. P. C. 277; 1891, 2 Ch. 577 | 159 | Distributing electricity | Threats: action for infringement must be taken by person actually threatening. |

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| Knight, *Re* | 1887, Griff. A. P. C. 35; Good. O. C. 26 | 98 | | Opposition to grant: appellant withdrawing must pay costs. |
| Kurtz *v.* Spence | 1886, 3 R. P. C. 368; 1887, 4 R. P. C. 127; 1888, 5 R. P. C. 161, 368; L. R. 33 Ch. D. 579 | 83, 155 | Manufacture of chemicals | Useless part vitiates whole: plaintiff in threats action may question validity of defendant's patent. |
| Kynoch *v.* Webb | 1899, 17 R. P. C. 100 | 52, 78, 86 | Concentration of sulphuric acid | Insufficiency of specification: old not distinguished from new. |
| LAKE, *Re* | 1888, 5 R. P. C. 115; Good. O. C. 28. | 98 | Locomotives | Opposition to grant: Comptroller will not consider transactions taking place abroad. |
| Lancashire Explosives *v.* Roburite | 1895, 12 R. P. C. 170 | 27 | Explosives | Combination of items of common knowledge, good subject-matter. |
| Lancaster's Application, *Re* | 1881, Griff. P. C. 293; Good. O. C. 21. | 93, 96 | Spring piston packing | Opposition to grant: opposition on expired patent: parties may show samples at hearing. |
| Lane-Fox's Patent | 1892, 9 R. P. C. 411 | 161 | Distributing electricity | Insufficient accounts: petition lodged during appeal from judgment holding patent invalid. |
| Lane-Fox *v.* Kensington Light Co. | 1892, 9 R. P. C. 413 | 10, 15, 61, 69 | Distributing electricity | Infringement: patent held bad for disconformity, non-utility, and insufficiency. |
| Lang's Patent | 1890, 7 R. P. C. 469; Good. O. C. 1st App. 17 | 114, 115 | Wire ropes | Amendment of specification *pendente lite*: addition of drawings and matter enlarging invention not allowed. |
| Lang *v.* Gisborne | 1862, Good. P. C. 278; 31 Beav. 133 | 58 | Self-registering target | Prior publication by French book. |
| Lawrence *v.* Perry | 1865, 2 R. P. C. 179 | 75 | Crayon holders | Anticipation by United States patents: drawings not an essential in specifications. |
| Leonhardt *v.* Kallé | 1891, 11 R. P. C. 531 | 127 | Colouring matter | Delay prejudices right to interim injunction. |
| Levinstein's Petition | 1898, 15 R. P. C. 732 | 179 | Dyes | Compulsory licence. Respondents manufacturing in Germany: no foreign patents: petition granted. |

| ame of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
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| Lewis *v.* Marling | 1829, Good. P. C. 281; 1 Web. P. C. 490; 4 Car. & P. 52, 57 | 63 | Cropping machines | Partial failure of utility not necessarily fatal to patent. |
| Lister *v.* Leather | 1857-8, S E. & B. 1004; Good. P. C. 283; 27 L. J. Q. B. 295 | 23, 29, 89 | Woolcombing machine | In combination claim essential part is protected apart from specified combination. |
| Lister *v.* Norton | 1885, 2 R. P. C. 68; 1886, 3 R. P. C. 199, 203 | 33, 55, 79, 136 | Imitation sealskin | Combination old in other goods may be new in specific application: publication during abandoned Provisional. |
| Livet's Patent | 1892, 9 R. P. C. 327 | 167 | Steam boilers | Petition for prolongation refused: specification not prepared in good faith: prior patent referred to by Crown. |
| L'Oiseau and Pierrard, *Re* | 1887, Griff. A. P. C. 36; Good. O. C. 75 | 91, 97 | Automatic electric battery | Applicant possessing accepted Complete may oppose grant: position of foreign applicant. |
| London Hosiery Co. *v.* Griswold | 1886, 3 R. P. C. 251 | 169 | Knitting machine | Agreement by assignor to impart further improvement to purchaser. |
| London & Leicester Co. *v.* Higham | "Lawson on Patents," 3rd Ed. p. 172 | 129 | Knitting machine | Practice in particulars of objections. |
| Longbottom *v.* Shaw | 1891, 8 R. P. C. 333; L. R. 43 Ch. D. 46 | 26 | Cloth winding frame | Obvious combination not subject-matter. |
| Lorraine, *Re* | 1888, 5 R. P. C. 112; Good O. C. 35 | 101 | Clocks | Disclaimer and references are inserted to inform the public. |
| Losh *v.* Hague | 1837-9, 1 Web. P. C. 200; 8 L. J. Ex. 251 | 47 | Wheels | Analogous user: wheel old on road, not new on rail. |
| Lucas *v.* Miller | 1885, 2 R. P. C. 155 | 63, 70 | Bicycle lamp | Disconformity not held. Legitimate development of Provisional. |

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| Luddington Cigarette Co. *v.* Baron Cigarette Co. | 1900, 17 R. P. C. 715 | 121 | Cigarette machine | Terms of amendment of specification *pendente lite*: severe terms imposed because of circumstances: no fixed rule as to terms. |
| Luke, *Re* | 1886, Griff. P. C. 291 | 99 | Spinning frame | Opposition to grant: patent issued jointly to applicant and opponent. |
| Lupton and Place, *Re* | 1897, 14 R. P. C. 261 | 105 | Loom Dobbie levers | Opposition to grant: applicant not allowed to claim something not originally relied on. |
| Lyon *v.* Goddard | 1893, 10 R. P. C. 331; 1894, 11 R. P. C. 351 | 15, 19 | Disinfecting machine | Small invention upheld: commercial success: utility: subject-matter. |
| Lyon *v.* Mayor of Newcastle | 1894, 11 R. P. C. 218 | 125, 127 | Disinfecting machine | Interlocutory injunction not granted where defendants have undertaken not to use machine. |
| Lyon's Patent | 1894, 11 R. P. C. 537 | 166 | Disinfecting machine | Prolongation granted on terms that patentee should issue licences to all persons on same terms. |
| MacEVOY, *Re* | 1888, 5 R. P. C. 285; Good. P. C. 11 | 96 | Portland cement | Opposition to grant: held, manufacturer under prior patent not entitled to oppose (but see *Re Meges*). |
| Macfarlane *v.* Price | 1816, 1 Web. P. C. 74; 1 Stark. 199; Good. P. C. 294 | 77 | Umbrellas | Patent held bad for not distinguishing old from new. |
| McCormick *v.* Gray | 1861, 2 H. & N. 25; 31 L. J. Ex. 12; Good. P. C. 292 | 50 | Agricultural machines | Claim for one old part renders whole invalid. |
| McLean's Patent | 1898, 15 R. P. C. 118 | 165 | Moulding slabs | Prolongation refused: accounts incorrect: law costs not entitled to be deducted from profits. |
| Mandelberg *v.* Morley | 1893, 11 R. P. C. 1 | 112 | Waterproofs | Submission of plaintiffs to have action dismissed: costs of particulars &c. reserved till reviewed by Taxing Master. |
| Marsden, *Re* | 1896, 13 R. P. C. 87 | 101 | Feeding textile fibre | Opposition to grant rebutted: no special reference, even if applicant's might infringe opponent's patent. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Marshall and Naylor's Patent | 1900, 17 R. P. C. 553 | 100, 148 | Hot and cold tap | Patent revoked on proof that employer had patented servant's invention: *substitution of petitioner.* |
| Mathers *v.* Green ... | 1865, L. R. 1 Ch 29; 34 Beav. 170; 35 L. J. Ch. 1; Good P. C. 208 | 109, 110, 170 | Lawn mower | Co-patentees: joint owners have equal and independent rights if interest not severed. |
| Medland, *Re* . | 1889, 41 Ch. D. p. 493 | 140 | —— | Costs of shorthand note of judgment in Appeal Court. |
| Meyer, *Re* . | 1899, 16 R. P. C. 523 | 97 | Looms for weaving | Opposition to grant: person working under prior patent entitled to oppose (*per curiam, Re MacEvoy*). |
| Mica Insulator Co. *v.* Electrical Co. | 1898, 15 R. P. C. 489 | 131 | Insulating material | Anticipation by prior grant (*per* Kekewich, J., p. 495, l. 36). |
| Millar and Miller .. | 1898, 15 R. P. C. 718 | 107 | Tanning hides | Opposition to grant: third ground of opposition not to affect legitimate development of Provisional. |
| Mills, *Re* .. .. | 1901, 18 R. P. C. 322 | 105 | Saccharin | Opposition to grant: applicant not allowed to shift his ground and substitute one claim for another. |
| Mills *v.* Carson ... . | 1892, 10 R. P. C. 9 | 175 | Lamp burner | Exclusive licence for term of patent: lapsing of patent from non-payment of fees: licensee must continue to pay royalties. |
| Minter *v.* Mower ... | 1837, 6 A. & E. 735; Good. P. C. 301 | 82 | Balanced chair | Claim so wide as to include prior patent: principle. |
| Montgomery *v.* Peterson | 1891, 11 R. P. C. 221, 633 | 118 | Manufacture of bread | Owner of invalid patent may procure revocation of another: a person giving licence to infringe another's patent does not himself infringe. |

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| Morgan's Patent | 1888, 5 R. P. C. 186; Good. O. C. 70; Griff. A. P. C. 17 | 115, 117 | Carriages | Petitioner to revoke having *locus standi* on any one ground may impeach the patent on any other lawful ground. |
| Morgan *v.* Windover | 1890, 7 R. P. C. 131; 1888, 5 R. P. C. 295 | 31, 47, 48, 61 | Carriage spring | Analogous user: "Coe" spring before used at rear of carriage, placed in front. Patent bad. |
| Morgan *v.* Seaward | 1837, 1 Web. P. C. 167; 2 M. & W. 544 | 53 | Paddle wheel | Prior confidential and experimental manufacture does not invalidate. |
| Moseley *v.* Victoria Rubber Co. | 1886, 3 R. P. C. 351; 55 L. T. N. S. 482; 1887, 4 R. P. C. 241 | 55, 59, 136 | Waterproof fabrics | Abandoned experiments: Patent Agent's communications not privileged. |
| Moser *v.* Marsden | 1893, 10 R. P. C. 350, 1895, 13 R. P. C. 24; 73 L. T. N. S. 667 | 22, 115, 116 | Raising machine | Propriety of amendment of specification not contestable save on fraud: unamended specification may be used to construe amended. |
| Moss *v.* Malings | 1886, 3 R. P. C. 373 | 132 | Bat handles | A witness may not usually be recalled to put fresh evidence to him. |
| Muirhead *v.* Commercial Cable Co. | 1891, 12 R. P. C. 39-61 | 113 | Electric transmission | Costs allowed on higher scale owing to technical character of case. |
| Mullins *v.* Hart | 1852, 3 Car. & K. 297; Good. P. C. 311 | 51 | Penholders | Anticipation by manufacture without sale by inventor (*per contra*, Betts *v.* Menzies). |
| Muntz *v.* Grenfell | 2 Web. P. C. 88 | 138 | Metal sheathing plates | Estopped against defendant who has worked patent in partnership with plaintiff. |
| Murchland *v.* Nicholson | 1893, 10 R. P. C. 417 | 50 | Milking apparatus | One bad claim vitiates whole patent. |
| NAIRN'S Patent | 1891, 8 R. P. C. 141 | 115 | Printing floorcloth patterns | Amendment of specification: extensive additions to description and the inclusion of drawings refused. |
| National Co. *v.* Gibbs | 1899, 16 R. P. C. 339; 2 Ch. 289; 18 W. R. 499 | 109, 181 | Distribution of electricity | The interest of co-patentees is joint and passes by survivorship. |
| Neilson *v.* Forman | 1841, 2 Coop. Ch. Ca. 61 | 127 | Smelting iron | Interlocutory injunction not readily granted where great loss and inconvenience would arise. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Neilson *v.* Harford | 1841, Good. P. C. 321; 1 Web. P. C. 295; 11 L. J. Ex. 20; 8 M. & W. 806 | 40, 41, 42, 84, 85 | Smelting iron | Construction of specification for the Court alone: no patent for mere principle. |
| Newall *v.* Elliott ... | 1858, Good. P. C. 326; 27 L. J. C. P. 337 | 67 | Telegraph wires | Office of Provisional: disconformity in details: differentiation of old from new. |
| Newman, *Re* ... ... | 1888, 5 R. P. C. 271; 279 | 100, 101 | Door check | Opposition to grant: Law Officer does not consider the question of disconformity: references are to protect the public. |
| New Ixion Co. *v.* Spilsbury ... ... .. | 1898, 15 R. P. C. 567 | 182 | Pneumatic tyres | Assignees should register to protect themselves. |
| New Ormonde Cycle Co., *Ex parte* | 1896, 2 Ch. 523; 13 R. P. C. 475 | 112, 181 | Cycles | Alteration in name may be placed on Register without Order of Court. |
| Newsum *v.* Mann ... | 1890, 7 R. P. C. 307 | 26 | Printing machines | Mere *casting together of known* parts no invention. |
| Newton, *Re* ... ... | 1899, 17 R. P. C. 123 | 102 | Looms for weaving | Opposition to grant. Reference following claim of prior patent. |
| Newton's Patent .. | 1884, 1 R. P. C. 177 | 161 | Sand blast | Petition for prolongation dismissed because of defective accounts: adjournment to correct, refused. |
| Nicoll *v.* Swears ... | 1893, 10 R. P. C. 210 | 46 | Ladies' habits | Burstable seam: mere adaptation no invention. |
| Nobel *v.* Anderson ... | 1894, 11 R. P. C. 519 | 62 | Explosives | A specification to be construed as of its date. |
| Nobel's Explosives Co. *v.* Anderson | 1895, 12 R. P. C. 164 | 39 | Explosives | Apparently slight changes may involve non-infringement in chemical patents. |

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| Nordenfelt's Patent ... | 1887, Good. O. C. 70; Griff. A. P. C. 18 | 115 | Iron castings | Insufficient specification cannot be transformed by amendment into a sufficient one. |
| North British Rubber Co. *v.* Gormully Co. | 1894. 12 R. P. C. 17 | 127 | Pneumatic tyres | Interlocutory injunction refused on account of delay and growth of defendant's trade. |
| Norwood's Patents ... | 1895, 12 R. P. C. 214 | 148 | Compound for coating walls | Revocation of patent obtained in fraud of petitioner's rights. |
| Nuttall *v.* Hargreaves ... | 1891, 8 R. P. C. 273, 450; 61 L. J. Ch. 94; 1892, 1 Ch. 23 | 69, 72 | Liquor tap | Patent void for disconformity: only new feature in combination, not in Provisional. |
| OLDHAM *v.* Langmead | 1789, 3 T. R. 439; Good. P. C. 342 | 138 | Unreported | Defendant, assignee to plaintiff, estopped from disputing validity. |
| Osmonds *v.* Balmoral Cycle Co. | 1898, 15 R. P. C. 505 | 71 | Cycle chain adjustment | Claim for combination of improvement, with accidental displacement of other item, held bad. |
| Osmonds *v.* Mutual Cycle Co. | 1899, 2 Q. B. 488 | 140 | Cycles | In taxation of costs between solicitor and client cost of shorthand notes allowed as necessary expense. |
| Otto *v.* Linford . | 1881, 46 L. T. N. S. 35; Good. P. C. 343 | 42, 47, 75, 85, 111 | Gas engine | Principle, with means for carrying into effect, held good claim. |
| Otto *v.* Steel . | 1885-6, 3 R. P. C. 109; L. R. 31, C. D. 241 | 58 | Gas engine | No prior publication where book not accessible to public. |
| Oxley *v.* Holden | 1860, Good. P. C. 350; 8 C. B. N. S. 666 | 55 | Carriage doors and sashes | Effect of publication during term of abandoned Provisional. |
| PARKER *v.* Maignen .. | 1888, 5 R. P. C. 207 | 133 | Filter | Application on eve of trial for leave to amend particulars of objection: plaintiff proceeding: terms. |
| Parker *v.* Satchwell ... | 1901, 18 R. P. C. 299 | 86 | Hair retaining device | A claim apparently in gross, may be construed as being appendant to main invention. |
| Parkes *v.* Stevens .. | 1869, L. R. 8 Eq. 358; 38 L. J. Ch. 627; Good. P. C. 355 | 29 | Lamps | Claim for combination protects each part that is new and material for that purpose. |
| Parkinson *v.* Simon .. | 1894, 11 R. P. C. 493; 1895, 12 R. P. C. 463 | 63, 85, 87 | Grain sieves | A claim is not a disclaimer: it is presumed that no two claims are co-extensive. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by decision, and *obiter dicta*. |
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| Parnell's Patent | 1888, 5 R. P. C. 126 | 111, 180, 183 | Pyrites process | An ante-provisional agreement which does not identify the invention cannot be put on the Register. |
| Patent Type Founding Co. *v.* Richards | 1860, 6 Jur. N. S. 39; Johns. 381; Good. P. C. 360 | 75 | Type metal | Provisions in specification for varying proportions do not create insufficiency. |
| Patterson *v.* Gas Light Co. | 1875-6, 3 App. Cas. 239; 47 L. J. Ch. 102 | 57 | Gas manufacture | Anticipation by publication to co-referees in preparing Government report. |
| Peck *v.* Hinde | 1898, 15 R. P. C. 113 | 156 | Hair curlers | Due diligence in threats action. |
| Peganoid *v.* British Leather Cloth Co. | 1901, 18 R. P. C. 317 | 111 | Waterproofing paper &c. | Anticipation by publication and prior user: on plaintiff's case breaking down, defendants allowed to continue cross-examination to establish their particulars of objections. |
| Penn *v.* Bibby | 1866, L. R. 1 Eq. 548; Good. P. C. 396; L. R. 3 Eq. 308; L. R. 2 Ch. 127; 36 L. J. Ch. 277, 455 | 35, 139 | Wood bearings for shafts | Old wood-choke bearings held not to anticipate shaft bearings of wood with means for water circulation. |
| Perry *v.* Société des Lunetiers | 1896, 13 R. P. C. 661 | 49 | Folding cameras | Addition of hinge-lock to camera held to constitute invention. |
| Pether *v.* Shaw | 1893, 10 R. P. C. 293 | 50, 82 | Feed water governor | Two methods claimed: one useless and old. Patent bad. |
| Pharmaceutical Society *v.* Piper | 1893, L. R. 1 Q. B. 686 | 188 | Medicine | "Patent Medicines" mean medicines which are the subject of Letters Patent. |
| Philpott *v.* Hanbury | 1885, 2 R. P. C. 33 | 59, 62 | Drafting dress patterns | Anticipation to be read as understood by workmen of "highest skill." |

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| Pieper's Patent .. .. | 1895, 12 R. P. C. 292 | 166 | Steam expansion valves | Prolongation refused mother patents abroad expired: delay in working. |
| Piggott *v.* Anglo-American Telegraph Co. | 1868, 19 L. T. N. S. 46 | 131 | Submarine cables | Inspection refused: secrets of manufacture endangered. |
| Pilkington *v.* Yeakley Hammer Co. | 1901, 18 R. P. C. p. 159 | 111 | Power hammers | Stay of execution refused: plaintiffs giving an undertaking. |
| Pirrie *v.* York Street Flax Co. | 1893, 10 R. P. C. 31; 1894, 11 R. P. C. 129 | 35, 18, 65, 132 | Wet flax spinning | User analogous to old dry spinning: small invention: patent sustained. |
| Pitt's Patent, *Re* | 1901, 18 R. P. C. 178 | 122 | Cigarette machine | Amendment of specification *pendente lite*: terms imposed by the Court will not be extended by the Law Officer. |
| Plating Co. *v.* Farquharson | 1879, L. R. 17 Ch. D. 49; Griff. P. C. 187 | 134 | Nickel plating | Inspection may be referred to expert sworn to secrecy. |
| Plimpton *v.* Malcolmson | 1875-6, L. R. 20 Eq. 37; Good. P. C. 371 | 58 | Roller skate | No anticipation by book inaccessible to public. |
| Plimpton *v.* Spiller | 1877, L. R. 4 Ch. D. 286; 20 Sol. J. 860; Good. P. C. 380 | 51, 52, 85, 86, 88 | Roller skate | Subordinate claim bad *per se* may be construed as appendant to main invention and therefore good. |
| Pneumatic Tyre Co. *v.* Chisholm | 1896, 13 R. P. C. 188 | 128, 111, 112 | Pneumatic tyre | Plaintiff possessing certificate of validity should plead it in subsequent action. |
| Pneumatic Tyre Co. *v.* Dunlop | 1896, 13 R. P. C. 553 | 169 | Pneumatic tyre | Covenants in assignment as to future improvements. |
| Pneumatic Tyre Co. *v.* East London Rubber Co. | 1896, 14 R. P. C. 77, 573 | 67, 70 | Pneumatic tyre | Not necessary in Provisional to detail advantages: invention in Provisional may extend to unforeseen developments in Complete. |
| Pneumatic Tyre Co. *v.* English Cycle Co. | 1897, 14 R. P. C. 851 | 67 | Pneumatic tyre | An abandoned Provisional may be ordered to be produced in Court by Patent Office to refute statement of witness. |
| Pneumatic Tyre Co. *v.* Leicester Pneumatic Co. | 1898, 15 R. P. C. 159 | 142 | Pneumatic tyre | "Subsequent action" certificate of validity. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
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| Pneumatic Tyre Co. *v.* Puncture Proof Co. | 1899, 16 R. P. C. 209 | 139 | Pneumatic tyre | The measure of damages is the actual loss sustained by plaintiffs. |
| Pneumatic Tyre Co. *v.* Tubeless Tyre Co. | 1898, 16 R. P. C. 77 | 39 | Pneumatic tyre | Non-infringement of the Welch tyre, the defendants not using an inner tube, the essence of the Welch combination. |
| Presto Gear Case Co. *v. Orme* | 1900, 18 R. P. C. 17 | 84 | Gear case | Lord Alverstone on the line of thought to adopt in deciding patent cases. |
| Preston Davies *v.* Black | 1894, 11 R. P. C. 574 | 44 | Pneumatic tyres | *Per* Lord McLaren: no patent for external form of element of mechanism apart from its use. |
| Proctor *v.* Bennis ... | 1887, 4 R. P. C. 333; L. R. 36 Ch. D. 740; 57 L. J. Ch. 11. | 30, 52, 71, 89 | Mechanical stoker | Where combination contains a new and essential element, that element separately cannot be taken and used with another combination for same purpose. |
| RANSOME *v.* Graham | 1882, 51 L. J. Ch. 903 | 187 | Trade mark case | Marking article "Patent" after patent expired. |
| Redges *v.* Mulliner ... | 1892, 10 R. P. C. 21 | 174 | Carriages | Right of licensee to terminate licence. |
| Reg. *v.* Crampton ... | 1886, 3 R. P. C. 367 | 187 | Electric bell | Applicant having Provisional protection only is subject to penalty for marking goods "Patent." |
| Reg. *v.* Comptroller, *ex parte* Tomlinson | 1899, 16 R. P. C. 233; 1899, 1 Q. B. 909; 68 L. J. Q. B. 568 | 97, 99, 118 | Looms for weaving | Opposition to grant: persons entitled to be heard: mandamus against Comptroller refused. |
| Reg. *v.* Cutler ... ... | 1816, 1 Stark 351; 1 Web. P. C. 76 *n.* | 82 | Fire grate | Revocation: principle claimed apart from apparatus. |
| Reg. *v.* County Court Judge of Halifax | 1891, 8 R. P. C. 338; 60 L. J. Q. B. 550 | 126 | Beer jug | Patent a franchise: County Court no jurisdiction to try validity. |

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| Reg. *v.* Townsend ... | 1896, 13 R. P. C. 265 | 188 | Not reported | An applicant whose Complete Specification has been accepted is apparently entitled to mark his goods "Patent." |
| Reg. *v.* Wallis ... ... | 1885, 3 R. P. C. 1 | 187 | Lamp | Applicant for Provisional protection may not mark his goods "Patent." Penalty inflicted. |
| Renard *v.* Levinstein ... | 1864-5, 11 L.T.N.S. 79, 505; 2 H. & M. 628; *Good.* P. C. 400 | 126, 175 | Dyes | Licensees may join with owners of patent as co-plaintiffs. |
| Rex *v.* Metcalf ... ... | 1 Web. P. C. 141 *note* | 65 | Tapering brush | Title held defective: bristles were of unequal length. |
| Rickmann *v.* Thierry ... | 1896, 14 R. P. C. 105 | 37, 46, 47, 48, 145 | Eyelets | A product is subject-matter: novelty does not prove invention. |
| Roper's Patent ... ... | 1887, 4 R. P. C. 201 | 166 | *Life raft* | *Prolongation*: delay in bringing into use through patentee's illness. |
| Rose's Patents Co. *v.* Braby & Co. | 1894, 11 R. P. C. 198 | 31, 129, 131 | Lighting apparatus | Held anticipated by patent of prior grant. Plaintiff's application made two months before publication of prior specification. |
| *Russell, Re* ... ... | 2 *De G. & J.* 130; *Good.* P. C. 589 | 99 | *Metal tubes* | *Opposition*: joint grant to applicant and opponent. |
| Russell *v.* Cowley ... | 1835, *Good.* P. C. 406; 1 C. M. & R. 864 | 38 | Gas tubes | Mutual inspection and taking samples: addition or subtraction constitutes invention. |
| Rylands *v.* Ashley ... | 1890, 7 R. P. C. 175 | 135 | Glass bottles | Sufficiency of answers to interrogatories. |
| SACCHARIN Corporation *v.* Anglo-Continental Works | 1900, 17 R. P. C. 307; 1901, 1 Ch. 414 | 124 | Saccharin | Indirect infringement: importation of goods partly made from patented ingredients abroad. |
| Saccharin Corporation *v.* Haines | 1898, 15 R. P. C. 344 | 136 | Saccharin | Insufficient replies to interrogatories: order for better answers. |
| Saccharin Corporation *v.* Reitmeyer | 1900, 17 R. P. C. 666; 1900, 2 Ch. 659 | 123 | Saccharin | Contract made in England and executed abroad no infringement. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
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| Saccharin Corporation *v.* Sitos | 1900, 17 R. P. C. 536 *note* | 112 | Saccharin | Certificate of validity given in absence of defendants. |
| Sachse's Application ... | 1900, 18 R. P. C. 221 | 104 | Incandescent mantles | Opposition to grant: in restricted improvement, position of alleged master patent not to be discussed narrowly. |
| Savage *v.* Harris | 1896, 13 R. P. C. 90, 361 | 49, 60, 75 | Ladies' hat comb | Drawings not an essential in specification: anticipation: no invention. |
| Saxby *v.* Gloucester Waggon Co. | 1880-3, L. R. 7 Q. B. D. 305; Good. 417; 50 L. J. Q. B. 577 | 21 | Railway signals | Mere combination without invention. Patent invalid. |
| Semet & Solvay's Patent | 1894, 12 R. P. C. 10 | 164 | Distilling coal | Prolongation: foreign patent lapsed: difficulty of introduction: meritorious invention. Petition granted. |
| Serrell's Patent .. .. | 1889, 6 R. P. C. 101 | 116 | Electric Solenoid | Patent cannot be amended by striking out original claim and substituting subordinate arrangement. |
| Shaw *v.* Barton ... ... | 1895, 12 R. P. C. 282 | 31 | Jointing tyre rings | Analogous application: no invention. Patent bad. |
| Shillito *v.* Larmuth ... | 1884, 2 R. P. C. 1 | 127 | Stoves | Interlocutory injunction granted where patent ten years old and not previously challenged. |
| Shoe Machinery Co. *v.* Cuttan | 1895, 12 R. P. C. 530; 65 L. J. Ch. 44 | 132 | Shoe making machinery | Leave refused by Court of Appeal to allow defendants after trial to add to their particulars of objections. |
| Siddell *v.* Vickers ... | 1887-9, 5 R. P. C. 81, 416; 6 R. P. C. 464; 1892, 9 R. P. C. 152 | 26, 27, 140 | Operating heavy forgings | Combination of old materials: held valid: no disconformity: absence of distinctness in claim not fatal. |
| Sielaff, *Re* ... ... | 1888, 5 R. P. C. 484 | 103 | Coin-freed apparatus | Opposition to grant: alleged master patent may be limited by its own claim. |

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| Simpson *v.* Holliday | 1865-6, 12 L. T. N. S. 99; Good. P. C. 425; L. R. 1 H. L. 315 | 74, 78, 82 | Dyes | Of two processes claimed one was useless. Patent held bad. |
| Singer *v.* Rudge ... | 1891, 11 R. P. C. 463 | 33 | Bicycle Lock | Lock old in one form of machine: held no invention as applied to other form. |
| Sinnette's Patent ... | 1898, 15 R. P. C. 761 | 55 | Anchor | Anticipation by article no longer in existence: memory of wi. esses. |
| Skinner *v.* Perry ... | 1892, 9 R. P. C. 406; 10 R. P. C. 1 | 151, 155 | Camera | Threats: letter from patentee in reply to enquiry alleging plaintiff's to be infringement of his. |
| Slazenger *v.* Feltham ... | 1888, 6 R. P. C. 130 | 48 | Tennis racquet | Anticipation: no subject-matter or invention. |
| Smith, *Re* ... ... | 1896, 13 R. P. C. 200 | 106 | Water heater | Opposition to grant: Law Officer may consider doctrine of mechanical equivalents. |
| Smith's Patent, *Re* .. | 1886, Griff. P. C. 268 | 80 | Unreported | So long as a claim clearly points to the subject-matter of the specification it will suffice to secure acceptance from Comptroller. |
| Southwell and Head, *Re* | 1899, 16 R. P. C. 361 | 103 | Weaving carpets | Opposition to grant: opponent alleging master patent must bring evidence of state of knowledge before the Comptroller. |
| Spencer *v.* Ancoats Rubber Co. | 1888, 6 R. P. C. 46 | 139 | India rubber springs | A body corporate committing breach of injunction is liable to sequestration of goods and committal of directors. |
| Spencer *v.* Jack .. ... | 1862-4, 3 D. J. & S. 346; Good. P. C. 431; 11 L. T. N. S. 212 | 25 | Steam engines | Combination of known things embodying substantial improvement is good subject-matter. |
| Stanfield's Patent ... | 1897, 15 R. P. C. 17 | 165 | Hydraulic pontoons | Prolongation refused: petitioner must disclose in petition his earlier patents for same subject. |
| Storey *v.* Graham ... | 1899, 1 Q. B. 406; 16 R. P. C. 106 | 189, 190 | Patent Agents' Rules | Unregistered person describing himself as "Patent Agent": conviction affirmed. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Stead *v.* Williams ... | 1843-4, Good. P. C. 437; 13 L. J. C. P. 218 | 57 | Wooden pavements | Tindal, C. J., on prior publication. |
| Steers *v.* Rogers ... | 1893, 10 R. P. C. 245; 1893, App. Cas. 233; 68 L. T. 726 | 110 | Manufacture of gas | Part owner of patent by assignment can work independently of co-owner without accounting. |
| Stell's Application ... | 1891, 8 R. P. C. 235 | 101 | Doubling fibres | Principles applied by Law Officer in requiring disclaimers in opposed patents. |
| Stevens *v.* Keating ... | 1847, 2 Web. P. C. 182; 19 L. J. Ex. 57; Good. P. C. 443 | 39, 81 | Artificial marble | Claim too wide. Patent bad. |
| Stewart's Application ... | 1896, 13 R. P. C. 627 | 91, 97 | Steam boiler furnace | Opposition: persons entitled to oppose before Comptroller are the same as those entitled before Law Officer. |
| Stewart's Patent ... | 1885, 3 R. P. C. 7 | 163 | Sugar mills | Prolongation refused: anticipation: evidence not in particulars of objection admitted at hearing: costs. |
| Stewart *v.* Casey ... | 1891, 9 R. P. C. 9 | 111, 168, 184 | Vessels for holding volatile liquids | Equitable assignments may be entered on Register: an assignment of patent must be by deed. |
| Stohwasser *v.* Humphreys | 1900, 18 R. P. C. 116 | 48 | Puttee gaiter | Analogous application and combination of old items. Patent bad. |
| Stuart, *Re* ... ... | 1892, 9 R. P. C. 452 | 99 | Making fishing nets | Opposition to grant. Evidence of fraud before Comptroller must be such as would convince jury. |
| Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co. | 1897, 14 R. P. C. 757 | 62, 113 | Incandescent lamp | Certificate of validity granted on expired patent. |

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| TATHAM *v.* Dania ... | 1869, Griff. P. C. 213 | 45 | Waste breaking machine | Analogous application: no invention: no infringement. |
| Taylor's Patent ... ... | 1896, 13 R. P. C. 482 | 51, 149 | Fire-place | Anticipation by prior user of one grate in private house. |
| Taylor and Scott *v.* Annand | 1900, 18 R. P. C. 53 | 27 | Late news type-setting | Old materials used for new purpose. Patent sustained. |
| Thomas *v.* Hunt . | 1861, 17 C. B. N. S. 183; Good. P. C. 462 | 124, 172 | Manufacture of soap | Licence to manufacturer implies licence to sell and resell. |
| Thomas and Prevost ... | 1898, 16 R. P. C. 69 | 105 | Mercerising fabrics | Opposition to grant: an originally improperly framed specification may be refused amendment. |
| Thomas and Prevost .. | 1898, 15 R. P. C. 257 | 107 | Dyeing fabrics | Opposition to grant: withdrawal of opponent after decision: refusal of Law Officer to reopen case except on ground of fraud. |
| Thompson *v.* James ... | 1863, 32 Beav. 570; Good. P. C. 465 | 33 | Crinoline steels | Analogous application: substitution of steel for whalebone. Patent invalid: no subject-matter. |
| Thomson *v.* Hughes | 1890, 7 R. P. C. 187 | 136 | Mariner's compass | Discovery of documents in chambers: appeal for larger order refused. |
| Thomson *v.* Macdonald | 1890, 8 R. P. C. 5 | 59 | Steam boilers | Common knowledge by specification: if defendant pleads "not true and first inventor," he should show who is: specification insufficient *qua* specification may be sufficient as anticipation. |
| Thornborough and Wilks | 1896, 13 R. P. C. 115 | 100, 102 | Moveable partition | Opposition: applicant may not contend that opponent's patent is bad from prior use or publication. |
| Ticket Punch Register *v.* Colley | 1895, 12 R. P. C. 171 | 137 | Ticket punch | Expert's evidence on mechanical equivalents is "legitimate and important." |
| Tolt's Application, *Re* ... | 1892, 9 R. P. C. 487 | 104 | Bottle stoppers | Opposition: if applicant's invention shows no substantial advance on opponent's, the patent will be refused. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Tubeless Tyre Co. *v.* Trench | 1899, 16 R. P. C. 291 | 61, 69 | Pneumatic tyres | Patent held bad for disconformity and non-utility. Patentee may not cure defects by use of subsequent knowledge: utility means useful for specified purpose. |
| Tubes, Limited *v.* Perfecta Tube Co. | 1901, 18 R. P. C. 339 | 86 | Tubes | An essential part omitted in claim will not be read into claim by the Court. |
| UNITED Horseshoe Nail Co. *v.* Stewart | 1885, 2 R. P. C. 122; 3 R. P. C. 139; 5 R. P. C. 269; 13 App. Cas. 401 | 58 | Nail making machine | If prior publication accessible to public, not necessary to prove that anyone consulted it. |
| United Horseshoe Nail Co. *v.* Swedish Horse Nail Co. | 1888, 6 R. P. C. 1 | 62 | Nail making machine | Non-utility of part vitiates the whole. |
| United Telephone Co. *v.* Equitable Telephone Co. | 1888, 5 R. P. C. 233 | 127 | Telephone transmitter | Delay in applying for interlocutory injunction may be excusable from circumstances. |
| United Telephone Co. *v.* Harrison | 1882, Good. P. C. 472; L. R. 21 C. D. 720 | 67 | Electro-telephony | Disconformity: Fry, J., on office Provisional: prior publication. |
| United Telephone Co. *v.* Walker | 1886, 4 R. P. C. 63; 56 L. T. 508 | 139 | Telephone transmitter | Defendant not entitled to set off value of goods delivered up as against damages. |
| VAISEY'S Patent ... | 1894, 11 R. P. C. 501 | 150 | Medicine | Fact that patent taken out with purpose of evading Pharmacy Act not *per se* ground for revocation. |
| Van Gelder *v.* Sowerby Bridge | 1890, 7 R. P. C. 208 | 112, 171 | Separator | Mortgagee cannot be registered as *proprietor*: *mortgagor may* sue alone for infringement. |

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| Vavasseur *v.* Krupp ... | 1870, L.R. 9 Ch. D. 351; *Good.* P. C. 483 | 139 | Projectiles | Infringement by importation: rights of foreign Sovereign: goods delivered up remain property of defendant. |
| Vickers's Application, *re* Siddell's Patent | 1887, Griff. P. C. 320 | 117 | Operating heavy forgings | Petition for revocation: application for Attorney-General's fiat: arrangement as to costs in action. |
| Vickers *v.* Siddell ... | 1890, 7 R. P. C. 292; 15 App. Cas. 496 | 28, 68, 81 | Operating heavy forgings | Absence of distinct claim not fatal: combination of old parts: small amount of invention: no disconformity. Patent upheld. |
| Vorwerk *v.* Evans ... | 1890, 7 R. P. C. 265 | 36 | Curved waistband | Claim for product: different mode of production: no infringement. |
| Von Buch, *Re* ... | 1887, Griff. A. P. C. 40; *Good.* O. C. 17 | 98 | Incandescent gas light | Opposition: invention described but not claimed in prior patent. |
| Von Heyden *v.* Neustadt | 1880, L. R. 14 Ch. D. 230; 50 L. J. Ch. 126 | 58 | Salicylic acid | Indirect infringement: importation of product made abroad by aid of patented materials (see *Saccharin Co. v. Anglo-Continental Works*): mosaic of anticipations. |
| WAITE *v.* Johnson ... | 1900, 18 R. P. C. 1 | 158 | Die press | Threats: due diligence: application for interlocutory injunction refused, patentee having commenced action. |
| Walker *v.* Hydro-Carbon Syndicate | 1884, 2 R. P. C. 3 | 149 | Liquid fuel | Revocation petition on prior patent dismissed: the respondent may show by prior publication the limitation of the petitioner's patent. |
| Wallington *v.* Dale ... | 1851, *Good.* P. C. 487; 23 L. J. Ex. 49. 7 Ex. 888 | 38, 49 | Making gelatine | Omission of step in process, good subject-matter. |
| Ward *v.* Livesey ... | 1888, 5 R. P. C. 102 | 171 | Loom dobbies | Licence coupled with interest is not revocable at will, but is liable to forfeiture on breach of conditions. |
| Washburn Manufacturing Co. *v.* Cunard | 1889, 6 R. P. C. 398 | 125, 126 | Barbed wire | Importation by mere carriers is infringement. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Webb *v.* Levinstein ... | 1898, 15 R. P. C. 78 | 155 | Concentrating sulphuric acid | Single threat not followed by action: injunction granted. |
| Welch's Application, *Re* Martin | 1887, Griff. P. C. 320 | 147 | Tyres | Abandoned application for Attorney-General's fiat: no costs. |
| Welch, *Re* ... | 1889, Good. O. C. 10 | 91 | Tyres | Notice of opposition may be amended at hearing. |
| Welsbach *v.* Krumm .. | 1901, 18 R. P. C. 211 | 112 | Incandescent mantle | Certificate of validity granted in absence of defendants. |
| Welsbach Incandescent Co. *v.* New Incandescent Co. | 1900, 17 R. P. C. 237 | 62 | Incandescent mantle | Decreased utility in one respect balanced by increased utility in another will support patent. |
| Welsbach Incandescent Co. *v.* New Sunlight Co. | 1900, 17 R. P. C. 101 | 135 | Incandescent mantle | Interrogatories: member or officer of corporate body not obliged to give information in reply, which he has acquired outside of his existing relationship to company. |
| Wenham *v.* May | 1887, 4 R. P. C. 303 | 30 | Gas lamp | Infringement by taking essential of combination. |
| Whittaker, *Re* .. | 1896, 13 R. P. C. 580 | 101, 105 | Hand drill | Opposition: if nothing patentable left, patent refused. |
| Wilcox and Gibbs *v.* James | 1897, 14 R. P. C. 523 | 111 | Sewing machines | Discontinuance by plaintiff: certificate of defendant's particulars of objections refused on summons. |
| Williams *v.* Nye ... | 1890, 7 R. P. C. 62 | 24, 48 | Sausage machine | Mere connecting together of old things without invention no subject-matter. |
| Willoughby *v.* Taylor . | 1893, 11 R. P. C. 45 | 155 | Coiled wire tyres | Threats: injunction granted, defendant refusing to try validity of patent. |

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| Wilson *v.* Wilson | 1899, 16 R. P. C. 315; 1900, 17 R. P. C. 177; 18 R. P. C. 139 | 16, 88, 120, 132, 133, 134 | Bobbin ferrules | Utility: commercial success: small invention: patent held invalid on account of claim for separately useless part of combination. |
| Wood *v.* Raphael | 1897, 14 R. P. C. 496 | 26, 27, 18 | Double eye-glasses | Combination of old parts formerly separately used for same purpose: combination showed no new functional advantage. Patent upset. |
| Wood *v.* Zimmer | 1815, 1 Web. P. C. 44; Good. P. C. 502 | 51 | Manufacture of verdigris | Patent held bad for concealment in specification: anticipation by prior user for profit. |
| Woodward *v.* Sansum | 1887, 4 R. P. C. 166 | 70 | Pencil cases | Cotton, L. J., on disconformity: disconformity rebutted: legitimate development of Provisional. |
| Woolley *v.* Broad | 1892, 9 R. P. C. 208, 192 | 120, 132 | Lace design | Discretion of Judge: terms on amending particulars. |
| Worthington Pump Co. *v.* Weir | 1891, 11 R. P. C. 657 | 118 | Anti-corrosive for steam boilers | Revocation of patent: omission of essential from claim held fatal. |
| YATES and Kellett's Patent | 1887, 4 R. P. C. 150 | 167 | Wire cards | Prolongation refused: absence of proper accounts: adjournment to amend accounts refused. |
| Young *v.* Rosenthal | 1884, 1 R. P. C. 29 | 61, 84 | Corsets | Utility means an invention "better than the preceding knowledge": effect of word "substantially" in claim. |

| Name of Case. | Where Reported. | Pages in this Book. | Marks and Goods. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| ACCIDENT Insurance Co. *v.* Accident, Disease, and General Insurance Co. | 1884, 54 L. J. Ch. 101 | 272 | Firm name | Names too similar. Injunction granted. |
| Adam's Trade Mark ... | 1892, 9 R. P. C. 171 | 239 | Label with printed matter: furniture polish | Old mark: application to amend mark by removal of word "Patent" refused. |
| American Tobacco Co. *v.* Guest | 1892, 9 R. P. C. 218 | 219 | "Chancellor" cigarettes | Innocent user on small scale of mark: no costs against defendant. |
| Anglo-Swiss Milk Co. *v.* Metcalf | 1886, 31 Ch. D. 454; 3 R. P. C. 28 | 233 | Female carrying pails: milk | Word "Dairy-maid" with figure and pails considered too similar. |
| Apollinaris Co., *Re* ... | 1891, 2 Ch. 186; 8 R. P. C. 136 | 191, 207, 232, 235, 239 | "Apollinaris": for table waters | Geographical name. |
| Apollinaris Co. *v.* Herrfeldt | 1887, 4 R. P. C. 178, 183 | 231, 246, 253 | "Apollinaris": for table waters | "Apollinis" held similar. |
| Apollinaris Co. *v.* Norrish | 1875, 33 L. T. N. S. 212 | 191 | "Apollinaris": for table waters | Person having exclusive access to goods from one source, has exclusive right to name of that source, even though geographical. |
| Arbenz, *Re* ... ... | 1887, 4 R. P. C. 113 | 235 | "Gem": for air guns | Held descriptive. |
| Army and Navy Co-operative Stores, Limited, *v.* Junior Army and Navy Stores | 1879, Solas. Dig. 393 | 272 | Firm name | Injunction refused. |

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| Australian Mortgage Land Co. *v.* Australian and New Zealand Mortgage Co. | 1880, W. N. 6 C. A. | 272 | Firm name | Injunction refused |
| Australian Wine Importers Co., *Re* | 1889, 6 R. P. C. 311; 41 Ch. D. 278 | 191 | Label or "brand": for wine | Mere middleman may register trade mark. |
| Automatic Weighing Machine Co. *v.* Hygienic Society | 1889, 6 R. P. C. 175 | 255 | Patent case: automatic machines | Certificate of validity obtained in trade mark action to be pleaded in subsequent action. |
| BAKER *v.* Rawson | 1890, 8 R. P. C. 89 | 230, 236 | Circles, containing lighthouse; for files | Old mark: untrue statement as to user: expunged from Register. |
| Balfour *v.* Kilburn | 1862, 1 Hyde 270 | 215 | Crane on green background | Pelican on similar backing held to infringe. |
| Barlow *v.* Johnson | 1890, 7 R. P. C. 395 | 229, 232 | "Osman" towels | Prior publication and use by other trader does not invalidate: circumstances at date of registration to be regarded. Infringement held. |
| Barnett *v.* Leuchars | 1865, 13 L. T. N. S. 195 | 217 | "Pharaoh's Serpents": for fireworks | Use of plaintiffs' old boxes bearing his labels, held infringement. |
| Batt *v.* Dunnett | 1899, 16 R. P. C. 411; 1899, A. C. 128 | 222, 235, 236 | "Butterfly": for foodstuffs | Mark expunged: no real user of mark before or since registration. |
| Bayer *v.* Connell | 1897, 14 R. P. C. 275 | 240 | "C. B.": for corsets | Irish Court disclaims jurisdiction to order rectification of Trade Mark Register. |
| Bell and Black *v.* Bell | 1876, Sob. Dig. 514 | 216 | "Bell": device for matches | Similarity of bell and beehive. |
| Bewlay *v.* Hughes | 1898, 15 R. P. C. 290 | 263 | "Dindigul": for cigars | Geographical name: defendant restrained except as to cigars actually made of Dindigul leaf. |
| Blanchard *v.* Hill | 1742, 2 Atk. 484 | 192 | "Great Mogul": for cards | Courts in former times refused right of property in trade marks. |
| Bodega Co. *v.* Owens | 1889, 7 R. P. C. 31 | 270 | "Bodega," name of shops | Defendant restrained from using name either on shop or goods. |
| Boulnois *v.* Peake | 1868, 13 Ch. D. 513 *note* | 270 | "Carriage Bazaar," name of shop | Defendant restrained from using name. |

| Name of Case. | Where Reported. | Pages in this Book. | Marks and Goods. | Chief Points affected by Decision, and *short facts*. |
|---|---|---|---|---|
| Bovril Trade Mark | 1896, 13 R. P. C. 382 | 201 | "Bovril": for meat extract | Held to be fancy word not descriptive. Date of registration to be considered. |
| British Electrozone Co.'s Application | 1896, 13 R. P. C. 117 | 203 | "Electrozone": for chemicals | Held not invented word, being in ordinary use in America. |
| Brooks *v.* Brookes .. | 1899, 16 R. P. C. 523 | 197 | Name "Brooks" on cycle saddles | Defendant restrained from using his own name in confusing manner. |
| Brown's Marks, *Re* .. | 1891, 11 R. P. C. 365 | 239 | "Label" for blacking | Proprietor of old mark allowed to alter names and addresses on labels. |
| Budd *v.* Lucas | 1891, Div. Ct. 1 Q. B. 408 | 280 | Merchandise Marks Act | False description may be on invoice. |
| Burgess *v.* Burgess | 1853, 3 De G. M. & G. 896; 22 L. J. 675 | 197, 261, 270 | "Burgess's Essence of Anchovies" | Injunction refused in respect of use of name by plaintiff's son; granted in respect of imitative get-up of shop front. |
| Burgoyne's Trade Mark | 1889, 6 R. P. C. 227 | 231 | "Finn": for wines | "Connor" held dissimilar. |
| Burke's Trade Marks | 1891, W. N. 2 | 238 | Labels | Addition of "Limited" to name and removal of non-essential words allowed. |
| Burland *v.* Broxburn Co. | 1889, 6 R. P. C. 182 | 235, 236 | Label for soap, containing as prominent part the word "Washerine" | Word held descriptive: allowed to be disclaimed. |
| CALIFORNIAN Fig Syrup Co.'s Mark | 1888, 6 R. P. C. 126 | 216 | Label for medicines | Foreign marks registered under Convention must conform to British requirements. |
| Cameron *v.* Wiggins ... | 1900, Div. Ct., W. N. 253; 1901, Q. B. 1 | 280 | Merchandise Marks Act | False description may be on invoice. |

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| Carter Medicine Co.'s Trade Mark | 1892, 9 R. P. C. 401 | 215 | Little Liver Pills | Foreign Marks registered under International arrangements must conform to British requirements. |
| Caruncho *v.* Highmoor | 1883, 27 Sol. J. 190 | 251 | Copyright | Defendant offered undertaking in terms of writ: injunction granted, but plaintiff ordered to pay part of defendant's costs. |
| Carver *v.* Pinto Leite | 1871, L. R. 7 Ch. 90 | 254 | Cotton mark | Discovery of names of customers. |
| Cash *v.* Cash | 1901, 18 R. P. C. 211 | 197, 265 | Trading name | Defendant using own name without fraud restrained from doing so in selling certain specified articles. |
| Cellular Clothing Co. *v.* Maxton | 1899, 16 R. P. C. 397 | 261 | "Cellular" clothing | New name for new unpatented article cannot be monopolised by first user and inventor. |
| Cheavin *v.* Walker | 1877, 5 Ch. D. 850 | 220 | Descriptive tablet on filters containing *inter alia* the words, "H. M. Royal Letters Patent" | Patent expired: plaintiff disentitled by unqualified reference to lapsed patent: defendant's belief to have merely stated principle of filter. |
| Chesebrough Manufacturing Co.'s Marks | 1901, 18 R. P. C. 191 | 262 | "Vaseline": for petroleum jelly | No injunction: original name of new patented article |
| Chivers *v.* Chivers & Co. | 1900, 17 R. P. C. 420 | 266 | Trading name for jellies | Held name had not become identified with plaintiff's goods only |
| Christie *v.* Cooper | 1900, Div. Ct. 2 Q. B. 522 | 279 | Merchandise Marks Act | Innocent retailer |
| Christy *v.* Murphy | 1893, 12 How. Pr. 77 | 271 | Trading name "Christy Minstrels" | Injunction against defendant. |
| Churton *v.* Douglas | 1859, Johns. 174 | 269 | Trading name | Defendant restrained from using his own business name assigned to plaintiffs. |
| Clark *v.* Sharp | 1898, 15 R. P. C. 111 | 263 | "Eiffel Tower" Lemonade | In cases of "get-up" the question is not whether Judge and jury might be deceived, but whether public might be so. |
| Clarke *v.* Hudson's Executors | 1901, 18 R. P. C. 310 | 249, 252 | "Cogent": for cycles | Injunction not granted against innocent infringer, if he offers all reparation he can |

| Name of Case. | Where Reported. | Pages in this Book. | Marks and Goods. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Colburn *v.* Simms | 1843, 2 Hare 543 | 251 | Copyright case | Defendants submitting at once in terms of writ may not be cast in costs, though injunction granted. |
| Coleman *v.* Brown | 1899, 16 R. P. C. 619 | 231, 246 | "Wincarnis": for meat extracts | "Wincarnis" differentiated from "Vincalis." |
| Colley *v.* Hart | 1888, 11 Ch. D. 179; 6 R. P. C. 17 | 256 | Label for toilet paper | No statutory action in restraint of threats by owner of a trade mark. |
| Colman *v.* Farrow | 1897, 15 R. P. C. 198 | 246 | "Bull's Head" label for mustard | Get-up of defendant's label held deceptive. |
| Colman's Marks | 1891, 8 R. P. C. 209 | 239 | "Bull's Head" label for mustard | Non-essential matter may be subsequently disclaimed, even in old marks. |
| Condy *v.* Mitchell | 1877, C. A. 37 L. T. N. S. 766 | 243 | "Sanitas": for disinfectants | Where partners separate and divide assets, each may use partnership mark. |
| Coppen *v.* Moore | 1898, Div. Ct., 2 Q. B. 300 | 280 | Merchandise Marks Act | False description may be on invoice. |
| Coulson *v.* Coulson | 1887, 3 T. L. R. 740 | 256 | Label | Trade libel or slander action in connection with trade mark. |
| Cowie *v.* Herbert | 1897, 14 R. P. C. 436 | 240 | Picture label for biscuits | Scotch Courts claim jurisdiction to rectify Register of Trade Marks. |
| Croft *v.* Day | 1843, 7 Beav. 84 | 273 | "Day and Martin's" blacking | Injunction against fraudulent association to produce trading name of plaintiffs. |
| Curtis *v.* Pape | 1888, 5 R. P. C. 146 | 246 | "Diamond and K": for gunpowder | Use of diamond alone restrained. |
| DAIMLER Motor Car Co. *v.* British Motor Traction Co. | 1901, 18 R. P. C. 465 | 267, 271, 272 | Trading name | Held that "Daimler" meant a principle of construction. No injunction. |

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| Dale *v.* Smith ... ... | 1882, W. N. 145 | 255 | Copyright | No interlocutory injunction if defendant undertakes to discontinue. |
| Dausman *v.* Ruffner ... | 15 *U. S. Patents Gazette* 559 | 199 | Lines for subdivision of article | No trade mark in such subdividing lines. |
| Davis, *Re* ... ... | 1897, 14 R. P. C. 903 | 235 | "Compactum": for umbrellas | Mark held descriptive. |
| Dewar *v.* Dewar ... | 1900, 17 R. P. C. 311 | 235, 265 | "Dewar's Whisky" | Held plaintiffs had no exclusive right to name. |
| EASTMAN Photographic Co.'s Application | 1898, 15 R. P. C. 476 | 202 | "Solio": for photo paper | Held invented word suitable for registration: invented words may refer to character of goods: may be traced to foreign source. |
| Eastman Photographic Materials Co. *v.* Griffiths Cycle Corporation | 1898, 15 R. P. C. 105 | 232, 236 | "Kodak" for cameras | Held not registrable for cycles by other traders. |
| Edge, *Re* ... ... | 1891, 8 R. P. C. 207 | 235, 236 | "Edge's Filtered Blue" | Not a distinctive mark. |
| Edwards *v.* Dennis ... | 1885, 30 Ch. D. 454 | 214, 222, 235, 236, 241 | "Neptune" and device for galvanised iron | Mark must be registered only in respect of goods traded or intended to be traded in. |
| Edwards *v.* Elkan ... | 1888, 5 R. P. C. 70 | 253 | "Our Boys": for watches | Application for interlocutory injunction adjourned to enable defendant to apply to rectify Register. |
| Eno *v.* Dunn ... ... | 1890, 7 R. P. C. 311 | 231 | "Eno's Fruit Salt": for medicine | Dunn's Fruit Salt Baking Powder held to infringe. |
| Ermen and Roby's Mark | 1897, 4 R. P. C. 70 | 238 | "Lion" label for thread | Clerical error in Russian name rectified on Register. |
| Escourt *v.* Escourt Hop Essence Co. | 1875, L. R. 10 Ch. 276 | 261 | "Escourt's Hop Bitters" | Breach of trust in imparting secret of manufacture of goods. |
| FABER *v.* Faber ... | 1867, 49 Barb. 357 | 197 | "A. W. Faber": for pencils | Injunction refused: a man has a right to use his own name without fraud. |

| Name of Case. | Where Reported. | Pages in this Book. | Marks and Goods. | Chief Points affected by Decision, and *obiter dicta*. |
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| Farbenfabriken Application | 1891, 1 Ch. 645; 11 R. P. C. 81 | 201 | "Somatose": for foods | Held descriptive. Registration refused. |
| Farina *v.* Silverlock ... | 1858, 1 K. & J. 509; 21 L. J. Ch. 632 | 217 | "Label" for eau de Cologne | It may be lawful to print labels to replace genuine labels on genuine goods. |
| Faulder's Trade Mark, *Re* | 1901, 18 R. P. C. 535; W. N. [1901] 235 | 209 | Firm signature and "Silverpan": for jams | Motion to expunge: "Silverpan" held distinctive word within the meaning of Section 71: mark expunged on ground of non-disclaimer. |
| Fennessy *v.* Day & Martin | 1886, 55 L. T. 161 | 252 | Blacking label | Defendant threatened with action should offer undertaking in terms of writ, or such terms as plaintiff is entitled to obtain. |
| Field *v.* Wagel .. .. | 1899, 17 R. P. C. 266 | 203, 231, 263 | "Savonol:" for soap | "Savoline" held to infringe. |
| Foot *v.* Lea .. .. | 13 Ir. Eq. 481 | 270 | Trading name | Fraudulent use is a question of law and evidence. |
| GIANACLIS, *Re* .. | 1889, 6 R. P. C. 467 | 235 | "Gianaclis Cigarettes" | Held not distinctive. |
| Goodall's Trade Mark .. | 1889, L. R. 42 Ch. D. 565 | 213 | "Parchment Bank" paper | Statement and disclaimer must be contained in application: this defect cannot be cured when referred to Court. |
| Goodwin *v.* Ivory Soap Co. | 1900, 17 R. P. C. 689 | 205, 231 | "Ivy" Soap | Held that "Ivy" and "Ivory" might confuse: but injunction refused as proprietorship in "Ivy" not sufficiently established. |
| Great Tower Tea Co. *v.* Smith | 1889, 6 R. P. C. 165 | 235, 255 | "Tower Tea" | Mark expunged as in common use: no proof of fraudulent use by defendants: costs on higher scale. |

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| *Grossmith, Re* .. .. | 1889, 60 L. T. N. S. 612 | 228 | "Emollio": for face cream | Held abandoned by disuse for eleven years. |
| Guinea Coal Co. v. Pall Mall Guinea Coal Co. (Lee v. Haley) | 1869, L. R. 5 Ch. 155 | 272 | Trading name | Injunction refused. |
| Guinness & Co.'s Trade Mark | 1888, 5 R. P. C. 316 | 239 | "Guinness": label for stout | Leave given to add "Limited" to name. |
| HAINES' Trade Mark... | 1888, 5 R. P. C. 669 | 231 | Figure of dog, with "Staunch": for hardware | Held different from pig with initials. |
| Hall v. Barrows | 1863, 4 De G. J. & S. 150 | 212 | "B. B. H.," with crown: for iron | New proprietor may use assigned trade mark with old name and initials if old business in fact carried on under mark. |
| Hanson v. Game Harrison | 1892, 9 R. P. C. 186 | 213 | Series of trade marks for groceries | Former partner in dissolved partnership has no right to permit use of partnership marks by limited company of which he becomes director. |
| Harness's Trade Mark .. | 1899, 17 R. P. C. 40 | 236 | Tree, with "Koptica": for medical preparation | Register rectified by expunging respondent's name; application in same motion for substituting applicant's name for respondent's, dismissed and no costs given on account of this inclusion. |
| Harrison & Crossfield, *Re* | 1900, 18 R. P. C. 34 | 201 | "Nectar": for tea | Registration refused: selected word referring to quality of goods. |
| Hayward, *Re* ... ... | 1885, 54 L. J. Ch. 1063 | 234 | "Coker" canvas | Mark expunged: wrongly registered as old mark. |
| Hayward & Son's Marks | 1896, 13 R. P. C. 729 | 238 | "Coker" mats and canvas | Leave given to add "Limited" to name in marks. |
| Hedley's Marks .. .. | 1900, 17 R. P. C. 719 | 205 | "Red Cap": for soap | Held "Night Cap" not calculated to deceive or confuse. |
| Hendriks v. Montagne .. | 1880, 17 Ch. D. 638 | 269, 271 | Trading name | An unregistered company may prevent registration under Companies Act of a subsequent limited company in same name. |

| Name of Case. | Where Reported. | Pages in this Book. | Marks and Goods. | Chief Points affected by Decision, and *obiter dicta*. |
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| Henry Clay's Trade Mark | 1892, 9 R. P. C. 449 | 239 | "La Paz" &c. in an oval: for cigars | Only absolutely necessary alterations will be allowed in old marks. |
| Hill, *Re* | 1893, 10 R. P. C. 113 | 236 | "Forrest, London": for watches | Mark expunged: respondent, who had not succeeded to Forrest's business, held to be making fraudulent use of the name. |
| Holby *v.* Grosvenor Library, Limited | 1880, 28 W. R. 386 | 272 | Trading name | Plaintiff trading as "The Grosvenor Library" was granted an injunction. |
| Holbrook's Marks | 1901, 18 R. P. C. 117 | 238 | "Labels" for sauce | Addition allowed of "Limited" to name on labels. |
| Holloway *v.* Holloway | 1850, 13 Beav. 209 | 198, 269 | "Holloway's Pills" | Plaintiff's brother restrained from using his name so as to deceive the public. |
| Holt & Co.'s Trade Mark | 1896, 13 R. P. C. 118 | 105, 204 | "Trilby": for aprons | Mark upheld as selected fictitious name. |
| Hubbock *v.* Brown .. | 1900, 17 R. P. C. 638 | 220 | Stencilled brand: for white zinc | Word "Patent" in brand: no patent ever granted: use of word patent held as misrepresentation. |
| Hudson's Mark, *Re* .. | 1886, 3 R. P. C. 155 | 230 | Device of "Dolly" and hand: for soap powder | Plaintiffs debarred from relief: use not a condition precedent to registration: disclaimer of added matter. |
| Hudson *v.* Osborne ... | 1870, 39 L. J. Ch. 79 | 270 | Trade name of premises | Bankrupt vendor of goodwill through his trustee cannot use name sold to purchasers. |
| Hughes and Young, *Re* | 1893, 10 R. P. C. 369 | 212, 214, 230, 232, 235 | Device of "Anchor": for umbrellas | Old mark: expunged from Register as being common to trade. |

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| Humphries *v.* Taylor | 1888, 59 L. J. 820 | 236 | Slip with word "Herbalin": for beer | "Herbalin" common to trade: *successful defendant deprived of* costs, having made allegations he failed to prove. |
| Hyde, *Re* | 1878, 7 Ch. D. 724 | 235 | "Bank of England" sealing wax | Old mark: common to trade: expunged. |
| ISAACSON *v.* Thompson | 1871, 11 L. J. Ch. 101 | 249, 252, 271 | Trading name: "Madame Louise" | Injunction refused on ground of ten months' delay by plaintiff. |
| JAMES' Trade Mark, *Re* | 1886, 33 Ch. D. 392; 3 R. P. C. 310 | 218 | Device of black-lead block in shape of dome | Representation of goods in arbitrarily chosen shape does not invalidate registration. |
| Jamieson *v.* Jamieson | 1898, 15 R. P. C. 169 | 197 | Trading name | Use by person of same name: no man is bound to use extra precautions to distinguish his goods, if confusion likely to arise solely from similarity of names. |
| Jay *v.* Ladler | 1889, 6 R. P. C. 136 | 247 | "Bear" device: for furs | Advertisement of mark is infringement. |
| Jenkins *v.* Hope | 1895, 13 R. P. C. 57 | 251 | Patent case | Innocent infringers offering submission in terms of writ may escape both injunction and costs. |
| Jones's Trade Mark | 1885, 53 L. T. N. S. 1 | 243 | Figure of "Britannia": for cotton goods | Mark used in joint adventure: when adventure terminates, neither party has right to use. |
| Jones *v.* Hallworth | 1897, 14 R. P. C. 225 | 263 | "Solvyt": for dusters | General resemblance: injunction against passing off. |
| KIRSHENBOIM *v.* Salmon & Gluckstein | 1898, Div. Ct. 2 Q. B. 19 | 279 | Merchandise Marks Act | Defendants convicted for selling machine made cigarettes as "hand made." |
| LANGLEY *v.* Bombay Tea Co. | 1900, Div. Ct. W. N. 111; 1900, 2 Q. B. 160 | 280 | Merchandise Marks Act | Salesman handing light half pound packets of tea over counter in response to demand does not constitute "application" of false trade description to goods. |

| Name of Case. | Where Reported. | Pages in this Book. | Marks and Goods. | Chief Points affected by Decision, and *obiter dicta*. |
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| Lawrence & Co., *Ex parte* | 1878, 11 L. T. N. S. 98 *note* | 235 | Device, with word "Durable": for printers' rollers | Fraudulent registration by manager. Mark expunged. |
| Lazenby *v.* White .. | 1870, 11 L. J. Ch. 351; L. R. 6 Ch. 89 | 255, 266 | "Harvey's Sauce" | Name common to trade, but injunction granted to prevent sale as the "Original Harvey's Sauce." |
| Leaf's Application ... | 1887, 4 R. P. C. 30 | 200 | "Electric": for velveteens | Held to be descriptive. |
| Leahy *v.* Glover .. ... | 1893, 10 R. P. C. 141 | 191, 251 | "Two D." cigar | Generally no injunction granted in respect of isolated, inadvertent, and discontinued infringement. |
| Leather Cloth Co. *v.* American Leather Cloth Co. | 1863-5, 4 De G. J. & S. 137; 33 L. J. Ch. 199 | 248 | "Stamp" on leather | Mark containing word "Patent": no patent: plaintiffs barred by misrepresentation: Lord Westbury on infringement. |
| Leather Cloth Co. *v.* Hirschfeld | 1863, 1 H. & M. 295 | 254 | "Stamp" on leather | Discovery of customers. |
| Lee *v.* Haley ... ... | 1869, L. R. 5 Ch. 155 | 272 | Trading name | "Pall Mall Guinea Coal Co.": no infringement of "Guinea Coal Co." |
| Lever *v.* Bedingfield ... | 1898, 16 R. P. C. 3 | 261 | "Sunlight": for soap | Label having partly similar arrangement, but no mention of "Sunlight," held not to infringe. |
| Liebig's Extract Co. *v.* Chemists' Co-operative Society | 1896, 13 R. P. C. 736 | 261 | "Label": for meat extract | Defendants' label held to be deceptive: delay of three years by plaintiffs did not prejudice their case. |
| Linoleum Co. *v.* Nairn .. | 1878, 7 Ch. D. 834 | 262 | "Linoleum": for linoleum | New name of patented new product cannot be used to prolong monopoly of patent. |
| Linotype Co.'s Application | 1900, 17 R. P. C. 380 | 203, 230 | "Tachytype": for type composing machines | Accepted as invented word: absolute novelty in word not essential. |

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| London Assurance *v.* London & Westminster Assurance Corporation | 1863, 32 L. J. Ch. 664 | 272 | Trading name | Injunction refused: names not deceptively similar. |
| London Omnibus Co. *v.* Lavell | 1899, 18 R. P. C. 74 | 268, 270 | Colour and "get-up" of omnibus | Judge not to substitute personal view for evidence of deception. |
| Lyndon's Trade Mark | 1886, 3 R. P. C. 102; 32 Ch. D. 109 | 231 | Helmeted female head, for cutlery | Differentiated from armed man's head. |
| MacSYMON *v.* Shuttleworth | 1897, 15 R. P. C. 748 | 228 | Baking powder label | Penalty inflicted for putting "Registered" on mark which was only so in U.S.A. |
| McAndrew *v.* Bassett ... | 1864, 10 L. T. 65 | 252 | "Anatolia": for liquorice | Defendants to escape injunction and costs must offer submission in terms of writ. |
| Magnolia Metal Co.'s trade mark | 1897, 14 R. P. C. 621 | 206 | "Magnolia": for metal | Court of Appeal on "Geographical" names. |
| Manchester Brewery Co. *v.* North Cheshire and Manchester Co. | 1898, 1 Ch. 539; 1899, App. Cas. 83 | 270, 272 | Trading name | Use of name suggesting amalgamation with plaintiffs' firm not allowed. |
| Maréchal *v.* M'Colgan ... | 1901, 18 R. P. C. 262 | 234 | "G. B. D." in oval | "J. B. D." in oval held to infringe. |
| Meaby *v.* Triticine, Limited | 1897, 15 R. P. C. 1 | 203, 231, 235 | "Triticumina": for meal | Held descriptive. |
| Means' application ... | 1891, L. R. 1 Ch. D. 41: 8 R. C. P. 25 | 213 | "Device" and signature for spirits | Disclaimer must be made in application. |
| Mellin *v.* White ... ... | 1895, App. Cas. 154 | 256 | Infants' food | Self puffing is not libel on rival traders' goods. |
| Merchant Banking Co. of London *v.* Merchant Joint Stock Bank | 1878, 9 Ch. D. 560 | 272 | Trading name | Injunction refused: names not too similar. |
| Meyerstein's Application | 1890, 7 R. P. C. 111 | 201 | "Satinine": for starch | Refused as descriptive. |
| Millington *v.* Fox ... | 1834, 3 M. & Cr. 338 | 192, 251 | "Brand": for iron | Timely submission and favourable offer by innocent infringers may save them from costs. |
| Milner *v.* Reed ... ... | 1870, Sebas. Dig. 328 | 271 | Trading name | "Oldfield Lane Doctor": defendant restrained from using name. |

| Name of Case. | Where Reported. | Pages in this Book. | Marks and Goods. | Chief Points affected by Decision, and *obiter dicta*. |
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| Montague *v.* Moore | 1865, Seton, 5th Ed. 539 | 271 | Trading name | Defendant restrained from using "Christy Minstrels." |
| Montgomery *v.* Thomson | 1891, S. R. P. C. 361 | 259 | "Stone Ale": for beer | Common Law mark: defendant restrained. |
| Morgan *v.* McAdam | 1866, 36 L. J. Ch. 228 | 220 | "Patent Plumbago Crucibles" | Misrepresentation: no patent. Action dismissed. |
| Monson *v.* Bochm | 1884, 26 Ch. D. 398 | 228, 229 | Kangaroo device and word "Colonial": for soap | Abandonment: intention to abandon must be shown: defendant allowed to register as well as plaintiff: prior publication and user by another does not invalidate registration. |
| NÄHMASCHINEN Fabrik *v.* Singer | 1893, 10 R. P. C. 310 | 256 | Trade name "Singer" | Warning advertisement by defendants: held no libel on plaintiffs. Action dismissed. |
| National Biscuit Co.'s Application | 1901, 18 R. P. C. 170; 1901, 1 Ch. 550 | 263 | "Uneeda": for biscuits | Not an invented word. Mark refused. |
| New Ormonde Cycle Co.'s Mark | 1896, 13 R. P. C. 175 | 238 | "Ormonde Bicycle" | Change of *proprietor's name*: alteration on Register by Comptroller under Section 87 without Order of Court. |
| ORR-EWING *v.* Johnston | 1882, 7 App. Cas. 219 | 216, 217 | "Elephant": label for cotton goods | Defendants restrained from using "Elephant" at all. |
| PAINE *v.* Daniels | 1892, 10 R. P. C. 217; 2 Ch. 567 | 218 | "John Bull": for beer | Common Law right: actual deception need not be proved if defendant's mark is deceptive. |
| Palmer, *Re* | 1883, 24 Ch. D. 504 | 230, 234, 235 | "Braided Fixed Stars" | Held descriptive. |

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| Panhard *v.* Panhard | 1901, W. N. 153 | 273 | Trading name | A foreign company will be protected from assumption of its name in this country. |
| Payton *v.* Snelling | 1899, 17 R. P. C. 48 | 261 | "Red, White, and Blue" coffee tins | An unregistered "get-up" does not create an immediate monopoly: some prescriptive right must be shown. |
| Phillips' Trade Marks | 1891, 8 R. P. C. 469 | 239 | "Labels" for soap | Old marks: application to strike "Trade Mark" from labels refused. |
| Pinet *v.* Pinet ... ... | 1897, 15 R. P. C. 65 | 197, 270, 271 | Trading name | Fraudulent assumption of name restrained. |
| Pinto *v.* Badman | 1891, 8 R. P. C. 181 | 242, 253 | "El Destino" cigars | Register cannot be rectified on counter-claim. |
| Pirie *v.* Goodall ... ... | 1892, 1 Ch. 35 | 235 | "Pirie's Parchment Bank": for paper | Expunged as not distinctive. |
| Player & Son's Application | 1900, 18 R. P. C. 65 | 213 | "Sailor's Head": label for tobacco | Amendment to meet objection first raised in Court cannot be accepted: trivial alteration will not entitle to further registration or certificate for foreign requirements. |
| Pneumatic Tyre Co. *v.* Chisholm | 1895, 13 R. P. C. 488 | 255 | Patent Case | Certificate of validity in former action should be pleaded in subsequent actions. |
| Pomril's (Limited) Application | 1901, 18 R. P. C. 181 | 233 | "Pomril" on half apple: for cider | Held similar to whole apple with words "Apple Brand." |
| Powell, *Re* | 1891, App. Cas. 8 | 232 | "Yorkshire Relish" | Mark expunged: user as old mark not proved. |
| Powell *v.* Birmingham Brewery | 1897, A. C. 710; 66 L. J. Ch. 763; 14 R. P. C. 720 | 260 | "Yorkshire Relish" | Common Law mark: passing off: held defendants could not use name "Yorkshire Relish" till they had discovered exact secret of plaintiff's composition. |
| RADDE *v.* Norman | 1872, L. R. 14 Eq. 348 | 191 | "Kainit": for rock-salt | Held plaintiff having sole access to this particular natural product, was entitled to exclusive use of name. |

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| Ralli *v.* Fleming | Ind. L. R. 3 Calc. 117 | 193, 194 | "Heading": for cotton goods | Middleman entitled to trade mark. |
| Ralph, *Re* | 1883, 25 Ch. D. 194 | 228, 229, 232, 235 | "Home Washer": for washing machine | Non-user for twenty-one months held to be abandonment. |
| Ransome *v.* Graham | 1882, 51 L. J. Ch. 397 | 193, 220 | "Patent" and combinations of letters: for ploughs | "Patent" may be stamped on goods after expiry: but better to give date. |
| Read *v.* Richardson | 1881, 45 L. T. N. S. 51 | 216 | "Dog's Head" beer | Defendants restrained from using name or device of dog's head. |
| Reddaway *v.* Banham | 1896, A. C. 199; 13 R. P. C. 218 | 258 | "Camel": for woven belting | Common Law mark: defendants restrained. |
| Reddaway *v.* Bentham | 1892, 9 R. P. C. 503 | 258 | "Camel": for woven belting | Common Law mark: defendants restrained. |
| Reg. *v.* Ellinger | 1893, Manchester Guardian | 278 | "Rupee": mark for cotton piece goods | Defendants convicted of fraudulent imitation. |
| Reg. *v.* Hughes | 1893, Daily Chronicle, 24th October | 278 | Epps' cocoa label | Fraudulent printing and false application. |
| Reinhardt *v.* Spalding | 1879, 49 L. J. Ch. 57 | 251 | "Family salve" | Defendant's prior registration in Stationer's Hall of no effect as against plaintiff's subsequent registration in Trade Marks Register. |
| Reiss' Trade Mark, *Re* | 1888, 5 R. P. C. 291 | 238 | Device of garter with "Grass Bleach – Best Quality" | Ordered that name "Reiss" be inserted instead of "grass." |
| Ripley's Application | 1898, 15 R. P. C. 151 | 203 | "Pirle": for finished goods | Held the synonym of "Pearl" and to be descriptive. Mark refused. |
| Rivière, *Re* | 1881, 26 Ch. D. 48 | 232 | "Label" for spirits | Motion to expunge and substitute applicant's name, dismissed. Substitution in motion to expunge never entertained: person aggrieved. |

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| Rodgers *v.* Rottgen | 1888, 5 T. L. R. 678 | 245 | "Rodgers" with star and cross | "Rottgen" with two crosses held to infringe. |
| Rose *v.* Evans | 1879, 48 L. J. Ch. 618 | 232 | "Linetta": for lime juice | Mark expunged on motion by plaintiff: mark previously used by plaintiff and common to trade: person aggrieved. |
| Rose *v.* Loftus | 1878, 47 L. J. Ch. 576 | 247 | Name and mark moulded on lime juice bottles | Defendant restrained from using plaintiff's old bottles, even with defendant's label applied. |
| Rowland *v.* Michell | 1897, 14 R. P. C. 37; 1897, 1 Ch. 71 | 199, 261 | Label with portrait: for confectionery | Defendant restrained from using similarly arranged label with different matter and different portrait. |
| Royal Baking Powder Co., *Re* | 1899, 14 R. P. C. 425 | 235 | "Royal Baking Powder" | Marks improperly registered by American Company as old marks: service of notice of motion by registered letter: non-appearance of company: marks expunged. |
| Royal Baking Powder Co. *v.* Wright, Crossley & Co. | 1900, 18 R. P. C. 95 | 256 | "Royal Baking Powder" | Trade libel: malice: damage: held that circular by defendants should be restrained. |
| Rutter *v.* Smith | 1900, 18 R. P. C. 19 | 251, 254 | "Mitcham": for tobacco | One small sale only by defendant's manager: action characterised as trivial and dismissed with costs. |
| SANITAS CO. *v.* Condy | 1887, 4 R. P. C. 195, 530 | 246 | Tree and motto "Sanitas &c." | Defendants restrained from using "Sanitas" either alone or in compound words. |
| Savin's Trade Mark | 1895, 13 R. P. C. 21 | 239 | Device containing Russian and English names | Alteration substituting Russian name for English refused. |
| Seixo *v.* Provezende | 1866, L. R. 1 Ch. 192 | 246 | Crown brand and "Seixo" on wine casks | Physical resemblance of two marks not the only consideration: anything causing one to be mistaken for the other is an infringement. |

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| Sen-Sen Co. *v.* Britten | 1889, 16 R. P. C. 137 | 228 | "Sen-Sen": for confections | To print "trade mark" on the mark does not represent that it is registered. |
| Shipwright *v.* Clements | 1871, 19 W. R. 589 | 211 | "Zingari Bouquet" | Sale of interest in partnership to remaining partner includes interest in partnership trade marks. |
| Siegert *v.* Findlater | 1878, 7 Ch. D. 801 | 260 | "Angostura Bitters" | Defendant restrained from calling his goods "Angostura Bitters" until he had discovered the exact secret of manufacture. |
| Singer Manufacturing *v.* Loog | 1882, 18 Ch. D. 395; 8 App. Cas. 15 | 257 | "Singer," name trade mark: for sewing machines | Although where name describes principle it may be used to do so, care must be taken to show that the goods are not of plaintiff's manufacture. |
| Singer *v.* Spence | 1893, 10 R. P. C. 297 | 258, 267 | "Singer," name trade mark: for sewing machines | Although where name describes principle it may be used to do so, care must be taken to show that the goods are not of plaintiff's manufacture. |
| Singer *v.* Wilson | 1875-7, 2 Ch. D. 434; 3 App. Cas. 376 | 248, 266 | "Singer," name trade mark: for sewing machines | Not necessary to prove fraud in infringement of trade mark. |
| Slazenger *v.* Feltham | 1889, 6 R. P. C. 531 | 231 | "Demon" Racquets | "Demotic" held to infringe. |
| Slazenger *v.* Pigott | 1895, 12 R. P. C. 130 | 252 | "Demon" Racquets | Small sale by defendant's manager: description on invoice: apology by defendant and offer to submit to order in chambers in terms of writ: on motion, injunction granted, but costs restricted to those of order in chambers. |

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| Smith *v.* Carron Co. | 1896, 13 R. P. C. 108 | 203 | "Trafford" *et al.*: for stoves | "Stafford" held to infringe. |
| Smokeless Powder Co's Mark | 1892, 9 R. P. C. 109 | 208 | "Target" device with figures of sportsman and soldier | Section 71: "Smokeless Powder" held not "distinctive" and not subject to disclaimer. |
| Southern *v.* How (*Comp.* Eliz.) | Popham 144 | 192 | Cloth mark | Damages given for piracy. |
| Spratt's Patent *v.* Ward & Co. | 1879, 11 Ch. D. 240 | 249 | "Fibrine Dog Cakes" | Trial by jury refused. |
| Steinway *v.* Henshaw | 1888, 5 R. P. C. 77 | 231, 246 | "Steinway": for pianos | "Steinberg" held to infringe. |
| Stephens, *ex parte* | 1876, 3 Ch. D. 659 | 199 | "Acilyton": for inks | Trade Marks Act, 1875: mere combination of letters adopted since Act not a device within the statute. |
| Stock Owners of New South Wales, *Re* | 1897, 14 R. P. C. 733 | 235 | "Garter" enclosing figures: for meat | Alteration of proprietor's name on mark allowed. |
| Sykes, *Re* | 1880, 43 L. T. N. S. 626 | 193 | Shield, swan, and letters: for cotton goods | Bleacher's mark as distinguished from maker's mark. |
| Sykes *v.* Sykes | 1824, 3 B. & Cr. 541 | 192, 218 | "Sykes' Patent": for powder flasks | Knowledge of first buyer does not obviate danger of ultimate deception on resale. |
| TALBOT'S Trade Mark | 1894, 11 R. P. C. 77 | 231, 235, 236 | "Molliscorium": for harness | "Emolliolorum" held not to infringe: but expunged as being descriptive. |
| Taylor *v.* Taylor | 1854, 23 L. J. Ch. 255 | 215 | "Taylors' Persian Thread" | Resemblance having no apparent reason will be held to be for purpose of misleading. |
| Thewlis and Blakey's Mark | 1893, 10 R. P. C. 369 | 212, 240 | "Ancross": for umbrellas | Held to be mere word imitation of old common device mark of "Anchor." |
| Thompson *v.* Montgomery (*see Montgomery v. Thompson*) | 1891, 8 R. P. C. 361 | 235 | Stone ale | "Stone Ale" struck off: no evidence of user alone as old mark before 5th August, 1875. |
| Thorley's Cattle Food Co. *v.* Massam | 1880, 14 Ch. D. 763 | 256 | Thorley's food for cattle | Defendant restrained from issuing circulars containing untrue statements calculated to injure plaintiffs in their business. |

| Name of Case. | Where Reported. | Pages in this Book. | Marks and Goods. | Chief Points in Decision, and *obiter dicta*. |
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| Tussaud *v.* Tussaud | 1890, 44 Ch. D. 678 | 272 | Trading name | A man may do business in his own name though another business of same name exists: but cannot empower a limited company to use the name unless he has an established business and goodwill to sell to the company. |
| Turton *v.* Turton | 1888, L. R. 42 Ch. D. 128 | 197, 261 | Trading name | A man may use his own name in business although it may cause confusion with the name of another old-established business. |
| Trade Mark of Clement & Cie., *Re* | 1889, 16 R. P. C. 611 | 269 | Label with "St. Raphael": for liqueurs | Section 71: "St. Raphael" held part of the mark and not subject to disclaimer. |
| UPMANN *v.* Elkan | 1871, L. R. 12 Eq. 140 | 251, 254 | Cigar label | Innocent infringer: full submission before writ: injunction granted but no costs. |
| Upmann *v.* Forester | 1883, 24 Ch. D. 231 | 218, 219 | Cigar label | Importer: spurious label: 5000 cigars: alleged private consumption: injunction: costs. |
| VALENTINE Meat Juice Co. *v.* Valentine Meat Extract Co. | 1900, 17 R. P. C. 673 | 197, 265, 272 | "Valentine's Meat Extract" | Defendants restrained from using name "Valentine" in any form: right of person of same name to transfer his name to company, defined. |
| Van Duzer, *Re* | 1887, 4 R. P. C. 30; 34 Ch. D. 623 | 200, 206 | "Melrose Hair Restorer" | Held geographical and deceptive. |
| WHEELER & Wilson *v.* Shakespeare | 1869, 39 L. J. Ch. 36 | 266 | Trading name | "Wheeler & Wilson" held to denote a principle of construction in sewing machines and open to public use. |

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| Whitstable Oyster Co. *v.* Hayling Oyster Co. | 1901, 18 R. P. C. 131 | 263 | "Whitstable Oysters" | Defendants held entitled to describe their oysters as "Whitstable," their beds being in Whitstable district. |
| Williams *v.* Williams .. | 1817, 3 Mer. 157 | 261 | Secret of manufacture | A person in confidential relationship restrained from divulging secret of manufacture obtained while in such relationship. |
| Wills's Trade Mark | 1892, 9 R. P. C. 346; 10 R. P. C. 260; 3 Ch. 201 | 240, 251 | "Star"; for tobacco | Label "Star of Hope" calculated to deceive. |
| Winser *v.* Armstrong . | 1899, 16 R. P. C. 167 | 267 | "Winser Interceptors" | Expired design; words held to denote principle of construction, and open to public. |
| Wood *v.* Butler | 1886, 32 Ch. D. 247; 3 R. P. C. 81; 55 L. J. Ch. 377 | 232, 236, 243 | "Eton Cigarettes" | Mark expunged; plaintiff had placed "Eton" on goods of other manufacturers; mark held to have ceased to be distinctive of owner's own manufacture or goods. |
| Worthington's Trade Mark | 1880, 14 Ch. D. 8; 19 L. J. Ch. 646 | 231 | Triangular frame enclosing church; for beer | Held similar to red triangle of Bass; colour not considered in registration. |
| Wotherspoon *v.* Currie | 1872, L. R. 5 H. L. 508 | 259, 263 | "Glenfield Starch" | "Glenfield" held by long user to have become indicative of plaintiff's manufacture. |
| Wragg, *Re* | 1885, 29 Ch. D. 551 | 230, 232, 235 | Syphon, glass and hand; for aërated waters | Old mark; expunged; common to trade. |
| Wright and Crossley's Mark | 1898, 15 R. P. C. 377 | 232 | "Wright, Crossley & Co."; for baking powder | Old mark; application by R. B. P. Co. of New York to expunge; held that applicants were not "persons aggrieved"; motion and appeal dismissed. |
| Wright and Crossley's application | 1900, 17 R. P. C. 386 | 213 | "Lion" label of distinctive design; words and names incorporated | Application refused in its then condition; the provision as to disclaimer of added matter in Section 71, Subsection 2, not having been complied with in the application form. |

## PART III.—DESIGNS.

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Design. | Chief Points in Decision, and *obiter dicta*. |
|---|---|---|---|---|
| ADAMS *v.* Clementson | 1879, 12 Ch. D. 714 | 302, 303 | Portrait on hardware | Old decision: held not fit subject-matter (see *Saunders and Weld*). |
| BACH'S Design, *Re* | 1889, 6 R. P. C. 376 | 304, 308 | Vitreous lamp shade | Held bad: analogous to old shade of same design in linen. |
| Batley *v.* Kynoch | 1874-5, L. R. 20 Eq. 632 | 321 | Patent Case | Affidavit required to show that inspection is necessary. |
| Bayer *v.* Connell | 1897, 14 R. P. C. 275 | 327 | Trade Mark Case | Jurisdiction of Irish Courts in rectification of Register. |
| Birkin *v.* Pratt | 1895, 12 R. P. C. 371 | 326 | Lace design | Distribution of costs in different issues. |
| Blank *v.* Footmann | 1888, 5 R. P. C. 653 | 307, 310, 326 | Lace design | Prior publication by taking orders from sample before registration. |
| CHEETHAM *v.* Oldham | 1888, 5 R. P. C. 617 | 321 | Patent Case | Roving inspection never ordered. |
| Clarke's Design | 1896, 13 R. P. C. 351 | 304, 306, 307 | Shape of electric lamp | Held bad: analogous in shape to old oil and gas lamps. |
| Cooper *v.* Symington | 1893, 10 R. P. C. 261 | 298, 299 | Corset front | No new appearance: hooked corset having old laced-up appearance. |
| Cowie *v.* Herbert | 1897, 14 R. P. C. 136 | 327 | Trade Mark Case | Jurisdiction of Scottish Courts in rectification of Register. |
| DRAKE *v.* Muntz Metal Co. | 1886, 3 R. P. C. 13 | 323 | Patent Case | Order for inspection may be given plaintiff before delivery of Statement of Claim. |
| EDISON Telephone Co. *v.* India Rubber Co. | 1881, L. R. 17 Ch. D. 137 | 323 | Patent Case | Form of order and conditions on amendment of particulars. |

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|---|---|---|---|---|
| FIELDING *v.* Hawley | 1883, 18 L. T. N. S. 630 | 313 | Butter dish. | Marking: where complete article is composed of two parts fitting together, marking one part will suffice. |
| GERM Milling Co. *v.* Robinson | 1884, 1 R. P. C. 217 | 324 | Patent Case | Mere suspicion will not justify order for inspection. |
| Grafton *v.* Watson | 1884, 51 L. T. N. S. 141 | 316 | Calico prints | "Obvious" and "fraudulent" imitation. |
| Grocott's Design | 1899, 17 R. P. C. 139 | 294, 329 | Not reported | Substitution of rightful for wrongful owner on rectification of Register. |
| Guiterman's Design | 1886, 55 L. J. Ch. 309 | 294 | Toys | Mere agent for sale of articles made by author or manufacturer, cannot be registered as proprietor. |
| HARPER & Co *v.* Wright & Butler | 1895, 12 R. P. C. 183 | 301, 312, 315, 316 | Stove | Defendants' infringement held "obvious" imitation. |
| Harrison *v.* Taylor | 1859, 29 L. J. Ex. 3; 1 H. and N. 815 | 300 | Honeycomb fabric | Combination of two old designs held good. |
| Hecla Foundry Co. *v.* Walker | 1889, 6 R. P. C. 551 | 283, 297 | Kitchen range fire door | Utility not to be considered: the eye to be the judge of infringement. |
| Heinrich's Design | 1891, 9 R. P. C. 73 | 295, 329 | Writing table | Person claiming to be true author must submit proof of claim: if substantiated, claimant's name may be substituted on Register. |
| Heinrichs *v.* Bastendorff | 1893, 10 R. P. C. 160 | 307, 310 | Writing table | Prior publication: confidential exhibition to customer no publication. |
| Hoffmann *v.* Postill | 1869, L. R. 4 Ch. 673 | 325 | Patent Case | Rule in discovery as affecting plaintiff and defendant respectively. |
| Holdsworth *v.* McCrea | 1867, L. R. 2 H. L. 380 | 315 | Ornamental woven fabrics | Substantial imitation of a design is infringement. |
| Holliday *v.* Heppenstall | 1889, 6 R. P. C. 320 | 322 | Patent Case | Particulars of common knowledge never ordered. |
| Hothersall *v.* Moore | 1891, 9 R. P. C. 27 | 300, 309, 310, 315 | Dusters | Mere combination of two old features *not involving ingenuity is not* subject-matter for design. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject matter of Design. | Chief Points in Decision, and other facts. |
|---|---|---|---|---|
| Hurt *v.* Stevens | 1878, W. N. 79 | 308 | Gas chandelier | Design shown by travellers to customers to obtain orders before registration, is prior publication. |
| JAN *v.* Grossman | 1895, 12 R. P. C. 337 | 318, 326 | Powder puff | Innocent intender; small infringement; made in taking offered; action dismissed |
| Jewitt *v.* Eckhardt | 1878, L. R. 8 Ch. D. 404 | 294, 295, 319 | Toys | Exclusive licensee to sell goods made by another, not entitled to be put on Register as proprietor. |
| Johnson *v.* Bailey | 1893, 11 R. P. C. 21 | 312 | Teapot | Marking of worn-out articles sold illegibly marked; design struck off. |
| LAZARUS *v.* Charles | 1873, L. R. 16 Eq. 117, 122 | 293, 295 | Card basket | First importers; persons merely importing articles made abroad have no title to register themselves as proprietors of design. |
| Le May *v.* Welch | 1884, 28 Ch. D. 24; 54, L. J. Ch. 279 | 300, 301, 306 | Collar | Combinations of trifling characteristics old separately in common article, not subject-matter: Registration of little things not to harass traders. |
| McCREA *v.* Holdsworth | 1848, De G. & Sm. 196, 12 Jur. 820 | 318 | Damask designs | Manufacture without sale during registration is infringement: goods made and stored awaiting expiry of design are subject to injunction even after expiry of design. |
| McCrea *v.* Holdsworth | 1870, L. R. 6 Ch. 118 | | Damask designs | Infringement need not be exact copy of design. |
| McDougall *v.* Partington | 1890, 7 R. P. C. 172 | 321 | Patent Case | Inspection not granted where possibility of injury to one side exists. |

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|---|---|---|---|---|
| Moody *v.* Tree ... ... | 1892, 9 R. P. C. 233 | 298, 299 | Basket | Held to have been subject-matter for patent, but not for design registration. |
| Morris Wilson *v.* Coventry Machinists' Co. | 1891, 8 R. P. C. 353 | 319, 320, 323 | Bicycle | Practice in designs actions to follow practice in patent actions. |
| Morton's Design ... | 1900, 17 R. P. C. 117 | 283, 298, 306, 312 | Cuff link | Utility immaterial: novelty: improper marking: design expunged. |
| NEW Ormonde Cycle Co.'s Mark | 1896, 13 R. P. C. 175 | 330 | Trade Mark Case | Procedure in altering name of proprietor on Register. |
| Norton *v.* Nicholls ... | 1859, 1 E. & E. 765: 5 Jur. N. S. 1203: 28 L. J. Q. B. 225 | 317 | Mantilla shawls | Notice to retailer should be full and complete, and should specify the real claim intended to be made. |
| OLIVER *v.* Thornley .. | 1896, 13 R. P. C. 190 | 315 | Lace | *Infringement when not an absolute* but an obvious copy of design. |
| PLACKETT'S Design | 1892, 9 R. P. C. 136 | 307 | Lace | Held anticipated by similar registered and published designs. |
| Plating Co. *v.* Farquharson | 1883, Griff. P. C. 187 | 321 | Patent Case | Where trade secrets are alleged to be in danger from inspection, an independent referee may be appointed by the Court to inspect. |
| Potter & Co. *v.* Braco de Prata Co. | 1891, 8 R. P. C. 218 | 292 | Calico prints | Protection of design only extends over United Kingdom. |
| READ and Gresswell's Design | 1889, 6 R. P. C. 471 | 307, 309 | Candle shade | Anticipation by prior registration and publication in similar goods or class. |
| Rivett *v.* Grimshaw ... | 1894, 11 R. P. C. 351 | 300 | Bassinette | Combination of designs of bassinette and mail cart held registrable. |
| Rollason's Design .. | 1897, 14 R. P. C. 969; 1898, 15 R. P. C. 411 | 300, 304, 305, 306, 311, 312 | Collin plates | Combination of old designs with but little change sustained as good subject-matter. |
| SARAZIN *v.* Hamell | 1863, 7 L. T. N. S. 699 | 313 | Lace | *Marking: goods delivered on sale* abroad, must be marked. |

| Name of Case. | Where Reported. | Pages in this Book. | Subject-matter of Patent. | Chief Points affected by Decision, and *obiter dicta*. |
|---|---|---|---|---|
| Saunders *v.* Wiel | 1892, 9 R. P. C. 159; 10 R. P. C. 29 | 302, 303, 307, 320, 321 | Spoons and Forks | Modelled view of Westminster Cathedral on spoon handle held good subject-matter (*Adams v. Clement-son* disapproved). Interrogatories in penalty action not allowed. |
| Sherwood's Design | 1892, 9 R. P. C. 268 | 308 | Globes | Prior publication by sale of two globes. |
| Sherwood *v.* Decorative Tile Co. | 1887, 4 R. P. C. 207 | 306, 316, 317, 325 | Tiles | "Obvious" or "Fraudulent" imitation: aggregate of penalties limited by Act of 1883. |
| Smith *v.* Hope Bros. | 1889, 6 R. P. C. 200 | 301 | Scarf | Design too slight and obvious to be sustained: small difference from old shape. |
| Smith *v.* Roberts | 1888, 5 R. P. C. 611 | 317, 326 | Muslin goods | Innocent retailer not selling with knowledge of design (Section 58, Subsection 6). Action dismissed. |
| Smout *v.* Slaymaker | 1890, 7 R. P. C. 90 | 308 | Fire screen | Prior publication by exhibition and sale previous to registration. |
| TYLER *v.* Sharpe | 1893, 11 R. P. C. 35 | 301 | Closet basin | Commercial success of assistance in construing and sustaining subject-matter of design. |
| VARLEY *v.* Keighley Iron Works | 1896, 14 R. P. C. 169 | 305 | Presser bar | Design sustained though drawing in application not conclusive *per se* as to shape claimed. |
| WALKER *v.* Falkirk Iron Co. | 1887, 4 R. P. C. 330 | 298 | Kitchen range door | Subject-matter of design might also *be subject-matter for patent.* |
| Walker *v.* Heela Foundry Co. | 1887, 5 R. P. C. 71 | 323 | Kitchen range door | No alleged anticipation of design can be produced at trial unless pleaded in particulars. |

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|---|---|---|---|---|
| Walker *v.* Scott | 1892, 9 R. P. C. 182 | 208, 301 | Oil can | Rounding edges of old oil can, as subject-matter for design. |
| Wedekind *v.* General Electric Co. | 1897, 14 R. P. C. 190 | 313 | Telephone transmitter | Marking: transmitter proved to have been sold unmarked. Action dismissed. |
| Welsbach Co. *v.* New Sunlight Co. | 1900, 17 R. P. C. 101 | 325 | Patent Case | Interrogatories: officer of corporate body need not reply concerning knowledge acquired apart from his position in company. |
| Wilson *v.* Wilson | 1899, 16 R. P. C. 315 | 323 | Patent Case | Discretion of Judge as to terms in allowing amendment of particulars. |
| Winfield *v.* Snow | 1890, 8 R. P. C. 15 | 308, 326 | Silk lace | Prior publication: sample shown and retained, and order given before date of registration, held to constitute prior publication: design registration invalid. |
| Wirrmann *v.* Oppenheim | 1884, 27 Ch. D. 260 | 312 | China lamp | Marking: goods marked with wrong die; held, mistake did not void registration: plaintiff not bound to give innocent infringer notice before taking proceedings. |
| Woodley *v.* Broad | 1892, 9 R. P. C. 208; 129 | 205, 313, 323 | Lace | Licensee to sell goods made by proprietor has no right to sue for infringement, and has no right to register as proprietor: terms of leave to amend particulars are in discretion of Judge, and this discretion is not interfered with (*Welsbach Co. v. Wilson*): delivery on sale of unmarked goods, even when in unfinished state, invalidates registration. |

# KEY TO ABBREVIATED REFERENCES TO REPORTS.

| | |
|---|---|
| App. Cas. (or A. C.) | Law Reports (New Series), Appeal Cases. |
| Ark. | Arkyn's Reports. |
| B. & Ald. | Barnewall & Alderson's Reports. |
| Barb. | Barbour's American Reports. |
| Beav. | Beavan's Reports. |
| B. & Cr. | Barnewall & Cresswell's Reports. |
| Bos. & P. | Bosanquet & Puller's Reports. |
| B. & S. | Best & Smith's Reports. |
| C. & P. (or Car. & P.) | Carrington & Payne's Reports. |
| Car. & K. | Carrington & Kirwan's Reports. |
| Cart. T. M. C. A. | Cartmell's Trade Mark Cases, 1876 to 1892. |
| C. A. | Court of Appeal. |
| C. B. N. S. | Common Bench Reports (New Series). |
| Ch. D. | Law Reports (New Series), Chancery Division. |
| Ch. | Chancery. |
| Ch. Ca. | Cases in Chancery. |
| Cl. & F. | Clark and Finnelly's Reports. |
| C. M. & R. | Crompton, Meeson & Roscoe's Reports. |
| Coop. Ch. Ca. | Cooper's Chancery Cases. |
| Dav. Pat. Cas. | Davies's Patent Cases. |
| De G. J. & S. (or D. J. & S.) | De Gex, Jones & Smith's Reports. |
| De G. & J. | De Gex & Jones's Reports. |
| De G. M. & G. | De Gex, Macnaghten & Gordon's Reports. |
| De G. & Sm. | De Gex & Smale's Reports. |
| E. & B. | Ellis & Blackburn's Reports. |
| E. & E. | Ellis & Ellis's Reports. |
| Godd. O. C. | Goddard's Patent Practice before the Comptroller and Law Officer, with Appendix to end of 1892. (1893.) |
| " " (1st Appx.) | |

| | |
|---|---|
| Good. P. C. | Goodeve's Patent Cases, Vol. I. (Reports to end of 1883). |
| Griff. A. P. C. | Griffin's Additional Cases for 1887. |
| Griff. P. C. | Griffin's Patent Cases (1884 to 1886). |
| Hare | Hare's Reports. |
| H. Bl. | H. Blackstone's Reports. |
| H. of L. Cas. | House of Lords Cases. |
| Hyde | Hyde's Indian Reports. |
| How. Pr. | Howard's Practice (U.S.). |
| H. & M. | Hemming & Miller's Reports. |
| H. & N. | Hurlstone & Norman's Reports. |
| Ir. Eq. | Irish Equity Reports. |
| Ind. L. R. (Calc.) | Indian Law Reports, Calcutta. |
| Johns. | Johnson's Reports. |
| Jur. N. S. | Jurist (New Series). |
| K. & J. | Kay & Johnson's Reports. |
| L. J. Ch. | Law Journal Reports (New Series), Chancery. |
| L. J. C. P. | " " " Common Pleas. |
| L. J. Ex. | " " " Exchequer. |
| L. J. Q. B. | " " " Queen's Bench. |
| L. R. App. Cas. | Law Reports, Appeal Cases. |
| L. R. Q. B. D. | " " Queen's Bench Division. |
| L. R. Ex. | " " Exchequer. |
| L. R. Ch. D. | " " Chancery Division. |
| L. R. Ch. | " " Chancery Appeals. |
| L. R. Eq. | " " Equity Cases. |
| L. R. C. P. | " " Common Pleas. |
| L. R. P. C. | " " Privy Council Cases. |
| L. R. H. L. | " " House of Lords. |
| L. T. | Law Times. |
| L. T. N. S. | Law Times Reports (New Series). |
| Law. Pat. | Lawson on Patents &c., 3rd Edition. |
| M. & G. | Manning & Grainger's Reports. |
| M. & Cr. | Mylne & Craig's Reports. |
| Mer. | Merivale's Reports. |

| | |
|---|---|
| M. & W. | Meeson & Welsby's Reports. |
| New. Ir. Jour. | Newton's London Journal. |
| O. G. | Official Gazette of United States Patent Office. |
| Popham | Popham's Reports. |
| Q. B. | Queen's Bench. |
| R. P. C. | Reports of Patent, Design and Trade Mark Cases. |
| Sol. J. | Solicitor's Journal. |
| Stark. | Starkie's Reports. |
| Seton. | Seton's Reports. |
| Sch. Dig. | Schestion's Digest of Trade Mark Cases. |
| Taunt. | Taunton's Reports. |
| T. L. R. | *Times* Law Reports. |
| T. R. | Term Reports (Durnford & East). |
| U. S. Pat. Gaz. | United States Patent Gazette. |
| Ves. | Vesey's Reports. |
| Web. P. Cas. | Webster's Reports of Patent Cases. |
| W. N. | Weekly Notes. |
| W. R. | Weekly Reporter. |

The correct citations of the Law Reports, from and including 1891, are as follows:—

| | |
|---|---|
| [Date] 1 or 2 Ch. | Chancery Division, 1st or 2nd Vol. |
| [Date] 1 or 2 Q. B. (or K. B.) | Queen's Bench (or King's Bench), 1st or 2nd Vol. |
| [Date] A. C. | Appeal Cases. |

# INTRODUCTION.

Patents, Trade Marks, and Designs compared.

AT THE present day Patents, Designs, and Trade Marks are granted and registered under the provisions of The Patents, Designs, and Trade Marks Acts, which are dated respectively 1883, 1885, 1883, 1888, and 1901. These Acts will be referred to generally throughout this Work as "The Patents, Designs, and Trade Marks Acts, 1883 to 1901." The union of the three species of property in the titles of these Acts seems to imply a closeness of similarity which does not really exist. A few words will serve to differentiate them.

Patent.

Where a Patent has been granted, say for a new description of lamp, the manufacture and sale of the lamp become a monopoly, and every lamp of the same or substantially the same construction which is made and sold by others, without leave or licence, is an infringement of the rights of the Patentee.

Trade Mark.

But where a trader has registered a Trade Mark for a lamp which is not the subject-matter of a Patent, all the world may make and sell precisely the same lamp, with this restriction only, that they must not sell it under the registered Trade Mark, for this would be to represent the article as having been made by the owner of the Trade Mark.

Design.

A Design, on the other hand, like a Patent, has reference to the specific substance or *corpus* of an article, but rather from an artistic or configurative than from a functional point of view. Thus the patented portion of the lamp might relate to a new automatic safety extinguisher, which might be made and applied and be operative in several forms and still be within the scope of the Patent, while the Design Copyright might refer to the decorative stand supporting the lamp, which could not be varied from the registered design without going outside the limit of protection.

Arrangement of volume.

To follow the subjects of this work in their relative order of importance it is proposed to treat—First, of PATENTS; Secondly, of TRADE MARKS; and, Thirdly, of DESIGNS.

# PART I.—PATENTS.

## CHAPTER I.

### THE ORIGIN AND HISTORY OF PATENT LAW.—THE PATENT LAW AMENDMENT ACT, 1852.—THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 to 1901.

TO ASSIST the reader to a proper understanding of Patent Law as now existing, it may not be unprofitable to give a short sketch of its earlier history.

Origin of Letters Patent for Inventions.

Letters Patent for Inventions are the offspring, or rather the survival, of the ancient Royal Grants of Monopoly. From the earliest times it was recognised that the Sovereign was at liberty to exercise the prerogative of making special grants to subjects.

Grants.

These grants were made known by "Open letters," or *Litteræ Patentes*, addressed to all subjects of the realm, so that the privileges granted should not be questioned from want of knowledge. It is evident that from the first, new *inventions*, new *manufactures*, and *advances in arts and sciences* were considered favourable subjects for protection by these Royal Grants.

Alleged early Patent for Invention.

There is a tradition, not founded on any evidence the writer can find, that a Patent was issued by King Edward III. in respect of an alleged discovery of the Philosopher's Stone; but this may be dismissed as an idle tale. It is however a matter of record that the same Monarch granted a Patent to one John Kempe in respect of the introduction of a new manufacture or industry of

cloth-making, and also issued similar grants for clock-making to three men of Delft. But these and other grants made by Henry VI. for the manufacture of salt and in respect of mining operations were rather trade monopolies than patents for inventions.

Early trade monopolies and their abuse.

With lapse of time, however, the perverted custom of granting monopolies in the exercise of trades and in the sale of goods grew to such an outrageous extent that in the reign of Elizabeth a vast number of commodities, representing in some cases the merest necessaries of life, were in the hands of patentees or monopolists, who used their powers in the harshest and most arbitrary manner to enforce their rights. The supplies of coal, salt, vinegar, iron, steel, bottles, glass, lead, oil, tin, sulphur, pots, brushes, currants, and numbers of other products, natural and artificial, home and foreign, were governed by monopolists, who stood so little on conscience that, in certain places, that prime necessity of life, salt, rose from sixteen pence to fifteen shillings a bushel. According to the historian Hume, a list of these things, read in the House of Commons, brought to his feet an indignant member, who vowed to his astounded hearers that if things were allowed to go on at this rate "bread itself would be reduced to a monopoly."

But the foregoing represents the high-water mark of monopolies, and in the succeeding reign of James I. the whole vicious system was done away with by the famous *Statute of Monopolies*. At one stroke of the pen the bulk of these unjust and restrictive privileges was declared "utterly void and of none effect, and in no wise to be put in use or execution."

Statute of Monopolies declared, 21 Jac. I. c. 3, that Monopolies are declared

One of the exceptions to the general extinction of monopolies was made by Sections 5 and 6 of the Statute of Monopolies in favour of patents for inventions then in force and thereafter to be granted, and this is still the

Sections made an exception in favour of patents for inventions

basis upon which patent rights stand at the present day. For example, by Section 6 of that Statute the term of a patent was limited to fourteen years and the subject-matter to be "only of the sole working or making of any manner of new manufactures which others at the time of making such

Subject matter and conditions of patents defined.

letters patent and grants shall not use." The patent must be granted to the true and first inventor; the invention must be novel; the privilege must not be contrary to law, nor mischievous to the State, nor hurtful to trade, nor generally inconvenient. The term of fourteen years seems to have been fixed by doubling the usual period of apprenticeship *i.e.* seven years.

Reasons for fixing duration of patents.

Probably the draftsman of the section reasoned that if the inventor of a new manufacture trained an apprentice in the art for seven years, it was but just that he should have the services of the skilled workman, at skilled workman's wages, for another seven years, before the pupil should be at liberty to exercise the art for his own personal advantage. Indeed, under the earliest practice it was customary to insert a proviso in the grant, requiring the inventor to take apprentices during the last seven years of the term, if he had not done so before.

After history of Patent law.

The privilege of Letters Patent for inventions having been thus saved from the general wreck of monopolies brought about by the Statute of James I., thereafter passed through a long period of comparative obscurity, to endeavour to trace which would only weary without instructing the reader.

As to the procedure in obtaining a patent this became a model of circumlocution.

Procedure and practice generally bad.

Petitions, declarations, reports, references, warrants, stamps, bills, and seals were handled about from office to office, existing apparently only for the extraction of fees from the patentee. The Home Office, the Law Officers' Chambers, the Patent Bill Office, the Signet Office, the Privy Seal Office, the Letters Patent Office, and finally the Lord Chancellor's Office, each appeared in turn with mystic powers and striking paths. Nor must the Enrolment Office, the Petty Bag Office, and the Office of the Rolls Chapel be forgotten, although these were chiefly repositories of the enrolments and beyond the purview of the patentee.

In the Office of the Lord Chancellor the multiplication of the seals of office is an example of the wisdom of providing adequately that what is to be done the first time

should come through so many hands, to the end that nothing should pass the Great Seal . . . that was against law or inconvenient." But we moderns may be pardoned for surmising that institutions for which so clever an apologist could only find so meagre an excuse were ripe for removal.

Separate patents for England, Scotland, and Ireland.

England, Scotland, and Ireland had each its separate patent, the fees for protection in all three amounting to about £300. With the addition of attorneys' and other charges the entire cost to the patentee of a patent covering the United Kingdom could not, in those days, have been less than from £500 to £700. In re *Hay's Patent* (1 Web. P. C. 505) the accounts showed the patent to have cost £500. Up to the reign of Queen Anne no specification seems to have been required, but after 1714 the enrolment of a specification became compulsory.

As time went on, and as the volume of patent business increased, the attention of legislators was directed more and more to projected improvements in the Patent Law. Slight changes in the procedure were made, and the power of entering a disclaimer of any part of his specification was granted to the patentee by 5 & 6 Will. IV. c. 38, the same Act providing for a seven years' period of extension. By 7 & 8 Vict. c. 69 the possible period of extension was increased to fourteen years. Following these Acts there came

Disclaimer allowed 5 & 6 Will. IV. c. 38).

Further extension allowed (7 & 8 Vict. c. 69).

Patent Act, 1852.

## The Patent Law Amendment Act, 1852.

The changes effected by this Act were important.

One patent for United Kingdom.

One patent covered Great Britain and Ireland, the Channel Islands, and the Isle of Man. The whole business of the Commissioners of Patents was conducted in one office under a responsible head. The stages of proceedure were reduced to (1) The Application, with Provisional or Complete Specification; (2) The Filing Notice of Intention to Proceed with the Application; (3) The Applying for the Warrant and Seal; and, (4) if it had not been done at the time of application, The Filing

Stages of obtaining a patent.

of the Complete Specification. This option of filing a Provisional description of the invention at the time of application, and following it up within six months afterwards with a Complete Specification, was a new element in patent procedure which has proved extremely satisfactory in practice.

Provisional Specification.

Under the Act [illegible] the [illegible] payable on application is [illegible] and the [illegible] payable at the end of the third and seventh years respectively were £50 and £100, or the total amount payable [illegible] £150.

and valuable advance in his art to have his application for a patent in those countries met by the objection that it is not patentable subject-matter, an objection advanced possibly by an official who knows absolutely nothing of the industry in question, and who is quite incapable of appreciating the advantages and importance of the invention submitted to him. Thus it has frequently happened that inventions which have realised large sums of money in royalties in England have been refused protection in America and in Germany on the plea of lack of novelty or of patentability. It may seem, and no doubt it is, a pity that patents should be granted over and over again for the same thing; but the writer is persuaded that more injustice would be done than good effected by the adoption of the system of examination if accompanied with the power of arbitrary refusal or arbitrary dictation as to the form the specification and claims shall assume. As to the supposed security of patents which have been granted under the examination system, it is sufficient to state that as large, if not indeed a larger, proportion of patents granted in the United States are declared invalid in Courts of Law than is the case with patents granted in this country.

Injustice sometimes worked by examination system.

Anyone who is *curious to know the sometimes very* divergent opinions of different authorities upon the vexed question of examination will find a mine of interesting information in the Blue Book containing the Appendices to the Report of the Committee appointed by the Board of Trade to *inquire into the working of the Patents Acts* (dated 1901, price 1s. 5d.).

## The Patents, Designs, and Trade Marks Acts, 1883 to 1901.

Act of 1883 not an originating Act.

If the reader has followed the foregoing historical *résumé*, he will doubtless have noted that the Act of 1883 made no real change in the principles of Patent law. It was merely an amending Act by which the procedure was simplified, the cost decreased, the United

Kingdom placed under the scope of one patent, the principle of the Provisional Specification adopted, and sundry regulations promulgated relating to the conduct of litigation.

No change was effected in fundamental principles, and no attempt made to define afresh the subject-matter of patents. For a definition of the expression "invention" the reader of the Act was referred to the old Statute of Monopolies.

Patents, Designs, and Trade Marks Act, 1883.

As in the case of the Patent Law Amendment Act of 1852, so it is with the Patents, Designs, and Trade Marks Act of 1883. By this Act the procedure was still further simplified. The fees and stamps on the obtaining of a patent were reduced from £25 to £4, while the fees for maintaining the patent in force during the full term of fourteen years have, under recent Rules, been reduced from £150 to £95.

Procedure simplified and fees reduced.

These and sundry provisions having reference to the regulation of legal proceedings, restriction to one invention only, the amendment of specifications, oppositions, &c., represent the bulk of the changes made by the Acts of 1883 to 1888.

Patent Act of 1901.

The Patent Act of 1901 (1 Ed. VII. c. 18), which came into operation on the 1st of January, 1902, relates solely to international arrangements. It constitutes an amendment of Section 103 of the Act of 1883, and extends, from seven months to *twelve months*, the time within which persons who have applied for protection of an invention in a country other than the United Kingdom, and being subjects, citizens, or domiciled inhabitants of or in a State which has adhered to the International Convention or with which reciprocal arrangements may have been made by the British Government, are entitled to apply for a similar privilege in the United Kingdom. Sub-section 2 of Section 1 provides that any such application, when made in this country, must be accompanied by a Complete Specification, with drawings (if any); and provides, further, that the said Complete Specification, "if it be not accepted within the period of twelve months" shall be open to public inspection at the expiry of that period.

Extension of period of priority under Convention.

Application to be accompanied by Complete Specification.

If not accepted within twelve months from date of lodging application or complete to be void to pay for extension

The Act of 1901 does not make it plain from what period the twelve months for acceptance of the Complete are to run But the Patents Rules of 1901, dated the 19th December, 1901 (see Rule 27a at page 512 of this volume), say that the twelve months for acceptance are to be counted as "from the date of the first foreign application." As Section 104 of the Act of 1883 provides for the admission, by Order in Council, of British Possessions to the benefits of Section 103, the word "Foreign" in the Rule should apparently be read as "Foreign or colonial."

Having thus glanced broadly at the origin and development of patent for inventions up to the present day, the present Patent law can now be discussed with greater profit. It will be found that almost every phase of the subject which need be touched upon can be grouped under one of the following headings:

1 Procedure in Obtaining Patents
2 Who may be a Patentee
3 Subject-matter of Patents, including Invention, Novelty, and Utility
4 The Specifications (Provisional and Complete).
5 Opposition to Grant of Patent
6 Sealing of the Patent
7 Amendment of Specifications
8 Action for Infringement.
9 Petition for Revocation
10 Action to Restrain Threats
11. Prolongation of Patents.
12 Assignments, Licences, &c
13. Register of Patents.
14 Miscellaneous.

# CHAPTER II.

## PROCEDURE IN OBTAINING PATENTS.

Application for patent.

SO FAR as the merely formal steps are concerned, an application for a patent is a very simple matter. The respective forms and stamps are on sale at all postal money order offices in the United Kingdom, and when filled in can be delivered or posted direct to the Patent Office in London. The application papers consist of a declaration (Form A: and in the case of inventions communicated from abroad, Form A1), stamped with £1, in which the applicant must insert his full name, address, and occupation, and give the title of the invention. He must declare that he is the true and first inventor, and that the invention is not in use by any other person or persons to the best of his knowledge and belief, and he must sign his name at the foot of the form.

How to fill in forms.

Provisional protection.

If the applicant wishes to apply for provisional protection only, he will receive with Form A or A1 two unstamped copies of Form B, upon which he should write and sign his Provisional Specification. The declaration, with the two copies, may then be posted to the Comptroller-General at the Patent Office, and the business is complete. By return of post the applicant will receive his certificate of filing, and in the next week's issue of the *Illustrated Official Journal* (*Patents*) the application is advertised. In about three weeks or a month afterwards (provided that his specification is sufficiently intelligible, and that his papers have been filled up according to the instructions given) he will receive the certificate of acceptance, and this also is advertised. The specification itself is kept secret during the term of provisional protection.

Certificate of filing Provisional.

Advertisement and acceptance of application.

Complete Specification.

At any time within nine months from the date of his application the applicant may file his Complete Specification.

The form for this (Form C) can also be purchased at a postal money order office. These forms are supplied in duplicate, and one copy bears a £3 stamp. The Complete Specification must be prepared in accordance with this form and upon the lines and limits laid down by the Provisional. It should conclude with a clear statement of what the inventor claims as new, and should, when necessary or desirable, be accompanied by line drawings executed in Indian ink, and without the use of colour or brush shading, so as to be suitable for reproduction by photo-lithography or zincography. Such drawings are to be made on pure white hot-pressed drawing paper of smooth surface and good quality, each sheet to be in duplicate, size 13 inches in length by 8 inches in width, or, if this is too small, 13 inches in length by 16 inches in width. A marginal line should be placed round the sheets half an inch from the outer edge. On one of the copies of the drawing (marked "Original") the reference lettering should be in Indian ink; the other copy should be marked "True copy," and the lettering should be in faint blue pencil. Both copies should be signed. The drawings must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

Must agree with Provisional.

Drawings.

Differences in duplicate copies.

When the Complete Specification has been dispatched to the Patent Office, a certificate of filing will in due course be received by the applicant.

Certificate of filing Complete.

The Examiners in the Patent Office now compare the Complete Specification with the Provisional, and if they accord with one another, and are properly prepared in compliance with the Rules, a certificate of acceptance is issued and advertised in the aforesaid *Official Journal*. Three weeks afterwards the Complete Specification, together with the Provisional, is printed and published. Within two months from the date of the *Journal* in which such advertisement appears, any person interested in so doing, and being entitled to oppose, may give notice of opposition to the application. But if these two months should pass without opposition being offered, the patent is sealed and issued to the applicant.

Comparison by examiners of Provisional and Complete.

Acceptance of Complete and publication.

Period for opposition.

Sealing of patent.

The foregoing is an exact account of the procedure when a Provisional Specification only is filed with the application, and is afterwards followed up by a Complete Specification. But it should be said here that the applicant has the option of filing a Complete Specification in the first instance instead of a provisional description. Each course has its advantages, and the simpler plan will be to lay these in order before the reader.

Provisional Specification may be dispensed with.

*First.*—If application is made for provisional protection only in the first instance, the advantages are that the preliminary cost is less, while the applicant has nine months during which he may, without fear, test the value of his invention either publicly or privately, improve upon the details, make searches as to its novelty, sell or agree to sell his discovery or its products, and, in short, deal with his invention just as if he had a patent, except in this respect, that he has no right of action against infringers until he has obtained his patent, and then only in respect of infringements committed after publication of his Complete Specification (Patents Act, 1883, Section 13). To these should be added the consideration that, as the Provisional Specification may be a document much less exact in its terms than a Complete Specification, an application for provisional protection may be filed at a stage in the conception of the invention when it might be impossible or injudicious to give full details. A further important advantage is that more time is given to consider the subject of foreign patents. Lastly, if the invention should prove disappointing, the application may be abandoned without incurring further expense, and without rendering the invention public property, seeing that the specifications of all abandoned applications are never published, but remain secret. Therefore, if the applicant should afterwards be able to remedy the defects in his invention, there is nothing to prevent him from renewing and completing his application, provided that he has not in the meantime published his idea, or that some other inventor has not crept in after the date of his first, but before the date of his second, application.

Advantages of provisional with application.

Applicant may work invention during Provisional Protection.

Infringements after publication of Complete.

Foreign patents.

Renewal of abandoned application.

In practice the great majority of applications for patents are accompanied in the first instance by a Provisional Specification only.

Filing Complete with application.

*Secondly.* If application is made accompanied by a Complete Specification, the advantages which exist are much less obvious. Where an agent is employed there is no doubt some slight saving in agency fees. The total stamp amounts are the same in both cases: viz. £4. The acceptance and publication of the Complete Specification at once place the applicant in a position to deal with infringers as soon as he gets his patent into his hands.

Only recommendable where invention is perfect.

On the whole, it may be said that a Complete Specification should only accompany the application in those cases in which the details of the invention are fully worked out, and where the applicant has no reasonable doubt of the novelty, utility, and assured practical success of his invention.

Some reasons for the employment of patent agents.

In the foregoing description of the mode of procedure it has been assumed that the Provisional and Complete Specifications are prepared by the inventor himself. But if the writer may be allowed to express an opinion, grounded upon long experience, the preparation of the specification by the inventor himself is not a course to be recommended. No prudent man attempts to draw a conveyance, mortgage, will, or other legal instrument without the assistance of a properly qualified adviser, and such care is no less essential in the case of Patent Specifications. The fatal facility with which any person, fired by some crude idea, can rush into a post-office, buy a form, scribble a few incoherent lines, and breathlessly post the whole to the Comptroller, is by no means an unmixed benefit, and has its result in a flood of rubbish poured into the Patent Office every year. Probably a very large proportion of the applications thus made would never have been filed if they had been submitted in the first instance to the calmer judgment of an experienced and properly trained patent agent or solicitor.

But, apart from this, should the invention really contain some valuable subject-matter, the assistance of a professional

adviser would in many instances enable the inventor to reap results of which his own precipitancy and self-confidence deprive him. Undoubtedly there are many inventions so simple that a plain man using plain language can express the gist of his invention sufficiently well to satisfy requirements; but in all cases the burden is laid upon the applicant that the specification and claims shall be prepared with "reasonable skill and knowledge," and if these essentials are wanting nothing can save the patent from being upset should it come to be tested in a Court of Law.

Specification must be prepared with reasonable skill and knowledge.

To return from this digression, it has been said that, where a Provisional Specification has been first filed, the Complete Specification should be lodged before the expiration of the succeeding nine months. If from any excusable cause this term should elapse without the Complete Specification being filed, it may be filed within one month after on payment of a fine of £2. If it be not filed within the extreme time allotted—that is, within ten months from the date of application—the application is considered to be abandoned.

Extension of time to complete application.

The examination of the Complete Specification has already been referred to. If the Examiner should report that it does not properly describe the invention, or goes beyond the Provisional Specification, or that the claims are absent or imperfect, or that more than one invention is claimed, the Comptroller may refuse to accept the specification until these faults have been corrected. If the applicant disputes the justice of these objections he may appeal to the Law Officer, who will either sustain or rebut the Comptroller's decision.

The examination of the Complete Specification.

Comptroller's objections to specification may be appealed against.

Oppositions will be treated under the heading specially devoted to that subject (see Chapter XIV.).

Opposition.

If no opposition is entered, or if the opposition is unsuccessful, the patent is issued and dated as of the day of application.

Date of patent.

The patent is granted for fourteen years, and covers Duration. the United Kingdom of Great Britain and Ireland and the Isle of Man. The Channel Islands no longer appear in the grant.

Renewal fees.

At the end of the fourth year annual payments are required to keep the patent in force. According to the present scale the annual fees are as follows:—

| | £ | s. | d. |
|---|---|---|---|
| Before the end of the fourth year, and in respect of the fifth year ... ... | 5 | 0 | 0 |
| Before the end of the fifth year, and in respect of the sixth year ... ... | 6 | 0 | 0 |
| Before the end of the sixth year, and in respect of the seventh year... ... | 7 | 0 | 0 |
| Before the end of the seventh year, and in respect of the eighth year ... | 8 | 0 | 0 |
| Before the end of the eighth year, and in respect of the ninth year ... ... | 9 | 0 | 0 |
| Before the end of the ninth year, and in respect of the tenth year ... ... | 10 | 0 | 0 |
| Before the end of the tenth year, and in respect of the eleventh year ... | 11 | 0 | 0 |
| Before the end of the eleventh year, and in respect of the twelfth year ... | 12 | 0 | 0 |
| Before the end of the twelfth year, and in respect of the thirteenth year ... | 13 | 0 | 0 |
| Before the end of the thirteenth year, and in respect of the fourteenth year ... | 14 | 0 | 0 |

Extension of time to pay renewal fees.

If by "accident, mistake, or inadvertence" (Section 17, Sub-section 3), the payment of an annual tax should be overlooked, an extension of time of from one to three months, during which the annuity may be paid, can be obtained on payment of the following fines:—

| | £ | s. | d. |
|---|---|---|---|
| On extension of time for one month ... | 1 | 0 | 0 |
| ,, ,, ,, two months ... | 3 | 0 | 0 |
| ,, ,, ,, three months ... | 5 | 0 | 0 |

Duplicate of lost Letters Patent may be issued.

In the event of the Letters Patent being lost or destroyed, the Comptroller may, on a satisfactory explanation of the disappearance of the original, cause a duplicate to be sealed and issued on payment of a fee of £2.

Amendments.

The question of Amendments of Specifications will be treated under its proper heading (see Chapter XVI.).

# CHAPTER III.

## WHO MAY BE A PATENTEE.

Persons entitled to become patentees.

ANY person, of either sex, whether a British subject or an alien, may be a patentee. Even those who are generally considered under legal disabilities, such as infants and lunatics, may become patentees, so long as the necessary documents are prepared in the prescribed manner. No inquiry is made by the Patent Office as to the age, sanity, or coverture of the applicant. A corporate body is a person within the Statute and may be a patentee (Section 117). But a corporate body alone could not make the necessary declaration, not having the mind to invent, but must be coupled with the true inventor. Foreign corporations owning patents abroad and desirous of obtaining British patents usually communicate the invention to a representative or agent in this country, who thus becomes the grantee on behalf of his foreign correspondents.

Corporate bodies.

Exceptions.

It is submitted that the general rule—viz. that any person may be a patentee—is subject to exception in the case of the Sovereign, on the principle that the Crown cannot make a grant to itself. Further, although many such patents exist, it may be doubted whether a beneficed clergyman can legally become a patentee, in view of the prohibition from trading under 1 & 2 Vict. c. 106, Sections 28 to 30. The question whether an alien enemy is incapacitated as a patentee was raised, but not decided, in *Bloxam v. Elsee* ([1825-7] 1 C. & P. 558; 1 Web. P. C. 132). The probability is that he would not be ousted on that account alone.

Joint patentees.

Two or more persons may make a joint application for a patent, and it is provided that a joint application may legally be made by the inventor or inventors in conjunction with another individual or with persons who are not joint inventors. Thus an invention may be patented

in the joint names of the inventor and a capitalist with whom he has agreed to associate himself. The name or names of the actual inventor or inventors must, however, be specified in the declaration.

Importers.

The term "Inventor" is not under the Act confined to a person who evolves an invention from his own mind. The term is also used to designate one who first introduces or imports an invention from abroad. A patent granted to such an applicant would be perfectly valid if it could be shown to be unknown and unpublished in this country at the date of the application, if no fraud within the jurisdiction and as against the true inventor has been practised. However, if the invention has been previously patented or protected abroad, the foreign or other inventor has the privilege, in those countries which have become parties to or share in the privileges of the International Convention, of making an application here within twelve months and obtaining the same date as that of the original patent abroad. Such foreign applications under the Convention must, when made in this country, be accompanied by a Complete Specification (see Section 1, Sub-section 2, of The Patent Act, 1901), and if not accepted within twelve months will be thrown open to public inspection.

Rights of foreign inventors under International Convention.

Rights of deceased inventor's representatives.

If an inventor should die before applying for a patent his legal representatives may make the application, and if his death should occur after the application, but before completing, his legal representatives may proceed and obtain the grant of the patent.

Communicated inventions.

A person resident in this country may patent in his own name an invention communicated to him by the actual inventor abroad. In such cases it is usual, though not essential, to indicate the source from which the knowledge has been derived.

# CHAPTER IV.

## SUBJECT-MATTER OF PATENTS.

Definition of "Invention."

IT HAS been said that neither in the Patent Law Amendment Act of 1852 nor in the more recent Acts of 1883 to 1901 has any attempt been made to define the meaning of the term "Invention." In both instances the reader is referred back to the ancient Statute of Monopolies. Turning, then, to Section 6 of that Statute, we find that Letters Patent and Grants of Privilege are limited in favour 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 Grant, 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 inconvenient.**"

Section 6 of Statute of Monopolies.

"Invention" means new manufacture.

Therefore, the subject-matter of Letters Patent must be some "*manner of new manufactures.*" It is very unlikely that the old draftsman in setting down this definition of subject-matter had any glimpse of the magnitude of the interests that would be created by this Section 6 of his Bill. The clause was the earliest effective legislative recognition of the public policy of allowing temporary privileges to the inventors of new manufactures. It is the basis of our present law and the cradle of the still more gigantic patent system in force across the Atlantic.

The discussions that have taken place upon the true meaning of the "working or making of any manner of new manufactures" only prove how unintentionally well chosen and comprehensive the expression really is. "Manufacture" has been held to be synonymous with

"Manufacture"

means both method of making and product.

"invention," and to mean not only the process of making, but also the thing produced. For example, "manufacture" as applied to hatting might mean (*a*) the machinery by which the hat is made, or (*b*) the successive steps or processes to which the hat body is subject, or (*c*) the hat itself. "It was admitted," says Chief Justice Eyre, in *Boulton v. Bull* (1795, 2 H. Bl. 463; 3 Ves. 140), "that 'manufacture' is applicable not only to things made, but to the practice of making: to principles carried into practice in a new manner: to new results of principles carried into practice." Thus the term excludes a mere barren principle, no matter how great the discovery may be, so long as no immediate practical result useful to individuals or to trade is brought about. In other words, the mere laying bare of a physical law or force which has been in existence since the world began, no matter how tremendously it may increase the scope of our knowledge and the sum of our wealth, cannot be patented. Thus, to instance extreme cases, Newton could not have patented his discovery of the laws of gravity; nor Harvey his of the circulation of the blood; nor Franklin his of electricity. But lesser minds coming after these great intellects may, by special devices, put these newly-discovered forces into harness, so that they shall grind corn, pump water, or carry messages, and for these devices patents will be granted.

But does not include bare principle.

Discovery not "invention."

"Manufacture" includes "process." *Crane v. Price.*

At one time it was doubted whether the language of the Statute extended to processes, but by a long series of decisions, of which *Crane v. Price* (1842, 1 W. P. C. 393; 12 L. J. C. P. 81; 4 M. & G. 580) is one of the oldest, it has been placed beyond controversy that a process, whether it be chemical or mechanical, is good subject-matter for a patent.

To those having any knowledge of the varied standpoints from which patentable inventions can be surveyed it need hardly be said that it is impossible to cut up and label the legitimate subject-matter of patents into a *distinct and exhaustive number of areas*. *One portion* of any such arbitrary division is sure to be found overlapping or trenching upon the others. But for the sake

of convenience it might be found profitable in a work of this nature to consider patentable inventions as being roughly divided into the following six classes: viz.

Classes of subject-matter.

1. New and useful machines for new or old purposes, and improvements in existing machinery.
2. New and useful combinations of mechanical parts and of materials.
3. Improvements in existing manufactures, processes, or parts of processes.
4. Novel and useful results and products of manufactures and processes.
5. New or improved processes, for which special machinery may or may not be necessary.
6. New principles, coupled with a mode of carrying the same into practical effect.

A short examination of each of these heads, with a few annexed practical examples, will assist the reader to understand them more fully.

## 1. *New and Useful Machines for New or Old Purposes, and Improvements in Existing Machinery.*

New and improved machinery.

A new machine or contrivance may be for an entirely new purpose, or it may be for use in connection with an old purpose. The first is an extremely rare class of invention. The second is most common. As an example of the first, take the subject of the transmission of speech over long distances by electricity. Here was a new purpose, and the telephone, with its vibrating plates, transmitter, and receiver, formed a new apparatus for this new purpose. Therefore the telephone was a patentable invention of the highest order—namely, a new apparatus for a new purpose. As an example of the employment of machinery to effect for the first time by a mechanical operation what had hitherto been done by hand, the original sewing machine might be instanced. Sewing is among the oldest of arts. But the first sewing machine was an absolutely new

Example of the highest type of invention.

Example of a lower type.

contrivance for this old purpose: therefore it formed patentable subject-matter, though of a less high class than the telephone, seeing that the purpose to which it was applied was old.

Improvements in existing machinery.

Improvements in existing machinery may be said to *form the bulk of patented inventions*. For example, there are hundreds of patented improvements on the original sewing machine. Indeed, in all classes of machinery of which large quantities are used, an improvement which to an outsider may seem but a very slight advance is often the source of fortune to its inventor, and is patentable subject-matter.

Instances of apparently slight advance.

*Moser v. Marsden.*

In *Moser v. Marsden* ([1893] 10 R. P. C. 350) Lopes, L. J., said that a new mode of using an old machine by altering it, involving the exercise of invention and ingenuity in its application, *is good subject-matter for a patent*. In the above case, in which the Court of Appeal and the House of Lords ([1895] 13 R. P. C. 24; 73 L. T. N. S. 667) affirmed the validity of the patent for the well-known Moser "raising" machine, the evidence showed that the advance effected by the patentee upon prior inventions for the same object, although apparently slight, had *practically* been exceedingly successful, and this had great weight with the Court in supporting the patent.

Instances of very slight advance.

*Goddard v. Lyon.*

In *Goddard v. Lyon* ([1894] 11 R. P. C. 354) the only essential difference between the plaintiff's disinfecting machine and similar disinfecting apparatus made before the date of the patent was, according to Lord Watson, "That in the plaintiff's the purifying chamber is fitted with a door capable of resisting, and therefore enabling the process to be carried on with, high pressure steam. If the 'Aberdeen'" (*i.e.* the alleged anticipation) "had been made with a door to the inner chamber which would have permitted the use of high pressure steam, the plaintiff's invention would, in my opinion, have been thereby anticipated." It may be said that, in spite of the apparent obviousness of the improvement, the patent was sustained.

To multiply examples of what have been held to be patentable improvements in existing machinery (no change

being made in the purposes for which such machines are used) would be to cite more than half of all decided patent actions, and the two foregoing cases have been selected as examples of comparatively slight improvements in existing mechanism which have been upheld as patentable matter. Still, let it be noted that obvious alterations and additions such as might occur to a man of average intelligence in constructing a machine are not as a rule patentable. The advance must betray *invention* as well as involve *utility*. What these expressions have been held to mean will be discussed under their proper headings.

Obvious alteration not invention.

Additions to or improvements on existing patented machinery or things may also be made, and in their turn patented (see *Hoe v. Bellestable*, 1866, 15 W. R. 194; *Lister v. Leather*, 1857-8, 8 E. & B. 1004, 27 L. J. Q. B. 295). If the improvement is separable from, and is no essential part of, the existing patented machine or thing, it may be made and sold separately. But if it forms an integral part of the machine or thing, and is useless apart from it, it would evidently be of little advantage to the inventor, as he could not make use of the original invention without the sanction of the original patentee. On the other hand, the original patentee could not make use of the improvement without the permission of the second patentee, and, as a consequence, the second patentee might find his reward in selling or licensing to the original patentee.

Improvements upon existing patents.

## 2. *New and Useful Combinations of Mechanical Parts and of Materials.*

Although patents are granted for combinations, it must be said at the outset that a combination to warrant a patent should show invention. Obvious combinations are not good subject-matter. Therefore, in every case it is necessary to take the merits into consideration to decide whether or not the effecting of the combination shows the exercise of invention. All engineers have at their disposal a certain number of well-known parts and motions which are the *disjecta membra* of the mechanical arts. In building a machine for a certain purpose he may make use of these

Patents for combinations.

Mere judicious arrangement not patentable.

known parts and motions, and by combining them produce an apparatus fit to perform a certain function. So long as he merely exercises judicious selection and puts the different parts to their obvious uses, he does not *primâ facie* exercise invention but only ordinary workman's skill, and in that case the machine, although perhaps the first of its kind, is not necessarily a patentable invention. Take as an example the simplest form of combination: viz. the mere coupling together of two well-known things which have heretofore acted separately, but which on being connected give a continuous operation. A good illustration of this is to be found in *Williams v. Nye* (1890) 7 R. P. C. 62). The plaintiff in this case had merely taken a well-known mincing-machine and an equally well-known machine for filling skins, and connected them together, so that the mincing and filling operations were continuous instead of being interrupted as before. The result was a sausage-making machine which was proved to be most useful, meritorious, and economical. Nevertheless, the Judges of the Court of Appeal expressed themselves as satisfied that there had been no such exercise of the *inventive* faculty as to make the plaintiff's machine subject-matter for a patent. Even where the combination was apparently not quite so easy to effect, the patent could not be upheld. In *Saxby v. Gloucester Waggon Co.* (1880-81) L. R. 7 Q. B. D. 305; 50 L. J. Q. B. 577) a decision adverse to the patent was grounded on the same objection. As was pointed out by Field, J., the evidence showed that any person conversant with the subject could by placing the two known parts side by side effect the patented combination without further experiment or information.

Mere putting together two known things not invention.

*Williams v. Nye.*

*Saxby v. Gloucester Waggon Co.*

Still, even this simplest type of combination viz. the connecting of two well-known machines—might be patentable if the method and means used to connect them required invention. For example, merely to place a folding machine in line with a printing machine so as to print and fold continuously, instead of separately as before, would not be invention if nothing more were done. But if the continuous printing and folding involved some necessary transmitting mechanism, requiring design and

But mere coupling together if

the exercise of invention, to pass each printed sheet to the folders, then the combination would be patentable subject-matter.

invention is required is patentable.

It is impossible to patent the combination of a concrete thing with an abstract property or qualification. Chief Baron Pollock, in trying to express this, once said: "You cannot have a valid claim for the combination of 2½d. with a pound of butter." An example will help the point to be better understood. We will suppose that rollers covered with *porcelain* were well known as being the best rollers that could be used for crushing grain. Suppose it were afterwards discovered that to make one roller run a little faster than the other produced a grinding as well as a crushing effect, which vastly improved the result by separating the germ from the starch part of the grain. Here is a real invention. It cannot be said that the idea is unpatentable. But, at all events, the claim that was really made—viz. "The combination of porcelain rollers with *differential velocity*"—proved to be untenable. Mere improved adjustment of the parts of a machine was held not to be patentable in *Kay v. Marshall* (1838-41] 2 W. P. C. 39, 71, 79; 8 L. J. C. P. 261).

Combination of a concretion and abstraction not patentable.

Almost the largest class of patented inventions is that of combinations of known mechanism. In *Spencer v. Jack* (1862-4 33 L. J. Ch. 346; 11 L. T. N. S. 212) Lord Westbury took occasion to say that "it is impossible to deny that if there be a combination of several things previously well known, which combination is attended with *results of such utility and advantage to the public that* the combination itself is rightly denominated *a substantial improvement*, it is, I say, impossible to deny that that is the subject of a patent."

Combinations of known parts.

Such combinations may consist of arrangements of known mechanical parts or groups of parts. The combination may consist of mere rearrangement, addition, or subtraction. The known parts or groups must not be independent of each other, nor must the connection of the groups be known or obvious. The combination may consist entirely of old parts or groups, and in such a case the patentee is usually tied somewhat closely to the arrangement

Patents for *mere* combinations of known parts usually narrow.

shown and described. Therefore, another inventor might, by changing the combination to a greater or less extent, place himself outside of the scope of the patentee's claims (see *Ashworth v. Roberts* [1890], 7 R. P. C. 451; L. R. 45 Ch. D. 623; 60 L. J. Ch. 27; and *Curtis v. Platt* [1864], 35 L. J. Ch. 852; 11 L. T. N. S. 245; Good. P. C. 144).

*Curtis v. Platt.*

Examples of obvious combinations.

As examples of combinations of old parts too obvious to constitute subject-matter reference might be had to *Longbottom v. Shaw* ([1891] 8 R. P. C. 333; L. R. 43 Ch. D. 46) where hooks, formerly attached separately to a cloth winding frame, were, according to the patent, attached first in rows to a carrying strip of metal, and this strip with its attached hooks then secured to the reel. This was held not patentable. In *Newsum v. Mann* ([1890] 7 R. P. C. 307) a patent was held bad where the invention consisted *of combining in one casting several parts of a frame* which had hitherto been cast separately. In *Dudley's Patent* ([1895] 12 R. P. C. 192) a combination of old parts in gun mechanism under the first claim was held to show no invention and no substantial advantage, and to be bad.

*Wood v. Raphael.*

In *Wood v. Raphael* ([1897] 14 R. P. C. 406) the patent was upset on proof that the patentee had only combined in double eyeglasses certain features—viz. a rigid bridge, pivoted placquets, and spring arms—which had before been separately used in double eyeglasses. The admitted advantages of the combination did not save it, no new function being performed.

Examples of combinations held not too obvious.

But, on the other hand, combinations of old parts for old purposes are generally sustained where, in addition to increased utility, it is obvious that ingenuity is present. In *Haygarth v. Hamilton* ([1881] Griff. P. C. 115) the combination of the old prism with the old pavement light was upheld, the Court coming to the conclusion that ingenuity had been exercised in effecting the combination. In *Siddell v. Vickers.*

*Siddell v. Vickers.*

([1887-9] 5 R. P. C. 81, 416; 6 R. P. C. 464) the combination of an endless chain, chain-wheel, and ratchet arrangement for turning large forgings was upheld, notwithstanding that the endless chain and chain-wheel had been in common use for this very purpose, and

the internal ratchet teeth and pawl was a mechanical appliance of the commonest knowledge, although not before used for this specific purpose. It must be said, however, that Lord Herschell, in his judgment, admitted that this case was near the border line, and that no great exercise of the inventive faculty had been required. A difference between this and the *pince-nez* case is, that in *Wood v. Raphael* (*supra*) *all* of the parts of the combination had before been used separately in a *pince-nez*, whereas in *Siddell v. Vickers*, *one* of the elements of the combination had not been used for such a purpose before, and in addition a new functional advantage was gained by the combination. It would be unsafe, however, to deduce any general rule that no combination the parts of which had been separately used for the same purpose could, as a combination, be patentable subject-matter.

Combinations of known parts must show new functional advantages.

Rigby, L. J., in discussing the essentials of a combination of old parts, said, in *The Lancashire Explosives Co. v. The Roburite Co.* ([1895] 12 R. P. C. 482): "Invention consists in many cases in putting together items of common knowledge which no one else has ever thought of combining." Abbott, C. J., also, in *Brunton v. Hawkes* ([1820-21] 4 B & Ald. 541; Good, P. C. 97) said that "a patent for a machine each part of which was in use before, but in which the combination of the different parts is new and a new result produced, is good, because there is a novelty in the combination."

Rigby, L.J., on invention in combinations.

It should be said at this point that the tendency of the Courts under recent practice is rather in favour of sustaining combination patents without enquiring too narrowly into the *quantum* of invention, if it is clear that a public want has been met and a considerable commercial success obtained.

Thus, in *Taylor & Scott v. Annand et al.* ([1900] 18 R. P. C. 53), the plaintiffs' patent was for apparatus to print late racing and other news in successive editions of a newspaper. Previously the ordinary method in use was to cut out a portion of the stereo. plate, or to leave a gap in the plate, which was filled in when required by a small fudge-box, containing the late news set up in type.

*Taylor & Scott v. Annand.*

The objections to these methods were the time consumed and the difficulty of securing the type in the small box. The plaintiffs' appliance consisted of an auxiliary short baby-roller carried on an eccentrically mounted shaft, and moveable to any position along the shaft. The short baby-roller carried the late news type, and could be shifted on the shaft so as to bring the type opposite to the blank left in the earlier edition to receive this late news. Evidence showed that auxiliary rollers for printing matter other than or additional to the matter on the main cylinder had been previously used in printing machines, but those rollers had been of equal length with the main printing cylinder. A baby-roller or short drum adjustable on a shaft was *per se* of common knowledge for other purposes, and shafts carried in eccentric bearings are quite usual in other machinery: for instance, in throwing toothed wheels in and out of gear. In short, as far as the immediate claim of the plaintiffs against the defendants was concerned, there was no single item of the arrangement which was not old in machinery generally, and certainly invention was not strikingly evident. The Court of First Instance felt this so much that the patent was declared bad, *inter alia*, for want of subject-matter. But this judgment was reversed and the patent sustained by the Court of Appeal and House of Lords. Lord Halsbury, L. C., in his judgment, admitted that "there is nothing more difficult when one is dealing with a mechanical combination than to keep one's mind free from the impression created by the fact that all the elements or most of the elements are old," and further quoted with approval the dictum of Lord Herschell in *Vickers v. Siddell* ([1890] 7 R. P. C., p. 304) on the difficulty of applying the law relating to combination patents to particular cases. The deft manner in which the apparently simple and obvious appliance of the plaintiffs coped with the particular requirement of adding late news in a hurry to successive editions of a paper, and the fact that many newspapers had taken licences, were pointed to as indicating utility, novelty, and commercial success. "And," said the learned Lord Chancellor in concluding, "to say that it is so obvious

Halsbury, L. C., on combinations.

that it requires no invention seems to me to be absolutely contrary to the reasonable inference to be drawn from the condition of facts to which I have referred."

Instances of very slight advances in combination patents are to be found in *Plimpell v. Hannan* ([1896] 13 R. P. C. 398), which related to concrete flooring; *Haddan v. Lyon* ([1894] 11 R. P. C. 354), where the invention, broadly speaking, consisted in strengthening a steam door in an otherwise old disinfecting machine; and *Birch v. Harrop* ([1903] 13 R. P. C. 615), where the plaintiff, although unsuccessful in proving infringement, nevertheless successfully upheld the validity of his patent for a combination in which the only new feature appears to have been a not very striking variation in the mode of moving the feed ring of a piece goods sewing machine. Although the defendant used an obvious mechanical equivalent, the Court of Appeal said the patent was too narrow to allow them to go into the question of mechanical equivalents.

Narrow nature of mere combination patents.

*Birch v. Harrop* and the often quoted case of *Curtis v. Platt* (*supra*) are, therefore, instances of the narrowest type of combination patent in which the patentee is practically tied down to what he has shown and described, and a patent of this limited range is always liable to be infringed if the infringer can change or modify the details sufficiently to place himself outside of the scope of the claim.

Combination containing a new feature.

But this evasion is not so easy when a combination, otherwise old, includes an essentially new element, although this may depend for its utility entirely upon its connection with the combination. Here the patentee is in a better position, and although an infringer may vary the arrangement and details of the combination, so long as he uses the novel element or a colourable imitation of it, he will be held liable. In *Lister v. Leather* ([1857-8] 8 E. & B. 1004; 27 L. J. Q. B. 295) Lord Campbell said, "A valid patent for an entire combination for a process gives protection to each part thereof *that is new and material for that process*." James, V.-C., in *Parkes v. Stevens* ([1869] L. R. 8 Eq. 358; 38 L. J. Ch. 627) also says: "The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for the process.

*Lister v. Leather.*

*Parkes v. Stevens.*

which is nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part, of a man's invention: and the question in every case is a question of fact—Is it really and substantially a part of the invention?"

*Proctor v. Bennis.*

This reasoning was followed in *Proctor v. Bennis* ([1887] 4 R. P. C. 333; L. R. 36 Ch. D. 740; 57 L. J. (Ch.) 11), where the plaintiff had patented a combination forming an improved mechanical stoker. Every part of the combination was old for the purpose except a pivoted flap or shutter, which threw the coal with a circular sweep into the furnace. This swinging flap replaced the old horizontally-moving pusher or ram. The evidence showed that the circular sweep of the flap had many advantages over the old fuel pusher in more evenly distributing the coal on the grate and reducing the shocks and strains on the tappets and springs. The swinging flap was not specifically pointed out as the novel part, and the claim was simply for the combination of the tappets, the shafts, the springs, and flaps as described and shown.

Relying upon the opinion of Lord Westbury in *Harwell v. Bostock* ([1863-4] 4 De G. J. & S. 77, 298; 9 L. T. N. S. 362, 528; 10 L. T. N. S. 144), that where *there is a patent for a combination the specification must* point out wherein the novelty and merit of the invention lies, the defendant, who used the flaps with a different combination of springs and tappets, took the objection that the combination only was claimed, and that the plaintiff could not pick out the flaps as if these had been separately claimed or discriminated. But Cotton, L. J., corrected the reading of Lord Westbury's dictum by the after-expressed opinion of Lord Cairns, in *Harrison v. The Anderston Foundry Co.* ([1876] L. R. 1 App. Ca. 574), that the discrimination between what is new and what is old in a combination is *a matter for evidence*. In *Proctor v. Bennis* the Court of Appeal decided that in using the swinging flap the defendant had taken the "pith and marrow" of the plaintiff's combination and had infringed.

In a combination differentiation of old from new is matter for evidence.

*Harrison v. Anderston Foundry Co.*

If essential of combination is

In *Wenham v. May* ([1887] 4 R. P. C. 303) the patentee had invented a gas lamp in which wire gauze

screens were used in certain specified positions, the said gauze screens being claimed "as described and shown." The defendants also used gauze screens, but not in the same positions as in the plaintiff's lamp, their defence being, practically, that they had not infringed the specific combination claimed. It was held that both upon the evidence and the specification, the object of the plaintiff's invention was to equalise and regulate the regenerative air-currents by means of wire gauze screens, irrespective of the specific arrangement, and that the defendants by adopting such gauze screens had infringed the essence of the plaintiff's patent. A lesson on the essential of an apparatus or combination may also be had from a consideration of *The Automatic Weighing Machine Co. v. National Exhibitions Association, Limited* (1901, 9 R. P. C. 41).

When taken the patent is infringed.

But, on the other hand, if someone makes use of the combination, omitting an element which the patentee has described as an essential and claimed as part of the combination, there is no infringement, though the evidence of the plaintiff may bring into prominence the utility and importance of the parts actually taken by the alleged infringer (*Bunge v. Higginbotham* 1901, 18 R. P. C. 201).

But no infringement if part described as essential, but not really so, is not taken.

In passing from mechanical combinations to those of materials we enter another field. A number of possible examples could be easily suggested. Thus, different materials may be mechanically mixed so as to produce new and useful results, such as linoleum floorcloth for example. New compositions of colours, varnishes, and cements might be so produced. In the same manner the combination of two materials, viz., caoutchouc with a woven fabric, results in a new product: *i.e.* a waterproof cloth; or the combination of two or more metals results in a new alloy. All of these are patentable.

New compositions of materials.

### 3. *Improvements in Existing Manufactures, Processes, or Parts of Processes.*

In order to differentiate the selected heads that have been set down as representing the main divisions of subject-matter, and so to avoid repetition, it will be necessary to consider the word "manufacture," not always in the broad

and general terms extracted from the Statute of Monopolies, but sometimes in its narrower and more generally understood sense.

Restricted meaning of "Manufacture."

"Manufacture," under the present heading, must therefore be taken to represent the "making of anything by hand or by art," such, for instance, as the weaving of cut pile fabrics, the making of lead piping, or the production of gas

Examples.

For example, in the manufacture of pile fabrics, instead of the usual plan of weaving the pile in loops and cutting these loops by an after operation, an inventor might produce a new method of weaving pile fabrics face to face in a double web, and cut the pile by the after operation of separating one fabric from the other, thus saving time both in the weaving and in the pile-cutting. Another inventor might propose to cut the pile in the very act of weaving, each pick as it is beaten up being severed by a series of knives worked from the healds. Both of these inventions would be patentable improvements in that special manufacture.

Again, take the production of lead piping. For many purposes, although it makes so convenient and cheap a tubing, lead is unsuitable. Metals of a higher cost have therefore to be used. But suppose a cheap and easy method were invented of thinly lining the interior of the lead pipe in the course of manufacture with this superior metal, so that all the advantages of the more expensive metal were obtained at the cost of only a slight increase in the price of the lead tubing. Here would be a patentable improvement in the manufacture of such tubing, based both upon the mechanism, if new mechanism had been devised, and also in respect of the new product viz. the lined lead tubing.

Then to glance at a supposititious improvement in the manufacture of gas. The improvement might relate to the retorts, or to the purifiers, or to the materials distilled in the retorts; or the inventor might make an entire change in the process, and, as has been lately done, manufacture gas from a mixture of decomposed steam or water gas and vaporised oil.

Just as an inventor may effect a radical change in the whole of a mechanical or chemical manufacture or process, so the invention may relate to a part only of the process.

With this general introduction a few of the decided cases bearing on the present division of subject-matter may now be considered.

Example of improvement in existing manufacture.

In *Lister v. Norton* ([1886] 3 R. P. C. 199) the plaintiff had patented an improvement in the manufacture of imitation seal skins, which consisted in blending silk with the mohair fibre before spinning. The silk gave smoothness and brilliancy, and the mohair elasticity. Before the date of the patent imitation seal skins were well known, and silk and mohair blended before spinning had been used in the production of dress goods. Nevertheless, as an improvement in that particular manufacture (*i.e.* imitation seal skins) the patent was upheld.

Substitution of one known material for another for analogous purpose.

But the mere substitution of one known material for another in the production of a known article—as, for instance, the substitution of steel for whalebone and cane in crinolines—was, in *Thompson v. Jones* ([1863] 32 Beav. 570), held not to be subject-matter. But where the substitution of one material for another requires adaptation and shows some ingenuity, the patent may be upheld. Thus, in *American Braided Wire Co. v. Thomson* ([1889] 6 R. P. C. 518; L. R. 44 Ch. D. 274) woven wire was for the first time used to make ladies' busties, which had formerly been made of cushions and of elastic pads of horsehair and whalebone. The House of Lords upheld the patent not with any great enthusiasm, but because they believed some thought and ingenuity had been expended on it. Great commercial success attended the patent, and this, no doubt, had its effect on the decision.

If invention required, such substitution is patentable. *American Braided Wire Co. v. Thomson.*

Obvious analogous user not patentable.

The application of a known article or apparatus to a purpose analogous to that to which it has been already applied is seldom subject-matter, and is never so held if the extension to this analogous purpose appears obvious. Thus an old form of locking apparatus formerly used in cycles when in motion was held, in *Singer v. Hodge* ([1891] 11 R. P. C. 463), not to be subject-matter when

Examples of obvious analogous user.

applied to lock the head of a bicycle at rest. In *Rose's Patents Co. v. F. Braby & Co.* ([1894] 11 R. P. C. 198) the use of steam pressure in a manner analogous to the well-known oil vapour pressure in lighting apparatus of the "Wells" type was held not patentable. So the use of a common mode of joining the abutting ends of wires by a split tube and solder for the specific purpose of connecting the joined ends of the inextensible wire rings of tyre covers was held in *Shaw v. Barlow* ([1895] 12 R. P. C. 282) to be bad subject-matter. In *Bradge v. Parnell* ([1899] 16 R. P. C. 625) an apparatus for cutting necktie linings by clamping several layers of material between templates and cutting through the mass with a band-knife, the knife being guided by the conformation of the templates, was held bad. The evidence showed that cutting piles of cloth with a band-knife was old, and also the use of guiding templates for the same purpose. There certainly were difficulties to be overcome in dealing with such soft and fluffy material, but the House of Lords, sustaining the Courts below, held that the alleged invention was merely a more skilled application of well-known tools and processes. The Judges were not unanimous either in the Court of Appeal or in the House of Lords.

*Harwood v. Great Northern Railway Co.* The Fish-plate Case.

An old and frequently quoted case on the point of analogous use is *Harwood v. Great Northern Railway Co.* ([1860-5] 2 B. & S. 194, 222; 11 H. L. Ca. 654; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27), where the plaintiff had patented a channeled fish-plate for securing together the abutting ends of rails. The patent was upset on proof that plates having the same characteristics had been used to fish together the ends of wooden beams.

*Morgan v. Windover.* The "Cee" Spring Case.

Another case bearing on the same point is that of *Morgan v. Windover* ([1890] 7 R. P. C. 131), where a "cee" spring, long in use at the rear of a carriage, was claimed when applied to the front. The plaintiff failed on the ground that it was a mere analogous user, and that no sufficient invention was apparent.

Sometimes, however, when the user is apparently analogous, invention may be so apparent as to support the

patent. Blackburn, J., in considering the case of *Bramwell v. Pickering* ([1875] Griff. P. C. 40), gave an example of what he considered could be a patentable analogous user by supposing the apparatus commonly in use for the making of macaroni piping of paste, adapted so as to be used for the manufacture of metal tubing, just as in *Ehrlich v. Ihlee* ([1888] 5 R. P. C. 437) the Jacquard principle was used for the production of musical sounds and harmonies instead of for weaving patterns in a loom. But instances of much closer analogous user have been sustained as patentable. Thus in *Pirrie v. York Street Flax Spinning Co.* ([1894] 11 R. P. C. 429), although the use of thin paper cop-tubes in the dry spinning of cotton was of ordinary common knowledge, the plaintiff, who claimed the employment of similar thin paper tubes in the spinning of *wet* flax fibre, had his patent sustained. The facilities in removing the tubes with the wound-on flax from the wooden bobbins after the drying process, and the better preservation of the form of the wound-on flax by reason of the presence of this thin paper core, were points in the evidence which induced the Court to find increased utility and invention. In *Gadd v. Mayor of Manchester* ([1892] 9 R. P. C. 516) the plaintiff's mode of supporting gasometers had been previously used in connection with docks and pontoons, but in spite of this alleged analogous prior user the patent was sustained. The old case of *Penn v. Bibby* ([1866] L. R. 1 Eq. 548; L. R. 3 Eq. 308; L. R. 2 Ch. 127; 36 L. J. Ch. 455), sometimes quoted as a case of analogous user, was only so to a small degree. The plaintiff's wooden bearings for propeller shafts, with the spaces for the free circulation of water, had little in common with the rough wooden chocks used to support the bearings of grindstones and the like, which were advanced as anticipations. The Court sustained the patent.

Example by Blackburn, J., of patentable analogous user.

Examples of users held not to be analogous.

In chemical inventions the rule of law against mere analogous user is not so strong. As was said by Lord Herschell, in *Badische Anilin Fabrik v. Levinstein* ([1887] 4 R. P. C. 449), "analogy does not go a long way in chemistry."

The rule against analogous user not so strong in chemical inventions.

No general rule applicable.

A just consideration of the cases only shows how dangerous it would be to attempt to lay down any general rule. Each case must be decided on its own merits, and evidence alone can decide whether or not in the application of old things to analogous or apparently analogous uses such invention and experiment have been required, and such increased utility proved, as will entitle the patentee to have his patent upheld.

### 4. *Novel and Useful Results and Products of Manufactures and Processes.*

Products good subject-matter for patents.

It was at one time doubted whether a new product was good subject-matter for a patent. But it is evident that such doubts can no longer be maintained. Certainly when claimed as the result of a particular process or mode of manufacture, itself new, the product can be claimed. In *Tennent v. Evans* (1890) 7 R. P. C. 265) the patentees had invented a new mode of weaving ladies' waistbands to the required curved shape, each waistband being woven, lined, and turned out by the loom as a finished article. Before the date of the patent such waistbands had been cut from woven material to the required curve and then lined and finished, the whole process entailing considerable waste of material and expenditure of time. The new apparatus comprised a specially designed loom with the warp in separate sections and conical warp drawing rollers. The waistband produced was something perfectly new in construction, and in addition to the claim for the apparatus a specific claim for the product *i.e.* the curved woven waistband was made. The defendants attacked this claim, saying that a mere product was not patentable. But Cotton, L. J., although not feeling called upon to adjudicate on the claim as for a mere product apart from the method of production, intimated that in his opinion, even considered as a claim for a product *per se*, it might be sustained. The learned Lord Justice referred to the case of *American Braided Wire Co. v. Thomson* (1890) 6 R. P. C. 518), where the patented product was a lady's bustle, and said: "If there is a new thing produced, and that is useful and

complies with other requirements, then, in my opinion, there could be a thoroughly good patent taken out for that."

Halsbury, L. C., in *Rickmann v. Thierry.*

In *Rickmann v. Thierry* (1896, 14 R. P. C. 105) Lord Chancellor Halsbury said: "The learned counsel, when asked what the invention was, stated that it was the product itself, and there can be no doubt that the product itself may be good subject-matter of a patent." Incidentally it was stated in this case that a valid patent could be had both for the process and the product. The plaintiffs, in *Rickmann v. Thierry*, did not claim the process at all by which the eyelets were coated with celluloid. They claimed the finished article, the product, and, it is apparent, would have succeeded had it not been for certain anticipatory matter brought forward.

On the authorities, then, it may be stated that when a product is new and useful and complies with other requirements, it can be claimed by itself and apart from any process.

No patent for producing by machinery a formerly hand-made article.

There is no authority for saying that one may patent the mere production by machinery of something which has heretofore been produced only by hand. Nor is it possible to patent as a new product something which, although old as produced by hand, has for the first time been put upon the market as made by machinery. A man could not patent as a new product and by itself a machine-made cigarette as against the old hand-made cigarette.

New compositions of materials.

In examples of mechanical admixtures of materials, resulting, for instance, in a new artificial stone or a new cement, where there is no invention in the process of mixing or making, but only in the selection of the materials, clearly the materials separately and apart from each other cannot be claimed as destined for that purpose. It is only when amalgamated and formed into the new and useful thing, whether artificial stone or cement, that they become appreciable subject-matter. Therefore the proper object to which to direct the claim is the product. In the same manner the novel result of a chemical process, such as a new dye, is a product capable of being patented. But the results of mere changes or variations in operations

capable of indefinite change are doubtful subject-matter, even when the product is something appreciably different from what has been produced before. For example, although a number of patents are taken out for so-called new cloths, produced merely by a rearrangement of the ordinary operations of a weaver's loom, it is more than doubtful whether any such patent could be sustained, unless the result exhibited an advance of such importance as to justify the maintaining of the patent.

### 5. *New or Improved Process with or without Special Machinery.*

Process patents.

If the result or product of a process is good subject-matter for a patent, it is clear that a new or improved process itself, whether applied to the making of a new product or to the manufacture of an old product, is equally good subject-matter. Lord Eldon, L. C., in *Hill v. Thompson* ([1817] Good. P. C. 241; 8 Taunt. 375), where the process related to the manufacture of iron, said that a new combination of old materials is patentable; and in *Gibson v. Brand* ([1841-2] Good. P. C. 211; 11 L. J. C. P. 177), where the patent related to a new process in the manufacture of silk, Coltman, J., said that a process is good subject-matter. James, V.-C., in *Elmslie v. Boursier* ([1869] L. R. 9 Eq. 217; 39 L. J. Ch. 328), said that one of the most useful of inventions is that of a process by which a common article may be made more economically than it was before. The old authority usually cited in maintaining that a process is good subject-matter is the case of *Crane v. Price* ([1842] Good. P. C. 131; 4 M. & G. 580). But at the present time, when process patents are sustained every year, it would be thrashing a dead horse to cite the modern cases where process patents have been upheld.

Old cases on process patents.

*Elmslie v. Boursier.*

*Crane v. Price.*

An addition to or subtraction from a process is patentable.

A patentable invention may of course be constituted by an *addition* to an existing process. It has also been held, as in *Russell v. Cowley* ([1835] Good. P. C. 407; 1 C. M. & R. 864) and *Wallington v. Dale* ([1851] Good. P. C. 487; 23 L. J. Ex. 49), that the *omission* of one or more steps from an existing process is patentable subject-matter. Where both process

and product are new, both may be claimed: where the product is old and the process new, the process can be claimed. Thus in *Stevens v. Keating* (1847 2 Web. P. C., p. 182) Pollock, C. B., said: "The real invention may not be so much for the thing when produced as for the mode in which it is produced, and its novelty may consist not so much in its existence as a new substance as in its being *an old substance produced by a different process.*"

A new process producing an old thing is patentable.

In the case of *Badische Anilin Fabrik v. Levenstein* (1897 4 R. P. C. 449) it was held that the prior use of an analogous chemical invention will not go far as an anticipation of an after-invention. The cause of this is, probably, that analogy and deduction in chemistry are not so obvious as in mechanical operations. The same rule holds good in cases of alleged infringement. Thus, in *Nobel's Explosives Co. v. Anderson* (1895, 12 R. P. C. 164), the plaintiffs, who had claimed the use of a *soluble* nitro-cellulose in the manufacture of a certain explosive, were unable to succeed against the defendant, who used *insoluble* nitro-cellulose.

Cases illustrating the dictum that analogy does not go far in chemistry.

A process may be new and the product may be new, yet the process may be worked by apparatus which has been in common use before, and cannot be claimed merely because of its application to a new purpose. But in some cases the apparatus for carrying out the process may require to be specially devised, and then it may constitute a separate invention.

Patent might be for process, product, and apparatus.

Thus there might be an invention in which apparatus, process, and product may all be new, and in such a case each may constitute subject-matter for a separate claim.

## 6. A *New Principle coupled with a Mode of Carrying the Same into Practical Effect.*

It has again and again been laid down by the highest authorities that a principle *per se* cannot be patented. Thus Lord Chancellor Halsbury, in *Pneumatic Tyre Co. v. Tubeless Tyre Co.* ([1898] 16 R. P. C. 77), said: "You cannot appropriate to yourself a mere principle; you can only appropriate the application of the principle." In practice one of the difficulties attending the general application of

A bare principle not patentable.

the rule is whether the particular invention under consideration is or is not within the vague lines which define a principle.

It is undoubtedly true that the discovery of an abstract and fundamental law of nature or of a natural or scientific truth—such, for example, as the law of gravity, the circulation of the blood, the principles of electricity—cannot be validly patented. For, although our knowledge of these things is the result of logical reasoning, thoughtful observation, and well-weighed deduction, nevertheless they are in no sense inventions. Columbus, although he discovered America, did not invent it. "An invention is not the same thing as a discovery. When Volta discovered the effect of an electric current from the battery on a frog's leg, he made a great discovery, but no patentable invention" (*per* Lindley, L. J., in *Lane-Fox v. Kensington Lighting Co.* [1892], 9 R. P. C. 413).

"Discovery" not invention.

But, passing from these landmarks in human progress to the consideration of smaller issues, it is questionable whether it is not too much the custom to seek to narrow down the field of invention, by describing as principles, and therefore as unpatentable, matters which are really improvements legitimately due to invention, and relating rather to practice than to principle. Take, for example, the well-known "Hot-blast" case of *Neilson v. Harford* ([1841] 1 Web. P. C. 295; 8 M. & W. 806; 11 L. J. Ex. 20), which is quoted so often as a test case on this very matter of principle. The action was tried in 1841, at a time when patent actions were remarkably rare, and when Judges had but little opportunity of making acquaintance with technical matters. The invention was simple. Prior to the date of Neilson's patent, iron-smelters had used a blast of *cold air* to blow up the smelting furnaces. Neilson's improvement was that he *heated* the blast. The advantages which have been derived by the iron industry of this country from this simple advance have been held to be incalculable. Fortunately for the patentee, the Court held that his claim was not for the hot blast *per se*, but for the hot blast in conjunction with the means by which the blast was heated. Otherwise it is perfectly plain, from the observations of the

*Neilson v. Harford.*

Judges, that had it been construed that Neilson claimed "heating the air-blast of smelting furnaces" irrespective of any air-heating means, his patent would have been considered bad, as laying claim to a principle.

It was not and cannot be pretended that the air-heating means involved any invention at all. Neilson briefly alluded to a heating box as a suitable means. But the invention lay altogether in the use of a hot blast. The least intelligent of ironmasters, when once told in three words what the object of the invention was—viz. to "heat the blast"—would have had no difficulty in constructing at once a more or less efficient heating means, such as a heating box, or a cylinder, or a heating coil, or a jacketed flue. He would have been astounded if he had been told that the patentable part of the invention lay, not in the grand secret of heating the air-blast, but in the self-evident heating means at his feet, although this had scarcely given him any trouble to devise, and had called for the exercise of no invention at all. During the hearing of the above case of *Neilson v. Harford*, Alderson, B., said: "I take it that the difference between a patent for a principle and a patent that can be supported is, that you must have an embodiment of the principle in some practical mode, described in the specification, of carrying the invention into practical effect, and then you take out your patent not for the principle, but for the mode of carrying the principle into effect." It is useless to speculate whether the Court, constituted as it is to-day, might not, in the case of *Neilson v. Harford*, have given a different ruling upon the question as to whether the mere heating of the blast fell within the domain of principle. The precedent has been established, and all that can be said is, that wherever it is a question of claiming anything which seems to be of the nature of a principle, the rule is to claim it in conjunction with and as effected by the means for carrying the principle into effect, however simple and self-evident such means may be.

*Boulton & Watt v. Bull.*

Practically the same conclusions were arrived at in the case of *Boulton & Watt v. Bull* ([1795] 2 H. Bl. 463; 3 Ves. 140; Good. P. C. 70), the plaintiffs being the patentees of the

separate condenser in steam engines. This difference, however, might be noted, that the means for carrying into effect the principle or plan of separate condensation were not self-evident, like the air-heater, but might have called for the exercise of the inventive faculties. Still more so was this the case in *Otto v. Linford* ([1881] 46 L. T. N. S. 35). One of the chief features of this invention was what Jessel, M. R., called the "idea," or principle, of putting a cushion of air between the explosive mixture and the piston of a gas engine so as to regulate or make gradual what would otherwise be a sudden shock. "Of course," said his Lordship, "that could not be patented. I do not read the patent so: I read the patent as being to the effect that the patentee tells us that there is the idea which he wishes to carry out; but he also describes other kinds of machines which will carry it out, and he claims to carry it out substantially by one or other of these machines. That is the subject of a patent." It will, however, be evident to the reader that the mere "idea" of interposing this elastic fluid cushion in the cylinder would be but a half-told tale if the ingenious mechanism for carrying it into effect were not also described and shown.

*Otto v. Linford.*

Example of principle claimed without apparatus.

In *Booth v. Kennard* ([1850-7] Good. P. C. 68; 26 L. J. Ex. 23, 305) a general claim for making oil gas direct from seeds, without reference to apparatus, was held to be in effect a claim for a principle, and the patent was declared invalid.

Alderson, B., in *Jupe v. Pratt.*

Alderson, B., whose remarks in *Neilson v. Harford* have already been quoted, said in the later case of *Jupe v. Pratt* ([1837] 1 Web. P. C. 145). "You cannot take out a patent for a principle. You may take out a patent for a principle coupled with a mode of carrying the principle into effect. . . . If you have done that then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as a piracy of your original invention." But to claim all possible ways of carrying a principle into effect would be bad and equivalent to claiming the principle *per se*.

"Principle" as compared with

A distinction should be drawn between inventions entitled to the broad term "principle" and those which are

rather of the nature of a quasi-principle. In *Automatic Weighing Machine Co. v. Knight* (1889) 6 R. P. C. 297) the quasi-principle disclosed was the existence of a "break" between the weighing and the indicating apparatus, which break was keyed together or bridged over so as to make the machine operative when a coin was inserted. The defendant submitted that a claim for this would be a claim for a principle, but the Court of Appeal held it to be merely a patentable peculiarity in the arrangement of mechanism, rendering *all* arrangements of mechanism with this peculiarity an infringement. Later actions by the same plaintiffs against *The National Exhibitions Association* (1891) 9 R. P. C. 41) and against *Fearby* (1893) 10 R. P. C. 442) were successful upon this reading of the claim.

"essence" of invention.

*Automatic Machine Co. v. Knight.*

The indicated distinction between the broad term "principle" and its narrower sub-division of "essence" or "quasi-principle" was briefly referred to by the writer in the First Edition of this book. That it has forced itself upon the notice of other authorities is evident from the remarks on the subject which are to be found in the scholarly brochure by Dr. W. Martin, of His Majesty's Patent Office, on *The Construction or Interpretation of Specifications of Letters Patent*, published in 1900. The learned Author says, on page 19 of his work: "That there is a principle in every invention would seem to be somewhat contradicted by the popular statement—an echo of the Courts—that 'you cannot patent a principle.' The seeming contradiction simply arises from the ambiguity in the word 'principle.' That a mere philosophical abstraction or elementary maxim or truth cannot be the subject of a valid grant admits of no doubt: for such an abstraction is not a manner of manufacture within the meaning of the Statute of Monopolies. That protection merely issues for the manner, as some would contend, in which the principle is to be carried into effect is contradicted by facts; for when after the enunciation of a new principle, the subject of an invention, the method of its performance is clear to the juridical expert, it is highly probable that no such method need of necessity appear in the specification

(*Boulton v. Bull* [1795], Dav. Pat. Cas. 162, at p. 214). If a method does appear, its presence in these circumstances is simply a guarantee that the essence of the invention is not a mere philosophical abstraction, but is indeed a workable manufacture. The workable manufacture which may be stated in the form of a principle is what is indeed protected."

No patent for mere external design.

A valid patent cannot be obtained for the external design or form of an element of mechanism apart from the use to which it is applied (*Preston Davies v. Black* [1894], 11 R. P. C., at p. 580). But a patent could be obtained for an article the *shape* of which enabled it to fulfil a useful purpose.

Inventions having illegal or immoral objects are unpatentable.

# CHAPTER V.

## ESSENTIALS IN SUBJECT-MATTER.

### Invention.

THE remaining essentials in patentable subject-matter are Invention, Novelty, and Utility.

First, as to Invention: This has been to some extent treated under the foregoing chapter on subject-matter; but something still remains to be said. According to Section 46 of The Patent Act, 1883, "Invention" means any manner of new manufacture the subject of Letters Patent and Grant of Privilege within Section 6 of the Statute of Monopolies. This dry husk of information teaches us but little, and therefore to acquire a just conception of this most elusive quality in subject-matter it will be necessary to devote some consideration to the question of what constitutes "invention" in accordance with the authorities.

Definition of "Invention" in Statute of Monopolies.

Broadly speaking, invention in Patent law means the using of a man's intelligence, reason, and brains in such a manner as to evolve, or recognise, or find, or make known a something out of the beaten track, and not noticeable or known to the ordinary mind. "Something," as Willes, J., said in *Tatham v. Hanin* ([1868] Griff. P. C. 213), "which requires some exertion of mind that would properly be called 'invention.'" Or, as Lindley, L. J., said in *Lane-Fox v. Kensington Co.* ([1892] 9 R. P. C. 413): "A patentee must so use his knowledge and ingenuity as to produce a new result." Unfortunately there is no recognised and constant mete or measure we can apply to discover whether a man's device contains a sufficiency of the quality of invention. As Bowen, L. J., said in *Lyon v. Goddard* ([1893] 10 R. P. C. 334): "The question whether there is any ingenuity in the subject-matter of a patent is a question of fact which depends on a true view of all the circumstances."

Attempts to define by the Bench.

The alleged obvious nature of an invention may be battled by evidence.

Thus the argument that the improvement was obvious and the advance slight may be successfully met, or at least combated, by showing that rival manufacturers had never thought of the so-called obvious modifications in an article of which very large quantities were made every year, and especially if substantial advantages in utility and convenience had been obtained under the invention. In *Wilson v. Wilson* (1900 17 R. P. C. 177) the improvement consisted entirely in doubling over upon itself the upper edge of the ordinary spun metal ferrules on weft bobbins, so that, when applied, the folded-over edge sank into the wood and held the ferrule in position. Ferrules had been made in which the upper edge had been turned at right angles so as to catch in the wood of the bobbin, but the plaintiffs' was the first to have the edge folded down upon itself for the specific objects of the invention. The change had been most successful, and some millions were made every year. The Court of First Instance held that, slight as the difference was, invention was apparent, and the plaintiffs were successful. The Court of Appeal held the patent invalid chiefly because of an alleged defect in the form of one of the claims, but without dissenting from the general conclusions of Mr. Justice Bruce below (18 R. P. C. 130).

It does not follow that because a thing has never been done before, the element of invention is necessarily present. Said Cotton, L. J., in *Blakey v. Latham* (1889 6 R. P. C. 184): "A thing is not to be called new simply because it has never been done before; there must also be invention." The same learned Lord Justice also expressed a similar opinion in *Britain v. Hirsch* (1888 5 R. P. C. 226). In *Rickmann v. Thierry* (1896 14 R. P. C. 105) Lord Halsbury said: "A thing may be new, but unless it has some invention it is not patentable."

Mere novelty does not imply invention.

Mere adaptive modification is not invention.

In *Nicoll v. Stevens* (1893) 10 R. P. C. 240, Wright, J., decided that the mere prolongation of a buttonhole seam in a lady's habit, for the whole length instead of for a portion of the length only as before, was not a patentable invention. Mere adaptive skill and judgment in modifying an existing thing so as to make

it more useful is not invention (*Beard v. Egerton* [1846], 17 R. P. C. 708).

Accident not to be excluded.

An invention might be accidentally made, as is said to have been the case with waterproof silks or "tabbies." But even there, a man's observation and thought must be exercised to recognise and utilise the idea he has accidentally hit upon.

Amount of invention where novelty and utility are apparent.

As to the *quantum* of invention, where a device is new and useful very little invention will suffice to support the patent. As Lord Halsbury said in *Hickman v. Thomas & Co.*: "No smallness or simplicity will prevent a patent from being valid." For similar expressions of opinion on simplicity in inventions the reader is referred to the dicta of Tindal, C. J., in *Crane v. Price* (1842) 1 Web. P. C. 393; Jessel, M. R., in *Cope v. Lingford* (1881) 18 L. T. N. S. 330; and Bramwell, L. J., in *Haywood v. Hamilton* (1881) Griff. P. C. 116, where a combination of pavement light and prism, differing very little from what had been used before but giving materially increased useful results, was upheld as involving invention. "It is an invention," said the learned Lord Justice, "and not the less an invention because it requires small inventive powers to enable the patentee to do it."

Analogous application not invention.

As has already been pointed out in the preceding chapter, mere analogous application is not invention. A wheel well known before the introduction of railways cannot be patented for specific use on a railway (*Losh v. Hague* (1837-9) 1 Web. P. C. 200; 8 L. J. Ex. 251). A fishplate, used before the date of railways to connect wooden beams, cannot be patented for connecting rails on a railway (*Harwood v. Great Northern Railway Co.* (1860-65), 11 H. L. Cas. 654; Good. P. C. 224). There is no invention in applying an ordinary water tap to a beer bottle (*Huddart v. Rylands* [1891], 9 R. P. C. 1); nor in using a spring in front of a carriage which has been long used at the rear (*Morgan v. Windover* [1892], 7 R. P. C. 131). A method of fixing posts in concrete, old as used in structures on land, cannot be considered new as applied to the construction of groynes on the seashore (*Otis v. Cressy* [1901], 18 R. P. C. 410).

Examples of patents held bad.

The principle enunciated in *Morgan v. Windover* and other cases, that if a known article is applied to an analogous purpose the application is not patentable simply because it produces advantages not produced before received a new illustration in the recent well-known "Puttee Gaiter" Case (*Slohnsser v. Humphreys* [1900], 18 R. P. C. 116). Here the spirally wound strap or puttee combined with the gaiter for protecting the leg, both having been previously used separately for an analogous purpose, was held not to show invention. The patent was therefore declared invalid, although enormous commercial success was shown and the advantages of the combination were beyond question.

The "Puttee Gaiter" Case. *Slohnsser v. Humphreys.*

Commercial success does not prove invention.

Examples of apparent analogous user sustained.

On the other hand, many instances of apparently analogous user have been supported, as, for example, in the cases already referred to of *Pirrie v. York Street Flax Spinning Co.* ([1894] 11 R. P. C. 429), *Gadd v. Mayor of Manchester* ([1892] 9 R. P. C. 516), and *American Braided Wire Co. v. Thomson* ([1889] 6 R. P. C. 518).

Examples of patents not saved by commercial success.

Mere evidence of commercial success, and even of increased utility, will not excuse the absence of invention (see *Slohnsser v. Humphreys, supra*). Thus in the "Boot Protector" Case of *Blakey v. Latham* ([1889] 6 R. P. C. 184) both of these adjuncts were overwhelmingly proved, but the patent was upset for want of subject-matter. In *Williams v. Nye* ([1890] 7 R. P. C. 62) the same fate befell the patent for a combined mincing and filling sausage machine, although great utility and commercial success were shown. In *Riekmann v. Thierry* ([1896] 14 R. P. C. 105), celluloid eyelets; *Wood v. Raphael* ([1897] 14 R. P. C. 496), pince-nez; *Slazenger v. Feltham* ([1888] 6 R. P. C. 130), tennis racquets; and *Cooper v. Badeker* ([1899] 16 R. P. C. 363), felt bicycle handle covers, the patentees were all unsuccessful through lack of invention, although utility and commercial success were proved.

Wherever the Court finds a real or appreciable germ of invention, however small, it will uphold the patent. Thus the substitution of a round wick in a lamp for a flat wick was approved as patentable in *Hinks v. Safety Lighting*

Examples of patents upheld

though showing small invention.

Co. ([1870] L. R. 4 Ch. D. 607; 46 L. J. Ch. 185). In *Perry v. Société des Lunettiers* ([1896] 13 R. P. C. 664) the addition of a hinge to the folding sides of a camera previously unhinged was held to show invention. Another example of very slight invention is to be found in *Lyon v. Goddard* ([1894] 11 R. P. C. 354), the Disinfecting Machine Case. Even the modification of one element in an old arrangement was upheld in *Edison-Swan v. Woodhouse* ([1887] 4 R. P. C. 99); and the omission of a step in a process was held good subject-matter in *Wallington v. Dale* ([1851-2] 7 Ex. 888), and in *Booth v. Kennard* ([1856-7] Good. P. C. 68) was approved as such, although for other reasons the patent was not sustained.

Long felt want supplied strong argument for invention.

*Ehrlich v. Ihlee* ([1888] 5 R. P. C. 437) and *American Braided Wire Co. v. Thomson* ([1889] 6 R. P. C. 518) have been advanced as arguments that where an invention clearly meets a want long unsupplied the patentee must be taken to have exercised invention. According to Kay, L. J., in *Savage v. Harris* ([1896] 13 R. P. C. 364), such a test is, however, anything but conclusive.

Uselessness of alleged anticipations.

The fact that alleged anticipations were useless, and that the plaintiff's invention was extremely useful, has been held, in *Duckett v. Whitehead* ([1895] 12 R. P. C. 187, 376), to be strong evidence of the exercise of invention.

# CHAPTER VI.

## ESSENTIALS IN SUBJECT-MATTER.

### Novelty.

Novelty an essential in subject-matter.

THE next essential of valid subject-matter in a patent is that it shall be novel. The grant of a patent being upon the assumption that it is *a new manufacture* which the inventor is giving to the public, anything which disproves this view militates against the validity of the grant. "Novelty" means novelty within the United Kingdom, for anything done abroad and not published or made known here does not affect a British patent.

It is therefore of the utmost importance that the novelty of an invention should be inquired into by a careful search among the Patent Records and other sources of information before the expense of taking out a patent is incurred. It must be remembered that if it should transpire that any portion of the claimed matter is old, the whole patent is invalid, at least until amendment of the specification. In *Marchland v. Nicholson* ([1893] 10 R. P. C. 417), for example, it turned out that the plaintiff's fifth claim for quite an unimportant detail was bad for want of novelty. The whole patent thereby became invalid, and Lord Chief Justice Clerk, in delivering judgment, said: "I cannot but regret that the complainer, who, I think, has a good and patentable invention, should have made a claim, which is bad, for an unimportant detail of his apparatus. Unfortunately, the law is, as stated by the Lord Ordinary, that this claim being bad the whole patent must fall."

The whole of the claimed matter must be novel.

Cases establishing the rule.

This rule in Patent Law is founded on the older cases of *Huddart v. Grimshaw* ([1803] 1 Web. P. C. 85); *Hill v. Thompson* ([1817-18] 1 Web. P. C. 229; 8 Taunt. 375); and *Brunton v. Hawkes* ([1820-1] 4 B. & Ald. 541; Good. P. C. 97), and has been followed in later cases, such as *McCormick v. Gray* ([1861] 2 H. & N. 25; 31 L. J. Ex. 42); *Haslam v. Hall* ([1887] 5 R. P. C. 1); *Pether v. Shaw* ([1893] 10 R. P. C. 293), and is the rule in present practice.

The universal application of this rule, however, is relaxed if it can be shown that the matter claimed in the doubtful subordinate claim is meant to be used only with and as part of the main invention. Thus, in *Plimpton v. Spiller* ([1877] Good. P. C. 380; L. R. 4 Ch. D. 286; 20 Sol. J. 860), the second subordinate claim, looked at by itself, was clearly bad for want of novelty; but, as the Court was of opinion that the subordinate matter claimed was meant to be claimed only for use in and as a part of the roller skate, which was the real invention, the patent was upheld. In *British Dynamite Co. v. Krebs* ([1879] Good. P. C. 88; also reported as Appendix 13 R. P. C. 190) the patentee appeared to claim something separately (means for exploding), which, outside of his patent, was certainly old. The House of Lords held that this subordinate claim was intended to be appurtenant to the real invention, and was surplusage which might be disregarded: the patent was therefore upheld. But the patentee who depends upon this benevolent construction of his faulty subordinate claim is in a very risky position; and unless it is clear that the presence of this subordinate integer in a separate claim can only be explained on the supposition (supported by the specification) that it was meant as an adjunct to and as part and parcel of the real invention, then the rule will be let in and the patent will be held invalid. In *Cropper v. Smith* ([1884] 1 R. P. C. 81) the plaintiff's third claim was for a bed-plate connecting the end standards of a lace-making machine. This was manifestly old, but Pearson, J., in the Court of First Instance, thought that such a claim came under the ruling in *Plimpton v. Spiller* (*supra*), and upheld the patent. The Court of Appeal, however, was of a different opinion, and held that the third claim was a separate claim, and had no functional connection with the rest, and that being for an old thing the patent was invalid. Again, in *Cassel Gold Extracting Co. v. Cyanide Gold Syndicate* ([1895] 12 R. P. C. 232), the first claim was for any strength of cyanide of potassium solution "substantially as described," while the second was for a solution of a given strength. Strong efforts were made to get the Court to read the first claim (which, as it stood alone, was bad) as if it were

Occasional relaxation of the rule in the case of subsidiary claims.

*Plimpton v. Spiller.*

*British Dynamite Co. v. Krebs.*

Examples where rule was not relaxed.

*Cropper v. Smith.*

*Cassel Gold Co. v. Cyanide Syndicate.*

limited by the specification and therefore the same as the second claim, which was good. But the Court of Appeal decided that they must be considered as independent claims, and the patent was held bad. In *Electric Construction Co. v. Imperial Tramways Co.* ([1900] 17 R. P. C. 537) an attempt was made to read a separate claim, bad from want of novelty, into the main invention, but without success. In the report of this case there appears an interesting discussion on the principles which guided the decision in *Plimpton v. Spiller (supra)*. According to Lord Alverstone, M. R., the benevolent view of a claim, on the face of it bad, can only be taken when the specification contains such a statement of the existing state of knowledge as to lead the Court to the conclusion that it would be manifestly absurd to suppose that the patentee really meant to claim as novel what at first blush he appears to have claimed. But in this connection it would be wise to note the warning of Lord Davey in *Kynoch v. Webb* ([1899] 17 R. P. C. 100), where he says: "You are not to put a forced construction on the specification as not intending to claim something that is old, because it is foolish or suicidal of the patentee to claim it."

*Electric Construction Co. v. Imperial Tramways Co.*

*Kynoch v. Webb.*

Where the invention is a process the novelty is in the whole process, not in a part; and where the patent is for a mere combination, the novelty must be sought for in the general construction and arrangement, not in the integers. But where an absolutely new and useful feature is included in a combination (like the swing flap in *Proctor v. Bennis* [1887], 4 R. P. C. 333) a mere re-arrangement of the combination, or even a new combination which included the novel feature, would be an infringement.

General rule as to novelty.

The broad rule with regard to novelty is that if the invention has by any means whatever become known in this country to several members of the public not under any obligation of secrecy, either by prior use or by prior publication, no patent can be afterwards granted for it. The reason is that in such circumstances the patentee has nothing to give to the public in return for the grant from the Crown; nor can any such grant deprive the public of the right freely to use what they already possess.

# CHAPTER VII.

## ESSENTIALS IN SUBJECT-MATTER.

### Novelty as Affected by Prior User.

PRIOR use by members of the public (or even by the inventor himself), if effected in a sufficiently public manner, will destroy the validity of any patent granted after the date of such user. As to prior use by the inventor himself, such use to prevail against his right to a patent must be open and unquestionable. Mere experiment in his own closet or workshop, or mere confidential disclosure to or experimental user on his behalf by another, will not destroy the inventor's right. For example, in *Morgan v. Seward* ([1837] 1 Web. P. C. 170; 2 M. & W. 544), the inventor of a paddle-wheel had two pairs of such wheels made for him before the grant of his patent by an engineer whom he had cautioned to keep silence. The wheels were made, packed, and exported before the date of the patent; nevertheless the patent was upheld so far as this issue was concerned. The authorities go to show that the inventor is allowed a reasonable latitude in proving the utility and practicability of his invention before making application for a patent, so long as these experiments do not discover the invention to others who are not in confidential relationship to him. But this doctrine must not be pushed too far. The inventor must not, even experimentally, *use his invention for profit* before protecting it. Thus, in *Germ Milling Co. v. Robinson* ([1886] 3 R. P. C. 254) the plaintiff while under cross-examination acknowledged having sold some flour treated according to his patent process about three weeks before the date of his patent. No one could say that the flour disclosed the process, but the admission of the patentee showed that before the invention had been protected it had been used for profit.

Mere experimental use or confidential disclosure is not publication.

Must not be used even experimentally for profit.

and on this ground the patent was held invalid. The same circumstances vitiated the patent in *Wood v. Zimmer* ([1815] 1 Web. P. C. 44, 82). In *Bells v. Menzies* ([1857-62] 10 H. L. Cas. 117; Good. P. C. 45) the patent was held good although a quantity of the capsules forming the invention had been made in the plaintiff's own works by his own workmen, *but none sold or sent out*. Even absolutely secret user by the inventor personally for profit would avoid a patent subsequently obtained by him or by another. In Dolland's Case (Good. P. C. 175, decided in 1776) the patent was upheld because the prior secret user which was proved to have taken place had been confined to the closet and had never been used for the purposes of profit. The reason why even secret user by one person for profit destroys the novelty of some subsequent patent of another is, that were it otherwise the later inventor could under his grant prevent the former secret user from continuing to do what he had formerly freely done (see the cases of *Heath v. Smith* [1854], Good. P. C. 238; and *Tennish v. Keene* [1835-7], Good. P. C. 127).

But otherwise if goods not sold before date of application.

Secret user not for profit.

Public user might be brought about by sending round the article constituting the invention as a sample (see *Hancock v. Somerrell* [1851], 39 "Newton's London Journal," p. 158), even although no sales were effected; or by manufacturing the article and storing it in a warehouse for the purposes of sale, as in *Mullins v. Hart* ([1852] 3 Car. & K. 297). In *Taylor's Patent* ([1896] 13 R. P. C. 482) revocation followed on proof that the petitioner had used in his own private house, and before the date of the patent, a fireplace similar to that of the respondent.

Circulation ple.

Single user in private house.

Prior user which had been discontinued for a long period of years would, if fully proved, avoid a subsequent patent. In *Deerness v. Fletcher* ([1899] 16 R. P. C. 150) it was proved by three witnesses, one of them a man over eighty, that one water gauge similar to the plaintiff's had been used for a few weeks on a boiler about thirty years before the date of the patent. The works had been broken up, and no vestige of either gauge or boiler remained, so that the proof depended entirely upon the memory of the witnesses. But Romer, J., held the proof to be sufficient,

Discontinued prior user.

and declared the patent to be invalid. In *Haggenmacher v. Watson* ([1897] 14 R. P. C. 349, 631) the evidence of a witness, who spoke to certain alterations he had effected about eight years before the date of the patent, corroborated by two witnesses who had not a perfectly clear idea of what they had seen, was held to invalidate the patent, although in this case also the anticipating apparatus was no longer in existence. *Household v. Neilson* ([1842-3] Good. P. C. 265; 9 Cl. & F. 788), *Guilbert-Martin v. Kerr & Dubb* ([1887] 4 R. P. C. 18), and *re Sinnelle's Patent* ([1898] 15 R. P. C. 761) are cases bearing on the same point. But if such prior user was simply of the nature of an abandoned experiment, and especially if the prior user failed in something accomplished by the subsequent invention, the patent will be sustained. This was held in *Jones v. Pearce* ([1832] Good. P. C. 269), *Edison-Swan v. Woodhouse* ([1887] 4 R. P. C. 79), and *Moseley v. Victoria Rubber Co.* ([1886] 4 R. P. C. 241; 55 L. T. N. S. 482). It was said in *Dunn v. Eley* ([1865-7] L. R. 3 Eq. 496), by Wood, V.-C., that an unsuccessful or only partly successful prior user, which if it had come after the patent would have been held to be a clumsy infringement, might, nevertheless, be no anticipation of the patent.

Examples of cases where anticipating goods were no longer in existence.

Abandoned experiments not anticipations.

Prior user might be clumsy infringement after patent, but no anticipation before.

Another incident of prior user or publication affecting the patent arises where the applicant, after having obtained provisional protection for an invention, and after having under such provisional protection sold and advertised articles in accordance with the invention, drops the first provisional, and, incorporating some important addition or alteration, applies afresh for a patent. The question is, Does user of the original invention during the currency of the first unpublished and abandoned provisional affect the validity of the patent obtained under the second? The answer is, Not if the patent, on the second application, is granted *within the original period of provisional protection*. This was decided in *Oxley v. Holden* ([1860] Good. P. C. 350; 8 C. B. N. S. 666), and was followed by Chitty, J., in *Lister v. Norton* ([1886] 3 R. P. C. 199). The learned Judge, in the latter case, said that such a

Publication during provisional protection afterwards abandoned.

*Oxley v. Holden.*

*Lister v. Norton.*

conclusion might very fairly be drawn from the wording of Section 8 of the Act of 1852, which is practically repeated in Section 14 of the present Act. It is true that Section 8 of the Act of 1852 says that during provisional protection the invention might be "used and published without prejudice to *any* Letters Patent to be granted for the same"; whereas Section 14 of the present Act (which allows of publication under the current application) says "without prejudice to *the* Letters Patent to be granted for the same." It is a nice point whether the use of the definite article in the present section would affect decisions on this question under the present Statute. Might not the use of the word "the" in the section be held to mean the patent under that specific provisional and no other? Under the circumstances set forth it would be advisable to file a Complete Specification with the second application, and get the patent sealed before the expiry of one year from the date of the first provisional. It is at least certain that a claim to a patent for an invention which has been published under the first provisional cannot be kept alive by a series of overlapping provisional protections.

Possible reading of present section.

# CHAPTER VIII.

## ESSENTIALS IN SUBJECT-MATTER.

### Novelty as Affected by Prior Publication.

HAVING shown in the last chapter that undoubted prior public user of an invention destroys the validity of any subsequently granted patent for the same invention, some consideration may now be devoted to the effect of prior publication as distinguished from prior user in the United Kingdom. An invention is held to be published when a description or drawing of it has appeared in any book, newspaper, pamphlet, or specification accessible to the public, and conveying to the minds of persons skilled in the art clear and full information regarding the invention. By such publication the public become possessed of the invention, and no subsequently granted patent for the same thing is valid. Publication might even take place in a Government report, not printed but open to two or three members of the public, as in *Patterson v. Gaslight Co.* ([1875-6] 3 App. Cas. 239; 47 L. J. Ch. 402), where information known only to three co-referees, and embodied in a report, unpublished at the date of the patent, was held to anticipate a patent taken out in the interim between the preparation of the report and its issue.

What constitutes publication.

A lecture delivered to the public and fully describing an invention afterwards patented would constitute prior publication.

Publication by public lecture.

Without citing the innumerable authorities on prior publication it will be sufficient to state the law as crystallised by Tindal, C. J., in *Stead v. Williams* ([1843-4] Good. P. C. 437; 13 L. J. C. P. 218): "If the invention has already been made public in England by a description contained in a work, whether written or printed,

Tindal, C.J., on what constitutes publication.

which has been publicly circulated in such a case the patentee is not the first and true inventor within the meaning of the Statute."

Publication might be in a foreign language.

It is not necessary that the publication should have been printed or issued in this country. It might be a foreign book or journal, and be printed in a foreign language. In *Lang v. Gisborne* ([1862] Good. P. C. 278; 31 Beav. 133) a patent for a self-registering target was upset by prior publication in England of a French book: and in *Harris v. Rothwell* ([1887] 4 R. P. C. 225; L. R. 35 Ch. D. 416) a knitting machine patent was held invalid because of the presence in the Patent Office Library of a German specification which described a similar invention. But the prior publication must be in a language ordinarily known to educated Englishmen. Apparently a book or specification in Arabic or Chinese would not do.

If open to public, not necessary to prove actual perusal of publications.

Granted that the prior publications are accessible to the public it is not necessary to prove that they have ever been consulted (*United Horseshoe Nail Co. v. Stewart & Co.* [1885], 2 R. P. C. 122). But if, instead of being shelved and catalogued, the book has lain away in some chest or back room, its presence unsuspected until rooted out in a search for anticipations, it has been held that this could hardly be called prior publication—*Hinks v. Safety Lighting Co.* ([1876] 4 Ch. D. 607); *Hinks v. Mabeledason* ([1875-6] Good. P. C. 374; L. R. 20 Eq. 37); *Otto v. Steel* ([1885-6] 3 R. P. C. 109; L. R. 31 Ch. D. 241).

Publication by drawing.

A drawing published prior to the patent and clearly illustrating the subject-matter, though without any description, would anticipate the patent. This was held in *Hornburger v. Squire* ([1889] 6 R. P. C. 194), and in the more recent case of *The Electric Construction Co. v. The Imperial Tramways Co.* ([1900] 17 R. P. C. 537).

In any case of prior publication the alleged anticipation must be sufficiently full and clear to enable a person skilled in the art to carry the invention into practical effect without

Mosaic of anticipations.

requiring to make experiments. Nothing less will do, and a patent cannot be upset by choosing a portion from one prior publication and a portion from another, and combining them so as to make up the invention it is desired to assail. In *Von Heyden v. Neustadt* ([1880] L. R. 14 Ch. D. 230;

50 L. J. Ch. 126) James, L. J., said: "If it requires this mosaic of extracts from annals and treatises spread over a series of years to prove the defendant's contention, that contention stands thereby self-condemned." Chitty, J., was of a similar opinion in *Moseley v. Victoria Rubber Co.* ([1887] 4 R. P. C. 241; 55 L. T. N. S. 482).

"Paper anticipations."

Where a prior specification or publication has been brought forward by the defendant, but which does not appear to have been carried commercially into effect, and does not exactly describe the plaintiff's invention, one frequently hears the depreciatory remark that it is "a mere paper anticipation," as if this were a separate kind of anticipation not subject to the rules holding good in other classes of prior discovery to the public. But granted that this alleged "mere paper anticipation" substantially discovers the invention, the phrase is meaningless, and the prior publication, although only on paper, is as effective as if the invention had been made commercially. Speaking on the subject of so-called paper anticipations Lord Westbury said, in *Hills v. Evans* ([1862] Good. P. C. 248; 31 L. J. Ch. 457). "The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information." Groves, J., in *Philpott v. Hanbury* ([1885] 2 R. P. C. 33), went a little further than this, and was of opinion that if the prior publication is read and understood by "the highest class of skilled workmen" to indicate the subsequent invention, it will suffice as an anticipation. Kekewich, J., in the later case of *Thomson v. Macdonald* ([1890] 8 R. P. C. 5), seems independently to have adopted the same view, and said that a prior specification, even although not so full and complete in its directions as the subsequent specification, and even although it had never been used practically, might nevertheless be sufficient for the purposes of anticipation. Then, in *The Anglo-American Brush Electric Co. v. King, Boura* (9 R. P. C. 313; [1892] A. C. 367), Lord Watson said of a so-called "paper anticipation": "The sufficiency or insufficiency of the prior

*Hills v. Evans.*

*Philpott v. Hanbury.*

Skilled workman test.

A specification less complete than the plaintiff's and never used might be an anticipation.

Even an insufficient

specification might anticipate.

specification for that purpose does not afford a crucial test of prior publication": *i.e.* it may be insufficient as a specification but sufficient as an anticipation (see also Lindley, L. J., in *Savage v. Harris* [1896], 13 R. P. C. 361).

Reasons deduced from the cases.

Thus an analysis of the cases dealing with so-called paper anticipations yields the result that if the prior publication instructs "the highest class of skilled workmen" (to quote Groves, J.) sufficiently to carry out the invention, even although it has never been used practically, and even although the specification as a specification may show defects in sufficiency, it may nevertheless constitute an anticipation.

Patent Office abridgments.

The field which should be most carefully scanned in searches to fortify or break down claims to novelty in a specification is that afforded by the Patent Records and published specifications of British and Foreign patents. The classified indexes and abridgments of subject-matter which, together with the specifications, may be consulted at the Patent Office Library and at the public libraries of most large towns render such a task comparatively easy.

# CHAPTER IX.

## REMAINING ESSENTIAL IN SUBJECT-MATTER.

### Utility.

Meaning of "Utility."

THE remaining element in subject-matter is Utility. By "Utility" is not meant the mere capacity to be put to a useful or profit earning purpose. Thus, as Kekewich, J., pointed out in *Cole v. Saqui* ([1888] 5 R. P. C. 489) (a Toy Case), "the amusement of children is a useful thing." But utility is not in itself sufficient to impart patentability to a new analogous arrangement of an old thing (*Morgan v. Windover* (1890), 7 R. P. C. 131); invention also is required. Utility, according to Groves, J., means "an invention better than the preceding knowledge" (*Young v. Rosenthal* (1884), 1 R. P. C. 29), and means usefulness for the purpose indicated by the inventor. As was said by Lindley, L. J., in *Lane-Fox v. Kensington Co.* ([1892] 9 R. P. C. at p. 417), "Utility is often a question of degree, and always has reference to some object. Useful for what? is the question which must be always asked; and the answer must be: Useful for the purposes indicated by the patentee." Thus, in *Easterbrook v. Great Western Railway Co.* ([1885] 2 R. P. C. 201), it was demonstrated that the plaintiff's railway signal lock was liable, in certain circumstances, to such error as to make it a possible source of danger. The patent was, on these grounds, held void for want of utility. In *Tubeless Tyre Co. v. Veuch* ([1899] 16 R. P. C. 291) it was shown that, without the use of a subsequently invented soft soap seal (which was not indicated in the specification), a claimed form of the split tyre cover leaked under air pressure. Byrne, J., in giving judgment for the defendants said (see page 311 of Report): "You must have utility in the sense of the article being useful for

Utility alone not sufficient.

Must be useful for the indicated purpose.

Failure of utility avoids the patent.

Subsequent improvement cannot be called in to make up absent utility.

the purpose for which the inventor designed it." Incidentally, this case establishes the proposition that a patentee cannot call in subsequent invention to make useful that which, according to and at the date of his original specification and claim, was not useful. In other words, as was said by Lord Esher in *Nobel v. Anderson* ([1894] 11 R. P. C. 519), "The specification must be construed as of the day after publication" (see page 523, line 10). The learned Master of the Rolls probably meant to say "the day of *application*."

Utility a question of fact.

Commercial success not conclusive.

The utility of an invention is always a question of fact and a matter of proof. The satisfying of a public demand and the commercial success of a patent are strong, although not conclusive, evidence of utility (*Ehrlich v. Ihlee* [1888], 5 R. P. C. 198; see also *Cassel Gold Extracting Co. v. Cyanide Gold Syndicate* [1895], 12 R. P. C. 232, and *per* Wills, J., in *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.* [1897], 14 R. P. C. 757).

Amount of utility may be small, but sufficient.

The amount of utility in an invention may be very small, but yet enough to support the patent. This was held in *The American Braided Wire Co. v. Thomson* (*supra*); and in *Philpott v. Hanbury* ([1885] 2 R. P. C. 33) Grove, J., said that "the slightest amount of utility—I will not say an infinitesimal scintilla but a very slight amount of utility—is sufficient to maintain a patent."

Utility not always evidenced by an advance in the same direction.

A patent may even be supported for something which seems on the face of it retrogressive rather than an advance. Thus, in *Welsbach Incandescent Gas Light Co. v. New Incandescent Co.* ([1900] 17 R. P. C. 237), a mantle of higher illuminating power was replaced by a mantle of lower illuminating power but of greater durability than the former mantle. Buckley, J., expressed himself that the advantage of durability, though combined with less lighting power, constituted such utility as would support the patent.

Non-utility in one claim invalidates the whole.

Care should be taken in preparing the specification to keep the claims confined only to those parts of the invention which carry utility, remembering that non-utility in the subject-matter of one claim will wreck the whole. In *United Horse Shoe Nail Co. v. Swedish Horse Nail Co.*

([1888] 6 R. P. C. 1) the plaintiff's patent was declared void because the sixth claim referred to a mode of punching nail blanks which the evidence demonstrated could not be carried out in an economical and useful manner. In *Parkinson v. Simon* ([1895] 12 R. P. C. 403) non-utility in the sense of not being effective for the indicated purpose caused the subject-matter of two claims, and consequently the whole patent, to be held bad.

Old case on non-utility of one subordinate claim.

*Lewis v. Marling* (Good. P. C. 281; 1 Web. P. C. 493; 4 Car. & P. 52, 57) is apparently a ruling that if a subordinate and *non-essential* part of an apparatus has been claimed and should afterwards turn out to be unnecessary surplusage, the patent would not be held invalid on the ground of want of utility. *Per* Lord Tenterden: "It would be very hard to say that this patent should be void because the plaintiffs claim to be inventors of a certain part of the machine not described as essential, and which turns out not to be useful." But this is an old case (1829) and should be considered with caution.

Infringement as evidence of utility.

The mere attempt of the defendant to infringe has been construed as evidence of the utility of the thing infringed. As Kay, J., said in *Lucas v. Miller* ([1885] 2 R. P. C. 155): "Better evidence of the utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it."

# CHAPTER X.

## THE SPECIFICATION: TITLE.

HAVING reviewed in the preceding chapters the essentials of subject-matter in patentable inventions, we may now proceed to consider the preparation of the specification and claims which constitute the instrument whereby the invention is described and ascertained.

The origin of the specification has already been indicated and an attempt made to contrast the advantages and disadvantages of filing a Provisional or a Complete Specification with the application (see Chapter II.). In dealing with the specification it will be assumed that the usual course of filing a Provisional Specification with the application is followed. The present and the three following chapters will deal successively with the Title, the Provisional Specification, the Complete Specification, and the Claims.

### TITLE.

In making an application for a patent the first thing that requires to be settled is the Title of the invention. This is an important point, and care should be taken to choose a title which will be properly descriptive. Fortunately, under present practice there is little chance of going wrong in this particular. The Patent Office Examiners will decline to accept a title which is not in their opinion sufficiently descriptive, and the Comptroller has power to decline to date and number such imperfect application. It might therefore happen that the applicant would find himself delayed and hampered by defects in his title.

Title should be neither too wide nor too narrow.

In choosing a title the applicant should seek to make it wide enough to cover all that he has invented without trying to spread his net over too large an area. Vague generalities are to be avoided, but on the other hand the

inventor must not run to the other extreme of making his title too narrow. The supervision exercised by the Comptroller is, as a rule, so discreetly exercised that very few questionable titles are passed. Even where the title is not all that could be desired, a defect in the title is seldom seriously urged in legal proceedings. Hence it has arisen that the old cases of *Cochrane v. Smethurst* (1816) (Good. P. C. 124): *Felton v. Greaves* (1829) (Good. P. C. 193): *Bar v. Metcalf* (1 Web. P. C. 141 n.): *Crampton v. Benyon* (6 B. Mon. 71: Good. P. C. 103), and others, where patents were held bad on account of defects in the title, are now to some extent of academic interest only.

Example of objection to rule.

In *Pirrie v. York Street Flax Spinning Co.* (1893) (10 R. P. C. 34) the defendants took objection to the title of the plaintiff's invention, "Improvements in wet spinning for flax or yarns," on the ground that it was actually winding and not spinning that took place on the cop. But the Court rebutted the objection, pointing out that the spinning took place simultaneously with the winding.

Objections to defective title still hold good.

But it must on no account be forgotten that where, in spite of the indicated safeguards, it turns out that the specification and claims contain matter clearly outside of the title, the validity of the patent will be in the greatest jeopardy. For example, if the title were "Improvements in apparatus for the manufacture of paper," and the specification and claims referred also to a process appurtenant to the invention but not absolutely hingeing on the use of the described mechanism, it would no doubt be a grave question whether the patent could be upheld. The proper title in such a case would be "Improvements in the process of and in apparatus for manufacturing paper."

No "fancy" titles accepted.

The applicant may not use a fancy name in the title to designate his invention. In examining the *Official Journal* one frequently comes upon such titles as "The 'Simplex' Bottle Stopper." "Smith's 'Triumphal' Cue Tip," or "The 'Nokorko' Screw Tap." This is ingenuity wasted, for all such titles are disallowed by the Comptroller, and the applicant requested to amend his papers in this respect. The proper titles would be "An Improved Bottle Stopper": "Improvements in Billiard Cues," &c.

# CHAPTER XI.

## THE PROVISIONAL SPECIFICATION.

SINCE its introduction under the Amendment Act of 1852 the Provisional Specification accompanying the application has been made use of in the bulk of cases, in so far at least as the applications of British inventors are concerned. Under the present Act the conditions governing the Provisional Specification are practically the same as before. Now, as then, the Provisional must sufficiently ascertain the nature of the invention. This does not mean that a mere intimation of the inventor's object will suffice. Suppose, for instance, the applicant had invented some improvement in friction clutches, it would not suffice to say in his Provisional Specification: "My invention relates to friction clutches," and stop there. He must go a little further, and state what the invention is in as general terms as he pleases, but at least he must say enough to earmark the invention and enable it to be identified with the apparatus to be afterwards more fully described and illustrated in his Complete. It is a vice in a Provisional Specification to describe the invention so minutely that it only needs the insertion of the letters of reference on a drawing to transform it into a Complete Specification. In a properly framed Provisional sufficient elasticity is left to include and admit of after modifications in detail, and even of general arrangement. In too precise and detailed a Provisional the inventor often finds himself bound hand and foot when preparing his Complete, and if he includes modifications and additions to any extent he may well fear the creation of apparent disconformity between the Provisional and Complete Specifications.

The Provisional Specification should simply ascertain the nature of the invention.

It should not describe the invention too fully.

Room should be left for modification.

The object of the period of provisional protection is to enable details and improvements to be made and elaborated by means of practical experiment, but that privilege may

Object of provisional protection.

be wholly defeated by being too precise in the Provisional description. As Hyles, J., said in *Newall v. Elliot* (1858) (Johns. P. C. 320; 27 L. J. C. P. 337); "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." And again, *per* Mr. Justice Fry, in *United Telephone Co. v. Harrison* (1882 (Johns. P. C. 472; L. R. 21, C. D. 720): "In a Provisional Specification you must find the nature of the invention described, though it need not be described otherwise than roughly, so long as it is fairly described." According to Mr. Justice Romer, in *Pneumatic Type Co. v. East London Rubber Co.* (1898) 14 R. P. C. 77): "It is not necessary in the Provisional to detail the advantages of the invention."

Fry, J., on the office of the Provisional.

Advantages need not be set out.

The Provisional Specification remains a secret document until published with the Complete. If no Complete is filed the Patent Office apparently preserves the Provisional for some time, as in *Pneumatic Type Co. v. English Type Co.* (1897) 14 R. P. C. 351) an official of the Patent Office produced on behalf of the plaintiffs, and on being called for by the Judge, a Provisional Specification filed nearly seven years previously.

Provisional a secret document.

# CHAPTER XII.

## THE COMPLETE SPECIFICATION.

The Complete must particularly describe the invention.

THE Provisional Specification having broadly set forth the invention, it remains for the inventor in his Complete Specification to "particularly describe and ascertain the nature of the invention and in what manner the same is to be performed" (Act of 1883, Section 5, Sub-section 4).

Must not extend beyond scope of Provisional.

In considering a Provisional Specification upon which it is proposed to found a Complete Specification the first duty of the draftsman is to ascertain and digest the title and contents of the Provisional, and then to see that the matter of the Complete upon which it is proposed to found claims does not extend beyond the scope of the Provisional. If it does, disconformity would be the result, and disconformity between the Provisional and Complete Specifications is fatal to the validity of the patent.

Disconformity fatal to patent.

Said Lord Halsbury, in *Vickers v. Siddell* (1890) 7 R. P. C. 292; 15 App. Cas. 496): "It is suggested that the new machinery of the Comptroller and the Examiners has superseded the power of raising any objection to the conformity of the Complete and Provisional Specifications. I am unable to take that view. I think it is an essential condition of a good patent that the invention described in the Provisional should be the same as that in the Complete Specification, and I think that the third sub-section of Section 26 preserves that as a ground upon which a patent may be revoked."

Thus the present practice follows the old, and, as a matter of fact, disconformity between the Provisional and Complete Specifications is a not infrequent cause of the invalidity of patents. The following are a few of the cases in which disconformity was held to have been proved:—

Examples of disconformity.

*Bailey v. Roberton.*

In *Bailey v. Roberton* (1878) 3 App. Cas. 1055) the Provisional described a meat preservative as made from

gelatine mixed with bisulphite of lime. In the Complete not only was this composition claimed, but also a solution of bisulphite of lime *alone*. Patent held invalid.

In *Nuttall v. Hargreaves* (1891, 8 R. P. C. 273, 450; 61 L. J. Ch. 94; 1892, 1 Ch. 23) a gauze strainer for a beer tap, not mentioned in the Provisional, was claimed in the Complete. Patent held invalid. *Nuttall v. Hargreaves.*

In the *Cera Light Co. v. Dobbie* (1892, 11 R. P. C. 10) the Provisional described a metallic conductor of heat in a lamp as placed *near* the wick holder. The Complete described it as in metallic *contact* therewith. The patent was held bad for disconformity. *Cera Light Co. v. Dobbie.*

In *Brooks v. Lamplugh* (1897, 15 R. P. C. 33) the Provisional of one of the plaintiff's patents described a cycle saddle carrier radially adjustable on a pin. The Complete claimed an eye with trunnions where the radial adjustment had no place. The patent was held bad. *Brooks v. Lamplugh.*

The Provisional Specification in *Castner-Kellner v. Commercial Development Co.* (1900, 17 R. P. C. 593) described a *stationary* mercury cathode with moveable bells. The Complete claimed a *moveable* mercury cathode. The patent was held bad. *Castner-Kellner v. Commercial Development Co.*

In *Tubeless Tyre Co. v. Trench Tyre Co.* (1899, 16 R. P. C. 291) the Provisional detailed various forms of automatically sealed joints in split tubeless tyres, the joints being all made by contact of rubber with rubber. The Complete claimed a modification, where the seal was made between the rubber and the metal of the rim. The patent was held invalid both for disconformity and non-utility. *Tubeless Tyre Co. v. Trench.*

The case of *Lane-Fox v. Kensington & Co.* ([1892] 9 R. P. C. 413) may also be referred to as an example of disconformity. *Lane-Fox v. Kensington & Co.*

But it is only where the substantial purpose of the inventor has been departed from or exceeded and something like a new invention introduced that disconformity holds good. Improvements in details, so long as these are not of the nature of separate inventions but are directed towards and confined to the main object of the improvement, are not causes of disconformity (*Carter v. Leyson* [1901], 18 R. P. C. 508).

Examples of discontinuity not made out. *Lucas v. Miller.*

Thus, in *Lucas v. Miller* (1888, 2 R. P. C. 150), which related to a patent for a bicycle lamp, the inventor in his Complete described certain clip washers which were important improvements in his method of suspending the lamp to the wheel hub. These washers were not referred to at all in his Provisional, but were claimed as part of his combination in the Complete Specification. The defendant pleaded disconformity, but Kay, J., held that by virtue of their close functional connection with the lamp these washers constituted an improvement which the inventor was right in describing and justified in claiming. Again, in *Woodward v. Sansum* (1887, 4 R. P. C. 160), where the patentee had included in his Complete Specification and claims features which were admittedly improvements not referred to in his Provisional but which made his pencil more useful, the patent was upheld, Cotton, L. J., saying that "A patentee putting in a Provisional Specification showing the nature of his invention is not bound to describe therein any mode of carrying it into effect, but if he does so and before filing his Complete discovers an improvement upon such mode, or discovers a different mode, he is bound to give to the public in his Complete Specification the benefit of what he has discovered as to the mode of carrying the invention into effect."

*Woodward v. Sansum.*

*Welch Dunlop Tyre Case.*

The well-known Welch tyre patent was challenged on the ground of disconformity in *Pneumatic Tyre Co. v. East London Rubber Co.* (1897, 14 R. P. C. 373). There is no doubt that at the date of the Provisional the inventor contemplated the application of his improved wire-edged cover to rubber treads only. In his Complete he claimed it as applied to pneumatic tyres also, and the Court of Appeal held he was justified in so doing.

*Gadd v. Mayor of Manchester.*

Objections on the ground of disconformity were also raised to the plaintiff's patent in *Gadd v. Mayor of Manchester* (1892, 9 R. P. C. 249, 516), the patentee having described and claimed mechanism for supporting gasometers which, as far as concerned Fig. 16 of the drawings, was not in the Provisional. But the Court of Appeal dismissed the objection and upheld the patent. Lindley, L. J., in delivering judgment, said: "The whole object of

provisional protection is to enable a patentee to work at and improve his invention. The only limit set to what he can do in this respect is that the invention as finally specified must not be a different invention from that provisionally protected."

Post-provisional improvement should not be separately claimed.

But an additional improvement of this sort should always be claimed as part of or combined with the main invention. If claimed *per se*, and especially if claimed as applicable to other apparatus, it is a separate invention and would create disconformity.

Example of faulty claim.

When proposing to claim any such post-provisional addition or improvement let the patentee be sure that it properly arises out of and is a legitimate development and part of the original invention, not a mere incident to it. In *Osmonds, Limited v. Belmont Cycle Co.* (1898 15 R. P. C. 305) the patentee having by his improved chain-adjusting gear displaced the ordinary footstep on the rear axle placed the footstep on another convenient part, no invention being required to do so. This re-arrangement of the footstep was not mentioned in the Provisional. Nevertheless, in preparing his Complete Specification the inventor claimed the chain adjusting gear in combination with the step in its new position. Chitty, J., remarked that the patentee might as well have said: "I claim that gear with a hat on a man's head." The step had clearly nothing to do with the chain-adjustment gear, and if instead of the step the inventor had devised some post-provisional improvement in the handle bar he might as logically have claimed this in combination with the chain adjustment. The patent was held bad.

*Osmonds, Limited v. Belmont Cycle Co.*

An essential even in a combination may create disconformity.

But let this be noted, that a part not mentioned in the Provisional and forming an essential or the essential element in a combination as described and claimed in the Complete would, even as part of a combination claim, create disconformity. For example, if in *Procter v. Bennis* (1887) 4 R. P. C. 333) the pivoted swinging flap had not been mentioned in the Provisional, but had been described and claimed in the Complete, even as a part of the combination, there is no doubt that as soon as the essential nature of

*Nuttall v. Hargreaves.*

the pivoted flap became apparent in the light of the evidence, disconformity must have been held. In *Nuttall v. Hargreaves* (*supra*) the Court, in compliance with the arguments of the plaintiff, read the combination claim as including a wire-gauze strainer not mentioned in the Provisional but described in the Complete, and which turned out to be the essential feature of the whole tap. The result was that the Court held that, even when an essential feature not in the Provisional was wrapped up in a combination claim in the Complete, disconformity followed. This also was held in the later case of *Adams v. Stevens* (1898 16 R. P. C. 223).

*Adams v. Stevens.*

Complete must be sufficient and full.

Another point to be observed in preparing the Complete Specification is that it must be sufficient and full.

When an applicant files his Complete he is fulfilling his part of a contract with the public. On the one hand he gains the exclusive monopoly of his invention for a fixed period of fourteen years. For that privilege he undertakes, by means of his specification, so to instruct the public that at the end of his monopoly they will be able to use his invention as fully and advantageously as himself. Therefore, any ambiguity, suppression, or misdirection is a breach of faith, which only requires to be laid bare to destroy the privilege.

Complete must be prepared in good faith.

Accordingly, all specifications should be prepared in as transparently honest a manner as possible, and with all the marks of anxiety on the part of the patentee thoroughly to instruct his readers in the best methods known to him at the time of carrying his invention into effect.

Reasonable skill and knowledge.

Reasonable skill and knowledge must be apparent in the preparation of the specification, and a patentee will not be excused for shortcomings on account of ignorance. Specifications and drawings must be prepared so as to be intelligible and complete, and the Court will not study to piece together what it was the duty of the inventor to make plain.

Examples of bad specification. *Hill v. Evans.*

In *Hill v. Evans* (1893 10 R. P. C. 337) the specification turned out to be so badly prepared that the Court was satisfied that the nature of the invention had *not* been properly ascertained. "Can anybody," said Hawkins, J., "reading this specification.

form any judgement as to what the object of the invention is? . . . The more I look at it the more satisfied I am that both the Provisional and the Complete Specifications are absolutely wanting in the essential features which ought to present themselves upon both Provisional and Complete Specifications, and I therefore hold that it is bad for that reason."

Specification addressed to skilled persons.

The specification is addressed to persons who are competent to understand and carry out processes or manufactures akin to the subject-matter of the patent. As Lord Eldon said in *Harmar v. Playne* (1807 Cimod. P. C. 219; 14 Ves. 130): "No sort of specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch." Therefore it is not necessary that technical terms and trade expressions should be explained, unless they are more than ordinarily obscure or uncommon. Thus, if the invention deals with electricity, the inventor may use the scientific and accepted terms common among electricians: if with chemistry, those terms which are common knowledge with chemists. So in an invention connected with a loom, for example, the patentee may safely presuppose an acquaintance on the part of his readers with the ordinary mechanism and operations of weaving. For it would be insufferable that a chance mention of a shuttle, reed, picking-stick, or weft fork, should be a signal for the writer to stop and carefully explain to the reader what these were.

Construction of sufficiency of specification.

As a development of this implied knowledge on the part of the reader the Courts have in turn come to assess the sufficiency of a description by what is known as "the ordinary working test."

This means that a Complete Specification will be held to be sufficient in law if the directions are plainly enough given to enable a person of average intelligence, *and conversant with that particular industry*, to carry the invention into effect.

Lord Cairns on sufficiency.

As was said by Lord Cairns in *British Dynamite Co. v. Krebs* (1879 Cimod. P. C. 88; 13 R. P. C. 190): "When the nature of the invention is ascertained by the Court as a

matter of construction the Court has then to enquire whether the manner in which the same is to be performed is sufficiently described in the Specification to the comprehension of any workman of ordinary skill in the particular art or manufacture; and this the Court can best do by the evidence of workmen of that description and by the evidence of what workmen of that description have actually done under the patent."

Skilled workman test.

The reader is not to be called upon to exercise extraordinary intelligence or invention, or to fill in evident gaps left by the patentee. But he must duly exercise his trade knowledge and trained intelligence as a workman in interpreting the instructions of the patentee. In *Crossley v. Beverley* (1829) 3 C. & P. 513; Good. P. C. 1301) the defendants asserted that the description of a gas-making apparatus was incomplete because no mention was made of the condenser. Lord Tenterden, C. J., brushed this objection aside, saying that "a workman who was capable of making a gas apparatus would know that he must put in a condenser."

Extent of error not fatal.

To go a little further than this, it may be said that where a patentee in his description makes an error which is on the face of it an error, and which could not possibly mislead anyone acquainted with the subject-matter, such error will not vitiate his patent.

But not so with errors not evident.

This was the opinion of Lord Westbury, L. C., in *Simpson v. Holliday* (1866) 12 L. T. N. S. 99; Good. P. C. 425). But his lordship nevertheless went on to say that this was not a correct statement of the law when applied to errors which were only discoverable by experiment and further inquiry.

Provision may be made for reasonable variations.

In a Complete Specification a patentee is not tied down to exact and definite proportion or detail if the nature of the invention reasonably admits of variation. Thus, in the description of a new alloy, the proportions of metal to form the alloy should be stated specifically; but where variations might be made in these proportions without essentially affecting the nature or utility of the alloy, it is quite permissible for the patentee to say so and to indicate the limits within which such variations

might be made (*Patent Type Founding Co. v. Richards* [1860], 6 Jur. N. S. 39; Johns. 381; Good. P. C. 3001). On the same grounds a combination claim, consisting of several parts, would not be defeated by mere variation or substitutes where the characteristics of the combination were preserved. In short, whether in mechanical or chemical combinations or processes, a reasonable latitude will always be allowed in construing the specification.

Drawings.

Wherever a Complete Specification can be made more easily understood by the addition of drawings these should be incorporated.

It was said by North, J., in *Lawrence v. Perry* ([1865] 2 R. P. C. 179), that drawings are not an absolute necessity even for the explanation of mechanical patents. But the patent in question was under the Act of 1852, and Sub-section 4 of Section 5 of the present Act says that a Complete Specification *must* be accompanied by drawings if required. Nevertheless, a specification dealing with an appliance improvement has been held by Chitty, J., to be sufficient, though no drawings were annexed (*Savage v. Harris* [1901], 18 R. P. C. 300). There is little doubt, however, that it is, if not essential, extremely desirable that drawings should be used wherever possible. Language is at the best a very poor and misleading substitute for a representation of the thing itself, and, besides, a faithful and careful drawing is of use in explaining what might otherwise be an ambiguity in the description. Thus, if the descriptive part were to tell the reader something which is absurd perhaps something so misleading that if it stood alone the very validity of the patent might be imperilled if that misleading statement is coupled with a reference to the drawing the error in the description can be explained and neutralised, so long as the drawing is so unmistakeably clear and correct that a competent person can at once see for himself that a mistake has been committed. An omission in the drawing of one small air hole, which was an essential of the invention, upset the patent in *Hinks v. Safety Lighting Co.* ([1876] L. R. 4 Ch. D. 607; 46 L. J. Ch. 158; Good. P. C. 252); but in *Otto v. Linford* ([1881] 46 L. T. N. S. 35; Good. P. C. 313) an obvious

Advantages of drawings.

*Hinks v. Safety Lighting Co.*

*Otto v. Linford.*

error in the drawing which would not have deceived an engineer was not allowed to prejudice the patent.

Object of drawings.

In making a drawing the great object should be to clearly illustrate the subject-matter of the invention. This is sometimes so far lost sight of that an inventor, in illustrating an improvement in locomotive furnace bars for example, is content with nothing less than giving several complete views of an entire locomotive engine and tender. The result is, that the illustrations of the improved bars are dwarfed and the specification encumbered by the presence of matter that has nothing to do with the invention.

Hints on the preparation of drawings.

Perspective drawings or isometrical projections are much in evidence in American specifications, and should be used where possible, as these appeal to the understanding of a much wider class than is the case with purely mechanical drawings.

Reproduction of drawings by photography.

As the drawings attached to the specification are now reproduced by photography, and generally to a reduced scale, it is incumbent upon the patentee to see that his drawings are neat, black, clear, and distinct, and to be as large a scale as the prescribed sizes of sheet will conveniently hold. The lettering should be large and carefully formed, and each letter should unmistakeably indicate the part referred to.

Provisional drawings may serve for complete.

It should be mentioned that under Subsection 1 of Section 5 of the present Act (Section 2 of the Act of 1888) it is prescribed that when drawings have been filed with the Provisional Specification these drawings can be referred to in the Complete Specification without the necessity for filing fresh copies of the drawings.

Difficulty of distinguishing old from new.

In pursuance of the advice already given, as to the exercise of absolute good faith in preparing the Complete Specification, it might be useful also to point out the advantage of distinguishing the old from the new in a specification, especially where a combination is concerned. As Cresswell, J., says in *Wilson v. Rastall* (1852) 1 Web. P. C. 627; 11 L. J. C. P. 177; 6 Scott, N. C. 214): "Every party is bound to tell the public clearly by his specification what he claims, and what they may do or may not do without risk of an action for infringing his patent."

*Macfarlane v. Price.*

In *Macfarlane v. Price* (1816) 1 Web. P. C. 74; 1 Stark. 199; (Good. P. C. 204) certain improvements in umbrellas and parasols were described, no distinction being made as to which of the details were new and which were old. The patent was alleged to be infringed by the use of a certain part shown in the drawings, and admittedly of the essence of the invention. But Lord Ellenborough, C. J., nonsuited the plaintiff on the ground that no one could be fairly expected to gather from the specification what the novel parts really were.

*Bovill v. Bostock.*

So in *Bovill v. Bostock* (1863) 4 De G. J. & S. 238; 10 L. T. N. S. 141; (Good. P. C. 209) certain improvements in a sewing machine were so described that Lord Westbury held that no one could properly distinguish between what was new and what was old, and on that account declared the specification insufficient. Again, in *Harrison v. Anderston Foundry Co.* (1876) (Good. P. C. 221; L. R. 1 App. Ca. 574), in which *Bovill v. Bostock* was discussed, Lord Hatherly laid it plainly down that where the improvement was merely in an integer in an otherwise known combination, it was the duty of the patentee to lay his finger on the new part and tell the public that this was his improvement. This differentiating of the new from the old need not, of course, be carried out where common knowledge or the knowledge of the ordinary skilled workman is sufficient to identify the old parts.

*Harrison v. Anderston Foundry Co.*

*Where elements of combination may be new or old.*

For example, if the invention refers to a new equilibrium valve for governing the passage of steam to the valve chest of a steam engine, and the specification describes the valve in connection with an ordinary ball governor, it would not be necessary to disclaim the governor, for every one knows how old that is. But if the valve itself were partly old, it might be necessary to point out what parts of the valve were new and constituted the improvement. As regards an improvement upon a foregoing invention or existing patent, it will be sufficient, for the purposes of differentiation between old and new, to indicate the specification of the first invention.

Examples where differentiation held not to be obligatory.

*Goddard v. Lyon.*

*Hookham v. Johnson.*

Before leaving the question of differentiating the old from the new, it must *per contra* be pointed out that the newer practice does not always adhere to the older precedents. For instance, in *Goddard v. Lyon* ([1894] 11 R. P. C. 354) Lord Watson said that a "patentee is not *bound* to state what is new and what is old," and *per* Wills, J., in *Hookham v. Johnson* (1897 14 R. P. C. 525), "a patentee is not bound in a combination claim to distinguish between new and old parts in the combination."

But *contra* in *Kynoch v. Webb.*

But that the old and useful rule cannot be safely disregarded was recently shown in *Kynoch v. Webb* (1899 17 R. P. C. 100), where the plaintiff's patent was upset in the House of Lords mainly on the ground that the specification did not distinguish the new from the old in a combination.

Inutility of alternative method avoids patent.

When two or three methods of carrying an invention into effect are described in the specification, and one of them turns out to be useless, the patent is invalid. In *Simpson v. Holliday* (1865-6 Giood. P. C. 425; 12 L. T. N. S. 99; L. R. 1 H. L. 315) a cold and a hot process for the production of a dye were described in the specification and claimed. The cold process turned out to be useless, and the patent was held invalid on that account.

Construction of specifications.

In construing specifications of Letters Patent for inventions the practice of the Courts seems to have gone through a pendulum-like swing before settling down to the present rule of reasonable and fair construction. In former times Letters Patent for inventions suffered from the vestiges of that odium which attached to the bad old monopolies. As a result, when a patent came into Court it was subject to the most keen and searching scrutiny. The leaning of the Court was always dead against the patentee and in favour of the public. This

Former modes of construction.

might be termed the period of *malevolent* construction of specifications. But early in the present century more liberal conceptions concerning the inventor and his mission began to prevail, and the practice of the Courts swung into what has been called the *benevolent* construction.

Present practice in

That, in its turn, has been succeeded by a very evident determination on the part of the Court to allow itself to be

construing specifications.

influenced neither by the benevolent nor the malevolent theory of construction, but to give fair consideration to the meaning of the language employed, and to decide accordingly.

In *Cropper v. Smith* ([1884] 1 R. P. C. 81; 26 Ch. D. 700; 10 App. Ca. 249) Bowen, L. J., gives an excellent exposition of the rules governing the Courts at this date.

Chitty, J., on construction.

Chitty, J., in *Lister v. Norton* ([1886] 3 R. P. C. 203), speaking of the construction of a specification, says: "It ought to be construed, like any other legal document, as a whole. It certainly ought not to be construed malevolently; I will not say it ought to be construed benevolently; I do say it ought to be construed fairly. It must be read by a mind willing to understand, not by a mind desirous of misunderstanding." Cozens-Hardy, J., in *Electric Construction Co. v. Imperial Tramway Co.* ([1899] 16 R. P. C. 631), said: "A specification ought, I apprehend, to be regarded in the same manner as any other document which has to be interpreted by the Court it must be looked at as a whole. The claims must not be looked at as if they stood alone. A strained and unnatural interpretation must be avoided."

Any part of the invention which has been indicated in the Provisional Specification may be abandoned or disclaimed in the Complete.

# CHAPTER XIII.

## CLAIMS.

Claims required by the Act of 1883.

NEXT to a clear and comprehensive setting forth of the invention in the body of the Complete Specification the most important task of the patentee is the framing of the claims, by which he points out and fences off the real fruits of his brain. Prior to the present Act of 1883 it was not necessary to conclude the specification with claims, although, for their own sakes, patentees usually did so. Now, however, every Complete Specification must end with "a distinct statement of the invention claimed" (Section 5, Sub-section 5).

Simple as the requirement may seem, it is sometimes a matter of considerable difficulty to select and limit in clear and comprehensive language not only the pith and gist of the invention, but also the subsidiary and collateral claims that may spring from the main trunk.

Powers of Comptroller to require claims to Complete.

The Comptroller-General of the Patent Office has power to require that something in the shape of a claim shall be appended to the Complete; but as to the form and substance of the claim, so long as it agrees with the invention described in the specification, he has no power to interfere, and does not attempt, except by discreet suggestion, to guide the applicant. It appears that there must be some attempt to indicate the scope of the invention in the claim. Herschell, S.-G., in *re Smith's Patent* (Griff. P. C. 91), expressed an opinion that to say "I claim the invention described in the specification" would not be a claim that should be accepted by the Comptroller. But he also said that if the claim read, "I claim the improved bicycle substantially as described," such a phrase might be accepted, as it clearly pointed to a particular machine. But even if it were possible to pass a specification through the Patent Office without any claim, it seems that this would not vitiate the patent.

Herschell, S.-G., form of claim.

Claim must refer to the invention as described.

lord Halsbury, in *Vickers v. Siddell* (1890) 7 R. P. C. 292: 15 App. Ca. 496), held that the provision as to the appending of a claim to the specification is directory only and that non-compliance would *not* render the patent invalid. This was followed in *Kelly v. Heathman* (1890) 7 R. P. C. 343).

But, per Lord Halsbury, absence of claim not fatal to patent.

The primary rule in drawing a claim is to take care that the claim shall not cover anything more than the actual invention. "The object of a claim," said Lord Chelmsford in *Harrison v. Anderston Foundry Co.* (1876) L. R. 1 App. Ca. 574), "is to define and limit with precision what it is that is claimed to have been invented and therefore patented." In working out an invention and preparing the Complete Specification it is often the case that extensions of the uses of and changes in the apparatus begin to suggest themselves more or less vaguely to the inventor, some of which he thinks might possibly lead to evasion if hit upon by other inventors. In this state of mind claims are prepared in which, not content with claiming the substance of the invention, the patentee endeavours also to secure some foothold in case of possible developments of his idea by others. With this object the claim is drawn in vague terms, which the patentee flatters himself not only cover the design originated by himself, but would trip up anyone who might come within measurable distance of his domain. As was said by Lindley, M. R., in deciding against the validity of the patent in *Dick v. Ellam* (1900) 17 R. P. C. 196), "the inventions might have been patentable if the patentee had not thrown his net too wide as patentees constantly do to catch people who do not infringe the real invention."

Object of claim is to define invention. *Harrison v. Anderston Foundry Co.*

Danger of "fishing" claims.

*Dick v. Ellam.*

This ambition has often proved fatal, and in thus snatching at the shadow the patentee runs great risk of losing the substance.

In *Stevens v. Keating* (1847) 2 Web. P. C. 175; 16 L. J. Ex. 57; Good. P. C. 443) the patentee had described a mode of making a new cement by the use of sulphuric acid with limestone or chalk. The gist of the invention was the employment of the acid for the purpose. Not content with having proved the usefulness of sulphuric acid for his purpose, the patentee said, in the body of his

Claims must not be too wide. *Stevens v. Keating.*

specification, that other acids might be used, and claimed the process in combination with the use of acids "as hereinbefore described." This was held to be a claim for every acid, and as it was proved that certain acids would not do the claim was upset as being too wide.

*Minter v. Mower.*

Again, in *Minter v. Mower* (1837) 6 A. & E. 735; Good. P. C. 301), the patentee of an automatically self-balancing chair, instead of claiming his own construction of the chair, which was both novel and useful, claimed "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of the chair, as above described." It was shown at the trial that a form of chair acting upon this claimed principle, but infinitely less cleverly constructed than the plaintiff's, had been made and sold before the date of his patent. It was held that Minter's claim, instead of being confined to his own invention, was wide enough to cover the anticipatory chair also, and was therefore bad.

Non-utility in part of combination claimed makes the whole bad.

If an essential part of a combination, operation, or process, or an alternative arrangement or process, described and claimed should turn out to be useless, the patent is bad. The first would put an entire stop to the useful function of the machine or would nullify the process, and is clearly a fatal defect (see Lord Denman's remarks in *Reg. v. Cutler* [1816], 1 Stark. 354; 1 Web. P. C. 76 n.). The second—viz. the failure of an alternative arrangement or process—is also a reason for upsetting a patent. The principle seems to be that the Court says: "Here you have two methods presented to you as equally useful. You are told that one is as good as the other. Having nothing to serve as a guide, you may choose the useless method. It fails. Practically, therefore, you are put to experiment to prove what is useful and what is useless, and that is distinct failure of a patent."

Or failure in alternative arrangement.

*Simpson v. Holliday.*

In *Simpson v. Holliday* (1865-6) Good. P. C. 425; 12 L. T. N. S. 99) two methods of preparing dyes were described. The method first described was perfectly successful; the second (an alternative method) was a failure. The patent was held invalid on that account.

*Pether v. Shaw.*

Similarly, in *Pether v. Shaw* (1893) 10 R. P. C. 203).

Kekewich, J., held the plaintiff's patent bad because, of two alternatives suggested in the claim, one was of no use, although the other had proved highly successful. In *Kurtz v. Spence* ([1886-8] 5 R. P. C. 161; L. R. 38 Ch. D. 579) the patentee claimed as an agent in a process peroxide of manganese, whether hydrated or anhydrous. The latter proved to be useless for the purposes of the invention, and the patent was held bad. It must be remembered that the claim is always read together with the specification; therefore where a claim is made, and direct qualifying reference is had to the specification, the claim is limited thereby, and the reader must go to the specification to learn the extent of the limits. But as this course is very apt to lead to doubt and uncertainty, it is unquestionably better to formulate in the claim itself the feature which it is desired to secure.

*Kurtz v. Spence.*

Claim may be limited by specification.

Sometimes the interpretation of the true meaning of a claim is a matter for settlement by evidence; that is to say, that though a claim may seem too wide to an outsider, it may have a more restricted meaning to a person well acquainted with the industry in question. Thus, in *Gandy v. Baddaway* ([1885] 2 R. P. C. 49), the claim was for "constructing belts or bands, for driving machinery, of cotton, canvas, or duck *woven hard*," &c. It was shown that at least ten classes of "hard woven" canvas were known in the market. Of these, numbers two, three, and four only were suitable for the purposes of the invention. The other classes were useless. The plaintiff endeavoured to show that a workman acquainted with this class of manufacture would, without further instructions, have used number two, three, or four, and would never have thought of using any of the other numbers. It is to be gathered from the judgment that if this had been established on evidence, the Court might have upheld the patent. But no such evidence was forthcoming, and, consequently, the patent was held invalid.

True meaning of claim sometimes matter for evidence.

*Gandy v. Baddaway.*

"Substantially as hereinbefore described" is a phrase often appearing as the termination of a claim. The words are used sometimes with the intention of giving increased breadth to a claim, sometimes for the purpose

Grove, J., on the use of the word "substantially."

of narrowing it. In *Young v. Rosenthal* ([1884] 1 R. P. C. 29) Mr. Justice Grove gave it as his opinion that it was unnecessary to use any such word as "substantially" to qualify a claim. The elasticity sought to be obtained in a claim by such a qualification, either by increasing or limiting its ambit, is already given by the law. "The law says if a man although not literally infringing the letter of the patent yet substantially infringes it, it is an infringement." As was said by Lord Alverstone in *Presto Shoe Case Co. v. Orme* ([1900] 18 R. P. C. 17): "In my judgment, be it a combination claim or be it not, you are only allowed to follow the words of the claim, but you are not to permit mere mechanical equivalents or mere colourable alterations to prevent a thing being an infringement, having regard to what the meaning of the claim is." It is certainly reasonable to consider that all expressions which mean that anything practically or substantially the same will be deemed an infringement of the described invention are unnecessary and might as well be left out. They do no good, for it is always for the Court to decide what is and what is not an infringement, and no amount of fencing with such expressions as "mere mechanical equivalents," or "substantially the same arrangement of parts," &c., so commonly found in specifications, will influence the Court in any way.

Lord Alverstone on colourable alterations.

Principles.

The subject of how far it is safe to claim anything savouring of a principle has already been referred to in the foregoing pages (see Chapter IV., on "Subject-Matter"). It seems proper, however, at this point to repeat the rule already laid down, that although a bare principle *per se* cannot be patented, yet, if the principle is new and a method of carrying it into effect has also been devised, the principle, coupled with the mode of carrying it into effect, may be patented. If this is done, any other substantially similar mode of carrying the principle into effect which another person might seek to use will be very narrowly scrutinised, and if possible held to be within the limits of the patent. The chief expressions of judicial opinion most favourable to the first exploiter of a new principle are to be found in *Neilson v. Harford* ([1841]

Claim should be for principle, coupled with mode of carrying into effect.

Good. P. C. 321; 8 M. & W. 806); *Otto v. Linford* ([1881] Good. P. C. 343; 46 L. T. N. S. 35); and *Joye v. Pratt* (1837 Good. P. C. 274). But as Farwell, J., pointed out in *Chamberlain v. Mayor of Bradford* ([1900] 17 R. P. C. 493), in recalling the dictum of Cotton, L. J., in *Automatic Weighing Machine Co. v. Knight* ([1889] 6 R. P. C. 297), the usual reading of Baron Alderson's opinion in *Joye v. Pratt* is much too wide. Said the learned Judge: "If the claim is in general terms for every mode of carrying the principle into effect, it becomes a claim to the principle itself, and therefore fails." This was already noted by Lord Abinger in *Neilson v. Harford (supra)*.

Claim must not be generally for every mode of carrying into effect.

It seems reasonable to submit that a claim which the patentee would not venture to make for himself will not be made for him by the Court, and that a claim for a new mode of carrying out a new principle will be confined substantially to that mode, and will not extend to all other modes as one might judge from a perusal of Baron Alderson's words.

According to Smith, L. J., in *Edison-Bell Phonograph Co. v. Smith* (1894 11 R. P. C., p. 404), a claim is also a disclaimer: but, *per* Lord Herschell, in *Parkinson v. Simon* (1895 12 R. P. C., p. 406), "it is no longer correct to speak of a claim as a disclaimer."

A claim is not a disclaimer. *Parkinson v. Simon.*

The question as to how far a subordinate claim, *prima facie* bad by itself for want of novelty or utility, ought to be considered as annexed to and forming part of the good claim or claims, so as to be capable of being held valid, in accordance with the ruling in *Plimpton v. Spiller* and *British Dynamite Co. v. Krebs*, has been already discussed in Chapter VI., to which the reader is referred.

Apparently bad subsidiary claim not necessarily fatal.

The risk and uncertainty attending the interpretation of a claim of this dubious nature is well exemplified by the sometimes apparently contradictory character of the decisions. It is true that a claim is not to be read as an isolated sentence but together with the specification (*per* Kay, L. J., in *Parkinson v. Simon* [1894], 11 R. P. C. 493). But a patentee who has deliberately made a separate and independent claim for a part of his invention which is *ab initio*, or afterwards turns out to be, not good subject-

When evidently separate and independent

Invalid subsidiary claim is invalid.

*Kynoch v. Webb*; *Electric Construction Co. v. Imperial Tramways Co.*

matter will not be assisted by the Court, because it was "foolish or suicidal" of him to do so (*per* Lord Davey in *Kynoch v. Webb* (1899), 17 R. P. C. 100). In *Electric Construction Co. v. Imperial Tramways Co.* (1900, 17 R. P. C. 537) it was plain from the specification that spring suspension of a motor in a car was the object of the invention. But Claim 1 detailed an arrangement in which the spring suspension was absent, and which, in the absence of the springs, turned out to be old. The plaintiffs contended that the Court should read the claim with the specification and construe it as referring only to apparatus in which spring suspension was used. *Plimpton v. Spiller* was quoted as an authority for this, but without effect, the Court declining to amplify the claim in such a manner as to assist the plaintiffs. In *Electric Construction Co. v. Imperial Tramways Co.* (supra) the part left out of the claim in dispute (*viz.*, the spring suspension) was not an essential or necessary part of the motor and car; that is to say, they were complete, as a working combination, without the springs. But even where the feature omitted from the claim is an essential and necessary part of the mechanism, or necessary to the continuity of an operation

*Parts of invention, Limited v. Patents Film Co.*

as in *Parts, Limited v. Patents Film Co.* (1901, 18 R. P. C. 339), the omitted feature will not be read into the claim by the Court.

Invention where part left out of claim is essential

Where a claim, although susceptible of being construed to have been made in error, is plainly subsidiary to the main invention, and intended to be used only in combination with it, lack of novelty in a separate and independent claim will not cause invalidity (*Parnell, J., in Parker v. Stafford* (1901, 18 R. P. C. 260). In the latter case the patented device was intended by the inventor to be used [illegible]

notoriously old or not fit subject-matter, the Court may, in the exercise of its discretion and common sense, construe the faulty claim as being intended to include or be combined with the portion of the invention which is clearly novel and useful, and so cure the defect. But this benevolent view of a *prima facie* bad claim will not be taken when it is arguable that the patentee might reasonably have thought at the time that the subject-matter of the claim was sustainable.

Where a portion of the invention although novel is not specifically claimed, it will not be construed as claimed. *British Motor*

A *fortiori*, if two methods of carrying an invention into effect are stated in the specification, and only one method is claimed, the claim cannot be stretched to include the absent modification. In *British Motor Syndicate, Limited v. Taylor & Son, Limited* (1901, 18 R. P. C. 56), the plaintiffs' specification referred to two methods of igniting the explosive mixture in the cylinder of a gas engine: First, by reduction of pressure at an efflux nozzle through the operation of a cock; and, secondly, by the alteration of the richness of the issuing jet of mixture, the result in either case being that the flame at the proper times had access to the contents of the cylinder. The first method only was claimed, viz., the variation of the velocity of outflow. Strenuous efforts were made to show that this claim was meant to include the variation of the richness of the outflow, and the argument succeeded in the Court of Appeal. But the House of Lords, in restoring the decision of Kekewich, J., held that the claim covered no more than it actually expressed. Referring to an observation of Romer, L. J., that the patentee had *quite clearly* covered the second modification in his claim, Lord Davey said: "With great respect to the learned Lord Justice, that is a [illegible] upon which I cannot concur. The very point to be decided [illegible] that the specification [illegible] and [illegible]

Brett, L. J., on repeat or surplus claims.

seems to be found in the dictum of Brett, L. J., in *Wimpton v. Spiller (supra)*: "If you can say that the subsidiary claim cannot under any circumstances increase the monopoly of the patent, it seems to me that the subsidiary claim is unimportant, is futile, has no effect, and therefore does not raise any objection to the patent." It follows, then, that a claim which is practically a repetition of a preceding claim is to be treated as surplusage and of no effect.

Claim for separate part of combination useless by itself is bad.

A claim which covers a part of a combination, which part by itself is useless, or at least fulfils no functional duty, is bad and vitiates the patent (*Wilson v. Wilson* [1900], 18 R. P. C. 130). Here a metal hoop, which formed an effectively useful thing only when *in situ* on the bobbin, purported in Claim 3 to be claimed separately and by itself. For this reason the claim was held bad. Nevertheless, as the claim specified the improved hoop as being for "application to tubes and bobbins as described and illustrated," it is submitted that the Court of Appeal might have been guided to a different finding had its attention been directed to the cases here[in]before indicated (see also *Parkes v. Bloch* [1901], 11 R. P. C. 575).

Combinations. Whether chemical or mechanical combinations of materials, or combinations of parts or motions in machinery, or combinations of methods in industrial processes, are all the subject-matter for claims.

When the invention relates to a combination of materials mechanically mixed or combined so as to produce a new article or a new alloy or a waterproof fabric or a chemical combination, it is generally the best course to proceed by specifying or naming the proportions of the materials and the method of

When the invention relates to a combination of

This was a dictum of Lord Campbell in *Lister v. Leather* (1857-8) Giood. P. C. 268; 8 E. & B. 1004), and a similar view was taken in *Proctor v. Bennis* (1887 1 R. P. C. 333). It is, however, much safer not to depend upon such rulings, but to make a positive claim for the novel element as an essential part of the particular combination in which it figures.

Reference to the book of essential novelty.

The following rules may be useful as guides in the preparation of claims:

Rules for the preparation of claims.

(1) The claim should not embrace more than the actual invention, but should specifically claim all that is novel.

(2) A claim should be expressed in the clearest and most concise language; should refer unmistakably to the invention described in the specification; and should not contain any vague and speculative phrases.

(3) If the invention discloses a new principle, the claim should be for the principle, coupled with the means for carrying it into effect.

(4) If the invention relates to a new thing or product, the claim should be for the product, and the method of producing it should also be claimed

[illegible]

# CHAPTER XIV.

## OPPOSITION TO GRANT OF PATENT.

Provisional Specification a secret document.

IT HAS already been said that the Provisional Specification during the period of provisional protection is a secret document. Its tenor is unknown to the public, and opposition thereto is not contemplated by the Act. It has also been said that when the Complete Specification has been filed, examined, and accepted, the fact of acceptance is advertised in the *Official Journal*. This advertisement is accompanied by a notification that all persons interested in opposing the grant of a patent on the indicated application may, at any time within two months from the date of the *Journal*, give notice of opposition. At the same time, the specification and drawings are thrown open to public inspection at the Patent Office, and the printing of the specification is usually effected within three weeks after acceptance.

Advertisement of acceptance of Complete Specification.

Time for giving notice of opposition to grant of patent.

Publication of specification.

In all cases the specification is published and placed on sale in ample time to give an intending opponent, not resident near the Patent Office, every opportunity of examining it at his leisure, before filing his notice of opposition.

Persons entitled to oppose.

The words of the Act (Section 11) are that "any person" may oppose, but it has now been finally settled by the Court of Appeal in *Hoyle v. Cunynghame*, [1900] 1 Q. B. 196, that only those having a real interest in a prior patent or some other substantial interest as will be hereinafter defined are entitled to oppose. The grounds of opposition are as follows:

Grounds of opposition.

(1) That the applicant has obtained the invention from the opponent, or from a person of whom he or the person under whom he claims.

(2) That the invention has been patented in this country on an application made by the opponent or by a person of whom he or the person under whom he claims.

(3) That the Complete Specification describes or claims an invention other than that described in the Provisional Specification, and that such other invention forms the subject-matter of an application made by the opponent in the interval between the leaving of the applicant's Provisional Specification and the filing of the Complete Specification.

Person entitled to oppose may quote other patents besides his own.

An opponent once entitled to oppose may include in his grounds of opposition not only the prior patent or patents in which he may be personally interested, but also any other patents in which he has no beneficial or personal interest (see *Stewart's Application* [1891], 13 R. P. C. 627).

Notice of opposition.

The notice of opposition (which bears a ten shilling stamp) must set forth the grounds upon which the opponent intends to rely. The Patent Rules provide that the notice must be signed by the opponent, be accompanied by an unstamped copy, and give an address for service in the United Kingdom. If one of the grounds of opposition should be that the invention has been already patented in this country, the number, title, and date of the patent should be given. It may be noted that a person whose Complete Specification has been accepted, but not yet sealed, is on the footing of a patentee in these oppositions (*re Wilson and Wood* [1877], 46 L. T. 306; 6 Ind. O. C. 750). So long as the notice of opposition undeniably places the applicant in possession of the real grounds of opposition, quibbling objections to mere informalities in the notice will not affect its validity, and the Comptroller has power, under Rule 18, to amend either before or at the hearing (see *Dicey* [1888], 5 R. P. C. 313; *re Lake* [1887], 4 R. P. C. 82; 6 Ind. O. C. 82; *Lake v. Dicey* [1887], 4 R. P. C. 113; 6 Ind. O. C. 113; *Wilson v. Wood*, 6 Ind. O. C. 750; *Wilson*

Applicant whose complete specification has become accepted may oppose.

Practice to amend statement of grounds of opposition.

declarations in support, which might or might not be necessary, he must do so within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's Complete Specification. On leaving these declarations at the Patent Office he must send a list of them to the applicant.

Declarations by applicant in support of application.

Within fourteen days from the date of receiving this list the applicant may leave declarations in answer, delivering also a list to the opponent; and within a further period of fourteen days the opponent may leave declarations in reply.

Declarations by opponent in reply.

These last declarations must be confined strictly to reply. In some cases further declarations or rejoinders might be filed by the parties, but only by special leave of the Comptroller, and in most instances the declaratory evidence is closed by the opponent's reply.

Time for filing declarations may be extended; but in certain cases not where fraud alleged.

The discretionary power of the Comptroller to extend the time for filing declarations, or to give leave for the filing of additional declarations or evidence, is, by Rule 43 and by special direction of the Law Officers, never exercised in favour of an opponent who alleges that the applicant has obtained the invention from him: that is where fraud is either asserted or inferred. Declarations should be as few and as concise as possible; otherwise if the opposition goes to appeal, the Law Officer may order the diffuse declarant to costs (*Brand's Application* [1895], 12 R. P. C. 162).

Copies of all of the declarations can be had by the parties from the Patent Office or by arrangement with each other.

Decision on evidence may be given on the pleadings;

As to the advisability or necessity of filing declarations, it may be said that this depends entirely on the grounds of opposition. Where the grounds are simply a petitio for a price patent declarations can rarely be necessary, as the question will, after all, be decided upon a comparison of the two specifications. But where the

Where the grant of a patent has been opposed on the ground that the invention has already been patented in this country, the applicant may produce any evidence of public knowledge or prior patents which will tend to limit the ambit of the opponent's specification.

Applicant may cite prior specifications of public knowledge to limit opponent's claim.

Thus, in *re Jones* (Griff. A. P. C. 33; 6 Rep. Pat. Cas. 21), the applicant sought to minimise the scope of the opponent's patent by citing several specifications prior to the opponent's. The opponent objected, but the Law Officer intimated that it was material that he should be informed of the state of public knowledge; and such is now the well-established practice before the Comptroller and Law Officer. Without pretending to try the validity of the opponent's patent, it is the practice to admit all anticipatory specifications and publications quoted by the applicant for the purpose of seeing from what standpoint of public knowledge the opponent's patent must be regarded. Notice of these prior publications should be given to the opponent and to the Comptroller before the hearing, or copies might be attached as exhibits to the applicant's declarations, if such are filed; and all models or samples referred to in the declarations of both sides should be constituted exhibits. But merely illustrative samples or specimens of the inventions under consideration, or of matters imputed in the declarations, may be produced and shown to the Comptroller or Law Officer at the hearing to assist explanations. Thus, in *re Lancaster's Applications* (Griff. P. C. 203; 6 Rep. Pat. Cas. 21), the applicant sought to demonstrate the action of his spring piston packing at the hearing to the Law Officer by means of a specimen. The opponent asked that this should be barred, but the Solicitor-General (Giffard) said it assisted him very much to see the specimen, and he would look at it to better his understanding of the drawings.

Exhibits.

Illustrative samples.

*Re Lancaster* also decided the point that an opponent may oppose on an expired patent

Where the opponent is a patentee one of the parties may apply for a hearing, and the Comptroller appoints a time, at least ten days' notice of the hearing being given to the parties. A hearing fee of £1 is payable by each side

At the hearing the parties themselves may appear, or their agents or solicitors, or they may be represented by counsel. As a rule the applicant begins, the opponent follows, and the applicant replies; but where the *onus probandi* lies on the opponent—as, for example, where the applicant is charged with fraud—the opponent begins.

Opponent confined to grounds of opposition in notice.

At the hearing the opponent must confine himself strictly to the grounds of opposition stated in his notice. Fresh grounds of opposition cannot be raised (*re Bailey*, Griff. P. C. 269; Good. O. C. 25). Generally the hearing is little more than an oral urging of the chief points made in the declarations when such are filed.

Decision.

The Comptroller, who is generally assisted by one or two of the Chief Examiners, seldom gives his decision at the hearing, but notifies the parties in writing.

Appeal to Law Officer.

If either or both of the parties should be dissatisfied with the Comptroller's decision, appeal can be made to the Law Officer. Notice of such appeal must be filed at the Patent Office within fourteen days from the date of the decision. In the event of an appeal being contemplated, or being probable, it is not advisable for the successful party in the meantime to bind himself to unqualified acceptance of the decision, as it is conceivable that such acceptance may trammel him in using his old evidence or producing new evidence, if such should be available, to resist the appeal before the Law Officer.

Possible danger of unqualified acceptance of Comptroller's decision.

Appeal a rehearing.

The proceedings before the Law Officer amount to a rehearing of the case, and if the successful or partly successful party before the Comptroller has by his premature unqualified acceptance of the decision practically acceded to the exclusion or to a certain reading of parts of his evidence, he may be precluded from reproducing or giving effect to these before the Law Officer. At all events, he will have deprived himself of the power to file new evidence which may have come to his knowledge since the hearing before the Comptroller.

A party accepting Comptroller's decision *in toto* not

In *re Hampton and Pacer* (Griff. A. P. C. 13; Good. O. C. 71), which was an amendment case, the successful applicants accepted the Comptroller's decision in their favour without qualification. The unsuccessful opponent

appealed to the Law Officer. The applicants then applied under Lr. O., Rule 8, for leave to file evidence to show that the opponent's invention had been in use by others before the date of his patent; but, as they had accepted the Comptroller's decision *in toto*, Clarke, S.-G., refused leave. When the Comptroller decides partly in favour of the applicant and partly in favour of the opponent cross notices of appeal should be filed if each intends to question that part of the decision which is in favour of his opponent.

Law Officer allowed new evidence before Law Officer.

When notice of appeal has been given, the Comptroller transmits all the papers in the case to the Law Officer's clerk. When the date of the hearing has been appointed, seven days' notice is given to the parties and to the Comptroller.

Proceedings before Law Officer.

The hearing before the Law Officer is limited to the points raised in the notice of appeal. The whole or a part only of the Comptroller's decision may be questioned; and if the party upon whom the appeal is served wishes to do so, he may question other parts of the Comptroller's decision by counter-appeal. The evidence before the Law Officer must be the same as that used before the Comptroller, and no further evidence will be admitted save as to matters which have occurred or come to the knowledge of either party since the date of the decision appealed against, except with the leave of the Law Officer upon application for that purpose. In *re Bailey's Patent* (Griff. P. C. 269; Good. O. C. 25) Davey, S.-G., decided that this rule related to evidence pure and simple, and refused to allow the opponent to put in the specification of a prior patent which had come to his knowledge since the hearing. The Law Officer held that such was not evidence, but an additional ground of opposition.

Rules as to further evidence.

The applicant may, however, with leave, add to his evidence of prior knowledge before the Law Officer.

The question of who is entitled to oppose deserves at this point to receive some further consideration. Section 11, Sub-section 1, of the Act, when dealing with opposition *before the Comptroller*, says "any person" may oppose. Of course, as regards "any person" opposing on the first and third grounds of opposition—viz., that the applicant had obtained the invention from the opponent, or that the

Further consideration of persons entitled to oppose.

applicant's Complete contained something which the opponent had protected between the dates of the applicant's Provisional and Complete, the opponent's *locus standi* is unquestionable. But this is not so clear when the second ground of opposition is considered—viz., that the invention had already been patented in this country. Seeing that the expression "any person" is unqualified in the first sub-section, it appeared to be open to any person to oppose on this ground. Sub-section 3 of the same section, which relates to appeals to the Law Officer, makes it clear that any person applying to be heard by the Law Officer must be some person, to quote the sub-section, "in the opinion of the Law Officer entitled to be heard." But no such qualification appears to attach to opponents before the Comptroller.

Assignee of or manufacturer under lapsed patent.

The matter was soon raised when the Act came into force. In *re Vilmay* (Griff. P. C. 285; Good. O. C. 12), where the opponent was the assignee of, and a manufacturer under, a lapsed patent, Herschell, S.-G., held him entitled to be heard, and, on the general question of *locus standi*, the learned Law Officer intimated that in his opinion it was not competent for *any* member of the public to oppose a patent.

Patent agent on behalf of patentee.

In *re Heath and Frost* (Griff. P. C. 288; Good. O. C. 13) it was held that a patent agent could not oppose in his own name on behalf of the grantee of a prior patent.

Grantee of expired patent.

In *re Lancaster* (Griff. P. C. 293; Good. O. C. 14) it was decided that the grantee of a prior expired patent could oppose.

Manufacturer under prior patent.

In *re MacEvoy* ([1888] 5 R. P. C. 285; Good. O. C. 14) the opponent was a manufacturer under one of the prior patents relied on in the notice of opposition, but Clarke, S.-G., held him not entitled to oppose. But see now the more recent case of *re Meyer* ([1899] 16 R. P. C. 526).

Persons about to manufacture under prior patent.

In *re Bairstow* ([1888] 5 R. P. C. 286; Good. O. C. 15) the opponent, who alleged he was about to manufacture under the prior patent, was held not to have sufficient interest to entitle him to oppose.

Licensee.

In *re Hill* ([1888] 5 R. P. C. 599; Good. O. C. 15) a licensee under a prior patent was held entitled to oppose.

Foreign grantee of antedated patent under Convention.

In *re Ercolli* (Griff. A. P. C. 28) a French patentee who, under the Convention, had his British application antedated, to be of the same date as his prior French patent, and thus got in front of an English applicant, was held not entitled to oppose.

Applicant under provisional protection.

In *re Bailey* (Griff. P. C. 269) decided that a person having merely prior Provisional Protection cannot oppose. But *re L'Oiseau and Pierrard* (Good. O. C. 16, 75; Griff. A. P. C. 36), decided that an applicant whose Complete Specification has been accepted is in a position to oppose.

Comptroller's and Law Officer's Courts alike in deciding who is entitled to oppose.

In *re Stewart* ([1896] 13 R. P. C. 627) an important advance was made when Webster, A.-G., decided that in respect of the qualification of the opponent there was no distinction between the Comptroller's Court and that of the Law Officer, and that the persons entitled to be heard in opposition before the Comptroller are the same as those entitled to be heard on appeal before the Law Officer.

Ruling in *Reg. v. Comptroller, ex parte Tomlinson.*

Finally, in *Reg. v. Comptroller, ex parte Tomlinson* ([1899] 16 R. P. C. 233), the Court of Appeal approved of the ruling in *re Stewart*, and decided further that a member of the public having no interest is not entitled to oppose the grant of a patent on the ground merely that the invention has been patented by another person in this country on an application of prior date; and, *per* Smith, L. J., that the Law Officer is also the final authority to decide whether a person is entitled to be heard before the Comptroller or Law Officer in opposition to a request for leave to amend a specification.

Law officer the final authority.

In deciding who is entitled to oppose, the Law Officer will consider each case on its merits. But an interest of some sort must be apparent.

Thus, the decision as to who is the proper person to oppose either the grant of a patent or the amendment of a specification lies with the Law Officer, and his decision is final. The cases already given show upon what points the Law Officer has pronounced, and by these the Comptroller will be guided. But it would be useless to say that the class of persons entitled to oppose can even now be exhaustively specified. Special circumstances will always be considered. Thus, in *re Meyer* ([1899] 16 R. P. C. 526), which was the application forming the basis of the proceedings in *Reg. v. Comptroller, ex parte Tomlinson*, the opponent (although he had no actual interest

in the prior patents cited in opposition) nevertheless succeeded in obtaining a hearing before the Law Officer. The facts were that the opponent had undertaken the manufacture of looms in accordance with one of the prior patents (A), in virtue of which he opposed. But finding he could not proceed without a license he stopped further work, and an earlier patent (B), prior to (A), was brought to his notice, which, as well as the patent (A), he alleged to cover the subject-matter of the new patent (C), which he opposed. Webster, A.-G., held that he had established sufficient interest to entitle him to oppose, and laid down the rule that "where there has been a *bonâ fide* attempt to carry out the invention sought to be protected by the person who desires to be heard in opposition, and proof is shown that he may be damnified or affected by the application which he desires to oppose, he is entitled to be heard."

A person who has attempted to carry out commercially the applicant's invention may oppose.

Opponent must show that invention has been claimed.

Opposition cannot be founded upon mere description in a prior specification. The invention must be *claimed* (*re von Buch*, Griff. A. P. C. 40; Good. O. C. 17). The Comptroller-General has no power to award costs, but the Law Officer usually allows a sum for costs to the successful party. The average allowance is from five to ten guineas, but considerably larger sums have been awarded where costs have been heavy. An appellant who withdraws, without reason given, before the hearing is liable to pay costs (*re Knight*, Griff. A. P. C. 35; Good. O. C. 26).

Costs.

First ground of opposition. Invention obtained from applicant.

Proceeding now to the grounds of opposition the first is—That the applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.

Only transactions in this country considered.

This ground of opposition only holds good in respect of transactions in this country. If the information has been acquired abroad the applicant being the first importer is, according to the Statute of Monopolies, the true and first inventor (*re Edmunds*, Griff. P. C. 281, Good. O. C. 27; *re Lake* [1888], 5 R. P. C. 415, Good. O. C. 28; *re Higgins* [1891], 9 R. P. C. 75, Good. O. C. 33, Appendix).

In supporting an allegation that the applicant has obtained the invention from the opponent the evidence requires to be very strong, especially if fraud is alleged.

Test of evidence in fraud.

Neither the Comptroller nor the Law Officer will stop a patent except upon evidence so conclusive that in their estimation no jury could fail to find for the opponent (*re Stuart* [1882], 9 R. P. C. 452). There have been cases following the precedent laid down by Lord Cranworth in *re Russell* (2 De G. & J. 130), where the facts were such as to lead the Law Officer and Comptroller to issue the patent to a trustee on behalf of both parties or jointly to the applicant and opponent, as, for instance, in *re Lake* (Griff. P. C. 294), *re Cardwardine* (Griff. P. C. 284), and *re Evans and Olney* (Griff. P. C. 279).

Patent might be issued jointly to applicant and opponent.

Declarants may be cross-examined before Law Officer.

As there is no provision for cross-examination of the declarants or other witnesses before the Comptroller, the latter will often, when the evidence is conflicting, take such a course (but always in the form of giving a decision) as will cause the parties to go to the Law Officer, before whom cross-examination is permissible (*re Evans and Olney*, *supra*).

Master and servant.

*re Heald.*

The relationship of master and servant does not give the master any rights in the servant's invention, even if the servant works out the invention in his master's time and with his master's tools. Thus, in *re Heald* (1891) 8 R. P. C. 429; (Good. 0. C. 25), Clarke, S.-G., said: "I am not aware of any authority which lays down that the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer, so as to prevent the person employed from taking out a patent for it." But where an inventor employs a workman to work out an invention, improvements in detail invented or suggested by the workman become the property of his employer, and the workman cannot afterwards take out a patent for these improvements. This was very plainly stated by Davey, S.-G., in *re David and Woodley* (Griff. A. P. C. 26). Said the Solicitor-General: "I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, these suggestions are the property of his

*David and Woodley.*

employer, *and the workman cannot afterwards take out* a patent for them." The relationship of master and servant in the evolution of an invention was also considered in the more recent revocation case of *Marshall and Naylor's Patent* ([1900] 17 R. P. C. 553). In this case the petitioner was a workman in the employment of a company of which the two patentees were directors. The petitioner had been asked by one of the patentees to invent a tap which, by the introduction of steam, would give hot, warm, or cold water as desired. The petitioner did so, and perfected the invention. For his services he was paid £10. The Court held the invention was the petitioner's, and that the patentees had no right to the patent, which was revoked.

*Marshall and Naylor's Patent.*

When the opposition is based upon the second ground, viz., that the invention has been patented in this country on an application of prior date, the similarity between the inventions must be very close to stop the patent. All the reported cases show that in most instances of refusal to seal a patent the inventions have been practically identical, so that it would serve no useful purpose to instance specific causes of refusal.

*Second ground of opposition: On prior patent.*

When the differences between the interfering inventions are at all appreciable, or if sufficient cause is shown to make it a matter of reasonable doubt, the patent is usually granted. For instance, in *re Thwaites* (Griff. P. C. 277), although, as James, A.-G., said, "the two inventions were very nearly the same," the patent was sealed. The Comptroller and the Law Officer are guided in this lenity by the consideration that from the refusal of a patent there is no appeal, and that if the applicant's patent turns out to be really an infringement of the opponent's, the opponent has his remedy in a Court of Law, or by petition for revocation.

*Resemblance to prior patent must be very close.*

*The question of the validity of the opponent's patent* is never considered (*per* Webster, A.-G., in *re Newman* [1888], 5 R. P. C. 271). Clarke, S.-G., in *re Haythornthwaite* ([1889] 7 R. P. C. 70), held that the applicants could not be allowed to contend that the opponents' patents were bad for disconformity, or, as in *re Thornborough and Wilks* ([1896] 13 R. P. C. 115), that the opponent's patent was invalid from prior user.

*Validity of opponent's patent never considered.*

Disclaimer sometimes required in applicant's specification.

But although the opponent may not succeed in stopping the applicant's patent he may nevertheless compel the insertion in the applicant's specification of a short paragraph indicating generally, if need be, the state of the art at the date of the application, or, it might be, disclaiming generally such parts of the invention as the hearing may have shown to be claimed in the opponent's or other prior patents, but without any specific reference to the opponent's name or patent. Or if the circumstances warrant it, and especially if the opponent's is a pioneer or master patent, the applicant may be compelled by the Comptroller or Law Officer to insert in his specification a special reference by name and number to the opponent's patent, with an intimation that he disclaims anything covered thereby.

Special reference to master patent.

Object of disclaimers to protect the public.

These disclaiming clauses, and particularly the special references, are seldom pleasing to applicants, and special disclaimers are enforced generally with reluctance by the Comptroller or Law Officer. As was said by Webster, A.-G., in *Stell's Application* (1891) 8 R. P. C. 235), the true principles upon which the Law Officers act are— First, that there must be no repetition of the claim to the earlier invention in the later patent; and, secondly, it must be clear that the public are not misled. Therefore, in many cases a slight alteration in the specification or claim or a short reference to the then existing state of the art, without anything of the nature of a disclaimer, may be sufficient to meet the opposition. Although no doubt the opponent is apt to regard the insertion of a special reference to his name and patent in the applicant's specification as a personal advantage gained, the Law Officer has been careful in a number of cases to lay down that these disclaimers are not inserted solely in the interests of either opponent or applicant, but chiefly to protect and inform the public (*re Lorraine* [1888], 5 R. P. C. 142, Good. O. C. 35; *re Newman* [1888], 5 R. P. C. 279; *re Hill* [1888], 5 R. P. C. 599). On the other hand, the insertion of a general disclaiming clause, besides being a protection to the public, is rather an advantage than otherwise to the applicant (*per* Webster, A.-G., in *re Guest and Barrow*), and in proper cases is readily ordered and inserted. But,

Slight alteration may serve in lieu of disclaimer.

as already observed, the special reference is much more sparingly used. As was said by Webster, A.-G., in *re Guest and Barron* (1888) 5 R. P. C. 313; (Good. C. C. 38): "I have never considered that a prior patentee has any right to be specially named unless the applicants are willing to name him, and unless it is clear that there is no other publication except the one that is mentioned."

When a special reference may be ordered.

The principles governing the insertion of such special references are that if the applicant's invention is no more than an improvement upon the prior patent, and is in no sense an independent invention (as in *re Huskins*, Griff. P. C. 291), a special reference may be ordered. Webster, A.-G., practically adhered to this rule in the more recent case of *re Newton* (1899) 17 R. P. C. 123), although in that case, in view of certain circumstances, he did not insist on a specific reference to number, name, and date, but adopted the middle course of requiring a disclaimer following the exact terms of the opponent's claim. The learned Law Officer said: "I have often laid down the rule as to the cases in which I think specific references are right—viz., where there is substantial identity between the fundamental parts of the two inventions, but a difference *which can only be justified on the ground of improvement.*"

Where applicant's invention is an improvement on opponent's.

Where opponent's is master patent.

So also if the opponent's patent is a pioneer or master patent, or describes and claims something the like of which has not been done before, a specific reference may be obtained. Webster, A.-G., in *re Hill* (1888) 5 R. P. C. 599), said: "It is not prudent or desirable to insert special references to particular prior patents unless there is, practically speaking, no question that the earlier patent is what I may call a master patent." In construing the alleged master patent of the opponent, although prior specifications and other prior publications and evidence of common knowledge may be referred to by the applicant for the purpose of limiting the opponent's claim and rebutting the contention that it is a master patent, instances of alleged prior user or disconformity or other causes of invalidity will not be considered. The gist of the remarks of Finlay, S.-G., in *re Thorabrough and Wills*

Alleged master patent may be narrowed by references to prior specifications &c.

But the mere validity of

(1896) 13 R. P. C. 1151, is that even if it be alleged that to read the opponent's patent so widely as to constitute it a master patent would invalidate it in a Court of Law, that contention will not avail to protect the applicant from a special reference. opponent's patent cannot be construed

When an opponent represents his patent to be a master patent "it is his duty," said Webster, A.-G., in *re Southwell and Wood* (1896) 13 R. P. C. 361 a, "to support such a claim before the Comptroller by evidence, unless the parties agree as to the existing state of knowledge." The present practice is for the opponent in such a case to file a declaration that a careful search has been made among patent records and publications generally, and that nothing has been found to destroy the opponent's claim to a master patent. If anything is found in the slightest degree affecting such a claim, it must be produced to the Comptroller. Such a declaration may be made by the opponent himself if he made the search, or by some skilled person who made the search on his behalf. The applicant may, of course, make an independent search, and produce whatever evidence he may find to rebut the contention that the opponent's is a master patent. opponent alleging master patent must support by evidence.

But even when all this is done the limits of the opponent's patent may be deducible from the claim, for it is clear that a claim originally intended to be limited cannot afterwards be alleged to be broader than its terms, simply because subsequent knowledge shows that it might without danger have been drawn in wider terms. Indeed, the addition to a claim of the usual phrase "as described" has been held to prevent the patentee from alleging that such a claim can be a master claim. In *re Sielaff* (1888) 5 R. P. C. 454 Webster, A.-G., said: "I am not satisfied that Everitt's is the master patent. Looking at the claim 'as described,' I should doubt exceedingly whether it was a proper description to suggest that Everitt's was the first patent for connecting together two moving pieces of mechanism by a coin." But limits of master patent deducible from claims.

Where the applicant's specification discloses a minimum of invention and the opponent's is not absolutely but of the nature of a master patent, according to Carson, S.-G., Where applicant's invention is narrow master

patent to be liberally construed.

the position of the alleged master patent is not to be discussed in too narrow a spirit (*re Sachse's Application* [1900], 18 R. P. C. 221).

No special reference to concurrent application.

A special reference is never given in the case of concurrent applications (*re Greenhalgh* [1897], 14 R. P. C. 387).

Nor even when applicant's invention would infringe.

Even if the applicant's invention would be an infringement of the opponent's patent, that is not *per se* a reason for a special reference (*re Marsden* [1896], 13 R. P. C. 87). Although the patent quoted by the opponent may have

Expired patent.

expired, this was considered by Clarke, S.-G., in *re Hall and Hall* (1888, 5 R. P. C. 283), to be no reason why it should not be specially referred to. On the contrary, he considered it an additional reason.

Quantum of applicant's invention sometimes considered.

Although the Law Officer will not consider whether or not the applicant's invention is subject-matter for a patent, nevertheless he may weigh the quantum of invention, and if it shows no appreciable advance upon the opponent's patent he may refuse to seal (*re Todd's Application* [1897], 9 R. P. C. 487). This discretion of the Law Officer to

Subject-matter.

adjudicate upon the quantum of the applicant's invention was recently exercised in *Bridge's Application* ([1901] 18 R. P. C. 257), where Carson, S.-G., decided that the mere stringing together of separate items previously patented by the opponent and others did not show sufficient invention to justify the grant of a patent. This decision goes considerably beyond the decision in *Todd's Case*.

Applicant may obtain patent for residuum of original claim.

A common result of opposition to the grant of a patent is that the applicant's claim may be cut down to a shadow of its former self, if not completely destroyed. Many applicants, rather than accede to the total refusal of their application, cling to some trifling detail of which they originally thought nothing, and request that a patent may be granted on this surviving wreckage. It is within the province of the Comptroller or Law Officer to do so if the surviving detail formed part of the original claim, and if it is in any degree an advance. But when it is plain that

But residuum must have been within original claim

after eliminating the part objected to there is nothing patentable left, the patent will be refused (see *re Hedge* [1895], 12 R. P. C. 136; *re Whittaker* [1896], 13 R. P. C. 580;

*re Harrild and Parkins* [1900], 17 R. P. C. 617). It is true that in *re Harrild and Parkins' Case* Carson, S.-G., said: "If I found something substantially new, and clearly the object of the inventor, on the evidence before me I might order the patent to be sealed with an entirely different claim." But it would be dangerous to interpret this *dictum* as meaning that the applicant would be allowed to claim something not within the ambit of his original claim or claims. If he meant this the learned Law Officer corrected himself in the later case of *in re Mills* ([1901] 18 R. P. C. 322, *infra*). As Finlay, S.-G., said when refusing a patent in *re Lupton and Place* ([1897] 14 R. P. C. 261): "When an applicant has put forward a specification making a claim manifestly the subject of previous patents, would it be right to amend the specification in the manner proposed by the Comptroller so as to limit his claim to this one point on which reliance is now placed? In my judgment it would not be right to do so." The same learned Law Officer, in *re Whittaker* (*supra*), refused to allow the applicant to shift his ground and amend his specification so as to claim a trifling feature not originally claimed. Said the Law Officer: "If all that the applicant claims is the improvement of having a joint instead of a fixed bar at this bend, *he ought to have said so.*" In *re Thomas and Perrost* ([1898] 16 R. P. C. 69) the Law Officer said that a specification ought to be properly framed in the first instance, and, if not, it is by no means a matter of course that amendment will be allowed. In *re Gurnell* ([1899] 16 R. P. C. 154) Finlay, S.-G., made some observations to the same effect. In *re Mills* ([1901] 18 R. P. C. 322) Carson, S.-G., also decided that an applicant whose claim *as originally drawn* is anticipated by the patent relied on by the opponent, but whose specification contains something that may distinguish his alleged invention from the patent of his opponent, will not be allowed to amend his claim by introducing or substituting such distinguishing matter.

Applicant not allowed to shift his ground.

If after the opponent has done his worst there still remains something apparently novel of the original claim

of the applicant, a patent may be granted on such restricted claim either with or without a general disclaimer or special reference. But where the residuum of the applicant's claim appears to be trifling and immaterial, the patent is and ought to be refused outright.

The doctrine of mechanical equivalents may be considered.

In comparing the applicant's and opponent's specifications questions of mechanical equivalents will be considered; and if it is obvious that the applicant's alleged improvements are merely mechanical equivalents for the opponent's parts, the application will be refused (*per* Clarke, S.-G., in *re Haythornthwaite* [1889], 7 R. P. C. 70); and in *re Smith* ([1890] 13 R. P. C. 200) Webster, A.-G., reaffirmed the doctrine that the Law Officer can consider the question of mechanical equivalents as bearing on the identity of *inventions*.

Third ground of opposition.

The last of the three grounds of opposition—viz., that the Complete Specification describes or claims an invention other than that described in the Provisional Specification, and that such other invention forms the subject-matter of an application made by the opponent in the interval between the leaving of the applicant's Provisional Specification and the leaving of his Complete Specification—was introduced by the Amending Act of 1888. The additional ground was intended to remedy a possible abuse, such as was disclosed in *re Green* (Griff. P. C. 286), where the applicant's patent was refused although the specifications made it clear that the opponents had not originally in their Provisional Specification contemplated certain improvements for which the applicant had thereafter made provisional application.

Applicant introducing intermediate improvements made by opponent and protected by him.

Now, however, such a case is impossible; and even if the first applicant were to describe part of the second applicant's invention without laying claim to it, the second applicant might oppose the patent and get such part of the description expunged. In *re Hetherington* ([1890] 7 R. P. C. 419) the Complete Specification of the applicant described, but did not claim, a modified arrangement of flexible bend for carding engines not foreshadowed in his *Provisional Specification*. The opponents had filed a subsequent Provisional Application which contained a clear

*Re Hetherington.*

description of this arrangement of flexible bend. The applicant's patent was allowed to go forward only upon condition that the description of the opponents' flexible bend should be struck out.

But applicant still allowed to develop invention under Provisional.

This ground of opposition is not, however, allowed to interfere with the privilege which the inventor has of developing the invention upon the general lines laid down in his Provisional Specification. Thus, in *re Millar and Miller* ([1898] 15 R. P. C. 718), the patent was unsuccessfully opposed on these grounds, Webster, A.-G., holding that the applicants had merely described a legitimate development of the invention indicated in their Provisional Specification. The same was held in *re Edwards* ([1894] 11 R. P. C. 461).

Law Officer's decision final, except where fraud discovered.

The decision of the Law Officer on appeal from the Comptroller is final, but a case may be ordered to be reheard on the grounds of fraud or serious mistake or miscarriage (*per* Finlay, S.-G., in *re Thomas and Prevost* [1898], 15 R. P. C. 257).

# CHAPTER XV.

## SEALING OF THE PATENT.

### Nature of the Property so Created.

Patent sealed as of date of application.

EVERY Patent is dated and sealed as of the day of application.

Letters Patent are sealed with the Seal of the Patent Office, which has the same effect as if sealed with the Great Seal of the United Kingdom. The use of the Great Seal for this purpose was discontinued in 1878.

Periods within which sealing must be effected.

The sealing must be effected within fifteen months from the date of application, unless under special circumstances over which the patentee has no control—such, for example, as delay caused by opposition, in which case the Law Officer may direct the sealing at any time. Should an applicant die before the expiry of the fifteen months the patent may be granted to his legal representative and sealed within twelve months of death. If an extension of time of one month for filing the Complete Specification has been obtained, a patent may be sealed within nineteen months from the date of application (Patents Act, 1885, Section 3).

Patent may be issued to legal representative of deceased inventor.

Duration of patent.

Under the terms of the grant the patent privilege lasts for fourteen years, and is maintained in force by payment of the following annual renewal fees, which come into existence at the end of the fourth year:—

Annual taxes.

| | £ | s. | d. |
|---|---|---|---|
| Before the expiry of the fourth year, and in respect of the fifth year ... | 5 | 0 | 0 |
| Before the expiry of the fifth year, and in respect of the sixth year ... | 6 | 0 | 0 |
| Before the expiry of the sixth year, and in respect of the seventh year ... | 7 | 0 | 0 |
| Before the expiry of the seventh year, and in respect of the eighth year ... | 8 | 0 | 0 |

| | £ | s. | d. |
|---|---|---|---|
| Before the expiry of the eighth year, and in respect of the ninth year ... | 9 | 0 | 0 |
| Before the expiry of the ninth year, and in respect of the tenth year ... | 10 | 0 | 0 |
| Before the expiry of the tenth year, and in respect of the eleventh year ... | 11 | 0 | 0 |
| Before the expiry of the eleventh year, and in respect of the twelfth year ... | 12 | 0 | 0 |
| Before the expiry of the twelfth year, and in respect of the thirteenth year | 13 | 0 | 0 |
| Before the expiry of the thirteenth year, and in respect of the fourteenth year | 14 | 0 | 0 |

Extension of time to pay taxes.

When by accident the payment of the annual tax has been overlooked, an extension of time can be obtained on payment of the following fines:—

| | £ | s. | d. |
|---|---|---|---|
| On extension of time for one month ... | 1 | 0 | 0 |
| ,, ,, ,, two months ... | 3 | 0 | 0 |
| ,, ,, ,, three months .. | 5 | 0 | 0 |

Nature of patent property.

A patent falls under the head of personal estate. As such it is transmissible by assignment, by devolution, or by operation of law, as, for example, to a trustee in bankruptcy.

Rights of co-patentee.

When a patent has been granted to more than one person, the mutual rights and obligations of the co-patentees are worthy of a short consideration. Their position is in no degree that of an ordinary commercial partnership. They possess a joint interest, which passes by survivorship unless there has been severance of the joint interest (*National Co. v. Gibbs* [1899], 16 R. P. C. 339; 2 Ch. 289; 48 W. R. 499).

Joint interest.

Independent rights.

*Mathers v. Green.*

According to the decision in *Mathers v. Green* ([1865] L. R. 1 Ch. 29; 34 Beav. 170; 35 L. J. Ch. 1) each co-owner of a patent can assign his share, and sue for an infringement, independently of the other or others. He can work the patent himself and for his own benefit without accounting to his co-patentees, and can also grant licences under his own hand. This was the substance of Lord

Chancellor Cranworth's decision in *Mathers v. Green*, Lord Romilly, M. R., in the Court below, ruled that a co-patentee who granted a licence independently of his fellow-patentees was liable to account to them for their proper share of the royalties accruing under such a licence, but the Lord Chancellor apparently thought otherwise, although he gave no express decision on this point.

*Sheers v. Rogers.*

The decision in *Mathers v. Green* was approved and followed in the House of Lords in the more recent case of *Sheers v. Rogers* (1893, 10 R. P. C. 245; [1893] App. Cas. 233; 68 L. T. 726). The defendant was part owner of a moiety of a patent by assignment, and was mortgagee of the other moiety. It was sought to make the defendant liable to account to the mortgagor for a share of the profits made by working the patent, but without success, the House of Lords approving and confirming the judgment of Romer, J., in the lower Court, that a part owner of a patent, even when only so by assignment, can work the patent, without accounting to his co-owner.

Rights of assignee of part of patent.

Mortgagee.

Of course a mortgagee of a patent or share in a patent alone would not be in the same position, but must account for profits as mortgagee in possession in the usual way.

Desirable to define mutual rights of co-patentees by agreement.

It is, therefore, clear that where there is a possibility of disputes of this nature arising, co-patentees should clearly define their relative positions and rights by means of a properly prepared agreement or severance of the joint interest, which would prevent any co-owner from taking an unfair advantage of his fellows. For example, it might be provided that no one of the co-owners should use the invention without the consent of the other or others, or without accounting to him or them for the profits. Again, it might be mutually agreed that none of the owners should sell his share without the consent of the others, or that the patent should be sold only in its entirety. Provisions should also be made regarding the granting of licences, the payment of renewal fees, the prosecution of infringers, and other points likely to breed differences if unprovided for. If it is not desired that the law of survivorship should take effect severance of joint interest should be effected by the co-patentees.

Severance of interest.

Register of Patents.

A Register of Patents is kept at the Patent Office in accordance with Section 23 of the Patents Act. Every patent upon being sealed is entered upon this Register, and all dealings with the patent, whether by assignment, licence, amendment, extension, or revocation, and, in short, everything affecting the validity or proprietorship of the patent, should be entered on the Register by those concerned.

Entries on the Register.

Documents affecting patent only registrable after sealing.

The patent is registered immediately upon being sealed, and, as the Comptroller recognises no property in the invention until after the grant, no documents affecting to deal with the patent will be registered until the patent has been sealed.

Notices of trusts not entered on Register.

No notice of any trust can be entered on the Register (*Haslett v. Hutchinson* (1891), 8 R. P. C. 157); but an equitable assignment of a patent or share therein may be entered on the Register as a document affecting the proprietorship of the patent (*Stewart v. Casey* (1891), 9 R. P. C. 15). An agreement made *before* the filing of an application, and referring to proposed dealings with the patent to be afterwards obtained, was refused entry on the Register even after the sealing of the patent.

Query as to agreements made before application.

This was decided in *Parnell's Patent* (1888), 5 R. P. C. 126); but North, J., in refusing the motion to compel entry on the Register, declined to lay down as an absolute rule that no document executed before the date of application could be entered on the Register after sealing. Probably an agreement made before the date of application, but having attached to it, as an exhibit, a model or description and drawing of the invention, would be capable of registration if the model or description or drawing corresponded clearly with the invention for which application was afterwards made.

Registration of assignments and licences.

An assignment, licence, or other deed affecting the ownership or use of the patent should be immediately registered by the person claiming to be entitled under the assignment, licence, &c. The fee for each entry in the Register is ten shillings.

Entries by joint patentees.

A joint patentee is not entitled to have any entry put upon the Register which will affect the rights of his co-owner: and such entry may, on

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application by the party prejudiced, be expunged by the Court (*Horsley and Knighton's Patent* [1879], L. R. 8 Eq. 475; 39 L. J. Ch. 137).

Entry of mortgages.

A notification of a mortgage of a patent may be entered on the Register, but the mortgagee is not entitled to be registered as proprietor (*Van Gelder, Apsimon & Co., Limited, v. Sowerby Bridge, Limited* [1896], 7 R. P. C. 208).

Procedure in placing entries on the Register.

A request for entry of any document on the Register should be left at or posted to the Patent Office, together with the original assignment, license, or other document, and also a copy of the same. The Comptroller, having made the entry in the Register, returns the original, bearing his certificate of entry, but retains the copy. If the assignment, license, or other document should refer to other documents of title, not being matters of record, an official or certified copy of these should accompany the request.

Bodies corporate registrable as proprietors &c.

A body corporate may be registered as proprietor in its corporate name, and any change of name, whether of a company or individual, arising by operation of law may be placed on the Register by the Comptroller under Section 87 of the Act (*per* North, J., in *re parte New Ormonde Cycle Co.* [1896], 2 Ch. 323; 13 R. P. C. 475). A certificate of the change of name should be obtained from the Registrar of Joint Stock Companies and filed with the request to vary the entry.

Inspection of Register.

The Register of Patents is open to inspection by the public, and a certified copy of any entry may be had on payment of a small fee.

Certified extracts *prima facie* evidence.

The Register is *prima facie* evidence of any matters directed or authorised to be inserted therein. Written or printed copies or extracts, certified by the Comptroller, and bearing the seal of the Patent Office, of patents, specifications, or of registers, books, and other documents kept there, are admitted in evidence, without proof or production of the originals, in all courts of law.

Rectification of Register.

The Register may be rectified by an order of Court made on the application of any person aggrieved (*re Horsley*, L. R. 8 Eq. 475; and see also Section 90 of the Act).

# CHAPTER XVI.

## AMENDMENT OF SPECIFICATION.

Amendments before sealing at instance of Comptroller.

THE Provisional Specification might be required to be amended by the Comptroller prior to acceptance under Section 7 of the Act, and the Complete Specification might similarly be required to be amended under Section 9. But these amendments are rather of the nature of supervisory directions by the Comptroller in the event of the invention not being fairly described, or the title being incorrect, or the drawings inadequate, or the Complete differing from the Provisional Specification—all as set forth in the said Sections 7 and 9. If the applicant differs from the Comptroller upon the advisability of these corrections or amendments he may appeal to the Law Officer, whose decision is final. Amendments in the specification might also result from opposition to the grant as set forth in Chapter XIV.

Amendment by patentee.

But what is intended to be dealt with in this chapter is the amendment of the specification upon the initiative of the patentee himself.

Reasons for amendment.

For example, it often happens that after the Complete Specification has been filed, or after the patent has been granted, the applicant or patentee finds that he has claimed something which turns out to be old, or that in some other respect his specification requires amendment.

Section 18, Sub-section 1.

Provision for such amendment has been made in Section 18, Sub-section 1, of the Patent Act:—

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

Limits of amendment.

The words in italics show the limits within which amendments must be confined. The amendment may consist of striking out, correcting, or making clear, but it must not in the slightest degree increase the scope of the patent.

Claim too wide.

The most usual cases of amendment are those in which the patentee has made his original claim too wide; but there are also instances where the amendment may be only of the nature of correction or explanation.

Amendment of drawings.

In several instances mistakes in the drawings have been allowed to be amended without altering a word in the specification, as, for example, in the case of *re Abel's Patent* (*Lawson on Patents*, 3rd ed., p. 73), the specification of which was found faulty in respect of the drawings during the trial in *Otto v. Linford* (1881, 46 L. T. N. S. 35), the defects being afterwards corrected by the filing of new drawings. New drawings may also be added to define the amendment (*per* Clarke, S.-G., in *re Lang's Patent* (1890), 7 R. P. C. 469; Good. O. C., 1st Appendix 17).

Persons entitled to amend.

The persons entitled to amend are the applicant or patentee, the term "patentee" meaning (*per* Section 46) the person for the time being entitled to the benefit of the patent. Thus, an assignee may amend, and where a patentee has assigned part of his patent the part assignee should join with him in amending. Where a patent has been mortgaged the mortgagee should join with the beneficial owner in amending (*re Church's Patents* (1886), 3 R. P. C. 95). A mortgagee alone could not amend.

Specification may be amended more than once.

The expression "from time to time" in Section 18 imports that a specification may be amended and re-amended more than once. But repeated disclaimers are not encouraged, and if the matter goes to the Law Officer on appeal the successful applicant to amend may be refused costs (*re Haddan's Patent*, Good. O. C. 62; Griff. A. P. C. 12).

Nature of amendments.

The nature of such amendments as are permissible under Section 18 cannot be set down in general terms; but in all cases they must, in accordance with the Statute, only cut down and explain, and never add to the scope of the patent.

But a description originally insufficient cannot generally be made sufficient (*Johnson's Patent* [1896], 13 R. P. C. 659), especially where the patent is old or where the amendment introduces subsequent knowledge. The scope of a specification cannot be extended to cover apparatus subsequently brought into use. Thus it was not allowed to extend the application of a steam escape nozzle to a gas engine exhaust (*Beck and Justice's Patent*, Good. O. C. 72; Griff. A. P. C. 10). Where it is clear that a patentee has not prepared his original specification in good faith and with reasonable skill and knowledge, in many cases he cannot, under colour of an amendment, retrieve his shortcomings (*Needenfell's Patent*, Good. O. C. 70; Griff. A. P. C. 18); but in *Morgan's Patent* (Good. O. C. 70; Griff. A. P. C. 17) the patentees were allowed to correct a misdescription, and describe more fully a figure of the drawings which had before been insufficiently described. A general claim having been originally made, no amendment which strikes out the general claim and substitutes claims for subordinate parts will be allowed. When a patentee has described and claimed an improved method of manufacture without indicating particular means or machinery, no amendment introducing and claiming particular means or machinery will be allowed (*Niven's Patent* [1891], 8 R. P. C. 444; *Lang's Patent* [1890], 7 R. P. C. 471).

Insufficient description.

Amendment must not extend patent.

General claim cannot usually be altered to claims for subordinate parts.

When the specification and drawings are clear, but the claim has been drawn in such a manner as to be ambiguous, the claim may be amended so long as the amendment is clearly of a restrictive nature (*Ashworth's Patent*, Good. O. C. 66; Griff. A. P. C. 6). It is evident from the remarks of Webster, A.-G., in *Johnson's Patent* ([1896] 13 R. P. C. 659), that a manifest error made by a British agent in translating or describing a foreign principal's invention may be cured by amendment.

Ambiguous claim may sometimes be corrected.

Clear error may be amended.

Where a feature in a claim is apparently set forth as an essential, whereas evidence adduced shows that it could not have been so meant, the defect might be cured by amendment (see *Moser v. Marsden* [1893], 13 R. P. C. 24).

Error in claim.

General claims for subordinate features cannot be turned into one claim for a combination; neither can a claim for

Claim for combination cannot

be made claim for details.

a combination be altered to a claim for details described in the specification (*Sewell's Patent*, [1889], 6 R. P. C. 103).

No special reference to opponent's patent.

An opponent to an amendment cannot obtain a special reference to his patent in the applicant's specification (*Hampton and Facer's Patent*, Good. O. C. 71; Griff. A. P. C. 13). In the same case it was held that the applicant may not impute disadvantages to a method of manufacture of the kind described and claimed by the opponent; and further, that if the applicant accepts the Comptroller's decision he cannot advance further evidence before the Law Officer.

Old patents more difficult to amend.

An application to amend a patent which is nearing its expiration is more narrowly scrutinised than amendments of less mature patents (*Johnson's Patent*, [1896], 13 R. P. C. 659).

Amendment once granted cannot be questioned except where fraud alleged.

*Moser v. Marsden.*

Before the decision of the House of Lords in *Moser v. Marsden* ([1895] 13 R. P. C. 24), to the effect that an amendment once granted by the Patent Office cannot afterwards be contested in a subsequently tried action for infringement, except on the ground of fraud, the Law Officer, in case of doubt, was accustomed to incline in favour of the patentee. Now, however, that *Moser v. Marsden* has established that the propriety of an amendment cannot be questioned in after proceedings, the Comptroller or Law Officer is more strict, and no doubt amendments which might have been accepted with some dubiety previous to this decision would not now be allowed. *Per* Lord Watson, in *Moser v. Marsden*, the unamended specification may be referred to for the purpose of construing the amended.

Reasons for amendment.

The reasons given in the "request in writing" to amend must, of course, vary with circumstances. A discovery by the patentee that part of the claimed invention is old, or that the description is not perfectly clear, or that the new parts are not sufficiently differentiated from the old, forms usually the reason for amendment. But if the reason given in the request should turn out to be erroneous the request could be corrected without affecting the acceptance of the amendment. Any reason which gives colour to the deduction that lack of good faith or of reasonable skill and knowledge affected the preparation

Request to amend may be corrected.

of the original specification and claims would, however, seriously prejudice the acceptance of the amendment.

Former practice in amending patents under old Act.

After the present Act came into force, when applications to amend were made, it was held that in the case of all patents granted under the Act of 1852, as a general rule, a condition should be imposed that no action should be brought or other proceeding taken in respect of any infringement prior to 1st of January, 1884 the date when the new Act came into force. But as all patents under the old Act have now expired that condition no longer holds good.

Power of Law Officer to impose conditions, section 18, Sub-section 4.

As regards patents granted under the present Act, although apparently Sub-section 4 of Section 18 gives the Law Officer power to impose conditions in respect of amendments, and although according to Finlay, S.-G., in *Ainsworth's Patent* ([1895] 13 R. P. C. 76) and in *Allison's Patent* ([1898] 15 R. P. C. 408), the Law Officers recognise that they have such power, and might under exceptional circumstances use it, nevertheless it was early held by Clarke, S.-G., in *Allen's Patent* (Good. O. C. 64; Griff. A. P. C. 31), that the Law Officer will not as a rule impose conditions, but will leave the Court to deal with the matter under Section 20 of the Act. This section provides that 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.*

Section 20.

Power of Court to impose conditions in action for infringement.

There is practically no more difficulty in amending the specification of a patent which has been sealed than there is in amending a specification not yet sealed. In the former case the official fee is £3, and in the latter case £1 10s.

Fees on amendment.

The formalities to be complied with in making application for leave to amend may be briefly stated.

Procedure in amending.

The request for leave to amend a specification must be signed by the applicant or patentee. The amendment or amendments should be shown in red ink on an officially

Advertisement.

certified copy of the printed specification. If accepted by the Comptroller the request to amend is advertised in the *Official Patent Journal*, and generally in one or two newspapers. For example, if the patent relates to knitting machines the Comptroller might require the proposed amendment to be advertised in a district devoted to such an industry: for instance, in Leicester. If to cotton machinery it might be required to be advertised in Manchester. The heading of the advertisement invites opposition from anyone interested.

Persons entitled to oppose amendment.

According to Section 18, Sub-section 2, "any person" may oppose the granting of the amendment, but practically to entitle an opponent to be heard he must be a person interested, who is threatened or aggrieved or prejudiced by the proposed amendment. His interest must be equivalent to the interest of a person entitled to be heard in opposition to the grant of a patent, and the Law Officer may decide finally whether or not he is entitled to be heard (*per* Smith, L. J., in *Reg. v. Comptroller, ex parte Tomlinson* 1899, 16 R. P. C. 233; 1899 1 Q. B. 909; 68 L. J. Q. B. 508). In *Bell's Patent* (Goel. C. C. 13; Griff. A. P. C. 10) the opponents contended that the amendment would make the invention the same as that comprised in two prior patents in which the opponents had no interest. Here it was ruled that the opponents were not entitled to be heard on these grounds.

Decision rests with Law Officer.

Limit of time for opposing.

The time within which opposition to an amendment will be entertained is one month from the date of the advertisement in the *Official Patent Journal*. The notice of opposition bears a stamp of ten shillings. It must contain the full name and address of the opponent, and state the reasons of opposition. The applicant is advised of the opposition by the Comptroller, and thereafter declarations are filed by the opponent in support of his opposition within fourteen days of the expiry of one month from the date of the advertisement. The proceedings and rules as to declarations are identical with those already described with reference to the opposition to the grant of a patent.

Declarations by opponent and applicant.

Decision.

The decision of the Comptroller is subject to an appeal to the Law Officer, whose decision is final.

Amendment during legal proceedings.

It now remains to consider the question of the amendment of a specification in respect of which legal proceedings are pending, such, for example, as an action for infringement or proceedings for revocation. The plaintiff patentee sometimes finds on receipt of the defendant's defence and particulars of objections that there are defects in his patent which very greatly minimise his chances of success. His claim, for example, may be so wide as to trench upon the subject-matter of some prior user or prior patent which the defendant cites, or his attention may have been called to some question of disconformity. So he makes up his mind to disclaim the dangerous surplusage. But having submitted himself to the Court he cannot (unless he drops his action and pays the defendant's costs) apply to the Comptroller to amend without getting leave from the Court. Provision for this is made in Section 19 of the Act, which runs as follows: —

Plaintiff wishing to amend must either drop action or obtain leave of Court.

Section 19.

> "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 Judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification *by way of disclaimer*, and may direct that in the meantime the trial or hearing of the action shall be postponed."

By disclaimer only.

The reader will note that the scope of the amendment is more limited than in Section 18. It is to be by way of *disclaimer* only.

Leave usually granted.

When the application is made in due form to the Court—say by summons at chambers—leave to disclaim will as a rule be granted, if reasonably good cause is shown.

Sometimes refused.

The Judge might, however, in the exercise of his discretion (for example, if he thinks there is absolutely no invention left) refuse leave to apply (*Armstrong's Patent* [1897], 14 R. P. C. 747; 77 L. T. N. S. 267). But leave is only granted upon conditions, and the Judge has full discretion as to what these conditions shall be. As the

Conditions within discretion of Court.

Court of Appeal will not interfere with the exercise of the Judge's discretion unless satisfied that injustice has been done (*Woolley v. Broad* [1892], 9 R. P. C. 492; *Wilson Bros. v. Wilson & Co.* [1899], 16 R. P. C. 315; *re Allison's Patent* [1900], 17 R. P. C. 513) it is necessary to prosecute the application in the first instance with the greatest care. Affidavits of the patentee and others tending to show that reasonable skill and knowledge were exercised in preparing the original specification and claims should be filed. If the Court decides to grant leave to apply to amend, the conditions may be varied in accordance with the circumstances. For instance, in *Pease Vesta Co. v. Bryant & May* (1887: 4 R. P. C. 71), where little had been done beyond the issue of the writ, it was ordered that the costs of the defendants up to and including the application for leave to amend and consequent upon the amendment should be paid by the plaintiffs in any event. But in *Haslam Foundry Co. v. Goodfellow* (1887: 5 R. P. C. 28; L. R. 37 Ch. D. 118), where the pleadings had been closed and the action set down for trial before the application was made, the plaintiffs were ordered to pay in any event the costs of the application and the costs of and occasioned by the disclaimer, except so far as the proceedings in the action might be utilised for the purposes of the trial, other costs being reserved.

Conditions vary in accordance with circumstances.

Costs of amendment in action.

The costs in the Patent Office of obtaining or opposing the disclaimer will not be the subject-matter of direction by the Court (*Pease Vesta Co. v. Bryant & May, supra*) unless under exceptional circumstances (*Gadd v. Bradley* [1884], 1 R. P. C. 209). The costs "occasioned by the disclaimer" do not include any costs which may be incurred by the defendant in opposing in the Patent Office the plaintiff's application to disclaim.

Plaintiff and defendant allowed to amend pleadings after disclaimer without leave.

The order giving leave to apply to the Patent Office usually provides that the plaintiff and defendant shall be allowed to make the necessary amendments in their pleadings after disclaimer, and that the action should meanwhile be stayed (*Haslam Foundry Co. v. Goodfellow, supra*; followed by Byrne, J., in *Chatwood's Patent* [1899], 16 R. P. C. 370).

Exceptional conditions sometimes imposed. *Dudley v. Perkes.*

Exceptional circumstances might, however, bring about the imposition of more severe conditions. For example, in *Dudley v. Perkes* ([1896] 13 R. P. C. 381) the House of Lords imposed the additional terms that the plaintiff should not bring or maintain any action for infringement in respect of anything done before the date of the hearing of the appeal. But the circumstances here were very exceptional. One claim only of the original five was proposed to be retained. The patent had been revoked for over a year, and large quantities of guns with the patented parts had been sent out by the defendants and by others in the trade. Kekewich, J., in *Luddington Cigarette Co. v. Baron Cigarette Co. (In re Pill's Patent* [1900], 17 R. P. C. 750), thought himself bound by the decision in *Dudley v. Perkes* to impose this condition as a common form; but the Court of Appeal, although upholding the order, emphatically repudiated any such idea. Lindley, M. R., said: "I protest altogether against the notion that the order in *Dudley v. Perkes* ought to be regarded as the laying down of a settled form." On appeal the House of Lords were of the same opinion. The exceptional circumstances in this case were, *inter alia*, that out of twenty-two claims twenty were disclaimed. Exceptional circumstances—viz., the dropping of nine claims out of fourteen, delay in seeking amendment, and other points prejudicial to the applicants—led to the imposition of similar conditions in *Allison's Patent* ([1900] 17 R. P. C. 513). In this case Webster, M. R., expressed a doubt whether, when the Court is seised of the matter (as in an action for infringement or petition for revocation), the Law Officers had any jurisdiction to deal with the question of conditions.

*Luddington Cigarette Co. v. Baron Cigarette Co.*

Lindley, M. R., on conditions of amendment.

Webster, M.R., doubts whether in amendments *pendente lite* Law Officers have any jurisdiction as to conditions.

In considering the nature of the conditions to be imposed the Court will take into account the age of the patent, the amount of matter disclaimed (in the *Luddington Cigarette Case*, *supra*, twenty claims were dropped out of twenty-two), the character and cost of the patented article, and other incidental points.

Damages very seldom given in respect of infringements before disclaimer.

Damages in respect of infringements committed prior to amendment are scarcely ever awarded, but such damages were given in *Hopkinson v. St. James Electric Light Co.* ([1892] 10 R. P. C. 46), where the invention

was exceedingly meritorious and good faith was apparent in the original claim. The claim for such damages should be specially pleaded (*Kone v. Boyle* (1901), 18 R. P. C. 325). Such damages are never given in cases where the patent has been declared invalid by the Court.

Proposed form of disclaimer not usually considered by Court.

The Court will not, as a rule, enquire into the particulars of the amendment, these being for the Comptroller or Law Officer to consider (*re Hallock's Patent* (1896), 13 R. P. C. 501).

Order of Court giving leave to apply, left with request to amend.

In presenting the request to amend at the Patent Office a certified copy of the Order of the Court should be left with the request. The amendment will then be considered by the Comptroller, and a hearing given to the applicant. The Comptroller's decision is subject to appeal to the Law Officer.

Defendant may oppose.

The defendant may appear in opposition, and may ask for the imposition of terms by the Comptroller, but, as already said, the Patent Office authorities usually leave the defendant to his remedy under Section 20.

Law Officer will not impose larger conditions than the Court.

In *re Pitt's Patent* (1901), 18 R. P. C. 478) the opponents, who were also the defendants in an action for infringement, asked the Law Officer to impose larger terms by extending the conditions laid down by the Court to the effect that no action might be brought or maintained in respect of infringements committed *prior to the date of the amendment*. But Carson, S.-G., following Clarke, S.-G., in *re Allen's Patent* (Good, 6, C. 161), refused to impose terms in excess of those laid down by the Court.

Costs before the Comptroller and Law Officer.

The Comptroller has no power to award costs in oppositions to amendments, but the Law Officer may give costs to the successful appellant or respondent.

# CHAPTER XVII.

## ACTION FOR INFRINGEMENT.

Infringement.

DURING the fourteen years term of patent right the privilege of making, using, exercising, and vending the invention is limited to the owner of the patent and his representatives. Any person making or dealing with the patented article in an unauthorised manner is an infringer. Importation from abroad is an offence (*British Motor Syndicate v. Taylor* [1900], 17 R. P. C. 723), even if the infringing articles are immediately re-exported. But an English merchant who, in pursuance of a contract made in England, delivers a patented article at a foreign port to an English importer does not infringe, seeing there is no actual making, using, exercising, or vending of the invention within the realm (*Saccharin Corporation v. Reitmeyer* [1900], 17 R. P. C. 606; [1900] 2 Ch. 659). If a person makes a sample of the patented thing merely experimentally he does not infringe, but if he sells it or uses it for profit the case is otherwise (*per* Jessel, M. R., in *Pearson v. Law* [1878], L. R. 9 Ch. D. 48; 26 W. R. 138). But the very slightest real use of such an experimental manufacture would constitute infringement.

Importation is infringement.

But not where contract though made in England is executed abroad.

Experiment not infringement.

A person who merely uses something which is an infringement is liable as an infringer, and it does not matter whether he is an innocent user or not.

Mere user is infringer.

Necessary use of an infringing article in a foreign vessel touching at a British port is not an infringement (Patent Act, Section 43).

User in foreign vessel.

Sale of the infringing article is an offence, and, as in the case of user, the ignorance of the seller is no excuse. Even the mere offering for sale, although no sale is effected, constitutes infringement (*Incandescent Co. v. New Incandescent Co.* [1898], 15 R. P. C. 81; *British Motor Syndicate v. Taylor* [1900], 17 R. P. C. 723), in respect of which an injunction can be obtained. According to the dictum of

Sale or offering for sale is infringement.

Lord Alverstone in the latter case mere possession with a view to sale is infringement.

Unauthorised advertising is ground for injunction.

Advertising an infringing article justifies an action to restrain infringement. Jessel, M. R., in *Pearson v. Lee* (*supra*), laid down that "if a patentee has reasonable ground to apprehend that a man will infringe his right he can come to the Court and obtain an injunction to restrain him from carrying out his intention" (quoted and approved in *Dowling v. Billington* [1890], 7 R. P. C. 191).

Exhibition without intent to sell.

Merely showing a machine carrying the patented invention at an exhibition, without the intention of selling, is an offence (*Dunlop v. British Cycle Co.* [1901], 18 R. P. C. 313).

Repair of patented invention.

A patented article may be repaired by its purchaser so long as no renewal of the essential parts of the invention is effected. In *Dunlop Co. v. Neal* ([1899] 16 R. P. C. 247; [1899] 1 Ch. 807; 80 L. T. 746), the defendant was held to have infringed because he had fitted a fresh cycle tyre cover to the old inextensible wire rings, the patent being for the combination (see also *Dunlop v. Excelsior Rubber Co.* [1901], 18 R. P. C. 209, and *Dunlop v. Holborn Tyre Co.* [1901], 18 R. P. C. 222).

Implied licence by authorised seller.

When a patented article has been sold by anyone who does so lawfully, an implied licence attaches to all subsequent sales and resales (*Thomas v. Hunt* [1864], 17 C. B. N. S. 183). But a patented apparatus taken under a distress from a licensee cannot be used without a fresh licence (*British Mutoscope Co. v. Homer* [1901], 18 R. P. C. 177).

Infringement by disregard of conditions of sale.

A patented article may be sold subject to a condition as to use (*Incandescent Co. v. Brogden* [1899], 16 R. P. C. 179). But such condition would be binding only on those to whose notice the condition had been brought when purchasing (*Incandescent Co. v. Cantelo* [1895], 12 R. P. C. 262).

Infringement by workman.

A workman who has infringed in disobedience to the express orders of his master is liable, and also renders his master liable for infringement (*Betts v. De Vitre* [1864-73], L. R. 3 Ch. 429, at p. 442; 6 H. of L. 319; 34 L. J. Ch. 289, 291).

Indirect infringement: use

In *Saccharin Corporation, Limited v. Anglo-Continental Works, Limited* ([1900] 17 R. P. C. 307; [1901]

of patent materials abroad in making imported product.

1 Ch. 414), a material was imported into this country which had been manufactured abroad by the aid of constituents patented by the plaintiffs. The nature of the constituents was chemically changed by the process of manufacture, and the imported product was not the patented invention. The Court held that the defendants were indirectly depriving the patentees of the benefit of their invention, and granted an injunction. Carriers who transport infringing articles into this country are liable to be restrained by injunction (*Washburn Manufacturing Co. v. Canard Co.* (1890), 6 R. P. C. 308).

Carriers.

Action for infringement.

When the owner of a patent discovers that it is being infringed by manufacture, or use, or sale, or importation, or that the invention is otherwise being dealt with in a manner constituting infringement, he may seek his remedy by instituting an action for infringement. He must not threaten unless he means business. If he does he may find the tables turned by having an action brought against him by the threatened party under Section 32 of the Act. But before commencing proceedings a patentee should always make sure that he is upon firm ground. Therefore, if he has not done so before, let him get a careful search made among the patent and other records to see if in any respect his patent is anticipated wholly or in part. If anything should be found that causes him doubt, let him amend his specification as set forth in the last chapter. Having re-assured himself as well as he can as to the soundness of his patent, he may then, after reasonable negotiation with the infringer (*Lyon v. Mayor of Newcastle* (1894), 11 R. P. C. 218), issue the writ. The action should by preference be entered on the Chancery side, as the machinery of the Chancery Courts is better fitted than that of the King's Bench Division for the trial of patent actions. The practice also in interlocutory proceedings in patent matters has been much better ascertained and crystallised into recognised precedents, which do not always hold good on the Common Law side. The Vice-Chancellor of the County Palatine of Lancaster has jurisdiction to try patent actions; but County Courts have no such power where the validity of the patent is in

Threats.

Clearing for action.

Preliminary negotiations.

Chancery Division for patent actions.

Where the validity of the patent is in dispute, County Court no jurisdiction.

dispute (see Section 117, Sub-section 1, and *Reg. v. County Court Judge of Halifax* [1891], 8 R. P. C. 333; 60 L. J. Q. B. 550).

Endorsement of writ.

The writ should be endorsed with a claim for—(1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's Patent No. of 190 ; (2) Damages, or, in the alternative, an account of profits; (3) Delivery up or destruction of the infringing articles. It is not necessary to ask for costs: but if the plaintiff is in possession of a certificate that the validity of his patent has been questioned in a former action costs as between solicitor and client should be claimed.

Plaintiff.

As to the parties in the action, the plaintiff might be the patentee or the assignee or the mortgagor, either alone or joined with the mortgagee. Co-owners of a patent should join, but one co-owner alone may take action where injunction and delivery up only are asked. A licensee, whether exclusive or general, cannot sue; neither can an exclusive agent for the sale of a patented article, although it has been said that an exclusive licensee may use the name of the patentee for this purpose (*Heaard v. Levinstein* [1911-5], 2 H. & M. 628; Good. P. C. 400). The assignee and trustee of a bankrupt patentee or legal owner may sue. If the plaintiff has acquired the patent from someone else, and if any of the infringements have taken place during the former proprietorship, it would be advisable to join the former owner as co-plaintiff.

Defendant.

The defendant might be the person manufacturing the infringing goods or the user or seller. An importer into this country of goods patented here could be sued, even if a mere carrier (*Washburn Manufacturing Co. v. Cunard Co.* [1889], 6 R. P. C. 305). A corporation, and also its servants, can be sued for infringement.

No action till patent sealed.

The plaintiff cannot take action for infringement until the patent has been sealed and issued, and then only in respect of infringements committed after the acceptance and publication of the Complete Specification (see Section 13).

Entering appearance by defendant.

The defendant should enter an appearance within eight days, and until he does so no further steps can be taken in the action. If the case is of great urgency leave might be obtained to serve notice of motion with the writ, or an

*ex parte* application might be made before appearance for an interlocutory injunction, but exceptionally good cause would require to be shown. After appearance of the defendant the plaintiff might apply for an interlocutory injunction, but this is very seldom granted, since, if the defendant has any defence at all, it would necessitate going into the whole question of the cause of action, which at this stage could not conveniently be done. No interlocutory injunction will be granted if the Court is satisfied that the defendant has no intention of continuing the infringement (*Lyon v. Mayor of Newcastle* [1894], 11 R. P. C. 218). If the patent is of some age and its novelty has not previously been challenged, and a *primâ facie* case of infringement is established, the plaintiff is, generally speaking, entitled to an interlocutory injunction (*Skillito v. Isaacs* [1884], 2 R. P. C. 1). The same may also be said where the validity of the plaintiff's patent has been upheld in a former action, or where the defendant has not ventured to challenge the validity, but in either case a *primâ facie* case of infringement must be shown. When the patent is recent, and its validity is disputed, no interlocutory injunction will be granted. Undue delay in bringing an action after knowledge of the infringement will also prejudice the plaintiff's claim to an interlocutory injunction (*Borrill v. Crate* [1885], L. R. 1 Eq. 388; *North British Rubber Co. v. Gormully & Co.* [1894], 12 R. P. C. 17; *Leonhardt v. Kalle* [1894], 11 R. P. C. 331), unless there are special circumstances which excuse delay (*United Telephone Co. v. Equitable Telephone Co.* [1885], 5 R. P. C. 233). A defendant may often avoid being subjected to an interlocutory injunction by undertaking to keep an account pending trial (*Leonhardt v. Kalle, supra*). Where hardship to the defendant would ensue by the stoppage of large works or expensive machinery an interlocutory injunction is not readily granted (*Neilson v. Forman* [1841], 2 Coop. Ch. Ca. 61).

Interlocutory injunction.

Interim injunction never granted where defendant discontinues.

Depends on standing of patent and proof of infringement.

Delay.

Offer of defendant to keep account.

Any order granting an interlocutory injunction should, and generally does, in the defendant's interests, contain a clause that, in the event of the defendant succeeding in the action to be afterwards tried, any damage suffered by the defendant through the order should be made good by the plaintiff.

Condition in order re damages.

Statement of claim.

The writ having been served and appearance entered, it then falls upon the plaintiff to deliver his statement of claim. This is governed by the ordinary rules, but there is an additional statutory obligation upon the plaintiff under Section 29, Sub-section 1, of the Act, to deliver at the same or at a subsequent time particulars of breaches, showing the particular instances of infringement of which he complains. In his statement of claim the plaintiff should plead the grant of his patent, identifying it by number, date, and title, and showing the devolution of ownership should the plaintiff be other than the original patentee. He might also plead that the letters Patent are valid and subsisting (although this is not necessary), and state generally that the defendant has infringed. The concluding claim should be similar to that endorsed on the writ: viz. —For an injunction to restrain the defendant, his servants, workmen, and agents, from making, selling, supplying, using, advertising, or offering for sale, or otherwise wrongfully dealing with or in goods made in infringement of the plaintiff's patent; damages or an account; and delivery up or destruction of the infringing articles. If the validity of the plaintiff's patent has been established in a former action, then he should claim costs as between solicitor and client, and should plead the certificate (*per* Chitty, J., in *Pneumatic Tyre Co. v. Thisholm* [1896], 13 R. P. C. 488).

Particulars of breaches (Section 29, Sub-section 1).

Contents of statement of claim.

Certificate of validity if existing should be pleaded.

Particulars of breaches to contain alleged instances of infringement.

In the particulars of breaches delivered with the statement of claim all the alleged instances of infringement known to the plaintiff should be set out, with date, place, and name. The purpose of particulars is to let the defendant know exactly what he has to meet at the trial, and if the transactions alleged to constitute infringements are not admitted they must be proved.

Particulars should, as a rule, be unqualified.

The allegations of infringement should be, generally speaking, unqualified. Such words as "in particular" or "by way of example and not of limitation" or the like are liable to be struck out (*Haslam v. Hall* [1887], 4 R. P. C. 203). When the plaintiff's patent contains several claims he should point out the claim or claims alleged to be infringed. Except by leave of the Court, which is not easily obtained, instances of infringement not

appearing in the particulars of breaches cannot be proved at the trial (*Heuser v. Hardie* [1894], 11 R. P. C. 421).

Defence.

The defendant should deliver his defence within ten days from the delivery of the statement of claim, or within such enlarged time as the plaintiff or the Court may allow.

Contents of defence.

The usual defence is (*a*) that the defendant has not infringed; (*b*) that the patentee was not the true and first inventor (but in such case the defendant must be prepared to show who was the true and first inventor); (*c*) that the patent is invalid from want of novelty or utility or want of subject-matter, or because of disconformity, or from insufficiency, or from other causes.

Particulars of objections (Section 29, Sub-section 2. Particulars of objections should clearly point out and delimit grounds for attacking validity of patent.

The defendant must also deliver with his defence, and in accordance with Section 29, Sub-section 2, particulars of objections to the patent. The particulars of objections should be divided into paragraphs, and must give full particulars of the grounds upon which the defendant disputes the validity of the patent. Thus, if the defendant pleads prior publication he must identify the prior specifications or books he depends on. If the prior specification or publication is very short and simple he may refer to the whole: but if the prior publication is long and involved, and if it contains matter other than that affecting the plaintiff's patent, then the defendant ought to give the pages, lines, and figures he relies on. According to Scotch practice it is apparently not required that the defendant should give pages and lines of alleged anticipating specifications (*Rose's Patents Co. v. F. Braby & Co.* [1894], 11 R. P. C., p. 206, line 28).

Scotch practice.

Should indicate the claims attacked.

If the plaintiff's specification has several claims the defendant should point out the particular claims affected by the anticipatory matter (*London and Leicester Co. v. Higham*, "Lawson on Patents," 3rd ed., p. 172; *Harris v. Rothwell* [1886], 3 R. P. C. 243; *Boyd v. Farrer* [1887], 5 R. P. C. 33). But apparently he need only do so when the plaintiff's specification is long and involved and the claims numerous. North, J., in *Heathfield v. Greenway* ([1893] 11 R. P. C., p. 19), said that there must be special grounds for imposing such an order on the defendant. If the plaintiff thinks the particulars of objections are insufficient or too vague he may apply by summons

Present practice in applications for further and better particulars.

for further and better particulars. It must, however, be said that under the most recent practice it is becoming increasingly difficult to get the Court to compel the defendant to narrow his particulars of objections to pages and lines of the alleged anticipatory specifications, even when it may appear desirable that this should be done. If the defendant says that it would embarrass him to do so, and especially if he has an affidavit from his technical expert to this effect, the Court will seldom interfere. To enable the Judge to come to any decision on his own initiative he would require to go carefully through all the specifications, which would be almost equivalent to trying the action at this stage of the proceedings, and this he will not do. Therefore when the defendant says that he cannot discriminate parts of the specifications without embarrassing himself in his defence, he is generally allowed to refer to the whole. If at the trial it turns out that he is wrong, he will have to pay the costs (*per* Buckley, J., in *Edison-Bell, Limited v. Columbia Phonograph Co.* [1906], 18 R. P. C. 1).

Prior publications.

Prior user as an objection.

If the defendant relies upon prior user he must, in his particulars and in accordance with Sub-section 3 of Section 29, tell when, where, and by whom such prior user was effected; and if the article or part of it can be produced so much the better. If the defendant relies on general common knowledge he need plead no specific instances of prior publication or user (*Holliday v. Heppenstall* [1890], 6 R. P. C. 320); but he must be prepared to prove such a general and common trade knowledge and user as will bring it within this category. If he pleads disconformity the defendant must point out exactly where the Complete Specification differs from the Provisional.

No particulars need be given of general common knowledge. *Holliday v. Heppenstall.*

Disconformity.

Non-utility, insufficiency.

If he pleads non-utility or insufficiency he must point out the portion he is prepared to prove inoperative, or the exact parts of the specification he contends to be insufficient (*Headfield v. Greenway* [1893], 11 R. P. C. 17). The more exact and full the defendant is in his particulars of objections the less is he likely to be subjected to applications by the plaintiff for further and better particulars.

Defence of prior grant.

A further defence of comparatively recent origin is the defence of prior grant of a patent to another for the same invention. This defence is not often used, but the circumstances under which it might be raised are as follows:—Suppose that, prior to the plaintiff's application, someone else had, say six or eight months before, filed an application for the same or substantially the same invention. This application not having been published or made known at the time the plaintiff protected his invention, the plaintiff might complete his application, and obtain his patent, unconscious of the fact that the prior applicant had obtained his patent in advance. The result would be that two grants were in existence for the same thing. Now suppose the second grantee were to take action against an independent party for infringement, the defendant who wished to avail himself of the existence of the prior grant would be wholly unable to make use of the ordinary defence of prior publication, seeing that there had been no prior publication, the first grantee's specification not having been published when the plaintiff made his application. In this dilemma recourse is had to Section 26 of the Act, which says (Sub-section 3) that 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 for infringement. Now *Scire Facias*, to repeal Letters Patent, formerly lay in the case, *inter alia*, of a subsequent grant to another person of a patent already granted to someone else for the same invention. The defendant may therefore, by way of defence, plead the prior grant, since he could not plead prior publication, and such a plea has succeeded (*Rose's Patents Co. v. F. Braby & Co.* [1894], 11 R. P. C. 198; *Mica Insulator Co. v. Electrical Co., Limited* [1898], 15 R. P. C. 489). It is true that in *Rose's Patents Co. v. F. Braby & Co.* (*supra*) the head-note of the report does not make it plain that prior grant was the rock upon which the plaintiff's patent split, but a careful study of the report shows that in fact it was so. The patent of the plaintiff Rose was held invalid owing to the prior patent of Robinson, which was dated eight

Circumstances under which prior grant might be pleaded.

Section 26, Sub-section 3.

months prior to the plaintiff's patent, although *Robinson's* specification was not published until two months after the plaintiff's application. It is open to the plaintiff, in his reply, to attack and, if possible, to destroy the validity of the prior patent so as to remove it from his path, and this was done in *Brooks v. Lamplugh* (1897) 14 R. P. C. 597). In this case the patent pleaded as a prior grant was owned by one of the interested parties. But the question might well be asked whether the plaintiff would be allowed by the Court to attack the validity of a patent belonging to a third person not a party to the action?

Query whether particulars of prior grant would be ordered.

It is doubtful whether particulars of such prior grant would be ordered by the Court. The point was raised but not settled in *Birmingham Tyre Syndicate v. Belsize Tyre Co.* (1900) 17 R. P. C. 277).

Amendment of particulars of breaches and of objections.

The particulars of breaches and the particulars of objections may be amended from time to time by leave of the Court or a Judge (see Section 29, Sub-section 5). The application is usually made by summons at Chambers, but if the advisability of so amending should have been just then discovered the application might be made at the trial of the action. For example, in *Badische Anilin Fabrik v. Société Chimique* (1897) 14 R. P. C. 875) the defendants were allowed to introduce a new objection at the trial.

By summons and sometimes at trial.

In Court of Appeal.

The Court of Appeal, by Order LVIII. Rule 4, of the Rules of the Supreme Court, has jurisdiction to amend particulars of objection, introducing fresh evidence on the appeal (*Shoe Machinery Co. v. Cutlan* 1893, 12 R. P. C. 330, 65 L. J. Ch. 44; *Pirrie v. York Street Flax Spinning Co.* 1894, 11 R. P. C. 429), but such amendments are not readily granted. Whether in the Court of First Instance or in the Court of Appeal it must be shown by affidavit that the new evidence could not, even with the exercise of great diligence, have been discovered before (*Moss v. Malings* (1886), 3 R. P. C. 373; *Pirrie v. York Street Flax Spinning Co.*, *supra*).

Conditions of amendment.

In acceding to an application to amend particulars, the Judge has absolute discretion as to what conditions he may impose (*Woolley v. Broad* (1892), 9 R. P. C. 208; *Wilson v. Wilson* (1899), 16 R. P. C. 315). But, as a rule, the party

seeking to amend must pay to the other side all the costs of and occasioned by the application to amend. Where a defendant asks leave to amend his particulars of objections the conditions are usually those originated in *Baird v. Moule* (1876, L. R. 17 Ch. D. 139, *note*), and sanctioned in *Edison Telephone Co. v. India Rubber Co.* (1881, L. R. 17 Ch. D. 137), under which the plaintiffs were allowed to elect within a given time whether they would discontinue the action, and giving them, if they did so elect, their costs since the delivery of the original particulars of objections, the defendants to pay the costs of the application in any event. The order in *Ehrlich v. Ihlee* (1887, 4 R. P. C. 115) also provided that the costs of and subsequent to the amendment being made at that stage in the proceedings (the action having been set down) should be the plaintiff's in any event. If the plaintiff elects on the spot not to discontinue, the order will simply be that leave to amend is granted, the defendant to pay the costs of the application and all costs of and subsequent to the amendment (*Parker v. Mangnall* (1888), 5 R. P. C. 207).

*Baird v. Moule.*

*Edison Telephone Co. v. India Rubber Co.*

Seeing that by the common form of order the plaintiff in the event of discontinuance gets the costs between the original particulars of objections and the proposed amendment in the ordinary case of one amendment, it might be asked how the plaintiff would fare in the event of *repeated amendments?* Suppose *that an amendment* were made by the defendant, and that the plaintiff, having considered it, elected not to discontinue, but went on. Afterwards, suppose the defendant applied to make a second amendment. Should the plaintiff obtain an order giving him, in the event of discontinuance, the costs between the original particulars of objections and the second amendment, or only between amendment No. 1 and amendment No. 2? The Court of Appeal, in *Wilson v. Wilson* (1889, 16 R. P. C. 315), decided that in such a case the costs given to the plaintiff in the event of discontinuance should only be those between amendments Nos. 1 and 2 and not between the original particulars of objections and amendment No. 2. Smith, L. J., differentiated this case from that of *Ehrlich v. Ihlee* (1887, 4 R. P. C. 115), which was relied on by the appellants,

Form of order in the case of repeated amendments.

*Wilson v. Wilson.*

by pointing out that in the latter case no issue had been joined on the first amendment to the objections; in fact, from the report it appears that no prior amendment had ever been made by the defendants, but only two deliveries of further and better particulars on orders obtained by the plaintiffs. In *Wilson v. Wilson*, however, issue had been joined on the first amendment, the plaintiffs thus adopting and recognising the amendment as no more hurtful to their case than the original particulars of objections had been. The two cases were therefore clearly differentiated.

Inspection.

By Section 30 of the Act an inspection order may be granted to either party in an action for infringement. An application for such an order may be made by summons at chambers.

Procedure and grounds for inspection order.

A plaintiff to obtain an inspection order must show that an inspection is necessary to place his case properly before the Court (*Piggott v. Anglo-American Telegraph Co.* 'Isis', 19 L. T. N. S. 46), and he must file affidavits supporting these contentions and setting forth the grounds. Mere suspicion and personal belief will not do (*Crom Milling Co. v. Robinson* [1884], 1 R. P. C. 217). The defendant may resist such an order on general grounds, and particularly if he practises any peculiar course of manufacture or secret process or trade secret which he does not wish publicly known. But even in such a case the Court might appoint an expert, sworn to secrecy, to inspect the defendant's works and report to the Court (*Plating Co. v. Farquharson* [1879], Griff. P. C. 187). The Court might also order the taking of samples of the defendant's manufacture.

*Ex parte* orders.

Usually an application for an order for inspection is only made after notice given to the other side; orders on *ex parte* applications are made only under very exceptional circumstances.

Interrogatories.

In actions for infringement, as in other actions, interrogatories may be administered on either side by leave obtained from a Court or a Judge (Rules of the Supreme Court, Order XXXI., Rule 1). Five pounds at least must be paid into Court as security for costs before delivery of interrogatories is allowed.

The interrogatories proposed to be administered must be exhibited to the Court in making application. If sufficient reasons can be shown the party interrogated may refuse to answer. Either of the parties may appeal, but appeals are rarely successful unless there has been an absolute miscarriage of justice.

Interrogatories are sometimes resorted to when an application for further and better particulars would be the proper procedure. But where the particulars have been held to be sufficiently full interrogatories will not be allowed as an indirect means of amplifying such particulars (*Hoffmann v. Postill* (1869), L. R. 4 Ch. 673).

Purpose of interrogatories.

Interrogatories are often a useful means of shortening proceedings at the trial by getting either party to admit questions of fact that would otherwise require to be proved in Court—questions relating to infringement and the like. All interrogatories must be strictly relevant to the issue, and all "fishing" interrogatories or questions tending to incriminate the person answering need not be replied to.

The distinction between interrogatories as delivered by the plaintiff and by the defendant has been said to consist in this, that a plaintiff is not entitled to a discovery of the defendant's case, but a defendant may ask questions tending to destroy the plaintiff's claim (*Hoffmann v. Postill, supra*).

What interrogatories may and may not be answered.

Questions depending on the construction of the patent need not be answered, but interrogatories addressed to the plaintiff as to whether certain modifications were not necessary to make his patent operative were ordered to be answered (*Rylands v. Ashley* (1890), 7 R. P. C. 175). A body corporate may be interrogated through a member or officer of such body: but no member or officer can be compelled to answer concerning information acquired in any capacity apart from his then relationship to the company (*Welsbach Incandescent Gas Light Co. v. New Sunlight Co.* [1900], 17 R. P. C. 401).

Replies to interrogatories.

The replies to interrogatories must be made in affidavit form within ten days or within such extended time as a Judge may allow. According to Wood, V.-C., in *De La Rue v. Dickinson* (1857), 7 E. & B. 738; Good. P. C. 164), everything showing or merely tending to show

the fact of infringement must be set forth in the answer to the full extent of the interrogatories. In *Ashworth v. Roberts* (1890) 7 R. P. C. 451) interrogatories as to whether defendant had not hardened and tempered wire in a certain indicated manner and substantially as set forth in plaintiff's specification were ordered to be answered.

Interrogatories framed on plaintiff's specification.

Names of customers.

In *Lister v. Norton* (1885) 2 R. P. C. 68) interrogatories as to whether the defendant had sold their imitation sealskins to certain customers named were ordered to be answered. But if the defendant admits infringement and sales generally, sales to named persons need not be admitted. In *Saccharin Corporation v. Haines* (1898) 15 R. P. C. 344) interrogatories requiring the defendants to say if they had sold a certain description of saccharine, where it was made, and from whom they obtained it, were ordered to be answered. In *Bean and Jaffé v. Richardson* (1893) 10 R. P. C. 136) the interrogatories were framed on the statements in the plaintiff's specification, but did not refer to the Specification. North, J., decided that they must be answered.

Discovery of documents.

Discovery of any documents in the possession or power of either party may be had by order of the Court or a Judge.

Communications with patent agent not privileged.

Communications passing between a party and his patent agent cannot be pleaded as privileged from discovery or production, even where the patent agent is also the party's solicitor (*Moseley v. Victoria Rubber Co.* (1886), 3 R. P. C. 351; 55 L. T. N. S. 482).

Documents in former action.

Documents referring to matters in a former action and relevant to the issues in the action then proceeding—such, for example, as affidavits, notes of evidence, and the like—might in some cases be ordered for production (*Bean v. Sonson* (1888), 5 R. P. C. 510); see also the remarks of Cotton, L. J., in *Thomson v. Hughes* (1890) 7 R. P. C. 187).

Proof of title and production of Letters Patent.

When the action comes on for trial the plaintiff, if the validity or ownership of the patent is disputed, should prove his title and produce the Letters Patent. The construction of the specification, like that of any other written document, is left to the Court. Patent actions are generally tried without a jury (Section 28), although by

the same section the Court has power to direct that it shall be tried with a jury. Under Section 28 the Court may, if it thinks fit and at the request of either party, call in a specially qualified assessor to assist at the trial of the action. Assessor.

If infringement is not admitted the plaintiff should first prove this. Proof of infringement.

The evidence of expert witnesses is frequently advisable, as was said by Lindley, M. R., in *Brooks v. Steele* (1896) 14 R. P. C. 73), "to explain technical terms; to show the practical working of the machinery described or drawn; to point out what is old and what is new in the specification, and to show the particulars in which an alleged invention had been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff's invention and what is done by the defendant." But the evidence of an expert witness on the construction of a specification may be ignored (*Edison-Bell Phonograph Co. v. Smith* (1894), 11 R. P. C., at p. 404). The proper function of expert witnesses is to indicate all points requiring consideration, but their actual opinion whether there is infringement or not is immaterial. Questions as to what are and what are not mechanical equivalents may be referred to expert witnesses (*per* Smith, L. J., in *Ticket Punch Register Co. v. Colley* (1895), 12 R. P. C. 171, see p. 186, line 8). The construction of the specification is not admissible evidence from an expert. Expert evidence. Expert must not construe specification. Evidence on mechanical equivalents.

When insufficiency is alleged against a specification the evidence of an intelligent workman of approved skill and knowledge in the specific art meets with more favour from the Court than the evidence of a professional expert witness. Evidence as to insufficiency.

The object of the particulars delivered with each party's pleadings is to prevent surprise, and to ensure that each shall know exactly what he has to meet. But where evidence of the nature of a surprise is let in at the trial, as, for instance, in *Borcroft v. Smith* (1896) 14 R. P. C. 172), where unwary cross-examination elicited proof of an anticipation of the plaintiff's patent which did not appear in the particulars of objections, the surprised party should apply Adjournment on surprise evidence.

for an adjournment if the new proof is of a serious nature. Otherwise, if he takes a verdict, the Court of Appeal will not allow him to adduce evidence in rebuttal.

New trial on ground of surprise.

The granting of an adjournment on the ground of surprise is always a matter for the discretion of the Court. A new trial on the ground of surprise cannot be obtained unless there is an affidavit alleging surprise (*per* Lord Esher in *Huggenmacher v. Watson* [1897], 14 R. P. C., at p. 634, line 6).

Action may be remitted to a referee.

When an action involves abstruse scientific questions or exhaustive examination of documents, the Court may, under The Arbitration Act, 1889, remit the action to a referee or arbitrator.

Estoppel.

The defendant may in certain circumstances be estopped from denying the validity of the plaintiff's patent. This is so if the defendant has submitted to judgment in a previous action for infringement of the same patent (*Houcher v. Clayton* [1864-5], Good. P. C. 214); or if he has worked the patent in partnership with the plaintiff (*Mantz v. Crenfell*, 2 Web. P. C. 88); or if he, being the original patentee, has sold the patent to the plaintiff, and is acting in breach of the assignment (*Chambers v. Crichley* [1864], 33 Beav. 374. Good. P. C. 112; *Oldham v. Langmead* [1789], 3 T. R. 439. Good. P. C. 342). But it seems that if the defendant is a bankrupt patentee whose trustee in bankruptcy has assigned the patent to the plaintiff, the defendant is not estopped from denying the validity of the patent (*Cropper v. Smith* [1884], 2 R. P. C. 17; 10 App. Ca. 249).

Assignment by bankrupt's trustee not estoppel.

Results of judgment for plaintiff.

If satisfied of the validity of the plaintiff's patent and that infringement has been established, the Court will grant an injunction and damages, or an account of profits, with costs, and sometimes delivery up or destruction of the infringing goods. An injunction only holds good while the plaintiff's patent is in force, and if the patent should be declared invalid in some subsequent action the injunction comes to an end (*Dunn v. Eley* [1865], L. R. 3 Eq. 496; Good. P. C. 160). Goods manufactured during the term of patent right, and stored away ready to throw upon the market as soon as the patent lapses, are infringements, and

Effect of result of subsequent judgment on injunction.

Mere manufacture without sale is infringement.

are within the terms of an injunction, and pursuable even after the expiry of patent right (*Crossley v. Beverley* [1829], Good. P. C. 136; 3 C. & P. 513; 9 B. & C. 63). Should a defendant commit any breach of the injunction, the plaintiff should move for committal for contempt, and in the case of a body corporate for sequestration of the goods of the defendant company and committal of the directors (*Spencer v. Amcotts Rubber Co.* [1888], 6 R. P. C. 46). It seems that the successful applicants are entitled to costs on the higher scale, and in some cases to costs as between solicitor and client.

Committal for breach of injunction.

Breach by corporation.

Though delivery up of the infringing goods to the successful plaintiff may be ordered, the plaintiff cannot sell these for his own profit. They remain the property of the defendant (*Varrasseur v. Krupp* [1870], L. R. 9 Ch. D. 351). But the defendants cannot set off the value of such delivered-up goods as against damages or profits payable by them to the plaintiffs (*United Telephone Co. v. Walker* [1886], 4 R. P. C. 63; 56 L. T. 508). When part only of the defendant's apparatus constitutes the infringement, that part only is required to be delivered up or destroyed (*Edison-Bell Phonograph Co. v. Smith* [1894], 11 R. P. C. 389; *Howes v. Webber* [1895], 12 R. P. C. 465).

Goods delivered up are not plaintiff's property.

Only infringing part delivered up.

In assessing damages the true measure is not always merely the loss of profit the plaintiff may have sustained, or the gains the defendant may have made, but in such assessment other circumstances may be taken into account (*Pneumatic Tyre Co. v. Puncture Proof Co.* [1899], 16 R. P. C. 209; *American Braided Wire Co. v. Thomson* [1890], 7 R. P. C. 152). But the ordinary rule of law against over-remoteness of damage holds good in patent as in other actions (*Boyd v. Tootal Broadhurst* [1894], 11 R. P. C., at p. 184). Although a patentee has obtained damages against a manufacturer for infringement, he may also proceed against a purchaser of the infringing goods (*Penn v. Bibby* [1866], Good. P. C. 371; L. R. 3 Eq. 308; 36 L. J. Ch. 277). In an inquiry as to damages the plaintiff is entitled to have the damages assessed down to the date of the inquiry. Damages, or a payment by way of royalty, are usually preferred to an account of

Damages.

Not merely loss of profit.

Different persons liable.

Account of profits.

profits, as the taking of such accounts is always attended with great difficulty, and is a work of such trouble and expense that the Courts have always advised against it (*Siddell v. Vickers* [1892], 9 R. P. C. 152; *Automatic Reboot Co. v. Mayor of Salford* [1897], 14 R. P. C. 450).

Costs.

The successful party as a general rule gets the costs of the action. But taxed costs by no means cover the successful litigants' actual expenses. Only a tithe of the heavy fees paid to professional expert witnesses is allowed by the Taxing Masters. The costs of shorthand notes are usually not allowed; but in the Court of Appeal, in the absence of a direction to the contrary, the costs of an appeal include the costs of the shorthand writer's notes of the judgment (*re Medland* [1891], 41 Ch. D., at p. 493; *in re De Falbe, Ward v. Tyler* [1901], 1 Ch. D. 523). It seems that an agreement of solicitors as to shorthand notes is not binding. The costs of shorthand notes have been allowed in taxation between solicitor and client as a necessary expense in the action (*Osmonds v. Mutual Cycle Co.* [1899], 2 Q. B. 488; see also Notes to Order LXV., Rule 27 (9), of the Rules of Supreme Court). If solicitors agree, it should be to the effect of making the costs of the shorthand notes costs in the action, and the Judge should be informed of this arrangement and consent at the commencement of the hearing.

Shorthand notes.

Between solicitor and client.

Costs of particulars must be certified for by Judge.

Section 29, Sub-section 6, of the Patent Act is to the effect that 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.

Practice in granting certificates of costs in particular.

Accordingly a successful plaintiff or defendant should, on the delivery of judgment, apply for a certificate that his particulars of breaches or particulars of objections are reasonable and proper, or have been proven. If the action has been tried out, and the particulars gone into, the Judge will have little difficulty in making up his mind whether he ought to grant or withhold such a certificate,

or what portions of the particulars are entitled to such a certificate; but even where there has been no trial, or no sufficient trial of the action, such certificates may be asked for and are sometimes granted. Thus, in *Pneumatic Tyre Co. v. Welshodm* ([1898] 13 R. P. C. 488), a certificate of the plaintiffs' particulars of breaches was granted although the action was undefended. In *Allen v. Oates* ([1898] 15 R. P. C., at p. 304) a certificate was granted only in respect of those particulars of breaches relied on at the trial. As touching particulars of objections a certificate was granted in *Chamberlain v. Mayor of Bradford* ([1900] 17 R. P. C. 493) in respect only of those particulars referred to at the trial. In *Wilcox & Gibbs v. James* ([1897] 14 R. P. C. 523), where the plaintiffs discontinued after delivery of defence, a certificate of the particulars of objections was refused on the ground that the Court had not been granted an opportunity of testing whether the particulars were reasonable and proper or not. But in *Chamberlain v. Mayor of Huddersfield* ([1901] 18 R. P. C. 454), where the plaintiffs applied for leave to discontinue after the pleadings were closed, one of the conditions of leave was the payment of the costs of the defendants' particulars of objections as if certified. In *Pegamoid, Limited v. British Leather Cloth Co.* ([1901] 18 R. P. C. 317), where the plaintiffs gave up their case after cross-examination of their chief expert, the defendants were allowed to continue the cross-examination for the purpose of proving their particulars of objections and obtaining a certificate.

Costs certificates in particulars of objections.

The cases are various and sometimes apparently conflicting, but the broad rule to be deduced is that, where the Court has had no opportunity of judging of the reasonableness of the particulars, a certificate will seldom be granted, and the Court will not enter into a sort of half trial of the action in order to see whether or not the particulars of objections are reasonable (*per* Romer, L.J., in *Wilcox & Gibbs v. James, supra*). Where the particulars have been gone into, a certificate will be granted in respect of the whole or of those portions which the Court may think reasonable and proper; or refused, either wholly or in respect of those portions which the Court may think

General principles upon which certificates of costs for particulars are granted.

too remote or trifling. Thus, out of ten heads of particulars five might be allowed and five disallowed, and a certificate will be given only in respect of those allowed. Where the plaintiff submits to have his action dismissed without being heard, it has been held that the proper course was to reserve the question of costs and of the certificate of particulars of objections until the matter had been before the Taxing Master (*Mandelberg v. Mackay* 1898, 14 R. P. C. 1).

Certificate that validity of patent has been challenged.

If the validity of the plaintiff's patent has been impeached by the defendant and has not been destroyed at the trial, the plaintiff should apply under Section 31 of the Patent Act for a certificate that the validity of the patent came in question. This section enacts that "in an action for infringement of a patent the Court or a Judge may certify that the validity of the patent came in question: and if the Court or a Judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same."

"Subsequent action."

"Any subsequent action" means any action started after the certificate in the earlier action has been granted. This was held in *Automatic Weighing Machine Co. v. International Hygienic Society* (1889) 6 R. P. C. 475), and in *Pneumatic Tyre Co. v. Leicester Pneumatic Co.* (1898) 15 R. P. C., at p. 165). In any subsequent action a plaintiff who has a certificate granted in a former action must plead the certificate and ask for solicitor and client costs (*Pneumatic Tyre Co. v. Thisholm* [1896], 13 R. P. C. 485).

Certificate of validity should be pleaded.

Instances in which certificate has been given.

If the validity of the patent has been challenged by the defendant in his defence, a certificate will be granted although validity is not contested at the trial (*Fabriques Chimiques v. Caspers* [1897], 15 R. P. C. 94). Even where the defendants did not appear at the trial a certificate was granted, validity having been raised in their particulars (*Acetylene Co. v. Midland Acetylene Syndicate* [1900], 17 R. P. C. 534, and see *Saccharin Corporation v. Sitos*, 17 R. P. C. 536, n.; *Welsbach v. Kromm* [1901], 18 R. P. C. 211).

Certificate may be granted in respect of good claims in bad patent.

Where one or more of the claims of a patent have been held bad, a certificate may be granted in respect of the remaining good claims (*Badische Anilin Fabrik v. Société Chimique* [1897], 14 R. P. C. 892; *Haslam v. Hall* [1887], 5 R. P. C. 1). Even when the patent has expired before the trial a certificate may be granted (*Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.* [1897], 14 R. P. C. 757; *Kane v. Boyle* [1901], 18 R. P. C. 325).

Certificate in expired patent.

No appeal on certificate.

No appeal lies against the granting or withholding of a certificate, the same not being a judgment or order within Section 19 of The Judicature Act, 1873.

Certificate in Judge's discretion.

The granting or refusing of a certificate is always a matter for the Judge's discretion, and even where a certificate has been granted the Court or a Judge in a subsequent action is not bound to give solicitor and client costs to a successful plaintiff (*Automatic Weighing Machine Co. v. National Exhibitions Association* [1899], 8 R. P. C., at p. 352).

Costs on higher scale.

Costs on the higher scale are not often given. There is no rule as to the particular circumstances which would justify the giving of such costs in patent actions, but, generally speaking, where the action has involved the consideration of important and abstruse scientific issues, costs on the higher scale will be given (*Muirhead v. Commercial Cable Co.* [1894], 12 R. P. C., at p. 64; *Heidemann v. Smokeless Powder Co.* [1898], 15 R. P. C., at p. 325).

Public Authorities Protection Act.

In cases which come within The Public Authorities Protection Act, 1893, a successful defendant public authority gets costs as between solicitor and client (*Chamberlain and Hookham v. Mayor of Bradford* [1900], 17 R. P. C. 762).

Appeal re costs on higher scale.

Although no appeal lies as to costs generally, nevertheless where costs on the higher scale have been given for certain stated reasons by the Judge of First Instance, appeal might be had to review whether such alleged reasons did actually exist, and thus practically an appeal against the allowance of costs on the higher scale may be said to lie.

Stay of execution on appeal.

When an appeal is contemplated, application may be made for a stay of execution pending appeal. Stay of injunction is seldom granted, especially where the plaintiff

gives an undertaking (*Pilkington v. Yeakley Vacuum Hammer Co.*, 1901', 18 R. P. C., at p. 539). Indeed, it may be said that as a rule stay of an injunction is never granted unless there are good reasons, such, for example, as that the public or the public service might suffer or be prejudiced, in which case a short stay might be had, but only on condition that the defendant keeps an account. A stay as to costs is seldom granted. If refused in the Court below, an application for a stay pending appeal might be made to the Court of Appeal.

Appeal or re-hearing.

Rule 1 of Order LVIII. of the Rules of the Supreme Court enacts that "all appeals to the Court of Appeal shall be by way of rehearing, and shall be brought by notice of motion in a summary way, and no petition, case, or other formal proceeding, other than such notice of motion, shall be necessary. The appellant may, by the notice of motion, appeal from the whole or any part of any judgment or order, and the notice of motion shall state whether the whole or part only of such judgment or order is complained of, and in the latter case shall specify such part."

Interlocutory orders concerning injunctions are appealable without leave.

By The Judicature Act, 1894, Section 1, Sub-section (*b*), interlocutory orders or judgments are not appealable without leave, except, *inter alia*, in cases concerned with the granting or refusing of an injunction &c. As almost every patent action concerns an injunction, it follows generally that all interlocutory matters in patent actions are appealable without leave. From an interlocutory order appeal must be made before the expiration of fourteen days. From a final judgment appeal must be made in three months. In the case of a final order the notice is fourteen days: from an interlocutory order the notice is four days.

Halsbury, L. C., on the duties of the Court of Appeal.

The hearing upon appeal is a rehearing, and the Court of Appeal will approach the matter "without any presumption that the judgment in the Court below was right. The Judges of the Court of Appeal ought to consider the case impartially, and should in no sense be influenced by the judgment of the Court of First Instance. It is not within their competence to say that they would have given a different judgment if they had been the Judge of First Instance, but because he has pronounced

a different judgment they will adhere to his decision" (*per* Lord Halsbury, L. C., in *Bickmann v. Thierry* [1896], 14 R. P. C., at p. 116).

Papers for the Court of Appeal.

The Court of Appeal should have copies of the professional shorthand writer's notes of evidence in the Court below.

Fresh evidence.

Fresh evidence may be admitted by leave of the Court of Appeal, but such leave is not readily granted. It must be evidence not known to or available by the applicant at the trial below (*per* Lindley, L. J., in *Hinde v. Osborne* [1885], 2 R. P. C. 151). Thus, where a defendant in the Court below rested his defence on non-infringement only, and did not challenge the validity of the plaintiff's patent, he was not allowed to raise this issue in the Court of Appeal (*Hinde v. Osborne*, *supra*).

Appeal to House of Lords.

From the decision of the Court of Appeal an appeal may be made to the House of Lords within one year.

# CHAPTER XVIII.

## REVOCATION OF PATENTS.

Scire Facias abolished.

THE old action of *Scire Facias* having been abolished by the Act of 1883, revocation of a patent is now obtained by petition to the Court. "The Court" means the High Court of Justice in England, the Court of Session in Scotland, and the High Court of Justice in Ireland. With regard to the Court of the County Palatine of Lancaster, its jurisdiction has been enlarged by Section 3 of The Chancery of Lancaster Act, 1890, so that revocation matters affecting parties within its jurisdiction may now be undertaken by that Court.

Meaning of "The Court."

Persons who may petition for revocation.

A petition for revocation may be presented by -

1. The Attorney-General for England or Ireland, or the Lord Advocate in Scotland, or any person authorised by them.
2. 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.
3. Any person alleging that he, or a person under or through whom he claims, was the true inventor of the subject-matter or a portion of the subject-matter of the patent.
4. 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.

Fiat of Attorney-General or Lord Advocate.

Under Paragraphs 2, 3, and 4 a person may present his petition as of right; but upon other grounds he must obtain from the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, his fiat or leave to

present the petition. This fiat is not issued as a matter of course; but even where the applicant can present his petition under Paragraphs 2, 3, and 4, it is sometimes better to fortify the petition with the fiat of the Attorney-General or Lord Advocate, so as to decrease the possibility of the petition failing upon the ground of insufficient *locus standi* (*Hoyle's Patent* 1893, 12 R. P. C. 118; *Morgan's Patent* 1888, 5 R. P. C. 161).

In *Morgan's Patent* (*supra*), Chitty, J., held that, granted the petitioner is qualified to present the petition himself under Paragraphs 2, 3, and 4, the patent may be attacked on any other ground, such as disconformity, insufficiency, or the like.

Procedure in obtaining fiat of Attorney-General.

To obtain the fiat of the Attorney-General, the following papers should be sent to the patent clerk:

(*a*) A memorial to the Attorney-General asking his authority, and stating all the circumstances.

(*b*) A statutory declaration verifying the statements in the memorial.

(*c*) Two copies of the proposed petition and of the particulars proposed to be delivered with it.

(*d*) The certificate of a barrister that the petition is proper to be authorised by the Attorney-General.

(*e*) A certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is in a position to pay the costs of the petition if unsuccessful.

Application for fiat.

An application for the Attorney-General's fiat may be heard *ex parte*, or directions may be given to advise the patentee of the application, so that both parties may be heard. The granting or withholding of the fiat is within the discretion of the Attorney-General. There is no power to give costs on these applications (*Welch's Application, re Martin's Patent*, Griff. P. C. 320); but by consent the costs may be made costs in an action for infringement agreed to be taken by the respondent against the applicant within a given time (*Vickers's Application, re Siddell's Patent*, Griff. P. C. 320).

Costs.

In Scotland by action of reduction.

Section 109 of the Patent Act provides that—

"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."

Scottish decisions on "persons having interest."

For instances of persons "having interest" see *Worthington Pump Co. v. Weir* (1891) 11 R. P. C. 557), and *Montgomerie v. Peterson* (1894) 11 R. P. C. 221, 633). In this latter case it was held by the Court of Session that the owner of an invalid patent may yet obtain the revocation of another patent.

Fraud.

The petitioner who alleges the patent to have been obtained in fraud of his rights must prove positive fraud. "To be in fraud of his rights it must be done either with the intention of depriving the principal of his rights or must be insisted upon so as to deprive the principal of his rights" (*per* Cotton, L. J., in *Avery's Patent* 1887, 4 R. P. C. at p. 327). Where it was found, as in *Norwood's Patents* (1895) 12 R. P. C. 214), that the invention was not that of the patentee, but that the patent had been taken out with the intention of depriving one of the petitioners of his rights, the patent was revoked (see also *Gibb's Patent* (1891), 8 R. P. C. 438). In *Marshall and Naylor's Patent* (1900) 17 R. P. C. 553) a servant had, at the request of his master, invented a tap to perform specific functions. The servant worked out the invention, made the models, and perfected the tap, all in his master's time and with his master's tools. The master had no share in the actual invention of the tap. Ten pounds was paid to the servant for extra time and trouble, and the master, in conjunction with a co-director, patented the tap. On petition for revocation by the servant on the ground of fraud the patent was revoked.

Fraud by master on servant.

Substitution of true inventor as patentee (section 26, Sub-section 8).

When a patent is revoked on the ground of fraud, the successful petitioner, if he is the true inventor, can have a patent granted to him for the invention, as of the date of revocation, but expiring at the same time as the original

revoked patent would have expired. Thus, in the case last cited, application was made under Sub-section 8 of Section 26 of the Patent Act to issue the patent for the remainder of the term to the successful petitioner, the servant.

Proof of priority of true inventor.

Where the petitioner claims that he is the true inventor of the invention patented by the respondent, he must show very conclusively that the alleged prior invention is practically identical with the respondent's, and that it was by a specification, by public user, or by other means, published in this country. To prove that he invented, but did not publish or publicly use the invention afterwards independently invented and patented by the respondent, would not avail, any more than it would avail as an anticipation in an action for infringement. If the petitioner founds his petition on a prior specification, the respondent may advance evidence of prior knowledge to limit the petitioner's claim, or bind him to the particular devices described and illustrated (*Walker v. Hydro-Carbon Syndicate* [1894], 2 R. P. C. 31). As the words of the sub-section are "true inventor" and not "true and first inventor," which include "importer," it has been suggested that a patentee who had imported an invention from abroad might be liable to have his patent revoked by the actual inventor. But it is difficult to see why a first importer to whom a grant has been legally made should have his patent revoked on such a ground.

Query as to imported invention.

Prior public user.

The next in order of those who may petition for revocation of a patent are persons who have publicly made, used, or sold the invention prior to the date of the patent. Thus, in *Haddon's Patent* (1893, 2 R. P. C. 218) the petitioner proved that he had publicly made and sold an infant's food as described by the patentee some years prior to the date of the patent, and consequently the patent was revoked. In *Taylor's Patent* (1896, 13 R. P. C. 482) the petitioner proved the use in his private house of a fireplace similar to the patented invention of the respondent, and the patent was thereupon revoked. The Court will be satisfied with such substantial anticipation as would serve as a successful defence in an action for

Use in private house.

infringement. In *Edmond's Patent* (1889) 6 R. P. C. 355) apparatus was claimed for the manufacture of hollow arched or "Paragon" umbrella ribs. The petitioner showed that the same machinery had for some time previously been used in the production of solid umbrella ribs. The mere application of this old apparatus for the manufacture of hollow ribs was held by Pollock, B., to be unpatentable, and the patent was revoked.

Analogous prior user.

Particulars of objection.

Particulars of objection to the patent must be delivered with the petition exactly as is done by the defendant with his defence in an action for infringement. Proof of these objections only, and no others, will be allowed at the hearing of the petition. Particulars may be amended from time to time by leave of the Court or a Judge, as in actions for infringement.

Certificate of reasonableness of particulars not provided for.

It does not appear from Section 26 of the Patent Act that the Judge has any power to give a certificate of the reasonableness of the particulars, but, on the other hand, there is no such prohibition against the Taxing Master allowing costs on the particulars, without such a certificate as exists in Section 29.

Additional grounds for revocation.

The petition and particulars may include as grounds for the revocation of a patent insufficiency of description, disconformity between the Provisional and Complete Specification, want of subject matter or invention, and prior grant, in addition to prior use or publication, fraud, and the other grounds already treated of (Section 26, Sub-section 3).

Pharmacy Act.

The fact that the patent was taken out to evade the provisions of the Pharmacy Act is not a ground for revocation (*Dudley's Patent* [1894], 11 R. P. C. 391).

Petitioner cannot plead estoppel on respondent's patent.

A defendant in an infringement action in which certain of the patentee's claims have been held bad cannot, in the event of his petitioning for revocation, set up that the patentee is estopped by the former judgment from denying that the said claims are bad (*Dudley's Patent* [1895], 12 R. P. C. 192). All persons having an interest in the patent must be made respondents (*Avery's Patent* [1887], 4 R. P. C. 152).

Respondent may amend bad patent.

Under Section 19 of the Act, during proceedings for revocation a patentee may obtain leave to amend his patent, subject to such terms as to costs and otherwise as the Court or a Judge may impose, the hearing of the petition being meanwhile postponed. The usual conditions are those imposed by Byrne, J., in *Chatwood's Patent* ([1899] 16 R. P. C. 371), where the applicants were ordered to pay in any event the costs of the application and of the petition up to and occasioned by the disclaimer, except only so far as the proceedings in the matter might be utilised for the purpose of the hearing of the petition, should the same be heard. In the event of the petitioner electing not to proceed with the petition, the respondents were to pay all the costs of the proceedings. This order differs from the older order in *Goulard and Gibbs's Patent* ([1888] 5 R. P. C. 189), chiefly in providing for the utilisation, without expense to the applicant, of such parts of the proceedings as can be utilised if the petition goes on.

Conditions of amendment.

It will be noted that Section 19 admits of amendment by disclaimer only.

Order of procedure at hearing.

At the hearing of the petition, which is similar to that of an infringement action, the respondent begins, the petitioner follows, and the respondent concludes. Unless the evidence is taken by affidavit, which seldom happens, the hearing is treated as a witness action, and is entered in the witness list. When the evidence is by affidavit the party who has the right to begin (generally the respondent) should file his evidence-in-chief first (*per* Chitty, J., in *Gale's Patent* [1891], 8 R. P. C. 438).

Revocation order should be noted on Register.

When an order of revocation has been made, the order is taken to the Comptroller at the Patent Office by the successful petitioner, and a note of the revocation is placed on the Register. There is no actual or formal cancellation of the grant.

Costs.

The successful petitioner gets his taxed costs from the respondent, and if unsuccessful must pay costs. There is no way of cancelling the grant otherwise than by petition, and this sometimes works great hardship. A patentee who has obtained a patent for an invention which he has independently made, and who has throughout acted

Hardship of present regulation as to revocation.

honestly and in perfect good faith, is liable to find himself suddenly served with a petition for revocation. Although he may from the first recognise the hopelessness of his position, and may be perfectly willing to consent to the revocation of his patent, nevertheless the petition must go on and the costs must be incurred. It really seems worth suggesting that some amendment should be made to the Act, whereby an innocent patentee desirous of resigning his patent should be able by some simple and inexpensive formality to get the grant revoked without incurring the sometimes ruinous expense of even an unopposed petition.

Appeal. Revocation of a patent may be stayed pending appeal to the Court of Appeal and House of Lords.

# CHAPTER XIX.

## ACTION TO RESTRAIN THREATS.

Redress for threats under Statute of Monopolies.

ALTHOUGH it has been maintained that Section 4 of the Statute of Monopolies gave a right of action at Common Law to any person "hindered, grieved, disturbed, or disquieted by pretext of any monopoly or letters patent," it is nevertheless true that no use was ever made of this alleged remedy, with the result that before the Act of 1883 a patentee might almost with impunity send out circulars threatening legal proceedings on account of alleged infringements of his patent. He was then under no direct compulsion to bring any action in furtherance of his threats, and unless the party aggrieved could prove that these threats were injurious, untrue, and made maliciously and in bad faith, he had no remedy so long as the patentee could make out any case that he had, or believed he had, reasonable ground for uttering such threats.

Patentees' threats formerly not actionable by Statute.

Redress for threats under Act of 1883, Section 32.

Now, however, Section 32 of the Act of 1883 provides that

> "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 damages, 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."

Threats must now be backed by action.

The object of the section is not to prevent a patentee from threatening at all if he sees his patent infringed. This he may do, but he must do it in good faith, believing his patent is valid, that it has been infringed, and intending, if satisfaction is not given him, to take action *forthwith* to enforce his threat, if, indeed, he has not already taken action.

Grounds for threats.

The threat should not be made upon suspicion merely, but must be in respect of something done, something being done, or something intended to be done (*per* Lindley and Kay, L. JJ., in *Johnson v. Edge* 1892, 9 R. P. C. 142).

A general warning not a threat.

As Bowen, L. J., put it in *Challender v. Royle* (1887 4 R. P. C. 363; L. R. 36 Ch. D. 425): "A merely general warning to pirates not to pirate and to infringers not to infringe," coupled with an intimation that the patentee has a patent which he means to enforce, is not in itself an actionable threat. But it depends on the manner in which even such a general statement is circulated, and on the class of persons to whose notice it is brought. Thus, a general notice that violations of a certain patent were rife, and that parties were warned not to infringe, sent out by the patentee as wrappers for his goods and addressed as circulars to customers of a rival manufacturer of similar wares, was held under the circumstances to constitute an actionable threat (*Johnson v. Edge, supra*). So a general complaint to the piano trade of infringements by foreign manufacturers, capable of being construed as referring to the plaintiffs, who had a branch in England, was held to be an actionable threat (*Herrburger v. Squire* (1888), 5 R. P. C. 581). As to the possible effect of general advertisements see also the remarks of Bowen, L. J., in *Skinner v. Perry* (1892), 10 R. P. C., at p. 8). The gist of the decisions and *obiter dicta* in the matter may be summed up in this, that, although *primâ facie* a mere general advertisement or circular is not in itself an actionable threat, still the manner in which it is put forward or distributed, the circumstances which surround it, and the ascertainable evidence of *mala fides* or malice will all be considered and weighed.

But may be made so by circumstances.

One threat enough.

Threats or a threat—for only one threat has led to the granting of an injunction (see *Wells v. Levinstein*

[1898], 15 R. P. C. 78) may be by letters (*Willoughby v. Taylor* [1898], 11 R. P. C. 45; *Barrett v. Day* [1890], 7 R. P. C. 54), and may be in a correspondence expressed to be carried on "without prejudice" (*Kurtz v. Spence* [1887], 5 R. P. C. 161), or by solicitor's letter (*Crampton v. Patents Co.* [1888], 5 R. P. C., p. 383; *Combined Weighing Machine Co. v. Automatic Machine Co.* [1889], 6 R. P. C. 502). Such letters may be sent to the principals or to their customers (*Thomson v. Drosophore* [1895], 12 R. P. C. 95). Even although the alleged threatener may not have expressly referred to his patent, if it is evident he has it in his mind such a letter may be an actionable threat (*Douglass v. Pontsch* [1896], 13 R. P. C. 673). A verbal threat is also actionable, although it may be more difficult to prove (*Kurtz v. Spence, supra*); and in a complaint of a verbal threat the name of the person to whom the threats were made should be given, as in slander cases (*Thomson v. Drosophore* [1894], 11 R. P. C. 536). A letter from a patentee answering enquiries as to a new invention and expressing the opinion that it was an infringement of his patent, and that he was prepared to stop its sale, was held a threat (*Skinner v. Perry* [1892], 9 R. P. C. 406).

by letter.

solicitor's letter.

To customers.

Verbal threat.

Reply to enquiry.

The remedy of a threatened party or a party capable of showing himself to have been aggrieved by threats is to be sought in an action claiming an injunction against the continuance of the threats, and also claiming damages. In *Kurtz v. Spence* ([1886], 3 R. P. C. 368), Chitty, J., held on a summons that the plaintiff could not question the validity of the defendant's patent in his Statement of Claim, but the Court of Appeal in the same case ([1887] 4 R. P. C. 427), confirming Cotton and Bowen, L.JJ., in *Challender v. Royle* ([1887] 4 R. P. C. 363), held that he could (see also *Herrburger v. Squire* [1888], 5 R.P.C. 581); and it is now settled practice that such can be done. The plaintiff must give particulars of the threat complained of; and where these have been verbal statements made by the defendant's servants or agents, the names of the persons to whom the threats were spoken must be given (*Thomson v. Drosophore* [1894], 11 R. P. C. 536). If in his statement of

Remedy of persons threatened.

Threatened persons may challenge validity of patent.

Particulars of threats.

If patent attacked, particulars of objections required.

claim the plaintiff attacks the validity of the defendant's patent, he must deliver particulars of objections showing upon what grounds he disputes the patent, and giving the specific instances of prior publication or prior user, or disconformity, or other grounds upon which he depends.

Defence.

If the plaintiff does not challenge the validity of the patent the defendant (although not bound to do so) must almost of necessity, by way of counterclaim, assert infringement of his patent and the validity thereof, seeing that, according to the section, no injunction or damages can be obtained by the plaintiff if the defendant succeeds in showing that, in fact, the defendant has a valid patent, and that the plaintiff has infringed it. By his counterclaim the defendant might also claim an injunction and damages for infringement (*Appleby's Twin Roller Chain Co. v. Endle* 1890, 16 R. P. C. 318). In support of his plea of infringement the defendant must deliver particulars of breaches just as if he were a plaintiff in an action for infringement. The plaintiff may, in his reply, deny infringement, and attack the validity of the patent, delivering, at the same time, particulars of objections just as a defendant would do in an infringement action. To this the defendant may put in a rejoinder (*Thomson v. Brosophone* 1895, 12 R. P. C. 95).

Counterclaim for injunction and damages.

Dual nature of action.

The action would thus assume the dual character of an action for restraint of threats combined with an action for infringement. Both issues may be tried in the same action, the questions of validity and infringement first, and if the defendant fails in these then the threats issue (*Heyberger v. Squire* 1888, 5 R. P. C. 381).

Threats condoned if immediately followed by action.

But, as will be seen, the section provides that the prohibition against making threats does not apply if the person threatening commences, and prosecutes with due diligence, an action for infringement of his patent. This suggests an inquiry as to what is "due diligence." That, again, depends on circumstances (*per* North, J., in *Colley v. Hunt* 1890, 7 R. P. C. 101). An action commenced, but discontinued from the necessity of amending the specification, was in the circumstances held to have been commenced and prosecuted with due diligence (*Clark v. Hunt* 1898,

Due diligence.

15 R. P. C. 113). Even where an action has been commenced with due diligence, although afterwards discontinued or dismissed, the alleged infringer may, after the withdrawal of the action, take proceedings against the patentee in respect of the threats, and may, if malice or *mala fides* is found, obtain damages (*Bishop v. Inman* 1900, 17 R. P. C. 749). The time from which due diligence may be reckoned is from the issue of the threat (*Challender v. Royle* 1887, 4 R. P. C. 363), and three months is generally considered a fair period for the exercise of due diligence (*Colley v. Hart, supra*). In *Heerlungen v. Spicer* (1888, 5 R. P. C. 581) fourteen months was held too long a delay.

Separate actions discouraged.

As to the expediency of pressing to trial two separate actions, one for restraint of threats by the threatened party and another for infringement of his patent by the party threatening, the Lord Chancellor and Lords Justices Cotton and Fry in *Automatic Machine Co. v. Combined Weighing Machine Co.* (1889, 6 R. P. C. 317), expressed the strongest disapproval of such a course. Said the Lord Chancellor—"My attention has been called to the frequency of the practice of reduplicating actions and increasing unnecessary costs by trying the same action in two different forms, one to restrain threats and the other upon the patent itself. I confess I regard with very great jealousy expedients by which an action is made to cost twice as much as it need, because it is brought in two different forms."

Procedure advisable in threats actions.

The best plan appears to be that if the plaintiff in a threats action does not attack the validity of the defendant's patent, the defendant, by counterclaim, may raise the issues of infringement and validity, and let these be fought out in the threats action. Failing this, and also if infringement and validity have been put in issue, should it be expedient that the defendant should protect himself under the section by bringing and prosecuting an action for infringement "with due diligence," he may do so, and then arrange with the other side, or get an order of the Court that the threats action may be stayed until the infringement action has been tried out. Of course, if he succeeds in establishing infringement and validity, the threats action is gone.

Example of apparent delay held to be due diligence.

If the parties have been in correspondence for a long time, and the threatened parties at last take action for restraint, a cross action taken by the patentee after inspection has been held to have been taken with due diligence, although three years had passed since the initial threat (*Ellin v. Pneumatic Tyre Agency* 1898', 10 R. P. C. at p. 316). But this is only in consonance with the remarks of North, J., in *Valley v. Hart* (*supra*), as to the modifying influence that circumstances may exercise in enabling the Court to rule what is and what is not due diligence. Thus, if it is evident that the action is not taken *bonâ fide* but only to comply technically with the section, or if it is evident that the action would never have been taken had not the patentee's hand been forced by the threats action, the Court might declare that there was no due diligence (*Appleby's Twin Roller Chain Co. v. Eadie* (1899), 16 R. P. C. at p. 330; see also Cotton, L. J., on *bonâ fides* in respect of such actions, *Challender v. Royle*, *supra*).

Example where due diligence held absent.

Prosecution of the action.

"Prosecuted" with due diligence does not necessarily mean that the action must have been prosecuted to a trial, much less to a successful issue (*Valley v. Hart*, *supra*), and where the patentee has threatened several persons, it is enough if he brings an action against one of them, although that one may not be the plaintiff in the threats action (*Challender v. Royle*, *supra*). But in *Bishop v. Inman* (1900) 17 R. P. C. 749), where the first action was withdrawn and a second action was dismissed for want of prosecution, the jury found that though the threats were made *bonâ fide*, and the first action was brought *bonâ fide*, nevertheless the first action was not prosecuted with due diligence, and the second action was neither brought *bonâ fide* nor prosecuted with due diligence, and damages were awarded in respect of both series of threats.

One action will do.

Action not brought *bonâ fide*.

In *Wade v. Johnson* (1900) 18 R. P. C. 1) a patentee brought an action for infringement, which was dismissed on the plaintiff's default. The patentee then issued a threatening circular, and within five days was served with a writ in a threats action. The patentee immediately brought a second action for infringement. A motion for interlocutory injunction by the plaintiff in the threats action was dismissed.

the Court holding there was no evidence to show that the second action brought by the patentee was not being prosecuted with due diligence.

The person who threatens is the person who must bring the action. He cannot substitute as plaintiff another who is the real owner of the patent in virtue of which he threatened (*Kensington Electric Co. v. Lane-Fox* [1891], 8 R. P. C. 277; [1891] 2 Ch. at p. 577). The threatener must take action.

It is only with difficulty that an interim injunction can be obtained in a threats action. The plaintiff would require to show conclusively that he was not infringing the defendant's patent. Interim injunction.

Damages are measured by the actual loss sustained by reason of the threats. These may be assessed by the Court, or an inquiry as to damages may be instituted. Loss of profits under a contract repudiated because of the threats has been assessed as damages (*Hoffmann v. Salsbury* [1890], 16 R. P. C. 375). Measure of damages.

In threats actions as in other actions appeal may be made to the Court of Appeal and also to the House of Lords. Appeal.

# CHAPTER XX.

## PROLONGATION OF PATENTS.

Patentee may petition for prolongation.

SECTION 25 of the Act of 1883 refers to the extension of the term of a patent, and provides that a patentee may present a petition to His Majesty in Council, praying that his patent may be extended for a further term: but such petition must now be presented at least *six months* before the time limited for the expiration of the patent.

Grounds for prolongation.

Subsection 3 is to the effect that if the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for His Majesty in Council to extend the term of the patent for a further term, not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

"Patentee" means those entitled to benefit of patent.

As the term "patentee" includes, under Section 46, any person who is for the time being entitled to the benefit of the patent, it follows that not only can the original patentee present a petition for extension, but also the executor or administrator of a deceased patentee, or an

Position of assignee.

assignee of a patentee who has sold his interest. An assignee is not, however, to be placed on the same favourable footing as the original patentee, and if the patentee has been paid a reasonable sum for his patent the assignee cannot be favourably considered because he has made a bad bargain (*Hopkinson's Patent* 1896, 14 R. P. C. 5). A mortgagee

Mortgagee.

ought to be a party to the petition (*Church's Patents* (1886, 3 R. P. C. 95), and should in fact join with the patentee.

Statement in petition must be full and exact.

In presenting a petition for extension, the applicant must state fully and fairly everything relating to the patent, and be prepared with complete sets of profit and loss accounts, so that approximately exact results of the

working under the patent may be laid before the Committee (*Lane-Fox's Patent* [1892], 9 R. P. C. 411). Anything savouring of suppression or designed confusion will most certainly result in the throwing out of the application (*Clark's Patent* [1899], 16 R. P. C. 433; *Henderson's Patent* [1901], 18 R. P. C. 449; *Ferranti's Patent* [1901], 18 R. P. C. 518).

It is much better to state an even apparently damaging fact plainly than to try to suppress it, for there is no tribunal more impatient of want of good faith than the Judicial Committee.

A petition for the extension of a patent requires to be presented within six months before its expiry; otherwise there is no jurisdiction to entertain the petition (*Adam's Patent* [1898], 16 R. P. C. 1); but the petition must not be presented too much in advance of the six months, or it may be put back as premature. It appears that an opponent cannot have extension of time to oppose simply because he did not see the advertisement in time (*Hopkinson's Patent* [1896], 13 R. P. C. 114). Time for presenting petition.

It must be "prosecuted with effect": *i.e.* some definite step must have been taken by the Judicial Committee before the patent expires. Prosecuted with effect.

New Rules to be observed in proceedings before the Judicial Committee of the Privy Council for the prolongation of patents came into force on the 1st of January, 1898. These Rules are to the following effect:- New Rules.

1. *A party intending to apply by petition under Section 25 of* the Act shall give public notice by advertising three times in the *London Gazette* and once at least in each of three London newspapers. Advertisements.

If the applicant's principal place of business is situated in the United Kingdom, at a distance of fifteen miles or more from Charing Cross, he shall also advertise once at least in some local newspaper *published or circulating in the town or district where* such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from Charing Cross, he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no *such manufacture, then, if he resides at a distance of fifty miles or* more from Charing Cross, he shall advertise once at least in some Advertisements in local journals.

newspaper published or circulating in the town or district where he resides.

Particulars in advertisements.

The applicant shall in his advertisements state the object of his petition, and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He shall also give notice that *caveats* must be entered at the Council Office on or before such day so named in the said advertisements.

Presentation of petition.

**2.** A petition under Section 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.

Affidavit of advertisements.

The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the first of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

The petitioner shall apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner shall forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers.

Papers to be lodged at Council Office.

**3.** A party presenting a petition under Section 25 of the Act must lodge at the Council Office eight printed copies of the Specification: but if the Specification has not been printed and if the expense of making eight copies of any drawing therein contained or referred to would be considerable the lodging of two copies only would be deemed sufficient.

Accounts.

The petitioner shall also lodge at the Council Office eight copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. He shall also furnish three copies of the said balance sheet for the use of the Solicitor to the Treasury, and shall upon receiving two days' notice give the Solicitor to the Treasury, or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance sheet at the hearing or from which the materials for making up the said balance sheet have been derived.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for the hearing.

*Caveat* of opposition.

**4.** A party intending to oppose a petition under Section 25 of the Act must enter a *caveat* at the Council Office before the day on which the petitioner applies for a time to be fixed for hearing the matter thereof, and having entered such *caveat* shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

The petitioner shall serve copies of his petition on all parties entering *caveats* in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service.

Papers lodged by opponents.

All parties intending to oppose a petition shall within three weeks after such copies are served upon them respectively lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.

Copies.

5. Parties shall be entitled to have copies of all papers lodged in respect of any petition under Section 25 of the Act at their own expense.

Forms.

All such petitions and all statements of grounds of objection shall be printed in the form prescribed by the Rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance sheets of expenditure and receipts shall be printed in a form convenient for binding along with such petitions.

Costs.

6. Costs incurred in the matter of any petition under Section 25 of the Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any petition, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

Relief from compliance with requirements.

7. The Lords of the Committee may excuse petitioners and opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under Section 25 of the Act as they shall consider to be just and expedient.

Attorney-General to be heard for Crown.

8. The Lords of the Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition under Section 25 of the Act. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Lords of the Committee.

Interest of opponent.

The opponent is not required to show such personal interest as in the case of opposition to the grant of a patent or amendment of a Specification before the Law Officer.

Opponent's particulars of objections.

It is advisable that the opponent should state fully all the particulars of objections to the extension in the *caveat*; but in *Stewart's Patent* (1885) 3 R. P. C. 7) evidence of prior user, not included in the particulars, was admitted, although this resulted in the loss of the costs by the opponents, who were successful.

Free hand of Attorney-General.

The Attorney-General may give evidence of objections on behalf of the Crown, irrespective of the particulars (*Church's Patents* [1886], 3 R. P. C., at p. 101).

Parties may appear personally.

At the hearing, the petitioner and opponent may appear, either personally or by counsel. The Attorney-General is always present to watch the case in the interests of the Crown, and may interpose, even although no *caveat* has been entered. The rules of evidence are the same as in Courts of Law.

Merits of invention considered.

In examining the request for extension, the Judicial Committee will take into consideration the merits of the invention as regards the public, and the remuneration obtained from it by the patentee or his representative or assignee.

Points to be proved by petitioner.

The three chief points to be proved by the petitioner are—

1. The merit of the invention.

2. That every possible effort has been used to make the invention commercially successful.

3. That, without any fault of his own, the petitioner has been unable to reap a sufficient reward.

Advantage to public.

As far as merit is concerned, the chief thing to make plain is the great utility of the invention to the public (*Currie and Timmis's Patent* [1897], 15 R. P. C. 63).

Foreign patents.

Where foreign patents have been obtained for the invention, this should be stated, and the accounts should show the expenditure and receipts in connection with these (*Newton's Patent* [1884], 1 R. P. C. 177; *Adair's Patent* [1881], L. R. 6 App. Ca. 176). The fact that foreign patents have been allowed to lapse, or have expired by efflusion of time, is a point against, though not fatal to, prolongation (*Semet and Solvay's Patent* [1894], 12 R. P. C. 10).

Deductions from profits.

Where a certain profit has been made, deductions from this will be allowed for personal expenses of the petitioner during the periods when he devoted himself exclusively to the pushing of the patent (*Haseland's Patent* [1894], 11 R. P. C. 467).

Deduction of law expenses not allowed.

It seems that law expenses incurred by the patentee in maintaining his patent rights are not allowed to be deducted from the profits (*McLean's Patent* [1898], 15 R. P. C. 418).

Validity of patent.

Although it is scarcely the function of the Judicial Committee to try the validity of the patent for which extension is sought, still they will not grant extension where the patent is evidently bad. Therefore evidence of anticipation by the opponent will be received and given effect to (*Hocking's Patent* [1895], 2 R. P. C. 151). If the validity is only doubtful the patentee will get the benefit of the doubt.

Periods of extension.

As a rule, no extension is granted for a longer period than seven years, but in rare instances extensions of ten and even fourteen years have been granted.

Issue of new patent.

Under present practice, if the petitioner is successful a new patent is directed to be sealed for the period of prolongation allowed.

The new Letters Patent are sealed and dated as of the date of expiration of the original patent. No new specification requires to be filed.

The petition ought to bear on its face the whole history of everything relating to the matter (*per* Lord Hobhouse in *Standfield's Patent* [1897], 15 R. P. C. 17).

Profits on foreign patents.

The amount of profits derived from foreign patents should be carefully and fully stated (*Burff and Bower's Patent* [1895], 12 R. P. C. 383).

Assignees.

When the original inventor has been adequately remunerated, and has no further interest in the patent, the assignees, although they may have lost by the transaction, are not in the more favourable position of the patentee (*Hopkinson's Patent* [1901], 14 R. P. C. 5). In the petition in re *Finch's Patent* ([1898] 15 R. P. C. 674) the patentee had absolutely assigned his patent for a sum of money to the petitioners, and would have derived no further benefit from the prolongation. Lord Macnaghten, in refusing prolongation, referred to what had been said in the *Burff-Bower Patent* ([1895] 12 R. P. C. 383) by Lord Watson: "There is no case in which this Board has granted an extension of a patent to an assignee which did not directly or indirectly tend towards the benefit of

Prolongation must benefit original inventor.

an original inventor who would, had there been no assignment, have been in a position to claim an extension himself." This case is identical with the *Bergh-Bower* and *Hopkinson Cases (supra)*. Here, as Finch only received sixty pounds for his invention, he might well have pleaded insufficient remuneration had he been in a position to petition; and the petitioners, had they been well advised, would have joined Finch in the petition, with arrangements for further remuneration from the extension. *A fortiori*, an assignee is not granted prolongation when the patentee himself could not ask it on the ground of insufficient remuneration, as in *Hopkinson's Patent (supra)*, where the patentee had received nearly £30,000 in cash and shares.

Where a patentee assigns to a company, not being able himself to bring out the patent, the company may share in the benefits of prolongation (*Harris's Patent* 1898, 11 R. P. C. 27).

Conditions sometimes imposed.

Prolongation may be granted coupled with conditions, such, for instance, as the granting of licences on reasonable terms, as in *Lyons's Patent* (1904, 11 R. P. C. 537).

Delay in exploiting patent.

Delay in pushing the patent and getting it on the market during the earlier portion of the patent right may cause refusal of prolongation (*Dellbeare's Patent* 1896, 13 R. P. C. 203; *Piper's Patent* 1895, 12 R. P. C. 202; *Henderson's Patent* 1901, 18 R. P. C. 449). But this might be capable of explanation, for even where the invention had never been brought into actual use through illness and other causes, the patent was prolonged (*Roper's Patent* 1897, 1 R. P. C. 201).

Invalid patent not prolonged.

The question was discussed, but not decided, whether a patent could be prolonged of which one of the claims was admittedly bad (*Burlingham's Patent* (1898), 15 R. P. C. 195). No doubt where the validity of the patent is obviously unsustainable, prolongation will not be granted; but where there is any doubt the Committee will leave that question to be decided in another Court (*Kay's Patent*, Good. P. C. 516).

Petitioner should show validity of patent.

In order that the Judicial Committee may have full information on the subject, a petitioner for prolongation

where there is any question as to validity, should himself refer to prior patents within his knowledge and touching in any manner on the subject-matter of his patent (*Lind's Patent* [1892], 9 R. P. C. 327).

Defective accounts.

An application for an adjournment to supplement defective accounts is not ordinarily granted (*Yates and Kellett's Patent* [1887], 4 R. P. C. 150).

Costs.

By Section 25, Sub-section 7, of the Act, the costs in proceedings for prolongation are in the absolute 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.

Costs of opponents.

A successful opponent will usually get his taxed costs. Very often when there are several opponents, as in *Hopkinson's Patent* ([1896] 14 R. P. C. 5), to simplify matters the Committee awards a lump sum to be divided among the opponents (*Ferranti's Patent* [1901], 18 R. P. C. 518).

Abandoned petition.

If the petition is abandoned those who have entered *caveats* of opposition will generally get their costs.

# CHAPTER XXI.

## ASSIGNMENTS OF PATENTS.

Patents assignable in whole or part.

THE form of grant being to the patentee, his executors, administrators, and "assigns," it follows, from the terms, that a patent is assignable. Not only is it assignable as a whole, but any part or share of the patent may be dealt with, or the right to use a distinct and separate part of the invention may be bought and sold (*Dunnicliffe v. Mallet* [1859], 7 C. B. N. S. 209). Further, by a direct provision in Section 30 of the Act, a patent may be assigned for any place in or part of the United Kingdom, and such district or divisional assignments are by no means uncommon.

By deed.

An assignment should be by deed (*per* Lindley and Bowen, L. JJ., in *Stewart v. Casey* [1891], 9 R. P. C. 9); for the grant itself being under seal, it follows, as a rule of law, that things which are created by deed can only be assigned by deed.

When not under seal.

If, however, an instrument not under seal purports to be an assignment of a patent, it is submitted that it would act as an agreement to assign, and specific performance could be enforced on this ground. At all events such an agreement would act as an equitable assignment (*Fletcher's Patent* [1893], 10 R. P. C. 252). An equitable assignee, however, is not in so favourable a position as a legal assignee, as he cannot sue infringers in his own name, and is liable to have his title defeated by a subsequent legal assignee taking without notice (*Actien Gesellschaft v. Tomler* [1900], 18 R. P. C. 6).

Executing assignments.

An assignment of a patent to take effect upon the happening of a certain event would operate as an assignment without further assurance upon the happening of the event (*Cartwright v. Amatt* [1799], 2 Bos. & P. 43).

Passes to trustee on bankruptcy.

If a patentee, or the proprietor of a patent or of a share in a patent, should become bankrupt, his interest or share passes to the trustee in bankruptcy.

Form of assignment.

In drawing an assignment, any form of words which clearly transfers the proprietorship of the patent from the assignor to the assignee will serve.

The usual course is first to indicate the patent grant, distinguishing it by number, date, and title. If the assignor is himself an assignee, the devolution of title should be set forth.

Next come the words purporting to assign the patent, together with the rights and powers of the patentee, the consideration being here set forth.

Covenant for title.

The covenant for title is implied, in accordance with The Conveyancing Act, 1881, if the assignor describes himself as the "beneficial owner" or "trustee." Next should follow a covenant for the validity of the patent, so far as the acts of the assignor are concerned, for there is no implied warranty of validity (*Hall v. Conder* [1857], 2 C. B. N. S. 22, 533). In addition, it is sometimes considered prudent to insert an express covenant as to any improvements upon the patent that may thereafter be made by the assignor (see *Pneumatic Tyre Co. v. Dunlop* [1896], 13 R. P. C. 553; *London Hosiery Co. v. Grisenthwaite* [1886], 3 R. P. C. 251). If this were not done, a patentee or assignor might immediately afterwards produce an invention which might entirely supersede the invention he had sold.

No implied warrant of validity.

Improvements on patent.

Provision for annuities.

When the assignment deals with a share of a patent only, or is an assignment for a specified district, it is advisable to make provision for the payment of the annuities; otherwise an assignee might find himself compelled, for his own sake, to pay the annuities which would keep the patent in force, not for his benefit alone, but for the benefit of others upon whom he would have no claim for contribution.

In all cases where there are several co-owners of a patent, it is advisable to make specific arrangements as to the payment of their proportions of the annual renewal fees by the owners, and to embody the arrangement so

made in a written instrument. The mutual rights and duties of the co-owners should also be laid down and limited in the same instrument.

Rights of co-patentees.

A co-patentee or joint owner or assignee might himself, and without the concurrence of the others, manufacture the invention, grant licences, or make profits without accounting to the other owners (*Matthews v. Olsson*, 1865, L. R. 1 Ch. 29; 34 Beav. 170; Good. P. C. 205). This might fall hardly on the others, as a manufacturer capable of turning out large quantities of the patented goods might, so long as he was owner of a small share in the patent, do so with impunity, and without paying a farthing to his co-patentees. They, on the other hand, might be unable to get the manufacture taken up by others, so that the owner of, say, one-sixth of a patent might be making large profits, while the holders of the remaining five-sixths were making nothing.

Agreements between co-patentees.

To prevent this, an agreement should be made binding the present or future co-owners to account to each other for the profits made by them respectively, and to act in concert when granting licences. With regard to the latter, however, it should be said that in *Matthews v. Olsson* (*supra*) an unreversed portion of the judgment of the Court of Appeal held that where one of several joint patentees grants a licence, he is bound to account for the profits to his co-patentees. But although this ruling was not specifically reversed, the Lord Chancellor, in the beginning of his judgment, expressed himself against this part also of Lord Romilly's finding in the Court below. The point is therefore doubtful.

Assignment to trustees.

In the event of the co-owners objecting to the quasi-partnership brought about by such an agreement as has been indicated, the patent could be assigned to trustees for the owners, the trustees being authorised to grant licences for the benefit of the owners, keep accounts of all profits, and distribute them in the proportions of ownership. The trustees would also be empowered to pay the renewal fees as they fall due, to provide for all current costs and expenses, and to institute or defend any proceedings at law in respect of the patent or trust.

A patent may be assigned to a body corporate in its corporate name, and such body corporate is entitled to be registered as the proprietor of the patent.

A patent assignable to a body corporate.

An action for infringement of a patent may be brought by the assignee, and the assignees of a bankrupt patentee may bring it. Where a distinct portion of a patent has been assigned, the assignee of that portion can act alone in bringing an action for infringement of this part of the invention. This was laid down by Erle, C. J., in *Donnisthorpe v. Mallett* (1859, 7 C. B. N. S. 209, 227).

Infringement action by assignee.

All assignments should be entered in the Register of Patents.

Entry on Register.

A patentee may mortgage his patent, in which case he remains the patentee and proprietor and is entitled to take action against infringers in his own name (*Van Gelder v. Sowerby Bridge*, 1860, 7 H. P. C. 205). He need not join the mortgagee as co-plaintiff. There is no provision for entering a mortgagee on the Register as proprietor; but the legal and even the equitable assignee is entitled to have his assignment noted on the Register.

Mortgage.

# CHAPTER XXII.

## LICENCES.

BY a Licence the patentee relaxes the prohibition contained in the grant of Letters Patent against the public in favour of a certain person, viz. the licensee, whereby the licensee is allowed to exercise the privilege originally granted exclusively to the patentee.

Licences may be classed as *E[illegible]*, *[illegible]*, and *Res[illegible]*.

An *E[illegible]* licence is a licence which is granted to one person [illegible] only. The patentee may reserve the [illegible] [illegible]

Licences should be under hand and seal (see form of grant), although this is not essential if the licence has been kept and worked under (*Thomas v. Hankinson* 1844, 12 M. & W. 823; 13 L. J. Ex. 198); but a licence of a less formal nature, even when granted by word of mouth, would be perfectly good as between licensor and licensee (*Crossley v. Dixon* 1863, 10 H. L. 293), especially if royalties have been paid and accepted. Such an oral licence could not of course be registered in the Patent Office. Form of licence.

The terms of a proposed licence should be very carefully scanned by the intending licensee otherwise in the event, for example, of the cancellation or voiding of the patent, he may find himself estopped from questioning the validity of the patent, although all the world besides may use it (*Heaton-Noble Co. v. Stockton Co.* 1894, 11 R. P. C. 230). Formally speaking, the mere relation of licensor and licensee implies that the taker of the licence while the licence remains in force admits the validity of the patent and is therefore estopped on [illegible]

notice in writing to the licensor, and at the same time cease to use the invention (*Hodges v. Wallace*, 1892, 10 R. P. C. 21; *Crossley v. Dixon*, 1863, 10 H. L. 293).

Licensee estopped to dispute validity of patent.

When the relationship of licensor and licensee has been thus properly determined estoppel is gone, and the licensee may afterwards dispute the validity of the patent, that is to say, if he again commences to manufacture under the patent, he will be prima facie to be dealt with as an ordinary infringer, and not as being estopped under his former licence. When the licence is coupled with an interest so as to be more than a bare licence, it is of the nature of a grant and is not revocable at will, unless the determination [illegible]

Where [illegible] to the construction of [illegible] the licensee as much as possible by the terms of the agreement at the one end, and to the [illegible]

figure per annum within a given period. Otherwise an interested manufacturer might take an exclusive license for the express purpose of locking the patent up.

In the case of an exclusive license, the payment of the renewal fees by one or other of the parties should be expressly provided for. In the absence of such provision neither would be bound to pay the fees and the licenses of the license might continue after the patent had lapsed.

observation of Lindley, L. J., in *Guyot v. Thomson (supra)*, that such a licence is not a conveyance within the meaning of The Conveyancing and Law of Property Act, 1881, Section 7.

Licensee may vary article if within limits of patent.

So long as a licensee fairly produces the patented article he is not liable to an action for infringement or for departure from the terms of the licence, though he may deviate from a defining drawing and deposited pattern in a point not within nor of the essence of the invention (*Dunlop Co. v. Buckingham & Adams Co.* [1901], 18 R. P. C. 423; see also *Dunlop Co. v. Cresswell et al.* [1901], 18 R. P. C. 473).

Covenants by licensee.

The licensee usually covenants to pay the royalties and other sums agreed upon; to keep proper books of account; to allow inspection and the taking of extracts; and to make periodical returns, verified by statutory declaration, if required. He should also agree to stamp, number, or otherwise distinguish the goods where this is possible.

Covenants generally.

All questions as to mutual assistance in litigation, detection of infringements, the patenting of improvements, terms of revocation of licence, settlement of disputes by arbitration, &c., may be set forth in the instrument according to the arrangements of the parties.

Fraudulent licensor.

Where it is apparent that the licensor has acted fraudulently, all royalties and sums paid to him under the licence are recoverable.

Entry of licence on Register.

Licences should be entered on the Register of Patents, and a registration fee of ten shillings is payable thereon. When the licence is by deed and no premium or fixed sum is payable on the making, the consideration being therefore uncertain, it must bear a stamp of ten shillings under the Stamp Act, 1891. Where a fixed sum is paid, an *ad valorem* duty is required, whether the licence is by deed or otherwise. Where the licence contains a provision for [illegible]

## Compulsory Licences.

Compulsory licences, section 22.

By Section 22 of the Patents Act the petitioner for a compulsory licence must establish to the satisfaction of the Board of Trade that by reason of the default of the patentee to grant licences on reasonable terms

What the petitioner must establish

(A) The patent is not being worked in the United Kingdom; or

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

(C) Any person is prevented from working or using to the best advantage an invention of which he is possessed.

Order by Board of Trade

If the petitioner succeeds in establishing one or all of these grounds of complaint the Board of Trade may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by *mandamus*.

This section has up till recently remained almost [illegible] inoperative. From the commencement of the Act till the end of 1897 only three applications for compulsory licences were made, and these so ill-conducted or factious that none of the three ever reached a hearing. Of late, however several applications for compulsory licences have been heard and decided, so that the procedure and practice under the compulsory licence clause is better understood.

The Board of Trade does not as a matter of course hear the application [illegible] but refers it to a referee, who usually [illegible] court elsewhere pro tem. The referee after hearing the application and [illegible]

the nature of the petitioner's interest," so that presumably some interest is required to give the petitioner *locus standi*. Exactly what interest is necessary can scarcely at present be defined. Where the complaint is that the patent is not being worked in the United Kingdom, or that the reasonable requirements of the public with respect to the invention cannot be supplied, it would seem that the different divisions of the public, political or otherwise, should be considered, and that, for example, a Liberal journal has a right to be placed in as favourable a position as a Conservative journal with regard to an invention for rapidly effecting changes in evening editions (*Hutton and Bleakley's Petition* 1898, 15 R. P. C. 749). A petitioner who asserts that the patent is not being worked in the United Kingdom should prove himself or some other co-petitioner to be in a position forthwith to manufacture in accordance with the licence (*Continental Tyre Syndicate's Petition* 1898, 15 R. P. C. 727).

Grounds of petition.

Under Heads (a) and (c) it seems that any member of the public who can show that the non-working of the patent or the non-supply to the public prejudicially affects [illegible] has sufficient interest to entitle him to petition. [illegible]

Reference by Board of Trade to referee.

The Board refers the petition and evidence to an expert referee, and if a *primâ facie* case for relief is made out then the petitioner is directed to deliver copies of the petition and evidence to the patentee. If, on the contrary, the petitioner is thought not to have made out a *primâ facie* case the petition is dismissed.

Declaration to be left by patentee

Within fourteen days from delivery of the petitioner's papers the patentee must leave at the Patent Office his declarations in opposition to the petition, and deliver copies to the petitioner.

Replies by petitioner.

The petitioner, within fourteen days from such delivery, must leave at the Patent Office his declarations in reply, and deliver copies to the patentee.

Hearing

The date of the hearing is then fixed by the Board of Trade, and the parties attend before the referee

The petitioner begins, the patentee replies, and the petitioner concludes. The referee will hear oral evidence, and on application may allow or require cross-examination of those who have made affidavits or declarations

[illegible]

# CHAPTER XXIII.

## AGREEMENTS.

AGREEMENTS, either conclusive or of a preliminary or executory nature, sometimes play an important part among documents affecting the working and proprietorship of patents and inventions.

Agreement prior to application.

Agreements may be made either before or after an application for the grant of a patent, and may be for divers objects. For example, if a poor inventor should make an application in conjunction with a person who has had no share in evolving the invention, but whose functions will be those of paying the expenses of obtaining the patent and of introducing the invention commercially, such an arrangement should form the subject-matter of an agreement prior to the application being made; for if this is not done, the mere presence of the co-applicant's name on the patent would vest him with equal proprietary rights, which it might be difficult to disprove if he should afterwards refuse to enter into the intended agreement. Other reasons for agreement might arise in the case of a money loan from someone to pay the cost of the patent and afterwards to introduce it, the lender to acquire a share in the patent. Such pre-application agreement should distinctly identify the invention (*per* North, J., in *Parnell's Patent* [1888], 5 R. P. C. 126); otherwise the Comptroller might refuse to register it (if this should afterwards become necessary), on the ground that he had no means of verifying the representation that the invention mentioned in the agreement was the same as that afterwards protected.

Inventor and capitalist.

Registration.

Joint applicants or patentees.

In the case of joint applicants or patentees, an agreement might be made between them, either before or after the grant of the patent, which will limit and define the respective rights of the parties, so that no one should

have an undue advantage over his co-patentees. Such severance of joint ownership would prevent the share of any deceased co-patentee from passing by survivorship to the surviving patentee (*National Co. v. Gibbs* [1899], 16 R. P. C. 330). Severance of joint ownership.

A share in an invention, and in the patent to be afterwards obtained, may be purchased even before application is made for a patent, and an agreement may be based upon this sale, in which the inventor binds himself to assign a share in the patent as soon as it shall have been issued; but care must be taken clearly to identify the invention referred to in the agreement with the invention protected or patented. Agreement for share of patent.

Legally, until the Letters Patent are actually sealed and issued, there is no vendible property existing: therefore an absolute assignment by deed of a patent for which application only has been made is not effectual. All that can be done is to make an agreement to assign when the patent is issued, and specific performance of such a contract will always be enforced, or, if conditional to do so on the sealing of the patent, the happening of that event would cause the agreement to operate as an assignment. No property in patent till sealed.

The question of the registrability of agreements of the foregoing nature will be referred to in the following chapter on the Register of Patents.

# CHAPTER XXIV.

## THE REGISTER OF PATENTS.

Object of Register.

WHEN a patent is sealed the Comptroller causes it to be entered by its date, number, and title, together with the name of the patentee, in the Register of Patents, which is a book kept at the Patent Office and containing particulars of everything affecting the existence and proprietorship of each patent so entered. Thus, the Register contains entries of assignments, licences, amendments, extensions, revocations, payments of renewal fees, and other incidents in the life of a patent.

Assignments, whether of the whole or of a part of a patent, or assignments of a patent for a limited or local field only, are all competent to be placed on the Register by the assignee, who is registered as absolute proprietor or as proprietor to the extent of the interest provided for in the deed.

Registration necessary to protect assignee.

An assignee is not compelled to register his assignment, but if he fails to do so he runs the risk of having his claim defeated by someone else who does register (*per* Lindley, M. R., in *New Arion Co. v. Spilsbury* [1898], 15 R. P. C., at p. 571).

Register as evidence.

The Register is *prima facie* evidence of any matters inscribed therein (Section 23, Sub-section 2).

Trusts not entered.

No notice of any trust, express, implied, or constructive, will be entered on the Register (*Haslett v. Hutchinson* [1891], 8 R. P. C. 457), but registration of an assignment containing trusts would not be refused. For example, it was held in *Stenard v. Casey* ([1891] 9 R. P. C. 9) that on the true construction of Sections 23, 85, and 87 of the Patents Act of 1883 (and the Patent Rules of 1883), Section 85 only excludes from the Register simple notices of trust, and not documents affecting the proprietorship of a patent, whether by creating trusts or otherwise; and that equitable

Equitable assignments.

assignments of a patent, or of a share in a patent, may be entered on the Register as documents affecting the proprietorship.

Documents dated before the sealing of Letters Patent, but after the date of application, will be accepted for entry on the Register, but only after the sealing of the patent. Documents dated before sealing.

In the majority of cases documents referring to dealings with an invention before application has been made for a patent are not capable of being entered on the Register at any time. The reason is that the Comptroller would have great difficulty in satisfying himself, except in rare instances, that the invention referred to in the document sought to be registered was the same as that afterwards protected and patented. For example, suppose that the invention referred to in the document was described simply as "Improvements in Prime Movers," without any further particularisation or means of identification, and that the application afterwards made had precisely the same title, it will be easily seen that this title might serve for fifty different inventions, and that the invention contemplated in the document might have been for an improvement in the cut-off valve of a steam engine, while the application, although bearing the same title, might refer to an entirely different part of, and be applicable to, an entirely different class of motor. Documents dated before application. Instance of non-registrable document.

Still, it is evident from the words of North, J., in *Parnell's Patent* ([1888] 5 R. P. C. 126), that where the invention referred to in the document and the invention afterwards patented are *unquestionably* the same, registration will not be refused. Therefore, in such an agreement a sketch and description of the invention should be attached so as to identify it with the subject-matter of the application to be afterwards made. The pre-application document must identify invention.

An agreement to be capable of registration must be in writing, and therefore agreements by word of mouth cannot be registered. Further, the agreement must be complete, for an incomplete agreement can give no legal or equitable title to the ownership of a patent (*Fletcher's Patent* [1893], 10 R. P. C. 252; *Haslett v. Hutchinson* [1891], 8 R. P. C. 457). Registrable matter must be in writing.

Mortgages.

No mere mortgagee can be entered as proprietor of a patent, but it seems that a notification of his interest may be entered on the Register, the mortgagor remaining on the Register as legal owner.

Assignments by deed.

An assignment of a patent must be by deed, and the assignee, by virtue of such a legal assignment, can get himself placed on the Register as owner of the patent.

Equitable assignments.

Nevertheless, as intimated in the last chapter, other documents not constituting legal assignments under seal, but operative as equitable assignments, may be entered on the Register (under Section 23 of the Act, in combination with Rule 46) as affecting the proprietorship of the patent (*Stewart v. Casey* [1891], 9 R. P. C. 19): that is to say, that although an equitable assignee cannot on that account alone get himself put on the Register as proprietor, nevertheless the recording on the Register of his equitable right and interest acts as a protection in so far as it gives notice to others of his claim in equity to have the proprietorship altered at law.

Alteration of proprietor's name.

The Comptroller has power under Sections 78 and 87 to alter the name of a corporate body or patentee entered as proprietor on the Register as and when such alteration of name arises by operation of law. Thus, a company altering its designation, or a woman changing her name by marriage, or a man by deed poll, can have the alteration made on the Register (*ex parte New Ormonde Cycle Co.* [1896], 13 R. P. C. 475).

Correction of clerical errors.

Clerical errors in the name or address of a registered proprietor of a patent may be corrected under Section 91 of the Act on request in writing addressed to the Comptroller, and accompanied by the prescribed fee.

Varying the Register by order of Court.

Power is given to the Court by Section 90 to make, expunge, or vary entries in the Register on the application of any person aggrieved. The Court may direct an issue to be tried for the decision of any question of fact, and may award damages and costs to the party aggrieved. The application may be made by summons or notice of motion. When the registered proprietor against whom the application is directed is domiciled in Scotland or Ireland.

it has been contended that the Courts there have no special jurisdiction in such cases, and the proceedings are generally instituted in the High Court. However, it is well to note here that although the Irish Court in *Hayes v. Connell* (1897 14 R. P. C. 273) disclaimed jurisdiction, the Court of Session in Scotland in *Currie v. Herbert* (1897) 14 R. P. C. 430) was of opinion that it had jurisdiction to entertain a petition for rectification of the Register. If the registered proprietor is a foreigner, the accepted course is to serve the Comptroller with copies of the summons or notice of motion with an intimation of the date of hearing, which will apparently be transmitted by the Comptroller to the foreign proprietor (*La Compagnie Générale &c.* 1891, 8 R. P. C. 406).

Appeal.

An appeal lies from the High Court to the Court of Appeal.

Entry of order in Register.

It is the duty of any person in whose favour an order of extension or revocation of a patent has been made to carry the order to the Patent Office, and see that the purport of the order is duly entered on the Register (*Patent Rule 74*).

When a person becomes entitled to a patent, or to an interest therein, by agreement, or by transmission, or by operation of law, he should forward a request to the Comptroller for the entry of his name on the Register as complete or partial owner of the patent.

Form of request to enter on Register.

The request should be made according to Form "L," and should be signed by the person requesting to be registered as proprietor.

Body corporate.

A body corporate may be registered as proprietor in its corporate name, and in such a case the request should be signed by an authorised agent or by the secretary or other proper officer.

Documents to accompany request.

The request—on Form "L" in the case of an assignment and on Form "M" in the case of a licence—should be accompanied by the original assignment, licence, or other document, and by an attested copy of the same, which is retained by the Comptroller.

Collateral documents.

If the assignment or other instrument should refer to a document or documents affecting the title and not in the possession of the Comptroller, the original or an official or attested copy must be left with the Comptroller.

Certified extracts.

Certified extracts from the Register are furnished by the Comptroller on payment of a small fee, and the Register is open to the inspection of the public every weekday. Thus a proposing purchaser or licensee can satisfy himself concerning all registered dealings with the patent.

Rectification by Court.

Where rectification of the Register has been ordered by the Court, the order directs due notice of the rectification to be given to the Comptroller, who will thereupon amend the Register.

# CHAPTER XXV.

## MISCELLANEOUS.

### Offences and Penalties: Patent Medicines: Patent Agents.

#### *Offences and Penalties.*

Falsely representing an article as patented.

SECTION 105 of the Act of 1883 provides that "Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, shall be liable for every offence, on summary conviction, to a fine not exceeding five pounds."

A person shall be deemed to represent that an article is patented if he sell the article with the word "Patent," "Patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed, or otherwise applied to the article.

Expired patent.

It is apparently not an offence under this section to continue to mark an article as "Patent" after the patent has expired, but the number and year of the patent should be added so as not to deceive the public (*Bousome v. Graham* [1882], 51 L. J., Ch. at p. 903).

Inventions provisionally protected.

Where an invention has been provisionally protected only, it is an offence to mark it as "Patented" (*Reg. v. Wallis* [1885], 3 R. P. C. 1; *Reg. v. Crampton* [1886], 3 R. P. C. 367). In such a case the best course is to mark on the article, "Patent applied for, No. ." Where a Complete Specification has been accepted by the Patent Office, the applicant is declared by Section 15 to have "the like privileges and rights as if a patent for the invention had been sealed," except the right to sue infringers. It is submitted that this gives him the right to stamp his goods

Complete Specification accepted.

"Patent." At all events, in *Reg. v. Townsend* ([1896] 13 R. P. C. 265), the prosecution failed as against an applicant who had done so.

Use of Royal Arms.

The succeeding section (106) forbids the use, except under authority, of the Royal Arms, or of arms deceptively similar thereto, in the carrying on of any business or calling, and so as to lead to the belief that the said business or calling is being carried on under royal or official authority or patronage. The maximum fine on summary conviction is twenty pounds.

False entry on Register.

By Section 63 of the Patent Act any person making a false entry in the Register of Patents, or producing in evidence any writing falsely purporting to be a copy of any entry therein, is guilty of a misdemeanour.

## *Patent Medicines.*

Offence to describe stamp medicines as patent.

What are popularly known as "Patent Medicines" are distinct from patented inventions, and the term is a misnomer, which it is apparently no longer legal to use in the way of business. Under The Stamp Medicines Act, 1812, stamps, for application to any particular proprietary medicine, may be had from the Secretary of Stamps and Taxes, Inland Revenue, Somerset House, London. The applicant is required to pay for the preparation of the plate from which his stamps are to be printed, and this plate is kept in the custody of the Secretary, and used only for the purpose of printing the stamps which the owner may require.

As has been said, such stamped proprietary medicines have hitherto been marked, known and sold as "Patent Medicines," although not the subject of Letters Patent. Now, however, it is clear that, strictly speaking, anyone describing and selling medicines of this description as "Patent Medicines" might be liable to a penalty. In *Pharmaceutical Society v. Piper* ([1896] L. R. 1 Q. B. 686) Collins, J., distinctly held that patent medicines meant "*Medicines the subject of Letters Patent.*"

## *Patent Agents.*

Registration of Patent Agents.

Under the Supplementary Act of 1888 it was provided that after the 1st of July, 1889, no person shall be entitled to describe himself as a Patent Agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a Patent Agent. Any person contravening the section is liable on summary conviction to a fine not exceeding twenty pounds. The term "Patent Agent" means exclusively an agent for obtaining patents in the United Kingdom. The passing of this Act was a most necessary recognition of the importance to the public of the Patent Agent's profession. Up to the date of the Act there had been no means whatever of excluding incompetent persons from practising, much to the detriment of the public. In forming the Roll it was of course impossible to shut out many with very slender claims to admission. But, in spite of this drawback, it may fairly be said that the great body of the profession as it now exists has attained a very high standard of efficiency. Admission to the Roll is now only to be obtained after proof of proper professional training as a pupil under a registered Patent Agent, and after passing very searching qualifying examinations, which are held from time to time under the Register of Patent Agents Rules, 1889 to 1891.

Penalty for false description as "Patent Agent."

Admission to Roll by examination.

It seems that by the very narrow interpretation of the Act of 1888 an unregistered person can only be convicted if he has expressly described himself as a "Patent Agent." To call himself a "Patent Expert" was held not to be an offence (*Graham v. Ell* [1898], 15 R. P. C. 250). A person *bond fide* in business as a Patent Agent before the commencement of the Act is entitled to registration, but if he continues to practise without being registered he commits an offence (*Storey v. Graham* [1899], 1 Q. B. 406: 16 R. P. C. 106). An annual fee is payable by all registered agents. A person who omits to pay this fee is struck off the Roll, and if he continues to practise is liable to prosecution (*Institute of Patent Agents v. Lockwood* [1894], 11 R. P. C. 374: [1894], App. Ca. 347). In the latter case it was held that the Patent

Persons entitled to registration.

Annual fee payable.

Rules of 1888.

Agents Rules under the Act of 1888 were neither unreasonable nor *ultra vires*, but were of the same effect as if they were contained in the Act; and in *Storey v. Graham* (*supra*) the Divisional Court held that if the Rules of 1889 had been repealed as contended by the appellant they were revived by the Rules of 1901.

Rules of 1905.

By the Patents Rules of 1905 the Comptroller is authorised by the Board of Trade to refuse to recognise or to communicate with any person as Patent Agent whose name has been struck off the Roll for malpractices.

Chartered Institute of Patent Agents.

The Institute of Patent Agents, which was intended to constitute a representative body of the Patent Agents of the United Kingdom, was formed in 1882, and was incorporated by Royal Charter in 1891. The Fellows of this Institute have alone the privilege of styling themselves Chartered Patent Agents. The transactions of the Institute are published annually in a volume edited by the Secretary.

# PART II.

# TRADE MARKS.

## CHAPTER I.

### INTRODUCTION.

Origin of trade marks.

THE custom of a maker of vendible goods adopting a distinctive mark to affix to his merchandise is very ancient.

Among communities where reading was a rare accomplishment shops and taverns were invariably distinguished not by the names of their owners, but by their signs, and the same appeal to the eye of the unlearned was made for the purpose of distinguishing goods. Antiquarians point to such distinctive makers' marks upon objects identified with various periods in the world's history, and there is no doubt that in the most remote times a workman whose goods had acquired favour by reason of his skill and care marked his products so as to show their origin. From 1300 A.D. to 1600 A.D. it is certain that both in this country and on the Continent the use of merchants' marks was general. These were probably used to distinguish one trader's goods and bales from those of another, so as to prevent confusion in carriage and handling by assistants wholly illiterate. They were hereditary, and, these being the days of one man one mark, a merchant regarded his mark with as much legitimate pride as did the noble his coat-of-arms. They are to be found carved on buildings and tombs, and even Mother Church was not above complimenting a merchant who had been a liberal donor to her funds by allowing him to place his mark in memorial

Mediæval merchants' marks.

windows among the blazoned shields of knights and nobles who had done likewise. Such a practice is alluded to in the following extract from "Piers Plowman's Creed," written about the end of the fourteenth century:—

"Wyde wyndowes y-wrought
Y-wryten ful thykke
Shynen with shapen sheldes
To shewen aboute
Wyth *merkes of merchauntes*
Y-meled betweme."

Early recognition of trade marks at Common Law.

At an early period in our own history the Common Law began to take note of and punish fraudulent imitations of makers' marks, and to recognise and protect the right of the producer or merchant to have his distinctive mark reserved exclusively to himself.

*Southern v. How, temp.* Elizabeth.

The first recorded case, although in all probability not the first dealt with by the Courts, is that of *Southern v. How* (*Popham*, 144), which occurred in the reign of Elizabeth, and in which damages were given to a clothmaker or clothdealer—it is not clear which—on proof of piracy of his distinctive mark. It is true that in after cases—as, for example, in *Blanchard v. Hill* ([1742] 2 Atk. 484)—the Courts, suspicious of creating anything that seemed to savour of monopoly, for some time hesitated to declare that there was any actual right of property in a trade mark; but early in the present century this ceased to be a matter of doubt. For example, in the year 1824, in *Sykes v. Sykes* (3 B. & Cr. 541), the danger to the public was first recognised of allowing an improperly applied trade mark on goods which did not deceive the first purchaser to go forth to the world, and in changing hands deceive some *ultimate* purchaser who had not the knowledge of the first buyer; while some years later, in *Millington v. Fox* ([1838] 3 My. & Cr. 338), the necessity of proving fraudulent intention under the Common Law on the part of the defendant was done away with. These decisions show that it had become apparent that the exclusive possession of a distinctive trade mark was in no sense a monopoly likely to be injurious to the public, but was in reality a protection to them.

*Blanchard v. Hill.*

Gradual recognition of right of property in trade marks.

*Sykes v. Sykes.*

*Danger of ultimate deception of purchaser.*

Proof of fraudulent intention not necessary.

*Millington v. Fox.*

Trade mark not a monopoly.

It was of advantage to the trader, because he was thereby enabled to reap with more certainty the custom to which his skill and enterprise entitled him. It was also a protection to the public, because in buying an article which bore a well-known mark they were more certain of getting something which possessed acknowledged and approved qualities.

A protection to the public.

The accepted principles upon which the Courts now proceed in trade mark cases are best expressed in the following deliverance of Bacon, V.-C., in *Ransome v. Graham* ([1882] 51 L. J. Ch. 897):—"A manufacturer who produces an article of merchandise which he announces as of public utility, and who places upon it a mark by which it is distinguished from all other articles of a similar kind, with the intention that it may be known to be of his manufacture, becomes the exclusive owner of that which is henceforth called his 'trade mark.' By the law of this country (and the like law prevails in most other civilised countries) he obtains a property in the mark which he so affixes to his goods. The property thus acquired by the manufacturer, like all other property, is under the protection of the law, and for the invasion of the right of the owner of such property the law affords a remedy similar in all respects to that by which the possession and enjoyment of all property is secured to the owners."

Bacon, V.-C., on trade marks and their ownership.

It will be noted that the learned Vice-Chancellor, in the foregoing quotation, speaks only of a "manufacturer" adopting a trade mark for the goods he has made. It must, however, be said that, although this is perhaps the most common ownership of a trade mark, there are many instances where the mark is adopted and applied by those who are not actual makers of the goods to which the mark is attached. Thus one person may weave calico, and another may print or bleach or pack it, and a trade mark might be applied by the printer or bleacher or packer, and be registered by him and recognised as his alone (*re Sykes* [1880], 43 L. T. N. S. 626); or the mark might be applied by a mere middleman, who has no share whatever in the manufacture or treatment of the goods, such as an exporter or importer, who merely sells or buys (*Ralli*

Persons entitled to require and use trade marks.

*v. Fleming*, Ind. L. R., 3 Calc. 417; *re Apollinaris Co.* [1891], 2 Ch. 186; 8 R. P. C. 137); or by a person who has selected the goods (*re Australian Wine Importers Co.* [1889], 6 R. P. C. 311; 41 Ch. D. 278; *Leahy v. Glover* [1893], 10 R. P. C. 141). In all of these cases the mark belongs to the middleman, and the actual manufacturer, who supplies him with the goods to which the mark is affixed, has no claim to any share in it.

Trade marks applicable to natural products.

But, apart from manufactured goods, trade marks might be used to distinguish substances which are natural products, such as moulders' sand, coal, mineral waters, mineral oils, fruit, and the like. Even the name of a natural product may be appropriated as a trade name to an individual if he alone has exclusive access to the natural product (*Apollinaris Co. v. Norrish* [1875], 33 L. T. N. S. 242; *Rodde v. Norman* [1872], L. R. 14 Eq. 345).

Trade marks not registrable before 1875.

Previous to 1875 no means existed for acquiring and protecting trade marks by registration. It was occasionally the practice to enter a trade mark at Stationers' Hall; but this conferred no protection whatever. Therefore in bringing an action against an infringer it was necessary to depend entirely upon the Common Law right, and to prove prescriptive user before the plaintiff's right to take action was admitted.

Merchandise Marks Acts, 1862 and 1887.

The Merchandise Marks Act, 1862, had for its main object to subject infringers of trade marks to the operation of the Criminal Law, and the same is the case under The Merchandise Marks Act, 1887. But before the latter date registration had been provided for by The Trade Marks Registration Acts, 1875 to 1877, and at the present time registration is governed by The Patents, Designs, and Trade Marks Acts, 1883 to 1901.

Trade Marks Registration Acts, 1875 to 1877.

Patents, Designs, and Trade Marks Acts, 1883 to 1901.

Registration of trade marks is granted to aliens, and the rights of aliens in their marks are protected in the English Courts as rigorously as if they belonged to British subjects.

# CHAPTER II.

## ON THE NATURE AND DEFINITION OF A TRADE MARK.

PASSING over in the meantime the definitions of trade marks as set out in The Merchandise Marks Acts, 1862 and 1887, and as in The Trade Marks Act, 1875, the present statutory definition of a trade mark is to be found in Section 64 of the Patents Act as amended by the Act of 1888. The definition as it now stands is as follows:—

Definition of trade marks.

**64.** (1) For the purposes of this Act, a trade mark must consist of, or contain at least one of, the following essential particulars:

(A) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or — Distinctive reproduction of name.

(B) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or — Signature.

(C) A distinctive device, mark, brand, heading, label, or ticket; or — Device, brand, &c.

(D) An invented word or invented words; or — Invented word.

(E) A word or words having no reference to the character or quality of the goods, and not being a geographical name. — Selected word.

(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any — Additions and disclaimers.

right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

(3) Provided as follows:-

Not necessary to disclaim name.

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

Old word, letter, and figure marks.

(ii.) Any special or 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.

Definitions amplified.

The foregoing definitions are sufficiently clear to speak for themselves, but a short reference to each head may prove of advantage.

Name marks.

**First.**—(A) **A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or**

**Secondly.**—(B) **A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark.**

The first and second heads are practically one and the same, and may be treated together.

Name *per se* not a registrable trade mark.

By itself, and apart from any distinctive manner of printing or impressing, a name may constitute a trade mark—not a registrable trade mark—but still a species of property which can under the Common Law be made good against all the world, with the exception of *persons of the same name*. For it is clear that, although a manufacturer of the name of Smith may have carried on business as a sewing machine maker for many years, and may have made his name famous in connection with sewing machines, he

cannot on that account prevent another person of the same name from establishing a similar business, and selling machines under his own name. Smith would have his remedy if Jones were to manufacture sewing machines and sell them under the name of Smith, because it would be reasonable to imply that such a course showed fraudulent intent on the part of Jones to take improper advantage of the fame acquired by Smith. The rule, therefore, is that whilst as against persons bearing a different name a manufacturer's Common law right in his "name trade mark" is absolute and exclusive, nevertheless as against persons bearing the same name no such exclusive right can be set up. Cases that may be referred to on this point are *Burgess v. Burgess* (1853) 3 De G. M. & G. 896), *Faber v. Faber* (1867) 49 Barb. 357), *Jamieson v. Jamieson* (1898) 15 R. P. C. 169), and *Turton v. Turton* (1888) 42 Ch. D. 128).

Common law remedy against fraudulent use of name.

It must, however, be said that in some cases, even as against persons of the same name, a manufacturer would have his remedy, and a rival may be restrained from the free use of his own name, especially if any fraudulent or unfair conduct in connection with such use can be brought home to him. Take, for example, the case of *Pinet v. Pinet* ([1897] 15 R. P. C. 65), where it was found that the defendant had changed his name to Pinet for an impliedly fraudulent purpose. Even if it can be shown that he has not taken sufficient care to distinguish his goods from the plaintiff's, the defendant may be restrained. Thus, in *Brookes v. Brookes et al.* (1899) 16 R. P. C. 523) the defendant was enjoined from using his own name (albeit it differed in spelling from the plaintiff's) in any such manner as to confound his cycle saddles with those of the plaintiff. Indeed it might be said that of late the Courts have shown a disposition to go even further than this and say that where a man sets up a business under his own name he may be restrained from using his own name at all in connection with specific goods which have become identified with the name of an old-established firm of the same name, even although no fraud is alleged (*Cash v. Cash* [1901], 18 R. P. C. 213; *Valentine v. Valentine* (1900), 17 R. P. C. 673). The tenor of the order in *Cash v. Cash* was such as virtually

Restraints upon the use of a man's own name.

*Cash v. Cash.*

to debar the defendant from using his own name at all or in any form in connection with frillings and woven initials, which goes far beyond the old cases. In *Holloway v. Holloway* (1850, 13 Beav. 209) a brother of the plaintiff had to submit to an injunction, because it was held that he used his own name in such a manner as to imply a fraudulent intent to pass off his pills and ointment as of the plaintiff's manufacture.

*Holloway v. Holloway.*

*Burgess v. Burgess* (*supra*) was decided upon similar lines, although within more restricted limits, the defendant being restrained from using any sign or intimation capable of confusing the two establishments in the public mind. These and other cases may be submitted as showing that the mere name of an individual or firm, although not now registrable, is a perfectly valid trade mark, but subject to this disadvantage, that the owners cannot always prevent others of the same name from using it also for the same class of business, so long as such others use it honestly.

*Burgess v. Burgess.*

Name only registrable when reproduced in distinctive manner.

As has, however, been said, a mere trade name, *per se*, and without any distinctiveness in its get-up, never was, and is not now, registrable in itself as a trade mark. It must, as the present Act says, be printed, impressed, woven, or otherwise produced in *some particular and distinctive manner*—that is to say, in some ornamental, fanciful, or peculiar fashion; and it is clear that a copy of a written signature comes under this description, since any one written signature is distinctive from another written signature. A trade name registered in this distinctive manner is then good against all the world—that is to say, *in its distinctive dress*. Except as regards the copy of a signature, the name registered in its distinctive dress need not be the actual name of the individual or firm applying for registration.

Signature.

Signature must be actual name.

**Thirdly.**—(c) **A distinctive device, mark, brand, heading, label, or ticket.**

Device, brand, &c.

It will be noticed that each variety of mark set forth is subject to the qualification of distinctiveness. Applications for registration of marks under this heading are closely tested in respect of the essential feature of distinctiveness,

Distinctiveness.

and refusals are frequent on account of its absence. The mark must not only be distinctive—*i.e.* noteworthy in itself—but it must also be distinctive as compared with other existing marks.

Device.

The word "device" relates to a picture, such for example as a representation of some real or imaginary animal, or a geometrical or other figure, or crest, or in some cases a portrait (*Borland v. Michell* [1897], 1 Ch. 71; 14 R. P. C. 37). It seems that "device" does not include a word or arrangement of letters however distinctively combined (*see parte Stephens* [1876], 3 Ch. D. 659).

Marks.

It has been held in America that "marks" or lines on an article for a useful purpose—such, for example, as marking tobacco or edibles into squares or figures for the purpose of easy and exact subdivision—cannot be claimed as exclusive trade marks (*Hausman v. Ruffner*, 15 U. S. Pat. Gaz. 559).

Representations of goods.

It was at one time possible to register pictorial representations of the goods as trade marks to be applied thereto; but the Comptroller will not now accept such pictorial representations as registrable trade marks (see Official Order in *Trade Marks Journal*, No. 570, 27th February, 1889).

Initials.

It may be taken that initials printed in the ordinary non-distinctive manner are not registrable as trade marks, but initials arranged as a monogram or design of a sufficiently distinctive character, and especially when combined with some device, are usually accepted by the Comptroller.

Brand.

A "brand" is a mark for branding on corks, casks, butter-tubs, and the like. A "brand" is also applied to metal goods in bar and pig form, these goods being generally spoken of as under a particular "brand."

Heading.

"Heading" is a technical name best known in the Manchester trade, and used to designate coloured or other stripes, or combinations of stripes, woven or printed, as headings or narrow borders upon the selvages or ends of piece goods. Registration of such "headings" is now possible only in the case of combination old marks, and even with old marks registration is extremely unlikely. It is certain that no new mark would now be registered

which consists only of coloured stripes or arrangements of stripes as a "heading" to piece goods. An application for such a mark would be refused for lack of distinctiveness. "Heading" has also been interpreted as an additional and auxiliary label applied above the ordinary label upon which the chief mark is printed, but its recognised and usual meaning is that known in the Manchester trade.

Label. "Label" clearly refers to adhesive papers bearing the trade mark and capable of being stuck upon bottles, jars, cases, packets, and the like.

Ticket. "Ticket" describes the case of a mark impressed upon a piece of material, such as pasteboard or metal, and loosely attached to the goods. The examples which most readily suggest themselves are the tickets pinned to the wares of a fancy goods dealer or a clothier.

Invented words. **Fourthly.** — (b) **An invented word or invented words.**

No fancy words under Trade Marks Act, 1875. The Trade Marks Acts, 1875 to 1877, excluded fancy words from registration. The Patents Act, 1883, permitted the registration of fancy words not in common use. A fancy word has always been a favourite form of trade mark, since it is available not only to sight, but to speech, hearing, and memory. As a result of the Act of 1883 so many applications were received for the registration of fancy words, most of them both descriptive and laudatory of the goods, that the Courts were obliged to restrict and narrow the construction of the term "fancy word." In the leading case on the subject (*in re Van Duzer* [1887], 4 R. P. C. 31; 34 Ch. D. 623) it was finally decided that a fancy word, to be capable of registration, must be a word having no meaning at all to the average Englishman, such for example as the word "Aeilyton": a word which, as Lopes, L. J., put it, was so obviously inappropriate to the goods as neither to be deceptive nor descriptive. "Melrose" was the word which Van Duzer wished to register as a trade mark for hair restorer; and the Court of Appeal held it to be geographically descriptive and deceptive. On the same day the Court considered *Leaf's Application* ([1887] 4 R. P. C. 31), which was for registration of the word

Fancy words under the Act of 1883.

*In re Van Duzer.*

Definition of "fancy words."

"Electric" as applied to velveteens. This word the Court considered descriptive, although why is not at the present day very obvious. At all events, both applications were refused on the ground that the words were not fancy words within the meaning of the Act.

Act of 1888, "invented words."

These "fancy word" cases were decided in 1887. In 1888 was passed the amending Act, which substituted "invented" words for "fancy" words. Undoubtedly the legislature intended the Act to relieve the Court of the burdensome consideration of "fancy words." But the Courts at first showed no inclination to part from the traditions and currents of thought set up by their bygone contests with fancy words. The House of Lords has intimated in the "Solio" Case that the decisions before the Act of 1888 afford no assistance in the construction of Sub-sections (D) and (E), but this direction was only given in 1898. In 1890, two years after the amending Act, in *Meyerstein's Application* ([1890] 7 R. P. C. 114), Mr. Justice Kay refused registration of the word "Satinine" for starch, as being descriptive of the effect produced, and no doubt the decision will bear defending; although it should be pointed out that in Sub-section (D) there is no qualification at all attached to "invented" words. This decision strengthened the hands of the Patent Office authorities in their reading of Sub-section (D), which was that it should be qualified by the words attached to Sub-section (E)—viz., that "invented" words should have no reference to the character and quality of the goods. By this mistaken practice all the troubles due to the old "fancy" words clause were revived. The Trade Marks Office proved itself ingenious beyond all computation in discovering hidden references to the character and quality of the goods, in words which to a plain business man were guiltless either of the one or of the other. The Courts showed no inclination to check a practice which was certainly annoying and was rapidly becoming harmful, for in the *Farbenfabriken Application* ([1894] 1 Ch. 645; 11 R. P. C. 84), where the applicants had applied to register the invented word "Somatose," which had been refused, the majority of the Court of Appeal sustained the Comptroller in his refusal.

House of Lords on bygone decisions re fancy words.

"*Satinine*" Case.

Erroneous reading of Sub-section (D) by Patent Office.

"*Somatose*" Case.

"Somatose" was intended to be applied to a new meat extract, but because of its alleged derivation from the Greek "*Soma, Somatos*, the body," it was thought to be descriptive, "in that it had reference to the applicability of the goods to the human body" (*per* North, J.). For this reason it was held by the Lower Court and also by the Court of Appeal not to be a proper example of an invented word. This decision, which was given in 1894, is now admittedly mistaken, but of course it rendered the registration of invented words even more difficult than before.

Increasing difficulties in registering invented words.

"*Solio*" Case. Reversal of the former practice.

At this juncture the Eastman Photographic Company came to the rescue of harassed word inventors. This company had applied to register the invented word "Solio" as a trade mark for photographic paper (*re Eastman Photographic Co.'s Application* [1898], 15 R. P. C. 476). Anyone might have predicted that in the then existing state of mind of the Patent Office such an application was doomed to failure. Photographic paper is acted on by the sun. The sun is "Sol." The suffix "io" may mean nothing, or it may be part of the word "iodine." Clearly the word "Solio" was audaciously descriptive of the character of the goods. Result: prompt rejection. The Court of First Instance and also the Court of Appeal sustained the Comptroller in his refusal to register, but the House of Lords took a different view, and ordered registration. In their judgment the House held that an invented word may be registered although it has reference to the character and quality of the goods; and that the Sub-sections (*d*) and (*e*) of Section 64 (Section 10 of 1888) are distinct and alternative. The "Somatose" Case was disapproved. Lord Herschell said that the decisions before the Act of 1888 afford no assistance in the construction of Sub-sections (*d*) and (*e*) of Section 10 of the Act of 1888; and Lord Macnaghten added that it was no objection to an invented word that it could be traced to a foreign source or that it should contain a covert allusion to the character or quality of the goods. The word need not be wholly meaningless. In short, almost all the long-cherished opinions and traditions of the Comptroller and the inferior Courts on this description of trade mark were put to rout right and left.

House of Lords hold that invented word may refer to character and quality. "*Somatose*" Case disapproved.

Invented word may be traceable to a foreign root and need not be meaningless.

This decision, which was given in 1898, has had its crop of consequences, and several invented words have been both registered and upheld in Court which would infallibly have come to grief under the earlier practice. Thus "Savonol" has been upheld as an invented word trade mark for soap (*Field v. Nagel* [1900], 17 R. P. C. 266). "Tachytype" for type-composing machines (*re Linotype Co.'s Application* [1900], 17 R. P. C. 380). In the latter case it was held not to be necessary that the word should have been invented by the applicant himself or that there should have been no prior publication.

"*Savonol*" for soap.

"*Tachytype*" for type machines.

But although the "Solio" and other decisions based thereon seriously affect a number of authorities on this class of word trade mark, they do not alter the accepted conclusions that (as Lord Shand pointed out in the "Solio" Case) the mere addition of a diminutive or short syllable to a word in ordinary and common use does not make it an invented word. Thus "Soapine" would not, in the writer's opinion, be an invented word for soap, though "Savonol" has been held an invented word for that material. Neither is a word or expression known in the English language but run together or distorted in spelling so as to *look* unlike the original, while preserving its sound when spoken, an invented or registrable word under the sub-section. Thus, neither "Cheapandgood" nor "Phiteesi" is an invented word, nor are they registrable. In *re National Biscuit Co.'s Application* ([1901] 18 R. P. C. 170; [1901] 1 Ch. 550) the word "Uneeda" was refused registration as being merely an ordinary expression run together and misspelt. In *Ripley's Application* ([1898] 15 R. P. C. 151) "Pirle" for dyed and finished goods was considered to be the same as "Pearl," which, it was held, would have been descriptive; but note that this was decided before the "Solio" Case; "Electrozone" for electrically treated chemical substances was shown to be a word in ordinary use in America, and to be descriptive and not an invented word (*re British Electrozone Co.'s Application* [1896], 13 R. P. C. 447). Perhaps had the "Solio" Case been decided, Mr. Justice North might not have held, as he did in *Meaby v. Triticine Co.* ([1897] 15 R. P. C. 1), that

"*Uneeda*" Case.

"*Pirle*" Case.

"*Triticumina*" Case.

"Borril" Case.

the mark "Tritiemunina" was improperly registered as a fancy word in 1886, although that case, on its own merits, seems not easily reconcilable with the prior decision in the *Borril Trade Mark* (1886 13 R. P. C. 382), in which the word "Borril" was held to be a fancy word, properly registered as such. It might have been thought that "Borril" suggested concentrated beef to the ordinary mind much more than "Tritiemunina" suggested ground wheat. But in the "Borril" Case the date of registration (1886) and the importance of the business built up had great influence with the Court of Appeal in leading them to sustain the registration.

Selected words.

**Fifthly.**—(E) **A word or words having no reference to the character or quality of the goods, and not being a geographical name.**

We have seen that under the first and second Clauses (A) and (B) provision is made for the registration of personal and firm names and signatures in a distinctive, characteristic, and particular manner; that under the third clause (C) devices, brands, labels, and the like are registrable; and that under the fourth clause (D) "invented" words or expressions are provided for. The fifth clause (E), which we now consider, takes us out of the region of "invented" words, and provides for the registration as trade marks of arbitrarily chosen words or expressions existing in the English, foreign, or dead languages. But it must be noted that the choice of such existing words or expressions is limited. Any word or expression savouring of advertisement, recommendation, or description, or any attempt to register a mere surname apart from its distinctive dress—as provided for in Sub-sections (A) and (B)—is barred. Therefore an application to register "Premier Ebony" as a trade mark for ink would be certain of refusal as referring to quality and as being descriptive. The word "Nectar" has been refused as a trade mark for tea, as having reference to the character or quality of the goods (*re Harrison and Crossfield* [1900], 18 R. P. C. 34).

Must not refer to character or quality.

Names of fictitious or mythical personages

The meaning of the fifth heading—Sub-section (E)—was discussed in the Court of Appeal in *Hall & Co.'s Trade Mark* ([1898] 15 R. P. C. 118). The registered mark

may be registered.

in this case was the word "Trilby" in plain type, and it was contended that this being the name of an individual, although a fictitious one, it was, if registrable at all, only registrable under Clause (A) in a special and distinctive form. But the Court held otherwise, pointing out that Clause (A) was intended for personal or firms' trading names, and that the word "individual" did not apply to an imaginary or mythical personage such as "Hamlet," "Jupiter," and the like. Therefore "Trilby" was upheld as properly registered and as a valid trade mark.

Examples of selected words as trade marks.

"Monkey" for soap, "Lone Jack" for tobacco, "Charter Oak" for stoves, are examples of registrable trade marks under this heading, being neither descriptive, nor geographical. "Ivy" has been registered for soap, and no objection was taken to it in Court (*Goodwin v. Ivory Soap Co.* ([1900] 17 R. P. C. 689). "Red Cap," "Night Cap," and "White Cap" have also been accepted by the Comptroller for soap (*re Hedley's Marks* ([1900] 17 R. P. C. 719).

Geographical words excluded.

Geographical words are expressly excluded from the category of registrable word trade marks under this heading, and the rule is strictly adhered to. Geographical dictionaries and general gazetteers are ransacked by the Trade Mark authorities, with the result that many words which no one ever dreamt of as possessing a geographical signification have turned out to appear in such a list. For example, the word "Camel," which had been already registered in 1888 in connection with driving belts, was refused extension to another class by the Comptroller, after the Amending Act of 1888, because it was discovered a very small and unimportant parish in Somersetshire bore that name. On appeal this refusal was upheld by the Board of Trade. This excluding clause was intended to prevent in the future the registration of such marks as "Glenfield Starch," "Eton Cigarettes," "Melrose Hair Restorer," "Strathmore Whisky," "Reading Biscuits," "Rugby Portland Cement," and the like.

Reason for exclusion.

The reason is that another manufacturer starting business in the same locality might be embarrassed in describing the place of origin of his goods if the name of the place of origin had been registered as a trade mark by

a rival manufacturer. Hence a possible discouragement to trade, which it is no part of the public policy to countenance.

Presentday reading of geographical prohibition.

But under present practice it is unlikely that a word such as "Camel" would be refused registration because of any faint geographical significance it might be found to possess. The presentday reading of the geographical prohibition is to be found in the decision of the Court of Appeal in *Magnolia Metal Co.'s Trade Mark* (1897 14 R. P. C. 621). There it was contended that the word "Magnolia" was geographical because evidence showed that there were several places in the United States called "Magnolia." But, as was said by the Court of Appeal: "In our judgment the phrase 'geographical name' in Section 64, Sub-section (c), ought not in general to receive so wide an interpretation. . . . . A word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word 'Monkey' is not proved to be a geographical name by showing merely that a small, and by no means generally known, island has been called by that name. If, indeed, in its primary and obvious meaning the word has reference to a locality, as the word 'Melrose' in *Von Duzer's Case*, or the word 'Eboli' in *Sir Titus Salt's Case* (Mr. Justice Chitty declining to distinguish the derivative 'Eboline'), it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be) and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word 'Apollinaris,' given to the water from a spring known as the Apollinaris Spring. So if 'Magnolia' had been the name of the place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the articles manufactured in the place having the name."

The geographical *locus* must be of some importance.

The name must in no instance be the name of the place where the articles are manufactured.

Names of well-known springs.

The names of well-known mineral water springs such as "Apollinaris," "Hunyadi Janos," "Friedrichshall," are geographical names and not sustainable as properly registered trade marks (*re Apollinaris Co.'s Marks* [1891], 8 R. P. C. 137).

Substance of decisions.

The substance of the different rulings under present practice as bearing upon geographical significance in words under Sub-section (E) may be summarised thus:—If the Word Mark consists of or contains an undoubtedly geographical name, be it of county, town, village, or locality, such as London, Harrogate, Melrose, Bolton, or Cornholme, it cannot under any circumstances be a validly registrable trade mark. If it is, or affects to be, the place or locality where the article is made, such as "Eton Cigarettes," "Melrose Hair Restorer," "Cornholme Bobbins," the mark is also bad because of its geographical significance. If the Name Trade Mark indicates the name of the natural source from which the goods are obtained, such as "Apollinaris Water," the mark is bad, no matter how unimportant and obscure the place may be. But if the Name Mark selected is not the place of manufacture, but happens to be the name of an almost unknown and obscure place or locality such as Monkey Island, in the Caribbean Sea, or Magnolia, the designation of one or two inconsiderable places in America, or Camel, a small and unknown parish in Somersetshire (although this last illustration may be taken with caution), such coincidences will not bar registration nor invalidate the mark when registered.

The distinction between registered and Common Law trade marks must be kept in view.

It must be remembered that these rules refer to trade marks under the Statute, and have nothing to do with unregistered old and well-established trade marks, or rather trade names, such as "Reading Biscuits," which are upheld under the Common Law, and which will be dealt with separately in a succeeding chapter.

Additions to marks.

Sub-section 2 of Section 64 provides that in conjunction with one or more of the essential particulars mentioned in the section—*i.e.* under headings (A), (B), (C), (D), and (E)—there may be registered any letters, words, or figures (meaning numerals), or any combination of these; but the applicant must state the essential particulars of his

mark, and must disclaim any right to the exclusive use of the added matter. Sub-section 3 (1) provides that the applicant need not disclaim his own name or place of business; while (2) sets forth that any *special and distinctive* words, letters, figures, or combinations of these used as a trade mark before the 13th of August, 1875, may be registered as a trade mark under this part of the Statute.

Old word, letter, and figure marks.

These portions of Section 64 should be compared with Section 74, which provides (*a*) for the entry on the Register, and in combination with *old* marks, of any *distinctive* device, mark, heading, ticket, letter, word, &c., or combinations of these, although the latter may be common to the trade; and similarly (*b*) for the entry on the Register, and in combination with *new* marks, of any *distinctive* word or words, although the same may be common to the trade. But in either case, just as in Section 64, the applicant must state what are the essentials of his trade mark, and must disclaim the added distinctive devices or letters or words which he acknowledges as common to the trade, saving only his own trade name and address, which need not be disclaimed.

Combinations with old marks of devices common to the trade.

Same as to new marks.

Common matter to be disclaimed.

Thus, Section 64 deals with additions to the mark which are neither distinctive nor common to the trade, and which the applicant may or may not disclaim in the exercise of his discretion and at his peril; whereas Section 74 refers to distinctive additions of these separate classes to (*a*) old marks and (*b*) new marks, which additions the Comptroller is empowered to enter on the Register although they may be common to the trade, but which additions the applicants *must* disclaim. But notice that, under Section 74, the additions must be "distinctive" to be subject to the obligatory duty of disclaimer. Thus in *Smokeless Powder Co.'s Trade Mark* ([1892] 9 R. P. C. 109) the words "Smokeless Powder" were part of the mark. The applicants to expunge or vary contended that the words "Smokeless Powder" were distinctive and common to the trade, and should have been disclaimed. Chitty, J., held that, apart from the fact that the words formed part of the company's name, the words "Smokeless Powder"

Distinction between Sections 64 and 74.

To be subject to disclaimer the common matter added must be distinctive.

"*Smokeless Powder*" *Case.*

were not distinctive words but formed part of the label, and that no disclaimer was necessary, and that the motion should be refused. In *re Trade Mark of Clement & Co.* ([1899] 16 R. P. C. 611) the Court of Appeal held that the words "St. Raphael" written across the label were not an addition to the mark but part of it, and that no disclaimer was required. Another decision on the same point occurred in *re Pinder's Trade Mark* ([1900] 18 R. P. C. 37; W. N. [1901] 235). The mark consisted of the firm's signature with the added word "Silverpan," which was found common or open to the trade. The defendants were sued for "passing off" their goods as and for the plaintiffs' by the use of the word "Silverpan." The defendants moved to rectify the Register by expunging the mark, on the ground that the word "Silverpan" was distinctive within the meaning of Section 74 and should have been disclaimed. Kekewich, J., found that the word though open to the trade was not "distinctive" within the section and not subject to disclaimer. The Court of Appeal held that the word "Silverpan" was at the date of the registration intended to be "distinctive" within the Statute; that it should have been disclaimed on application, and that the mark must be expunged. "Silverpan" Case.

Although the registration of old marks—that is to say, marks *in use before the 13th of August, 1875* has already been shortly alluded to; and although the question has now largely lost its importance, a few additional remarks on the subject may prove of interest. Old marks.

At the date of the coming into force of the present Act many proprietors of existing and old marks found themselves in danger of being shut out from registration altogether. As far as "word," "letter," and "figure" trade marks are concerned, it is evident that the new statutory definitions of a trade mark narrowed the view which traders had been accustomed to take of the limits within which this class of trade marks might be adopted and maintained. Many words, letters, and figures, and combinations of these, not agreeing with the definitions for new marks, were in use before the passing of the Act, and had become so valuable to their owners that to shut Old marks not within the definitions of Act of 1883.

them out from registration would have meant the infliction of considerable hardship. A side door was, therefore, opened by Section 64, Subsection 3 (iii.), under which it is 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 the Act."

By means of this saving clause an old mark consisting of the particulars set forth, and which would probably be refused as a new mark, may be accepted for registration, provided it fulfils the conditions set forth.

Distinctiveness in old marks.

These are that the word or words or combination forming the mark must be "*special and distinctive*," and that the mark was in use before the 13th of August, 1875. As to the interpretation of the term "special and distinctive," the practice of the Patent Office and the effect of a number of decisions tend to show that old marks are not by any means so severely criticised in respect of their special and distinctive nature as are new marks. Many labels and marks which have been in use since before the 13th of August, 1875, and which carry on their faces scarcely any features which can be called special and distinctive, are nevertheless now accepted by the Comptroller, and have been sustained by the Courts.

User must have been within United Kingdom.

To be effectual the requisite prior user must undoubtedly have been as a *bonâ fide* trade mark applied directly to goods within the United Kingdom. The mark claimed must always have been used precisely in the form for which registration is sought. No material addition to or subtraction from the mark as used will be permitted. If the old mark has been altered in any way since the 13th of August, 1875, even although the alteration is but slight, the application to register is almost certain of refusal as an old mark. The amount of such prior user is not of much importance, provided that the use has actually taken place and in accordance with the required conditions.

Must be registered and used exactly in old form.

Registration of an old mark, where such registration implies the enjoyment of privilege in respect of prior use as an old mark, is confined absolutely to the goods

upon which the mark has been placed, and does not extend to registration as an old mark in respect of other goods to which its use has been extended after the 13th of August, 1875. For this extended use registration as a new mark is requisite. Foreign user is not taken into account, and where goods, whether of British or foreign origin, bearing a certain trade mark, have merely passed through this country on their way to another market, without being exposed here for sale, no privileges are acquired in respect of such prior user in the United Kingdom.

Mere transit of the goods not user.

Under the working of the Act of 1875 a common incident to the registration of old marks was that in many trades different applicants sought to register the same, or practically the same, mark for the same class of goods. Sometimes the applicants were wholly unaware of the existence of the other marks, and cases arose in which several applicants applied in perfectly good faith to register as their own a mark which it turned out had been used by others for an equal or greater length of time in other parts of the country. This was especially the case in devices of a common type, such as anchors, crowns, tridents, &c. Clearly, where ten different manufacturers made ten different applications for the registration of the same mark for the same class of goods, and to which all seemed to have an equal right, it would have been ridiculous to recognise all of the marks, while to have registered one or two only would have been unjust to the others.

Similarity of many old marks.

The Commissioners of Patents under the 1875 Act therefore formulated what was known as **The Three Mark Rule.** This was to the effect that an old mark that is to say, a mark used before the 13th of August, 1875 - might be registered by different persons in the same trade up to the number of three, and no more. This indulgence was, however, subject to the qualification that if the mark should prove to have been used before the 13th of August, 1875, by more than three persons, then it should be treated as a mark *common to the trade*, and not capable of registration by anyone; and if any person had obtained registration before the Comptroller became aware of the facts, his registration might be cancelled

Three Mark Rule.

If in use by more than three persons mark now held common to the trade.

*(re Hughes and Young's Trade Mark* [1893], 10 R. P. C. 369).

Three Mark Rule adopted in Act of 1883.

This Three Mark Rule is given effect to in Section 74, Subsection 3, of The Patents Act, 1883, which expressly provides that any device which was, before the 13th of August, 1875, publicly used by more than three persons for the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods. Even where a word which is capable of being held descriptive of an old and common device mark is attempted to be registered, registration may be refused. Thus in *Thwaites and Blakey's Application* ([1893] 10 R. P. C. 360) the word "Ancross" was refused registration because the Court held it to be a colourable imitation of "Anchor," the *device* of an anchor having been proved common to the trade in *Hughes and Young's Case (supra)*.

Common marks registrable in combination with other distinctive features.

This does not mean that such a common mark is altogether incapable of registration. A common mark consisting, for example, of a word, such as the word "Selected" in the steel pen trade, or "Parchment" in the paper trade; or a combination of words, such as "Bank of England" in the sealing wax trade; or a device, such as a "syphon and glass" in the mineral water trade, or an "anchor" in the umbrella trade; or a combination of words and a device, such as a "crown" with the words "Best Best" in the iron trade, is still registrable, and many such marks have been registered, but only when

But must be expressly disclaimed.

accompanied by certain additions, whether of words, letters, figures, or devices, which latter are claimed as the distinctive characteristics, all proprietorship in the common portion of the mark *per se*, being *expressly disclaimed*.

Comptroller's Rules as to common additions in old and in new marks.

Rule 18 of the "Instructions" issued by the Comptroller runs as follows:

**18.** In the case of a trade mark used before the 13th August, 1875, common or open marks of any kind may be registered in connection with it; but in the case of a trade mark not so used (*i.e.* a new mark) common or open marks consisting of a word or combination of words only can be registered as a part of the mark.

In each case the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the foot of the application form, such note to be signed by the applicant or his agent.

An owner of such a combination mark is bound to use the combination as registered, and in no other form.

Disclaimer must be made at time of application.

Disclaimers, whether in new marks or in old, must be made with the application. As was said by Mr. Justice Byrne in *Wright and Crossley's Application* (1900) 17 R. P. C. p. 389), "I cannot find any ground for distinguishing in reference to disclaimer between new marks and old marks which have to be registered under Section 64, Sub-sections 1 and 2, and to which Section 74 does not apply. It has been decided that the provision that the statement and the disclaimer shall be contained in the application is not merely directory, and that it cannot be waived by the Court on an appeal from the Comptroller" (see *Goodall's Trade Mark* (1887), L. R. 42 Ch. D. 566; and *Meens' Application* (1891), L. R. 1 Ch. D. 41, 8 R. P. C. 25).

Amendment on application not entertained by the Court.

An amendment proposed by the applicant to the Court to meet an objection raised for the first time by the Comptroller, cannot be accepted by the Court (*re Player & Son's Application* (1900), 18 R. P. C. 65). The same case decides that a superfluous application not involving any material change in the mark, and made merely to meet the exacting requirements of a foreign law for a certificate of home registration, will not be accepted.

Unnecessary applications.

By Section 1 of the Act of 1875 if the owner of a trade mark, whether old or new, failed to obtain registration, he was left powerless, so far as the Statute was concerned, to restrain infringement or claim damages. But quickly recognising that there might be cases in which the owner of an old mark had an equitable claim to protection, although his mark might have been held incapable of registration, the Legislature cured this defect in the amending Act of 1876. The effect of the alteration was that if the proprietor of a trade mark in use before the passing of the principal Act had applied for and had been refused registration, he might, nevertheless, institute proceedings, either for the prevention of wrongful use or damages for the infringement of such trade mark. Therefore, when an owner of an old mark had applied for registration and had been refused, his possession of the Comptroller's

Certificate of refusal to register.

certificate of refusal placed him in a position to sue for infringement of his trade mark in addition to and independently of his Common Law rights.

Section 77. Section 77 of The Patents Act, 1883, preserves this arrangement, and is as follows:—

**77.** A person shall not be entitled to institute proceedings to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the 13th of August, 1875, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Registration is *prima facie* evidence of right to mark: after five years conclusive.

The registration of a person as proprietor of a trade mark is *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiry of five years from the date of registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of the Act (Patents Act, 1883, Section 76). The lapse of five years from registration is, however, no bar to proceedings brought for the purpose of rectifying the Register.

But wrongful registration may be expunged.

Therefore, if the registration of a mark is and has been wrongful from the first from any cause, it is liable to be expunged from the Register, even after the lapse of five years (*Edwards v. Dennis* [1885], 30 Ch. D. 454; *Hughes and Young's Trade Mark* [1893], 10 R. P. C. 369).

Sheffield marks.

The registration of trade marks for cutlery and goods within the terms of the Cutlers' Company's Acts is governed by special rules (see next chapter).

Particulars debarred from registration.

In addition to pictorial representations of the goods, it may be noted that the following particulars are also restricted from registration either as trade marks or as parts of trade marks: viz.:—

(*a*) Names of persons in the possessive case in combination with the names of goods.

(*b*) The Royal Arms, or Arms so nearly resembling them as to be calculated to deceive.

(*c*) Representations of the reigning Sovereign or any member of the Royal Family.

(*d*) Representations of the Crown or the National Arms or Flags of Great Britain.

(*e*) Such words as "Imperial," "Royal," and the like, either alone or as essential parts of a trade mark.

Aliens may register trade marks in United Kingdom, international Convention.

It has been said that the subjects and citizens of Foreign States are upon equal terms with British subjects in obtaining the registration of their trade marks in this country. Section 103 of the Act of 1883 further enacts that where a subject of a Foreign State which has become a party to the International Convention for the Protection of Industrial Property (see Appendix A) has made an application for the registration of a trade mark in his own country, he shall be entitled to the registration of his trade mark in this country in priority to other applicants (that is to say, applicants coming after the date of his foreign registration), provided he files his application in this country *within four months* of registration abroad.

Foreign marks not conforming to British requirements.

It has been contended that this section, if read literally and taken in conjunction with Article VI. of the International Convention and Paragraph 4 of the Final Protocol thereof, would point to the possibility of the Comptroller being required by a foreign applicant to register a mark under these provisions which could not be accepted by him if proffered as a new mark by a British subject. Many foreign countries will register almost any description of mark which may be presented, and which would, as an original British mark, be certain of refusal here. In practice, however, the Comptroller always refused such foreign applications as did not comply with British requirements, and apparently the Courts were prepared to sustain him in such refusals.

*Carter Medicine Co.'s Mark.*

In *Carter Medicine Co.'s Trade Mark* (1892, 9 R.P.C. 401), North, J., makes it clear that, in his opinion at least, foreign trade marks, even when registered abroad, should, to ensure registration here, conform to the requirements

of the British Acts of 1883 to 1901. The same opinion was held in *California Fig Syrup Co.'s Mark* (1888) 6 R. P. C. 126).

British declaration attached to amended Convention of 1900.

Nevertheless, to do away with any doubts on the question, the British Delegates, in acceding to the amendments made in the Convention at Brussels on the 14th December, 1900, put on record a declaration to the effect that the British Government consented to the maintenance of Article VI. of the Convention and Paragraph 4 of the Protocol in their present form only on condition that all of the contracting States should be at liberty to keep their existing law on the subject. Thus the matter is set at rest, and applications under the Convention to register marks in this country by foreign traders who have already registered abroad must conform in all respects to the requirements of Section 64.

In such States as have given their adhesion to the Convention British subjects have, of course, corresponding advantages.

Having thus passed in review the various definitions of trade marks and the qualifications and circumstances which govern registration, this chapter may be fitly closed by a few words of practical advice upon the choice of a trade mark.

Practical advice on the choice and designing of trade marks.

Glancing at the list of essentials as set forth in Section 10 of the Act of 1888 (repealing Section 64 of the Act of 1883), which must be carefully kept in view when deciding upon a trade mark, it is evident that the two most important divisions are—

1. A distinctive device.

2. An invented word; or a word arbitrarily chosen, but not referring to the goods and not having a geographical significance.

An inspection of the applications advertised in the official *Trade Marks Journal* makes it apparent that in the great majority of cases manufacturers prefer to adopt a distinctive device or picture as their trade mark.

Next in order of popularity appear to be invented and arbitrarily-chosen words.

Use of trade mark before registration.

It is a common indiscretion among manufacturers to design or choose a trade mark, apply it at once to the goods, and seek no protection from registration until the mark has, from its popularity, become a valuable trade property. It then occurs to the user—possibly only after attempts at infringement by others—that it would be advisable to register the mark, and application is made for that purpose. In many cases the response of the Comptroller is to the effect that the mark is not of a registrable nature, or is so similar to another registered mark that acceptance is impossible. Thus the applicant finds himself in this unsatisfactory position, that he must either choose a new mark and regard the time and money spent in advertising and popularising his first mark as thrown away; or he may elect to continue trading under the refused mark, with the consciousness that if it should be infringed or fraudulently imitated by a rival he has only the Common Law remedy to depend upon, and can claim none of the advantages which the possession of a certificate of registration would have conferred upon him.

Therefore, in designing and deciding upon a device or word as a trade mark, it is desirable that an intending user should first of all make himself certain as to its novelty and acceptability.

The Register of Marks is very jealously guarded against the inclusion of fresh marks which may seem in the smallest degree to interfere with marks already registered. Even where the Comptroller is himself of opinion that the mark applied for is admissible, he will frequently ask the applicant to obtain consent to registration from the registered owner of an existing mark, which may in his estimation present some resemblance, however faint, to the proposed mark, and such permission is not easily obtained.

Consent of prior registered owner.

The proper plan is, therefore, to make an application at once and without loss of time for the registration of the intended mark. Two or three weeks will enable the Comptroller to decide whether or not it is a mark which he can accept. If refused, another mark could then be substituted, and if this is accepted the trader may then

proceed to apply it to his goods with some assurance that he is safe in doing so.

*Device marks should be bold and striking.*

In preparing a "device" trade mark the design should be broad and simple, so as to be easily remembered when once seen. It should be striking, characteristic, and "distinctive" both in itself and as compared with other marks. Distinctive design must be apparent, and it may safely be said that simple geometric figures and the like, either alone or in combination, stand but little chance of acceptance. Carefully worked little pictures are not easily recognisable at a distance or at a glance, and a device which is successful as a specimen of the fine arts is not usually the best type of trade mark. As a rule, a device which sticks in the memory has something of the grotesque in it.

*No representation of the goods allowed.*

No attempt should be made to introduce representations of the article to which the mark is to be applied. This would infallibly lead to refusal. Existing trade marks in which such representations occur have either been registered as old marks in existence before the 13th of August, 1875, or they have been applied for and registered before the present rule against such representations took effect.

It has, however, been held in the Court of Appeal that where the shape in which the product is sold is not a necessary but an arbitrarily-given shape—as, for example, blacklead in the form of a dome, where the lead was also sold in squares and other shapes—a representation of such arbitrarily-chosen shape may be registered as a trade mark (see *In re James's Trade Mark*, 1886, 33 Ch. D. 392; 3 R. P. C. 340).

*"Dome Blacklead" Case.*

*Invented and selected words.*

When inventing, and especially when selecting, a word as a trade mark no attempt should be made to refer either directly or inferentially to the goods themselves, or to their character, qualities, or effect. "Thermos," for example, has been refused as a trade mark for woollen underclothing as being suggestive of warmth. In selected words "Aquarius" has been refused as a trade mark for waterproofs; and many similar examples to the same effect might be given. All words having a geographical significance should also be avoided, as well as any words having too close a similarity to known surnames.

The remaining forms a trade mark may assume are: Name marks.

3. The name of an individual or firm, printed or reproduced in some particular and distinctive manner; and

4. The copy of a signature.

It is clear that neither of these types is so useful nor so exclusive as a "device" or "word" trade mark would be. As to the name, it is only the distinctive manner of printing or reproducing it, or, in other words, the device formed from the name, that constitutes the protected mark. The name itself cannot be confined to one individual. Another of the same name might commence manufacturing the same goods, and would have an equal right to register his distinctively printed name, or his signature, so long as neither imitated the distinctive features of that already registered.

To summarise the directions contained in the Official Instructions, together with the prohibitive parts of the Statute, the chief points to be avoided in designing or choosing a trade mark are as follows: Summary of prohibitive rules as to trade marks.

1. *A "Device" Trade Mark* should not include any pictorial representation of the goods, nor of the Royal Arms, nor representations of the reigning Sovereign, nor of any member of the Royal Family, nor of the Royal Crown, nor of the Flag or National Arms of Great Britain.

2. *In a "Word" Trade Mark* the word or words, if "invented," may (see Lord Herschell in the "*Solio*" *Case*) refer to the character and quality of the goods, but, if selected, should not refer to the character, quality, or effect of the goods. Neither must the word or words constitute a geographical name nor a surname.

3. *In a "Name" Trade Mark* the name must be printed or impressed in a distinctive manner, or must be a signature. It must not be used in the possessive case in conjunction with the names of goods. Thus, "Hunter's Bath Bricks" is unregistrable, even when printed.

stamped, or written in some particular and distinctive manner (see official order in *Trade Marks Journal* No. 370, 27th February, 1889).

4. *Generally.* Even where the goods are patented specialities, it is advisable not to include the words "Patent" or "By Royal Letters Patent" in the registered mark unless accompanied by the number and date of the patent.

Not advisable to include the word "*Patent*" in trade mark.

The reason is this: Should the patent from any cause cease to exist, the trade mark then contains a statement which is not true and is deceptive, and tends to prolong the patent monopoly (*Morgan* v. *Meldam* 1886, 36 L. J. Ch. 225: *Ransome* v. *Graham* 1882, 51 L. J. Ch. 397): and in any proceedings by the owner this would be a most effectual weapon in the hand of a defendant (*Thomas* v. *Walker* 1877, 5 Ch. D. 580. On the other hand, should the owner on the expiry of the patent cease to use the word "Patent" in his mark without altering the Register, he might be challenged for using his mark in a form different from that registered. In the case of an old mark used since 1856 the employment of the word "Patent," where no patent ever existed for the goods, was held by Rigby, L. J., to be a misrepresentation which debarred the plaintiffs from relief (*Hubbuck* v. *Brown* [1900], 17 R. P. C. 635), and this though the word "Patent" had been disclaimed.

Such words or phrases as "Registered," "Entered at Stationers' Hall," "To counterfeit this is forgery," &c., must be struck out of all representations of trade marks sent up with applications to register.

# CHAPTER III.

## PROCEDURE IN REGISTERING A TRADE MARK.

Procedure in registration.

THE mere procedure in registering a trade mark is so simple that a short account will suffice to make it plain.

Persons qualified to register.

Any individual, firm, company, or corporation capable of acquiring and holding property may register a trade mark. Foreigners have equal rights with British subjects, provided the mark is actually used on goods sold in this country.

Forms.

The requisite forms for making application to register trade marks are on sale at all the chief post-offices in the United Kingdom. Form "F," which bears a stamp of five shillings, is the form of application for registration.

One of the representations of the mark should be mounted on this form, and the particulars inserted in accordance with the marginal notes which are printed on the sheet.

Goods.

All goods in respect of which trade marks may be registered are divided into fifty classes, and the applicant must state the class under which he desires to claim the mark, and also particularise the goods to which the mark is to be applied. This classification will be found in the Trade Mark Rules in Appendix I.

Classification of goods.

It is important to note here that an applicant should not claim the mark for goods in which he does not deal or intend to deal. By a recent regulation the Comptroller draws attention to the practice of applying for marks in Class 50 for miscellaneous goods, which, he says, "it is difficult to suppose would be generally dealt with by the same firm." He goes on to say that care should be taken not to include goods for which the mark is not intended, and that evidence may be asked to show that the goods specified are actually made or dealt in by the applicant. This restraint, which is really applicable to all classes, is directly in the interests of applicants, seeing that registration in respect of goods not traded in may afterwards be

Marks registered for miscellaneous goods.

Registering marks for goods not traded in.

made the subject of a motion by some aggrieved person to rectify the Register by expunging or limiting the mark, and this notwithstanding that the mark has been five years on the Register. A case bearing directly upon this point is that of *Edwards v. Dennis* (1885) 30 Ch. D. 454); and more recently in the House of Lords, in *Bull v. Bunnett* (1899) 16 R. P. C. 411), the right of aggrieved persons to expunge marks improperly registered for goods in which no trade has been done, was not even questioned. Practically, there is no difficulty in getting the Court to expunge a trade mark registered in this improper manner.

*Edwards v. Dennis.*

Application form.

The application form "F" is signed by the applicant or by his agent duly authorised. If the application is made by a firm the form may be signed in the firm's name by a partner; if made by a company the secretary or other officer, or a director, may sign his own name, adding his proper designation and also the words "For the Company."

Representations of marks.

Two additional representations of the mark must accompany the application form "F," mounted on sheets "G" of equal size with the form "F," and bearing the name and address of the applicant or his agent. In Classes 23 to 35 inclusive (Textile Goods and Materials), four additional representations of the mark must be supplied.

Where the representations of the mark are too large to mount on forms "F" and "G," they may be mounted on linen, and folded and fixed to the forms. The papers, when completed, may be delivered or posted to "The Comptroller, Patent Office (Trade Marks Branch), 25 Southampton Buildings, London."

Acceptance or refusal of mark by Comptroller.

In the course of two or three weeks the applicant will be advised either of the acceptance of his mark or that it has been objected to or refused by the Comptroller. When refusal takes place it is based either on resemblance of the mark to existing marks on the Register, to which the applicant will be referred, or on the ground of non-conformance with the requirements set forth in the last chapter.

Objection of Comptroller.

Sometimes the objection of the Comptroller to register a mark on account of its resemblance to an existing mark

may be got over by obtaining the consent of the owner of the prior mark. When so objected to, and the resemblance seems remote, it is advisable to sound the owner of the prior mark with the view of obtaining his consent to registration, even where this is not suggested by the Comptroller. If the prior owner gives his consent, the Comptroller will in many cases withdraw his objection.

Procedure on acceptance.

When the mark is accepted by the Comptroller the notice of acceptance calls upon the applicant to furnish a wood block or electrotype for the purpose of illustrating the advertisement of the mark in the official *Trade Marks Journal*. Such a block or electrotype should correspond exactly with the representations accompanying the application, and should not be more than two inches square. If larger an additional charge of two shillings for each additional inch or part of an inch will be made. The largest space available is eight inches by six inches.

Block of mark.

Nothing but the actual mark as applied for should appear on the face of the block or electrotype. The number of the application should be written or printed on the side of the block or foundation of the electrotype.

*Trade Marks Journal.*

The *Trade Marks Journal* (price sixpence) is published weekly, and contains a print of each mark advertised, with particulars of the class and applicant's name and address. When the mark is not illustrated, as for example in the Cotton Classes, the advertisement refers to a place or places where a representation of the mark can be seen.

Issue of certificate of registration.

If no opposition to registration is offered within one month from the date of advertisement in the *Journal*, the applicant is called upon to pay the final fee (£1), and the certificate of registration is at once issued. This is the short history of a trade mark application, where nothing is done, either by the Comptroller or by outsiders, to trouble or arrest its progress. But any applicant should be prepared for such a possibility.

Comptroller's action on objecting to application.

The Comptroller's objection to register a mark submitted to him, whether based on the ground of nonconformity to the Rules, or because of resemblance to an existing mark, is frequently accompanied by an invitation to the applicant to appear before him personally or by

representative, and state his case in support of the application. If the applicant does not accept this invitation, or if he fails at the hearing to convince the Comptroller that his mark should be accepted, the mark is absolutely refused. If dissatisfied with the decision of the Comptroller the applicant may appeal to the Board of Trade, and the Board may either decide the matter or, as is their usual course, refer the appeal to the Court.

Appeal to Board of Trade.

Opposition by interested or aggrieved person.

If, on the other hand, the mark should be opposed by a rival trader or by any other aggrieved person who thinks his interests would be imperilled by the registration of the mark, the notice of opposition should be given within one month from the date of the *Journal* containing the advertisement. The time for opposition might, however, be extended by the Comptroller, on good cause being shown, for a period of not more than three months.

Notice of opposition.

The notice of opposition must state the ground or grounds on which the opponent intends to oppose the registration, and be signed by himself or by his solicitor or agent, and must contain an address for service in the United Kingdom. Form "J." given in the Rules, is to be adopted, with such variations as are called for by the circumstances. This form bears a £1 stamp.

Form.

Opposition on prior mark.

When the opponent bases his opposition upon the existence on the Register of a trade mark similar to the mark opposed, the notice must state the date of registration and the number on the Register of such alleged anticipatory trade mark.

Statement by applicant in support of application.

Within one month after receipt of this notice of opposition, or within 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 to support his application. If he fails to send this counter-statement, he is considered to have abandoned his application.

Declaration by opponent.

The next step is taken by the opponent, who must leave a declaration or declarations containing the evidence upon which he relies to support his opposition. Such declaration must be filed within two months after the expiry of one month (or such further time, not exceeding

three months, as the Comptroller may allow) from the date of the advertisement of the mark. The opponent must at the same time deliver a copy of the declaration to the applicant.

Applicant's declaration in reply.

Within one month from the delivery of the said copy the applicant should leave his declaration or declarations in support of his application and in reply to the opponent's declarations, and should supply the opponent with a copy thereof. Within seven days from the receipt of such copy the opponent may leave further declarations, which should be confined strictly to matters in reply to the statements in the opponent's declarations.

Completion of evidence.

This completes the evidence, and no further declarations can be filed by either party, except with the consent of the other or by special leave of the Comptroller. On completion of the evidence the Comptroller, upon the application of either party, and on the payment of the prescribed fee (£1), appoints a time for hearing the case, and gives at least seven days' notice of the appointment to the applicant and opponent.

Hearing before Comptroller.

At the hearing, the parties or their representatives attend and state their case fully: the declarations form the groundwork of all that is said, and no opposition is allowed which has not been set forth in, or does not directly spring from, the declarations filed. The decision of the Comptroller is usually signified to the parties in writing, within from one to two weeks from the hearing.

Appeal to Board of Trade.

Should either of the parties be dissatisfied with the decision he may appeal to the Board of Trade. Notice of the intention to appeal should be left at the Patent Office within one month from the date of the Comptroller's decision. The notice of appeal must be accompanied by a written statement of the grounds of appeal and of the appellant's case in support. In addition to serving the Patent Office with these papers a copy of the notice of appeal and of the appellant's case in support must be sent to the Secretary of the Board of Trade, Whitehall Gardens, London, and also to the other party in the matter.

The Board of Trade then decide whether they will hear the appeal or refer the matter to the Court. If they decide to hear the appeal, seven days' notice of the hearing

is given to the appellant and to the Comptroller and to the respondent. The evidence used at the hearing before the Board of Trade is the same as that used before the Comptroller.

Appeal usually referred to Court.

As a matter of fact, the Board of Trade has of late made it an almost invariable practice to refer the appeal to Court, and this proceeding has much to recommend it, especially where there are equitable reasons why registration should be granted, although a rigid reading of the Act and the Rules would seem to bar registration. The Comptroller and the Board of Trade, however they may wish to help the applicant, generally find themselves, in the absence of any specific ruling on the point, bound to adhere to the strict letter of the Act and Rules, whereas the Court may exercise such discretion as will prevent hardship.

"The Court."

Practically, the Chancery Division of the High Court of Justice is meant by "the Court," and in the case of applications at the Manchester Office "the Court" means also the Lancaster Palatine Chancery Court (Section 26 of the Act of 1888).

Grounds of opposition.

Opposition is often encountered from the owner of another similar registered mark, but this is not always the case. The opponent might enter opposition upon other grounds.

Abandonment of application.

If an applicant abandons his application immediately upon being notified of opposition, he may be called upon to pay to the opponent such costs of the opposition as the Comptroller may think reasonable. But this is the only stage in the proceedings at which the Comptroller has power to award costs. If the matter proceeds to a hearing no costs are allowed to either party.

Costs.

Even if the case is ultimately heard by the Court, and the opponent is successful, no costs are allowed to him in respect of the proceedings below – *i.e.* before the Comptroller and the Board of Trade.

### *Sheffield Marks.*

Sheffield metal goods marks.

The registration of trade marks in respect of goods within the Cutlers' Company's Statutes is regulated by special Rules. The privileges of the Cutlers' Company are recognised and the regulations mainly expressed in Section 81 of the Acts of 1883 to 1901.

Sheffield Register.

The Cutlers' Company was authorised to establish at Sheffield a new Register of Trade Marks, to be called "the Sheffield Register," and to this Register were transferred all trade marks for cutlery and kindred goods which had been registered or entered before the 1st of January, 1880, by persons carrying on business in Hallamshire, or within six miles thereof. The Company is also empowered to enter in the Sheffield Register all trade marks which have been assigned by the Cutlers' Company, and actually used before the 1st of January, 1884, but which have not been entered in either of the other Registers.

Metal goods trade marks in Hallamshire.

Applications for registration of trade marks for metal goods, if made by persons carrying on business in Hallamshire or within six miles thereof, are to be sent direct to the Cutlers' Company. If made by a person outside this area the application is to be sent to the Comptroller, who communicates with the Cutlers' Company. When an application is made direct to the Company they notify the Comptroller of the fact; and if the Comptroller has no objection to make, the application is proceeded with by the Company. As a matter of fact, the Comptroller acts in unison with the Company; and if both are of opinion that the mark may proceed, registration can be effected, and not otherwise.

Aggrieved applicants.

Any person considering himself aggrieved by refusal of his application by the Company may appeal to the Court.

Definition of metal goods.

The expression "metal goods" used in the Act is not confined to cutlery, but is explained to mean "all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal."

Duration of registration.

When a trade mark has been registered, the period of protection lasts for fourteen years. At the end of that time the registration may be kept in force for another fourteen years upon payment of a renewal fee of £1, and so on from time to time at the expiry of each successive period of fourteen years, so that the registration of a trade mark may be kept in force for an indefinite time. If this renewal fee is not paid, the Comptroller may remove the mark from the Register within three months from the termination of the fourteen years. If the renewal fee is paid before the termination of the three months

Renewal.

Restoration of mark to Register.

an additional fine of 10s. is imposed. But even if the three months should pass without payment, and the mark has actually been expunged from the Register, the Comptroller will restore the mark if a sufficient explanation is forthcoming, and upon payment of an additional fine of £1.

Abandonment of mark by disuse &c.

The right to a registered trade mark might also be lost to the proprietor by abandonment, which might mean either total abandonment by prolonged disuse on his own part or abandonment of his exclusive right by acquiescence in the use of the mark by others, to such an extent as to create common and concurrent right in others. To constitute abandonment the intention to abandon must, however, be shown (*per* Chitty, J., in *Monson v. Bacha* [1884], 26 Ch. D. 398). Mere non-user of a trade mark for a length of time does not *per se* show abandonment. The period of time during which a trade mark has been disused would, of course, be an element of importance. It has been said (*in re Crossmith* [1889], 60 L. T. N. S. 612) that non-user for eleven years, during which the sale of the goods had ceased, and all labels had been destroyed, amounted to abandonment. In *re Ralph's Trade Mark* ([1883] 25 Ch. D. 194) suspension of business for twenty-one months was held to constitute abandonment. It cannot be said with certainty that the Court would look upon mere disuse of a trade mark, for four or five years for example, as abandonment unless intention to abandon was clearly present.

The intention to abandon must be apparent.

Penalty for representing mark as "registered."

Under Section 105 of the Act any person who represents a trade mark applied to any article sold by him as "registered," which is not so, shall be liable for every offence, on summary conviction, to a fine not exceeding £5. Even though application to register a mark has been made it is an offence to call the mark "registered" before it actually is so. Though registered abroad it is an offence to call a mark "registered" in this country when actually no registration has been effected here (*MacSymon v. Shuttleworth* [1897], 15 R. P. C. 748). But the use of the words "Trade Mark" alone is not a representation that it is registered (*Sen-Sen Co. v. Britten* [1899], 16 R. P. C. 137).

# CHAPTER IV.

## RECTIFICATION OF REGISTER BY THE REMOVAL OR LIMITATION OF REGISTERED MARKS.

Registration equivalent to proof of public use.

BY Section 75 of the Act (being Section 17 of the Amending Act of 1888) it is provided that application for registration of a trade mark shall be deemed to be equivalent to public use of the mark, and the date of the application shall be deemed to be the date of the registration. Thus, in instituting proceedings for infringement, the registered proprietor of a trade mark is no longer called upon, as he formerly was, to prove lawful or prescriptive user before he can obtain relief in a Court of Law or Equity for the infringement of his mark. Registration of the mark is now notice to the world, and is equivalent to "lawful user" at Common Law. It must not, however, be inferred that the owner of a mark which has merely been registered, but not put to use at all, could obtain an injunction against someone afterwards using the mark. The essence of Trade Mark Law is entirely against the assumption that anyone should be permitted to harass his neighbours by registering and shelving a mark, only asserting his proprietorship when another, wittingly or unwittingly, uses the mark for trade purposes (*cf. Rolph* [1883], 25 Ch. D. 194).

But the mark must actually have been used.

Prior or common use by others.

The mere element of novelty or even of originality in a trade mark is not an essential to valid registration, as in the case of a patented invention or registered design. In other words, merely to prove that the mark had been used in priority by another trader on the same class of goods and before registration is no reason for removing it from the Register (*Monson v. Bacham* [1884], 26 Ch. D. 398; *Barlow v. Johnson* [1890], 7 R. P. C. 395). The prior or concurrent user might get his mark registered, in spite of

the previous registration, on showing the circumstances, but he cannot oust the first registered proprietor from the Register merely on the score of his prior or concurrent user unless in the case of fraud or *mala fides*, or by showing himself to be a "person aggrieved" under Section 90. According to American decisions it seems to be a rule there that a mark to be validly registrable should in the first place have been the mark of the applicant, and no other. But the same rule cannot be said to hold good here, although Fry, L. J., in *re Hudson's Mark* (1886) 3 R. P. C. 155), speaking of the Act of 1875 (which in this respect cannot be differentiated from the Act of 1883), remarked that he had come to the conclusion that "the true meaning of the Act was to enable a person who had invented a trade mark which had not previously been used by some other person to obtain registration of that trade mark &c." (see p. 163 of Report). Certainly if it can be shown that the mark was used on the same class of goods prior to registration and concurrently by more than two persons in addition to the registered owner, the mark will be liable to removal from the Register as being common to the trade. This is established practice in old marks (*Wragg's Trade Mark* (1885), 29 Ch. D. 551; *Hughes and Young's Trade Mark* (1893), 10 R. P. C. 360) under the "Three Mark Rule" (see p. 211), and, it is submitted, would hold good in the case of marks not old (*Great Tower Street Tea Co. v. Smith* (1889), 6 R. P. C. 165).

As to mere prior publication of a word which has been registered as a trade mark see Mr. Justice Cozens-Hardy's remarks in *Lindoype Company's Application* (No. 2) (1900), 17 R. P. C. 380).

Five years' registration is conclusive of right of owner.

When a person has been placed upon the Register as proprietor of a trade mark this is *prima facie* evidence of his right to the exclusive use of the mark, and after the expiry of five years from the date of registration it is *conclusive* evidence of his right (Section 76). This, however, is upon the assumption that the registration was in the first place good (*Baker v. Bowson* (1890), 8 R. P. C. 89). If not, it is clear that the title can be challenged, even after the expiry of five years. As Jessel, M. R.,

But registration must

remarked in *re Palmer* ([1883] 24 Ch. D. 504), referring to the corresponding Section in the Act of 1875: "The Act only says that after five years the person who has registered a trade mark shall be entitled to the trade mark, but does not say that the mark, as registered, shall be deemed to be a trade mark." As a matter of fact, many trade marks have been expunged from the Register after having been registered for a much longer period than five years. have been *ab initio* good.

There are three sections in the Act which provide for rectification of the Register. Section 90 relates to cases wherein any person aggrieved by wrongful or incorrect registration of a mark by another may get the Court to expunge or correct the entry. Section 91 provides for the correction by the Comptroller at the instance of the registered proprietor, of clerical errors, or for the cancelling of the entry, the assistance of the Court not being required. Section 92 provides for the correction by leave of the Court of any entry by way of addition or alteration of any non-essential particular. Rectification of Register, Sections 90, 91, 92.

Section 90 is as follows:—

**90.** (1) The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person or of any other particulars from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry as the Court thinks fit; or the Court may refuse the application, and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit. Expunging or varying registered mark.

(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. Trial of issue.

(3) Any order of the Court rectifying a Register shall direct that due notice of the rectification be given to the Comptroller. Notice of order to Comptroller.

The important point to note first is that the applicant under Sub-section 1 must be a "person aggrieved." When the complaint is that the mark ought not to be on the Register at all—that, in short, it cannot properly be Persons aggrieved.

anyone's mark them, as was said in *Rose v. Evans* (1879) 48 L. J. Ch. 615), "any person interested in the same trade is a person aggrieved." But that definition is perhaps a little too wide, for the grievance must not be a mere grievance in gross, and, as was pointed out by Rigby, L. J., in *re Wright, Crossley & Co.* (1898, 15 R. P. C. 377), a similar observation of Lord Herschell in *re Powell* (1894, App. Ca. 8) is not to be taken as justifying the conclusion that the mere fact of a man being in the same trade makes him a person aggrieved within the section. Fry, L. J., in *re Hicks* (1884, 26 Ch. D. 651), said that "*any person aggrieved*" *means any person* "who will in all reasonable probability suffer any injury or loss using these words in a legal and not in a sentimental sense from the persons claiming to use it." The same learned Lord Justice, in *Hallinan's Co.'s Case* (1891, 2 Ch. 151), said that "whenever one trader by means of his wrongly registered trade mark narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, *this rival is an aggrieved person.*"

The grievance must not be merely in gross.

Must refer to pecuniary or pecuniary injury or loss.

A *fortiori* a person is "aggrieved" when he is challenged by the registered owner as an infringer, or has his own registration opposed, and he may then, if he has any grounds for doing so, apply to have the mark expunged (*in re Rolph*, 1883, 25 Ch. D. 194; *in re Wragg*, 1885, 29 Ch. D. 551; *in re Hughes and Young*, 1893, 10 R. P. C. 389).

Defendant in an action is aggrieved.

When it becomes a question as to whether a mark has been improperly registered or not, the circumstances existing at the date of registration must alone be regarded (*Wood v. Lambert*, 1885, 32 Ch. D. 247; *Barlow v. Johnson*, 1890, 7 R. P. C. 305). An application to expunge might be successful upon the ground that opposition to the original registration would have been successful. This was held by Romer, J., in *Eastman Co. v. Griffiths* (1898, 15 R. P. C. 105), the mark "Kodak," registered by the defendants for cycles, being removed from the Register on the application of the plaintiffs, who had previously registered the word for cameras. The evidence

Grounds for application to expunge.

showed some connection between cameras and cycle fittings. But, generally speaking, there is no reason why a mark registered and used in one trade or class of goods should not be registered and used in an entirely different trade or class of goods by an independent proprietor. As Lord Westbury said in *Leather Cloth Co. v. American Leather Cloth Co.* (1865) 33 L. J. Ch. 199), "the use of the same mark in connection with a different article is not an infringement."

The same mark might be registered by another person for different goods.

There are various grounds upon which a trade mark may be expunged or altered. For instance, the finding of the Court may be practically a revision of the Comptroller's discretion in registering the mark at all, as not conforming to the conditions of the Statute and Rules at the time of registration. Or the person registered as proprietor may not be the person entitled to be so registered; or registration may have been procured by misstatement, or without any intention of trading under the mark.

Reasons for expunging mark.

A host of decisions may be consulted in which marks have been expunged from the Register or altered by an order of Court for a variety of reasons. It would be tedious and unprofitable to recapitulate even a tithe of these examples, but one or two salient instances might be given where the mark has been challenged, and in some cases expunged as being too similar to pre-existing marks and for other reasons. The difficulty of drawing any instructive inference from a bare statement of the effect of any decision is enhanced by the necessary absence from any such statement of the age, facts, and evidence which in all cases guide the Courts in comparing the marks and in giving enlarged effect to, or limiting the scope of the older or registered mark.

As regards devices, in *Anglo-Swiss Milk Co. v. Metcalf* (1886) 31 Ch. D. 454; 3 R. P. C. 250) the word "Dairy-maid," with a half-length stencil figure of a woman, was held too similar to a full-length female figure carrying two pails. The plaintiffs' brand had become known as the "Milkmaid." In *Pomril, Limited's Application* (1901 18 R. P. C. 181) a cider mark consisting of half an apple with the word "Pomril" written across it was held too near to a circular

Device marks expunged for similarity to other marks.

label containing a small central representation of an apple and the words "Apple Brand." In *Worthington's Trade Mark* (1880) 14 Ch. D. 8; 49 L. J. Ch. 646) a triangular frame enclosing a church as a mark for beer was considered too near the well-known red triangle of Bass. In *Marshall v. Metalgon* (1901) 18 R. P. C. 262) the letters "J. B. D." enclosed in an oval were considered an infringement of the letters "G. B. D.," also within an oval. But in *Haines' Trade Mark* (1888) 5 R. P. C. 669) a pig in outline with accompanying initials was held different from a dog with the word "Stanch." In *Lyndon's Trade Mark* (1886) 3 R. P. C. 102; 32 Ch. D. 109) a helmeted woman's head was differentiated from a man's head, although the opponent contended that when stamped on cutlery, for example, and on a small scale, one mark could scarcely be told from the other.

Word marks expunged for similarity to other word marks.

As regards word marks, in *Apollinaris Co. v. Herrfeldt* (1887) 4 R. P. C. 478) "Apollinis" was held to infringe "Apollinaris." In *Steinway v. Henshaw* (1888) 5 R. P. C. 77) "*Steinberg*" was held too similar to "Steinway." In *Slazenger v. Feltham* (1889) 6 R. P. C. 531) "Demotic" infringed "Demon." In *Eno v. Dunn* (1890) 7 R. P. C. 311) "Dunn's Fruit Salt Baking Powder" was held too similar to "Eno's Fruit Salt." In *Goudrin v. Ivory Soap Co.* (1900) 17 R. P. C. 689) it was held that "Ivy" and "Ivory" might lead to confusion. In *Field v. Wagel Syndicate, Limited* (1899) 17 R. P. C. 266). "Savoline" was held an infringement of "Savonol." But in *Talbot's Trade Mark* (1894) 11 R. P. C. 77) "Emolliolorum" was held dissimilar from "Molliscorium." In *Burgoyne's Trade Mark* (1889) 6 R. P. C. 227) "Domoo" was held different from "Emu." In *Coleman v. Brown* (1899) 16 R. P. C. 619) "Vincalis" was held different from "Wincarnis." In *Mealey v. Triticine, Limited* (1897) 15 R. P. C. 1). "Triticine" was held different from "Triticumina."

old marks improperly registered.

Among trade marks held to be improperly registered as old marks there occurred the cases of *Baker v. Rawson* (1890) 8 R. P. C. 89); *in re Palmer* (1883), 24 Ch. D. 504 ("Braided Fixed Stars"); *in re Hayward* (1883), 54 L. J.

Ch. 1063 ("Coker Mats"); *Thompson* v. *Montgomery* [1891], 8 R. P. C. 361 ("Stone Ale"); *in re Royal Baking Powder Co.* [1899], 14 R. P. C. 425 ("Royal Baking Powder"); *Dewar* v. *Dewar* [1900], 17 R. P. C. 341 ("Dewar's Whisky").

Marks common to the trade.

Marks common to the trade: *In re Wragg* [1885], 29 Ch. D. 551 ("Syphon and Glass"); *in re Hyde* [1878], 7 Ch. D. 724 ("Bank of England" on Sealing Wax); *Great Tower Tea Co.* v. *Smith* [1889], 6 R. P. C. 165 ("Tower Tea"); *Hughes and Young's Trade Mark* [1893], 10 R. P. C. 369 ("Anchor").

Marks improperly registered for goods not traded in.

Marks improperly registered in classes of goods not traded in: *Edwards* v. *Dennis* [1885], 30 Ch. D. 454 ("Neptune"); *in re Apollinaris Co.* [1891], 2 Ch. 186 ("Friedrichshall Water"); *Ball* v. *Dunnett* [1899], 16 R. P. C. 411 ("Butterfly" for oats).

Marks improperly registered by someone other than principal.

Marks improperly registered by agent without owner's consent: *Ex parte Laurence & Co.* [1878], 44 L. T. N. S. 98, *n.*; and by foreign importer's agent, *In re Apollinaris Co.* [1891], 2 Ch. 186.

Non-distinctive and possessive name marks.

Name marks not registered in distinctive form: *In re Edge* [1891], 8 R. P. C. 207 ("Edge's Filtered Blue"); *in re Cimmelis* [1889], 6 R. P. C. 467 ("Cimmelis' Cigarettes"); *Pirie* v. *Goodall* [1892], 1 Ch. 35 ("Pirie's Parchment Bank." paper).

Descriptive marks.

Marks held to be descriptive, or having reference to the character and quality of the goods: *In re Palmer* [1883], 24 Ch. D. 504 ("Braided Fixed Stars." Vestas); *re Arbenz* [1887], 4 R. P. C. 143 ("Gem." Air Guns); *re Tallal* [1894], 11 R. P. C. 77 ("Emolliolorum." Saddle Paste); *re Davis* [1897], 14 R. P. C. 903 ("Compactum." Umbrellas); *Burland* v. *Broadbent Co.* [1889], 6 R. P. C. 482 ("Washerine." Soap); *re Edge* [1891], 8 R. P. C. 207 ("Filtered Blue"); *Mendy* v. *Triticine Co.* [1897], 15 R. P. C. 1 ("Triticumina." Meal), but this latter is doubtful since the "Solio" Case.

Proprietor having no established business.

Mark improperly registered, proprietor having no business established: *Re Ralph* (*supra*) ("Homewasher"); *Ball* v. *Dunnett* (*supra*).

Marks exactly similar to

Mark exactly similar to mark already registered in other classes of goods held calculated to deceive:

other marks in cognate classes.

*Eastman Co. v. Griffiths* (1898), 15 R. P. C. 105 ("Kodak" registered for cameras held not registrable for cycles by other traders).

Deceptive marks.

Marks held to be deceptive: *Wood v. Butler* (1886), 3 R. P. C. 81; 32 Ch. D. 247 ("Eton Cigarettes" made in London); *re Hill* (1893), 10 R. P. C. 113 ("Forrest" Watches not made by Forrest).

Character of alterations on Register.

Some of the foregoing were wholly expunged; others had part only of the marks struck out or disclaimed, as in *Burland v. Broxburn*; or the classes of goods in respect of which the mark had been registered were cut down, as, for example, in *Edwards v. Dennis*; *re Metcalf*; and *Butt v. Dunnett* (*supra*); or by entering a disclaimer of certain parts, as in *Baker v. Hanson* and *re Edge* (where the word "Filtered" was ordered to be disclaimed).

Applicant to expunge cannot have his name substituted for ousted proprietor.

Where the applicant to expunge the mark claims to be the real owner, an application to have his name substituted for that of the then registered proprietor is always futile, and the applicant may lose his costs by asking for something which the Court has no power to grant (*re Harness's Trade Mark* (1899), 17 R. P. C. 40). The usual course is to expunge the wrongful entry and let the applicant then make an application to the Comptroller to register the mark in his own name.

Damages

Damages are rarely obtainable under Section 90, but the successful party almost invariably gets his costs, and the Comptroller also is entitled to his costs if he elects to appear. The Court, however, has entire discretion as to costs, and if the conduct of the successful party warrants such a step, costs may be refused (*Humphries v. Taylor* (1888), 59 L. T. N. S. 820; *re Talbot* (1894), 11 R. P. C. 77).

Costs.

Appeal.

An Order under Section 90 is a Final Order, and an appeal to the Court of Appeal can be heard by not less than three Judges unless the parties consent to be heard by two Judges, in which case notice that the consents have been filed must be given to the Cause Clerk (see Notice, 23rd June, 1899, 43 Sol. Jo. 627).

Power of Comptroller

Section 91 refers to dealings between the Comptroller and the applicant for, or the registered proprietor of, a

trade mark. On receipt of a request in writing, accompanied by the prescribed fee, the Comptroller is authorised (Sub-section (A)) to correct any clerical error in connection with or in an application for registration of a trade mark. (B) Correct any clerical error in the name, style, or address of the registered proprietor of a trade mark. (C) Cancel the entry or part of the entry of a trade mark on the Register, provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the Register as the proprietor of the said trade mark. (D) Permit an applicant for registration to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the trade mark to be registered.

to make unimportant alterations.

These sub-sections deal with ministerial matters which hardly call for discussion. It is obvious that the power given under Sub-section (C) to the Comptroller to strike a trade mark from the Register at the request of the owner enables the latter to avoid a threatened application to expunge, with its consequent expense. It is a pity that no similar provision exists in the case of Patents.

Proprietor may delete trade mark from Register.

Section 92 provides:-

**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.

Registered proprietor may apply to Court to alter mark in non-essential particulars.

(2) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant, and the Comptroller shall be entitled to be heard on the application.

(3) If the Court grants leave the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the Register to be altered in conformity with the Order.

In applications under Section 92 the applicant usually encounters no opposition outside of the Comptroller, and in many instances the Comptroller informs the applicant that he has no intention of appearing in opposition. Under Rule 51 of the Trade Marks Rules the Comptroller must

Procedure in applying to the Court.

have at least fourteen days' notice of the intended application, and, according to the same Rule, if leave is granted the applicant must forthwith supply to the Comptroller some representations of the trade mark altered in the manner proposed. Should the applicant succeed before the Court, he should leave an office copy of the order with the Comptroller, whereupon the desired alteration will be made on the Register.

Copy of order to be left with Comptroller.

Only non-essential particulars can be altered.

Alterations can only be made of non-essential particulars. Thus, where the trade mark contained the name of the company who was the registered owner and the name of the company afterwards was changed, the Court allowed the new name to be substituted for the old on the registered marks (*re Stock Owners of New South Wales*, [1897] 14 R. P. C. 733). In the same manner, when a company owning certain registered marks became a limited company, leave was given to add the word "Limited" to the company's name on the marks (*re Hayward & Sons' Marks*, [1896] 13 R. P. C. 729; *re Hallbrooks' Marks*, [1901] 18 R. P. C. 447. It was held in *New Dunsmuir Cycle Co.'s Mark*, [1896] 13 R. P. C. 475, where a company, having changed its name, desired to insert its new name on the Register as proprietor, that the Court had no power to make such an order under Section 92, but that the Comptroller had power to do so under Section 87. This decision seems to do away with the necessity of applying to the Court as was done in *re Stock Owners of New South Wales (supra)*.

Name of proprietors.

Addition of word "Limited."

Power of Comptroller to alter registered proprietor's name under Section 87.

No alteration allowed prejudicial to other owners.

No alteration is allowed which might prejudice other registered owners or which might go outside of the restrictions of the Act (*re Reiss' Trade Mark*, [1898] 5 R. P. C. 291). Non-essential words may be omitted (*Burke's Trade Mark*, [1891] W. N. 2); and the name of a proprietor's works may be altered (*re Brown and Roby's Mark*, [1897] 4 R. P. C. 70).

Greater difficulty in altering old marks.

It is more difficult to get the Court to allow alterations in old marks—*i.e.* marks registered as in use before the 13th of August, 1875—than in new. Old marks have certain privileges, and are under corresponding disabilities. It is, therefore, only under exceptional circumstances that

any alteration is permitted (*per* Kekewich, J., in *Henry Clay's Trade Mark* (1892), 9 R. P. C. 480). Necessary alterations are allowed if possible. For instance, the addition of "Limited" to the name of a company which has become limited is always allowed (*Gladiness & Co.'s Trade Mark* (1888), 5 R. P. C. 316). An application to omit the words "Trade Mark" from an old mark has been refused (*Phillips' Trade Marks* (1891), 8 R. P. C. 489); but see *re Colman's Marks* (1891), 8 R. P. C. 209), where leave was given on terms, these being new marks. A similar application to omit the word "Patent" from an old mark was refused (*Adam's Trade Marks* (1892), 9 R. P. C. 174). In *Sarin's Trade Mark* (1895) 13 R. P. C. 21) an application by the registered proprietor of an old mark to strike out a word and substitute his own name in Russian was refused, because to a person not understanding Russian, and to whom Russian letters would appear rather as devices than letters, the alteration might seem a material modification of the mark as originally registered. It seems that had the words struck out and replaced been merely names and addresses in English, the application would have been granted (*re Bourn's Marks* (1894), 11 R. P. C. 305). A registered label, the whole label constituting the trade mark, but containing some separate device to which special attention is called by the words "Trade Mark," was said by Fry, L. J., in the *Apollinaris Case* (1891) 8 R. P. C. 136) not to be registrable because misleading. In consequence of this remark Messrs. Colman applied to remove from their labels (certain of them being old marks) the words "Trade Mark" surmounting a Bull's Head in the corner of the label. Leave was granted, but only upon condition of entering on the Register a statement of the essential particulars of the label, and disclaiming the added matter (*re Colman's Marks* (1891), 8 R. P. C. 209).

Addition of "Limited" to proprietor Company's name.

Striking out of word "Patent."

Alteration of non-essential particulars from one language to another.

Alteration of possibly misleading item in label.

*re Colman's Marks.*

Proceedings to rectify the Register are usually taken in the Chancery Division. "The Court" in England is His Majesty's High Court of Justice, or where the mark was applied for in the Manchester Branch Office for Trade Marks "the Court" includes the Palatine Court of Chancery. The Irish Court has held that it has no jurisdiction

Rectification proceedings usually taken in Chancery.

Jurisdiction of Irish and Scotch Courts.

to order any alteration or rectification of the Register of Trade Marks (*Bayer v. Connell*, 1897, 14 R. P. C. 275); but a Scotch Court has jurisdiction to entertain a petition for rectification of the Register (*Guerin v. Herbert*, 1897, 14 R. P. C. 436).

Methods of hearing the application.

Evidence is ordinarily given by affidavit, and the deponents may, in the discretion of the Court, be subjected to cross-examination. But frequently the case is taken as an ordinary witness action. Declarations filed by the respondent, the registered proprietor, in matters appertaining to the registration, transfer or alteration of the mark may be put in as evidence by the applicant (*Thearlis and Blakey's Mark*, 1893, 10 R. P. C. 389). Discovery of documents relating to the grounds of the motion may in some cases be ordered (see *Wills's Trade Mark*, 1892, 9 R. P. C. 346).

Discovery.

Appeal.

Appeal from the decision of the Court may be made to the Court of Appeal and to the House of Lords.

# CHAPTER V.

## TRANSFER AND DEVOLUTION OF TRADE MARKS.

Registered trade mark wedded to goodwill of business.

SECTION 70 of the Act of 1883 provides that a trade mark when registered shall be assigned and transmitted 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.

Mark cannot be transferred except with goodwill.

The owner of a trade mark cannot therefore legally dispose of the mark to another without at the same time transferring to him the goodwill of so much at least of the business as relates to the goods in respect of which the mark has been registered. As was said by Fry, L. J., in *Edwards v. Dennis* (1885, 30 Ch. D. 454), "an assignee has no exclusive right to a trade mark unless the assignment is of a business co-extensive with the trade mark as registered." Trade marks which have been registered as a series cannot be broken up and disposed of piecemeal. They must be assigned and transmitted as they were registered - viz., as a series (Section 66).

Marks in series cannot be broken up.

Reasons for tie between trade mark and goodwill.

The reasons for this indissoluble union between a trade mark and the goods or business which have made the mark a readily accepted sign of certain qualities are plain. The reputation of the mark has been made by the goods, and the mark must follow the business in those particular goods - otherwise it might be made an instrument of fraud. This is so far the case that, in *Shipwright v. Clements* (1871, 19 W. R. 599), Vice-Chancellor Malins held that if a business were sold without any word being said about the trade mark the mark would be understood and held to pass to the purchaser. This is a rule which holds good in American practice as well as here.

Mark must indicate in hands of

When the mark is indicative of origin, it must, in the hands of the assignee, indicate what it indicated in the

assignee what it indicated in hands of assignor.

hands of the assignor. Thus, as was said by Fry, L. J., in *Pinto v. Badman* (1891 8 R. P. C. 181), "it may be assigned if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when in the hands of a transferee it would indicate something different from what it indicated in the hands of the transferor."

But although a trade mark may contain the name or initials of the former owner, if the business and goodwill of the former owner has in fact been transferred to the new proprietor, his continued use of the mark with the old name or initials on it is not a deception (*Hall v. Barrows*, 1863, 4 De G. J. & S. 150).

Portion of business with corresponding marks.

A portion of a business may be sold with the trade marks referring to those goods which are dealt with in that part of the business, and the use of the marks will be restricted to those generally.

On bankruptcy, mark passes to trustee.

On the bankruptcy of the owner of a trade mark the mark, together with his other effects, passes to the trustee in bankruptcy as being goods and chattels within Section 15, Sub-section 5, of The Bankruptcy Act, 1883, and the trustee has the power to deal with it as with any other asset. When one of the members of a partnership, otherwise solvent, becomes bankrupt, his individual share or interest in the mark cannot be sold, but will pass to the solvent partner or partners. The reason of this is, that the undivided interest in the trade mark is valueless apart from the goodwill. If the owner of a trade mark, carrying on a business, assumes a partner or partners, the trade mark becomes part of the partnership assets, unless specially reserved by the original owner. The new partner or partners is or are entitled to registration as joint owner or owners with the original proprietor.

In partnership is part of assets.

Right of remaining partner to trade marks.

On dissolution of partnership, the mark goes with the goodwill. If one of the partners carries on the old business the trade mark passes to him with the goodwill, the value of the interest in the mark being accounted for to the retiring partner as one of the partnership assets. But if the partners agree to divide the partnership assets and carry on the same business separately, each is at liberty to use

the mark (*Cloudy v. Mitchell* 1877, C. A. 37 L. T. N. S. 760). But a former partner in a dissolved partnership was, in *Hanson v. Grace Harrison* (1892, 9 R. P. C. 186), prevented from allowing a limited company carrying on business, with which he afterwards became associated, to use one of the marks of the former partnership. When a trade mark is designed and used in a joint adventure, neither of the parties has a right to the mark after the adventure is closed (*re Jones's Trade Mark* 1891, 38 L. T. N. S. 11).

But former partners in dissolved partnership may not, even on sale, retain marks.

Trade mark in joint adventure.

On the death of the proprietor of a trade mark the mark passes to his personal representative with the rest of his personal property. The owner may bequeath his trade mark to whomsoever he pleases, but always in connection with the goodwill of the business.

Devolves as personal property.

When a trade mark has thus been assigned or transferred, the new proprietor should at once, in accordance with Section 87 of the Act, get his name put upon the Register in place of that of the former owner. This is done by sending to the Comptroller a formal request to alter the Register, showing the particulars of the transfer and that the mark has been accompanied by the goodwill of the business, the whole of the several statements being verified by statutory declaration.

New proprietor should be registered at once.

In the event of the Comptroller refusing to enter an assignment upon the Register the assignee may make an application to the Court for an Order directing registration. In such a case the assignee would be a person aggrieved under Section 90. The facts entitling him to be held a *bonâ fide* owner of the mark, and the whole nature of the transaction by virtue of which he acquired it, must be embodied in his affidavits supporting the notice of motion.

Where Comptroller refuses to register.

There is no such thing as licensing another to use a trade mark. If the owner of the trade mark permits it to be used in connection with other people's goods he loses his claim to it (see the "Eton Cigarettes" Case, *Wood v. Butler* 1891, 32 Ch. D. 247).

Owner must not license another to use his trade mark.

# CHAPTER VI.

## ACTION FOR INFRINGEMENT.

Remedies for infringement.

WHEN the owner of a trade mark finds that his mark is being infringed the question as to how he will seek his remedy depends upon the nature of the infringement and also upon his own position. If his trade mark has been registered and the infringement is simply a copy of the mark he may bring an action in the Chancery Division for an injunction to restrain the infringement, with a claim for damages or an account of profits. With this claim he may, if he is so advised, and particularly if his mark has been not exactly copied but colourably imitated, claim an injunction and damages in respect of the passing off of the goods by the defendant as and for the goods of the plaintiff. Or he may bring an action for "passing off" and for false representation on the King's Bench side, claiming damages; or in an aggravated case he may institute criminal proceedings under The Merchandise Marks Act, 1887, by summons before a Magistrate or Justice of the Peace or by indictment.

Action to restrain infringement.

Action for passing off.

Criminal proceedings

Chancery Court.

The Chancery Division is the Court in which an action is usually brought when the plaintiff is the proprietor of a properly registered mark which has been infringed. The plaintiff's right to sue is derived from the Statute, Section 77 of which provides that "a person shall not be entitled to initiate any proceeding to prevent or to secure damages for the infringement of a trade mark unless in the case of a trade mark capable of being registered under the Act it has been registered in pursuance of this Act, or of an enactment repealed by the Act, or in the case of any other trade mark in use before the 13th of August, 1875, registration thereof under this part of this Act or of an Act 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."

Essential that the mark should be registered.

or refused.

Statutory right.

So far as the statutory right to sue is concerned, the plaintiff must therefore possess either a certificate of registration or, in the case of an old mark which has been refused, a certificate of refusal to register. This particular type of action will be considered first, and incidentally the "passing off" element in such actions, since it is difficult to separate one from the other.

Forms of infringement

The first thing for the plaintiff to establish is the fact of infringement. The infringement must imitate the mark as registered or the essential particulars of the mark, and must imitate it sufficiently closely to be calculated to deceive, so that goods bearing the infringing mark may be easily mistaken for goods bearing the registered mark. But the first essential is that the registered mark should have been imitated. As was said by Jessel, M. R. "If you come for trade mark and not for actual fraud you can only sue in respect of what you have registered as a trade mark."

Resemblance.

The infringement may be an exact copy of the plaintiff's mark as registered, or it may consist only of the most salient characteristics of the registered mark, or it may, without being a copy, imitate the general appearance of the plaintiff's mark so as to resemble it. "Resemblance is a circumstance which is of primary importance for the Court to consider, because if the Court finds that there is no reason for the resemblance, except for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading." *per* Wood, V.-C., in *Taylor v. Taylor* (1851) 23 L. J. Ch. 255.

Resemblance need not be exact in detail

The studied resemblance may be brought about in labels by arranging the general mass of the printing, colouring, and other general effects in such a manner that, without actually copying a single word or line of the plaintiff's label, the two marks may be almost indistinguishable at a short distance: as, for example, where a pelican on a green ground was substituted for a crane on a similar backing (*Bolfour v. Killoura*, 1 Hyde 270); "Rotigen" with two crosses for "Rodgers" with a star and a cross (*Rodgers v. Rodgers*, 5 T. L. R. 675).

Instances of general resemblance.

Labels.

A mustard-tin label, with grouping, colours, and arms similar to that of the plaintiff's, was held

to infringe in *Coleman v. Pierce* (1897, 13 R. P. C. 198).

Words. In words a deceptive similarity may also be created, as, for example, "Condisanitas" for "Sanitas" (*Sanitas Co. v. Condy*, 1897, 14 R. P. C. 193, 330); "Steinberg" for "Steinway" (*Steinway v. Headson*, 1897, 5 R. P. C. 77); "Apollinis" for "Apollinaris" (*Apollinaris Co. v. Herfeld*, 1897, 14 R. P. C. 478). But there was held to be sufficient difference between "Winearnis" and "Vinolis" (*Coleman v. Brown*, 1898, 16 R. P. C. 304). In device marks similarity was held between a bell and a beehive (*Bell Black and Co. v. Bell*, Sch. Dig. 5116); a diamond containing a "K" and a diamond without a "K" (*Curtis v. Pape*, 1898, 5 R. P. C. 113). But, even if every case adjudicated upon by the Courts were given, it would help but little in assisting the reader to come to a decision on some fresh case brought to his notice. As Lord Watson asked in *Orr-Ewing v. Johnston* (1880, 7 App. Ca. 219): "How can observations of Judges upon other and quite different facts bear upon the present case in which the only question is, What is the result of the evidence?" The plain rule is, that in each case the Court will institute a common-sense comparison of the marks in dispute, guided always by the evidence and by the behaviour of the parties.

Inutility of precedents in deciding cases of resemblance.

*Orr-Ewing v. Johnston.*

More physical resemblance not the only guide.

But, although the eye is so powerful a factor in settling trade mark disputes as to colourable imitation or general mutual resemblance, mere physical resemblance of the marks is not always the true guide.

*Seixo v. Provezende.*

Lord Cranworth, in his judgment in *Seixo v. Provezende* (1866, L. R. 1 Ch. 192), says: "I do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name may be as much a violation of the rights of that manufacturer as the actual copying of his device." In other words, even if marks placed side by side are easily distinguishable, the one might yet, apart from the other, be an infringement. This principle was followed in *Read v. Nicholson* (1891, 45 L. T. N. S. 511), where the beer of the plaintiffs having

Same echo of device.

"*Dog's Head Beer*" Case.

become well known in the market as "Dog's Head Beer," the defendants were restrained from describing their beer as such and from using any representation of a dog's head on their bottle labels, no matter how unlike the plaintiffs'.

Another example is to be found in *Ore-Ewing v. Johnston* (1882, 7 App. Ca. 219). The plaintiff had a mark which he applied to red yarn, an essential feature of the mark being the representation of two elephants. From this the goods had come to be known as the "Two Elephant" yarn. The defendants had also begun to use a ticket upon which two elephants figured. It was not contended that there was any deceptive resemblance between the tickets: nevertheless an injunction issued against the defendants in terms which practically forbade them from representing or alluding to elephants at all in trade marks for this class of goods. This mark was chiefly current in the Indian market.

*Case of "Two Elephant" Yarn Case.*

The infringing use of the mark must be in respect of goods for which the plaintiff uses his mark, and must of course be used in selling goods not of the plaintiff's manufacture. Therefore, if the goods made by the plaintiff are in the lawful possession of the defendant, and all that the latter has done is to place the plaintiff's mark on the goods he is within his rights in doing so, even if he prints the labels himself (*Farina v. Silverlock*, 1856, 1 K. & J. 509; 24 L. J. Ch. 632). The particular mode of applying the infringing mark to the spurious goods is not of importance so long as the goods are sent out in such a manner as to show that they are intended to be sold under the mark. Thus, placing the mark on a case or wrapper or placing a slip among the goods, or even printing the mark on a circular offering the goods for sale, will amount to wrongful use of the mark (*Day v. Ladler*, 1850, 6 H. P. C. 1361). Old cases or bottles or casks bearing the genuine mark must not be used to convey and cover spurious goods (*Burnett v. Lonchars*, 1868, 18 L. T. N. S. 495). In one instance where the plaintiff's old bottles bearing his mark moulded thereon were sent out containing other manufacturer's goods, the defendant having pasted his own labels on the bottles, it was held the use of the bottles constituted an infringement (*Rose v. Loftus*, 1878, 47 L. J. Ch. 576).

*The infringement must be in respect of goods similar to plaintiff's.*

*Mode of applying mark not material.*

*Advertisement. Day v. Ladler.*

*Old bottles refilled.*

Proof of actual deception not necessary

In the case of a registered trade mark, to obtain an injunction the plaintiff need not prove that actual deception of customers has taken place (*Price v. Jamieds*, 10 R. P. C. 217; 1893, 2 Ch. 567). Neither is there any necessity to prove

No need fraudulent intent.

fraudulent intent on the part of the defendant, for the principles upon which the Courts of Equity act in the case of trade marks are, that the motives of the infringer are immaterial. He may have acted innocently and without

Innocent infringer.

the intention of defrauding anyone (see the remarks of Chitty, J., in *Upmann v. Forester*, 1883, 24 Ch. D. 231). He may even himself have designed the offending mark, and may have intended to use it as his own mark in absolute ignorance of the existence of the mark which he

Ultimate deception.

has infringed. All of this matters nothing. The Court's duty is to protect the public, and it is undeniable that as soon as the goods leave the defendant, and pass from hand to hand, they may be made the instruments of fraud by middlemen, and ultimate purchasers may believe that they were originally manufactured by the person entitled to the genuine mark.

Even when the maker, knowing that they are not the goods of the person entitled to use the trade mark, tells this to the immediate purchaser, thinking thereby to clear himself from the charge of fraud, still he is not absolved, because, as the goods pass on from hand to hand, this representation does not pass on with them, and thus the next purchaser or the public at large may be deceived

Sykes v. Sykes.

(*Sykes v. Sykes*, 1824, 3 B. & C. 541). Consequently all that has to be done is to show that the trade mark has been taken.

Jessel, M.R., in Singer Manufacturing Co. v. Wilson.

This is the gist of a deliverance by Sir G. Jessel, M. R., in *Singer Manufacturing Co. v. Wilson* (1876-7, 2 Ch. D. 434; 3 App. Ca. 376), and summarises the principles of the Court of Chancery in such cases. So that it is not now necessary to show actual deception or intentional fraud, as would be the case in Common Law. All that is necessary in equity is to show that the plaintiff has an exclusive right to use the mark, and that the mark has been taken by the defendant (Westbury, L. C., in *Leather Cloth Co.'s Case*, 1863, 4 De G. J. & S. 137).

An innocent infringer will not, however, be so stringently dealt with as a wilful wrongdoer, especially if prompt submission is made. But it is unlikely that he will escape payment of the costs (see Mr. Justice Chitty in *Upmann v. Forester* 1883', 24 Ch. D. 231; but note Stirling, J., in *American Tobacco Co. v. Guest* 1892, 9 R. P. C. 218, which was the case of an innocent retailer who had made a very small purchase of cigarettes bearing the false mark). In this case the defendants were relieved from the payment of costs. The Court might even in certain circumstances refuse an injunction where the infringement is of a trivial nature committed without the knowledge of the defendants, and especially in cases where the defendants have immediately offered to apologise and pay costs (*Clarke v. Hudson's Executors* 1901', 18 R. P. C. 310).

Practice in the case of innocent infringers.

As a rule, trade mark cases are heard by a Judge without a jury, and even where a defendant in such a case gave notice of trial before a Judge and special jury, it was held that the case must be heard without a jury (*Spratt's Patent v. Ward & Co.* 1879', 11 Ch. D. 240).

Usually tried without jury.

In applying for an interlocutory injunction, promptness in taking action is above all things to be recommended to the plaintiff. Delay is looked upon unfavourably by the Court, unless it can be conclusively shown that such delay was necessary to secure the requisite evidence to establish the plaintiff's case (*Isaacson v. Thompson* 1871, 11 L. J. Ch. 101).

Interlocutory injunction should be promptly applied for.

It is advisable that the plaintiff, before beginning proceedings, should give the infringer notice of his intention to take action, so as to give an opportunity of explanation and submission.

Usually advisable to warn infringer.

The writ should be endorsed with a claim for an injunction to restrain the defendant, his servants and agents, &c., from applying the plaintiff's registered mark of [illegible] to any goods manufactured or sold by the defendant, and from issuing any boxes or cases or the like to which the mark is applied, or from affixing or using any label, ticket, or card containing or bearing the said mark &c. Or the claim might be for damages for the wrongful use or imitation of the plaintiff's trade mark, and for an

Endorsement of writ.

injunction and an order for delivery up and destruction of all goods, documents, articles, or things held to be an infringement of the plaintiff's rights &c. The endorsement must of course be modified to suit circumstances.

Statement of claim.

In the statement of claim the plaintiff, claiming as registered proprietor, should, if the nature of the infringement renders it desirable, describe the mark, and should

Particulars.

preferably give particulars of registration. He should then allege infringement by the defendant, giving some instances of breaches, plead damage sustained by the wrongful acts of the defendant, and claim an injunction on the lines suggested in the endorsement on the writ, together with damages or an account of profits, with delivery up of the goods or materials which constituted or created the infringement.

Colourable imitation.

The statement of claim might be confined to the points indicated where the mark has been absolutely copied, but where the infringement may also be construed as a colourable imitation of the mark or get-up, paragraphs should be introduced into both writ and statement of claim complaining of such wrongful imitation or get-up, and setting forth that by reason of the alleged unlawful acts the

Passing off.

defendant has sold and passed off goods not of the plaintiff's manufacture as and for the plaintiff's goods. In such a case the claim for injunction should refer to such wrongful passing off.

Interlocutory injunction.

The plaintiff might, as soon as his writ is issued, apply for an interlocutory injunction. Formerly this was not readily granted except in cases where the clearest proof of the plaintiff's right and the defendant's wrongdoing was forthcoming. But under present practice, and especially where there is strong suspicion of intentional deception on the part of the defendant, the Court is more ready to grant such relief.

The position of an innocent infringer.

Theoretically, the position of an innocent infringer of a registered mark is no better than that of an intentional wrongdoer but practically the Courts will distinguish, especially where the defendant, as soon as the mistake is brought home to him, makes prompt submission, giving an undertaking and offering to pay such costs as the

plaintiff may have incurred. If after such an offer the plaintiff still goes on, the Court will not support him in any merely vindictive proceedings, although it may find itself compelled technically to issue an injunction. In *Millington v. Fox* ([1838] 3 M. & Cr. 338) the defendants, having inadvertently made use of the plaintiffs' trade mark, themselves informed the plaintiffs of the fact, offering an undertaking, payment of costs, and compensation. The plaintiffs applied for an injunction, which was granted, but without costs. In *Colburn v. Simms* ([1843] 2 Hare, 543), which concerned an infringement of copyright, the defendants, after the filing of the bill, offered to submit to an order in the terms of the bill. The plaintiffs refused and pressed for an injunction, which was granted, but without costs. In the course of his judgment Wigram, V.-C., said: "If a plaintiff immediately after the suit is commenced is offered and may obtain all he seeks, and still thinks proper to go on with his suit, the Court may give him his decree, but will not give him the costs." In *Upmann v. Elkan* ([1871] L. R. 12 Eq. 140), where an innocent infringer made full submission before issue of writ, the injunction was granted, but without costs; and in *Cormack v. Highmoor* ([1883] 27 Sol. Jo. 199), where the defendant offered an absolute undertaking in the terms of the endorsement of the writ, on plaintiff pressing for an injunction Chitty, J., granted it, but so far from giving the plaintiff his costs, he ordered him to pay five guineas towards the costs of the defendant. In some cases even the injunction has been refused. Thus, in *Jenkins v. Hope* ([1895] 13 R. P. C. 57), the innocent infringers of a patent offered, after the issue of the writ, to account for profits, to give a perpetual undertaking, and to pay all costs. The plaintiff, notwithstanding, proceeded with his action. The injunction was refused, but the plaintiff was held entitled to his costs down to the date of the offer, and the costs of the hearing. North, J., said the offer of the defendants should have been accepted. See also *Leahy v. Moore* ([1893] 10 R. P. C. 141) and *Rutter v. Smith* ([1900] 18 R. P. C. 49), where an application for an injunction in respect of an isolated sale of an ounce of tobacco under the plaintiff's

Examples of practice in the case of innocent infringers.

*Millington v. Fox.*

*Colburn v. Simms.*

*Upmann v. Elkan.*

*Cormack v. Highmoor.*

*Jenkins v. Hope.*

*Rutter v. Smith.*

*Clarke v. Hudson's Executors.*

trade mark was refused with costs. In *Clarke v. Hudson's Executors* (1901 18 R. P. C. 310), where the offence consisted in advertising the mark of the plaintiffs in an unauthorised manner (although this appeared to have been done by the printers without authority from the defendants), the offer of the defendants to apologise and give an undertaking and pay costs was disregarded by the plaintiffs, who wished additional terms. Farwell, J., refused an injunction, and only gave the plaintiffs the costs down to and including the writ.

But unless such by defendant must be full and includes what the plaintiff is entitled to.

But if the offer made by the defendant under such circumstances falls short of the terms of the writ, or short of such terms as the plaintiff is entitled to obtain, an injunction will be granted with costs (*McAndrew v. Bassett* [1851], 10 L. T. 155; *Hennessy v. Day & Martin* [1851], 55 L. T. 161). In *Stevenage v. Hyatt* (1905 12 R. P. C. 430), in which case an apology and an offer to consent to an order in the terms of the writ were made, North, J., when granting the injunction directed that the costs to be paid to the plaintiff should not exceed those of a consent order in chambers.

Interlocutory injunction not usually granted where plaintiff unduly delayed.

An interlocutory injunction is not usually granted where the plaintiff has unduly delayed (*Isaacson v. Thompson* 1871, 41 L. J. Ch. 101), and in any case an interlocutory injunction, if granted at all, should be subject to an undertaking by the plaintiff to make good any damages suffered by the defendant in the event of the injunction not being sustained.

Defence.

In considering his defence the defendant must first ascertain the title of the plaintiff and his conclusive or inconclusive right to the sole use of the mark. It will be remembered that according to Section 76 of the Act, mere registration of the mark is *prima facie* evidence of the proprietor's right to the exclusive use of it, while at the expiry of five years such *prima facie* right becomes conclusive as to his right to the exclusive use of the mark, but subject to the provisions of the Act. Evidently, then, a mere denial of infringement, with allegations that the trade mark is not the plaintiff's and that the alleged trade mark is not a trade mark as set out in the form in the Rules of Court of 1883, is very seldom of sufficient

Conclusive right of proprietor.

Form of defence.

breadth, and in the case of a mark registered for more than five years would apparently plead something which it is incompetent to plead.

Where plaintiff's mark has not been five years on Register.

If the plaintiff's mark has not been five years on the Register then the defendant may plead against the validity of the registration all the objections to the mark which might be imported into an application to expunge or vary the entry on the Register (*Dinte v. Badman* [1891], 8 R. P. C. 151). But this case also decides that a claim to rectify the Register should not be put forward by counter-claim. Thus he might contend that the mark was improperly registered in that it did not comply with the requirements of registration under Section 64 of the Act, in addition to the defences permissible even when the mark has been five years registered, as for example that the trade mark has become severed from the goodwill or has been abandoned, or that the plaintiff has been guilty of laches such as delay or acquiescence, or because of estoppel, or that the defendant has a concurrent right of user, or that the plaintiff does not use his mark as registered, or that it is fraudulent or deceptive or contains a misrepresentation, such, *e.g.*, as the word "patent" when there is no patent.

Examples of pleas in defence.

Where plaintiff's mark is not more than five years on Register.

But if the plaintiff's registration is more than five years old the defendant cannot attack the plaintiff's title generally. He cannot, for example, show that the plaintiff's mark is not a trade mark or that it was not competent to be registered as a trade mark under Section 64 (*Apollinaris Co. v. Herrfeldt* [1887], 4 R. P. C. 478, 483). To do this he must move the Court to expunge the mark from the Register, or to vary it in such a manner as to defeat the action. This must be a separate application, and a motion to expunge or vary cannot be added to the defence by way of counterclaim (*Dinte v. Badman, supra*). The motion to rectify is heard with the action, or on the application for interlocutory injunction, if such is made. In a proper case facilities are given for the introduction of such a motion to rectify. For example, in *Edwards v. Elkan* ([1888] 5 R. P. C. 709), Stirling, J., adjourned a motion for interlocutory injunction to enable the defendant to prosecute a counter application to register and to move to rectify the Register.

Limitations of defence.

Application to expunge cannot be by counter-claim.

Registration in Stationers' Hall.

Mere copyright registration of a trade mark in the Stationers' Hall gives birth to no trade mark rights, and is no defence if the copyrighted mark infringes another trader's mark (*Reinhardt v. Spalding*, 1879, 49 L. J. Ch. 57).

Discovery.

Discovery is granted in trade mark actions as in other causes. But such discovery will not be ordered where it is likely to be oppressive (*re Wills' Trade Marks*, 10 R. P. C. 269; [1892] 3 Ch. 201), nor where names of customers or correspondents referring to the matters in issue were concerned (*Warner v. Pinto Leite*, 1871, L. R. 7 C. L. 90). Discovery concerning sales, where the defendant denies infringement, is not usually ordered, and is scarcely material until infringement has been decided. But when an account of profits has been directed, discovery of customers and all goods sold is usually enforced (*Leather Cloth Co. v. Hirschfeld*, 1863, 1 H. & M. 295).

Names of customers.

Discovery of sales.

Inspection.

The Court may in its discretion, and if thought desirable for the purpose of obtaining such information or evidence as will assist the course of justice, order inspection. If, therefore, a plaintiff can show reasonable grounds, he may obtain an order to inspect goods which he has strong reasons for believing are marked with the infringing mark.

Applications for an inspection order are made in the Chancery Division by motion or summons, and in the King's Bench Division by summons.

Relief granted by the Court.

Should the plaintiff succeed in his action, he may obtain all or a part of the relief he asked viz., an injunction to restrain further infringement: delivery up of the goods bearing the infringing mark for destruction if need be, or for erasure of the mark if that can be done: damages, or an account of profits made by the defendant through his wrongful use of the mark.

Damages or an account.

It is for the successful plaintiff to elect whether he will have damages or an account of profits. He cannot have both.

Costs.

Costs usually follow the event, unless the successful plaintiff has been guilty of laches, or sometimes where the defendant is an innocent infringer or has been guilty of some technical offence only, as in *Upmann v. Elkan* (1871, L. R. 12 Eq. 140), the defendants being merely carriers. In this case the plaintiffs, though successful

in obtaining an injunction, obtained no costs. Again, in *Rutter v. Smith* ([1900] 18 R. P. C. 49), where only one sale of an ounce of tobacco passed off as the plaintiff's was proved, Mr. Justice Kekewich characterising the action as trivial, gave judgment for the defendant with costs. Where the case is of great importance and the issues complicated, costs on the higher scale may be given (*Great Tower Steel Tea Co. v. Smith* [1889], 6 R. P. C. 165).

Costs governed by circumstances.

Costs on higher scale.

If the right of the successful plaintiff to the exclusive use of his registered trade mark came in question at the trial, he should ask the Court or the Judge to certify to that effect (see Section 77A of the Act). The result of obtaining this certificate is that in any subsequent action for infringement of the registered mark, the plaintiff, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the subsequent action certifies that he ought not to have the same.

Certificate of validity of plaintiff's claim to trade mark.

Costs as between solicitor and client in subsequent action.

Presumably, following patent practice, to get the benefit of such a certificate in a subsequent action the plaintiff must plead it (*Pneumatic Tyre Co. v. Thisbolm* [1895], 13 R. P. C. 488); and following the same practice the second action must have been begun subsequent to the giving of the certificate, otherwise Section 77A would not apply (*Automatic Weighing Machine Co. v. Hygienic Society* [1889], 6 R. P. C. 475).

Certificate should be pleaded in subsequent action.

Appeal may be made both in interlocutory proceedings and from the final judgment of the Court of First Instance to the Court of Appeal, and from the latter to the House of Lords. In a case of urgency an appeal on an interim injunction has been advanced in the list on the ground that the defendant's business would be irretrievably prejudiced by the continuance of the injunction (*Lazenby v. White*, L. R. 6 Ch. 89).

Appeal.

Advancement of appeal.

It seems that a refusal to grant an interlocutory injunction should not be appealed against, even where the defendant refuses to submit to an injunction or to give an undertaking, if he at the same time removes the cause of complaint (*Dale v. Smith*, W. N. [1892], 145).

No statutory action for threats by proprietor of trade mark.

The section in the Patent Act of 1883 which makes a patentee liable to an action for threats against alleged infringers, does not extend to trade marks. Therefore the proprietor of a trade mark may give notice that his mark is being infringed, and that he intends to take proceedings without rendering himself liable under the Statute to an action for threats, and he cannot be restrained by injunction from so doing (*Colley v. Hart*, 44 Ch. D. 179; 1888 6 R. P. C. 17). But statements not made in good faith and calculated to injure the trade of another or amounting to trade libel or slander of title may be restrained (*Thorley's Cattle Food Co. v. Massam* (1880), 14 Ch. D. 763; *Coulson v. Coulson* (1887), 3 T. L. R. 740; *Nähmaschinen Fabrik v. Singer* (1893), 10 R. P. C. 310; *Royal Baking Powder Co. v. Wright, Crossley & Co.* (1900), 18 R. P. C. 95). It appears from the latter case that even when the statements complained of are untrue and made maliciously the plaintiff must prove special damage. But mere puffing of one's own goods, in however extravagant terms, is not a libel on the goods of rival traders (*Hubbuck v. Wilkinson* (1899), App. Ca. 151).

But action might be taken as for trade libel or slander.

# CHAPTER VII.

## COMMON LAW TRADE MARKS, TRADE NAMES, AND THE ACTION FOR "PASSING OFF."

Owners of non-registered and non-registrable marks may restrain infringement

THE last Chapter referred mainly to actions taken in respect of registered trade marks, which, on that account, occupy a privileged position under the Statute.

But it must not be supposed that it is only the owners of registered marks who can obtain relief against infringers or imitators. The owner of a mark or of a trade name which is perhaps incapable of registration may nevertheless restrain piracy by the exercise of his Common Law rights. This is a remedy which is alike open to the trader who never has registered his mark, to him whose mark has been refused, and to the proprietor whose mark has been expunged from the Register. The principle upon which the Court goes is that, whether the imitated mark or trade name is registered or unregistered, it will restrain the practice of fraud by one person at the expense of another. In an action for the infringement of a registered trade mark, as touched upon in Chapter VI., there is usually an ascertained tangible mark, and the issue is simply how and in what respect the infringer has invaded the property constituted by the mark. But, as Lord Blackburn said in *Singer Manufacturing Co. v. Loog* (1882) 18 Ch. D. 395; 8 App. Ca. 15, after referring to frauds committed by the infringement of registered trade marks, "There is another way in which goods not the plaintiffs' may be sold as and for the plaintiffs'. A name may be so appropriated by user as to cause it to mean the goods of the plaintiffs, although it is not and never was impressed on the goods so as to be a trade mark properly so called or within the recent Statutes. Where it is established that such a trade mark bears that meaning, I think the use of the name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not the

Name trade mark.

plaintiffs', may be the means of passing off those goods as and for the plaintiffs." (*See also* the instructive remarks of Romer, J., in *Singer v. Spence*, 1892, 10 R. P. C. 207).

Common law trade marks.

An unregistered or unregistrable trade mark or trade name, such as is referred to by Lord Blackburn, was first termed a "Common Law Trade Mark" by Lindley, L.J., in *Reddaway and Co. v. Banham Hemp Spinning Co.*, 1892, 9 R. P. C. 503, and the latest writers have adopted this name in alluding to such a trade mark. In the case just cited the plaintiffs had been in the habit of using the terms "Camel," "Camel Brand," and "Camel Hair," as descriptive of their woven belting, so that, as they alleged, belting so distinguished was known all over the world as the plaintiffs' manufacture, and no other. The defendants, who had not been long in business, began to use the same terms as descriptive of their belting, justifying their action by alleging that their belting was woven from woollen yarns known in the market as "Camel Hair Yarn," and in some instances having an admixture of camel's hair in the yarn. At the Manchester Assizes, in May, 1892, Cave, J., directed a verdict for the defendants. The plaintiffs moved for a new trial, and it was held in the Court of Appeal that there was evidence which ought to have been left to the jury. A new trial was therefore ordered, but before it took place the matter was arranged, the defendants submitting to an injunction.

This result was so far unsatisfactory, in that the point involved had not been the subject-matter of a direct pronouncement by the Courts. But the question was not to rest here. Another firm of rival manufacturers began to use the name "Camel Hair" in connection with their woven belting, and proceedings were taken by Messrs. Reddaway to restrain them. The case went to the House of Lords (*Reddaway v. Banham*, 13 R. P. C. 218; 1896, A. C. 199). The defendants contended that as the words "Camel Hair Belting" truly described their goods, which were composed substantially of camel hair, they could not be restrained from using those words. But the House of Lords were of a different opinion, and held that where words which were descriptive in an article have come

to denote the goods of a particular manufacturer, he is entitled to restrain others from using them so as to deceive purchasers, notwithstanding that the words are a description of the goods.

use by others will be restrained.

The result, therefore, was that practically the plaintiffs established their right to the Common Law trade mark constituted by the word "Camel," which was both an unregistered and an unregistrable word, seeing that the Comptroller had pointed out, and the Board of Trade had held, that it was not only a geographical name, but was also, strictly speaking, either descriptive or deceptive.

"Stone Ale" case.

Another instance of a Common Law trade mark is to be found in the "Stone Ale" Case (*Montgomery v. Thompson* [1891], A. C. 391), which was finally decided in the House of Lords in May, 1891. The respondents and their predecessors had for many years carried on business as brewers at the town of Stone. Their ale had become well known in the market as "Stone Ale." Together with other labels they had registered the words "Stone Ale" as a trade mark. The infringer, Montgomery, built a brewery at Stone, and began to sell his liquor as "Stone Ale." On an action being brought by Thompson, Montgomery applied to rectify the Register by cancelling the registration of the word "Stone." Chitty, J., held that Montgomery should be restrained from using "Stone Ale," and refused the motion to rectify.

Geographical name removed from Register, but defendant restrained from infringing.

On appeal it was held that the injunction against the defendant was properly granted, but that the registered mark "Stone Ale" must be removed from the Register, thus changing it from a registered into a Common Law mark.

The defendant Montgomery appealed to the House of Lords, but without success, as the Order of the Court of Appeal was affirmed. Thus it will be seen that even where a party has had the registration of his trade mark cancelled, as being at variance with the law which governs the registration of trade marks, he is not left defenceless, but may uphold his right to the exclusive use of the mark at Common Law.

"Enfield Starch" case.

Similar considerations weighed in deciding *Wotherspoon v. Currie* (1872, L. R. 5 H. L. 508), the "Enfield Starch"

Case, in which, as Lord Westbury said, it was evident "that long antecedently to the operations of the respondent the word 'Glenfield' had acquired a secondary signification or meaning in connection with a particular manufacture—in short, it had become the trade denomination of the starch made by the plaintiffs. . . . . The word 'Glenfield,' therefore, as a denomination of starch had become the property of the plaintiffs."

"Yorkshire Relish" case.

The case of *Powell v. Birmingham Vinegar Brewery Co.* (14 R. P. C. 720; 1897 App. Ca. 710; 66 L. J. Ch. 763) is also an instance of a trade name becoming a Common law trade mark by right of long user. The plaintiff had for thirty-four years designated his sauce which was made according to a secret recipe as "Yorkshire Relish." The defendants began to make and sell a similar but not identical sauce of their own manufacture under the same designation, but with their own name and address on the label. The plaintiff obtained an interlocutory injunction to restrain, and thereupon the defendants issued new labels with the name "Hollbrook's" in large letters and "Yorkshire Relish" in smaller letters. The House of Lords, to whom the case was carried, held that "Yorkshire Relish" meant the manufacture of a particular person viz., the plaintiff. That so long as the plaintiff succeeded in keeping the secret of the sauce, he remained in fact the sole manufacturer of "Yorkshire Relish," and that the defendants in selling their goods as "Yorkshire Relish," when they were not so in fact, committed a fraud upon the public and represented that the goods were the goods of which the plaintiff only was the manufacturer. The same principle held good in the earlier "Angostura Bitters" Case, where the defendant was restrained from calling his bitters "Angostura" until he should find out how to make the real "Angostura Bitters," the composition of which was a secret (*Siegert v. Findlater* 1878, 7 C. D. 801).

Secret recipe.

A person making his goods from a secret recipe has a right to the sole use of the same so long as he preserves his secret.

"Angostura Bitters" case.

Improper use of trade secret.

It should be noted at this point that when a person who has a trade secret employs workmen under an express or implied contract not to divulge the secret, such employés cannot in breach of trust make use of their knowledge and set it up against their employer; neither can such knowledge be acquired and used by

another by such breach of trust (*Williams v. Williams* 1817, 3 Mer. 157; *Essoyd v. Essoyd Hop Essence Co.* 1873, L. R. 10 Ch. 276). But this holds good only where a positive breach of trust has occurred.

The "Camel Hair" Case is thus representative of that class of Common Law mark which by original and continued user becomes, even although descriptive, the sole property of a particular manufacturer in respect of goods open to all the world to make but not to sell under that particular designation. The "Yorkshire Relish" Case is an example of a Common Law trade mark becoming appropriated to a manufacturer of certain goods made according to a secret recipe which other people cannot make because they have not the secret.

New trade marks invented to cover new goods

But there remains a third class of trade mark or name which is especially interesting to inventors. Suppose, for example, that a man invents an entirely new article or product, to describe which he invents an entirely new name, and then (whether the name is registered as a trade mark or not) proceeds to manufacture and sell the new product or article under that name, the question arises Can he preserve the right to the sole and exclusive use of that invented name which he has constituted his trade mark after the expiry of his patent? The answer is, Generally speaking, he cannot. As was said by Lord Davey in the *Wheeler & Wilson Co. v. Manufacturing Co.* (1893) 10 R. P. C. 307 at p. "If a man invents a new article and protects it by a patent, then during the term of the patent he has of course a legal monopoly; but when the patent expires all the world may make the article, and if they may make the article they may say that they are making the article, and for that purpose use the name which the patentee has invented to designate the article, and he cannot assert that the name is distinctive of the article" all the world

may make the article, and all the world may tell the public what article it is they make, and for that purpose they may *primâ facie* use the name by which the article is known in the market."

So, then, if a man invents an absolutely new description of floorcloth composed of boiled oil and finely ground cork and other ingredients and patents it, and then invents a new name for it—say "Linoleum"—and sells it in the market under that name, during the fourteen years of his patent monopoly no one else can make "Linoleum" or sell a floorcloth as "Linoleum." Thus the public only know the article as *Linoleum* and *by no other name*, so that to give the inventor a monopoly in the name after the patent had expired would be virtually to give him and his successors a monopoly for ever, and this would be against public policy (*Linoleum Co. v. Nairn*, 1878, 7 Ch. D. 834). The "Linoleum" Case was followed in the more recent "Vaseline" Case (*re Chesebrough Manufacturing Company's Trade Marks* 1901, 18 R.P.C. 191), where the mark "Vaseline" was struck from the Register as being the commonly known name of a patented preparation of petroleum jelly. And, as Lord Davey says, the same principle must hold good in a thing which is unpatented, and which, when the secret of manufacture is out, is open to any one to make. So that, apparently, the man who attaches a distinctive name to an article already known and open to all the world to make is in a more favourable position with respect to his trade name than if he had been the first discoverer or patentee of the new article.

"Linoleum" Case.

"Vaseline" Case.

But the principle is sound, for in the latter case there is no question of monopoly in the goods, and it is plain that in the case of a newly invented article for which a new name has to be found, such as "Dynamite," "Aspirin," and "Bakelite," and which obtains a world-wide reputation under that name and that name only, it would never do for the original inventor or patentee with a perpetual right to the only name by which the article is known to the public ever to become due to the public.

Person who invents new article gets no property in name

that he can restrain anyone else from using the same name, except upon goods which actually are produced in that district. In *Bewlay v. Hughes* (1898) 15 R. P. C. 290) the plaintiff had for some years sold his cigars under the name "Dindigul." The defendant began to sell his cigars also as "Dindigul," and alleged that the tobacco actually came from "Dindigul." The plaintiff obtained an injunction restraining him from using the name except upon cigars actually made of "Dindigul" tobacco. But compare this with the decision in *Wotherspoon v. Currie* (1872 L. R. 5 H. L. 508), where it was held that from long user and notoriety the plaintiff's starch had become so widely known as "Glenfield" starch that the defendant, although making his starch at Glenfield, must not sell his goods as "Glenfield" starch. However, this must be looked upon as an exceptional case. The plaintiffs in the "Whitstable Oyster" Case failed to establish any exclusive right to the name "Whitstable" as meaning oysters from their beds, the defendants showing that their beds were also in Whitstable (*Whitstable Oyster Co. v. Hayling Oyster Co.* 1901, 18 R. P. C. 434).

"Glenfield Starch" Case must be regarded as exceptional.

"Whitstable Oyster" Case.

Apart from the absolute copying of the mark of another, a rival trader might adopt a word or mark so nearly resembling that of another as to be calculated to deceive. Thus, in *Smith v. Chadwick* (1884 13 R. P. C. 105) the defendants were restrained from using the word "Stafford" to designate their stoves, as being too near the plaintiff's mark "Trafford"; and the use of "Savoline" has been held to infringe "Sunlight" for soap (*Field v. Wood* 1900, 17 R. P. C. 466).

The use of words too similar to the plaintiff's mark restrained.

But a much more common attempt at deception is where the general appearance of a trader's goods is imitated in such a manner that they can be easily mistaken for the

[illegible]

deceived, but whether (all of the collateral points having been considered) the true conclusion is that the ordinary customer of the retail dealer is likely to be deceived.

*"Red, White, and Blue Coffee Tin" Case.*

Merely originating a certain unregistered get-up does not, however, create a monopoly, particularly if it is imitated shortly after its appearance, as in the "Red, White, and Blue Coffee Tin" Case (*Payton v. Snelling* (1899), 17 R. P. C. 48). In *Rowland v. Mitchell* (1896), 14 R. P. C. 37) the plaintiff's wrapper, containing certain printed matter and a portrait of himself, had been imitated by a wrapper of the defendant with different matter similarly arranged and also bearing a portrait, but not of the plaintiff. The Court held the defendant's wrapper was calculated to deceive, and granted an injunction to restrain passing off, with costs. In *Liebig's Extract Co. v. Chemists' Co-operative Society* (1896), 13 R. P. C. 736) the same liability to confound the plaintiffs' with the defendants' tins caused the Court of Appeal to confirm an injunction against passing off which had been granted in the Court below. In the "Sunlight Soap" Case (*Lever v. Bedingfield* (1898), 16 R. P. C. 3), although the Court of Appeal recognised that some parts of the plaintiff's wrapper had been taken, yet the general resemblance between the wrappers was not sufficiently close to constitute passing off, and an injunction was refused.

A "get-up" may deceive though details are not copied.

Trader's name.

A further feature in attempts to pass off goods as and for the goods of another is to be found in those cases where a trader's name has been taken or imitated. We have seen that a man's own name or that of a firm may be registered as a trade mark, but only in a distinctive dress, and it is this distinctive dress only which he can claim.

A man's right to use his [illegible] name.

It is also common knowledge that a man may use his own name in his own business, so long as there is no fraud or misrepresentation and so long as he uses it in such a manner as to avoid confusion between his goods and those of a rival, no matter how long that rival may have been established in business (*Burgess v. Burgess* (1853), 3 De G. M. & G. 896, *Turton v. Turton*, L. R. 42 C. D. 128; and *Jamieson v. Jamieson* (1898), 15 R. P. C. 169). But, as was said by Byrne, J., in the latter case, a man entering

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a trade in which another person of a like name has established a reputation, has a burden cast on him to distinguish his goods from those of the other person. It was also said in the Court of Appeal in the same case that a man is not bound to use extra precautions to avoid confusion between his goods and those of other persons in the trade, if such confusion arises solely from similarity of name and from the use of features common to the trade. But such a case must be distinguished from the case where the name of a particular trader has in the market come to denote his goods. An example of this latter case is to be found in *Valentine Meat Juice Co. v. Valentine Extract Co.* (1900) 17 R. P. C. 673), where the defendant company were restrained by the Court of Appeal from carrying on business in meat extracts under the name of "Valentine," and from selling goods of this nature under any name including the word "Valentine." The evidence enabled the Court to come to the conclusion that the plaintiffs, who had traded under the name "Valentine" for nearly thirty years, were entitled to say that the name when used on goods of this nature denoted that the goods were of their manufacture. The defendant Valentine was restrained from carrying on any such business *without clearly distinguishing his goods from the plaintiffs'*, but the injunction against the company was, as pointed out, of a more sweeping nature. In *Dewar v. Dewar* (1900) 17 R. P. C. 311) the plaintiffs failed to convince the Court that the term "Dewar's Whisky" denoted only the whisky sold by them, and an injunction was refused, but the circumstances in this case were incomparably less favourable to the plaintiff than in the "Valentine Meat Juice" Case, as the defendants' firm had also been a long time in existence and the plaintiffs' assumption of the particular words complained of had been of comparatively recent origin. The principle of restraining a man from carrying on business in certain goods under his own name merely as the writer has asserted its extreme limit in the recent case of *Cash v. Cash* (1900) 17 R. P. C. 617), where the defendant, although not himself guilty of any fraud, was restrained from carrying on the business of a manufacturer of drillings &c. under his own name

in *Dewar v. Dewar.*

A man not bound to use extra precautions to avoid confusion.

But where trader's name and his goods are indissolubly connected in public mind defendant's acts narrowly scrutinised.

"*Valentine Meat Juice*" Case.

*Cash v. Cash.*

"*Chivers' Table Jelly.*"

In *Chivers v. Chivers & Co.* ([1900] 17 R. P. C. 420) an attempt on the part of the plaintiff to show that "Chivers," as applied to table jelly, meant his manufacture only, failed, it being proved that the defendants had been for a long time in business as jam makers and that the plaintiff had only begun his trade in table jelly ten years before the defendants did so.

Plaintiff must always prove long exclusive user.

It may be said with regard to all cases of individual name trade marks at Common Law that the plaintiff can only succeed by proving long exclusive use of the name in connection with certain goods, and in addition to such prescriptive right that the name has acquired a secondary meaning which would cause all such goods sold under that name to be mistaken for the goods of the plaintiff.

Names which have become public property.

At this point it seems not out of place to refer to individual name trade marks which by general use have become *publici juris* and open to anyone to use. Many of these are the names of what were once patented articles which have become so associated with the name of the original patentee as to be known generally and to

Instances of names become *publici juris.*

all the world by that name only, such for example as "Corliss Valves" for steam engines, "Galloway Tubes" for boilers, "Worthington Pumps," and many other instances which will occur to the reader. These names are now lost to the original users so far as exclusive right is concerned, so that any boilermaker may make and sell "Galloway Tubes," or any engineer may similarly make and sell "Worthington Pumps" or "Corliss Valves." In other branches of trade "Harvey's Sauce" was, in *Lazenby v. White* ([1871] 41 L. J. Ch. 354), admitted to be common to the trade, and "Worcestershire Sauce" is in the same category. These and other marks similarly situated would have been of enormous value had their original owners sustained their rights in them. The sewing machine industry furnishes other examples of the individual trade name of a patented article which has become welded to the article itself, becoming public property. In *Wheeler & Wilson Co. v. Shakespeare* ([1869] 39 L. J. Ch. 36), and in *Singer Manufacturing Co. v. Wilson* (2 Ch. D. 434; 3 App. Ca. 376), the Courts declined to continue a patent monopoly

But where the owners of the name still carry on business it must appear

by a claim to the exclusive use by way of trade mark of a name which had become descriptive of the principle of construction (see also *Daimler Motor Car Co., Limited v. British Motor Traction Co., Limited* [1901], 18 R. P. C. 465, concerning the use of the name "Daimler" as descriptive of a system). But although the term "Singer" as descriptive of a principle was thus thrown open to the public, nevertheless it was decided in *Singer Manufacturing Co. v. Spence* ([1893] 10 R. P. C. 297) that the name must not be so used as to be calculated to deceive the public and cause them to buy the machines as and for the manufacture of the Singer Company.

clearly that they are not the manufacturers of the goods.

The principle as to patented articles applies also to articles registered as a design. In *Winser v. Armstrong* ([1899] 16 R. P. C. 167) the plaintiffs in 1885 registered the design of a sewer trap and sold them during the period of registration, and afterwards as "Winser Intereeptors." The traps became well known as "Winser Intereeptors." In 1898—viz., eight years after the expiry of registration, the plaintiffs took action against the defendants, who had begun to make and sell traps of the same design as "Winser Intereeptors." Byrne, J., held that the name had become significant of that particular design of trap and did not necessarily mean that the goods were of the plaintiff's manufacture. The action was therefore dismissed.

The name of a registered design may also become *public juris*.

As compared with the action for infringement of a registered trade mark, the action for "passing off" does not greatly differ, except in this respect, that registration forms no part of it, and the plaintiff must prove that the conduct of the defendant is such as to deceive or to lead to deception, or in other words that the defendant is trying to pass off his goods as and for the goods of the plaintiff. The plaintiff must therefore either show that the defendant actually represented his goods to be those of the plaintiff, or by the use of a trade mark or a trade name or by get-up led buyers to believe, or was likely to lead them to believe, that the goods he sold were those of the plaintiff. Seeing, therefore, that a registered proprietor of a trade mark can only proceed upon his registered trade mark substantially as registered, it follows that he might fail upon this view of his claim,

No statutory right in action for passing off.

Plaintiff must prove deception or extreme probability of deception.

and yet, in the opinion of the Court, be entitled to succeed against the defendant upon the score of passing off. Such being the case, a claim in respect of passing off is generally added in actions for infringement of registered trade marks, so that if the action under registration breaks down, the case in regard of passing-off may succeed. Proof of actual damage done to the plaintiff is not in all cases necessary, but it is advisable if possible to adduce evidence of actual deception. Actual comparison of a plaintiff's and defendant's goods is a potent factor in deciding the question but in certain classes of alleged deceptive get-up, a view and comparison by the Judge does not entitle him to dispense with evidence of deception (*London Omnibus Co. v. Lavell* [1900], 18 R. P. C. 74).

In action on registered trade mark it is desirable to add claim for passing off.

Particulars.

Further points in defence.

In delivering his defence the defendant, in addition to the general denial of the acts imputed, should attack the position assumed by the plaintiff, and deny that the mark or name or get-up in question has any exclusive reference to the plaintiff's goods: that the mark or name or get-up used by the defendant is different from the plaintiff's, and is not used in such a manner as to pass off other goods as and for the goods of the plaintiff: that the defendant has an independent or concurrent right of user: that the plaintiff is barred from relief by some agreement or acquiescence: or delay, or deceptive or fraudulent use, or abandonment: or for any other reason the defendant may be able to allege.

Relief in action for passing off.

If the plaintiff in a passing-off action is successful, the relief granted is usually an injunction restraining the defendant from passing off or doing anything calculated to pass off his goods as and for those of the plaintiff: delivery up of all goods bearing the deceptive mark or name or get-up for destruction or erasure; destruction of all blocks, papers, documents, &c., furthering such deception; and damages or an account of profits.

The terms of relief and the form of the injunction are of course varied according to the circumstances and merits of the case.

Relief in action against person of same name.

Where the defendant's name and the plaintiff's name are the same, and the action is taken in respect of deceptive

use of the name, so as to cause confusion between the goods of the parties, the injunction as a rule never goes beyond restraining the defendant from using his name in such a manner as to deceive.

Trading or firm name on sign-board &c.

Just as an imitation of a well-known trade mark or trade name, placed upon goods, becomes an instrument of fraud by leading the public to believe that they are buying the goods of one person, whereas the goods are really those of another person, so the trading name of an individual or company may be imitated, on a signboard for example, or in advertisements or circulars, in such a manner as to deceive the public into the belief that they are dealing with the individual or firm whose name has been imitated. Except under the terms of The Companies Act, 1862 (25 & 26 Vict. c. 89), there is no such thing as registration of a firm's name in the same sense as trade mark or design registration.

Suppose, therefore, a firm of cabinet makers consisting of less than seven members (this being the number entitling to registration under The Companies Act, 1862) were to launch a business under the title of "The London and Counties Furnishing Company," there are no means of registering such a name; and if another firm should assume the same or a deceptively similar name, the first company has only its Common Law remedy. Where the name of the company is composed of words in ordinary use, the evidence as to deception or the probability of deception, through the assumption by another company of a similar name, requires to be very convincing before a successful action can be maintained.

It is not enough to say that the defendant's business is represented as being *similar* to the plaintiff's: it must be clear that it is represented as *actually* the business of the plaintiff, or at least the representations must be of such a nature as to convince the Court that the public will be deceived to that extent (*Thorton v. Douglas* [1859], Johns. 174; *Holloway v. Holloway* [1850], 13 Beav. 209). As James, L. J., said in *Hendriks v. Montagne* ([1880] 17 Ch. D. 638): "All the Court requires is to be satisfied that the names are so similar as to be calculated to

Court must be convinced of the probability of deception.

produce confusion between the two—so calculated to do it that, when it is drawn to the attention of those adopting the name complained of . . . . it is not honest of them to persevere in their intention, though originally the intention might not have been otherwise than honest." An injunction may also be granted where the name is such as to suggest an amalgamation with the plaintiff firm (*Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.* [1899], App. Ca. 83). Where direct fraud is ascertained, as in *Pinet v. Pinet* (1897) 15 R. P. C. 65), where the defendant had assumed the plaintiff's name with the intention to trade in the same or a similar business, the Courts are always ready to assist the plaintiff.

Where an amalgamation is suggested.

Direct fraud.

"Get-up" of shop front or sign, or using a deceptive name or title thereon, where evidently intended to imitate the plaintiff's, will also be restrained (*Burgess v. Burgess* [1853], 3 De G. M. & G. 896, 22 L. J. 675; and *Peat v. Lee*, 13 Ir. Eq. 454). Just as a shop front may be got up so as to prove deceptive, and thereby cause the public to enter and buy, so a public vehicle may be got up so as to deceptively imitate another's property, and thus cause the public to use it under the belief that they are riding in the vehicle the get-up of which has been imitated. But to succeed in such a case the plaintiff must produce evidence to show that members of the public were actually deceived, and, except where the vehicles are absolutely identical, the Judge ought not to substitute a view under Order L., Rule 4, for evidence that the get-up of the defendant's goods is calculated to deceive (*London General Omnibus Co. v. Lavell* [1900], 18 R. P. C. 74).

"get-up" of business premises.

Public vehicles.

A peculiar or unusual name distinguishing a shop or place of business is usually protected from imitation. Thus "Uncle Tom's Cabin" as a name for a curiosity shop would probably be maintainable against an imitator. But this would not hold good if the title were simply descriptive, such as "The Antiquarian Stores" (see *Hudson v. Osborne* [1870], 39 L. J., Ch. 79; *Boulanger v. Peake* [1868], 13 Ch. D. 513, *note*; *Badegu Co., Limited v. Owens* [1889], 7 R. P. C. 31).

Distinguishing names for business premises.

Fraudulent assumption of name.

Where the trading name is the actual name of an individual or of the members of a firm, and this is assumed by a person or association of a different name or names (as in *Pinet v. Pinet, supra*), the fraudulent intention is obvious. But even when the plaintiff's name is itself assumed, or is a fancy title, relief may be obtained as in "The Christy Minstrels" (*Christy v. Murphy*, 12 How. Pr. 77; *Montague v. Moore*, Seton, Fifth Edition, 538); "The Oldfield Lane Doctor" (*Milner v. Reed* [1870], Solus. Dig. 328); or "Madame Louise" (*Isaacson v. Thompson* [1871], 41 L. J., Ch. 101), where the plaintiff only missed getting an injunction by her own delay.

Fancy name assumed by plaintiff.

Registration of company names, Companies Act, 1862.

As to registration under the Companies Act of 1862, Section 20 of that Act provides that "No company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved, and testifies its consent in such manner as the Registrar requires."

Unregistered firm name.

A company cannot, however, under the Companies Acts, legally register and maintain a name similar to the name of an earlier unregistered company (*Hendriks v. Montagne* [1880], 17 Ch. D. 638).

Right of plaintiff company must be established by evidence.

But in any action brought to restrain the registration of a company with a name so nearly resembling that of an existing company as to cause confusion, evidence is admissible for the purpose of ascertaining how the existing company has used its name and what by reason of its connecting that name with its goods the public have come to attribute to that name. Thus, in *Daimler Motor Car Co. v. British Motor Co.* ([1901] 18 R. P. C. 465) the Daimler Motor Car Co. brought an action to restrain the defendants from registering a company under the name of the *Daimler Wagon Co., Limited*, the plaintiffs relying on Section 20 of The Companies Act, 1862, and also on their Common law right. The Court held that the word "Daimler" meant a particular system, and was used by all persons who manufactured under the "Daimler" Patents, and that

the plaintiffs had failed to establish that the word "Daimler" was so identified with their goods as to cause confusion if used in the name of another company.

Promoting company of similar name without goodwill.

From *Thossaud v. Thossaud* ([1896] 44 Ch. D. 678), and also from the "Valentine Meat Juice" Case ([1900] 17 R. P. C. 673), it seems that although a defendant may commence and carry on a business similar to that of the plaintiff in his own name, albeit that name is the same as the plaintiff's, he cannot, nevertheless, start a limited company under his name unless he has a reasonably long-established business and goodwill to assign to the company. According to Stirling, J., in *Thossaud v. Thossaud* (*supra*), if it be granted that a private business properly assigned becomes the property of a joint stock company, there seems no reason why "that company might not be registered under the same name as had previously been used in connection with the business."

Examples of relief granted.

Injunctions have been granted in *Hoby* (*The Grosvenor Library*) *v. Grosvenor Library, Limited* (28 W. R. 386); *Accident Insurance Co., Limited v. Accident, Disease, and General Insurance Co., Limited* ([1884] 54 L. J., Ch. 104); *Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.* ([1899] A. C. 83); *Guinea Coal Co. v. Pall Mall Guinea Coal Co.* ([1869] L. R. 5 Ch. 155. *See v. Haley*).

Examples of relief refused.

But relief was refused in *Army and Navy Co-operative Society, Limited v. Junior Army and Navy Stores, Limited* ([1879] Sebas. Dig. 393); *Australian Mortgage, Land, and Finance Co. v. Australian and New Zealand Mortgage Co. W. N.* ([1880] 6 C. A.); *Merchant Banking Co. of London v. Merchants' Joint Stock Bank* ([1878] 9 Ch. D. 560); *London Assurance v. London and Westminster Assurance Corporation* ([1863] 32 L. J., Ch. 664). *Daimler Motor Car Co., Limited v. Daimler Wagon Co., Limited* ([1901] 18 R. P. C. 465), and in several other cases. The *ratio decidendi* in these cases is that no one can obtain a monopoly in a name which merely describes the nature of the business, the locality of its operations, or a system of construction.

Fraudulent partnership.

A partnership got up between persons of the requisite names, and intended to take fraudulent advantage of the reputation attaching to an old-established business, will

not be permitted to take the name of the older business, although the partners may be of the same names. Thus, in *Croft v. Day* ([1843] 7 Beav. 84) an injunction was obtained against a man of the name of Day who had associated himself with a person named Martin, and begun to sell blacking under the firm name of "Day & Martin."

Foreign firms.

The Court has jurisdiction to protect foreign trading firms from improper assumption of their firm name in this country, even when the foreign plaintiff firm has no agency here. In *Panhard et Levassor v. Panhard Levassor Motor Co.* ([1901] W. N. 158) the defendants, an English registered company, were restrained from using the names of *Panhard and Levassor*, who were well-known motor car manufacturers in Paris.

# CHAPTER VIII.

## THE CRIMINAL PROSECUTION.

### The Merchandise Marks Acts, 1887, 1891, and 1894.

Offences under The Merchandise Marks Act, 1887.

FOLLOWING the Merchandise Marks Act of 1862, *The Merchandise Marks Act, 1887*, makes the forgery of trade marks a misdemeanour. To "forge" a trade mark means the making of a spurious trade mark so like an existing mark for the same goods as to be calculated to deceive. The term also means falsifying a genuine trade mark by alteration, addition, erasure, or other change. If these acts are done without the assent of the proprietor of the genuine trade mark, they constitute offences under the Act, and the person charged must prove that he acted without intent to defraud. In this the present Act differs from the former Act of 1862, which threw the onus of proving "intent to defraud" upon the prosecutor. It is also an offence to make any die, block, machine, or other instrument, for the purpose of forging or being used to forge a trade mark.

Block for forging a trade mark.

Offences.

The following are the offences and punishments as set forth in the Act, so far as trade marks are concerned:—

OFFENCES.

**2.** (1) Every person who

Forging a trade mark.

(*a*) Forges any trade mark; or

Falsely applying.

(*b*) Falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive; or

Making block or die.

(*c*) Makes any die, block, machine, or other instrument for the purpose of forging or of being used for forging a trade mark; or

False description.

(*d*) Applies any false trade description to goods; or

(e) Disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade mark; or — Selling or possessing printing block.

(f) Causes any of the things above in this section mentioned to be done, — General.

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

(2) Every person who sells, or exposes for, or has in his possession for sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark, or mark so nearly resembling a trade mark as to be calculated to deceive, is falsely applied, as the case may be, shall, unless he proves — Persons offending must prove absence of guilty knowledge, and must assist prosecutor to discover real offenders.

(a) That, having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark, mark, or trade description; and

(b) That, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or

(c) That otherwise he had acted innocently: be guilty of an offence against this Act.

### Punishments and Penalties.

(3) Every person guilty of an offence against this Act shall be liable — Punishments and penalties.

(i.) On conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and

(ii.) On summary conviction, to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second, or subsequent, conviction, to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and

(iii.) In any case to forfeit to His Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

Definition of "trade mark."

In Section 3 of the Act it is set forth that the expression "trade mark" used in the Act means a trade mark "registered in the Register of Trade Marks kept under The Patents, Designs, and Trade Marks Act, 1883," and includes any mark protected by law (whether with or without registration) under international arrangements, such for example as the existing International Convention. The term also includes marks registered under the Trade Marks Act of 1875, and of course extends now to the amending Act of 1901, following the Patents Acts of 1883 and 1885.

Innocent retailer.

It will be seen that, unlike what has been said with reference to the civil remedy, a distinction is drawn between the case of a person who issues or causes to be issued the infringing trade mark, and of him who merely sells articles bearing the false mark. In the former case the circumstances all point to intentional fraud. In the latter case the seller or dealer might have acted quite innocently. In such a case the Act tells him how he must proceed to prove absence on his part of "intent to defraud." He must show where he got the goods, and from whom he obtained them. He must also show that he had no reason to doubt the genuine nature of the mark, and, in short, not only produce every possible proof of his own innocence, but also assist the prosecutor to discover the real offenders.

If a person should be convicted under this Act, he is not thereby relieved from further civil proceedings.

Misapplying a genuine label.

Where a tradesman shifts a genuine label from goods of superior quality to goods of an inferior quality, although by the same maker, such wrongful user of a trade mark would constitute an offence under the Act. Any person untruly representing that a trade mark is registered is liable on conviction to a penalty.

Offences by engravers and lithographers.

Innocent engraver.

Engravers or lithographers who execute instructions for a block, stamp, or die, well knowing it to be meant for fraudulent purposes, commit an offence under the Act. But an engraver who makes a die or block according to instructions without any such guilty knowledge, and who derives no advantage from the sale of

the goods to which the forged mark is applied, can clear himself on proof of innocence in the same manner as the innocent seller. Such persons should give immediate notice that they intend to rely on this defence: otherwise they may have to pay the prosecutor's costs, although discharged from the prosecution. A defendant may appeal to the Quarter Sessions, and if charged before a Court of summary jurisdiction he may elect to be tried on indictment.

Evidence.

In cases under the Merchandise Marks Act the defendant is allowed to give evidence upon oath, and his wife may in like manner be sworn and subjected to examination like any other witness.

Among the reported cases under the Act there are very few indeed in which the head and front of the offending has been direct imitation of the prosecutor's trade mark. This is owing to the custom that has obtained of taking many cases which would be fitly the subject of criminal prosecution into the Court of Chancery.

Rules of evidence in criminal proceedings based upon those in the civil suit.

It may, however, be said that the rules which regulate comparison of the marks and the evidence which would point to intentional imitation and fraudulent intent are much the same as those obtaining in the High Court. Therefore, the magistrate, or the justices on a summary proceeding, or the Court and a jury on indictment, would practically, in a question of fraudulent imitation, have to decide the same issues that would arise in the Higher Courts. Such being the case, the evidence adduced by the prosecutor should be as full and based upon the same principles that would guide the plaintiff seeking an injunction in the High Court, as already explained in foregoing chapters.

An excellent example of a case of criminal prosecution under Section 2 of the Act, and founded upon the alleged fraudulent imitation and forgery of registered trade marks, was decided in 1893 at the London Central Criminal Court before the then Common Serjeant (Sir Forrest Fulton), both the traders who labelled and disposed of the goods and the printer of the labels being found guilty and sentenced. The prosecution was instituted by James Epps & Co., *Reg. v. Hughes.*

Limited, and the defendants (Hughes, Morris, and Fairweather) were indicted for conspiracy to defraud. The prisoners pleaded guilty. The evidence showed that Hughes and Morris had applied the forged labels (which were almost exact imitations of Messrs. Epps's registered labels) to packets of cocoa of an inferior quality; while Fairweather had printed the labels, knowing the fraudulent purpose for which they were intended. Morris and Hughes were sentenced to twelve and five months' hard labour respectively, and Fairweather (the printer) to four months' (*London Daily Chronicle*, 24th October, 1893).

*Reg. v. Ellinger.*

Another important case, of special interest to the Manchester trade, was decided in the City Police Court, Manchester, in July, 1893. The prosecution originated with Messrs. G. & R. Dewhurst, merchants in Manchester, and the defendants were shippers in the same city. Messrs. Dewhurst were the proprietors of a combination trade mark for piece goods, known to the trade as their "Rupee Combination." This combination consisted of—

1. A green ticket with a border enclosing a lion, and bearing the name of the firm;
2. The firm's signature in blue stamped upon the cloth;
3. A ticket in black and silver, the chief features being a rupee in obverse and reverse;
4. Figures in blue, stamped on the cloth, and showing the length; and
5. A coloured stripe "heading."

Example of fraudulent imitation of combination trade mark.

The goods were for export to India. The defendants, shipping to the same markets, had imitated the "Rupee Combination" by arrangements of green and black and silver tickets, signature and figures in blue, together with coloured "headings," which, although not identical with, were deceptively similar to the Dewhurst combination. It was pointed out that the items of the infringing combinations, when compared severally with the items of

the Dewhurst combination, showed readily recognisable differences, nor was the actual relative arrangement of the items in all cases slavishly copied, while the name of the actual shipper or consignee was plainly printed on the tickets and on the cloth. Nevertheless, the unmistakeable *general* resemblance, coupled with certain damaging evidence as to fraudulent intent, resulted in the conviction of the defendants. An interesting point in this case is that it is one of those which show that in adjudicating upon an alleged imitation or infringement of a trade mark, the nature of the market and the degree of intelligence or civilisation of the ultimate purchasers—in other words, their susceptibility of being deceived—must be taken into consideration. The fact that in this instance the ultimate purchasers were natives of India, who were, according to the evidence, mostly ignorant of English, and incapable of easily distinguishing minor differences where a general resemblance to the genuine mark existed, had a powerful effect in influencing the judgment adversely to the defendants.

Susceptibility of ultimate purchaser to deception.

The innocent retailer is usually tenderly dealt with if he can show that he has taken reasonable precautions or that otherwise he had acted innocently. In *Christie* v. *Cooper* (Div. Ct. [1900], 2 Q. B. 522) it was held that a person, albeit he had reason to suspect the genuineness of the trade mark, might, nevertheless, have acted innocently in selling the goods, and might therefore be exonerated under Section 2, Sub-section 2, of the Act.

Reasons for exonerating innocent retailer.

Although not strictly connected with trade marks it might be of use to notice one or two instances of applying a false trade description to goods. For example, in *Kirschenbaum* v. *Salmon & Gluckstein* (Div. Ct. [1898], 2 Q. B. 179) cigarettes in fact machine made, were represented as "hand made." It was held to be no defence that the machine made goods were of as good quality as the hand made, and the defendants were convicted. Apparently "false trade description" might be read "incorrect" trade description.

Applying false trade description. "*Hand-made*" *Case.*

The false description need not be actually applied to goods. A false description in an invoice referring to the

False description need not be

actually applied to goods.

goods is within the Statute (*Budd v. Lucas*, Div. Ct. [1901], 1 Q. B. 408; *Clapper v. Moore*, Div. Ct. [1898], 2 Q. B. 300; *Cameron v. Higgins*, Div. Ct. [1900], W. N. 253; [1901], 1 Q. B. 1). But the mere handing over of two half-pound packets of tea by a salesman in response to a demand by a purchaser, which packets contained less than the full weight, was held not to constitute an "application" to the goods of a false trade description of their weight within the Statute (*Langley v. Bombay Tea Co.*, Div. Ct. [1900], W. N. 141; [1900] 2 Q. B. 460).

Right of defendant to question validity of registration.

It has been a matter of discussion whether a defendant, prosecuted under the Merchandise Marks Act, can avail himself of the privilege, enjoyed by a defendant in the higher Courts, of questioning the validity of the registration of the mark which he has been charged with fraudulently imitating. *Primâ facie* one would think that the criminal charge should not deprive him of that advantage, but the writer is unable to point to any judicial solution of the question.

One of the amendments, made the 14th December, 1900, upon the terms of the International Convention of 1883, was to the following effect:—

Amendment on International Convention, limited by Merchandise Marks Act, 1887.

*Article X. bis.*—The subjects or citizens of the States parties to the Convention (Articles II. and III.) shall enjoy in all of the States of the Union the protection accorded to native subjects or citizens against dishonest competition, forging, and dishonest use of trade marks abroad.

This Article when adopted was accepted by the British Delegates subject to the following declaration:—

It is to be clearly understood that Great Britain will not be bound to give protection beyond that established by The Merchandise Marks Act, 1887, which is most stringent and complete.

The text of the Convention, with the new amendments (consolidated), will be found in Appendix A. The new Article will prove a useful weapon in the hands of those British manufacturers who have hitherto seen their trade marks forged and fraudulently applied in foreign countries, almost with impunity.

# PART III.

# COPYRIGHT IN DESIGNS.

## CHAPTER I.

### INTRODUCTION.

Originally no proprietorship in designs.

THE protection of Designs applicable to manufactured articles is by no means a thing of absolutely modern creation. It is true that prior to 1787 no such thing as legal proprietorship in a design existed: but when at that date the Legislature awoke to the desirability of creating such proprietorship, it never ceased from time to time to improve and enlarge upon the original measure, the immediately beneficial effects of which were no doubt at once apparent. The proofs of its interest are to be found in the fact that between 1787 and the date of the present Statute not less than twelve enactments were passed relating to the protection of designs, the bulk of these Acts being indicated in the third schedule of the present Act of 1883.

First Designs Act, 1787.

The first in 1787 (27 Geo. III. c. 38) seems to have been of a tentative nature seeing that it was limited to expire at the end of the succeeding parliamentary session. By its terms, designs applicable to printed linens, cottons, calicoes, and muslins were copyrightable by their proprietors for two months from the date of first publication.

Amending Acts, 1794 and 1839.

In 1794, by an amending Act (34 Geo. III. c. 23), the former Act was made perpetual, and the term of two months was extended to three. By a further Act passed in 1839 (2 Vict. c. 13) the provisions of the original Act were made to include textile fabrics of wool, silk, and hair,

Extension to Ireland.

Creation of Register of Proprietors.

or mixtures of linen, cotton, wool, silk, and hair, the operation of the Act being at the same time extended to Ireland in addition to England and Scotland. An Act of the same year closely following the latter Act created a Register of Proprietors, and gave protection for twelve months from the date of registration. The Act at the same time extended the field of articles to which designs

Metal work designs.

were applicable, and provided that designs in metal work were to be protected for three years instead of for twelve months.

Act of 1842.

Then followed the consolidating and amending Act of 1842 (5 & 6 Vict. c. 100), whereby the definition of designs and the methods of application, whether to the ornamentation or to the moulding or shaping of the article, were particu-

Action for damages.

larised. The different goods susceptible of treatment were classified, and, in addition to the recovery of penalties for piracy, the proprietor was given a right of action for damages.

Act of 1843.

Useful designs.

The Act of 1843 (6 & 7 Vict. c. 65) introduced the feature of "useful designs" in articles of manufacture, the Registrar (whose office had been created by the preceding Act) being empowered to exercise his discretion as to what were "ornamental" and what were "useful" designs.

Act of 1850.

Provisional registration.

In 1850 an Act (13 & 14 Vict. c. 104) was passed providing for the registration of designs within the Sculpture Copyright Act, but the chief feature in this Act was the introduction of "provisional registration" of designs.

Acts of 1858 to 1875.

Register entrusted to Commissioners of Patents.

Minor Acts followed in 1858, 1861, and 1865, extending and modifying in detail the previous Acts, and by the Act of 1875 (38 & 39 Vict. c. 93) the ministerial powers and duties of the Board of Trade and the custody of the Register were transferred to the Commissioners of Patents, who from the date of that Act administered the Designs Office.

Patents, Designs, and Trade Marks Acts, 1883 to 1901.

Lastly, the whole of these prior Acts then surviving were repealed by the Patents, Designs, and Trade Marks Acts of 1883 to 1901, which, together with the Designs Rules, now regulate and govern the registration of designs.

Formerly two types of design:

The reader will thus note that, prior to the now subsisting Acts of 1883 to 1901, there were two distinct

"Ornamental" and "useful."

forms of copyright in Designs—viz., "Ornamental" and "Useful." Ornamental designs referred solely to such designs as are used to beautify articles of manufacture, such as designs for printed calicoes, wall papers, carpeting, and the like, or raised or flat ornaments upon all sorts of goods, or ornamental shapes of manufactured objects. Useful designs, on the other hand, referred to objects whose novel shape or configuration enabled them to fulfil a useful purpose, such, for example, as an ink-bottle moulded with a recess to fulfil the additional function of a pen tray; or a tool whose shape or configuration enabled it to be used for more than one purpose; or a pavement light or prism of such a shape or configuration as to enable it to divert light into cellars.

Distinction now abolished.

Now, however, under the present Act this distinction between Ornamental and Useful Designs is abolished, and a design is registered for the ornament or pattern, or for the shape or configuration, the latter not necessarily meaning a beautiful or artistic shape or configuration.

Utility not considered.

As to any *useful effect* that may be brought about by the shape or configuration of a design, registration gives no claim in respect of this. The shape or design must appeal to and be judged by the eye alone, and the Court will disregard all reference to the useful effect, if any such exists.

*Hecla Foundry v. Walker.*

Thus, in *Hecla Foundry Co. v. Walker, Hunter & Co.* (1889) 6 R. P. C. 554), the Lower Courts, hampered probably by some reminiscences of the extinct Useful Designs registration, instanced the useful effect of the registered design of a kitchen range fire-door as one of the reasons for recognising and maintaining the validity of the registration. But the Judges in the House of Lords, while upholding the decision of the Courts below, expressly pointed out that the *utility* of the design must not be allowed to influence the question in any respect.

The only test is that of novelty and originality.

The propriety of this view has never since been doubted, and in *re Morton's Design* (1900) 17 R. P. C. 117) Mr. Justice Farwell, when the question of utility was raised, said: "What you have to see is whether, tested by the eye, the design is novel or original within the meaning of the

Act. That it may be useful seems to me to be immaterial, because I think it must be admitted that however useless a novel design may be, it would still be within the meaning of the Act if it were novel or original."

This goes a long way towards clearing the decks for a proper comprehension of the present Act, and makes plain the fundamental principle that under the present Statute the old and familiar differences between ornamental and useful designs, with all the considerations that flowed from these differences, are abolished and done away with.

There must be a recognisable difference from something done before.

Practically speaking, in the eye of the Act a novel and original design simply means something in the decoration, shape, or appearance of an article different to a sufficiently appreciable extent from anything publicly done before in the same article or class of article. Those of the succeeding pages which are devoted to the consideration of actual examples will show how small a difference may constitute a valid and registrable design. By means of these examples it is hoped the significance of the word "design" within the Act may become apparent. To discuss the larger and more abstract meaning of the term is not within the province of these pages.

Following the convenient arrangement of the two preceding divisions of this work, the succeeding chapters will deal successively with the Procedure in Registering Designs, including a reference to the Register: the Persons Qualified to Register: the Subject-Matter of Designs: Novelty: Marking: the Action for Infringement, and the Rectification of the Register.

# CHAPTER II.

## PROCEDURE IN REGISTERING DESIGNS.

Procedure in registering.

THE procedure in registering designs is simplicity itself, and the scope of this chapter will be limited to bringing together, condensing, and classifying the information scattered throughout the Act, the Board of Trade Rules, and the Comptroller's instructions.

Application forms.

Stamped forms of application to register, price 10s. in Classes 1 to 12 (except for lace), and 1s. in Classes 13 and 14, and also for lace designs, can be obtained at the chief post-offices of most important towns. Examples of these forms are to be found in Appendix II. By following the marginal instructions on the application form, "E," no mistake need be made by the applicant in filling in the particulars. The only part of the form that calls for the exercise of judgment is that where the applicant is directed to state the nature of the design, and "whether it is applicable for the pattern or for the shape." The latest instructions issued by the Patent Office require that the statement of the nature of the design shall particularise whether it is applicable for "the pattern" or for "the shape or configuration" or for "the ornament," these more extended terms being drawn from Section 60 of the Act. It may be taken that the terms "pattern" and "ornament" are, in many cases, practically synonymous. If any difference is to be recognised, "pattern" may be taken to refer to repeat designs, such as checks, stripes, or combinations of that description, or floral or other repeat devices which are usually employed to decorate window-curtains, calicoes, carpets, wall-papers, and the like; while "ornament" would more fitly apply to ornamental tracery or designs upon metal articles or picture frames, or furniture, or goods, or utensils such as cutlery or china. Lace designs (in Class 9) are classified as "patterns," and the lace design application forms, E1 and O1, which appear in the set of Rules which came

Statement of nature of design.

Pattern, shape or configuration, or ornament.

Pattern.

Ornament.

into operation on the 30th of November, 1893, contain a statement that "the nature of the design is the pattern." It may be noted that these latest application forms for hire request the Comptroller to register the accompanying design "without search." "Shape or configuration" evidently refers more particularly to manufactured objects and articles in the round, and relates to general outline rather than to surface decoration. The term would properly describe a design for a tombstone, or a chair, or a lamp-stand, and each of these might combine ornament with it, as set forth in Section 60.

Shape or configuration.

Short description of object might be added.

When thought to be necessary, a short technical description of the article may be added, with the part or parts which are claimed as new or original specifically defined. The form is signed by the applicant or his authorised agent and dated, and is then ready for filing. The application form should be accompanied by three exactly similar drawings, photographs, or specimens of the design. The drawings, photographs, tracings, or specimens should be mounted on foolscap sheets of paper of the same size as Form E (13 in. by 8 in.). Rough sketches or unfixed pencil drawings will not be accepted. When the design refers to the shape or configuration, two or more views of the object may be given, if such should be necessary, to convey a correct impression of the design. Both views should be on the same half-sheet of foolscap. Each drawing or specimen of a design in Classes 13 and 14 should show the complete pattern and a portion of the repeat, and ought not to be of less size than 7in. by 3in. When specimen cuttings of the design are furnished instead of drawings, they must be of a nature that will permit of their being pasted into books. The drawings or mounted specimens should be signed by the applicant or his agent.

Copies of design.

Signature of applicant or agent.

When the papers have been thus completed they should be delivered or sent by post to—

The Comptroller,
Patent Office (Designs Branch),
25 Southampton Building
Chancery Lane,
London, W.C.

The goods to which designs are applicable are divided into fourteen classes. The following is a list of the classes :—

Classification of goods.

1. Articles composed wholly or chiefly of metal not included in Class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, *papier mâché*, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including bookbinding of all materials.
7. Paper-hangings.
8. Carpets and rugs in all materials, floorcloths, and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework in muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece-goods.
14. Printed or woven designs on handkerchiefs and shawls.

By Section 58 of the Act the protection afforded to a registered design is restricted to the particular class or classes of goods in which the design is registered.

Same design may be registered in more than one class.

The same design may be registered in more than one class, but for each class a separate application, each with its annexed three representations, will be required.

Registration in sets.

When the design is to be applied to a set, each of the drawings accompanying the application should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

Lace designs.

There is a special form, "O," for applications of this nature, and the stamp is C1. For sets of lace designs in Class 9 a special form, O1, is provided.

Caveat applications.

Should an applicant be desirous of losing no time in making his application, he may send up the application forms, accompanied by a single sketch, instead of the three careful drawings or photographs required. This fixes the date of the application, and the finished drawings may then be made at greater leisure, and afterwards filed. The sketch and the drawings must, however, agree in showing the nature of the design.

Certificate of registration.

On receipt of an application the Comptroller considers the design, and if he decides to register it he sends a certificate of registration to the applicant, sealed with the seal of the Patent Office.

Objection to register.

The Comptroller might, however, decline to register, and in that case, before exercising the discretionary power given to him by the Acts adversely to the applicant, the Comptroller shall, if so required by the applicant, within one month from the date of the Comptroller's objection,

Hearing.

give the applicant an opportunity of being heard personally or by his agent, by sending the applicant ten days' notice of a time when he may be so heard. Within five days from the receipt of this notice the applicant must notify the Comptroller whether or not he intends to be heard.

The decision of the Comptroller consequent upon the hearing is then notified to the applicant.

Appeal from refusal to Board of Trade.

If this decision is a refusal to register, the applicant may still appeal to the Board of Trade. If he intends to do so, he should, within one month from the adverse decision, leave at the Patent Office a notice of his intention to appeal. The form of this notice (Form F) will be found in Appendix II. The notice is to be accompanied

by a statement of the grounds of appeal and of the applicant's case in support thereof. A copy of the notice should at the same time be sent to the Secretary of the Board of Trade, 7 Whitehall Gardens, London. The Board of Trade will then appoint a hearing, and a notice of the time and place of hearing is sent to the Comptroller and to the applicant. After the hearing, the Board of Trade gives its decision, and this is final. The Board might in some cases refer the matter to the Court. There is no provision as to costs.

Final decision.

When registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered. During the existence of the copyright in a design, the design shall not be open to inspection except by the proprietor, or by a person authorised by him, or by the Comptroller, or by the Court, and then only in presence of the Comptroller or his representative, and upon payment of the prescribed fee. The person making the inspection is not allowed to make any copy of the design.

Inspection of registered designs.

When the copyright in the design has ceased, the design is open to inspection by anyone paying the prescribed fee, and copies may be freely made.

Inspection of expired designs.

## Searches.

Any person wishing to know whether the registration of a particular design marked as "registered" is still in force, and when and by whom it was registered, may obtain the information he requires by producing or sending the design, with its mark and number, to the Comptroller, and paying the prescribed fee. The request for search should be made on Form "X" (see Appendix II), stamped with five shillings.

Searches by Comptroller.

A still more valuable provision in the Rules empowers the Comptroller, on payment of the same fee, to make a search among the registered designs for the purpose of finding whether a design produced by the person requesting the search is identical with, or an obvious imitation of, any registered design still in force.

Comptroller's certificate not evidence.

This is a precautionary measure that might be recommended to manufacturers who contemplate the production of a design concerning which they may have any doubt. It must, however, be said that if, even after receiving the Comptroller's certificate that it is *not* an obvious imitation, the owner of a registered design should take action on the ground that it is an obvious imitation, the Comptroller's certificate is not admitted as evidence on the defendant's behalf, and has no weight with the Court.

## Register of Designs.

Proprietor entered in Register.

Upon the issue of the certificate of registration, the name, address, and description of the proprietor of the design, together with the date and number of registration, are entered in the Register of Designs by the Comptroller.

Assignee or licensee entered on Register.

When 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, or as having acquired such right, should be addressed to the Comptroller, and left at the Patent Office, Designs Branch. This request, which is made on Form "K" (see Appendix II.), is stamped with ten shillings in the case of designs in Classes 1 to 12, and with one shilling in the case of designs in Classes 13 and 14. The assignment or licence must be in writing.

Request for entry.

The request should state the name, address, and description of the claimant, and give particulars, with dates and names of the assignment, transmission, or licence by virtue of which the request is made.

Verification by declaration.

The request concludes with a statutory declaration, signed by the claimant, verifying and declaring the truth of the several statements made and particulars given in the request. The Comptroller will then alter the Register in accordance with the request.

Body corporate may be registered.

When the request is made on behalf of a firm or partnership, it should be signed by some one or more members of the firm or partnership, or by his or their

duly authorised agent. A body corporate can be registered as proprietors by its corporate name, and the request may be signed by a director or by the secretary, or by the duly authorised agent of the body corporate.

When an order has been made by the Court to rectify the Register, the person in whose favour the order has been made should forthwith leave at the Patent Office an office copy of such order, whereupon the Register will be rectified or the purport of the order duly entered in the Register as the case may be. Four clear days' notice of every application to the Court for rectification of the Register should be given to the Comptroller.

Duty of person in whose favour order of Court has been made.

The Register of Designs shall be *prima facie* evidence of any matters directed or ordered by the Act to be entered therein.

Register of Designs *prima facie* evidence.

A certificate of any entry on the Register of Designs, for use in legal proceedings, may be had from the Comptroller by making a request on Form "I" (see Appendix II), which is stamped with five shillings.

Certificate of entry.

## Industrial and International Exhibitions.

Any person desirous of exhibiting an unregistered design at an industrial or international exhibition, certified so to be by the Board of Trade or by an Order in Council made in pursuance of Section 57 of the Act, should give the Comptroller seven days' notice of his intention to exhibit, and such notice must be given upon Form "L" (see Appendix II), stamped with five shillings. This notice preserves his prior right to make application for registration of the design during six months from the opening of the exhibition. The notice to the Comptroller should include a brief description of the design, and be accompanied by a sketch or specimen. Application for registration should be made within six months of the opening of the exhibition.

Exhibition of unregistered designs.

## Duration of Copyright.

The *Duration of Copyright* is limited to five years from the date of registration, and there is no provision for extension of this time. An unusual clause for the fostering of native industry occurs in Section 51 of the Act, which

Duration of copyright.

Working clause.

provides that 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 here, the copyright in the design shall cease. This clause is akin to the condition of "working" attached to the grant of many foreign patents.

Copyright extends only to United Kingdom.

It might be thought needless to say that the protection accorded to designs by The Patents, Designs, and Trade Marks Acts, 1883 to 1901, does not extend beyond the limits of the United Kingdom.

Reference, however, may be made to a case (*Potter & Co. v. Braco de Prata Co.* [1891] 8 R. P. C. 218) in which the plaintiffs, who were a British firm, sought to make the defendants (also British subjects) liable for the infringement of certain calico-printers' designs. It was admitted that the designs of the plaintiffs were being copied and sold, but the defendants pleaded that the goods bearing the designs were manufactured and sold in Portugal and Brazil—countries which were not subject to the operations of the Act. The judgment of the Lord President was to the effect that an infringement of a design registered under the Act consists in the production and sale of goods in this country, where they are protected, and nowhere else. No right is secured to a registered design in a foreign country by registration here, except the right under the International Convention (see Appendix A).

A tort created by a British Statute must, to be actionable, have been committed in this country.

The Acts of 1883 to 1901 extend to the Isle of Man, but nothing in the Acts is to affect the jurisdiction of the Courts in the Isle in proceedings for infringement or in any action or proceeding respecting a design, competent in those Courts (see Section 112 of the Act, Appendix F). Copyright in a registered design does not cover the Channel Islands.

### International and Colonial Arrangements.

Persons who have applied for registration of a design in any country or colony under the Convention, and who apply for registration in another country within four months thereof, will obtain the date of their original application (see Section 103, and Appendix A, page 431).

# CHAPTER III.

## PERSONS QUALIFIED TO REGISTER AND TO BE REGISTERED PROPRIETORS.

Who may register.

A PERSON qualified to register a design is the author or inventor of the design unless he produced it on behalf of another person for a good or valuable consideration.

To be precise, the words of Section 61 of the Act which purport to define the proprietor of a design are as follows:—

The author or purchaser or person having the right to apply the design.

"The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent but not otherwise."

Section 5 of the old Act of 1842 was much to the same purport, and under that measure it was held, in *Lazarus v. Charles* (1873) L. R. 16 Eq. 117, 122), that where a person has a workman in his employ, and the workman in the course of his business and employment makes a design which is new and original, the master may register the design as his property: but that persons not the original designers nor the employers of the designer, but merely customers who made a contract with the foreign designer that he should supply them with articles in this country according to the design, were not entitled to register themselves as proprietors here, since they were neither authors of the design nor had they purchased it for a valuable consideration. As Malins, V.-C., said in this case:—"The plaintiffs were not entitled to any merit of

Master and servant.

Exclusive licensees to sell cannot register as proprietors.

*Lazarus v. Charles.*

invention; they only did as anyone else might do: that is, they purchased the articles, but they gave no consideration to entitle them to be the proprietors of the design under the terms of the Act; for the agreement to purchase the articles from the manufacturer can form no consideration within the meaning of the Statute. Therefore they are not the designers of the article, nor are they entitled to be the proprietors by virtue of having purchased a design for valuable considerations. That is, in my opinion, a fatal objection to the plaintiff's title."

*Jewitt v. Eckhardt.*

Even where an exclusive right to sell was of the essence of a contract between the designer and the customer, the customer was held not entitled to register. In *Jewitt v. Eckhardt* (1878) 8 Ch. D. 401) an American manufacturer purported to sell to the plaintiff the sole right to deal in an article of a new design which was about to be put upon the market, it being stipulated that the plaintiff should obtain the goods exclusively from the manufacturer. Here it was held that the plaintiff, not having under the contract the right to manufacture, had not acquired the right to apply the design and could not be registered as proprietor.

Agent for foreign principals.

The agent of a foreign firm selling goods of a particular design in this country for his foreign principals has no claim to be registered as proprietor of the design (*Guilermain's Design*, 1886), 55 L. J. Ch. 309).

*Bona fide* mistaken and non-fraudulent registration may be cured by substitution of true author's name.

*Grocott's Design.*

Where a design was mistakenly registered by an agent of the designer in his own name instead of that of his principal, but without any fraudulent intent, the Court ordered the principal's name to be substituted for the agent's (*Grocott's Design*, 1899), 17 R. P. C. 130). But if the registration were originally fraudulent it seems that in motions to rectify the Register the practice in trade marks would be followed—viz., to strike the design off the Register and let the true designer re-apply in his own name. But how if in the meantime the design had been published? Re-registration by the true author would be futile in such a case, unless the Court were to order that the new registration should be dated the same as the original wrongful entry.

First importer.

Although in patent practice the first importer of an invention from abroad is considered the true and first inventor, there seems no reason to suppose that a mere first importer of a design from abroad, although not in any fiduciary relationship to the foreign author, could claim to be legally registered as proprietor (*Lazarus v. Charles* [1873], L. R. 16 Eq. 117).

Assignee.

An assignee of a registered design steps into the shoes of the registered owner, and may on application to the Comptroller be registered as proprietor (see Form "K" in Appendix II).

Licensee.

Holders of licences may also enter a notice of the licence, but neither assignment nor licence can be entered until the original proprietorship has been placed on the Register (*Jewell v. Eckhardt, supra*).

Licensee for sale cannot sue for infringement.

A bare licensee cannot sue for infringement, nor can the assignee until his name is on the Register (*Woolley v. Broad* [1892], 9 R. P. C. 208). In the latter case, where an unregistered verbal licensee joined with the proprietor in an action for infringement, judgment for the defendants was given so far as the licensee was concerned.

In disputed proprietorship onus of proof on claimant.

Where the proprietorship is disputed, the onus of proof lies on the party claiming the proprietorship (*Heinrich's Design* [1892], 9 R. P. C. 73).

Design is personal property.

A design is personal property, and on the death or bankruptcy of the proprietor goes to his personal representatives or to the trustee in bankruptcy.

List of persons qualified to register as proprietors.

To conclude, the persons qualified to be placed on the Register as proprietors may be classified as follows:—

1. The designer or author of the design.
2. A person on behalf of whom the designer or author has executed the design for a good or valuable consideration.
3. A person who has acquired the design or a share therein for a good or valuable consideration (*i.e.*, an assignee of the whole or a part); or has acquired the right, either exclusively or otherwise, to apply the design to manufactured articles.
4. Any person upon whom may devolve the foregoing property or rights in the design.

# CHAPTER IV.

## SUBJECT-MATTER OF DESIGNS.

Definition of "Design."

Must be capable of application to some article of manufacture.

THE term "Design" is defined in Section 60 of the Act to mean 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, stamping, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for sculpture or other thing within the protection of the Sculpture Copyright Act of the year 1814 (54 Geo. III., c. 56).

Thus a design, within the Act, may be some pattern or ornament printed or produced on the flat, such as woven or printed designs on textile fabrics, paper-hangings, floorcloths, or the like; or patterns or designs etched, or stamped, or cast, or embossed, or cut, or otherwise produced on metal articles, or glass, or plastic material, or furniture, or tiles, or worked or woven, as in lace; or it may be for artistic or beautiful shape or configuration, as in a lamp stand, or lamp shade, or iron railing, or gate; or for shape, in which no appeal is made to the sense of beauty, as in a new shape or configuration of grate-door, or oil-can, or cravat, &c. Or, as the Act says, the design may contain two or all of the foregoing elements—*i.e.* ornament, pattern, shape, and configuration.

Design may combine ornament, pattern, and shape.

No utility necessary.

It will be noted that the section does not make the smallest allusion to utility. It is the design, and the design alone, that is protected. The Court will not look beneath the surface, but must find the reasons for registration

apparent to the eye. If a useful object is attained, well and good; but this consideration will not be allowed to obtrude itself as an element to be taken into account.

*Heela Foundry v. Walker, Hunter & Co.*

In the case of *Heela Foundry Co. v. Walker, Hunter & Co.* (1889) 6 R. P. C. 551), already referred to, the design was applied to a kitchen range fire-door, and consisted in casting an "ogee" moulding upon the upper edge of the door, which moulding filled in the gap across the top of the grate when the door was closed, and practically continued the moulding of the same description which already extended along the front of the grate on each side of the grate. Its practical advantages were, that it did away with the usual hinged fall-bar which had before been used to bridge the gap, and also helped to exclude cold air from the top of the grate. The new door was not registered as part of the range, but as an object by itself, the short specification on the application form being, "Range fire-door, with moulding on top: *Shape* to be registered." The defendants (the appellants in the House of Lords) had infringed by using a similar fire-door.

Range fire-door.

"Shape" in design.

The Lord Ordinary, in giving judgment for the plaintiffs, and confirming the validity of the registration, laid stress upon the elements of utility; and on appeal the Inner House, confirming the Lord Ordinary, made the same mistake. Finally, on appeal to the House of Lords, the decisions of the Lower Scotch Courts were affirmed, but their error in allowing the question of utility to influence them was strongly insisted upon, and it was laid down that the eye alone must be the judge in dealing with a design. The defendants' fire-door had also a moulding along the top, and that being the plaintiffs' registered design, judgment was given accordingly. As Lord Fitzgerald said towards the conclusion of the case: "In the course of the discussion at the bar one of the learned counsel asked us to put the two things (*i.e.* the two fire-doors) side by side, and said that we should see by a look that the article produced by the appellants was an obvious imitation of the registered design of the respondents. My Lords, I looked at the two things then, and I came to the conclusion that the door of

Utility must not be considered.

The eye to be the judge.

the appellants was clearly an obvious imitation of the registered design of the respondents, and from that moment I thought that the argument was at an end."

*Moody v. Thos. Wesson Basket Case Co.*

*Corset Case, Farwell, J., on utility in Mackie's Design case.*

The judgment in the above case was resorted to for guidance in *Moody v. Thos. Wesson* (1902) 9 R. P. C. 333) by the Divisional Court; and in *Thorpe v. Symington* (1903) 10 R. P. C. 203); Mr. Justice Chitty decided that the utility of the registered corset could not make up for its shortcomings as a design. In the more recent deliverance of Farwell, J., in *Mackie's Design* (1900) 17 R. P. C. 117) the necessity of disregarding utility in designs was again insisted upon. Said the learned Judge: "That it (the design) may be useful seems to me to be immaterial, because I think it must be admitted that however useless a novel design may be, it would still be within the meaning of the Act if it were novel or original."

Instance of very slight subject-matter.

*Walker v. Scott.*

The case of *Walker v. Scott* (1902 9 R. P. C. 482) is another instance in which a design, while conforming to the requirements of the section, yet had wrapped up in it an essentially useful purpose or result. The design was applicable to a cyclist's oil-can, and consisted in rounding the edges of the can, so that when carried on the person there was no danger of its catching or cutting the clothes or person. The validity of the registration was not questioned by the defendant, and Chitty, J., in giving judgment for the plaintiff, did not seem to doubt its fitness as subject-matter. The design was practically a modified shape of oil-can. It was a change of shape apparent to the eye, and that satisfied the Court. The fact that the change did not mean any added beauty, and that it undoubtedly did enlarge the usefulness of the can, had nothing to do with the question.

A design might be or something also patentable.

While thus showing that *utility* does not form a recognised element in a design, it may be advisable at this point to go a step further and glance at a possible confusion between patentable inventions and designs. The judgment of Lord Shand in *Walker v. Falkirk Iron Co.* (1887 4 R. P. C. 390) is an authority for saying that it may well be that something which is perfectly fit subject-matter as a design might also be fit subject-matter for a patent.

For example, the range-door referred to in that case, by virtue of its useful functions, and in combination with the range, would undoubtedly have constituted a patentable invention, and yet the registration of the door as a design was upheld by the Court.

Nevertheless, such an instance is likely to be rare, and it may be instructive to notice an example where the registration of a design was held to fail, on the ground that it was not properly a design, but a patentable invention. In *Moody v. Pace* (1892) 9 R. P. C. 333) a design of basket was registered, the basket being woven in such a manner that the osiers were worked in singly, the butt-ends showing outside; the whole, on being finished off, presenting a very pretty appearance. The jury in the County Court found that the basket was a novelty, but the judge, doubting whether it was fit subject-matter for registration as a design, granted an appeal to the Divisional Court. There it was held that the so-called design was really a method of manufacture, and should have been patented. Again, in *Cooper v. Symington* (1893) 10 R. P. C. 264) the plaintiff had registered as a design a corset, in which the busks in front, although really fastened together by eyes and studs, had yet, when seated upon the wearer, the appearance of having been laced together. This appearance was obtained by the arrangement and display of certain diagonal lacing which confined the busks in their sheaths. The general appearance was similar to the admittedly more becoming appearance of a laced-up corset. But then, to lace up a corset was a tedious operation, whereas in the plaintiff's corset the busks were secured at once by means of the eyes and studs. It was held by the Court that in a design the eye must be the judge, and although in the registered corset there was undoubtedly something new which might have been patented, nevertheless the *appearance* to the eye was not new, but was precisely the same as the old laced-up corset, which indeed it was designed and intended to imitate. Accordingly, Chitty, J., refused the plaintiff's motion for an injunction.

But a patentable invention might be subject-matter for design.

*Moody v. Pace.*

*Cooper v. Symington.*

A design must be judged *from its appearance*, not its uses.

Combination designs.

A new combination of two or more old patterns or designs might form good subject-matter for registration as a new and original design. There is a case under the old Act of 5 & 6 Vict. c. 100—that of *Harrison v. Taylor* ([1850] 20 L. J. Ex. 3; 4 H. & N. 815), decided on appeal from the Court of Exchequer—in which it was held that the plaintiff's design, which related to a species of double honeycomb fabric, was new and original and formed good subject-matter. The design was formed by combining a large honeycomb fabric with a small honeycomb fabric, the small honeycomb fabric serving as a ground upon which the large honeycomb was displayed. Both the large and the small honeycomb patterns were old, but their combination had not been carried out before.

*Harrison v. Taylor.*

But the combination must show some ingenuity.

It is probable that when the combination of old elements to produce a new effect involves the exercise of taste and invention, it would not upset the design to analyse it and show where the different combined elements were obtained. But where the combination is a mere mechanical adding of one old thing to another, not betraying ingenuity in the combination, the result is not so likely to be upheld as novel and original. For example, in the case of *Hathersall v. Moore* ([1891] 9 R. P. C. 27) the plaintiff had registered, as a design for dusters, the combination of an old and well-known border with an equally old and well-known fabric as centre-piece. Bristowe, V.-C., held that this did not constitute a registrable design, and dismissed the action with costs.

*Hathersall v. Moore.*

Small change in combination design.

In *Rollason's Design* ([1898] 15 R. P. C. 441) the finding of the House of Lords was practically, from the nature of the evidence and the anticipatory matter, a finding that the result of a combination of old features, even although the combination itself is not strikingly new, may be a novel design; and in *Birrell v. Grimshaw* ([1894] 11 R. P. C. 351) a combination of a bassinette and mailcart was held to be a good registrable design.

Mere slight changes in style and

In *Le May v. Welch* ([1884] 28 Ch. D. 24; 54 L. J. Ch. 279), a registered design of a collar contained three characteristics

which it was admitted had *separately* appeared in collars prior to the date of the plaintiff's registration. The combination was considered too narrow and trifling to constitute a new design, and in the Court of Appeal Lord Justice Bowen, in delivering his judgment, very properly drew attention to one of the reasons of the Court for declining to maintain the validity of such a registration. "We must not," said his lordship, "allow industry to be oppressed. It is not every mere difference of cut, every change of outline, every change of length or breadth or configuration, in a simple and familiar article of dress like this, which constitutes novelty of design. To hold that would be to paralyse industry, and make the Patents, Designs, and Trade Marks Acts a trap to catch honest traders."

Shape of common article not subject-matter. *Le May v. Welch.*

In the last case quoted, not only the fitness or unfitness of a combination design as subject-matter for registration, but also the amount of invention or fancy displayed, was inferentially considered. As Lord Justice Bowen said, "there must be a substantial novelty in the design, having regard to the nature of the article." Thus, in *Smith v. Hope Bros.* (1889) 6 R. P. C. 200), the plaintiff had registered a design for application to a scarf. At the hearing it became apparent that the sole advance upon what was acknowledged to be an old shape of scarf was the introduction of one or two folds or pleats in the body of the scarf. Mr. Justice Stirling dismissed the plaintiff's motion for injunction with costs, and directed that the design should be struck from the Register. The learned Judge referred to the case of *Le May v. Welch (supra)*, and quoted with approval the remarks of Lord Justices Baggallay and Bowen. It should, however, be mentioned here that, just as the commercial success of an apparently obvious or simple invention has been considered an additional reason for maintaining a somewhat doubtful patent, so the commercial success of a registered design has been allowed to weigh with the Court in upholding the registration, even where the subject-matter has been somewhat narrow. In *Tyler v. Sharpe* (1893) 11 R. P. C. 35) Romer, J., in upholding

Some invention must be apparent.

*Smith v. Hope Bros.*

Commercial success may help to sustain design.

the plaintiff's design of a water-closet basin, said that, although the design was somewhat slight, he could not help being favourably impressed by the immediate popularity and large sale of the article to which the design was applied.

The question of what constitutes good subject-matter for registration as a design would be incomplete without a reference to the adaptation of existing and well-known things, such as famous objects or buildings, to the purposes of design, as applied to manufactured goods. It seems only reasonable to suppose that if someone adapts a view or picture of some thing, or some personality, whether it be a flower or landscape, a building, or a statesman, and applies that representation or picture to some article of manufacture, he should be allowed to register it as a new design, and should be protected in such a specific adaptation. His right may perhaps be open to cavil if the representation he made use of was common and well known, such as a well-known photograph or engraving, although even this might not affect his right. But suppose the particular representation or view he uses is one produced or procured by himself, it might be asked why such adaptation should not be fit subject-matter for registration as a design for application to certain specified manufactured goods, according to the Act. It used to be said, in text-books upon the subject of designs copyright, that the copy of a photograph of a well-known public character applied to manufactured objects is not a new or original design within the meaning of the Act. The decision upon which this assertion is based occurred in the case of *Adams v. Clementson* ([1879] 12 Ch. D. 714). But this case turned on the old Act of 5 & 6 Vict. c. 100, Section 3, which is differently worded from the corresponding sections of the Act of 1883, and it has been thought by a high authority (Lindley, L. J., in *Saunders v. Wiel* [1892], 10 R. P. C. 29) that the variation in the language of the Act of 1883 was influenced or caused by this very decision of *Adams v. Clementson*. In the latter case the dispute was between two earthenware manufacturers, the plaintiff, Adams, seeking to restrain

Adaptation of well-known objects and personages as subject-matter for designs.

*Adams v. Clementson.* Portrait on earthenware.

*Saunders v. Wiel.* Westminster Abbey spoon handles.

the defendant by injunction from infringing the plaintiff's registered design which he applied to plates and other articles of earthenware. The design consisted of a portrait of General Martinez de Campos, copied from a photograph which had been sent to the plaintiff from Cuba. The defendant had received a similar photograph and was applying it to similar goods. In both cases the goods were produced almost entirely for export to Cuba.

Vice-Chancellor Malins decided that this was not fit subject-matter for a registrable design, because the plaintiff had simply taken the photograph and copied it, and the defendant had done the same thing. Accordingly the injunction was refused. It is, however, submitted that this decision has since been subjected to such destructive criticism that there is but little fear of its being repeated or having henceforth any weight as a precedent. A more correct interpretation of the law as it now stands is to be found in the case of *Saunders v. Wild (supra)*. Here the plaintiff, a silversmith, had registered in Class 1 a design applicable to the handles of spoons and forks. The design consisted of a view of Westminster Abbey, modelled in relief on the spoon or fork handle. The nature of the design as stated in the application was for the "pattern and shape of spoon or fork handle in metal." The defendants had infringed, and, relying in their defence upon the decision in *Adams v. Clementson*, contended that the design was not one that could be registered. Cave, J., dissented from the judgment in *Adams v. Clementson*, and held that the design was proper subject-matter for registration, and that the defendants had infringed.

A modelled view of Westminster Abbey on spoon handle held good subject-matter.

In the Court of Appeal the decision of the Lower Court was upheld, and the adverse remarks of Cave, J., upon the decision in *Adams v. Clementson* were strongly endorsed by Lindley and Bowen, L. JJ. As was said by Lindley, L. J.: "What we have to consider is this: whether this registered design—for a design of some sort of course it is—is a design applicable for the pattern and for the shape to things in Class 1, and in particular forks and spoons, and whether it is a new or original design not previously published in the United Kingdom. Now

Lindley, L. J., on new and original designs.

why is it not? Has such a design applicable to metals ever been seen before? If you ask that question you are told this—'Yes, if you mean by design, public buildings, or if you mean cathedrals and churches, they are common enough'; therefore there is no novelty in the idea. But if you ask a little closer whether anybody has previously taken this particular aspect of Westminster Abbey and used it as a design applicable to things in Class I or to any things like it, the answer is, 'No, that is new and never has been published before.' That answer seems to me to bring the plaintiff's case within the Act of Parliament."

More substitution of one material for another in the same article does not make it a new design.

It has also been laid down that the mere substitution of one material for another, where the object is the same and to be used for a similar purpose, does not constitute a registrable new design. Thus in *re Bach's Design* (1880) 6 R. P. C. 370) Bach registered, in Class 4, a fairy lamp-shade produced in the form of a rose and made of vitreous material. It was shown that lamp-shades of a similar design, but made of linen, had been manufactured and sold prior to the registration of Bach's design, and as a result the motion to expunge the design was successful.

Analogous application of old thing bad.

In *Clarke's Design* ([1896] 13 R. P. C. 351) it was held that a design applicable for shape, consisting of two parts, which in conjunction with another part were old, for the purpose of an oil or gas lamp, was not a novel or original design for an electric lamp.

But a new design incorporating an old one may be good.

According to Lord Herschell, in *Harper & Co. v. Wright & Butler* ([1895] 12 R. P. C., at page 401), a design founded upon and even incorporating the whole or part of a previous design is good in its totality.

Slightness of change to constitute subject-matter.

How slight a change may constitute a well-known article subject-matter for a registrable design might be instanced in *Waller v. Nedl* (1892) 9 R. P. C. 482), where the mere rounding of the edges of a well-known oil-can constituted the subject-matter of the design. In *Rollason's Design* (1898) 15 R. P. C. 411), the collin plates in respect of which registration had been effected, were exceedingly similar to alleged anticipations both in shape and in ornament. The alleged distinctive feature of Rollason's plates viz., the

Drawing not conclusive as

sunk central flat portions, could not be said to appear in the drawings as sunk. But the House of Lords, having satisfied themselves of the proprietor's intentions, held that there was subject-matter, and sustained the registration. It seems, therefore, that very little difference of appearance will suffice to uphold a registered design. As was said by Lord Herschell in *Rollason's* Case: "Very often a very successful design may be one in which the difference from previous designs can, on analysis, be shown to be very slight, where, nevertheless, the result is to make the one so much more pleasing than the other that it is a successful design. Whilst on the one hand we certainly ought not to give protection to a design in which the variations are trivial and unimportant so that it is substantially the same design as one already registered, on the other hand we ought not to refuse it where the design is practically a different one, which may be more attractive." to form of design.

Another case in which the filed drawing did not seem a fair guide to the section of presser-bar actually claimed by the proprietor occurred in *Varley v. Keighley Iron Works, Limited* ([1896] 14 R. P. C. 169): but here also the plaintiff succeeded. It seems advisable in cases such as those of *Rollason* and of *Varley* that details should be given in the drawing of any point left in doubt by the main illustration.

# CHAPTER V.

## NOVELTY.

Design must be new or original.

ACCORDING to Section 47 of the Act, a design to be capable of registration must be "a new or original design not previously published in the United Kingdom." The words "new or original" mean, according to Fry, L. J., in *Le May v. Welch* ([1884] 28 Ch. D. 24), that "the design must either be substantially novel or substantially original, having regard to the nature and character of the subject-matter to which it is to be applied." Or as was said by Lindley, L. J., in *Clarke's Design* ([1896] 13 R. P. C. 351)—

Must be new with reference to the goods to which it is applied.

"The design must be new or original with reference to the kind of article for which it is registered. . . . A design may be new for a coal-scuttle but not for a bonnet. On the other hand a design for a shade of a gas-lamp can hardly be new if it was old for an oil-lamp." *Per* Chitty, L. J., in *Rollason's Design* ([1897] 14 R. P. C. 909):

Distinction between "new" and "original."

"There is a distinction between the words 'new' and 'original.' Every design which is original is new, but every design which is new is not necessarily original." Mr. Justice Manisty, in *Sherwood v. Decorative Tile Co.* ([1887] 4 R. P. C. 207), speaks of a new arrangement of well-known parts as constituting a "new" design, but not what the Act of Parliament means by an "original" design. It is questionable, however, whether the Legislature meant as much as they are credited with by the learned Judges mentioned, since in Section 61 the words used are new *and* original.

Novelty considered with reference to state of prior knowledge.

Novelty in a design must always be considered with relation to the state of knowledge at the date of registration. Thus, in *Morton's Design* ([1900] 17 R. P. C. 117), where the registered design related to the shank of a cuff-link, the state of knowledge as evidenced by prior examples of shanks, and by similar shanks appearing in prior patent specifications, caused the Court to decide that the design was not new or original.

Not generally new if registered in other class.

A registered design cannot be maintained as new and original if a similar design has previously been registered in a different class for substantially the same purpose (*Read & Cresswell's Design* [1889], 6 R. P. C. 471), and the same was held in *Burch's Design* ([1889] 6 R. P. C. 376), and in *Plackett's Design* ([1892] 9 R. P. C. 436). But this is, generally speaking, only the case where the registrations although in different classes are for application to the same or substantially the same articles. Thus although it was shown that the moulding on the registered design of fire-door in *Walker v. Falkirk Iron Co.* ([1887] 4 R. P. C. 390) was old in furniture and doors for other purposes, that was held not to destroy the validity and novelty of the registered design. In other words a design may be old in fire-irons and yet new in scarf-pins, or old in cathedrals but new in spoons (see *Saunders v. Wiel* in last chapter). But a design old in an oil-lamp cannot be new simply because it is applied to a gas-lamp (*Clarke's Design, supra*).

Design old in furniture may be new in a kitchen range.

Where a design has been freely exhibited and sold prior to registration, of course novelty has been destroyed and cannot be revived. But there are many instances where a species of *quasi*-disclosure has taken place, in respect of which the question has to be debated whether or not such disclosure amounts to publication. Confidential disclosure to a partner, servant, agent, customer, or friend, for the purpose of obtaining an opinion on the merits of a design, is not publication, so long as it goes no further, and so long as actual business is not done in the goods bearing the design.

Novelty destroyed by prior exhibition.

Confidential disclosure.

In *Heinrichs v. Bastendorff* ([1893] 10 R. P. C. 160) the defendant pleaded that a sample of the writing-table which embodied the design had, before registration, been submitted by the plaintiff to a customer, who had altered and returned it. It was held by Day, J., that this did not constitute publication. But where, as in *Blank v. Footman* ([1888] 5 R. P. C. 653), the inventor of a new lace design had shown and handed a sample of the lace to his agent, and the agent had in turn shown the sample in an alleged confidential manner to two selected customers, who gave orders and kept cuttings from the lace, it was held that

Disclosure for the purpose of doing business destroys novelty.

publication had taken place. It would seem that the mere confidential exhibition of the lace to the three indicated persons would not of itself have constituted publication, but the concluding of an order, and the leaving of the cuttings or samples in the customers' hands, went beyond mere confidential disclosure. Almost the same circumstances caused the registered design to be upset in the older case of *Hunt v. Stevens* (W. N. 1878, 79). An examination of the report of the more recent and very similar case of *Wingfield v. Smoor* ([1890] 8 R. P. C. 15), and a consideration of the remarks of Hawkins, J., will also help to show how far confidential communication of this description may go without constituting publication. In *re Sherwood's Design* ([1892] 9 R. P. C. 268) the proprietor of the design supplied a customer with two globes in accordance with the design three days before registration was effected. There was a slight difference between the design of globe as registered and the globes as supplied: but it was held that publication had taken place, and the design was ordered to be expunged from the Register.

Premature sale of articles in accordance with design destroys novelty.

Public exhibition.

In *Smoot v. Shoemaker* ([1890] 7 R. P. C. 90) a registered design of a fire-screen was ordered to be expunged from the Register upon proof that fire-screens identical in design had been publicly exhibited and sold prior to registration.

Publication by book or specification.

In addition to anticipation by prior user, or sale, or exhibition, or prior registration, a design might be anticipated by prior publication in the United Kingdom by means of a book, or specification, or pamphlet, or newspaper. The principle is precisely the same as that which holds good with reference to prior publication of patented inventions by such means, and the reader is referred to the division of this book on Patents and to the chapter which deals with prior publication.

Substitution of one material for another.

It has already been laid down that the mere substitution of one material for another, where the object is the same and to be used for a similar purpose, does not constitute a registrable new design. Thus, in *re Bach's Design* ([1889] 6 R. P. C. 376), Bach registered, in Class 4, a fairy lamp-shade produced in the form of a rose and made of vitreous material. It was shown that lamp-shades of a

similar design, but made of linen, had been manufactured and sold prior to the registration of Bach's design, and as a result the motion to expunge the design was successful.

Publication in one class will destroy novelty in another class.

The same design may be registered in more than one class; but a design already registered in one class, and put on the market and made public, cannot afterwards be properly registered in another kindred class as a new design. In *Hollersall v. Moore* (*supra*) the plaintiff had registered his design in Class 13 instead of in Class 14, which was the proper class. His after-registration in Class 14 was held not to retrieve his error, and the registration in Class 14 was held invalid from publication, although such publication took place after registration in Class 13.

Query whether registration *per se* is anticipation.

It has not been decided whether registration *per se* without publication would constitute anticipation. The point was raised but not decided in *Read and Dresswell's Design* (1889) 6 R. P. C. 471). In the writer's opinion registration alone, and without publication, would not constitute anticipation.

# CHAPTER VI.

## MARKING THE GOODS.

Goods must be marked.

SECTION 51 of the Act provides that before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark or with the prescribed word or words or figures denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Specified markings.

In pursuance of this section, the Board of Trade Rules under the Act provide that all goods in Classes 1 to 12 shall during the period of copyright bear the abbreviation "RD" and (except in the case of lace) the number appearing on the certificate of registration. All goods in Classes 13 and 14 (printed or woven designs on textile piece goods and on handkerchiefs and shawls) shall be marked "REGD" without the number.

Object of marking.

The object of the section being to protect the unwary by making it plain what goods are and what are not registered, a slight deviation from the strict letter of the Rules will not matter, so long as the goods are marked so as to make it plainly apparent that they are registered. In *Heinrichs v. Bostendorff* ([1893] 10 R. P. C. 160) the plaintiff had marked his tables "REGD" instead of "RD". The defendant pleaded that registration was invalid on that account, but Day, J., brushed this contention aside, saying, "I am of opinion that does not vitiate registration at all." It is better, however, to adhere strictly to the Rules.

Made-up goods may be marked in bulk.

When it is impossible or inconvenient to place the mark actually on the goods, it may be placed on the case, or wrapping, or card. In *Blank v. Footmann* ([1888] 5 R. P. C. 653) Kekewich, J., decided that the plaintiff had complied sufficiently with the Act in marking his trimming, when made up in bundles, with the abbreviation "RD" and the number, printed on a paper band surrounding the goods.

Consequences of failure to mark.

But failure to mark the goods at all will undoubtedly (unless the proprietor can show a very strong case) vitiate registration, and the same may be said where the failure is only partial. For example, should a dozen dusters of a registered design be woven in a piece of, say, twelve dusters, it would not be sufficient to affix the mark "REGD" to the piece alone, since that would be marking one only of the twelve dusters comprising the piece. When the piece is cut up, eleven dusters would go forth to the public, perhaps in different directions, without any indication of the design having been registered. This was held, *inter alia*, to vitiate registration in *Hathersall v. Moore* ([1891] 9 R. P. C. 27).

Relief in case of inadvertence.

It will be noted that Section 51 concludes with a saving clause, giving relief in case of error if the proprietor can show that he took all proper steps to ensure the marking of the articles. Thus mere inadvertence or blundering on the part of those over whom the proprietor of the design had no immediate control will not necessarily vitiate the registration of the design.

*Per* Lord Herschell—if the public is properly warned of registration that is the main thing.

As was said by Lord Herschell in *Rollason's Design* ([1898] 15 R. P. C. 441): "The section, by its concluding words, leaves an opening to prevent the operation of the section in full stringency, because it provides that the copyright shall not cease if all proper steps have been taken by the proprietor to ensure the marking of the article. In interpreting these concluding words, I think it is necessary to bear in mind the object of the section and to take into account too what the nature of the omission is. The object of the section, as stated in plain terms, is to 'denote that the design is registered': that is to say, to give warning to the public that they are not entitled to copy it by reason of registration. Of course, if there is nothing to give that notice to the public the proprietor would need to make out a very strong case to excuse himself under the concluding words of the section, because he has failed to do that which was essential to the very purpose of the provision contained in the section: namely—to denote to the public that the design was a registered one. Even in that case he might escape the loss of his design by making out a case which would show that it was not due to any fault of his."

Wrong number excused.

In the case of *Bollaert's Design* the registered number had been wrongly stamped on certain of the cutlin plates as No. 252,905 instead of No. 252,905, the mistake having originated in the stamping die, which had been examined and approved in error by the plaintiff. Nevertheless he was held excused and the registration sustained.

In *Harper v. Wright* ([1895] 12 R. P. C. 483) the owner put the wrong registered numbers on the articles in addition to the right numbers, but this was held not to vitiate his registration.

Old number used by mistake.

In *Ullmann v. Oppenheim* ([1894] 27 Ch. D. 260), a manufacturer employed by the proprietor of a design to make the articles for him, and to whom the proprietor had supplied a correct stamping die, used by mistake an old die, which related to an expired design of the same proprietor. Several articles were sold before the proprietor detected the blunder, but it was held that this did not vitiate his registration, it having been made apparent that he had done all in his power to ensure the correct marking of the articles. The question of what constitutes the taking of "all proper steps to ensure the marking" was also considered in the more recent case of *Johnson v. Bailey* ([1893] 11 R. P. C. 21), in which a manufacturer who had registered the design of a teapot, and had prepared moulds and given his workmen injunctions to see that each pot was properly marked, lost his copyright because the workmen allowed the mould to become so worn that the registration mark on the goods was illegible. The Lord Ordinary (Low) decided that such general instructions as the plaintiff had given, when not followed up by personal supervision, did not constitute the taking of "all proper steps to ensure the marking."

Proprietor must take all proper steps to ensure marking.

Marking the wrong part in an article.

In the still more recent case of *Morton's Design* ([1900] 17 R. P. C. 117) the registered design applied to the shank of a cuff-link. Instead of marking the shank, the proprietor marked the plate of the link. As Farwell, J., pointed out, there was a double misleading in such marking. Not only were the public not informed of what was registered, but they were invited to believe that something was protected which really was not. On these grounds, *inter alia*, registration was cancelled.

Sale of goods unmarked destroys copyright.

The articles are to be marked "before delivery on sale" by the proprietor or, as was decided in *Wedekind v. General Electric Co., Limited* ([1897] 14 R. P. C. 190), by his lawfully authorised agents. In the case referred to, the sale of at least one unmarked telephone transmitter was proved and the action dismissed. The sale of one unmarked article only destroyed the copyright in the older case of *Hunt v. Stevens* (1878 W. N. 70).

Sale of goods unmarked in unfinished state.

In *Woolley v. Broad* ([1892] 9 R. P. C. 429) the sale of lace protected by design registration when the lace was in the brown or unfinished state—without any registration mark, was held to destroy the copyright, although it was shown that the further treatment of the lace by the "finishing" firm to whom it was sold must have destroyed the registration mark.

Marking separable parts of article.

In a case under the old Act (*Fielding v. Hurley* [1883], 48 L. T. N. S. 638) where the design related to a butter-dish consisting of dish and cover, the dish only was marked, but it was held that this satisfied the Act, the dish and cover together being one article.

Samples.

Mere patterns of the registered goods if not sold need not be marked.

Penalty for describing an article as "registered."

It is an offence under the Act (Section 105) to describe an article as "registered" where no registration has been effected. A person is deemed to represent a design as registered if he sells the article bearing any word or mark expressing or implying that registration has been obtained. The penalty for such misrepresentation is that the offender is liable for each offence on summary conviction to a fine not exceeding £5.

Even if sold outside of the limits of the United Kingdom, goods to which a registered design is applied must be marked (*Sorazin v. Hamell* [1883], 7 L. T. N. S. 660), otherwise the copyright will be lost.

# CHAPTER VII.

## ACTION FOR INFRINGEMENT.

No Common Law right in designs.

THERE is no Common Law right in designs such as may exist in unregistered Common law trade marks or trade names. The right to sue for the infringement of a design rests only in the registered proprietor of the copyright. Legal proceedings in respect of designs are governed chiefly by Sections 58 and 59 of the Act.

Section 58.

Section 58 of the Act provides that during the existence of copyright in any design—

Unlawful for any unauthorised person to apply design.

(*a*) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply or cause to be applied such design, or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale, to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural; and

Unlawful to sell articles having design wrongfully applied.

(*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.

Penalties.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction, provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.

This section is a repetition substantially of Section 7 of the Act of 1842.

Differences between Clauses (*a*) and (*b*).

Clause (*a*) is evidently aimed at the manufacturer or producer of the goods, while Clause (*b*) seems to deal with the seller. It is not under Clause (*a*) necessary to bring home to the manufacturer knowledge of the

existence or registration of the design. It is enough that he applies it or causes it to be applied. But under Clause (*b*) the seller or retailer is only liable if he sells articles bearing the design, knowing that it has been applied without the proprietor's consent.

What constitutes an infringement.

As to what constitutes an infringement, it was said by Lord Westbury, in *Holdsworth v. Mc'ean* (1867, L. R. 2 H. L. 380), that "the appeal is to the eye, and the eye alone is the judge of the identity of the two things"; and by Lord Herschell, in *Hecla Foundry Co. v. Walker* (1889, 6 R. P. C. 554), that the eye is the test, and that the question should be determined by placing the designs side by side and asking whether they were the same, or the one an obvious imitation of the other, taking into account the state of knowledge at the time, and in what respects the registered design was new and original, when considering whether variations from the registered design were substantial or not. The same test was proposed to be applied in *Hollicrsall v. Moore* (1891, 9 R. P. C. 27), and it may safely be said that this test furnishes the means for deciding nine-tenths of all design actions brought into Court.

Test of the eye.

In *Mc'ean v. Holdsworth* (1870, L. R. 6 Ch. 418), and in *Oliver v. Thornley* (1896, 13 R. P. C. 480) it was held that to establish infringement it was not necessary that an exact copy should have been made by the defendant. If the appearance is strikingly similar to that of the registered goods that is enough. In *Harper v. Wright* (1895, 12 R. P. C. 433) the design of a stove, the ornament of which was Gothic in style, had been registered. The defendant's stove, although different in detail and even in style, was nevertheless so similar in general appearance to the plaintiff's that it was held to be an "obvious imitation." But it is of course not competent to register any particular *style* of ornament, and, as Lord Herschell said in *Harper v. Wright* (*supra*), if the whole point of the design consists merely of a cathedral window of a particular kind, a design consisting of a cathedral window of another kind would not infringe.

Need not be an exact copy.

General resemblance may constitute infringement.

An obvious and fraudulent imitation might be created, and the inference that it was so would be largely augmented.

Obvious and fraudulent imitation.

*Gaetano v. Watson, Harper v. Wright.*

where the defendant had instructed his designer to work as closely to the plaintiff's design as possible, and so as to produce the general effect without imitating the details (*Gaetano v. Watson* 1881, 51 L. T. N. S. 141; see also *Harper v. Wright, supra*). But it would scarcely be a profitable digression to enter upon a general discussion as to what would constitute a "fraudulent" or an "obvious" imitation of a registered design. As has already been said, the eye is in the main the judge as to what is and what is not an "obvious" imitation, and the circumstances of each case might be examined to determine whether it was also a "fraudulent" imitation. It is conceivable that a design might be held to be an obvious imitation of a registered design, even although in arrangement and detail it is, when narrowly inspected, different, so long as the general effect is the same. A *fortiori*, the defendant will not be allowed to shelter himself behind trifling distinctions and variations from the registered design.

Mamisty, J., on "obvious" and "fraudulent" imitations. *Sherwood v. Ivimatic Tile Co.*

In *Sherwood v. Ivimatic Tile Co.* (1887, 4 R. P. C. 207), Mamisty, J., says: "Upon the question of *obvious* imitation, you must to a great extent (I do not say entirely) be guided by the eye." And again the same learned Judge remarks: "It may not be easy—I do not say it is impossible—to define in words exactly what is meant by a *fraudulent* imitation. I think the word was introduced for the very purpose of meeting the case of an imitation, not an *obvious* imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud. For instance, having before your mind and before your eye the design of another, and introducing into your design some differences, in order if possible to avoid coming within the Act of Parliament."

In the case last quoted the same Judge came to the conclusion that the defendants' design, although not an "obvious," was on the other hand a "fraudulent," imitation.

If manufacturer has applied the design he is liable.

As has already been pointed out, the mere fact of applying or causing to be applied the registered design without the consent of the proprietor, renders the manufacturer of the goods liable to an action.

But Section 58 provides a

The case is, however, different with the retailer of the goods, and to succeed the plaintiff must show that the

defendant know that the design had been applied without the consent of the registered proprietor. To apprise him of this knowledge the proper course is to serve him with a notice which should show the defendant distinctly and intelligibly that the design had been applied without the plaintiff's consent (*Norton v. Nicholls*, 1858, 1 E. & E. 765, 28 L. J. Q. B. 225; *Smith v. Roberts*, 1888, 5 R. P. C. 611). A mere general notice that the retailer is selling goods with a registered design applied, but giving no details, is not a sufficient notice (*Smith v. Roberts, supra*). In the latter case, where the defendants after insufficient notice stopped the sale of goods of the class complained of and immediately upon an inspection of the plaintiffs' design returned all goods to the manufacturer, it was held there was no cause of action, and the case was dismissed with costs. In the course of his judgment, in *Smith v. Roberts*, Bristowe, V.-C., said: "I think that the intention of the Act, Section 58, Sub-section (*b*), is to protect a retail dealer, or dealer selling goods and not being himself the manufacturer of them, from pains and penalties in respect of that which he does not himself know; and if the retail dealer is selling goods as to which he has no knowledge that there is any registration, he is doing that which is no wrong; the wrong is in doing it after having knowledge brought home to him that protection by registration has been given to the goods which he is seeking to sell." In this action it was held that the defendants had not sold with knowledge that the designs were registered, and that there was no intention to sell after acquiring such knowledge. The action was accordingly dismissed, with costs against the plaintiff.

Refuge for innocent retailer.

Sufficiency of notice to retailer.

Intention of the section is to protect innocent retailer. *Smith v. Roberts.*

In the case of *Sherwood v. Ornamental Tile Co.* ([1887] 4 R. P. C. 207), where the sale of one hundred infringing tiles was proved, a penalty of £50 was imposed, although under the Act as it then stood a penalty of £5000 might have been adjudged. In view of this and similar cases, to prevent the possibility of ruinous penalties being imposed, in the amending Act of 1888 the total amount of penalties to be forfeited in respect of any one design was limited to a maximum of £100.

Penalties now limited in amount (Act of 1888).

Trumpery actions not encouraged.

In *Jun v. Grossman* (1895, 12 R. P. C. 337), the defendant purchased and resold one or two powder puffs the design of which had been registered by the plaintiff. The first knowledge he had of the registration of the design was imparted to him over the counter by the plaintiff, whereupon he withdrew the puff which remained in his shop window. He also promised to sell no more, but declined to give a formal undertaking to that effect. On summons for judgment under Order 32, Rule 6, the action was dismissed with costs. Kekewich, J., called it a useless and trumpery action.

Manufactured goods subject to expiry of registration.

Goods having the design applied during the currency of registration, and stored up to await the expiry of registration before being put on the market, may be made the subject of an injunction, and delivery up, and destruction may be ordered (*Metton v. Haldsworth*, 1818, 2 De G. & Sm. 4901).

Penalty recoverable as simple contract debt.

Under the old Act of 1842, the penalty for piracy of a registered design was recoverable by action or by summary proceeding before a magistrate or justices of the peace. But by Section 58 of the present Act, the penalty is recoverable as a simple contract debt in any Court of competent jurisdiction. Thus the plaintiff might sue in the High Court, or if his claim does not exceed £50 in the County Court. Where an injunction is sought or where there is a question of applying to rectify the Register by expunging a design, the Chancery Division would be the

Injunction.

Jury.

most convenient. If trial by jury is desired, or the action is for damages, as under Section 58, the King's Bench Division is more suitable.

Persons entitled to sue for infringement.

The registered proprietor is the person entitled to sue: that is to say, any person properly on the Register within the classification set forth in Section 61—viz., the author; the person on behalf of whom the design was made for a consideration; the assignee of the whole or a part; the holder of a licence, either exclusive or non-exclusive, to *apply* the design and on the Register of Proprietors; or the personal representative of the deceased or bankrupt proprietor.

Licensee to apply the design.

Licensee to apply design must be in writing

Previous designs must be similar to practice in patent actions.

The defendant.

Endorsement of writ.

Damages in lieu of penalties (Section 38).

Therefore although a licensee alone under a patent cannot sue in respect of infringements, although notice of his license is on the Register, a licensee to apply the design but not merely to sell articles under the design) has a right to be put on the Register as "proprietor" within the meaning of Section 61, and can therefore alone or together with his co-proprietors sue for infringement. But the license must be in writing (*Averill v. Lockwood*, 1878, L. R. 8 Ch. D. 166) and the licensee on the Register; otherwise he has no cause of action (*Woolley v. Broad* 1892, 9 R. P. C. 205).

In *Morris Wilson v. Coventry Machinists' Co.*, 1911, 8 R. P. C. 353, North, J., held that it was "a convenient rule that the course of proceedings adopted for patent actions should be followed as regards actions for infringement of registered designs." That rule is now generally followed, and in respect of certain points that will be noted, the procedure in a Design action is the same as that in a Patent action.

The defendant must be (a) the person who has applied or caused to be applied the design to goods in the class for which the design was registered, for purposes of sale; or (b) the person who exposes such goods for sale, knowing that the design has been applied without the proprietor's consent. The preceding portion of this chapter deals with the notice to be given to anyone who is or may be an innocent infringer.

The writ alleging infringement should be endorsed with a claim for

(a) The penalties against the defendant for infringement of the plaintiff's registered design;

(b) An injunction to restrain the defendant, his servants and agents from infringing the design; and

(c) Delivery up or destruction of all articles in the possession or under the control of the defendant.

In the event of the plaintiff electing not to proceed for penalties, he may, in lieu of the penalties, claim damages

for the infringement of his design, under Section 59. But he must not claim both damages and penalties (*Saunders v. Wiel* [1892], 9 R. P. C. 459). It should be noted that the same case decides that when penalties are claimed, interrogatories tending to show that the defendant was liable to such penalties cannot be administered.

Interrogatories in penalty action.

Statement of claim.

The statement of claim should recite—

(*a*) That the plaintiff is the registered legal proprietor of a design No. , registered on the day of , 19 , in Class , for application to (*specify goods*);

(*b*) That the defendant has since the said date of registration wrongfully and without the licence or written consent of the plaintiff applied or caused to be applied for the purposes of sale the said design, or an obvious or fraudulent imitation of the same, to goods similar to those in respect of which the design was registered.

The statement of claim should then conclude with substantially a repetition of the claims endorsed on the writ (*supra*).

In the case of a seller of the goods.

If the action is taken against a retailer, the statement under Clause (*b*) should be to the effect that the defendant has, since the date of registration, wrongfully sold and exposed for sale goods to which the said design, or an obvious or fraudulent imitation thereof, has been applied, the defendant knowing that the same has been applied without the consent of the plaintiff.

Procedure similar to that in patent actions.

Mr. Justice North having given it as his opinion in *Morris Wilson v. Coventry Machinists' Co.* ([1891] 8 R. P. C. 353), that proceedings in Patent actions should be regarded as the model upon which to regulate Designs actions, it is advisable that the statement of claim should be accompanied by particulars of breaches giving, if possible, all known or ascertained instances of infringement, with names, places, and dates. There is no specific obligation under the Statute to give such particulars, but under Order 19, Rule 7, of the Rules of the Supreme Court, they may be ordered, and as a rule they are given.

Particulars of breaches.

Defence.

In his defence the defendant should, in addition to denial of infringement, state everything that will assist him to rebut the plaintiff's claim, as for instance—

(*a*) That the defendant does not admit that the plaintiff is the registered proprietor of the design set forth by number and date in the statement of claim, or that the design was ever so registered; or, in the alternative, if such registration has been effected, the defendant denies that the plaintiff was entitled to register the said design in such class or at all.

(*b*) That the said design was not fit subject-matter for registration, and was not new or original, and that any copyright, registration, or protection alleged to have been obtained for the same is invalid and of no force and effect.

(*c*) That the design was published prior to the date of registration.

(*d*) That since the date of the alleged registration the plaintiff has sold or delivered on sale articles to which the alleged registered design was applied, without being marked, in accordance with Section 51 of The Patents, Designs, and Trade Marks Act, 1883, with the prescribed mark, words, or figures, denoting that the design was registered, or wrongly or insufficiently so marked, whereby any copyright that may at any time have subsisted in the said design has ceased.

(*e*) If the plaintiff possesses any copyright in the said design (which is denied) the defendant has not infringed.

Defence by retailer.

If the defendant is a retailer, a further paragraph should be to the effect that the defendant has not wrongfully sold and exposed for sale any goods to which the plaintiff's alleged registered design has been applied; or, in the alternative, if the defendant has done so, he did it without knowing that the design had been so applied without the consent of the plaintiff.

Defendant's particulars of objections.

The defence is preferably to be accompanied by the defendant's particulars of objections. As in the case of the plaintiff's particulars of breaches, particulars of objections are not obligatory under the Statute, but it is better that they should be given. They should set forth in paragraphs any facts or information upon which the defendant may intend to rely, showing for instance—

(*a*) That the plaintiff, or the original registered proprietor, was not the author of the design or had not duly acquired it or the right to enter himself as registered proprietor in any of the manners set forth in Section 61. (If the defendant can state who was the author let him do so.)

(*b*) That the design was not fit subject-matter for registration, and was not new or original, but was similar to, or a copy or substantially a copy of, a design or designs published or used prior to the date of registration by &c. (*here set forth prior publication or user of similar designs with full particulars*).

(*c*) That the design was published prior to the date of registration by &c. (*here set forth all instances of publication by books, prints, specifications, and other matter, and also any instance of prior user*). If it is alleged that the design is of common knowledge, particular instances of prior publication or user need not be given (*Holliday v. Heppenstall* [1890], 6 R. C. P. 320).

(*d*) Any instances of sales of unmarked or insufficiently marked goods made by the plaintiff since registration, if such sales have taken place.

Pages or sheets of drawings in books or publications should be given, and full circumstances of prior user, with dates, names, and addresses.

Summons for further and better particulars.

If the defendant's particulars of objections are thought by the plaintiff to be insufficient, he may apply by summons in chambers for further and better particulars,

and if thought fit, following the analogous practice in Patent cases, such further and better particulars will be ordered.

Particulars may be amended from time to time on terms.

In the event of the defendant desiring to amend his particulars of objections so as to include, for example, some anticipatory matters not cited in the original particulars, he may by summons obtain leave to do so, but the usual terms founded upon similar applications in Patent actions will be imposed—viz., that the plaintiff shall have leave to elect to discontinue, and if he elects so to do that he shall have the costs from the date of the first delivery of the defendant's particulars to the delivery of the amended particulars. This was held in the Designs action of *Morris Wilson v. Coventry Machinists' Co.* ([1891] 8 R. P. C. 353), following the order made in the Patent case of *Edison Telephone Co. v. India Rubber Co.* ([1881] L. R. 17 Ch. D. 137). But the Judge has absolute discretion and may make such an order unconditionally, and his discretion will not be interfered with by the Court of Appeal (*Woolley v. Broad* [1892], 9 R. P. C. 429; *Wilson v. Wilson* [1899], 16 R. P. C. 315).

Judge has absolute discretion.

Anticipations to be relied on must be pleaded.

No alleged anticipation of a registered design can be relied on at the trial unless pleaded (*Waller v. Hecla Foundry Co.* [1887], 5 R. P. C. 71). In *Birell v. Grimshaw* ([1894] 11 R. P. C. 351) the defendants were allowed to give in evidence particulars of an alleged anticipation of which the plaintiffs only had notice a short time before the trial. Day, J., held that sufficient notice had been given, and admitted the evidence, but it would be extremely unsafe to consider this as a precedent.

But this rule might be relaxed.

Order for inspection.

Application for inspection may be made at any time during the course of an action, and in the case of the plaintiff even before delivery of the statement of claim (*Drake v. Muntz Metal Co.* [1886], 3 R. P. C. 43). A defendant may apply at any time after entering appearance (Order L. of the Rules of the Supreme Court, Rule 6). In both cases, as a rule, notice must be given to the opposite party. Applications for such Orders are made in the Chancery Division by motion in Court or summons at chambers; in the King's Bench Division by summons

at chambers (Order LIV. of the Rules of the Supreme Court, Rule 12; Order LV., Rule 15). To obtain an order for inspection the plaintiff must show by affidavit that he has a case to be tried and that inspection is necessary to place the case properly before the Court; otherwise inspection will be refused (*Batley v. Kynoch* 1874–5, L. R. 20 Eq. 632). Mere suspicion will not justify inspection (*Oscar Co. v. Robinson* 1884, 1 R. P. C. 217), nor will the Court order a roving inspection (*Oldham v. Oldham* 1888, 5 R. P. C. 617). As Lord Halsbury, L. C., said in *McDougall v. Purrington* (1890) 7 R. P. C. 472): "The Court is always reluctant to grant inspection where it may be injurious to one side, and where the right depends on a question which has yet to be determined in the cause." Where the party upon whom the Order is sought to be imposed avers that inspection may disclose trade secrets, although this will not prevent the Court from making the Order, precautions may be taken by having the inspection made by some independent person, who will report to the Court, and whose report is private and confidential (*Plating Co. v. Farquharson* 1883, Griff. P. C. 187). Where an Order for inspection has been made the inspectors are usually specified by name, and the notice to be given to the opposite party is also indicated.

More suspicion not enough to justify inspection order.

No order made that may prejudice business of other party.

Where penalties are claimed interrogatories not allowed.

Order XXXI. of the Rules of the Supreme Court deals with the practice in discovery and inspection. As it is the rule that in actions for statutory penalties interrogatories by the plaintiff tending to show that the defendant is liable to such penalties are disallowed, in an action for infringement of a design brought for penalties under Section 58 of the Act interrogatories administered to the defendant need not be answered (*Saunders v. Wild* 1892, 9 R. P. C. 459). It seems, from the remarks of Lord Esher, M. R., in the latter case, that the remedies under Section 58 and 59 are distinct, and the plaintiff must elect under which he is going. In an action for damages under Section 59, apparently interrogatories may be administered.

Practice in administering interrogatories.

Leave must be obtained from the Court or a Judge before interrogatories can be delivered by either party.

and the party interrogating must pay at least £5 into Court before delivery. Application may be made by summons at chambers. As a rule, in the Chancery Division leave is only given to the plaintiff to interrogate after he has delivered his statement of claim, and to the defendant after delivery of his defence.

Limits of interrogatories.

The plaintiff must not seek discovery of the defendant's case, but the defendant may ask anything tending to destroy the plaintiff's claim (*Hoffmann v. Postill* 1870, L. R. 4 Ch. 673). A secretary or other officer answering on behalf of a corporate body need only answer as to information acquired in the course of his employment in the company and not as to information acquired apart from his function (*Welsbach Incandescent Gas Light Co. v. New Sunlight Incandescent Lamp Co.* [1900], 17 R. P. C. 401).

Answers to interrogatories.

When interrogatories are answered, they must be answered by affidavit filed within ten days or such other time as the Judge may allow. They must be answered fully, and everything tending to show the fact of infringement must be set out in the answers.

Interlocutory injunctions.

An interlocutory injunction to restrain infringement may be applied for immediately upon issue or service of the writ. If the evidence of infringement is sufficient to convince the Court, and it is apparent that the plaintiff would suffer seriously from a continuance of the wrong, an interlocutory injunction will be granted, or at all events the defendant will be ordered to keep an account. If the injunction is granted, the plaintiff must give the usual undertaking as to damages. But if the title of the plaintiff is questioned, or the defendant is able to show that he has on any ground a good *primâ facie* defence, or if the plaintiff has been guilty of undue delay or other laches, no interlocutory injunction will issue.

Costs.

In accordance with the ordinary rule, costs in Designs actions will usually follow the event. But, as in Patent cases, this rule may be and often is modified by circumstances. Thus, in *Sherwood v. Doncaster Tile Co.* (1887) 4 R. P. C. 207), where the Court was of opinion that a good deal of the successful plaintiff's evidence was unnecessary and improper, the defendants were ordered to

Judge's discretion as to costs.

pay two thirds only of the plaintiff's costs. And where, as in *Blank v. Footman* (1888) 5 R. P. C. 653), the plaintiffs failed in their action, but succeeded on one issue, they got the costs of that issue. In *Wigfield v. Snow* (1890) 8 R. P. C. 15) only one issue was tried, and the defendants were successful on that, with the result that they got the general costs of the action and of the issue upon which they had succeeded, the costs of the untried issues being reserved. In *Birkin v. Pratt* (1895) 12 R. P. C. 371) an unsuccessful plaintiff got the costs of the issue of want of novelty, the defendant succeeding on the issue of non-infringement.

Costs in the case of an innocent retailer.

*Smith v. Lewis Roberts & Co.*

*Jan v. Grossman.*

The innocent retailer pushed into an action against his will, and after he had done all he could to avert it, usually escapes costs. Thus, in *Smith v. Lewis Roberts & Co.* (1888) 5 R. P. C. 611) it was held that an innocent retailer who had sold in ignorance of the registered design, but who has neither sold nor threatened to sell after notice given, is entitled to have any action brought against him dismissed with costs; and this was also held in *Jan v. Grossman* (1895) 12 R. P. C. 537), although the defendant (an innocent retailer), while promising to sell no more of the goods, declined to give a formal undertaking to that effect.

No statutory provision as to threats.

There is no provision in the Designs portion of the Act giving a remedy in the case of threats of legal proceedings issued by the proprietor of a registered design, such as exists in the Patents portion relative to threats emanating from the proprietor of Letters Patent.

Trade libel.

If the threats in respect of a registered design constitute a trade libel or wrongfully interfere with or prejudice a man in his business he has a remedy at Common Law, but not under the Statute.

Appeal.

Either party may appeal to the Court of Appeal and thence to the House of Lords.

# CHAPTER VIII.

## RECTIFICATION OF THE REGISTER.

The Register of Designs.

SUB-SECTIONS 1 and 2 of Section 55 of The Patents, Designs, and Trade Marks Act, 1883, provides as follows:—

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: and

(2) The Register of Designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

Section 90. Provision for rectifying the Register.

Again, by Section 90, Sub-section 1, it is provided that:—

90. (1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars from any Register kept under this Act, or by any entry made *without* sufficient cause *in* any such Register, make such order for making, expunging, or varying the entry as the Court thinks fit, or the Court may refuse the application, and in either case may make such order with respect to the cost of the proceedings as the Court thinks fit.

The Court.

"The Court" means the High Court of Justice in England, or the Chancery Court of the County Palatine of Lancaster when the registered proprietor is within its jurisdiction. In *Hayes v. Connell & Co.* ([1897] 14 R. P. C. 275) the Irish Court held that it had no jurisdiction to interfere with the Register: but in *Currie v. Herbert* ([1897] 14 R. P. C. 436) the Court of Session in Scotland (Inner House) did not doubt that it possessed such jurisdiction.

Applications to rectify.

Applications to rectify the Register are usually made by motion, and sometimes, but more rarely, by summons, and are generally made on the Chancery side.

Persons entitled to make

The question as to who may be rightly considered a "person aggrieved" within the Statute has already

Application to rectify Register.

Person aggrieved.

Proprietor.

Person aggrieved.

Grounds of application.

been considered in Chapter IV, of the portion of this work devoted to Trade Marks; and practically as concerns Designs the issues are the same. In general terms when a person is hampered in his business, or prevented from engaging in it to the fullest legitimate extent, or when his customers are or may be intimidated or hindered from dealing with him by the existence of a design improperly on the Register, then he is a person aggrieved. He is also a person aggrieved if he is the registered proprietor of a similar design for the same or substantially the same goods, and standing on the Register in priority to the design he complains of. Again, he is a "person aggrieved" if he has been sued for infringement of the design. Once he has attained the *locus standi* of a person aggrieved, he may in his application to rectify the Register use all of the grounds upon which the registration of a design may be cancelled, or in respect of which the original registration might have been refused. For instance, he might contend that the person registered as proprietor is not and never was properly so: *e.g.* that he is neither the author, nor purchaser, nor licensee to apply the design to the manufactured articles. Or he may show that the registration of the design is invalid for want of novelty, or from prior user or publication, or for want of subject-matter; or that goods to which the registered design has been applied have been sold unmarked or improperly marked; or that being a design manufactured and applied abroad it had not been used in this country within six months of its registration here (Section 5 b). With regard to this section it might be asked whether mere importation of the goods from abroad would constitute "use" within the section?

No bona user of design.

Substitution of rightful for wrongful owner on the Register.

It will be remembered that in the Trade Marks portion of this work, it was shown that an applicant to expunge an entry in the Trade Marks Registry, even when he has proved to the satisfaction of the Court that the mark is really his own, cannot successfully include in the terms of his motion a request to have his name substituted for that of the originally wrongfully registered proprietor. The mark must be expunged and the proper owner may then make an application for reregistration on his own

behalf. This practice may be defended on the ground that mere prior publication and prior user, especially when wrongful, does not injure the validity of a trade mark at all. Besides, the owner has his Common law rights to fall back upon, which are non-existent in the case of a design. In a design the prior user and publication by the original wrongful proprietor would be fatal to validity if the design were re-registered by the true owner after ousting the wrongful holder. An assignment from the wrongful proprietor to the true owner would not do, because the title of the assignor would be bad. The only equitable alternative is that the name of the applicant who has proved his right should be substituted for that of the wrongful holder, as specially provided for in the case of patents (see Section 26, Sub-section 8), so as to preserve the validity in the hands of the new owner. This was done in the case of *Green's Design* (1899) 17 R. P. C. 139), the first of its kind. Kekewich, J., and counsel representing the Comptroller, seemed both to be under the impression that had the original registration been fraudulent instead of being inadvertent (as it was in the case cited) it would have been altogether bad, and nothing could have been done but to strike it off. But surely it is a hard saying that the true author is to be placed in a worse position by the fraud of his supplanter than by his inadvertence. However, the writer may be mistaken in this view of the meaning of the Court, and it is but just to point out that in *Heinrich's Design* (1899) 9 R. P. C. 73) the motion was to rectify the Register by striking out Heinrich's name and substituting that of the applicant. The applicant failed to convince the Court that he was the true author of the design, but there seems at no time to have been any question of the admissibility or propriety of the terms of the motion, though fraud was necessarily alleged.

Proprietor supplanted by wrongful registration.

*Heinrich's Design.*

When a change occurs in the name of a registered proprietor, the Register will be correspondingly altered on application to the Comptroller. Formerly it was the practice to apply to the Court for an order directing the Comptroller to make the alteration. But in a New

Power of Comptroller to alter change of name of proprietor on Register.

*Ormonde Cycle Co.'s Mark* (1896) 13 R. P. C. 475), which was the case of a limited company having changed its name, North, J., held that it was not competent for the Court to make any such order under Section 92, but that the Comptroller had power to make the alteration under Section 87. It would therefore seem that no application to the Court is necessary.

Application for entry in Register cannot be made by counter-claim in action.

Following the practice in Trade Marks, an application to rectify the Register of Designs cannot be made the subject-matter of a counter claim in an action for infringement. It must be separately made by motion or summons. When the Comptroller is made a party to the proceedings as is usually the case, he must have four clear days' notice of the application. The registered proprietor should also be made a respondent to the motion if within the jurisdiction. If without the jurisdiction the registered proprietor should be served by letter with a copy of the notice of motion informing him of the day fixed for hearing. For notice to be given in this manner, under such circumstances, the sanction of the Court is not necessary.

If rectification is ordered, the person in whose favour it is made should leave an office copy of the order with the Comptroller, who will make the necessary alteration in the Register.

Appeal.

An appeal lies from any decision of the Court of First Instance to the Court of Appeal and to the House of Lords.

# PART IV.

# FOREIGN AND COLONIAL PATENTS.

## GENERAL REMARKS

(*With a reference to the International Convention*).

Prior publication a bar to grant of patents in other countries.

IT frequently happens that an inventor who has protected or patented his invention in this country desires also to obtain patents abroad. It is necessary, therefore, to point out that certain foreign countries will not grant a valid patent if there has been prior publication in this country or in the particular country in which protection is sought. As a rule, publication may be said to take place when a complete and full description and illustration of the invention has been placed before readers here or in such foreign countries.

Mode of publication.

Therefore, an invention which has been fully described during the period of Provisional Protection in some widely circulated technical paper—such, for example as *The Engineer* or *Engineering*, which papers are as a rule posted immediately upon publication to subscribers in various foreign countries would be considered as published here and in such countries.

Publication of British Complete Specification.

If, however, no such publication has been allowed to take place during Provisional Protection, the publication of the British Complete Specification, which would follow in due course after filing and acceptance, would amount to the same thing. It may be taken for granted that the Patent Office copies of the Complete Specifications are to be seen in most foreign countries of any industrial importance within a short time after publication in London. The British Government presents complete sets of the Patent Office publications to certain British Colonies and Foreign States, including Austria, Belgium, France, Germany, Italy, Japan, Russia, Spain, Sweden, and the

British Specification sent abroad as soon as published.

United States of America. The agents in London, through whom the published specifications are transmitted to the respective countries, call for fresh consignments weekly as a rule, in one or two cases monthly, and the parcel for Austria is despatched on an average about once in six weeks. It appears, therefore, that publication of the Complete Specification here is followed so swiftly by publication abroad that, although of course such publication always remains a matter of proof, it would be, generally speaking, unsafe to delay filing the application in those foreign countries which are affected by publication.

Chief countries where prior publication bars foreign patents.

The chief foreign countries in which (saving the terms of the International Convention) valid patents cannot be obtained after the invention has thus been published are America, Austria, France, Germany, and Switzerland.

In Austria and France, and generally in Switzerland, a patent would be issued to the applicant without objection, even after such publication; but of course, if publication has actually taken place, such a patent would only remain good so long as it was unattacked. In Germany, however, patents are rigidly refused if it can be shown that the British Specification, or, indeed, any description which sufficiently ascertains the invention, was published in Great Britain even a day before the date of application in Germany.

Application should either be made before publication or under the Convention.

It will, therefore, be evident that if valid patents are desired in those countries, application should be made if possible before publication of the invention takes place in England, and certainly before any publication within the States named. As a rule it is sufficient to make application before publication of the Complete Specification in this country.

But an additional factor bearing upon the question of priority of applications for foreign patents by British inventors now falls to be considered. Readers of this work have no doubt heard of the International Convention or Union for the Protection of Industrial Property. This Convention was signed in Paris in 1883, and was acceded to by the British Government on the 17th March, 1884. One of the chief provisions of the Convention was that if

The International Convention of 1883.

a subject of any one of the subscribing countries who had made an application for a patent should make application under the Convention in any of the other countries within seven months of the original application, then these additional applications, based upon the original, would receive the original date, thus obviating the possibly hurtful effects of publication if such had taken place in the interim, and causing the different patents to start from an equal date. But since the conference held under the Convention on the 14th December, 1900, some of the original provisions stand altered. During the existence of the old arrangement certain of the signatories had from time to time proposed modifications of the terms of the Convention of 1883, which had for their objects—

Proposed amendments on the Convention.

(1) The extension of the time within which subjects and citizens of countries members of the Convention might mutually make applications for the protection of patents, trade marks, and designs in countries other than that in which the original application was made so as to secure the original date.

(2) The fixing of a common period of time in all of those countries which require patents to be worked within which patents would not be liable to forfeiture because of non-working.

(3) Regulations as to the registration of trade marks.

(4) Mutual provisions against dishonest competition by fraudulent use of trade marks and trade names.

After a voluminous correspondence, which is to be found set forth at length in the Blue Book containing the papers and correspondence relative to the Conference, published in 1901, price 7½d., the delegates met at Brussels, and the following alterations in the terms of the Convention were agreed to:—

Amendments made at the Convention in 1900.

(1) That the seven months' period of priority for patents be extended to twelve months, and that the three months' period of priority for trade marks and designs be extended to four months.

(2) That patents applied for in the various contracting States by persons admitted to the benefits of the Convention under the terms of Articles II. and III. shall be independent of patents obtained for the same invention in other States, whether parties to the Union or not. In other words, that failure or expiry of a patent in one country shall not affect the corresponding patent in another country.

(3) That the patentee in each country shall not incur forfeiture for non-working until the expiry of a minimum period of three years commencing from the date of the deposit of the application, and not even then if the patentee can give satisfactory reasons for his failure to work.

The foregoing represent the chief alterations in and additions to the terms of the Convention. The text of these, together with that of the minor alterations, will be found consolidated with the original Convention in Appendix A.

Period when amendments come into force.

According to Article III. of the Convention and Protocol, the new terms were to be ratified, and the ratifications deposited at Brussels, within eighteen months from the date of signature (14th December, 1900), and were to come into force within three months after such deposit, this term being fixed to provide for the meeting of the Japanese Parliament. Thus it will be seen that any Power taking full advantage of the possible delay might not come into line till the 14th September, 1902. At the time of writing (December, 1901), Denmark, Switzerland, and the United States of America have executed the necessary ratifications, and it is anticipated that the remaining Powers will do so forthwith.

Present parties to Convention.

The Powers which are at present parties to the Convention are:—Belgium, Brazil, Denmark, Dominican Republic, Spain, United States of America, Great Britain (with New Zealand and Queensland), Italy, Japan, Holland, Portugal, Servia, Sweden, Norway, Switzerland, and Tunis. At the Conference in 1900 the German delegate intimated

that Germany would seek admission to the Union as soon as the ratifications were complete, and similar announcements were made on behalf of Austria and Hungary. Canada is also on the point of adhering to the Convention. With these powerful recruits it seems likely that in a short time every State of any industrial importance will be a member of the Convention. Perhaps such a state of matters may ultimately lead to an International Patent Law.

Extra Convention countries having arrangements with Great Britain.

In addition to the countries actually members of the Convention there are certain countries and colonies with which the British Government has made arrangements for mutual protection of patents, trade marks, and designs under the Patents Acts, 1883–1901. These arrangements derive their terms from those of the Convention, and differ only in this respect, that they are binding only as between this country and the State with which the arrangement may be made. Countries with which such arrangements at present exist are—Paraguay, Uruguay, Mexico, Roumania, Ecuador, Greece (Trade Marks and Designs only), and the Republic of Honduras.

Query: Does Convention override Statutes in adhering countries?

But reverting again to the International Convention, the subject cannot be dismissed without some reference to a defect which at present seriously cripples the usefulness of the Convention. The question is this: Seeing that each country has its own Patent Law, is it clear that the resolutions of the delegates override the various Patent laws of the respective countries without statutory modifications? In the case of Great Britain clearly not, since the Patent Act of 1901 was passed expressly to give effect to the alterations made in the Convention in December, 1900. In the United States the same answer has been officially given (see page 265 of United States Commissioners' Report on the Revision of The Patents and Trade Marks Acts, 1900), with the additional unsatisfactory feature that no modification has yet been made in the Statutes there to meet the terms of the Convention. On the other hand, it cannot be said positively that the Convention does not override the law in those countries in which no declaration to the contrary has been made. For example, in the Appendices to the Report of the

Committee appointed by the Board of Trade to inquire into the working of the Patent Acts, published in Blue Book form (1901), it is stated in a note on page 16, although without any quoted authority, that the International Convention overrides the Statute in France.

Advice on taking advantage of Convention.

On the whole, until the Governments of the different countries which have adhered to the Convention have made satisfactory declarations on this subject, or have recognised the new alterations in and additions to the Convention, by Statute, the writer is of opinion that it would be unsafe to take it for granted that the Convention overrides the Patent Laws of the respective countries, or that inventors should proceed upon the assumption that the new terms of the Convention can be taken advantage of, except with the greatest caution.

Such being the case, the writer has deemed it best, in the succeeding portion of the work, to give a digest of the law and practice in each country without reference to the Convention. The countries which are members of the Convention are distinguished by an asterisk, thus: "Denmark."* Countries with which the British Government has made mutual arrangements outside of but in the terms of the Convention are marked with a dagger, thus: "Honduras."† Other countries remain unmarked.

As a matter of fact, the terms of the Convention have been hitherto but little taken advantage of by British inventors: but undoubtedly the new features lately imported into it confer advantages which applicants cannot afford to despise or overlook.

Examination.

Leaving the Convention and returning to the consideration of the foreign Patent Laws *as they stand alone*, it should be noted that in certain foreign countries, as for example in Germany, Austria, the United States of America, Switzerland, &c., applications for patents are subjected to a stringent examination both as to novelty and patentability, and the results of these examinations, especially in Germany, are sometimes surprising, and not always satisfactory to the inventor.

Durations of foreign patents.

The duration of foreign patents varies with the different countries, but in very few cases is the foreign patent allowed to run for a longer term than the full period of the

original home grant. It may have been seen that one of the objects of the amended Convention is to make the respective patents in the different countries independent of each other.

United States American patents.

A noteworthy and most important exception to the general rule as to the interdependence of patents in the different countries has recently been made in the case of United States patents by the new Act of 1897. Prior to this date the United States patent, which is granted for seventeen years, expired with any prior foreign patent of a shorter term, for the same invention. For example, when founded upon a prior British patent, the United States patent ran only for the remaining portion of the British term of fourteen years, and this is still the case with all patents applied for before 1st January, 1898. But according to the new Act all United States patents founded upon applications filed subsequently to 1st January, 1898, are not limited by any prior foreign patent, and will in all cases remain in force for the full term of seventeen years.

Premature lapsing of foreign patent does not affect United States patents.

So far as relates to United States patents applied for before the 1st January, 1898, and therefore limited by the term of any prior foreign patent which may have been obtained for the same invention, it may be worth noting that at one time it was thought that the premature lapsing of the mother patent in Great Britain or elsewhere, by the nonpayment of the renewal fees for example, also voided the United States patent for the same invention. But the decision of Judge Wallace in *Paillard v. Brown* (38 O. G. 1900), affirmed by the more recent finding of Justice Bradley, of the United States Supreme Court, in *Bate Refrigerating Co. v. Gillett et al.* (140 O. G. 1029), establishes the conclusion that such premature failure of the mother patent does not involve the expiry of the United States patent for the same invention, which will run for the full term of the mother patent, but no longer.

No United States patent can be granted to the inventor upon a previous foreign patent which has expired, from whatever cause, even when such cause has been the mere nonpayment of the taxes. This was established in the United States Supreme Court in 1892 in the case of *Hubner v. Nelson* (63 O. G. 311), the Court deciding that

the delay in applying for the United States patent until after the foreign patent had expired amounted to an abandonment of the right to a United States patent. But the Act of 1897 disposes of this question so far as concerns applications made after 1st January, 1898.

Difficulty in obtaining full term of patent right in all countries.

The differences of duration of patents in different countries suggest that an inventor who had thoroughly made up his mind concerning the world-wide value of his invention, and who was desirous of obtaining the full term of patent right in each country, might elect to secure his patent first in the countries which grant the longest term of all, and next and successively in the countries which grant shorter terms. For example, the first patents might be taken out in Belgium and Spain, which grant twenty years: the next in Canada, which grants eighteen years; the next in the United States, which grants seventeen; the next in France, Germany, Italy, Russia, &c., which grant fifteen: the next in Great Britain and the Colonies, granting fourteen: and after these in countries where the duration of grant would be for a less or uncertain term. It would not be impossible to carry out such a plan, but it is submitted that the suggestion is more theoretically interesting than practically useful, as unavoidable delays in obtaining the issues of the respective patents might either wreck the whole scheme or exhaust the patience of the applicant.

In the event of its turning out or being provided for that the new terms of the Convention are not repugnant to the Statutes of the different countries, the results aimed at above would happen automatically.

In most important foreign countries, with the notable exception of the United States, annual taxes are payable upon existing patents, and certain countries require the patent to be "worked" at intervals or continuously. These and other requirements are, however, so various that it will be safer for the reader to refer to each particular country in the alphabetically arranged digests which follow.

One of the most valuable of the new terms of the Convention is that which provides a common minimum period of three years in all countries, within which no patent is liable to forfeiture for non-working.

NOTE.—*Countries which are members of the International Convention are marked with an asterisk* (*), *and those outside of the Convention, between whom and Great Britain a mutual arrangement exists based on the terms of the Convention, are marked with a dagger* (†). *Other countries are unmarked.*

## ALGERIA.*

Algeria.

This is a French colony, and is covered by the French Patent Law.

## AMERICA* (United States).

America (United States).

(REVISED STATUTES, 1874; TITLE XI. AMENDING ACT, APPROVED 3RD MARCH, 1897.)

*Patentee.*—Anyone, of any age, sex, or nationality, who is the true and first inventor or discoverer, or the executor or administrator of a deceased inventor or discoverer, can obtain a patent. A patent may be issued to the inventor, or to and in the name of an assignee of the inventor, or jointly to the inventor and his assignee, but in all cases the *actual inventor*, or if deceased his executor or administrator, must make the application and sign the papers. When it is desired to issue the patent to the inventor's assignee, or to the inventor jointly with the assignee, an assignment should be filed *before the issue of the patent*, containing a request to that effect. A mere importer who is not the inventor, but who has introduced the invention for the first time from another country, is not entitled to apply for a patent. No official of the Patent Office can obtain a patent.

Patentee.

*Duration of Patent.*—United States patents are granted for seventeen years, and since the recent amending Act of 1897 this term is unvarying. A line of demarkation must, however, be drawn between patents applied for *before* 1st January, 1898, and patents applied for *after* that date.

Duration of patent.

*First.*—As regards patents applied for *before* 1st January, 1898, the Rules under the older Statute hold good, and

America (United States).

such patents are limited by the full term for which any prior mother patent may have been granted for the same invention in another country. Premature lapse of the mother patent, by nonpayment of renewal fees for example, does not affect the United States patent, which runs for the full term for which the mother patent was granted. To have a limiting effect the foreign patent must have been sealed or issued before the issue of the United States patent. It has been decided by the United States Courts that a patent applied for in the United States *after* the date of a British application, and issued *before* the sealing of the British patent, is not limited by the duration of the British patent, notwithstanding that the British patent is dated as of the date of the application and not of the actual sealing (*Emerson v. Lippel*, 1888, 42 O. G. 916).

*Secondly.* As regards patents applied for *after* 1st January, 1898, these are subject to the new Act according to which every United States patent is issued for the term of seventeen years and is unlimited by any prior foreign patent. But this advantage depends on restrictions which the foreign inventor especially must carefully note.

Where a foreign patent is already in existence, no patent for the same invention can be obtained in the United States unless the application upon which the foreign patent was granted was filed less than seven months before the date upon which the application for a patent was made in the United States. But if no foreign patent has been actually granted, and only an application for such foreign patent has been filed and is pending, even where the seven months' grace has elapsed, the inventor may apply for a United States patent, and if he can so expedite matters that the United States patent is issued before the actual sealing or issue of the foreign patent, the rule under the old Statute holds good, and there is no limitation of the United States patent by the previously applied for, but subsequently granted, patent. The practical difficulty is that when the foreign inventor fails to make his United States application within the seven months, the time is usually so short that the foreign patent is likely to be sealed

America (United States).

or issued before it is possible for the United States application to be examined, allowed, and the patent issued. The Comptroller of the British Patent Office has frequently to deal with requests to keep back the sealing of British patents so that United States patents may issue before them. But however obliging he may desire to be, Section 12, Subsection 3, of the Patent Act plainly directs him to seal the patent "as soon as may be," and (except in the case of opposition or the death of the applicant) the sealing cannot be delayed beyond fifteen months from the date of application. Thus these belated United States applications are in many cases doomed to be abortive. One way out of the difficulty would be for the British inventor to abandon his original application and re-file it so as to gain additional time, but such a course would no doubt be subject to many risks.

The term of a United States patent cannot be extended except by a special Act of Congress. Such extensions are costly, and are very seldom granted.

What is patentable.

*What is Patentable.* The subject-matter of patents in the United States of America is of the same nature as the subject-matter of British patents. Section 1861 specifies "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereon." This includes chemical processes, combinations in machinery, and other features common to British practice. With respect to purely mechanical processes, it has been held in the United States that processes which consist solely in the operation of a machine, are not patentable (*Wilson v. Medart*, 71 O. G. 751 [1895], since upheld in *Tuttle v. New Haven Clock Co.*, 73 O. G. 675). But processes of manufacture which involve chemical or other similar elemental action are patentable, though mechanism may be necessary in the application or carrying out of such processes; and of course the mechanism, if new, can be patented as mechanism for this purpose (*id.*).

Novelty of invention:

*Novelty of Invention: Effect of Prior Patent or Publication.* The invention must not have been known

**America (United States).**

Effect of Prior Patent or Publication.

or used by others in the United States before the invention or discovery thereof by the inventor, and must not have been patented or described in any printed publication in the United States or in any foreign country before his invention or discovery thereof, or more than two years prior to his application, and must not have been in public use or on sale in the United States for more than two years prior to his application, unless the same is proved to have been abandoned to the public (Rev. Stat., Sec. 4886, as amended 3rd March, 1897).

Therefore, where an applicant can show that he was the original and first inventor or discoverer, and had not *abandoned the invention to the public*, the mere fact that the invention had been in public use or on sale in the United States for a period of not more than two years; or that it had been patented or publicly ascertained in the States by another (who was not the true inventor) not more than two years before his application, would not bar the issue of a valid patent to him.

But, as already set forth, any inventor who has applied for a patent in a country other than the United States must either make his application for the United States patent within seven months from the date of his foreign application, or failing this he must obtain the issue of his United States patent before the issue or sealing of his foreign patent.

Taxes. *Taxes.*—There are no taxes or renewal fees payable after the issue of the patent.

Working. *Working.* It is not necessary to "work" the invention in the United States.

Procedure. *Procedure.* The application must be accompanied by a Complete Specification and drawings. There is no such thing as Provisional Protection, and the nearest approach, which consists in filing a *caveat*, is available only to citizens of the United States or residents about to become citizens. The examination of applications is conducted by a staff of considerably over thirty principal examiners, and about one hundred and seventy assistant examiners, divided into

first, second, third, and fourth grades, with a host of clerks and copyists, all grades representing at the end of 1901 a total of six hundred and eighty persons. The applications are arranged in order as received, each being taken in its turn. The time during which an application may be awaiting examination varies from one to six months. Inventions are classified into two hundred and three general classes, which are again split up into more than four thousand subclasses. At the present time a thorough general revision of the classification is in progress. The examination is very careful and thorough, and the applicant is allowed to reply to all references and objections advanced by the examiner. If the result of the examination proves the applicant to be entitled to a patent, the allowance is granted. The final fee may then be paid, and the patent is printed and issued. All patents are issued upon the third Tuesday after the first Thursday following the day upon which the final fee is received at the Patent Office. In the event of a patent being refused, the applicant may appeal to the Examiners-in-Chief; from them to the Commissioner of Patents; and from the Commissioner to the Court of Appeals of the District of Columbia.

Under the new Act all applications must be completed and prepared for examination within one year from filing, and where any action, amendment, or enquiry is taken or required, or made by the Office during the pending of the application, the applicant must prosecute his application within one year from such step, otherwise the application will be considered as abandoned. Under the older Statute two years was the period specified.

The new Act also provides that in actions for infringements no account of profits will be ordered or damages recovered in respect of infringements committed more than six years before the issue of the writ or filing of the bill of complaint in such action.

*Models.*—It was formerly the custom to require a model or sample of the invention in all cases, but these are now only rarely required. The Commissioner, however, retains the power to call for a working model, if the

Models.

American (United States).

specification and drawings fail to make the invention clear, or if the Examiner thinks the invention would be practically inoperative.

Assignments and licenses.

*Assignments and Licenses.* An invention may be assigned wholly or in part, and the assignment recorded at any time, either simultaneously with or after application for a patent is made or the patent granted. The assignment may be for the whole or for any specified part of the States. All assignments should be recorded in the Patent Office within three months from date; otherwise they will be void against a subsequent purchaser or mortgagee without notice. The assignment may be drawn in any convenient form so long as the patent or application is identified by description, number, and date. An assignment executed out of the United States should be acknowledged before a United States consul, and his certificate of such acknowledgment is *prima facie* evidence of the execution of the assignment (see Rev. Stat., Sec. 4898). *Licenses* relating to patents may be granted, and such licenses may be exclusive, general, or restricted. Licenses need not be recorded.

Marking Patented Articles.

*Marking Patented Articles.*—According to the Act, patented articles should be distinctly marked "Patented," together with the date. Where action is taken for the infringement of an invention not so marked "Patented," the plaintiff cannot recover damages, except upon proof that the defendant knew he was infringing a patent, or continued to infringe after having been notified of the existence of a patent.

Importation of Patented Articles.

*Importation of Patented Articles.* The patented articles may be imported into the United States without affecting the patent.

Government fees.

*Government Fees.*—The fee on application for a patent is 15 dollars, and on allowance 20 dollars.

# ARGENTINE REPUBLIC.

Argentine Republic.

## (Law of 11th October, 1864.)

*Patentees.* The actual inventor or his assignee, or a foreign patentee (if the inventor) or his assignee, may obtain a patent in the Argentine Republic. Patentees.

*Description and Duration of Patents.* Patents are granted for five, ten, or fifteen years, according to the merit of the invention or the wish of the applicant. A fifteen years' patent can be obtained only for an invention which has not been previously patented elsewhere. When a patent has been previously obtained in another country the duration of the Argentine patent is limited to the duration of the foreign patent, but is restricted to ten years at most. Patents of additions may from time to time be obtained, and these expire with the original patent. Inventions may be protected by natives of the Republic under provisional patents, which are kept secret, and may be extended from year to year, thus acting as a species of *veto*. Until lately it was assumed that foreigners also had this privilege, and in many instances they have obtained provisional patents; but under recent practice they are being refused to foreigners. There is an official examination as to novelty and patentability. The term of a patent once granted cannot be extended. Description and Duration of Patents

*Unpatentable Inventions.* Pharmaceutical compositions, financial schemes, principles or inventions of a theoretical nature or contrary to law and morals. Unpatentable Inventions.

*Novelty of Invention; Effect of Prior Patent or Publication.*—To obtain a valid patent the invention should be novel, and should not have received such wide and full publicity in Argentina, or in other countries, as to place the public in full possession of the invention. A foreign patentee may apply for and obtain an Argentinian patent at any time during the existence of his foreign patent. A rigid interpretation of Clause 4 of the Act would suggest that it would be safer for a foreign patentee to file his application in the Argentine Republic before the publication of his specification abroad. Novelty of Invention Effect of Prior Patent or Publication.

Argentine Republic.

Taxes.

*Taxes.* There are no annual taxes to pay after the issue of the patent, but one half of the application fees is usually paid in successive yearly instalments after the grant of the patent.

Working.

*Working.* To keep the patent in force the invention must be worked in the Republic within two years from the date of issue of grant, and the working must not be thereafter interrupted for a longer period than two years, unless under excusable circumstances, which should be reported to the Patent Office. It is advisable, although not obligatory, to obtain a legalised certificate of each working as it is effected. It would seem that importation of the patented goods constitutes working; but where the patent is for a process the process must be worked in the Republic.

Marking and importation.

*Marking and Importation.* There are no provisions regulating the marking or importation of patented articles, but anyone falsely marking his goods "Patented," or otherwise fraudulently representing himself to be a patentee, is liable to a penalty.

Assignments and licences.

*Assignments and Licences.*—Assignments can only be made by notarial act, and after payment of the full amount of fees still due on the patent. An assignment should be registered in the Patent Office to preserve the assignee's rights against third parties. Licences may also be issued under the patent.

Government fees.

*Government fees.* The fees on a new patent vary from 80 to 350 piastres, according as the patent is taken for five, ten, or fifteen years. Patents of importation are assessed on a scale similar to that in force for new patents and according to the term granted.

Australia.

## AUSTRALIA.

The Australasian Colonies of New South Wales, Queensland, South Australia, Tasmania, Victoria, Western Australia, and New Zealand have in each case separate Patent Laws, and these will be found under their separate headings.

# AUSTRIA

Austria

## (Including Bohemia, Bosnia, Herzegovina, and Lichtenstein).

(Law of 15th August, 1852; Treaty of Commerce, 24th December, 1867, extending Patent to Hungary; Law of 27th December, 1893, separating Austrian and Hungarian Patents; New Law, dated 11th January, 1897, and operating from 1st January, 1899.)

Under Article 14 of the reciprocal Treaty of Commerce of 1867 between Austria and Hungary a common Austro-Hungarian patent was formerly granted covering both countries; but under a further Statute of 27th December, 1893, which came into operation on the 1st January, 1894, separate and independent patents are granted in Austria and Hungary. The new Act, which came into force on the 1st January, 1899, deals with amendments of the Austrian Patent Law, and brings it very much into line with the existing German Patent Law.

*Patentee.* Only the true and first inventor or originator of an invention has a right to a patent for the same, but until the contrary is proved the first applicant is deemed to be the true inventor. Where a prior patent exists in another country, an Austrian patent for the same invention can only be obtained validly by the foreign patentee or his legal representative or assignee. A firm or corporation may be the grantee of a patent.

Patentee.

*Duration of Patent.* - Patents are granted for fifteen years, but if based upon a prior patent in another country the Austrian patent is limited by the term of such prior patent. Patents of addition are now granted, these being limited to expire with the mother patent.

Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.* - Prior to the date of application in Austria, the invention must not have been described in a printed publication nor must it have been publicly worked in the Empire. British inventors

Novelty: Effect of Prior Patent or Publication.

**Austria.** who have applied for a patent at home, and who wish to obtain an Austrian patent, would do well to refrain from giving premature descriptions of their inventions in the leading English technical papers, and to make the Austrian application before the publication of the British Complete Specification. Presentation copies of all published specifications are sent from the Patent Office in London to Austria at short intervals of time, so that publication in Austria may always be relied upon to take place very shortly after publication in this country. Nevertheless, the fact of publication in Austria is always a matter for proof. So far as copies of German Patent Office prints are concerned, valid patents may be obtained in Austria, irrespective of publication there, if applied for within three months from the issue of the German print.

Taxes. *Taxes.* When the patent has been granted (the grant dating from the time when it is advertised as open to public inspection) its continuance is conditional on the payment of an increasing annual tax due at the beginning of each successive year, and progressing from about £3 for the first year to £32 for the last.

Working. *Working.* The patentee must commence to work the patent within three years from the date of grant, and the working must be continued without serious interruption during the existence of the patent, and must be *bonâ fide*. Proof of the commencement of working, at all events, should as a measure of precaution be noted on the Patent Register.

Subject-Matter of Patents. *Subject-Matter of Patents.* All inventions the subject-matter of patents in Great Britain are patentable in Austria; but under the new law inventions relating to the manufacture of tobacco, salt, and gunpowder, which are Government monopolies, cannot be patented in Austria; nor are patents granted for articles of food or luxury, or for medicines or chemical products; but processes for the production of such articles may be patented. All applications are now subject to examination as to novelty and patentability.

*Assignments.*—When made in England the assignments prepared in Germany should be executed by the assignee before a notary public, whose signature in turn requires to be legalised by an Austrian consul. The assignment must be registered in Austria, and to effect this the *assignee* should sign a notarial power, also legalised by the consul, authorising an attorney in Austria to effect the registration of the assignment. Austrian Assignments.

## BAHAMA ISLANDS. Bahama Islands.

(Colonial Act 52 Vict. Cap. 23: 23rd May, 1889.)

*Patentee.*—Strictly the true and first inventor, but practically the first importer also, may obtain a valid patent. A corporation cannot alone apply for a patent. Patentee.

*Duration of Patent.*—Patents are granted for seven years, but extensions can be easily obtained up to a maximum period of twenty-one years. Duration of Patent.

*Novelty: Effect of Prior Patent.*—The invention must not have been publicly known or used within the Bahama Islands. The fact of prior patents having been obtained in other countries will not affect the granting of a perfectly valid patent in the Bahamas, so long as the invention is not public property there at the time of application being made. Novelty: Effect of Prior Patent.

*Taxes.*—No taxes are due after issue of seven years' patents. But in the event of extensions being sought, the Government fee is £10 for the second term of seven years, and £20 for the third term of seven years. Taxes.

*Working.*—Under the original Act it was necessary to work the patent in the Bahamas within three years from date. Now, however, under Section 6 of 53 Vict. c. 2, an amending Act assented to in March, 1890, repealed the working clause, so that there is now no obligation to work the invention within the colony during the term of patent right. Working.

**Bahama Islands.**

Assignments and Licences.

*Assignments and Licences.* Assignments require to be in duplicate and in the English language. Any form will serve, and, although not obligatory under present practice, it is desirable to have assignments acknowledged before a notary public whenever possible. Assignments must be recorded in the office of the Registrar of Records. Licences can be granted as in other countries.

General.

*General.* When a prior British patent exists, a certified copy of such patent should accompany the application papers. A printed copy of the specification, certified by the Comptroller, will do. No formal "Letters Patent" are at present issued by the authorities in the Bahamas, the only documents confirming title being the Registrar's certificate of filing and the *official Gazette* containing a notice of the application. A certified copy of the patent can, however, be obtained for about £6. There are no provisions as to importing or marking patented articles.

Government Fees.

*Government Fees.* £3 on original grant; £10 for first extension of seven years; £20 for second extension of seven years.

## BARBADOS.

(ACT OF 12TH DECEMBER, 1858.)

**Barbados.**

Patentee.

*Patentee.* The true and first inventor, or the first importer, may obtain a valid patent. Corporations or firms in their firm name cannot apply, although a corporation may join with the actual inventor or inventors.

Duration of Patent.

*Duration of Patent.* The duration and description of patents are the same as in the Bahamas. Patents are granted for seven years, but they may be extended for two successive terms of seven years each.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.* The invention must be new in Barbados: *i.e.* must not have been published nor be in general use before the date

of application. The fact of the invention having been patented or published elsewhere will not prevent the grant of a valid patent in Barbados. Barbados.

*Taxes.*—There are no taxes on the seven years' patent. If the patent is extended for the further second and third terms of seven years, fees are payable on such extensions. Taxes.

*Working.*—The invention must be worked in Barbados within seven years from the date of the patent. Theoretically the working should be *bonâ fide*, but in practice the working requirement can be validly met by importing and offering the patented articles for sale in the colony. A patent for a process should, however, actually be put in operation. Working.

*Assignments and Licences.*—Assignments should be prepared in duplicate in the English language, attested before a notary, and legalised. Licences may be granted. There are no provisions for the registration of either assignments or licences. Assignments and licences.

*General.*—No formal Letters Patent are issued, and the patentee must be content with the certificate of filing and the notice in the *Official Gazette* unless he cares to pay an extra fee of from £5 to £10 for a certified copy of the patent. The patented goods may be imported in any quantity, and there are no provisions to compel the marking of the goods with the word "Patented." General.

*Government Fees.*—On original grant £3 6s. 8d.; on first extension for seven years £10; on second extension for seven years £20. Government Fees.

## BELGIUM.[1] Belgium

(Law of 24th May, 1854.)

*Patentee.*—The true and first inventor, or his assignee, or anyone authorised by the inventor; or the first importer, or a firm or a corporation, may obtain a valid patent so long as no fraud has been exercised in procuring the patent. Patentee.

**Belgium.**

Duration and Description of Patents.

*Duration and Description of Patents.*—Belgian Patents are of two kinds—viz., Patents of Invention and Patents of Importation. *Patents of Invention* are granted to applicants who apply for a patent in Belgium before a patent has been issued to them for the same invention in another country. This patent is granted for twenty years. *Patents of Importation* are granted to an importer, or to an inventor who has already obtained a patent or patents in other countries. Such patents are limited, to expire with the prior foreign patent having the longest term, so long as this does not exceed twenty years. *Patents of Addition* for improvements on the original invention may from time to time be tacked on to the original patent, whether of invention or importation, and become part of the original patent, and expire with it.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—So far as *Patents of Invention* are concerned, the invention must not have been published or used openly in Belgium, nor must a patent for the same have been actually obtained in any other country before the date of the Belgian application. Therefore, a patent applied for in Belgium after the date of the British Provisional Protection, but before actual issue of the British Letters Patent, or at least before the filing of the British Complete, would be lawfully a patent of invention lasting for twenty years. *Patents of Importation* can be applied for at any time during the term of the foreign patent, granted that it has not meanwhile come into public and commercial use in Belgium, and also granted that it has not been clearly and fully described in a printed or published work in that country. The official publication of the Complete Specification in those countries where such publication takes place does not affect the validity of Patents of Importation in Belgium.

Taxes.

*Taxes.*—Belgian patents are subject to increasing annual taxes. The first tax of 10 francs is paid with the application; the second annuity is increased to 20 francs; and so on, the tax increasing 10 francs annually. If, by inadvertence, the tax should not be paid at the proper

time, one month's grace is allowed without fine, and six months' grace may be obtained by payment of a fine of 10 francs in addition to the tax. Belgium.

*Working.*—The invention must be worked in Belgium within one year from the date of the patent, or within one year of its having been practically or commercially worked in any other country; and so long as the working in any other country continues to be carried on, the working in Belgium must not cease for an entire year at a time. Where the Belgian patent has been taken out *after* the invention has been practically worked abroad, the invention should be worked in Belgium within one year from the date of the patent. The working should be *bonâ fide*. If the invention relates to a marketable article, the article should be made and offered for sale in reasonable quantity: if to a process, the process should be carried out in some manufactory in Belgium. In all cases a certificate of working should be obtained from the proper authorities. The question of "working" patented inventions in Belgium and in one or two other European States is full of uncertainty, expense, and annoyance. The usual course that inventors take is to effect some kind of nominal or perfunctory working of their invention at the lowest cost possible, and then, having received the certificate, they feel at ease. But this compliance with the letter of the law and evasion of the spirit, although it may serve to keep the patent in force, yet leaves it seriously open to attack. The Belgian Courts have declined to pronounce on such matters, and leave it to the Government to annul or maintain a patent according as it may think a patent has or has not been sufficiently worked. However, in the few cases which the Government authorities have taken into consideration, the opinion has been expressed that working cannot be effected by importation, although importation is not prohibited; also that a strictly legal working consists in manufacturing the patented articles in Belgium in sufficient quantity to meet the commercial demand. The Government, however, seldom or never interferes to annul Working.

Belgium.

a patent or question its validity on account of insufficient working unless called upon to do so by an interested party, and even then reasons for insufficient working might exist which would be held to form a good and sufficient excuse.

Assignments and Licences.

*Assignments and Licences.*—Assignments must be in French, executed in duplicate before a notary public, whose signature, when out of Belgium, must be legalised by a Belgian consul. Assignments must be registered. Licences can also be granted to work the patent in Belgium.

Government Fees.

*Government Fees.*—First tax on application 10 francs; second year 20 francs; and so on to the twentieth year, for which the tax is 200 francs. Patents of Addition become incorporated with the original patent, and no taxes are payable in respect of them except the fees on application. This, however, only applies to Patents of Addition granted to the original patentee.

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Bolivia.

## BOLIVIA.

(Law of 8th May, 1858.)

Patentee.

*Patentee.*—The actual inventor or the true and first importer from abroad.

Duration and Description of Patent.

*Duration and Description of Patent.*—There are two kinds of Patents—viz., *Patents of Invention* (that is, when the original patents are obtained in Bolivia), and *Patents of Importation* granted to a foreign patentee or to an importer. Patents of Invention are granted for not less than ten or more than fifteen years. The term of Patents of Importation is subject to a curious qualification. If the establishment of the industry would involve an outlay of 20,000 pesos, the patent is granted for three years; if the outlay would amount to 50,000 pesos, the term is six years; if to 100,000 pesos, the patent right is for ten years.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been widely or generally published in the press, or have come into general use, either in

Bolivia or elsewhere. An invention already patented in another country may be validly patented in Bolivia, even after the publication of the foreign specification. Bolivia.

*Taxes.*—None after issue of the patent. Taxes.

*Working.*—Patents must be worked in Bolivia within a year and a day from date, but this time may be extended on reasonable cause being shown. A certificate of the working should be obtained from the proper authorities. Working.

*Assignments and Licences.*—Assignments must be in duplicate, in the Spanish language, legalised by a Bolivian consul when executed out of Bolivia. A power of attorney, also legalised by the consul, is required to authorise the recording of the assignment, a step which is absolutely necessary to avoid forfeiture. Licences can be issued. Assignments and licences.

## BRAZIL.* Brazil.

(Law of 14th October, 1892.)

*Patentee.*—The true and first inventor may obtain a patent, or a foreign patentee may have his rights confirmed in Brazil. Joint inventors may obtain a joint patent. Patentee.

*Duration of Patent.*—Patents are granted for fifteen years, but they expire with a prior foreign patent for the same invention, if such has been obtained. Patents of addition to the original patent may be obtained during the first year by the original patentee or his legal representative only; after that time Patents of Addition may be obtained by other inventors. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not be known or publicly used in Brazil at the time of application. An inventor who has already obtained a patent elsewhere is protected from the consequences of publication, or use or attempted appropriation of the invention by another applicant in Brazil, if he makes his application within seven months (under the recent Convention amendment, twelve months) from the date of his foreign patent. If an inventor wishes to use or Novelty Effect of Prior Patent or Publication.

Brazil.

exhibit his invention in Brazil before applying for a patent there, he may do so with safety on obtaining an official permit to that effect.

Taxes.

*Taxes.* Patents are subject to annual and increasing taxes, commencing with 20 dollars for the first year, increasing to 30 dollars for the second, 40 dollars for the third, and so on, at the rate of 10 dollars per annum until the full term is reached. No extension of the time for payment is allowed.

Working.

*Working.*—The working of the invention must be effected, proved, and a certificate obtained, before the end of the third year, and such working must not be at any time suspended for a greater period than one year. If the working should be prevented by any circumstances over which the patentee has no control, the Government will condone the omission on proper proof being shown. Importation of the patented goods is not prohibited. The fraudulent marking of patented articles is punishable by a fine of from 100 to 500 dollars.

Assignments and Licences.

*Assignments and Licences* may be prepared in any convenient form, and must be in the Spanish language. No assignment will take effect until registered in the Bureau of Agriculture, Commerce, and Public Works.

Government Fees.

*Government fees.*—The actual Government fees, apart from other unfixed expenses, are represented by the amounts under the head of "Taxes."

British Guiana.

## BRITISH GUIANA.

(Ordinance No. 13 of 1861.)

Patentee.

*Patentee.*—Patents are granted to the true and first inventor, which term includes the first importer of the invention to the colony.

Duration of Patent.

*Duration of Patent.*—Patents are granted for fourteen years, subject to the limiting effect of any prior foreign patent. It is, however, not difficult to obtain the extension of a patent for a further term of seven years.

British Guiana.

*Novelty: Effect of Prior Patent or Publication.*—To obtain a valid patent the invention must not, prior to the date of application, have been publicly known or used in the colony. A prior patent in another country, even when published there, will not affect the validity of a subsequent patent in British Guiana, so long as the invention is not publicly known or used there at the date of application.

Novelty: Effect of Prior Patent or Publication.

*Taxes.*—A renewal fee of 100 dollars is due before the expiry of the seventh year of the patent right. No extension of the time for payment is obtainable.

Taxes.

*Working.*—There is no compulsory working of the invention, and the patented articles may be imported to the colony. The marking of the goods is left to the discretion of the patentee.

Working.

*Assignments and Licences.*—These should be in the English language, and assignments should be made in duplicate in any suitable form. When made in a foreign country they should be legalised by a British consul. Both assignments and licences must be entered in the Register of Patents.

Assignments and Licences.

## BRITISH HONDURAS.

British Honduras.

(Law of 10th September, 1862.)

*Patentee.*—The true and first inventor, or the first importer, may obtain a valid patent.

Patentee.

*Duration of Patent.*—Fourteen years, subject to the limit of any prior patent for the same invention obtained elsewhere. Extensions may sometimes be obtained.

Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not be published or publicly known, or used in the colony, before the date of application. The existence of a prior home or foreign patent, so long as it is not publicly known in British Honduras, will not affect the validity of a patent there.

Novelty: Effect of Prior Patent or Publication.

British Honduras.

Taxes.

*Taxes.*—A tax of 50 dollars is due before the end of the third year of the patent, and a farther tax of 100 dollars is due before the expiry of the seventh year. The time for making these payments cannot be extended.

Assignments and Licences.

*Assignments and Licences.*—These should be in the English language, and should be entered in the Register of Patents to have effect against third parties.

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British North Borneo.

## BRITISH NORTH BORNEO.

(Proclamation No. 1 of 1887.) See **Straits Settlements.**

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British South Africa.

## BRITISH SOUTH AFRICA.

Patents may now be obtained throughout the British South African Territories. The Cape Colony Act (No. 17 of 1860) has been adopted in text and practice.

Patentee.

*Patentee.*—Patents are granted to the true and first inventor or to the first importer.

Duration of Patent.

*Duration of Patent.*—Patents are dated from the day of application and run for fourteen years.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—So long as the invention is new in British South Africa, publication or patenting in another country will not bar the grant of a valid patent.

Taxes.

*Taxes.*—£10 before the end of the third year; £20 before the end of the seventh year. No extension allowed for making these payments.

Working.

*Working.*—None required, and importation of goods is allowed.

Assignments.

*Assignments.*—May be prepared in the ordinary British form, and should be witnessed and registered.

## BURMAH.

Burmah.

Burmah is a province of British India, and is covered by the Indian patent.

## CANADA.

Canada.

(Colonial Act of 1886, Cap. 61.)

*Patentee.*—A patent may be obtained by the true and first inventor or inventors, or by his or their assigns or legal representatives. As in the United States, the actual inventor, or, if deceased, his legal representative, must in all cases sign the papers and make the application, but the patent may issue to the inventor alone, or jointly to the inventor and his assignee, or to the assignee alone, a proper assignment and request being filed before the issue.

Patentee.

*Duration of Patent.*—Patents are granted for eighteen years, subject to the conditions as to payment of taxes and working; but where a prior patent exists in another country, the Canadian Patent will expire with the said prior patent. A special legislative Act is required to obtain an extension. A *caveat*, which is a species of provisional application, may be filed by an intending applicant so as to secure a date, and such a *caveat* will remain good for a year, but cannot be renewed.

Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—For the purposes of a valid patent, an invention is considered new in Canada if the invention has not been in public use or on sale in the Dominion for more than one year, without the consent of the original and true inventor. It will be remembered that similar latitude, extending to two years, exists in the United States. If a home or foreign patent exists for the same invention, the Canadian application must be made before the expiry of twelve months from the date of issue or sealing of such prior patent.

Novelty: Effect of Prior Patent or Publication.

*Taxes.*—The taxes for the full term of eighteen years may be paid before the issue of the patent. This, however,

Taxes.

Canada.

is very rarely done. The better plan is to pay the amount of 20 dollars for the first six years only at the time of making application, then to pay the renewal tax of 20 dollars before the end of the sixth year, and twenty dollars before the end of the twelfth year. There are no means of prolonging the time for making these payments.

Working.

*Working.*—The invention must be worked or commenced to be worked in Canada within two years from the date of the patent. The working must not be of a perfunctory nature, but must be sufficiently real and extensive to place goods on the market and supply any demand that may exist for the patented article. If two years should prove too short a period in which to effect this, an enlargement of the time to twelve months may be obtained by presenting a petition for such enlargement. This petition must not be made more than three months before the expiry of the term of two years. After working has been commenced, it must not be discontinued. In order to work an invention continuously, so as to comply with the law, it is a common practice with patentees to arrange with some manufacturer to make or to be ready to make the patented articles, and then to advise that the goods may be had from this manufacturer or agent. Such an arrangement is held by authorities in Canada to constitute a perfectly legal working of the invention within the provisions of the Act.

Assignments and Licences.

*Assignments and Licences* may be prepared in any manner acceptable to English practice. Every assignment must be registered in the office of the Commissioner of Patents.

Marking Patented Articles.

*Marking Patented Articles.*—All patented articles must be marked "Patented," together with the date of the patent. Penalties are exacted from those who fraudulently mark their goods "Patented" where no patent exists.

Importation of Patented Goods.

*Importation of Patented Goods.*—No patented goods must be imported by the patentee, or with his knowledge or consent, into Canada, at any time after twelve months from the date of the patent. The effect of such importation

would be to make the patent void. An extension of the term within which importing may be carried on may usually be had by filing a petition to that effect. Canada.

*Models.*—Before the Canadian patent is issued, it is usual to demand a model, which should to some extent be a working model of the invention. The size should not exceed twelve inches on the longest side. Compositions (except explosive compounds) should be explained by the production of samples of their ingredients. Models.

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## CANARY ISLANDS.

(See **Spanish Colonies.**) Canary Islands.

## CAPE COLONY.

(Including British Bechuanaland.) Cape Colony.

(Act No. 17 of 1860.)

*Patentee.*—Patents are granted to the true and first inventor, or to the person who first imports an invention into the colony. Patentee.

*Duration of Patent.*—Patents are granted for fourteen years, but where a prior home or foreign patent exists, the term expires with such prior patent. Duration of Patent.

*Novelty of Invention: Effect of Prior Patent.*—To obtain a valid patent in the Cape, the only requirement is that application should be made before publication or public use of the invention has taken place within the colony. The existence of a prior patent, or the fact of the invention having been published in another country, does not injure the validity of the grant in the Cape. Novelty of Invention: Effect of Prior Patent.

*Taxes.*—£10 is due to be paid before the end of the third year of the term of the patent right, and a further sum of £10 before the expiry of the seventh year. Taxes.

Cape Colony.

Working.

*Working.*—There is no obligation to work the invention in the colony.

Assignments and Licences.

*Assignments and Licences.* These may be prepared in any suitable form, and must be entered in the Register of Proprietors.

Ceylon.

## CEYLON.

(Act No. 16 of 1902.)

Patentee.

*Patentee.*—Patents are issued to the actual inventor or to his legal representative or assign. A first importer is not entitled to a patent.

Duration of Patent.

*Duration of Patent.*—Patents are granted for fourteen years, and are capable of extension if sufficiently good grounds can be shown. When prior patents exist, the patent in Ceylon is limited by the term of the mother patent.

Novelty of Invention: Effect of Prior Patent.

*Novelty of Invention: Effect of Prior Patent.*—When the original application is made in Ceylon, the invention must be new and unpublished in Ceylon or in the United Kingdom. If a British patent has been obtained, application in Ceylon should be made within twelve months from the date of the *actual sealing* of the British Letters Patent, and a valid patent will be issued for Ceylon, granted that the invention has not become publicly known in the colony before the date of application. Where application only has been made for a British patent, the applicant may take out a patent in Ceylon if he makes application there within twelve months from the date of his British application, and the validity of such a patent will not be affected by the fact that the invention has, within such period of twelve months, become publicly known in the United Kingdom and in Ceylon. The specification can from time to time be amended as in Great Britain.

Taxes.

*Taxes.*—An annual tax of 50 rupees is payable before the expiry of the fourth, fifth, sixth, seventh, and eighth years; and a tax of 100 rupees before the expiry of the ninth, tenth, eleventh, twelfth, and thirteenth years.

Ceylon.

*Working.*—There is no requirement as to working the invention, and no prohibition upon importation. Working.

*Assignments.*—These may be prepared in any suitable form, and should be entered in the Register of Inventions. The new proprietor's name should also be entered in the address book kept in the office of the Colonial Secretary for the purposes of service. Assignments.

## CHANNEL ISLANDS.

Channel Islands.

These islands are no longer covered by the British patent, but a species of protection may be obtained by enrolling a certified copy of the British patent in the Rolls of the Royal Court in Jersey and Guernsey.

## CHILI.

Chili.

(Law of 9th September, 1840; Amended 20th January, 1883.)

*Patentee.*—The actual author, or inventor, or first importer. Patentee.

*Duration of Patent.*—The duration of patents was fixed by the law of 1840 at ten years, but by the amending Act of 1883 power was given to the President to extend this term up to twenty years, and, as a matter of fact, in practice, this latter term is usually granted. The term of a patent commences at the expiry of the term fixed within which it must be worked. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention must be new to, or not known or published in, Chili at the date of application. With this proviso inventions already patented and published abroad may be validly patented in Chili. A regulation exists whereby, in the case of an invention which has been patented abroad, the Chilian application is advertised in the *Official Gazette*, so as to give any person who has begun to practise the invention in Chili an opportunity of opposing the grant. Novelty: Effect of Prior Patent or Publication.

Chili.

Examination.

*Examination.*—The application is subject to examination as to novelty and utility by a committee of experts.

Taxes.

*Taxes.*—None.

Working.

*Working.*—In granting the patent the Government fixes and endorses on the grant a period of time within which the invention must be put to work in Chili. The manufacture should be actually established or taken in hand by that time, and it is submitted that a mere perfunctory working would scarcely avail. An extension of the time for working, of not more than six months, may be obtained on sufficient cause being shown. The term of the patent commences on the expiry of the time allotted for working it. The working must not at any time be discontinued for more than one year.

Assignments &c.

*Assignments &c.*—These should be in the Spanish language, executed in duplicate, and legalised, when signed abroad, by a Chilian consul. The Minister of the Interior should be advised of the completion of an assignment, and, if he is satisfied that it is a *bonâ fide* transaction, he will enter the assignment on the transfer book.

Government Fees.

*Government Fees.*—A fee of 50 dollars is payable upon application.

China.

## CHINA.

The Empire of China has no law for the protection of inventions. Some sign of awakening has been shown by the publication of an Imperial Decree on the 5th of July, 1898, authorising the enactment of patent and copyright laws, but no advantage has, so far, been taken of this permission. It is, however, possible to obtain protection by securing a special grant or monopoly from the national authorities, the average cost of which has been estimated at about £500. Another method is to register certified copies of the specification in the Chinese Foreign Office, and also at the Consulate of the country to which the

applicant belongs, and thereafter to advertise full particulars of the invention, together with a notification of the inventor's right of property, in the principal Chinese official newspapers. This latter method is said to confer quite as much protection as the first, and is much less expensive, as it may be done for about £50. China.

## COCHIN CHINA.

Cochin China.

(INCLUDED UNDER THE FRENCH PATENT.)

## COLUMBIA.

Columbia.

(LAW No. 35, 13TH MAY, 1869.)

*Patentee.*—The true inventor, first importer, or the owner of a prior foreign patent, may obtain a valid patent in Columbia. Patentee.

*Duration of Patent.*—Patents are granted for five, ten, fifteen, or twenty years, at the option of the applicant. A Columbian patent will expire with a prior foreign patent. Duration of Patent.

*Novelty: Effect of Prior Publication.*—To be validly patentable the invention should not be known or published in Columbia. Inventions patented abroad may be patented in Columbia at any time during the existence of the prior patent, but not if the invention has in the meantime become known in Columbia. Novelty: Effect of Prior Publication.

*Unpatentable Inventions.*—No patents can be obtained for inventions relating to cigarettes or the manufacture of cigarettes, this being a Government monopoly. Unpatentable Inventions.

*Examination.*—There is no preliminary examination. Examination.

*Taxes.*—None after the issue of the patent. Taxes.

*Working.*—The patent must be worked within a year from date, and must not be discontinued during an entire year. There is nothing to prohibit importation. Working.

Columbia.

Assignments &c.

*Assignments &c.* should be prepared in Spanish and be made in duplicate. They should be legalised by a Columbian consul. There being no provision in the law for the assignment of patent rights, it is not the practice to register them; but, as a patent is now everywhere recognised as constituting property, it would be quite a proper step to seek registration for documents which deal with such rights.

Government Fees.

*Government Fees.*—Ten dollars on application. On grant of a patent a fee is paid, which is arrived at by assessing from 5 to 10 dollars for each year of the term for which the patent is issued.

## Congo Free States.

## CONGO FREE STATES.

(Law of 29th October, 1886; Decree of 30th October, 1886.)

Patentee.

*Patentee.*—Anyone may obtain a patent in Congo, whether the inventor or not.

Duration and Description of Patent.

*Duration and Description of Patent.*—Patents are classified as "Patents of Invention" and "Patents of Importation." Patents of Invention are granted for twenty years. A Patent of Importation expires with the prior foreign patent upon which it is usually founded. Patents of Addition are also granted, which become a part of and expire with the original patent.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The law says nothing as to the effect of prior use or publication upon patents in Congo. The practice is, however, grounded upon that of Belgium, so that it may be taken that inventions which are known or published in Congo at the date of application are not patentable there unless the invention is patented abroad, and even then only upon the conditions annexed to the Belgian law.

Examination.

*Examination.*—There is no examination.

Congo Free States.

*Taxes.*—None after issue of patent. Taxes.

*Working.*—Working is not compulsory. Patented articles may be imported, and there is no obligation to mark them as such. Working.

*Assignments.*—These must be notified to the Department of Foreign Affairs, and the assignment is advertised in the *Bulletin Officiel* in the same manner as patent grants. Assignments.

*Government Fees.*—One hundred francs on application. Government Fees.

## CORSICA.

Corsica.

(Included in French Patent.)

## COSTA RICA.

Costa Rica.

(Law of 26th June, 1896.)

*Patentee.*—The actual inventor. Patentee.

*Duration of Patents.*—Patents are granted for twenty years. Patents of Addition may also be had. Duration of Patents.

*Novelty: Effect of Prior Patent or Publication.*—The invention must be new; but the law specifically provides that patents may be issued to foreigners for the unexpired term of their home patent. It seems that publication of the prior patent specification will not bar the right to a valid patent in Costa Rica. Novelty: Effect of Prior Patent or Publication.

*Working.*—The patent must be worked in Costa Rica within two years from grant. Importation of the goods is held to constitute working. Working.

*Taxes.*—None after issue. Taxes.

*Assignments.*—These should be in duplicate and be legalised by a consul of Costa Rica. Assignments.

Cuba.

## CUBA.

Cuba having ceased to be a Spanish colony and the United States having made no attempt to impose its own patent law there, patents in Cuba are unprocurable until a stable Government has been established and the protection of inventions legislated for.

Cyprus.

## CYPRUS.

(No Patent Law.)

Denmark.

## DENMARK.*

(Law of 28th March, 1894.)

Prior to the 28th March, 1894, no statutory provision existed in Denmark for the protection of inventors. The Ministry of the Interior had powers to grant equivalent privileges, which were perhaps sufficiently adequate for national industries, but which adopted a harsh attitude towards foreign inventors. Now, however, Danish patents are granted by virtue of an Act passed by the Danish Parliament on the above date, and taking effect from July, 1894. The chief provisions are as follows:—

Patentee.

*Patentee.*—Any person, whether native or alien, may obtain a patent, provided he is the true inventor or the legal assignee of the true inventor. If the applicant is an assignee the assignment must be produced legalised by a Danish consul.

Duration of Patent.

*Duration of Patent.*—Patents are granted for fifteen years from the date of application, and are not subject to limitation by prior patents for the same invention in other countries. Patents of Addition are granted for improvements on the original invention, and these expire with the original patent. The grant of a patent may be opposed by an interested or aggrieved person.

Denmark.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—At the date of application the invention must not have been publicly used in Denmark, and must not have been fully and intelligibly described in print either in Denmark or elsewhere. Therefore prior publication of the specification of a foreign patent in a foreign country would destroy the validity of a Danish patent for the same invention (*per* Mr. E. Carpmael, *Transactions of the Chartered Institute of Patent Agents*, Vol. 14, p. 30). All applications are subject to examination as to novelty and patentability.

Taxes.

*Taxes.*—Patents, to be kept in force, must be sustained by the payment of annual taxes, amounting for the first, second, and third years respectively to £1 8s. 2d. in English money, and thereafter doubling in amount every third year until the end of the twelfth year, when the tax is £16 18s. for each of the last three years. An extension of time of three months within which to pay any overlooked tax may be had on payment of a fine amounting to one fifth of the tax due.

Working.

*Working.*—The invention protected by the patent must be worked in Denmark within three years from the date of the patent. Under special circumstances the term for working the patent may be prolonged, or exemption from working may be obtained. No authoritative decision has yet been given as to what amount of working will constitute a valid compliance with the Act, but leading authorities are of opinion that working on a small scale will suffice. Importation of the patented goods into Denmark is not permitted under the terms of the Act, but in practice it seems that when a patentee has obtained exemption from the duty of working the invention in Denmark importation of the patented goods is not only allowed but required.

Assignments and Licences.

*Assignments and Licences.*—These may be prepared in any suitable terms, and should be registered.

Government Fees.

*Government Fees.*—Represented in English money, these amount to £3 3s. on application, and consist of the application fee, 20 crowns; the issuing fee, 10 crowns; and the first annual tax, 25 crowns. The succeeding annual taxes have already been detailed.

Ecuador.

## ECUADOR.*

(Law of 18th October, 1890.)

Patentee.

*Patentee.*—The true inventor or the first importer.

Duration and Description of Patent.

*Duration and Description of Patent.*—There are two kinds of patents—viz., *Patents of Invention*, that is when the original patent is obtained in Ecuador; and *Patents of Importation*, granted to a foreign patentee or to an importer. Patents of Invention are granted for not less than ten or more than fifteen years. If the establishment of the industry constituting the subject-matter of a Patent of Importation involves an outlay of 20,000 pesos, the patent is granted for three years: if the outlay would amount to 50,000 pesos, the term is six years: if to 100,000 pesos, the patent right is for ten years.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been widely or generally published in the Press in Ecuador or elsewhere before the date of application. An invention patented in another country may be validly patented in Ecuador even after publication of the specification abroad.

Taxes.

*Taxes.*—None after issue of patent.

Working.

*Working.*—Patents must be worked in Ecuador within a year and a day from date. An official certificate of the working should be obtained.

Assignments and Licences.

*Assignments and Licences.*—Assignments should be in duplicate, in the Spanish language. When executed out of Ecuador they should be legalised by a consul of Ecuador. The assignment should be recorded, or it will be of no effect. Licences and assignments can be prepared in any convenient form.

Egypt.

## EGYPT.

There is at present no Patent Law in force in Egypt, but a system has of late years arisen whereby new inventions, trade marks, and designs may be enrolled at the

Registry of the Commercial Mixed Tribunals in Alexandria. Under this registration action may be taken against infringers and counterfeiters. The fact of such registration should be advertised in the principal Egyptian newspapers so as to establish further evidence of ownership, and to put traders on their guard. Egypt.

## FIJI ISLANDS.

Fiji Islands.

(Ordinance No. 3 of 1889.)

*Patentee.*—Patents are granted to the true and first inventor or importer. Patentee.

*Duration of Patent.*—Patents are granted for fourteen years, limited to expire with any prior patent in another country. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The fact of the invention having been already patented or published in other countries will not prejudice the validity of a patent obtained in Fiji, if unknown there at the date of application. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—None. Taxes.

*Working.*—None. Working.

*Government Fees.*—On application, £5 5s.; on issue of patent, £10 10s. Government Fees.

## FINLAND.

Finland.

(Decree dated 21st January, 1898, and Operating from 1st January, 1899.)

*Patentee.*—The actual inventor or his representative, or those deriving rights through him. Patentee.

*Duration of Patent.*—Patents are granted for fifteen years dating from the grant Patents of Addition may from time to time be obtai , expiring with the original patent. Duration of Patent.

**Finland.**

Subject-Matter of Patents.

*Subject-Matter of Patents.*—All useful inventions; but no patent will be granted for foods or medicines or for chemical products. Patents may, however, be obtained for processes for the production of such articles.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—No patent will be granted for an invention which by public use or by description in any publication has become known to persons in Finland versed in the particular industry to which the invention relates. But publication in consequence of an application for a patent made to a foreign Government will not prevent the grant of a valid patent if application is made in Finland within six months from the date of publication.

Taxes.

*Taxes.*—The patent, when granted, is subject to the payment of progressively increasing annual taxes, beginning with 20 marks for the second and third years, and rising to 70 marks for the last two years. Three months' grace is allowed for the payment of any tax which may have been overlooked, but subject to a fine amounting to one fifth of the tax due.

Working.

*Working.*—The patentee must work his invention in Finland within three years from the date of grant, and must not thereafter discontinue the working for any one year. If during the first three years or thereafter the patentee should fail to work the invention, he can be compelled to grant licences to work on reasonable terms to persons prepared to undertake the manufacture or exercise of the invention.

Assignments and Licences.

*Assignments and Licences.*—These must be recorded at the Direction of Industry, otherwise assignments or charges on the patent will be of no effect as against third parties afterwards obtaining and registering similar interests without notice of the prior assignment or charge. In the case of foreigners the assignment and power authorising registration must be legalised by a Russian consul.

Marking.

*Marking.*—Falsely marking goods as "patented" or advertising them as such when, in fact, no patent exists therefor, is punishable by a fine not exceeding 500 marks.

## FRANCE* (and Colonies).

France and Colonies.

(LAW OF 5TH JULY, 1844; DECREE OF 21ST OCTOBER, 1878; AMENDING DECREE OF 9TH JULY, 1901.)

*Patentee.*—Although, strictly speaking, only the true inventor or his assignee is legally entitled to a patent, practically anyone, whether the inventor or not, or the first importer, or a firm, or a corporation, may obtain a patent in France. In any case where the patentee is not the inventor, his title to the patent is unquestionable if he can show that he made the application in his own name and with the consent of the inventor. Patentee.

*Duration of Patent.*—Patents are granted for five, ten, or fifteen years at the option of the applicant. In almost all cases the fifteen years' term is asked for. Patents of Importation for inventions already patented abroad expire with the prior foreign patent which is the first to lapse. Patents of Addition are granted, and become part of the original patent, and expire with it. Duration of Patent.

*Unpatentable Inventions.*—Pharmaceutical compositions and medicines of all kinds, and also financial schemes, cannot be patented in France. Unpatentable Inventions.

*Novelty: Effect of Prior Patent or Publication.*—The invention must be novel, and Article 31 of the French Law says: "No discovery, invention, or application shall be considered as new which in France *or abroad*, and before the date of the deposit of the application, has received sufficient publicity to enable the same to be worked." It is clear, therefore, that to enable a British applicant to obtain a valid French patent he must make his application in France before the publication of his specification *in this country*. It must be understood that the French authorities make *no examination* into the *novelty* of an invention, and a patent for anything will be granted to any applicant; but of course a patent which did not possess the legal essentials would be of little value to its owner. The mere fact of a prior foreign patent being in existence for the same invention will not invalidate the French Novelty: Effect of Prior Patent or Publication.

**France and French Colonies.**

patent so long as the invention has not been published, or used, or otherwise made publicly known, before application for a patent in France.

New Rules as to Preparation of Specifications.

*New Rules as to Preparation of Specifications.*—In pursuance of the recent Decree of 9th July, 1901, new rules relating to the preparation of the specifications and drawings were promulgated on the 3rd September, 1901. Formerly the authorities accepted any specification, however inadequate, and any drawings prepared in any manner the inventor pleased. The specifications were not printed or published, and the administration of patents had scarcely any official recognition. Now, however, by virtue of the latest Decree, a French National Patent Office has been organised, and was opened in Paris on 1st October, 1901. The new rules insist upon the preparation of the specification in a proper and skilled manner. The drawings must be on sheets of fixed sizes which correspond with those of the British patent, and must be executed in clear black lines on Bristol board, so as to be capable of reproduction by photo-lithography. These rules came into effect on the 1st January, 1902. The intention is that in future French specifications will be printed, published, and sold at a small cost.

Taxes.

*Taxes.*—French patents are subject to the payment of an annual tax of 100 francs. No extension of time for the payment of the tax can be obtained.

Working.

*Working.*—A French patent must be worked within two years from the date of the *actual signature or issue of the Letters Patent*, and must not cease during any two consecutive years thereafter. Failure to fulfil this condition will render the patent liable to be declared void, unless such failure was caused by circumstances which were beyond the patentee's control. Sickness, poverty, political disturbance, the difficulty of getting the patent taken up by reason of the limited field of use all of these have been held good as excuses to prevent forfeiture. There are several cases which show that the French Courts are becoming more and more unwilling to accept the mere pretence of working

which is common in the case of most patents. It has been held, for example, that a single act of manufacture of the invention is not enough. No doubt the expense of working is a severe tax upon patentees; but if the patent is at all likely to be of value, proper working should not be neglected. The mere sending of the parts of a machine into France and fitting them together there would not, according to the Courts, be a sufficient working. The whole or a portion of the parts should be made in France, and the readiness of the patentee to supply a demand should be advertised in a French newspaper of standing. The patentee might sometimes find a manufacturer or agent to undertake the working of the invention on reasonable terms. It is advisable in all cases when the working is effected to obtain a certificate to that effect from the proper authorities. So long, however, as it is possible to prove afterwards *that the invention actually was worked*, the mere omission to obtain a certificate will not matter.

Assignments.

*Assignments.*—According to the French Law (Section 4, Article 20) no assignment can be recorded until all the future annual taxes are paid for the full term of the patent. This immediate expense can, however, be avoided by preparing an irrevocable power of attorney, authorising a notary to effect the assignment, and the name of the notary may be left blank. This power is signed by the vendor, legalised by a French consul, and may then be kept by the purchaser. If circumstances should require registration, he has only to fill in a notary's name, who will then be empowered to have the assignment made and recorded.

Marking and Importing Patented Articles.

*Marking and Importing Patented Articles.*—In France a patentee is not obliged to mark patented articles as such; but if he do so, he must add the words "*Sans Garantie du Gouvernement*," or the initial letters of the phrase, "S. G. D. G." The penalty for omitting this is from 50 to 1,000 francs. France being a member of the International Convention, the patented articles may be imported freely from other countries which are also members of the Union,

**France and French Colonies.**

as is, for example, the case with Great Britain. But the denizens of other countries which are not members of the Union are not allowed this privilege, and importation by a citizen of such a country would involve the forfeiture of his patent

Government Fees.

*Government Fees.* These are represented by the annual taxes already set forth.

*N.B. The French patent covers the colonies of Algeria, Cambodia, Cochin China, French Guiana, Guadeloupe, La Réunion, Loyalty Islands, Marquesas Islands, Martinique, Mayotte, New Caledonia, St. Pierre, Senegambia, and Tahiti.*

**French Indo-China.**

## FRENCH INDO-CHINA.

(DECREE OF 24TH JULY, 1888.)

Under this Decree patents are issued in Indo-China upon conditions similar to those set forth in the French Law.

**Gambia (British).**

## GAMBIA (British).

This colony has no Patent Law, but protection for a meritorious invention can easily be obtained by special Legislative Act, at a cost of about £50.

**German Empire.**

## GERMAN EMPIRE.

(LAW OF 1ST JULY, 1877.)

Patentee.

*Patentee.* Whoever first applies for a patent is entitled to the grant. Patents are granted to a single applicant, to joint applicants, to a firm, or to a corporation. But if a person who is not the inventor has his application opposed by the true inventor, and the latter succeeds in showing that the applicant obtained the invention from him, the patent will be refused to the fraudulent applicant and granted to the true inventor.

German Empire.

*Duration of Patent.*—Patents are granted for fifteen years from the day following the date of application, and the lapse of a prior foreign patent does not affect the German patent. Patents of Addition are granted, which expire with the original patent.

Duration of Patent.

*Unpatentable Inventions.*—Articles of food, pharmaceutical compositions, and the products of chemical processes. But chemical processes apart from the products are patentable.

Unpatentable Inventions.

*Novelty: Effect of Prior Patent or Publication.*—The German Law is very severe in respect to novelty. An application for a patent must be filed before the invention has been described in any printed publication, either in Germany or elsewhere. For example, German applications by British inventors, even when made before the publication of the British Complete Specification, have been refused, because of short descriptions of the invention which have been incautiously published in some English technical papers. Therefore, whoever wishes to secure a German patent must see to it that no publication of his invention shall be allowed to take place until after the deposit of his German application.

Novelty: Effect of Prior Patent or Publication.

*Examination.*—All applications are subject to a very strict and thorough examination as to novelty, utility, and patentability. The patent records and technical publications of every country are examined carefully, and any anticipatory matter which can be found is quickly brought to the notice of the applicant. Patentability is also a feature which the Examiners take upon themselves to decide. Although not so drastic in their decisions as they formerly were, the conclusions of the German Examiners are not always of a satisfactory nature. An appeal may be had from the decision of the First Examiner to the Board of Examiners-in-Chief.

Examination.

*Taxes.*—Annual progressive taxes are payable on German patents. The first annuity amounts to 30 marks, the second to 50 marks, and thereafter the tax increases at the rate of 50 marks per annum.

Taxes.

German Empire.

Working.

*Working.*—Patents must be put to work within three years from the date of the grant of the patent. If this working is not effected in due time, the Act says not that the patent therefore *becomes void* but that *it may be declared void*. There are, therefore, many cases where failure to work within the appointed time has not been followed by any annulment of the patent. But this depends upon the circumstances. For example, the patentee of a new manufacture of armour-plate was excused because of the difficulty and cost of working such an invention, and in view of the fact that he had offered to license certain makers in Germany. But the patentee of an automatic pencil was deprived of his patent because the Court held that the invention could have been easily worked in Germany. Besides, it was shown that a large demand existed in Germany for the pencil, which was proved by the fact that the patentee had imported enormous quantities of the pencils into Germany. The decisions all show that the provision for working is intended to be met by a real manufacture of the invention being carried on in Germany; that the working should be actual and thorough; and that a mere scamped pretence of working would not satisfy requirements. Therefore, when a patentee cannot himself establish such a manufacture, he should try to arrange with a German manufacturer or agent to make or put himself in a position to make the patented article, and to advertise that fact in the Public Press. Importation of the patented goods is not prohibited, and there is no obligation to mark the articles as "Patented," although this should always be done.

Models.

*Models.*—Models and samples are required in the following classes of invention:—Firearms, spools, spindles and shuttles (in the case of spindles a sectional model should also be supplied), skates, chemicals (except explosives), and dyes.

Assignments and Licences.

*Assignments and Licences.*—To enable an assignment of a German patent to be properly registered at the Patent Office the assignment should be in German, signed by

German Empire.

the assignor before a notary, whose signature should be attested by a German consul. No consideration need be expressed. The assignment should be accompanied by a power of attorney, signed by the assignee, and authorising an agent or attorney in Berlin to register the assignment on behalf of the assignee. This power should also be attested by a notary and a consul, as in the case of the assignment. Licences may also be granted in respect of German patents, and there is a provision in the German law whereby a patentee who refuses to grant licences on reasonable terms, when such licences seem to be demanded in the public interest, may be deprived of his patent.

## Useful Designs Patents.

Useful Designs Patents.

An Act for the protection of useful designs in Germany came into effect on the 1st of October, 1891. Such designs patents are granted without any examination. For many articles and novelties which would not warrant the expense of a patent, or which do not possess the elements of patentability, the Designs Act will suit admirably. The full period of protection is six years. Where a Patent of Invention is wished for, but where the chance of obtaining it seems slight, applicants sometimes file an application for a patent and an application under the Designs Act *simultaneously*, including under the latter application a request that the Office will grant the Design Protection only in case of the rejection of the Patent Application. If the patent is refused all is not lost, as the applicant has the Design Application to fall back upon. If the patent is granted, then the Design Application can be withdrawn. There is no obligation to work a patented design in Germany, as must be done in the case of ordinary patents. The design must be new in Germany.

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*Baden, Bavaria, Prussia, Saxony, and Wurtemberg are covered by the German patent.*

Gibraltar.

## GIBRALTAR.

Gibraltar has no Patent Law, but British patentees may have their patents extended to cover the dependency for the unexpired term of the British patent.

Gold Coast Colony.

## GOLD COAST COLONY.

This colony has no Patent Law, but protection may be obtained by way of special Legislative Act at a cost of about £50.

Greece.

## GREECE.†

Greece has no Patent Law, but a Private Act can be obtained for the protection of a meritorious invention.

Guade-loupe.

## GUADELOUPE.

Covered by French patent.

Guate-mala.

## GUATEMALA.

(Law of 17th December, 1897.)

Patentee.

*Patentee.*—All natives of the country and foreigners who have resided for at least one year in the Republic may obtain patents for new inventions. Patents may be granted to non-resident foreigners, where such grant is the only possible means of introducing a new industry into the country, and in such case only where there are International Conventions or Treaties providing for the grant of patents to non-resident inventors. (Guatemala withdrew from the International Convention in 1895, but at present has Treaties with France, Honduras, San Salvador, and Costa Rica, which provide for the reciprocal protection of industrial property.)

Guatemala.

*Duration of Patent.*—Patents are granted for from five to fifteen years. Patents of Addition to the original patent may from time to time be obtained either by the original inventor or by another. Duration of Patent.

*Novelty: Prior Patent or Publication.*—The invention must be new and must not have been published in Guatemala or abroad prior to the application. The existence of a prior patent or application in another country would not bar a patent in Guatemala, so long as no publication of the invention has taken place. Novelty: Prior Patent or Publication.

*Taxes.*—An annual tax of 30 pesos must be paid within the first ten days of January in each year, to maintain the patent in force. No grace is allowed in the event of oversight in making the payments. Taxes.

*Working.*—The patent must be worked within a year of grant, and must not be discontinued during any one succeeding year. In practice importation of goods difficult to produce in Guatemala, such as machinery and instruments, is asserted to constitute compliance with the working clause, but the manifest object of the condition in the Act is to cause the establishment of new manufactories and enterprises in the country, and it is difficult to see how mere importation can meet the requirements. Working.

*Marking.*—No actions in respect of infringements can be brought unless the patented articles legitimately on the market have been marked "patented," together with the number of the patent. Marking.

*Assignments.*—A patent may be assigned, but either the assignor or assignee must be bound to pay the annual taxes. Assignments must be registered in the *Diario Oficial*, and should in the case of British subjects be executed before a notary public and legalised by a Guatemalan consul. Assignments.

## HAWAII.

Hawaii.

(Law of 29th August, 1884.)

*Patentee.*—Only the true and first inventor is entitled to a patent. Patentee.

**Hawaii.**

Duration of Patent.

*Duration of Patent.*—Ten years from date of issue, but limited by the term of any existing prior foreign patent.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The invention should not have been publicly used or published either in Hawaii or elsewhere. But where an invention has been patented elsewhere, a valid patent can be obtained in Hawaii for the invention, granted that it has not been in public use in Hawaii for more than one year.

Taxes.

*Taxes.*—None after issue of patent.

Working.

*Working.*—The patentee is not obliged to work the invention in Hawaii.

Assignments.

*Assignments.*—Assignments should be acknowledged before a notary public, and must be recorded within three months from date of execution.

Government Fees.

*Government Fees.*—On application 5 dollars are payable. The Commissioner of Patents is paid a fee of 20 dollars for examination, and a tax of 5 dollars is payable on the issue of the patent. No further payments are required.

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**Holland.**

## HOLLAND.*

Holland has at present no Patent Law; but it is expected and hoped that this state of things will not much longer continue. The Queen in her Address from the Throne in September, 1901, mentioned a new Patent Law as one of the measures intended to be submitted to Parliament.

**Honduras (Republic).**

## HONDURAS† (Republic).

Honduras has no Patent Law; but the Government will protect inventions of special utility by introducing and carrying a Bill to that effect. The cost of such a grant necessarily varies, but the average expense is about £50.

## HONG KONG.

Hong Kong.

(ORDINANCE OF 1892.)

*Patentee.*—The patentee, inventor, or proprietor, by assignment or otherwise, of an invention which has already been patented in Great Britain is alone entitled to obtain a patent for the same invention in Hong Kong. Patentee.

*Duration of Patent.*—The term is limited to expire with that of the British patent. If the British patent is extended, the Hong Kong patent may be similarly extended. Duration of Patent.

*Novelty: Prior Publication.*—The form of petition (Schedule A) requires the applicant to declare that the invention is not now and has not been publicly used in the colony, but the Act says nothing about novelty, and it may be taken that, whether so used or not, the proprietor of a British patent has a right to a patent in Hong Kong. Novelty. Prior Publication.

*Taxes.*—None after issue. Taxes.

*Working.*—No requirements. Working.

## HUNGARY.

Hungary.

(LAW OF 7TH JULY, 1895, OPERATING SINCE 1ST MARCH, 1896.)

*Patentee.*—The true inventor, or his successors, assigns, or legal representatives, may obtain a patent. A firm or corporation may apply for and obtain a patent in its own name if it is the assignee of the inventor. Patentee.

*Duration of Patent.*—Patents of Invention are granted for fifteen years, dating from the day of application. Patents of Addition are also granted, expiring with the original patent. These can only be obtained by the original patentee. Patents of Improvement on an original patent are granted for fifteen years—during the first year only to the original patentee, and afterwards to him or to others. An application for a Patent of Improvement if made by some one Duration of Patent.

Hungary. other than the patentee during the first year is kept secret, and if at the end of that time the original patentee has not applied for a similar improvement a patent is issued to the subsequent inventor.

Subject-Matter. *Subject-Matter.*—Generally speaking, the subject-matter of valid patents agrees with the practice in most other States. But no patent is granted for an invention contrary to law or against public morals, nor for war material, nor medicines, foods, chemical products, and the like, although processes for the production of such things are patentable.

Novelty. Effect of Prior Patent. *Novelty: Effect of Prior Patent.* The invention must not have been previously used or published in Hungary or elsewhere so as to have become known to persons versed in the art. Publication of a Patent Specification in another country will vitiate novelty unless there is a reciprocal Treaty in force between Hungary and the State where patent publication took place. The novelty of an invention is not enquired into by the Patent Office.

Working. *Working.*—A patent may be revoked unless within three years from the publication of the grant the patentee works his patent in Hungary to an extent adequate to the demands of the country. But no revocation takes place until the patentee has been warned and sufficient time given him to comply with the requirements. Revocation may be avoided by granting licences to those desirous of working the patent.

Taxes. *Taxes.*—Besides the tax on application there are annual taxes on the patent, beginning with 40 kronen for the first year, and rising progressively to 500 kronen for the fifteenth year. Thirty days' grace without fine and thirty days with a fine of 20 kronen are allowed for the payment of any annuity.

Assignments. *Assignments.*—A patent may be assigned wholly or in part, and licences may be issued by the patentee. Assignments and exclusive licences should be registered in the Patent Office to be of effect against third parties taking without notice.

## ICELAND.

Iceland.

Iceland (which is a Danish Possession) has no Patent Law, but patents are granted in the same manner and upon the same terms and conditions as in Denmark. (See "Denmark.")

## INDIA.

India.

(Act No. 5 of 1888.)

Patentee.

*Patentee.*—Patents are granted only to the true inventor, his assignee, or legal representative. The term "inventor" does not include the first importer.

Duration of patent.

*Duration of Patent.*—Patents are granted for fourteen years, and are limited by the duration of any prior foreign patent. Thus an Indian patent founded on a prior British patent will expire with the British patent.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—When a British patent has already been applied for or obtained, an application by the inventor for an Indian patent may be filed at any time within one year from the *actual sealing* of the British Letters Patent. But in such a case the invention must not have been known or publicly used *in India* before the date of the British application. Use or publication in India between the date of the British application and the expiry of one year from the sealing of the British patent will not prejudice the Indian patent, whether such use or publication takes place in India or in the United Kingdom. But in the case of an original Indian application the invention must be absolutely new and unknown in India: and in the case of an application by a foreign patentee *i.e.* a patentee other than British —his application in India must be made within one year from the *actual date* of his prior foreign patent, and before any use or publication of the invention in India.

India.

Taxes.

*Taxes.*—As is the case in Great Britain, the Indian patent remains untaxed until the end of the fourth year of its existence, when annual taxes of 50 rupees from the fourth to the eighth year, and 100 rupees from the eighth to the thirteenth year, fall due to be paid. Extensions of time of from one to three months may be had, subject to a fine of from 10 to 50 rupees for payment of these taxes.

Working.

*Working.*—There are no requirements as to working, nor as to importation or marking.

Assignments.

*Assignments.*—Assignments may be drawn in any usual form, and must be registered at the office of the Secretary of the Government of India. Compulsory licences may in certain cases be applied for and enforced.

Italy.

## ITALY.*

(LAW OF 31ST JANUARY, 1864, WHEREBY THE SARDINIAN LAW OF 30TH OCTOBER, 1859, WAS EXTENDED TO THE WHOLE KINGDOM.)

Patentee.

*Patentee.*—In original applications by subjects the applicant must be the true and first inventor. In the case of inventions already patented abroad the true inventor or his assignee (which term includes an individual, a firm, or a corporation) may obtain a valid patent.

Duration of Patent.

*Duration of Patent.*—Patents are granted for from one to fifteen years, as desired by the applicant. In most cases it is advisable to apply in the first instance for a six years' patent, because in that case *two* years are granted within which to work the invention, whereas for a less term *one* year only is allowed. The six years' patent can afterwards be prolonged to the full term of fifteen years, either annually or by terms of years as desired. An Italian patent for an invention which has been already patented abroad expires with the foreign prior patent

which has been granted for the longest term. Patents of Addition are granted, to expire with the original patent, of which they form a part. Italy.

*Novelty: Effect of Prior Patent or Publication.*—When a foreign patent has been already applied for or obtained, a valid patent may be had in Italy for the same invention at any time during the existence of the said foreign patent, even when published and in general use. But in that case the Italian application should be made before the invention has become publicly known or been put to public use in Italy by persons *other than the inventor or patentee*. When an original application is made in Italy, the invention must not have been known or publicly used in the kingdom before the date of application. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—When the patent is applied for and the term of grant fixed, a proportional tax on the number of years agreed upon is calculated and paid, at the rate of 10 lire per annum. In addition to this there are annual taxes of 40 lire for each of the first three years; 65 lire for each of the following three years; 90 lire for the next three years; 115 lire for the tenth, eleventh, and twelfth years; and 140 lire for each of the three last years. Three months' grace without fine is allowed within which to pay these taxes. Patents of Addition are subject only to the payment in advance of a fee of 20 lire. Taxes.

*Working.*—If the term of patent right is less than six years, the patent must be worked in Italy before the expiry of one year from the date of the patent, and must not cease during any one year thereafter. If the term of the patent is for six years or more, then two years are allowed within which to work the patent, and the working must not cease during any two years thereafter. Where the working has been omitted, owing to causes which were beyond the patentee's control, his failure to work may be condoned so as not to entail forfeiture of his patent rights. As a rule, the Italian Courts have shown themselves inclined to favour patentees, but it may be said that lack of means has not been held to constitute a good excuse. When the patent is for a machine, the best plan is to import the machine, preferably in parts. Working.

Italy

and put it together and operate it in Italy. But a process patent should be worked by going through the process there. In all cases a properly attested certificate of the working should be obtained and filed by the patentee. Importation is allowed, and there are no provisions as to marking patented articles.

Assignments.

*Assignments.*—When a patent is assigned *in toto* the assignee becomes bound to pay the taxes or renewal fees. When only partly assigned, or when assigned in distinct shares or to separate individuals, not having common interests, registration can only be effected upon payment of the whole of the taxes still due in the future upon the remainder of the term of the patent right. It will be remembered that a provision similar to the latter, but applicable to all forms of assignment, exists in the French Law.

Jamaica.

## JAMAICA.

(Law No. 15 of 27th May, 1891.)

Patentee.

*Patentee.*—The intention of the Act is evidently to confine the grant of Letters Patent to the true and first inventor or his authorised attorney. But, with the widening of the meaning of the term "inventor," it is the custom for assignees and first importers to apply for patents of which they are in no sense the authors. There is, however, no decision to the effect that Letters Patent so granted are invalid.

Duration of Patent.

*Duration of Patent.*—Patents are granted for fourteen years, and when prior foreign patents exist the patent in Jamaica expires with the foreign patent having the shortest term. As is the case in the United States and in most other countries, a valid patent cannot be obtained for an invention the foreign patent for which has expired. Patents of Addition are granted, which expire with the original patent.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The invention should not, at the date of application, have

been introduced into public and common use in Jamaica. With this proviso, inventions patented and published in other countries may be validly patented in Jamaica at any time during the term of the foreign mother patent. Jamaica.

*Taxes.*—No taxes are due after issue. Taxes.

*Working.* The invention must be worked within two years from the date of the patent. Importation and operation of a patented apparatus have been held sufficient to fulfil the requirements of working in Jamaica. The goods need not be marked. Working.

*Assignments.* These should be registered in the office of the Colonial Secretary. Assignments.

## JAPAN.* Japan.

(LAW DATED DECEMBER, 1888, AND OPERATIVE SINCE 1ST FEBRUARY, 1890.)

*Patentees.*—Subjects and citizens of those countries which have treaties with Japan containing the "most favoured nation" clause are competent to obtain patents in Japan. The countries at present in that position are Great Britain, United States, France, Spain, Italy, Belgium, Portugal, Germany, Russia, and Holland. The applicant must be the actual inventor, but the patent may be issued to the inventor and an assignee jointly, or to an assignee alone upon a request to that effect by the inventor. Mere importers cannot obtain a patent, nor will a grant be made to a corporation. No official in the Patent Office can obtain a patent. Patentees.

*Duration of Patent.*—Patents are granted for five, ten, or fifteen years, at the option of the applicant. The term of grant cannot be altered after the issue of the patent. Patents of Improvement may also be had either by the original inventor or by others. A patent may be amended and re-issued. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention must be new, and must not have been put to public use or published in Japan or elsewhere at the date Novelty: Effect of Prior Patent or Publication.

Japan.

of application. An invention patented in another country but not published in Japan may also be patented there. But if publication has taken place in Japan (for instance, by the importation of the British Specification) a Japanese patent cannot be obtained, except under the Convention.

Subject-Matter.

*Subject-Matter.* Generally, the subject-matter of patents in Japan is the same as subject-matter in most other countries, but foods, drinks, and medicines cannot be patented.

Taxes.

*Taxes.* There are no annual taxes.

Working.

*Working.* The invention must be *bonâ fide* and commercially put in practice in Japan within three years from date of grant, and must not be suspended during any period of three years. Commercial importation of the patented goods is forbidden.

Models.

*Models.* Where practicable models (but not necessarily working models) of the invention must be supplied with the application, or within ninety days of demand. The model should not exceed 11½ inches in length, breadth, or height.

Assignments.

*Assignments.* Patents may be assigned or mortgaged, and the assignment or mortgage, to be valid against third parties taking without notice, must be registered in the Patent Office.

Marking.

*Marking.* Patented articles must be marked as such, otherwise the patentee cannot sue for infringements.

## LEEWARD ISLANDS.

Leeward Islands.

### (Antigua, Anguilla, Dominica, Montserrat, Nevis, St. Christopher, and Virgin Islands.)

(Act No. 12 of 1876, and No. 16 of 1878.)

*Patentee.*—The true and first inventor or first importer.

Patentee.

Duration of Patent.

*Duration of Patent.* Patents are granted for fourteen years, expiring with any prior foreign patents. Extensions may sometimes be obtained.

Leeward Islands.

*Novelty: Effect of Prior Patent or Publication.*—Prior publication or patents in another country will not prevent the grant of a valid patent in the Leewards, if the invention is not known or used in the colonies at the time of application being made. Novelty Effect of Prior Patent or Publication.

*Taxes.* Before the end of the third year a tax of £10 is payable, and before the end of the seventh year a further tax of £20. No prolongation of time is obtainable if these taxes should be missed. The patent must be forwarded for endorsement and the payment of the taxes. Taxes.

*Working.* No working is necessary. Working

*Assignments.* These may be in any suitable form, and should be recorded in the Register of Proprietors. Assignments.

*Government Fees.* In addition to the taxes already mentioned, the fees payable on application and issue of the patent amount to £15, and those to the Attorney-General to about £20. Government Fees.

## LIBERIA. Liberia.

(Act of 23rd December, 1864.)

*Patentee.*—The true and first inventor, his legal representatives or assigns. Patentee.

*Duration of Patent.*—Twenty years. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention, whether sought to be protected by a citizen of Liberia or a foreigner, must not be known or published within the limits of the Republic at the date of application. A prior patent in another country will not prevent the same inventor from obtaining a valid patent in Liberia. Novelty. Effect of Prior Patent or Publication.

*Taxes.*—None after issue. Taxes.

*Working.*—Patents granted to aliens must be worked within three years of date. Working.

*Assignments.*—By Section 8 patents are assignable in law. Assignments.

*Government Fees.*—Fifty dollars are payable on application. Government Fees.

Luxemburg.

## LUXEMBURG.

(Law of 30th June, 1880.)

Patentee. *Patentee.*—The first applicant or applicants. A firm or corporation may be the grantee of a patent. A patent may, however, be revoked if it can be proved that the grantee has procured the patent in fraud of another person.

Duration of Patent. *Duration of Patent.*—Patents are granted for fifteen years. Patents of Addition are also granted, which expire with the original patent.

Novelty Effect of Prior Patent or Publication. *Novelty: Effect of Prior Patent or Publication.*—The patent must not be known or publicly used in Luxemburg at the date of application. Neither must it have been published or openly worked in any one of the States of the German Customs Union. If these conditions as to novelty hold good, the existence of prior foreign patents will not prejudice the Luxemburg grant.

Taxes. *Taxes.*—There are annual taxes of 10 francs for the first year, 20 francs for the second year, and so on, increasing 10 francs per annum during the term of the patent. Three months' grace is allowed for making payment.

Working. *Working.*—The patent should be worked within three years from date. Importation and operation of a patented machine will satisfy requirements.

N.B.—The patent lapses if a patent for the same invention has not been applied for, or is not within three months applied for, in the States with which the Grand Duchy may be connected by treaties of Customs Union; and if such collateral patent expires from any cause, the Luxemburg patent also expires. At present the German patent is the only one answering to the indicated description, so that unless the inventor possesses or intends to apply for a German patent the Luxemburg grant would be of no use to him.

Madeira Islands.

## MADEIRA ISLANDS.

(Covered by Portuguese Patent.)

## MALTA.

Malta.

(Ordinance No. 13 of 1889; Ordinance No. 5 of 1893; Ordinance No. 1 of 1894.)

*Patentee.*—The true and first inventor or his authorised attorney. Patentee.

*Duration of Patent.* Patents are granted for fourteen years, limited by the term of any prior patent in another country. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been published or openly used either in Malta or elsewhere. A patent in another country will not prejudice the Maltese grant if the invention has not been made publicly known. The publication of the British, American, or German Specification would prevent the obtaining of a valid Maltese patent. Novelty Effect of Prior Patent or Publication.

*Taxes.*—Before the end of the fourth year £4; before the end of the fifth, sixth, and seventh years £5; before the end of the eighth and ninth years £7 10s.; before the end of the tenth, eleventh, twelfth, and thirteenth years £10. The payment of each tax must be endorsed on the Letters Patent. Taxes.

*Working.*—If the invention is not worked in Malta within twelve months, or if the working is thereafter suspended for a continuous period of twelve months, the patentee may be required to assign his rights, or grant the use of the patent to some competent manufacturer, for a consideration to be determined by a Civil Court. Inquiry from those competent to give an opinion points to the conclusion that importation and sale of the patented articles would satisfy working requirements. Working.

*Assignments.*—There are no provisions as to assignments, but it may be assumed that these may be prepared in the usual form in the English language. Assignments.

## MARTINIQUE.

Martinique.

(Covered by French Patent.)

Mauritius.

## MAURITIUS.

(Ordinance No. 16 of 1875.)

Patentee. *Patentee.* Patents are granted to the actual inventor, whether native or alien, and to the representative or assigns of the actual inventor. A mere importer cannot obtain a valid patent.

Duration of Patent. *Duration of Patent.* Patents are granted for a term of fifteen years, but this term is limited by the duration of any prior patent, whether British or foreign. Extension of the term may be obtained if the Governor in Council thinks that such extension is called for.

Novelty. Effect of Prior Patent or Publication. *Novelty: Effect of Prior Patent or Publication.*—An inventor who has obtained a British patent may take out a patent in Mauritius within one year from the date of the British patent, although the invention is publicly known and used in Mauritius at the date of application there. But such publication in Mauritius must not have taken place prior to the date of the British patent. There is no examination.

Taxes. *Taxes.*—None after issue of patent.

Working. *Working.*—There are no requirements as to working, and no provisions as to importation and marking.

Assignments. *Assignments* may be in any usual form, and must be registered and transcribed at the Mortgage Office.

Government Fees. *Government Fees.*—£10 on issue of the Procureur Général's certificate of protection, and £2 on the sealing of the patent.

Mexico.

## MEXICO. †

(Law of 7th June, 1890; Decree of 27th May, 1896.)

Patentee. *Patentee.*—Patents are granted to inventors, or to the improvers of any manufacture or branch of industry, or to their lawful representatives.

*Duration of Patent.* Patents are granted for twenty years, but where prior foreign patents exist the Mexican patent expires with the first or mother patent of the series. Extensions for five years are sometimes granted if the executive thinks fit. Existing ten years' patents, under the old Act, may be extended to the new term of twenty years. Mexico. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.* The application must be made before the invention has been publicly worked in Mexico or elsewhere. Publication of the specifications of prior patents by Foreign Patent Offices, or publicity given by International or other Exhibitions, is not considered to constitute publication. Apart from this requirement as to novelty, the existence of prior foreign patents is no bar to the granting of a valid Mexican patent. Patents are granted without examination. Novelty. Effect of Prior Patents. Publication.

*Working.*—By Decree of 27th May, 1896, the law has been so far amended that it is no longer necessary to prove the working of patented inventions in Mexico. Working.

*Taxes.*—By the same Decree the following taxes were imposed: viz., before the expiry of the fifth year 50 pesos; before the expiry of the tenth year 75 pesos; before the expiry of the fifteenth year 100 pesos. Taxes.

*Importation.*—Importation of the patented goods is allowed. In the interest of applicants no importation of the goods should be effected until after the grant of the patent. Importation.

*Assignments.*—A Mexican patent may be assigned at any time and place and in any language, although preferably in Spanish. The documents should be executed before a notary, legalised by a Mexican consul, and must be registered in the Mexican Patent Office. Assignments.

## MOROCCO. Morocco.

(Morocco has no Patent Law.)

Natal.

## NATAL.

### (Now including Zululand.)

(Laws No. 4 of 1870, No. 5 of 1871, and No. 32 of 1884.)

Patentee. *Patentee.*—Patents are granted to the true and first inventor. The Act provides that the word "inventor" shall bear the same interpretation which is put upon it in British practice. Therefore it is submitted that the true and first inventor includes the true and first importer to the colony.

Duration of Patent. *Duration of Patent.*—Patents are granted for fourteen years from the date of application. If prior foreign patents exist, the patent in Natal will expire with that foreign patent which first expires. Extensions of patents may, in some cases, be obtained.

Novelty: Effect of Prior Patent or Publication. *Novelty: Effect of Prior Patent or Publication.*—The sole essential is that the invention should not be publicly known or publicly used in Natal at the date of application. Prior patenting, or publication, or use elsewhere, will have no prejudicial effect upon the validity of the Natal patent. There is no preliminary examination.

Taxes. *Taxes.*—Before the expiry of the third year of the patent a tax of £5 is due, and before the expiry of the seventh year a tax of £10.

Working. *Working.*—There is no obligation to work the patent in the colony, and no provision as to importation or marking.

Assignments. *Assignments.*—These may be prepared in any usual form, in duplicate, and must be entered in the Register of Proprietors.

Newfoundland.

## NEWFOUNDLAND.

(Consolidated Statutes, Title XV., Cap. 54, Sec. 1.)

Patentee. *Patentee.*—The true inventor or the representative or assignee of the inventor.

Newfoundland.

*Duration of Patent.*—Patents run for fourteen years, but are limited by the term of any prior foreign patent. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—A patent may be obtained in Newfoundland for an invention already patented and published abroad, but it must not be publicly known or used in the island. There is no examination as to novelty. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—There are no taxes payable after issue. Taxes.

*Working.*—The invention should be brought into operation in Newfoundland within two years from date of patent. It is understood that importation and sale of the patented goods will constitute a valid working. There is no obligation to mark the goods. Working.

*Models and Specimens.*—When the invention relates to a machine, the patent authorities are empowered to demand a model; and in compositions of matter (except explosives) specimens of the ingredients and of the composition may be required. In practice neither models nor specimens are often asked for. Models and Specimens.

## NEW SOUTH WALES.

New South Wales.

(Act 24 of 6th December, 1852; Act 3 of 8th July, 1887: Amending Act, 1895; Regulations of 1898.)

*Patentee.*—The inventor, or his assignee, or nominee, or agent, or the first importer, or a firm or corporation. Patentee.

*Duration of Patent.*—Patents are granted for fourteen years from the date of the filing of the application. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention should not at the time of application have been published, made, sold, or used in New South Wales. Publication abroad, or the issue of prior foreign patents, will not prevent the obtaining of a valid patent in New South Wales. A preliminary examination is not usual, but it is provided in the Act that it may be ordered. Novelty: Effect of Prior Patent or Publication.

New South Wales.

Taxes.

*Taxes.*—There are no taxes after the issue of the patent.

Working.

*Working.*—There are no requirements as to working, importation, or marking.

Assignments and Licences.

*Assignments and Licences.*—These must be registered in the office of the Examiner of Patents; otherwise they are null and void. The periods within which registration must be effected are as follows:—When executed within the colony, fourteen days; within any of the other Australian colonies, thirty days; other places, ninety days. The documents are prepared in the English language, in any suitable form, and must be in duplicate.

New Zealand.

## NEW ZEALAND.*

(Act No. 12 of 1889; Amending Act of 1897.)

Patentee.

*Patentee.*—Patents are granted to the true inventor, or his nominee or assignee, or to the authorised first importer. A company or corporation may be the assignees, but cannot be the grantees of Letters Patent.

Duration of Patent.

*Duration of Patent.*—Patents are granted for fourteen years from the date of the acceptance of the specification. The Act makes provision for the extension of a patent for seven, and in exceptional cases for fourteen, years.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—To obtain a valid patent the invention must not have been published or made publicly known or openly used in New Zealand before the date of application. Subject to this condition, the existence and publication of British or foreign patents will not militate against the validity of the New Zealand patent. The application is not subject to any examination as to novelty or utility.

Taxes.

*Taxes.*—A tax of £5 is payable before the expiration of the fourth year of patent right, and a further sum of £10 is payable before the expiry of the seventh year. An extension of time of three months for the payment of these taxes may be had on payment of a fine of £4.

*Working.*—There are now, since 1st January, 1890, no requirements as to working, and none as to importation and marking. New Zealand. Working.

*Assignments.*—These may be drawn in the same form as British assignments. The documents are prepared in duplicate, and should be accompanied by a request for entry in the Register of Patents, signed by the assignee. Assignments.

## NICARAGUA. Nicaragua.

There is no Patent law in Nicaragua, but inventions are protected by special legislative grant if they promise to be of practical utility to the country. The cost of such grant averages from £50 to £60. The terms usually granted are ten years for a Patent of Invention; seven years for a Patent of Improvement; and five years for a Patent of Importation.

## NORWAY. Norway.

(Law of 16th June, 1885.)

*Patentee.*—Patents are granted to the actual inventor only, or to some one directly deriving his rights from the inventor. Patents of Addition are granted up to within two years from the date of the original grant, and then only to the original patentee. Patentee.

*Duration of Patent.*—Patents are granted for fifteen years. Such Patents of Addition as may be granted expire with the original patent. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—A valid patent cannot be obtained for an invention sufficiently well known in Norway, to be put in practice by other persons. But publication in print, or the exhibition of the invention in Norway, will not prevent the grant of a valid patent, if the application is made within six months of such publication or exhibition. But notice of such Novelty: Effect of Prior Patent or Publication.

Norway.

publication or exhibition should be given to the Patent Office. The existence of a foreign patent will be no bar to the grant of a Norwegian patent. There is no preliminary examination as to novelty.

Taxes.

*Taxes.*—Annual taxes are payable of 10 kroner for the second year, 15 kroner for the third, and so on, increasing 5 kroner per annum. Three months' grace may be obtained to make these payments, but under a fine of one fifth of the tax sought to be paid.

Working.

*Working.*—Inventions are required to be worked in Norway within three years from date of patent, and must not at any time thereafter be discontinued for an entire year. No proof of working is required by the authorities, but it is advisable to obtain a certificate of working on each occasion. In practice importation and exposure for sale are considered to meet requirements. The writer has been informed by a Norwegian correspondent that mere advertisement of the patented articles in a Norwegian journal is generally considered to satisfy requirements, but this suggestion must be taken with great caution. There is no foundation for it in the Act.

Assignments.

*Assignments* may be prepared in accordance with the law of the country where the contracting parties are domiciled. They should be legalised by a Norwegian consul, and must be registered at the Patent Office in Norway.

Orange River Colony.

## ORANGE RIVER COLONY

### (Late Orange Free State).

(Ordinance No. 10 of 1898.)

As the result of military operations in South Africa the late Orange Free State has become annexed to the British Empire under the title of the Orange River Colony. The British Comptroller of Patents, in a notice under date the 10th November, 1900, announced in the *Patent Journal* that he had been informed by the legal adviser to the military authorities in the colony that for the present no

change of any sort has been made in the existing Patent law, with the exception that applications may be filed either in English or in Dutch. Orange River Colony.

*Patentees.* Patents are granted to the actual inventors, whether citizens or foreigners, or to their authorised representatives or assignees. With the inventor there may be associated another or other applicants who are not inventors, or a firm or corporation may be associated with the inventor. In all cases, however, the inventor must join in the application, and must be indicated as such in the application form. Depending upon the liberal interpretation of the word "inventor," patents have in many cases been granted to first importers, but in the absence of any judicial decision on this point it is impossible to say whether such grants would be valid or not, although Article 43 does not read very favourably to the supposititious rights of a mere importer. Patentee.

*Duration of Patents.*—Patents are granted for fourteen years, but this term is limited by the duration of any prior foreign patent having the shortest term. Duration of Patents.

*Novelty: Effect of Prior Patent or Publication.*—The grant of prior foreign patents, or the publication of the invention in other countries, will not prevent the obtaining of a valid patent in the Orange River Colony, provided the invention is still new and unpublished in the colony at the time of application. By Article 45 of the Ordinance the exhibition or publication or use of the invention in or in connection with an international or industrial exhibition in the colony will not constitute publication in the eye of the law, granted that before such exhibition or publication the inventor has given written notice of his intention to exhibit, and makes application for a patent within six months after the opening of the exhibition. There is no examination as to utility or novelty. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—On or before the expiration of the third year of the patent a renewal tax of £5 is due to be paid, and a similar tax of £10 on or before the expiry of the seventh year. The Letters Patent must be produced to have the Taxes.

Orange River Colony.

payment of each tax endorsed thereon. An enlargement of the time for making this payment may be had for three months, subject to a fine of £5 in addition to the tax.

Working.

*Working.*—No requirements. There are also no provisions as to importation or marking.

Assignment and Licences.

*Assignments and Licences.*—Assignments should be in duplicate, signed by the assignor and legalised in the case of non-residents by a notary public. For the purposes of registration the assignment should be accompanied by a power of attorney, signed by the *assignee*, and, if executed by a non-resident, legalised by a notary public, empowering the attorney to record the assignment and pay the fees. Licences may be granted and recorded in a similar manner, and by Article 21, on the petition of any party who has been refused a licence and who is able to show that (*a*) the patent is not being used in the colony, or that (*b*) the reasonable requirements of the public are not being served, or that (*c*) a person is being prevented from using another invention to the best advantage, then the authorities may compel the patentee to grant licences on reasonable terms.

Government Fees.

*Government Fees.*—On depositing application, £1 1s. On certificate of allowance, £1 1s. On sealing Letters Patent a sealing fee is fixed which shall not be less than £10 nor more than £50. In practice this sealing fee was almost invariably fixed at £25. The Schedule says that the amount is fixed "according to the importance of the grant." The writer is given to understand that under British administration a moderate fixed fee is likely to be the rule.

Paraguay.

## PARAGUAY.†

Paraguay has no Patent Law, but inventions may be protected by special Act, the cost of which is usually about from £80 to £100. The documents are in form similar to those employed for Chili.

The Government of Paraguay is credited with being extremely desirous to encourage the introduction of useful

industries into the country. Where the inventor establishes a manufactory in Paraguay concessions in the shape of remission of taxation, land sites, free importation of machinery, &c., are readily made, and in some instances the Government will even advance capital for the installation of plant and for working expenses. Paraguay.

## PERU. Peru.

(Law of 28th January, 1869; Decree of 20th November, 1894; Amending Act of 3rd January, 1896.)

*Patentee.*—The true and first inventor or first importer. Patents may be issued to corporations and firms and to aliens as well as natives. Patentee.

*Duration of Patents.*—The extreme duration is ten years. It is said by the Act of 1896 that the applicant may himself fix the term of grant at from one to ten years. But by a recent opinion of the President of Peru this freedom accorded to the applicant is considered unconstitutional, and in future the Government will fix the term, which will in most cases be ten years, unless there are peculiar circumstances which justify a reduction of that term. Duration of Patents.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been published or publicly used in Peru. Publication abroad, or the existence of a prior foreign patent, will not bar the grant of a patent in Peru. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—The applicant must pay for the stamps upon the specification, each sheet of the specification and drawings requiring a separate stamp. He must also pay certain expert fees amounting usually to 150 soles, and in addition there is a final fee due on issue of the grant amounting to 50 soles. After the issue of the patent no further taxes or annuities are payable. Taxes.

*Working.*—The invention must be commercially worked in Peru within two years of grant or within such time Working.

Peru. for working as may be expressed in the patent. Before the Act of 1891 it was the custom to exact a bond or deposit of 2000 soles to ensure that working should be carried out, but such deposit is no longer required. Importation of the patented goods is not permitted, but in difficult cases it is suggested that to meet the working requirements the parts of the patented machine or article might be imported separately as general machinery and fitted together in Peru. Registration of the working is not necessary, but the working must be proved if the validity of the patent should be afterwards challenged.

Assignments. *Assignments.* These should be prepared in duplicate in Spanish, and in the case of assignments by British or United States patentees should be executed before a notary public and legalised by a Peruvian consul. The assignment should be registered in Peru, and to enable the agent in Peru to effect the registration the *assignee* must sign a power of attorney addressed to the Peruvian agent before a notary public and legalised by the consul as aforesaid.

## PHILIPPINE ISLANDS.

Philippine Islands.

Until 25th July, 1898, the Spanish patent could be extended for a small extra fee to the Spanish Colonies. But by a Ministerial Decree, dated as above, the extension of Spanish patents to the Colonies is suspended, so that until some stable Government is established in the Philippines there are no means of protecting inventions in those islands.

## PORTO RICO.

Porto Rico.

This island has been annexed to the United States, and will in future be subject to the provisions of the Patent Laws of these States.

# PORTUGAL.*

Portugal.

## (LAW OF 21st MAY, 1896.)

*Patentee.*—The actual inventor or first importer, the latter covering a firm or corporation. Patentee.

*Duration of Patent.*—Patents of Invention are granted to the actual inventor for any term less than or up to fifteen years, and Patents of Invention to the first importer for a maximum period of ten years. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—In the case of Patents of Invention granted to the first inventor the invention must be new in Portugal, but the publication in Portugal of a specification or description arising out of the grant of a patent in another country will not bar the grant of a Portuguese patent if there is a special Convention between Portugal and that other country, or if the application has been made before the expiry of the delay fixed for the right of priority in the International Convention, of which Portugal is an adherent. In the case of applications for Patents of Importation it is only necessary that the invention shall not have been publicly worked in Portugal prior to the application. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—A tax of 3 milreis is payable in advance for each year for which a Patent of Invention may have been demanded. For Patents of Addition a tax of 3 milreis is payable on application. For Patents of Importation a tax of 20 milreis (about £1) is payable on application. At the same time, the applicant must deposit at the General Bank a sum of 500 milreis, which will be returned to him if the patent is refused. When the patent is granted the applicant must make a deposit of from 5000 to 50,000 milreis, and if this final deposit is not made the 500 milreis already deposited become forfeited. This final deposit may, on the patentee establishing a manufactory, be replaced by a mortgage on land, building site, or machinery used in manufacturing the invention. Taxes.

*Working.*—A Patent of Invention must be worked within two years from date, and must not be discontinued during Working.

Portugal.

any two following years. For Patents of Importation working must be begun within a year from grant, and must not cease during any one following year. The Government may fix the minimum limit of production. Importation of the patented goods must not take place.

Assignments.

*Assignments.*—These are effected by notarial deed drawn up in Portugal and endorsed on the Letters Patent by the Patent Office. The transfer must be registered in the Department of Industry. Patents of Importation can only be assigned with the consent of the Government.

## PORTUGUESE COLONIES.

Portuguese Colonies.

By a Decree of 28th July, 1894, the extension to or granting of patents in Portuguese Colonies has been discontinued.

## QUEENSLAND.*

Queensland.

(Act No. 13 of 13th October, 1884; Act No. 5 of 4th September, 1886; Amendment Act of 1890; Rules of 1896-7-8.)

Patentee.

*Patentee.*—The "Patentee" is defined as the person for the time being entitled to the benefit of a patent. Accordingly, in practice patents are granted to the inventor alone or in conjunction with a capitalist, or to the inventor's assignee, or to the legal representative of a deceased inventor, provided the application is made within six months from the death of the inventor.

Duration of Patent.

*Duration of Patent.*—Patents are granted for fourteen years. Preliminary provisional protection for twelve months (limited to nine months for the time for filing the Complete) may be had in Queensland as in Great Britain.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The invention should not, prior to the date of application, have been published or openly used in Queensland. With this proviso the patenting or publication of the invention in

another country will not bar the grant of a patent in Queensland. There is a preliminary examination. Publication of an unpatented invention in an industrial exhibition held in the colony will have no hurtful effect, provided that notice is given to the Registrar of the intention to exhibit, and application for a patent is made within six months from the opening of the exhibition. Queensland.

*Taxes.* A tax of £5 is due before the expiry of the fourth year of the patent, and £10 before the expiry of the eighth year. In lieu of these amounts the taxes may be paid annually as follows: £1 before the expiry of the fourth and fifth years: £1 10s. before the expiry of the sixth, seventh, eighth, ninth, tenth, and eleventh years: and £2 before the expiry of the twelfth and thirteenth years. Taxes.

*Working.*—There is no obligation to work the patent. Working.

*Assignments.*—These may be prepared in any usual form, and should be registered in the Patent Office. The Registrar will not record the assignment until the Letters Patent are produced, so that he may endorse the assignment on the back thereof. Assignments.

## RUSSIA. Russia.

(Law of 20th May (1st June), 1896.)

*Patentee.*—Patents are granted indiscriminately to Russian subjects and to foreigners; to the true inventor or his legal assignee. Firms and corporations may also obtain patents. If different applications for the same invention are received on the same day the applicants must take a patent in their joint names, and if this suggestion is refused no patent will issue to either until the parties have decided their respective rights at law. Patents of importation are not now granted. Patentee.

*Duration of Patents.*—Patents are granted for fifteen years, but are limited by the duration of any prior foreign patent for the same invention. Where there are several Duration of Patents.

Russia. prior foreign patents of different terms the Russian patent expires with the prior patent of the shortest term. But the premature lapsing of a prior foreign patent by non-payment of fees or the like does not cause premature failing of the Russian patent. This was decided by a Departmental decision of 18th August, 1898 (No. 22166). Patents of Addition may be obtained expiring with the original patent.

Novelty: Effect of Prior Patent or Publication. *Novelty: Effect of Prior Patent or Publication.* The invention must be new in Russia: *i.e.* not publicly used or published in books or journals with sufficient exactness to instruct persons skilled in the art how to carry the invention into effect. But a distinction appears in practice to be drawn between books and journals and patent specifications and official gazettes, for these are not held to be such publication as will bar a Russian patent. Valid patents may be obtained in Russia after the issue of patents for the same invention in other countries, provided the application for the Russian patent is made by the true inventor or his legal representative.

Subject-Matter of Patents. *Subject-Matter of Patents.*—No patents can be obtained for mere abstract discoveries or principles nor for anything contrary to public morals. Chemical products, foods, beverages, and medicines are not patentable; neither are processes nor apparatus for the preparation of medicines. But processes and apparatus for the manufacture of chemical products, foods, and beverages are patentable. War material is not patentable, but weapons capable of being used by private persons as well as by the services are patentable.

Examination. *Examination.*—Applications for patents are submitted to a Technical Committee, presided over by the Directors of Commerce and Manufactures, or by one of the Sub-Directors. The examination concerns the novelty and subject-matter of the invention. On receiving his certificate of filing, the applicant may publish and work his invention openly in Russia without jeopardising his rights, but he cannot sue infringers until his patent is granted. He may, however, under Article 8 warn infringers that he will

proceed against them in respect of all torts committed between the date of filing and the grant, and in such circumstances his claims might be retrospective. Russia.

*Taxes.*—A tax of 30 roubles is payable on application, and a further 15 roubles in respect of the first year's tax is payable within three months of the allowance of the patent. Afterwards the following yearly taxes are payable: viz., 20 roubles for the second year; 25 for the third; 30 for the fourth; 40 for the fifth; 50 for the sixth; 75 for the seventh; 100 for the eighth; 125 for the ninth; 150 for the tenth; 200 for the eleventh; 250 for the twelfth; 300 for the thirteenth; 350 for the fourteenth; and 400 for the fifteenth year. Taxes.

*Working.* The patent must be worked before the expiry of five years from the date of signature of the patent. Nominal working is not accepted in Russia. The certificate of working, which must be obtained from a Russian official, will not be granted on mere perfunctory working, and if no such certificate is obtained and lodged at the Ministry the patent becomes void. Working.

*Assignments.*—Transfer of a patent must be notified to the Director of Commerce and Manufactures. This notification must be accompanied by the documents establishing the transfer. The assignment is then published in the *Messager Officiel* and in the *Journal du Ministère des Finances* at the cost of the assignee. A stamp duty of one fifth of one per cent. of the consideration is levied on each assignment. Assignments.

## ST. HELENA. St. Helena.

(Ordinance No. 3 of 1872.)

*Patentee.*—The grantee of a British patent, his executors, administrators, and assigns, may obtain letters of registration in St. Helena at any time during the existence of the British patent. Patentee.

St. Helena.

Duration of Patent.

*Duration of Patent.* The patent expires with the British patent, or with any extension thereof that may be granted.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.* So long as a British patent has been obtained, a patent in St. Helena is granted as a matter of course, and without regard to publication or public use.

Taxes.

*Taxes.*—None.

Working.

*Working.*—No requirements.

Assignments.

*Assignments* are made in the usual form.

Government Fees.

*Government Fees.* One guinea is payable to the Registrar on filing the specification.

St. Lucia. St. Vincent. Samoa. San Domingo. and San Salvador.

## ST. LUCIA, ST. VINCENT, SAMOA, SAN DOMINGO, and SAN SALVADOR.

These countries have no Patent Law, but in all of them protection for an invention can be obtained by special legislative Act, the expense varying from £25 to £200.

Servia.

## SERVIA.*

Although Servia is a member of the International Union, it has no Patent Law. It is expected, however, that a law will be passed shortly, as the Legislature is at present engaged on the preparation of a Bill.

Siam.

## SIAM.

There is no available mode of protecting inventions in Siam, but special legislative Acts may be furthered to protect inventions.

Sierra Leone.

## SIERRA LEONE.

Sierra Leone has no Patent Law, but inventions may be protected under special grant.

# SOUTH AFRICAN REPUBLIC (Late).

(See Transvaal.)

South African Republic (see Transvaal).

# SOUTH AUSTRALIA.

South Australia.

(Act No. 78 of 21st December, 1877; Act No. 201 of 1884; Patents Amendment Act, 1887.)

*Patentee.*—The true and first inventor or his personal representative or assignee. A corporation may obtain Letters Patent as assignees of the inventor or as the first importers or introducers. There is no decision as to whether "true and first inventor" includes the true and first importer, but in accordance with British practice many patents are taken out by first importers. Patentee.

*Duration of Patent.*—Patents are granted for fourteen years, limited to expire with the original or mother patent in those cases where prior patents for the same invention exist in other countries. Provisional protection for twelve months may be obtained. Duration of Patent.

*Novelty: Prior Patent or Publication.*—To ensure a valid patent the invention should not at the time of application be known or publicly used in South Australia. Inventions already patented abroad or in the mother country, but not publicly known in the colony, may be validly patented there, but no patent will be granted in respect of a foreign lapsed patent. Novelty: Prior Patent or Publication.

*Taxes.*—Before the end of the third year a tax of £2 10s. falls due, and before the end of the seventh year a further tax of £2 10s. No prolongation for making these payments is obtainable. The patent should be sent with the tax to have the payment endorsed. Taxes.

*Working.*—Under Clause 43 of the principal Act patents are liable, upon the application of an interested party, to be revoked by the Governor, if the invention has not been worked before the expiry of three years from date. In practice the working of South Australian patents is generally disregarded, and so far no case exists in which Working.

South Australia.

the power of revocation has been exercised upon this ground. Nevertheless, in the case of valuable inventions it would be wiser for the inventor to comply with the *clause*.

Assignments.

*Assignments.*—These may be in any convenient form, and must be filed in duplicate. Stamp duty is payable on the amount of the consideration money at the rate of 5s. per £100. Assignments must be endorsed as "certified as correct for the purposes of the Patent Acts of 1877 to 1887." This may be signed by one of the parties or by the local attorney or agent acting for the parties. A nominal consideration is professedly not allowed. The actual consideration should be stated, but a nominal consideration of £10 is not questioned. The assignment is registered in the Register of Proprietors.

Spain.

## SPAIN.*

(Law of 30th July, 1878.)

Patentee.

*Patentee.*—Patents are granted to any individual, firm, or corporation making application, whether originators of the invention or not.

Duration and Description of Patent.

*Duration and Description of Patent.*—Patents are of two kinds: *i.e.* Patents of Invention and Patents of Importation. Original applicants in Spain can obtain a patent for twenty years. If the invention has been already patented abroad, the patent in Spain is granted for ten years, but application must be made in Spain within two years from the date of the first foreign patent. If the applicant is merely an importer, the patent term is for five years only. Patents of Addition are granted, which expire with the original patent.

Novelty: Prior Patent or Publication.

*Novelty: Prior Patent or Publication.*—The Spanish application should be made before the invention has come into *public use in the Spanish dominions*. The existence, publication, or working of patents for the same invention in other countries is no hindrance to the obtaining of a

perfectly valid patent in Spain, so long as it is new there. The Spanish patent is, however, limited by the duration of the prior foreign mother patent. Spain.

*Taxes.*—Patents are subject to the payment of annual taxes amounting to 10 pesetas for the first year, 20 pesetas for the second, 30 pesetas for the third, and so on, increasing at the rate of 10 pesetas per annum. The peseta is equivalent to 10d. of English money. At the present date (1901) 21, as a war measure, all taxes have been increased forty per cent. Taxes.

*Working.*—The invention must be worked in Spain within two years from the issue of the patent, and must not be discontinued for a year and a day thereafter. The owners of patents are required to prove the first working before the Director of the Conservatory of Arts; subsequent workings need not be so proved. A merely perfunctory pretence of working, such as might serve in certain other countries, will not suffice in Spain. The patented articles should be actually made in Spain. Mere importation and working will not do. The goods may be imported for sale into Spain in any quantity. Working.

*Assignments.*—All assignments made out of Spain must be executed before a notary public, whose signature must be legalised by a Spanish consul. Assignments are registered in the Spanish Patent Office. All mention of consideration should be avoided. The Spanish consul is obliged to charge a heavy percentage on the consideration as stamp duty when legalising the documents. The assignment is good and valid though no consideration is expressed. Assignments.

## SPANISH COLONIES. Spanish Colonies.

By a Ministerial Order of the 28th July, 1898, the extension of Spanish patents to the colonies has been discontinued.

Straits Settlements.

## STRAITS SETTLEMENTS.

(Ordinance No. 12 of 1871.)

Patentee. *Patentee.*—Patents are granted to the actual inventor or his assignee, to the first importer, or to the patentee or proprietor of a British patent or invention patented in any British possession.

Duration of Patent. *Duration of Patent.*—Fourteen years is the term for which patents are granted, but this term is limited by the duration of any prior patent in another country.

Novelty: Prior Patent or Publication. *Novelty: Prior Patent or Publication.*—The invention is deemed to be new and patentable if not "publicly used" in the United Kingdom or in any British possession prior to the date of application in the colony. The use of the term "public use" would seem to point to the conclusion that publication of the specification in Great Britain, or publication in a newspaper or book, would not vitiate the claim of the patentee to a patent in the Straits Settlements, provided no public use had taken place. There is no examination as to novelty or utility.

Taxes. *Taxes.*—None after issue of patent.

Working. *Working.*—None required.

Assignments. *Assignments.*—Assignments must be prepared in duplicate and registered in the Register of Proprietors.

Sweden.

## SWEDEN.

(Law of 16th May, 1884. Amended by Law of 26th May, 1897. Operating from 1st January, 1898.)

Patentee. *Patentee.*—An applicant for a patent must be the actual inventor or his assignee. Corporations can only obtain patents as assignees of the inventor.

Duration of Patent. *Duration of Patent.* Patents are granted for fifteen years. Patents of Addition may be had expiring with the original patent.

Novelty: *Novelty: Effect of Prior Patent or Publication.*—No patent can be granted for an invention which has been

Sweden.

Effect of Prior Patent or Publication.

publicly used or published in Sweden. The fact that an invention has been shown at an International Exhibition will not bar a valid patent if application is made within six months from first exhibition. In the case of countries giving a similar concession to Sweden (*i.e.* members of the International Convention), an application in Sweden made within twelve months of the original application elsewhere will be dated as of the same date as the original application. But even if such application has not been made under the Convention, the mere existence of a prior foreign patent will not bar the grant of a Swedish patent if the invention has not been made known in Sweden. Applications are subject to a preliminary examination as to novelty.

Taxes.

*Taxes.*—An annual tax of 25 crowns is payable on the first, second, third, fourth, and fifth years; 50 crowns on the sixth, seventh, eighth, ninth, and tenth years; and 75 crowns for each of the five following years. Three months' extension of time within which to pay these taxes may be had, subject to a fine amounting to one fifth of the amount of the tax due.

Working.

*Working.*—The invention should be worked within three years from date of patent, and thereafter the working must not be discontinued for a year. The rules regulating the working are stringent. The time may sometimes be extended to four years in different cases. Importation of the patented goods is allowed, but this does not release the patentee from the obligation of working the invention in Sweden.

Assignments.

*Assignments.*—These should be executed in duplicate and legalised by a Swedish consul. The registration is effected on the request of the assignee.

## SWITZERLAND.*

Switzerland.

(Law of 15th November, 1888.)

*Patentees.* Patents are granted to the inventor or to his legal successors or assigns only.

**Switzerland.**

Grant of, and description of Patent.

*Duration and Description of Patent.*—The Swiss Patent Office makes it a rule that it will grant no patents for inventions which do not in themselves represent a visible and tangible marketable article. It follows from this short-sighted policy that patents cannot be obtained for mere new processes or methods of manufacture, although new products of new processes may be protected. To give time for the production of a specimen, or proof of the actual existence of the newly-invented thing or machine, the custom is to make provisional application for a patent in the first instance, which application must contain a full description and illustration of the invention, but need not be accompanied by specimens or proofs of actual existence. This provisional patent lasts for three years. During this term, or at the end of the three years, a definitive patent is granted upon the payment of the tax and on the production of the specimen of the invention, or, in the case of large objects, of photographs of the invention. The specimen might either be the actual thing itself, or it might assume the form of a scale model of the invention. In the case of large apparatus or articles not easy of transport, and where a model would be difficult or expensive to make, photographs of the invention will suffice. These photographs must show, as far as practicable, the parts which are claimed. For example, if the invention is a boiler, or a gas-making apparatus, containing arrangements of tubes, partitions, and parts which are essential to the invention, a mere outside view of the boiler or the apparatus will not do. The claimed arrangements of the tubes or parts should be apparent in the photograph, or it will not be accepted as a proof of existence. Models must be deposited of all inventions relating to the cases or movements of watches, all inventions relating to portable firearms, and for all patented articles composed of combinations of substances which it is difficult to determine. Swiss patents are granted for fifteen years from the date of application. All applications must be completed within six months of date.

Novelty: Effect of

*Novelty: Effect of Prior Patent or Publication.*—The invention must be new and unpublished in Switzerland at

Switzerland.

Price Patent or Publication.

the time of application. Proof of the published British specification having been at the disposal of the public in Switzerland would probably act as a bar to novelty. Switzerland is, however, a member of the International Convention, so that even after publication of a British specification the Swiss application would be valid if made within six months, or, according to the recent amendment on the Convention, within twelve months, from the date of the application in England. An examination as to novelty and utility is held upon all applications for patents.

Taxes.

*Taxes.* Patents are subject to the payment of annual taxes of 20 francs for the first year, 30 francs for the second, 40 francs for the third, and so on, increasing at the rate of 10 francs per annum as in Belgium.

Working.

*Working.*—The invention must be worked within three years from the date of application. The amount of working which will satisfy requirements has not been fixed by any judicial decision, but it would be unsafe to count upon anything less than a real and commercial carrying into effect of the invention. It must, however, be said that it is now generally held that it is not necessary to actually manufacture the invention in Switzerland so long as the patent is worked in a foreign country, proof of this foreign working being produced and registered in the Swiss Patent Office. But the foundation of this assumption has by no means been made plain to the writer. Importation of the patented goods is not prohibited, but if importation alone is carried on the patentee cannot refuse licences on reasonable terms to Swiss manufacturers; otherwise his patent is forfeited. All articles protected by a Swiss patent and sold in Switzerland must be marked with the Federal Cross and the number of the patent.

Assignments and licences.

*Assignments and licences.* If a patent is sold wholly or partly, or if a licence is granted after the filing of the application or after the grant of the patent, such assignment or licence must be registered at the Federal Office of Industrial Property.

Tasmania.

## TASMANIA.†

(Act No. 6 of 1893; Amended Regulations of 1896.)

Patentee. *Patentee.* The true and first inventor, which is assumed to include the first importer. Patents are granted to the inventor in conjunction with others who are not inventors. The legal representatives of a deceased inventor may obtain a patent if application is made within six months of the inventor's decease. A corporation may also obtain a patent as assignees of the inventor.

Duration of Patent. *Duration of Patent.*—Patents are granted for fourteen years from the date of acceptance of the application. Provisional protection may be had as in Great Britain.

Novelty: Effect of Prior Patent or Publication. *Novelty: Effect of Prior Patent or Publication.*—The invention must not at the time of application have been "publicly manufactured, used, or sold within Tasmania." Therefore prior publication or use of an invention abroad, and apparently even prior publication alone in Tasmania, will not prevent the grant of a valid patent. Subject to notice given to the Registrar, exhibition of an invention at an "Industrial Exhibition" within or beyond the colony will not amount to public use, if the application for a patent be made within six months from the opening of the Exhibition. The colony has a special arrangement with Great Britain whereby an application made within twelve months of the application in Great Britain has priority over other applicants. The same priority is accorded to citizens of the United States.

Taxes. *Taxes.* At or before the expiration of the third year from date a tax of £15 falls due, and a tax of £20 at or before the expiration of the seventh year. Three months' extension of time for paying these taxes may be had, subject to payment of £1 on the application form and £3 on the grant of extension.

Working. *Working.* No requirements.

Assignments. *Assignments.* Assignments and licences may be granted for the whole or a part of the colony. These should be entered on the Register.

## TOBAGO.

Tobago.

(Covered by Patent in Trinidad.)

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## TONQUIN.

Tonquin.

(Covered by French Patent.)

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## TRANSVAAL

Transvaal.

### (Late South African Republic).

This colony, formerly known as the South African Republic, is now a part of the British Empire. Until the present military occupation has given place to civil administration patents will be granted under the laws of the late Republic. A question put to the Secretary of State for the Colonies by Sir John Brunner in the British House of Commons on 26th February, 1901, as to the extension of the British Patent Law to the Transvaal and Orange River Colony met with the reply that at present "no alteration has been made in the Patent Laws of the late Republics." *An important change in practice, as it* affects British and American inventors, is that applications may now be filed either in English or in Dutch (see Government Notice No. 123 of 1900, page 1484 of *The British Illustrated Official Journal (Patents)*, No. 612, 19th December, 1900). Answers to enquiries personally made by the writer also point to the conclusion that the unreasonable practice, established by the late South African Commissioners of Patents under the law of 1897 requiring every non-resident applicant to lodge security for £100 in advance to meet the probable costs of a problematic opposition, will not under British auspices be adhered to. Applicants are cautioned in the above Government Notice to comply with the formalities of the Patent Law No. 10 of 1898, which is practically a reprint of Law No. 12 of 1897, with the exception of the correction of a clerical error in Section 51 of the prior Act

**Transvaal (late South African Republic).**

According to the latest information new Patent and Trade Mark Bills have already been drafted, and will shortly be submitted to the Legislative Council. If these should become law a number of the defects in the existing administration of Patent matters will be corrected.

Patentee.

*Patentee.* The true and first inventor or, if deceased, his legal representative if the application is made within twelve months of death. Corporations may have patents issued in their names, but the *application* must be made by the inventor. Patents are granted to joint applicants.

Duration of Patents.

*Duration of Patents.*—Patents are granted for fourteen years from date of application, but expire with the first prior foreign patent becoming void. No patent will be granted for an invention the subject-matter of an expired foreign patent. Provisional protection is granted for nine months, subject to the filing of the Complete Specification within four months from application.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The application should be filed before any publication or prior use of the invention in the colony. Prior publication elsewhere (such, for instance, as the publication in the *United States Gazette* or the British Specification) will not effect novelty in the Transvaal so long as these publications have not entered the colony.

Taxes.

*Taxes.*—At the end of the third year £20; at the end of the fifth year £100; at the end of the eighth year £150; and at the end of the eleventh year £200. Extension of time to pay these taxes may be had up to three months, subject to a fine of £10. (It is to be expected that even if the present law is retained these taxes will be shortly modified to more reasonable amounts.)

Working.

*Working.*—There are no requirements as to working; but if the patent is not worked or made reasonable use of in the colony, so that the wants of the public are not supplied, or if any person is prevented from deriving the full benefit of an invention in his possession, the patentee may be compelled to grant licences on reasonable terms.

*Assignments.* These must be made by way of notarial deed, and must be registered at the office of the Commissioner of Patents. When registration is effected by an agent, he must be provided with a power of attorney from the *assignee* authorising him to record the assignment. Patents may be assigned wholly or in part. Licences may also be granted and recorded. No special form of either assignment or licence is prescribed, and they may be in either English or Dutch. Transvaal. Assignments.

## TRINIDAD. Trinidad.

(The Patents, Designs, and Trade Marks Ordinances, 1894 and 1897.)

*Patentee.*—The actual inventor or the first importer or introducer of the invention into the colony. Joint inventors may obtain a patent, and corporations are included under the word "person," but a corporation alone cannot apply. Patentee.

*Duration of Patents.*—Patents are granted for fourteen years counting from date of grant. Extensions may, at the discretion of the Governor, be had for a period not exceeding seven years. Provisional protection for nine months may be obtained, and in such a case the Complete Specification may be filed at any time during the period of provisional protection. Duration of Patents.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been publicly manufactured, used, or clearly ascertained or described in any publication within the colony. Public use, or the issue of prior patents or publication of specifications elsewhere than in Trinidad, will not affect the validity of a patent there. Novelty: Effect of Prior Patent or Publication.

*Taxes.* None after issue of patent. Taxes.

*Working.*—There is no statutory obligation to work the patent, but as in Great Britain compulsory licences might be obtained from the patentee on proof that the Working.

**Trinidad.** invention is not being worked in the colony: or that the requirements of the public are not satisfied; or that any person is prevented from working to the best advantage an invention of which he is possessed. Where a patent is not being worked in the colony, it has been recommended to advertise occasionally in one of the principal papers offering to license suitable persons or to sell the patent.

Assignments. *Assignments.* These should be in British form, and when made by foreigners should be legalised by a British consul. The assignment should be registered with the authorities in Trinidad. No notice of trust will be entered on the Register.

Amendment: Disclaimer and Revocation. *Amendment: Disclaimer and Revocation.* Patents may from time to time be amended by explanation or disclaimer and may be revoked on the petition of any person aggrieved.

## Tunis. TUNIS.*

(Law of 22nd Rabia-el-Tani, 1306: 26th December, 1888; 1st Rabia I., 1310: 26th September, 1892.)

Patentee. *Patentee.*—Patents are granted to whomsoever may apply, or to a firm or corporation.

Duration of Patent. *Duration of Patent.* Five, ten, or fifteen years, at the option of the applicant, and dating from application.

Novelty: Effect of Prior Patent or Publication. *Novelty: Effect of Prior Patent or Publication.*—An application for a Tunisian patent should be filed before the invention is generally known or in public use either in the Regency or elsewhere.

Taxes. *Taxes.* Patents are subject to an annual tax, payable in advance of 100 piastres. No enlargement of time for paying this annuity can be obtained. These annual taxes are due on the date corresponding to the *delivery* of the patent (1st Rabia I., 1310).

*Working.* The invention should be put in practice before the expiry of two years from the date of the patent, and the working must not thereafter be interrupted for any two years in succession. Tunis being a member of the International Convention the prohibition against importation of the patented goods is inoperative against patentees who are citizens of States also in the Union, such as the United States and Great Britain for example. All patented goods should be marked with the number of the patent and the words "Sans Garantie du Gouvernement." Tunis. Working.

*Assignments.* As is the case in France, an assignment can only be recorded by paying the full amount of taxes for the term of patent right then unexpired. This immediate expense may, however, be obviated by adopting the plan advised with reference to the French assignment: viz., leaving the assignment unregistered *pro tem.*, and causing the parties to the assignment to execute a blank power authorising a notary (whose name can afterwards be filled in) to effect the registration and pay the fees. This power should be legalised by a French consul, and can afterwards be used by the assignee if required. Assignments.

## TURKEY. Turkey.

(LAW OF 18TH FEBRUARY, 1879.)

*Patentee.*—Patents are granted to the first inventor or first importer. A firm or corporation may be the grantee of a patent. Patentee.

*Duration of Patent.* The term of grant is for five, ten, or fifteen years as the applicant may elect. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.* The invention, to form the subject-matter of a valid patent, should not have been published or worked in Turkey, and, strictly speaking, should not have been made public abroad. It is, however, the usually accepted opinion, strengthened by a recent pronouncement by the Turkish Minister of Novelty Effect of Prior Patent or Publication.

Turkey

Commerce, that the mere official publication of the specification of a prior foreign patent would not injure the validity of a subsequent Turkish patent.

Taxes.

*Taxes.* Patents are subject to an annual tax of 2 Turkish pounds.

Working.

*Working.* The invention must be worked in Turkey within two years from the date of *application* (see recent Ministerial Regulation), and the working must not thereafter cease for any two successive years, on pain of forfeiture of the patent rights. Importation of patented goods is strictly prohibited, under penalty of forfeiture of the patent. Even the introduction of models of the invention or samples of the goods for exhibition, trial, or other purposes must take place only under permission from the Government. It appears that in some instances patents can be obtained not subject to the working clause, but at an increased cost.

Assignments.

*Assignments.* When a Turkish patent is assigned, all the taxes due on the unexpired term of patent right require to be paid in advance before the assignment can be recorded. This necessity is sometimes evaded by the plan frequently resorted to in the case of French assignments (see "France"). Assignments should be by notarial deed, and must, when made abroad, be legalised by a Turkish consul.

## URUGUAY.†

(Law of 12th November, 1885.)

Persons.

*Persons.* Patents are granted to the inventor, or to his attorney or assignee.

Duration of Patent.

*Duration of Patent.* Patents are issued for terms of three, six, or nine years, at the option of the applicant.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.* To constitute a valid patent the subject-matter should not be publicly known in Uruguay or elsewhere. When prior

Uruguay.

foreign patents have been obtained, the owner may, irrespective of publication or public use, obtain a valid patent in Uruguay if he files his application within one year from the date of the first prior foreign patent. Patents of Addition may be obtained.

Taxes.

*Taxes.* Patents are subject to an annual tax of 25 pesos. Patents of Addition are subject to an annual tax of one third of this amount. All taxes are payable in the first ten days of January in each year.

Working.

*Working.* On the grant of the patent the authorities specify what is, in their estimation, a reasonable time within which the invention must be worked. This may vary from one to three years, according to the nature of the invention. Once commenced the working must not be interrupted for any one year at a time.

Assignments.

*Assignments.* These must be in duplicate in the Spanish language, and must be legalised by a Uruguayan consul.

## VENEZUELA.

Venezuela.

(Law of 25th May, 1882.)

Patentee.

*Patentee.* Patents are granted to the actual inventor, or to a patentee who has already patented the invention in a foreign country.

Duration of Patent.

*Duration of Patent.* Patents are granted for five, ten, or fifteen years, at the option of the applicant, and when a foreign patent exists then for the unexpired term of the foreign patent. Patents of Improvement may be obtained.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.* A valid patent may be had only in cases where the invention is not publicly known or used in Venezuela, or has not been patented in another country to an inventor other than the applicant. But in the case of an inventor and owner of a foreign patent, he may at any time during the existence of the foreign patent protect his invention in Venezuela for a period coterminous with that of the foreign patent.

Venezuela.

Taxes.

*Taxes.*—Patents are subject to a tax of 80 bolivares per annum on Patents of Invention and 60 bolivares per annum on Patents of Improvement. Hitherto the practice in Venezuela has been to issue patents upon payment of one half of the taxes for the full term for which the patent was granted, and to permit the other half of the taxes to be paid at any time before the expiry of the first half of the said term. But by a Decree of 28th April, 1898, the President of the Republic has made it obligatory to pay the whole of the taxes in advance for the full term of the patent grant, and this must now be done.

Working.

*Working.*—A five years' patent must be worked within six months of the grant; a ten years' patent within one year; and a fifteen years' patent within two years of the grant.

As to what constitutes "working," an official announcement of 17th May, 1880, explains that where a patent is being worked abroad under a foreign patent it will suffice to import, sell, advertise, and put the invention in operation in Venezuela, actual manufacture of the patented goods not being required. But in this case certificates from persons using the invention, or in whose possession it is or has been, must be procured and produced to the authorities, together with copies of newspaper advertisements, in the Republic.

Assignments.

*Assignments.*—Patents may be assigned. The documents should be in Spanish, and when made out of the Republic should be legalised by a Venezuelan consul. Licences may be in any form so long as the existence of the permit is apparent.

## VICTORIA.

(Act No. 1031 of 25th November, 1890.)

Patentees.

*Patentees.*—Patents are granted to the actual inventor, or to his assignee, or to an importer who has had the invention communicated to him from abroad by the inventor. A corporation may be the grantee of a patent

for an invention communicated to them by the inventor. The legal representative of a deceased inventor may obtain a patent if application is made within twelve months from the death of the inventor. Victoria.

*Duration of Patent.*—Patents are granted for fourteen years. Inventions may be provisionally protected as in Great Britain, the Provisional being followed up in nine months by a Complete Specification. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.* The invention must not be a matter of public knowledge in the colony. But in the case of an applicant who is the owner of a foreign patent, publication or public use prior to application in Victoria will not matter if the Victorian application is made within one year from the date of the prior foreign patent. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—Before the expiry of the third year a tax of £2 10s. is payable, and a further tax of £2 10s. before the expiry of the seventh year. An extension of time for making these payments (in no case exceeding six months) may be had on showing sufficient cause and on payment of a fine of £1 in addition to the tax. Taxes.

*Working.*—Patentees are not required to work their inventions in the colony, and may import the patented goods at pleasure. Working.

*Assignments.*—These are prepared in the form customary in England, and should be entered upon the Register of Patents. Assignments.

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## WESTERN AUSTRALIA.† Western Australia.

(Patents Act, 1888; Amending Act of 1893; Rules of 1898.)

*Patentees.*—The true and first inventor or joint inventors, or the assignee of an inventor or an assignee jointly with the inventor, may apply for a patent. A corporation may Patentees.

**Western Australia.**

also apply as the assignee of the inventor, the documents being signed by two of the principal officers. The legal representative of a deceased inventor may also apply. A mere importer cannot obtain Letters Patent.

Duration of Patent.

*Duration of Patent.* Patents are granted for fourteen years. Inventions may be provisionally protected as in Great Britain, the provisional application being followed up within nine months by a Complete Specification. Extension of time to file the Complete Specification may be obtained up to three months on payment of a fine.

The Letters of Registration formerly granted are now abolished.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been published or be matter of public knowledge in the colony (*Australian Gold Co. v. Lake View Consols* [1901], 18 R. P. C. 105). Any person who has applied for or obtained a patent in Great Britain or in any other State included in the International Convention is entitled to a patent in West Australia in priority to any other applicant, provided his application is filed in West Australia within seven months, or, according to the recent amendment on the Convention, within twelve months, from the date of such prior application or patent elsewhere, the date given to the West Australian patent being the same as that of the said prior application or patent. The publication of the specification in Great Britain or the United States will not bar the valid grant of a patent in the colony so long as the specification has not been published in West Australia. The exhibition of an invention in an Industrial Exhibition in the colony six months prior to application does not constitute publication if notice has previously been given to the Registrar.

Taxes.

*Taxes.*—Before the expiration of the fourth year £5, and before the expiration of the seventh year £10. The payments of these taxes must be endorsed on the Letters Patent, which should be produced for this purpose. Extension of time to pay these taxes may be obtained, subject to a fine of 10s. for one month; 15s. for two; £1 for three; £1 10s. for four; £2 for five, and £3 for six months.

*Working.*—There are no requirements as to working the invention or marking the patented goods. The patentee may import the goods into the colony. Western Australia. Working.

*Assignments.*—These may be in any suitable form such as might serve for Great Britain or the United States. The assignment should be in duplicate, both signed, and should be entered upon the Register. The registration fee for either assignment or license is 10s., and the stamp duty on an assignment is 10s. Assignments.

NOTE.—*At the moment of going to press information has been received that the West Australian Patents Amendment Bill of 1900 will not be submitted to the King in Council and will not come into operation.*

## ZULULAND. Zululand.

Zululand is now incorporated with the Colony of Natal, and a patent in the latter now covers and is operative throughout all the territory hitherto known as Zululand. Any separate patents now subsisting in Zululand may be allowed to lapse so long as the corresponding patent in Natal is maintained.

# FOREIGN AND COLONIAL TRADE MARKS AND DESIGNS.

TRADE MARKS, and in many instances Designs also, can be protected in the bulk of the foregoing countries and colonies. In almost all the principal States and Dependencies this can be done under existing Statutes, and where this is not so, special arrangements or legislative Acts may be furthered to obtain the desired protection.

# APPENDIX A.

# INTERNATIONAL CONVENTION

FOR THE

# Protection of Industrial Property (1883)

AS AMENDED 14TH DECEMBER, 1900.

## CONSOLIDATED.

THE International Convention was initiated and concluded by the several assenting Powers for the purpose of affording mutual protection to their respective subjects and citizens in sustaining their rights, chiefly, to the abstract species of industrial property constituted by Patents for Inventions, Copyright in Designs, Trade Marks, and Trade Names. The original text of the Convention is in the French language, and the following excerpt is from the authorised translation.

The opening paragraphs rehearse the names and titles of the subscribing potentates and plenipotentiaries, and are of but slight interest to the general reader. Since the signature several changes have taken place, and it will serve a more useful purpose to give the complete list of the Governments which are now parties to the Convention. These are as follows: America (U. S.), Belgium, Brazil, Denmark with the Faroe Islands, Dominican Republic, San Domingo, France and her Colonies, Great Britain, Holland with Dutch Indian Colonies, Italy, Japan, Norway, Portugal with

The text of the Convention consists of nineteen Articles, and is followed by a Final Protocol explaining and qualifying the terms of these Articles. In the following copy the additional matter and amendments agreed to at the Conference of the 14th December, 1900, are introduced into and consolidated with the original text at their proper places. The new additions and alterations are printed in heavier type.

ARTICLE I. contains a list of the original subscribing Powers, which may now be replaced by the list given in the foregoing introduction.

ARTICLE II.—The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

ARTICLE III. Subjects or citizens of States not parties to the Union who are domiciled or have **effective and genuine** industrial or commercial establishments in the territory of any of the States of the Union shall be assimilated to the subjects or citizens of the Contracting States.

ARTICLE IV. Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated. Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through acts accomplished in the interval, either, for instance, by another registration, by publication or the working thereof, or by the sale of copies of the design or model, during these periods. The above periods of priority shall be **twelve** months for patents, and **four** months for industrial designs or models and trade marks.

**Article IV. bis. Patents applied for in the various Contracting States by persons admitted to the benefits of the Convention under the terms of Articles II. and III.**

shall be independent of patents obtained for the same invention in other States, whether parties to the Union or not. This provision shall apply to patents in existence at the time of its being put in force. The same thing shall apply, in the event of the accession of other States, to patents in existence on either side at the time of accession.

ARTICLE V.—The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture. Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ARTICLE VI.—Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union. That country shall be deemed the country of origin where the applicant has his chief seat of business. If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin. Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

ARTICLE VII. The nature of the goods on which the trade mark is to be used can in no case be an obstacle to the registration of the trade mark.

ARTICLE VIII. A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark.

ARTICLE IX. All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection. The seizure shall be effected at the request of either the public department or of the interested party, pursuant to the internal legislation of each country. In States whose legislation does not allow seizure on importation this seizure may be replaced by prohibition of importation. The authorities shall not be bound to effect seizure in the case of goods in transit.

ARTICLE X. The provisions of the preceding Article shall apply to all trade [illegible] bearing a false indication of the source of the goods or the name of a [illegible]

trade name of a fictitious character or assumed with a fraudulent intention. **Any producer, manufacturer, or trader who produces, manufactures, or trades in such goods, and who is established either in the locality falsely indicated as the place of origin or in the region in which this locality is situated, shall be deemed an interested party.**

**Article X. bis.—The subjects or citizens of the States parties to the Convention (Articles II. and III.) shall enjoy in all the States of the Union the protection accorded to native subjects or citizens against dishonest competition.**

ARTICLE XI. The High Contracting Parties **shall, in conformity with the legislation of each country,** grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognised International Exhibitions **which have been organised in the territory of one of them.**

ARTICLE XII. Each of the High Contracting Parties agrees to establish a special Government Department for Industrial Property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

ARTICLE XIII. An International Office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property). This office, the expenses of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

ARTICLE XIV. The present Convention shall be submitted to periodical revisions with a view to introducing improvements calculated to perfect the system of the Union. To this end Conferences shall be held in turn in one of the Contracting States by the Delegates of the said States.

ARTICLE XVI.—States which have not taken part in the present Convention shall be permitted to adhere to it at their request. Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses and admission to all the advantages stipulated by the present Convention, **and shall take effect one month after the despatch of the notification made by the Swiss Government to the other States of the Union, unless a later date has been indicated by the adhering State.**

ARTICLE XVII. The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the High Contracting Parties, who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ARTICLE XVIII. The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

ARTICLE XIX. The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

[Here follow the signatures of the respective plenipotentiaries.]

*The present additional Act shall have the same validity and duration as the Convention of the 20th March, 1883.*

*It shall be ratified and the ratifications deposited at Brussels at the Ministry of Foreign Affairs as soon as may be possible, and within eighteen months from the day of signature at latest.*

*It will come into force three months after the closing of the procès-verbal of deposit.*

*IN WITNESS whereof &c.*

*Done at Brussels in single copy the 14th December, 1900.*

# FINAL PROTOCOL.

[TRANSLATION.]

ON proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the Protection of Industrial Property, the undersigned plenipotentiaries have agreed as follows:—

1. The words "Industrial Property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters &c.).

2. Under the word "Patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

3. The last paragraph of Article 11. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

3 bis. The patentee in each country shall not incur forfeiture for non-working until the expiration of a minimum period of three years commencing from the date of the deposit of his application in the country in question, and in case the patentee fail to give satisfactory reasons for his inaction.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State on the ground that it does not satisfy, in regard to the goods to which it is applied, the conditions of the legislation of that State, provided that in this point it complies with the legislation of the country of origin, and that it has been properly registered in the country of origin. With this reservation, which relates only to the form of the mark, each State remains free to prescribe what conditions the marks of manufacture or trade shall fulfil to be admitted to protection in its territory.

To avoid misconstruction it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organisation of the special Department for Industrial Property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office instituted by virtue of Article XIII. are in no case to exceed for a single year a total sum representing an average of 2000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units: namely

| | | |
|---|---|---|
| First class ... | ... ... ... | 25 units |
| Second class ... | ... ... ... | 20 „ |
| Third class ... | ... ... ... | 15 „ |
| Fourth class ... | ... ... ... | 10 „ |
| Fifth class ... | ... ... ... | 5 „ |
| Sixth class ... | ... ... ... | 3 „ |

These coefficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expenses:

| | |
|---|---|
| First class ... | France, Italy. |
| Second class ... | Spain. |
| Third class ... | Belgium, Brazil, Portugal, Switzerland. |
| Fourth class ... | Holland. |
| Fifth class ... | Servia. |
| Sixth class ... | Guatemala, Salvador. |

The Swiss Government will superintend the expenses of the International Office, regulate the necessary [illegible]

annual account, which will be communicated to all the other Administrations.

The International Office will centralise information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement, which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said Administrations or by Societies or private persons will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The Administration of the country in which the next Conference is to be held will make preparations for the transactions of that Conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the Conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

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

In witness whereof the undersigned plenipotentiaries have drawn up the present Protocol.

Here follow the signatures of the respective plenipotentiaries and the Powers' states that the present additional Act shall have the same validity and duration as the Convention of the 20th March, 1883, and page 438, etc.)

# APPENDIX B.

## TWELVE SHORT PRECEDENTS OF AGREEMENTS, ASSIGNMENTS, LICENCES, MORTGAGES, &c.,

RELATING TO THE

## WORKING AND DISPOSAL OF LETTERS PATENT FOR INVENTION.

THE following short examples of Agreements, Assignments, Licences, and Mortgages may usefully serve as guides to persons engaged in preparing such documents.

Modern practice is all in favour of abridging and simplifying the intolerable prolixity which many draftsmen still affect. The Author has therefore, in drawing these Precedents, endeavoured to make them as concise as possible.

One notably new feature will be apparent in the examples of Agreements made prior to application: viz., the inclusion of a short description and sketch of the invention spoken of in the Agreement, so that the subject-matter of the Agreement may be identified with the subject-matter of the after application. This course is in all such cases advisable, lest it should be necessary afterwards to seek registration of the document, as such registration would inevitably be refused by the Comptroller if he should be unable to identify the invention referred to in the Agreement with the invention afterwards patented (*re* Parnell's Patent [1888], 5 R. P. C. 126).

With reference to the implied covenants for title &c., and to the position of those who grant loans or make advances under certain Agreements of this nature, it may be of use to the lay reader to glance at the extracts from the Conveyancing and Partnership Acts which appear immediately after the last of the precedents.

## Form 1.

*AGREEMENT between an Inventor who has been unable from want of means to develop or protect his Invention, and a second party who proposes to furnish the necessary funds in consideration of receiving a share in the Patent to be applied for.*

**An Agreement** made the day of . 19 , BETWEEN ANDREW BELL, of No. 15 Leaf Street, in the City of Birmingham, Metal Worker, of the one part, and CHARLES DENDY, of No. 56 Horne Square, Birmingham aforesaid, Stockbroker, of the other part.

WHEREAS the said Andrew Bell claims to be the true and first inventor of certain "Improvements in Apparatus for directly recording and transcribing Speech and Sounds," which invention he has not been able, from want of means and opportunity, properly to develop and patent: AND WHEREAS the said Charles Dendy has agreed with the said Andrew Bell to provide and pay a sum of money not exceeding Five Hundred Pounds for the further development and patenting of the said invention, but subject to the conditions and for the consideration hereinafter expressed:

NOW THESE PRESENTS WITNESS and it is hereby agreed between the parties as follows:—

1. The said Charles Dendy shall, upon the signing of this Agreement, advance the sum of £100 for the purpose of purchasing materials, tools, and all necessary adjuncts to enable the said Andrew Bell to proceed with his experiments and trials for the further development of the said invention, and if necessary additional sums will be advanced by the said Charles Dendy from time to time to continue the said experiments and trials, it being hereby agreed that the total sum so advanced shall not exceed £250.

2. If when the said sum of £250 shall have been expended the invention is still not sufficiently developed or advanced to warrant an application for Letters Patent, the said Charles Dendy shall be at liberty to give notice to the said Andrew Bell of his intention to withdraw from this Agreement, and thereupon, within one week after such notice has been given, and when all liabilities incurred in connection with the development of the invention

since the signing of this Agreement, and with the knowledge and consent of the said Charles Dendy, have been discharged by the said Charles Dendy, this Agreement shall cease and determine, and the invention will remain the sole property of the said Andrew Bell, who shall not be liable in respect of any sums expended by the said Charles Dendy in pursuance of this Agreement.

3. If the aforesaid experiments and trials should result in the proper and successful development of the invention, the said Andrew Bell shall forthwith make application for Letters Patent, and shall thereafter and in due course file the Complete Specification and take all necessary steps to obtain the Letters Patent, but all at the expense of the said Charles Dendy.

4. As soon as the Letters Patent shall have been issued and obtained, the said Andrew Bell shall execute a proper assignment conveying one half share in the said Letters Patent and invention, and in all further improvements upon the same devised by him, to the said Charles Dendy, as consideration for the moneys expended and to be paid by him: and if after provision for all outstanding amounts and charges the full sum of £500 shall not have been already expended, then the undisbursed balance shall be paid on the execution of the said assignment by the said Charles Dendy to the said Andrew Bell.

5. The said assignment shall contain conditions limiting the mutual rights and liabilities of the co-owners of the Letters Patent, and shall provide that the inventions and patents, however worked or disposed of, shall operate for the mutual benefit of the co-owners, and neither of the co-owners shall be at liberty to work or license the inventions and patent rights for his own benefit alone, but shall account for his share of the profits to his co-owner, the patent or patents being held equally between them as tenants in common, and in like manner the annual taxes which fall due at or before the expiry of the fourth year of the patent or patents shall be paid by the parties hereto in equal shares.

6. In order to identify the invention forming the subject-matter of this Agreement with the invention forming the subject-matter of the patent or patents to be hereafter applied for under the conditions of this Agreement, and so to provide for the entry of this Agreement upon the Register at the Patent Office, if such entry

should hereafter prove to be necessary or desirable in the interests of either of the parties, the following is a short description and sketch of the invention in its present condition:—[*Here insert a brief description and sketch of the invention.*]

7. It is to be understood that this Agreement shall have no effect as regards the obtaining ownership or working of any foreign patents for the invention, and that these may be obtained and dealt with by the said Andrew Bell at his own expense, and without reference to the said Charles Dendy.

8. The duties, liabilities, and benefits undertaken by and accruing to the parties to this Agreement shall extend and apply as far as possible to the executors, administrators, and assigns of either party.

IN WITNESS WHEREOF the within-named parties have hereunto set their hands the day and year first above written.

ANDREW BELL.
CHARLES DENDY.

NOTE.—*This document could not be capable of registration until after the patent had been applied for and issued, and then only if the invention indicated in the Agreement was, in the opinion of the Comptroller, the same as that covered by the patent. Registration would, however, only require to be sought in the event of the inventor refusing or failing to execute the assignment provided for in Paragraph 4.*

## Form 2.

*AGREEMENT between an Inventor whose Invention has not yet been protected, and a second party, not a co-Inventor, who is to join with him in applying for a Patent, and acquire one half share in consideration of his defraying the costs of applying for the Patent and paying the Inventor an additional sum of money upon the issue of the Patent.*

**An Agreement** made the day of . 19 .
BETWEEN EDWARD FISHER, of No. 13 Thacker's Row, Preston, in the County of Lancaster, Hairdresser's Assistant, of the one part, and GEORGE HARDY, of No. 35 Thacker's Row aforesaid, Grocer, of the other part.

WHEREAS the said Edward Fisher claims to be the inventor of "An Improved Apparatus for Heating Curling Tongs by Electricity," of which the following is a brief description and sketch, inserted for the purpose of identifying the subject-matter of this Agreement with the subject-matter of the patent to be hereafter applied for, that is to say [*here insert short description and sketch of the invention*]: AND WHEREAS the said George Hardy is desirous of acquiring one half interest in the said invention and in the patent to be hereafter obtained for the same, and the said Edward Fisher has agreed to sell one half share and interest as aforesaid for the sum and upon the conditions hereinafter set forth:

NOW IT IS HEREBY AGREED BETWEEN THE PARTIES AS FOLLOWS:—

1. Immediately upon the signing of this Agreement the said George Hardy will instruct a Patent Agent to make a search to ascertain the novelty of the said invention, and if no anticipatory publication is found, then the parties hereto will make application for a patent in their joint names, and will thereafter and in due course file the Complete Specification, and obtain issue of the Letters Patent. The costs of the search and all the charges incurred in applying for and obtaining the patent will be borne and paid by the said George Hardy as part consideration in respect of this Agreement, and no demand in respect thereof is to be made upon the said Edward Fisher, except that if the search discloses that the invention is not novel, and the matter proceeds no further, then the said Edward Fisher agrees to pay one half of the agent's charges incurred for making the search.

2. Immediately upon the issue of the Letters Patent, and not later than one week thereafter, the said George Hardy will pay to the said Edward Fisher the sum of £100, which, together with the aforesaid search and patent fees, shall constitute the consideration paid by him for the half share in the patent, and the agent who obtains the patent will be instructed to keep the Letters Patent in his hands until payment of this latter sum of £100 has been made.

3. The patent and every extension thereof shall be held and enjoyed by the parties hereto in equal shares as tenants in common, and all renewal fees and expenses connected with the maintenance

of the patent when granted shall be borne equally by the parties. Neither of the parties shall be entitled to work the invention for his exclusive benefit nor to grant licences without accounting to his co-patentee or his representative or assigns for one half share of all net profits derived from such working or licensing. Either of the parties shall be at liberty to sell his share of the patent, and his assignee shall be subject to and be bound by the conditions and restrictions herein set forth.

4. Any further improvements in the invention which may be devised by either of the parties shall be disclosed to the other, and if considered advisable the same shall be patented in their joint names and at their joint expense.

5. Except where the context requires a different interpretation, or where from other causes such interpretation is not reasonable, any expression referring to either or both of the said parties to this Agreement shall extend and be construed to apply also as far as possible to the assigns of the person or persons so designated.

IN WITNESS &c.

NOTE.—*This Agreement would not require registration unless difficulties were to arise in respect of the Partition Clause in Paragraph 3.*

## Form 3.

*AGREEMENT between Joint Inventors and intending Co-applicants for the purpose of defining their respective interests, rights, and powers inter and under the Patent to be applied for.*

**Memorandum of Agreement** made this day of , 19 , BETWEEN ISAAC JENKINS, of No. 37 Ther Street, in the City of Manchester, Cotton Spinner, of the one part, and KENNETH LATHAM, of The Hawthorns, Palatine Road, Didsbury, near Manchester aforesaid, Engineer, of the other part.

WHEREAS the said parties have jointly invented certain "Improvements in Carding Engines," a sketch and description of which is contained in the Schedule attached thereto and in respect of

which it is intended by the parties to make joint application for a patent: AND WHEREAS the said Isaac Jenkins has invented the chief portion of the said improvements, while the parts of the invention attributable to the said Kenneth Latham refer to less important details, it has been thought desirable before applying for a patent to define the respective shares and the terms and conditions in and under which the said invention and any Letters Patent obtainable for the same shall be possessed and worked by the parties:

NOW THESE PRESENTS WITNESS AND IT IS HEREBY AGREED AS FOLLOWS:—

1. The property constituted by the invention and Letters Patent to be hereafter applied for shall be considered as divided into three equal parts, of which two parts or thirds shall be the share of the said Isaac Jenkins, and the remaining one third the share of the said Kenneth Latham.

2. All expenses connected with ascertaining the novelty of the invention and obtaining Letters Patent therefor, and all renewal fees and charges connected with maintaining the patent in force when granted, shall be borne and paid by the parties hereto in the proportion of their respective interests: namely, two thirds by the said Isaac Jenkins and one third by the said Kenneth Latham.

3. In the same manner all net profits obtained as royalties or otherwise from the manufacture, sale, use, or licensing of the said invention and Letters Patent shall be shared by the parties hereto in the same proportions: that is to say, two thirds to the said Isaac Jenkins and one third to the said Kenneth Latham.

4. If either of the parties hereto should manufacture carding engines made in accordance with the said invention, a fixed royalty, to be mutually agreed upon, shall be chargeable upon each machine, and this royalty shall be shared between the parties in the indicated proportions.

5. Neither of the parties shall be entitled to grant licences without the consent in writing of the other, but either of the parties may sell his share of the invention and future Letters Patent without the concurrence of the other, and the purchaser

of the share so assigned shall be subject to the same conditions and restrictions and entitled to the same benefits as are imposed upon and secured to the original co-patentees under this Agreement.

6. The conditions of this Agreement shall apply, not only to the parties hereto, but also, as far as possible, to their assigns.

IN WITNESS &c.

SCHEDULE.

[*To contain description and sketch of invention.*]

NOTE.—*It would be advisable to follow up this Agreement, after the patent is issued, by a proper deed of partition.*

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## Form 4.

*AGREEMENT for Sale of Patent, between Inventor who has obtained Provisional Protection and Purchaser who arranges to pay the purchase-money in the following instalments: viz., One-third on signing Agreement; one-third on acceptance of Complete Specification; and the remainder on the issue of the Letters Patent.*

**An Agreement** made the day of , 19 , BETWEEN MATTHEW NASH, of No. 12 Prior's Court, in the City of London, Clerk, of the one part, and OLIVER PALEY, of Gracechurch Street, London aforesaid, Advertising Agent, of the other part.

WHEREAS the said Matthew Nash claims to be the inventor of, and has obtained Provisional Protection for, an invention entitled "Improvements in Means for Displaying Advertisements," No. 3698, dated 15th March, 1901, which invention and the patent to be obtained therefor he has agreed to sell to the said Oliver Paley:

NOW THESE PRESENTS WITNESS that in consideration of the sum of £150 paid by the said Oliver Paley to the said Matthew Nash as hereinafter set forth, he the said Matthew Nash DOTH HEREBY AGREE to sell and assign the said invention and Letters Patent to the said Oliver Paley, the purchase-money aforesaid to be paid in the following instalments: that is to say, £50 upon the signing of these presents; £50 upon the acceptance of the

Complete Specification (which the said Matthew Nash agrees forthwith, and at his own cost, to prepare and file); and £50 upon the sealing and issue of the Letters Patent.

PROVIDED that if the said Matthew Nash shall fail to file the Complete Specification in due course, the said sum of £50 paid upon the signing of this Agreement shall be returned by him to the said Oliver Paley, or if the said Complete Specification after acceptance should be successfully opposed, then the said sum of £50 paid at the signing of this Agreement, and also the sum of £50 paid on the acceptance of the Complete Specification, shall be repaid by the said Matthew Nash to the said Oliver Paley, and these sums shall be recoverable as a simple contract debt. PROVIDED FURTHER that upon the sealing and issue of the Letters Patent the said Matthew Nash shall forthwith execute a proper deed of assignment conveying the said invention and Letters Patent to the said Oliver Paley, or otherwise shall execute such further deeds or instruments as may be considered necessary to more fully vest and secure the said invention and Letters Patent in and to the said Oliver Paley, but at the cost of the said Oliver Paley. Any improvements upon the said invention which the said Matthew Nash may devise during the five years following the signing of this Agreement shall be disclosed and submitted to the said Oliver Paley or his assigns, and shall become his property, with the option of protecting the same by a patent if he or they should think fit, but at the cost of the said Oliver Paley or his assigns.

IN WITNESS &c.

NOTE.—*This document need not be registered. The Agreement should be replaced by the deed of assignment provided for, and that deed could be registered.*

## Form 5.

*AGREEMENT for Sale of Patent to Company, made between Patentee and Trustee for Syndicate about to form a Company; agreed consideration, partly cash, partly shares in Company; Patentee to be a Director in Company; Agreement to become void in the event of capital not being subscribed.*

**Memorandum of Agreement** made this day of , 19 , BETWEEN WILLIAM SCOTT, of Brierfield Hall, Northwich, in the County of Chester (hereinafter called "the Vendor"), of the one part, and GEORGE SCATTERGOOD, of

No. 3 Capstan Street, in the City of Liverpool, Solicitor (hereinafter called "the Trustee"), of the other part.

WHEREAS the said Vendor claims to be the true and first inventor of certain "Improvements in Pneumatic Wheel Tyres," for which he has obtained His Majesty's Letters Patent No. 14,036, under date the 12th February, 1902, and also certain foreign and colonial patents as set forth in the Schedule A hereto: AND WHEREAS the parties whose names appear in the Schedule B hereto, together with the amounts of their respective holdings or interests, and who are hereinafter referred to as "the Syndicate," have duly empowered and appointed the said Trustee to agree to purchase the said invention and Letters Patent (home, foreign, and colonial) from the Vendor, in trust for and on their behalf, for the consideration of £10,000 in cash, together with certain fully paid-up shares, but subject to the conditions hereinafter expressed:

NOW THESE PRESENTS WITNESS that, in pursuance of the said agreement and authorisation, and for the considerations and subject to the conditions herein expressed, IT IS HEREBY AGREED between the said Vendor and the said Trustee as follows:—

1. The Trustee shall upon the signing of these presents pay to the Vendor the sum of £250, being part payment of the aforesaid sum of £10,000, receipt of which sum of £250 is hereby acknowledged by the Vendor, and the Trustee shall thereupon inform the Syndicate of the execution of this Agreement.

2. The Syndicate or their agents shall then take the necessary steps to promote and form a limited company, to be entitled "The Scott Patent Tyre Company, Limited," and shall register the said company in terms of The Companies Acts, 1862 to 1900, the registered office to be in Liverpool as aforesaid.

3. The capital of the said company shall be £50,000, divided into 5000 shares of £10 each, and out of the said 5000 shares 1000 fully paid-up shares shall be allotted to the Vendor, in addition to the sum of £10,000 already referred to, and the Vendor shall be placed upon the board of directors.

4. Immediately upon the registration of the company prospectuses and advertisements will be issued and the subscription of capital invited. If the required amount of capital is subscribed the Vendor shall thereupon execute a proper assignment or assignments duly conveying and transferring the said invention and

patents, both in this country and elsewhere, and also the benefits of any future improvements devised by him upon or in addition to the said inventions and Letters Patent, as beneficial owner, to the said company or their duly appointed trustee, and the Vendor shall upon the execution of the assignment receive the sum of £9750, being the amount of purchase money hereinbefore set forth, less the sum of £250 paid at the signing of this agreement, and shall in addition have delivered to him the certificates representing 1000 fully paid-up shares of £10 each.

5. If sufficient capital should not be subscribed to pay the said purchase money and justify proceeding to allotment, then within three months after the date of the first issued prospectuses or advertisements inviting subscriptions of capital to the company this Agreement shall become null and void, and the Trustee shall forfeit and the Vendor shall retain the sum of £250 paid at the signing of this Agreement.

IN WITNESS &c.

SCHEDULE A.

*(Numbers, dates, and titles of Home and Foreign Patents.)*

SCHEDULE B.

*(Names of members of Syndicate, with amounts of holdings or interest.)*

NOTE.—*This Agreement, together with any subsequent instrument, should be referred to in any prospectus issued, and should also be filed with the Registrar of Joint Stock Companies, pursuant to Section 7 of The Companies Act, 1900.*

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## Form 6.

*ASSIGNMENT (Absolute) of Invention and Letters Patent by the Patentee to a Purchaser.*

**An Indenture** made the day of , 19 .

BETWEEN ROBERT SHEDDEN, of No. 29 New Smithhills, Paisley, in the County of Renfrew, North Britain, Iron Turner (hereinafter called "the Assignor"), of the one part, and THEODORE UNDERWOOD, of the Clydebank Shipbuilding Yard, Stobcross, Glasgow, in the County of Lanark, N.B., Marine Engineer (hereinafter called "the Assignee"), of the other part.

WHEREAS the Assignor claims to be the inventor of certain "Improvements in Feathering Paddlewheel Floats," for which he

has obtained Letters Patent No. 12,342, dated 23rd July, 1899: AND WHEREAS the Assignor has agreed with the Assignee for the sale to him, the Assignee, of the said invention and Letters Patent for the sum hereinafter expressed:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement and in consideration of the sum of £1000 paid by the Assignee to the Assignor upon the signing of these presents (the receipt of which sum is hereby acknowledged), he the Assignor, as beneficial owner, doth hereby assign unto the Assignee and his assigns absolutely all those the said invention and Letters Patent and the sole and exclusive benefit thereof, and all rights, powers, emoluments, and advantages whatsoever under or in respect of the said Letters Patent, the Assignor hereby covenanting with the Assignee and his assigns that, notwithstanding anything by him the Assignor done, omitted, or knowingly suffered, the said Letters Patent are now valid and subsisting.

IN WITNESS &c.

*NOTE.—This Assignment should be under seal, and should be registered.*

## Form 7.

*ASSIGNMENT of Half Share of Patent: Co-owners to work the Invention under the Patent independently of each other, but all Licences to be granted under the hands and seals of both.*

**An Indenture** made the day of . 19 . BETWEEN RICHARD MASON, of The Phœnix Boiler Works, Pendleton, Manchester, in the County of Lancaster, Boiler Maker (hereinafter called "the Assignor"), of the one part, and THOMAS JOHNSON, of No. 40 MacDonald Street, Belfast, in the County of Antrim, Ireland, Engineer (hereinafter called "the Assignee"), of the other part.

WHEREAS the Assignor has obtained Letters Patent No. 7326, dated the 12th of July, 1898, for "Improvements in the Construction of Steam Generators," of which he claims to be the true and first inventor: AND WHEREAS the Assignor has agreed to sell one half share of the said invention and Letters Patent to the Assignee for the sum of £600, but subject to the conditions hereinafter set forth:

NOW THIS INDENTURE WITNESSETH that, in consideration of the said sum of £600 paid by the Assignee to the Assignor

at the signing of these presents, and the receipt of which is hereby acknowledged, he the Assignor, as beneficial owner, doth hereby assign and convey one half share of the said invention and Letters Patent absolutely to the Assignee and his assigns, the said assignment being coupled with the following conditions:—

1. Either of the parties may, in carrying out his own business, manufacture and sell boilers made in accordance with the said invention, and under the said Letters Patent, without accounting to the other for profits and royalties derived therefrom.

2. Neither of the parties alone shall be at liberty to grant any licences to third parties to manufacture and sell under the said Letters Patent, but any such licence shall be granted only with the full consent of both parties, and under their respective hands and seals, and all royalties and profits whatsoever accruing under such licence or licences shall be divided equally between the parties hereto, share and share alike.

3. All renewal fees for maintaining the patent in force and the agency or other charges connected with the payment of such renewal fees shall be borne and paid by the parties hereto in equal proportions, and if either of the parties or his assigns should omit or refuse to pay his or their share of such renewal fees and expenses, the same shall remain a charge upon his or their share of the patent, or otherwise shall be recoverable from the party or his assigns by the other party by action at law as a simple contract debt.

4. Either of the parties shall be at liberty at any time to sell his share of the said invention and Letters Patent to a third party, but only after the other party has had the first refusal of the said share at the price for which the said half share is actually and ultimately sold.

5. The terms "Assignor" and "Assignee," and any other terms herein used to describe the parties to this Agreement, shall be understood to include, as far as possible, their assigns, except where such an interpretation is specifically barred.

IN WITNESS &c.

NOTE.—*This Agreement should be under seal and registered.*

## Form 8.

*ASSIGNMENT of a Patent to Trustees in Trust for Purchasers having unequal shares, the Trustees to exploit the Patent, sell the goods, grant licences, draw royalties, distribute profits, call for contributions, and otherwise act generally for the beneficial owners.*

**An Indenture** made the day of , 19 . BETWEEN HIRAM POTTER, of Newark, New Jersey, in the United States of America, Engineer (hereinafter called "the Vendor"), of the first part; JAMES STEEL of No. 12 Victoria Street, in the City of London, Civil Engineer, ALFRED MOTTERSHEAD, of the "Black Bull" Hotel, in the City of Chester, Wine Merchant, and PHILIP STAPLETON, of Burnley, in the County of Lancaster, Cotton Spinner (hereinafter called "the Purchasers"), of the second part; and GEORGE KINNEORS and FREDERICK WILSON, both of No. 133 King William Street, in the City of London, Chartered Accountants (hereinafter called "the Trustees"), of the third part.

WHEREAS the Vendor has obtained Her Majesty's Letters Patent in the United Kingdom for "An Improved Telephonic Transmitter," No. 328, dated 14th January, 1895: AND WHEREAS he has agreed to sell and the Purchasers have agreed to purchase the said invention and Letters Patent for the sum of £5000 in the following shares and proportions: namely—As to the said James Steel, one half share, for which his contribution to the purchase money is £2500, and as to the said Alfred Mottershead and Philip Stapleton, one fourth share each, for which their contributions to the purchase money are respectively £1250 each: AND WHEREAS the Purchasers have requested the Vendors to assign the said invention and Letters Patent to the aforesaid Trustees, in trust for the purchasers, subject to the payment of the purchase money and to the conditions herein expressed:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement and request, and in consideration of the said sum of £5000 paid at the signing of these presents, and the receipt of which the Vendor hereby acknowledges, he the Vendor, as beneficial owner, doth hereby assign and convey to the Trustees the aforesaid invention and Letters Patent, upon trust for the Purchasers as tenants

in common in the shares already set forth: namely, one half share to the said James Steel, and one fourth share each to the said Alfred Mottershead and Philip Stapleton. AND THE VENDOR doth hereby covenant with the said Trustees jointly, and also with each of the Purchasers separately, that, notwithstanding anything by the Vendor done, omitted, or knowingly suffered, the said Letters Patent are now valid and subsisting and not void or voidable. PROVIDED FURTHER and it is hereby agreed and declared as follows:—

1. Except under licence granted by the Trustees, none of the Purchasers or their assigns shall be entitled to make, use, exercise, or vend the said invention and Letters Patent within the United Kingdom.

2. The Trustees shall work and exploit the patent and premises to the best advantage of the Purchasers, and shall, subject to the direction and advice of the Purchasers, or a majority of the Purchasers representing three fourths of the value, manufacture the patented apparatus and grant licences for the manufacture, use, and sale of the invention at royalties to be fixed by the Purchasers or a majority as aforesaid, and all net profits, royalties, and emoluments accruing to the Trustees from and by such manufacture, licensing, and exploiting of the invention and Letters Patent shall form part of the trust estate, and, subject to the payment of all costs and expenses, shall be held by the Trustees in trust for the Purchasers and paid to them in accordance with their respective shares as hereinbefore set forth.

3. The Trustees may, and shall at any time during the continuance hereof, at the request in writing of the Purchasers or their assigns, or such of them as hold a majority in value of not less than three fourths of the entire value of the patent and premises, sell the said Letters Patent, and the purchase-money so obtained, after deducting all necessary costs and expenses, shall be divided among the Purchasers or their assigns in accordance with the amounts of their respective holdings.

4. The Trustees shall, out of the trust estate, pay the renewal fees necessary to maintain the said patent in force, or to obtain and maintain any further patents which may be applied for or bought by or under the direction of the Purchasers, or for any extension or

extensions of the said patent or patents, and, generally, the Trustees shall pay out of the trust moneys all costs, expenses, and liabilities strictly chargeable against the estate.

5. Any proceedings at law or otherwise necessary for the protection and maintenance of any Letters Patent aforesaid, or for the protection and maintenance of the rights of the owners therein, and for the prosecution of infringers pirating the invention or inventions, or slandering the title or titles of such Letters Patent or Patents, shall be taken and prosecuted by the Trustees when required so to do by the Purchasers or by a three fourths value majority of the Purchasers, the costs of such proceedings to be borne by the trust estate, and any moneys recovered in the form of damages or otherwise, or sums paid to compromise actions, shall be paid and accrue to the said trust estate, less costs and charges paid in recovering or obtaining the same or judgments to that effect.

6. The Trustees shall present accounts as between themselves and the respective Purchasers half-yearly, such accounts to be made out as extending from the 1st day of January in each year to the 30th day of June in each year, and from that day to the 31st day of December in each year, such accounts to be presented and a proper balance struck, audited by independent auditors appointed by the Purchasers and settled not less than fourteen days after the termination of the respective periods over which the accounts extend. If on the presentation of accounts it should be found that there is an adverse balance against the trust estate or the respective Purchasers, then the Trustees shall apportion the sum to be paid by each Purchaser, having regard to his (the Purchaser's) share, and shall require him in writing to pay such sum within fourteen days, and if default in payment is made the said sum due shall bear interest at five per cent. per annum, and shall until paid remain a charge upon the defaulting owner's share in the estate.

7. For each half-year or portion thereof, each Trustee shall during the continuance of his trusteeship receive the sum of £100, such payment to come out of the moneys of the trust estate generally and not to be chargeable as a debt against any of the Purchasers particularly.

8. The Trustees or either of them may be removed by the Purchasers, but such power of removal shall be exercised only by a majority representing two thirds in value of the entire ownership.

9. If any difference shall arise between the parties—that is to say, between the Vendor and the Trustees, or between the Trustees, or between the Purchasers, or between the Trustees and the Purchasers—in respect of the construction of this instrument, or of the respective rights, duties, or liabilities of the parties, the same shall, if competent and desirable, be referred to two arbitrators, one to be appointed by each of the parties, and such arbitrators, or their umpire, may accordingly make an award in respect of the said difference, and the costs of or incidental to such reference and award respectively, and the person or persons by whom and in what manner the same shall be paid; and the submission may be made an order of the High Court of Justice upon the application of either party, who may consent or instruct counsel to consent thereto for the other of them, the death of any party not to operate as a revocation of the submission or otherwise be a bar to proceedings in respect thereof.

IN WITNESS &c.

NOTE.—*Although dealing with a trust, this deed can and should be registered as an Assignment. Registration will not, however, refer to the trusts therein set forth (see Section 83 of the Patent Acts).*

## Form 9.

*LICENCE (Non-Exclusive) in consideration of Royalties to be paid Half-yearly.*

**An Indenture** made the day of . 19 .
BETWEEN HENRY DICKINSON, of No. 4 Saxby Street, Salford, in the County of Lancaster, Mill Mechanic (hereinafter called "the Licensor"), of the one part, and JOHN BOOTH (trading as "Jacob Booth and Co."), of The Penelope Works, Burnley, in the same county, Manufacturer (hereinafter called "the Licensee"), of the other part.

WHEREAS the Licensor has obtained Letters Patent No. 393 of the 8th day of January, 1900, for a certain invention entitled "Improvements in Shuttle Tongues": AND WHEREAS the Licensee has applied to obtain and the Licensor has agreed to grant the Licensee a licence to use the said invention in consideration of the royalties and upon the terms hereinafter set forth;

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement, and in consideration of the royalties hereinafter reserved and the covenants on the part of the Licensee hereinafter contained, the Licensor doth hereby grant unto the Licensee full liberty, licence, power, and authority to make, use, exercise, and vend the said invention within the United Kingdom and the Isle of Man: TO HAVE, HOLD, EXERCISE, and ENJOY the said licence and premises unto and by the Licensee and his successors in business for and during all the residue now to come and unexpired of the term of fourteen years for which the said Letters Patent were granted: YIELDING AND PAYING unto the Licensor half-yearly, on the 30th day of June and the 31st day of December in each year, for every gross of shuttle tongues manufactured and sold by the Licensee in accordance with the said invention and Letters Patent, the sum of ten shillings as royalty: PROVIDED ALSO that the Licensee shall keep at his usual place of business all proper books of account, and will enter therein all particulars relating to the manufacture and sale by him of the said patent shuttle tongues, and will produce the said books to the Licensor or his authorised agent at all reasonable times for inspection and the taking of copies or extracts therefrom, and will at the end of each half-year aforesaid deliver or send to the Licensor a statement in writing of all essential particulars of the manufacture and sale during such half-year of the said patent shuttle tongues, together with a statement showing the amount of royalties payable to the Licensor, and shall, if required so to do, verify the said statement and particulars by statutory declaration. AND IT IS FURTHER PROVIDED that if the amount of royalties payable under this licence should for any continuous two years fall beneath the aggregate sum of £100, then the Licensor may terminate and withdraw this licence by giving three months' notice to that effect. FURTHER, if, as the result of proceedings at law or otherwise, the aforesaid Letters Patent should in the High Court or in any Court of Appeal be declared null and void, either wholly or in respect of their essential features, this licence shall therefrom cease and determine, and the Licensee shall be at liberty to manufacture the said shuttle tongues without the payment of royalty to the Licensor, notwithstanding that this licence is expressed to be for the full term of patent right. In the event of the Licensee wishing to terminate and withdraw from this licence, he may do

so by giving the Licensor three months' notice to that effect, and nothing in the licence mentioned shall operate as estoppel to prevent the Licensee, after his licence has determined, from challenging the validity of the patent, either as plaintiff or defendant, in any action at law commenced and prosecuted after the termination of this licence.

THE LICENSEE shall stamp all shuttle tongues manufactured by him in accordance with the said invention and Letters Patent or otherwise. The shuttles to which the tongues are applied shall be stamped with the words "Dickenson's Patent," and also with the number of the patent.

LASTLY, the Licensor shall, during the continuance of this licence, pay the renewal fees necessary to keep the patent in force, and shall, if required, produce the certificate of payment fourteen days before the last day for such payment, or otherwise shall allow the Licensee to pay the said renewal fees, the amount thereof to be deducted from the royalties then or thereafter due to the Licensor.

IF THE LICENSEE should at any time fail to pay the royalties due to the Licensor within three weeks from the end of the half-year in respect of which such royalties are payable, the Licensor may thereupon by notice in writing revoke this licence without prejudice to his right of recovery of any moneys then due to him or to any right of action in respect of breaches of this licence.

IN WITNESS &c.

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## Form 10.

*LICENCE (Exclusive, save in respect of Licensor) for a Single County at Rent and Royalties.*

**An Indenture** made the day of . 19 . BETWEEN *George* CHAMPION, of the *Tubal Brass Works, Tubal* Lane, in the City of Manchester, Brass and Tin Worker (hereinafter called "the Licensor"), of the first part, and FREDERICK PERKINS, of No. 12 Grove Street, Bury, in the same county, Tinsmith (hereinafter called "the Licensee"), of the second part.

WHEREAS the Licensor claims to be the true and first inventor of and has obtained Her Majesty's Letters Patent No. 12,333 of 12th October, 1899, for an invention of "Improvements in Humidifying and Ventilating Apparatus": AND WHEREAS the Licensee has agreed to take, and the Licensor has agreed to grant, an exclusive but (except as hereinafter limited) non-assignable licence to the Licensee to make, use, exercise, and vend the said invention in accordance with the said patent at the rent and royalties and under the conditions hereinafter specified:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said agreement and conditions, and in consideration of the said rent and royalties reserved, the Licensor, as beneficial owner, hereby grants, and the Licensee agrees to accept, an exclusive licence upon the following terms:—

1. The licence hereby granted shall continue for the full term now to come and unexpired of the aforesaid patent rights, subject to the hereinafter contained conditions as to terminating the licence.

2. For each year during which the licence shall continue, dating from the date of this Indenture, the Licensee shall pay to the Licensor an annual rent of £50, payable in advance, the first payment of £50 being made at the signing of these presents and acknowledged by the Licensor to be so paid.

3. In addition to the said annual payment of £50, the Licensee shall pay to the Licensor for each humidifier manufactured by him during the continuance of this licence the sum of £1 as royalty, such payments to be made half-yearly. The first payment of royalties, if any should be due, shall be made fourteen days after the expiry of six months from the date of this Indenture, and thereafter half-yearly as provided.

4. The Licensee shall keep proper books of account at his usual place of business, and shall enter therein all particulars of humidifying and ventilating apparatus manufactured by him in accordance with the invention and patent, and shall allow the same to be inspected, and copies and extracts made thereof and therefrom, by the Licensor or his authorised agent at all reasonable times, and shall allow the Licensor or his authorised agent at all reasonable times to inspect his works if the Licensor should desire so to do.

The Licensee shall at the end of each half-year furnish true statements showing the number of humidifiers manufactured by him during the half-year then expired, and shall accompany the said statement by an account showing the amount of royalties due to be paid to the Licensor, and shall verify the said statements and accounts by statutory declaration if required so to do by the Licensor. All sums due as royalties from the Licensee to the Licensor shall be paid to the Licensor not less than fourteen days after the expiry of each half-year.

5. Although this Indenture is set forth as an exclusive licence, the Licensor reserves to himself the right to manufacture and sell humidifying apparatus in Lancashire under his patent as aforesaid, but at prices which shall not be lower than those quoted by the Licensee; and all humidifiers sold by the Licensor shall be strictly those of his own manufacture, made at his works in Tubal Lane as aforesaid, or in any other workshop to which he may hereafter remove, or in which he may carry on his business.

6. The Licensee will not during the continuance of this licence manufacture any humidifying apparatus except in accordance with the said invention, and will not, while the licence is in force, dispute the validity of the said Letters Patent, and will do all in his power to detect infringers and assist the Licensor in any proceedings at law or otherwise which the Licensor may institute to protect his patent rights and interests.

7. Each humidifier and ventilating apparatus manufactured and sold by the Licensee shall bear upon the casing, or upon some prominent part of the apparatus, a stamped brass plate, of not less than two inches in length by an inch and a quarter in breadth, bearing the words "Champion's Patent" and the numerals "No. 12333[99]"; but to this the Licensee may add his name and address as maker. These brass plates will be consecutively numbered, and will be supplied at cost price by the Licensor to the Licensee, the latter binding himself to use only such brass plates as are supplied to him by the Licensor, and no others, and all humidifiers in accordance with the patent identified as having issued from the hands of the Licensee and not bearing a brass plate so supplied shall be chargeable with triple royalty, hereby agreed to represent liquidated damages suffered by the Licensor, unless a reasonable explanation is forthcoming.

8. The Licensor binds himself to maintain the patent in force during the continuance of this licence by the payment of the annual renewal fees, the certificate of each payment of the said renewal fees to be shown by the Licensor to the Licensee not less than fourteen days before the payment shall have become due; and if from any cause the Licensor shall omit or fail to pay any such renewal fee, the Licensee shall be at liberty to pay the same, together with any fine, if such should have been incurred, and shall charge the same against the Licensor, and deduct it from any moneys due to the Licensor at that time or thereafter in the hands of the Licensee.

9. If any rent, royalties, or other sums due from the Licensee to the Licensor should remain unpaid for one month after the time when they shall have become due, or if a breach of any of the conditions herein contained should be committed by the Licensee, the Licensor shall be at liberty to terminate this licence by giving two months' notice, and at the expiry of that time this licence shall cease and determine.

10. If the Letters Patent in respect of which this licence is granted shall, as the result of proceedings at law between the Licensor and third parties, or by revocation or otherwise, be finally declared void, either wholly or as to a material part thereof, then this licence shall forthwith cease and determine, and the Licensee shall be at liberty to manufacture and sell the invention without accounting to the Licensor for rent and royalties: and in any case, if at any time after the expiry of three years from the date hereof the Licensee should wish to terminate this licence, he may do so by giving six months' notice to that effect, whereupon this licence shall cease and determine.

11. The Licensee shall not be at liberty to sell or assign this licence, during its continuance, to another or to others; but in the event of the death or withdrawal from business of the Licensee, this licence shall continue to his representatives and successors in business upon the terms and under the conditions hereinbefore set forth as enjoyed by and binding upon the Licensee himself.

IN WITNESS &c.

NOTE.—*This Licence should be entered in the Register of Patents.*

## Form 11.

*Notice by Licensor to Terminate Licence.*

(*Address and date.*)

IN ACCORDANCE with the power given me under Clause of the Licence dated the day of , 19 , granted by me to you in respect of Letters Patent No. 15,342 of 18th December, 1818, for "Improvements in Skates," I hereby give you notice that the said Licence shall, as and from the day of next, absolutely cease and determine.

(*Signature*) .

To A. B., of .

NOTE.—*An intimation of this withdrawal should be sent to the Comptroller-General of Patents.*

## Form 12.

*Mortgage of a Patent.*

**An Indenture** made the day of , 19 .
BETWEEN SIDNEY SMITH, of The Hollies, Cleworth Street, Barnstaple, in the County of Devon, Hat Manufacturer (hereinafter called "the Mortgagor"), of the one part, and WALTER PYM, of Newport, Barnstaple aforesaid, Gentleman (hereinafter called "the Mortgagee"), of the other part.

WHEREAS the Mortgagor has obtained His Majesty's Letters Patent No. 1236, dated 24th February, 1901, for an invention entitled "An Improved Filter"; AND WHEREAS the Mortgagor has applied to the Mortgagee for a loan of £500, to be secured, together with interest thereon, by a mortgage of the said invention and Letters Patent as hereinafter expressed:

NOW THIS INDENTURE WITNESSETH that, in consideration of the said sum of £500 this day paid by the Mortgagee to the Mortgagor (the receipt whereof is hereby acknowledged), the Mortgagor doth hereby covenant with the Mortgagee that he (the Mortgagor) will pay to the Mortgagee, on the day of next, the sum of £500, together with interest thereon at the rate of six per cent. per annum.

AND THIS INDENTURE ALSO WITNESSETH that, for the consideration aforesaid, the Mortgagor, as beneficial owner, doth hereby assign unto the Mortgagee all those the said invention and Letters Patent and the sole and exclusive benefit thereof, to hold the said invention, Letters Patent, and premises unto the Mortgagee and his assigns, subject to the proviso for redemption hereinafter contained. PROVIDED ALWAYS that if the Mortgagor shall pay to the Mortgagee the sum of £500, with interest for the same in the meantime at the rate of six per cent. per annum, on the said day of next, then the Mortgagee will at any time thereafter, at the request and cost of the Mortgagor, re-assign to him the said Letters Patent and premises; but otherwise if the said sum of £500 or any part thereof shall remain unpaid after the said day of next, he the Mortgagor shall pay to the Mortgagee, so long as the said sum or any part thereof shall remain unpaid, interest on the said sum or unpaid part thereof at the rate of six per cent. per annum by equal half-yearly payments on the day of and the day of . PROVIDED ALSO that if the said Mortgagor shall at the said period, or within fourteen days thereafter, make payment to the Mortgagee of the said interest, and shall perform and observe all the covenants and conditions herein contained and on his part to be performed and observed, then the Mortgagee will not call in the said sum of £500 or any unpaid portion thereof until the day of , 19 . PROVIDED ALSO that in such case provided, the Mortgagor shall not before the said day of , 19 , compel the Mortgagee to receive the said sum of £500 or the unpaid portion thereof.

AND THE MORTGAGOR doth hereby covenant with the Mortgagee that the said Letters Patent are now valid and subsisting and not void or voidable, and that the Mortgagor will during the continuance of this security pay all fees necessary for the renewal and maintenance of the said Letters Patent at least one month before the day when such renewal fees shall become due, and shall forthwith send or deliver to the Mortgagee the receipt for every such payment; and if the Mortgagor should fail to pay such renewal fee, then the Mortgagee may, if he think fit, himself make payment of the fee, and the amount, together with the expenses,

fine, or other charges, will remain on the security hereof as further moneys advanced. PROVIDED ALSO that until the Mortgagee shall become entitled to exercise the power of sale to be implied herein, the Mortgagor shall be at liberty to use and work the said invention without interference from the Mortgagee, and may also, in the joint names of himself and the Mortgagee, grant licences to make, use, exercise, and vend the same.

LASTLY, it is hereby declared that, except when the context requires a different interpretation, each of the expressions "Mortgagor" and "Mortgagee" shall, wherever used herein, be also applicable, as far as possible, to the assigns of the parties thereby designated.

IN WITNESS &c.

NOTE.—*This Mortgage should be registered.*

# APPENDIX C.

## EXTRACT FROM THE PARTNERSHIP LAW AMENDMENT ACT, 1865.

(28 & 29 Victoria, Chapter 86.)

The advance of money on contract to receive a share of profit not to constitute the lender a partner.

**1.** The advance of money by way of loan to a person engaged or about to engage in any trade or undertaking upon a contract in writing with such person that the lender shall receive a rate of interest varying with the profits, or shall receive a share of the profits arising from carrying on such trade or undertaking, shall not, of itself, constitute the lender a partner with the person or the persons carrying on such trade or undertaking, or render him responsible as such.

* * * * * * *

In case of bankruptcy &c. lender not to rank with other creditors.

**5.** In the event of any such trader as aforesaid being adjudged a bankrupt, or taking the benefit of any Act for the relief of insolvent debtors, or entering into an arrangement to pay his creditors less than twenty shillings in the pound, or dying in insolvent circumstances, the lender of any such loan as aforesaid shall not be entitled to recover any portion of his principal, or of the profits or interest payable in respect of such loan. . . . .

# APPENDIX D.

## EXTRACTS FROM THE CONVEYANCING AND LAW OF PROPERTY ACT, 1881.[1]

(44 & 45 Victoria, Chapter 41.)

*Covenants for Title.*

Covenants for title to be implied.

**7.** (1) In a conveyance there shall, in the several cases in this section mentioned, be deemed to be included, and there shall in those several cases, by virtue of this Act, be implied, a covenant to the effect in this section stated, by the person or by each person who conveys, as far as regards the subject-matter or share of subject-matter expressed to be conveyed by him, with the person, if one, to whom the conveyance is made, or with the persons jointly, if more than one, to whom the conveyance is made as joint tenants, or with each of the persons, if more than one, to whom the conveyance is made as tenants in common: that is to say—

On conveyance for value by beneficial owner.

(*a*) In a conveyance for valuable consideration, other than a mortgage, the following covenant by a person who conveys and is expressed to convey **as beneficial owner**: namely—

*Right to convey.*

That, notwithstanding anything by the person who so conveys, or any one through whom he derives title, otherwise than by purchase for value, made, done, executed, or omitted, or knowingly suffered, the person who so conveys, has, with the concurrence of every other person, if any, conveying by his direction, **full power to convey the subject-matter expressed to be conveyed,** subject as, if so expressed, and in the manner in which, it is expressed to be conveyed, and

[1] *This Act does not extend to Scotland.*

that, notwithstanding anything as aforesaid, that subject-matter shall remain to and be quietly entered upon, received, and held, occupied, enjoyed, and taken, by the person to whom the conveyance is expressed to be made, and any person deriving title under him, and the benefit thereof shall be received and taken accordingly, without any lawful interruption or disturbance by the person who so conveys or any person conveying by his direction, or rightfully claiming, or to claim by, through, under, or in trust for the person who so conveys, or any person conveying by his direction, or by, through, or under any one not being a person claiming in respect of an estate or interest subject whereto the conveyance is expressly made, through whom the person who so conveys derives title, otherwise than by purchase for value; and that, freed and discharged from, or otherwise by the person who so conveys sufficiently indemnified against, all such estates, incumbrances, claims, and demands other than those subject to which the conveyance is expressly made, as either before or after the date of the conveyance have been or shall be made, occasioned, or suffered by that person or by any person conveying by his direction, or by any person rightfully claiming by, through, under, or in trust for the person who so conveys, or by, through, or under any person conveying by his direction, or by, through, or under any one through whom the person who so conveys derives title, otherwise than by purchase for value; and further, that the person who so conveys, and any person conveying by his direction, and every other person having or rightfully claiming any estate or interest in the subject-matter of conveyance, other than an estate or interest subject whereto the conveyance is expressly made, by, through, under, or in trust for the person who so conveys, or by, through, or under any person conveying by his direction, or by, through, or under any one through whom the person who so conveys derives title,

Quiet enjoyment.

Freedom from incumbrance.

Further assurance.

otherwise than by purchase for value, will, from time to time, and at all times after the date of the conveyance, on the request and at the cost of any person to whom the conveyance is expressed to be made, or of any person deriving title under him, execute and do all such lawful assurances and things for further or more perfectly assuring the subject-matter of the conveyance to the person to whom the conveyance is made, and to those deriving title under him, subject as, if so expressed, and in the manner in which the conveyance is expressed to be made, as by him or them or any of them shall be reasonably required:

On mortgage, by beneficial owner.

(c) In a conveyance by way of mortgage, the following covenant by a person who conveys and is expressed to convey **as beneficial owner**: namely—

Right to convey.

That the person who so conveys has, with the concurrence of every other person, if any, conveying by his direction, full power to convey the subject-matter expressed to be conveyed by him, subject as, if so expressed, and in the manner in which it is expressed to be conveyed: and also that, if default is made in payment of the money intended to be secured by the conveyance, or any interest thereon, or any part of that money or interest, contrary to any provision in the conveyance, it shall be lawful for the person to whom the conveyance is expressed to be made, and the persons deriving title under him, to enter into and upon, or receive, and thenceforth quietly hold, occupy, and enjoy or take and have, the subject-matter expressed to be conveyed, or any part thereof, without any lawful interruption or disturbance by the person who so conveys, or any person conveying by his direction, or any other person not being a person claiming in respect of an estate or interest subject whereto the conveyance is expressly made; and that, freed and discharged from, or otherwise by the person who so conveys sufficiently indemnified against, all estates, incumbrances, claims, and demands whatever, other than those subject whereto the conveyance is expressly made; and further, that the person who so conveys and every

Quiet enjoyment.

Freedom from incumbrance.

Further assurance.

person conveying by his direction, and every person deriving title under any of them, and every other person having or rightfully claiming any estate or interest in the subject-matter of conveyance, or any part thereof, other than an estate or interest subject whereto the conveyance is expressly made, will from time to time and at all times, on the request of any person to whom the conveyance is expressed to be made, or of any person deriving title under him, but, as long as any right of redemption exists under the conveyance, at the cost of the person so conveying, or of those deriving title under him, and afterwards at the cost of the person making the request, execute and do all such lawful assurances and things for further or more perfectly assuring the subject-matter of conveyance and every part thereof to the person to whom the conveyance is made, and to those deriving title under him, subject as, if so expressed, and in the manner in which the conveyance is expressed to be made as by him or them or any of them shall be reasonably required:

On conveyance by trustee or mortgagee.

(*f*) In any conveyance the following covenant by every person who conveys and is expressed to convey **as trustee or mortgagee**, or as personal representative of a deceased person, or as committee of a lunatic so found by inquisition, or under an order of the Court, which covenant shall be deemed to extend to every such person's own acts only: namely—

Assurance against incumbrances.

That the person so conveying has not executed or done, or knowingly suffered, or been party or privy to any deed or thing, whereby or by means whereof the subject-matter of the conveyance, or any part thereof, is or may be impeached, charged, affected, or incumbered in title, estate, or otherwise, or whereby or by means whereof the person who so conveys is in anywise hindered from conveying the subject-matter of the conveyance, or any part thereof, in the manner in which it is expressed to be conveyed.

(2) Where in a conveyance it is expressed that by direction of a person expressed to direct **as beneficial**

**owner** another person conveys, then, within this section, the person giving the direction, whether he conveys and is expressed to convey as beneficial owner or not, shall be deemed to convey and to be expressed to convey as beneficial owner the subject-matter so conveyed by his direction; and a covenant on his part shall be implied accordingly.

(4) Where in a conveyance a person conveying is **not expressed to convey as beneficial owner,** or as settlor, or as trustee, or as mortgagee, or as personal representative of a deceased person, or as committee of a lunatic so found by inquisition, or under an order of the Court, or by direction of a person as beneficial owner, **no covenant on the part of the person conveying shall be, by virtue of this section, implied in the conveyance.**

(6) The benefit of a covenant implied as aforesaid shall be annexed and incident to, and shall go with, the estate or interest of the implied covenantee, and shall be capable of being enforced by every person in whom that estate or interest is, for the whole or any part thereof, from time to time vested.

(7) A covenant implied as aforesaid may be varied or extended by deed, and, as so varied or extended, shall, as far as may be, operate in the like manner, and with all the like incidents, effects, and consequences as if such variations or extensions were directed in this section to be implied.

Covenants to extend to heirs &c.

**59.** (1) A covenant and a contract under seal, and a bond or obligation under seal, though not expressed to bind the heirs, shall operate in law to bind the heirs and real estate, as well as the executors and administrators and personal estate, of the person making the same, as if heirs were expressed.

(2) This section extends to a covenant implied by virtue of this Act.

Effect of covenant with two or more jointly.

**60.** (1) A covenant and a contract under seal, and a bond or obligation under seal, made with two or more jointly to pay money or to make a conveyance, or to do any other act to them or for their benefit, shall be deemed to include, and shall, by virtue of this Act, imply an obligation to do the act to or for the benefit of the survivor or survivors of them, and to or for the benefit of any other person to whom the right to sue on the covenant, contract, bond, or obligation devolves.

# APPENDIX E.

## THE STAMP MEDICINES ACT. 1812.

ACCORDING to this Act, where any person prepares and sells medicaments for inward or outward use, alleged to be compounded from some secret recipe, or claims to have an exclusive right or title to the making or preparing of the same, **or where such medicaments are exposed for sale under the authority of any Letters Patent,** the packet, box, or bottle must bear a Government stamp applied in such a way that the contents cannot be reached without tearing the stamped label or cover. *Penalty for non-observance £10 for each offence.* (See remarks on "Patent Medicines," page 188, *ante*.)

# APPENDIX F.

## THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 to 1901 (Consolidated).

*The Acts contain 117 Sections with Schedules, and the respective Sections are to the following effect:—*

### PART I. PRELIMINARY.

Section
1. Short title.
2. Division of Acts into parts. Preliminary; Patents; Designs; Trade Marks; General.
3. Commencement of Act.

### PART II.—PATENTS.

*Application for and grant of Patent.*

4. Persons entitled to apply for patent. Joint Patentees; Statutory Declarations.
5. Application and specification. Drawings.
6. Reference of application to Examiner.
7. Power of Comptroller to refuse application or require amendment.
8. Time for leaving Complete Specification.
9. Comparison of Provisional and Complete Specifications.
10. Advertisement on acceptance of Complete Specification.
11. Opposition to grant of patent.
12. Sealing of patent. Extension of time.
13. Date of patent. Publication of specification.

*Provisional Protection.*

14. Provisional protection. Invention may be used during provisional term.

*Protection by Complete Specification.*

15. Effect of acceptance of Complete Specification.

*Patent.*

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

*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.

## PART II. PATENTS (*continued*).

*Compulsory Licences.*

Section
22. Power of Board of Trade to order grant of licences.

*Registry 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 King 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 for 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 afterwards acquired.
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.

*Registration of Designs.*

Section
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. Essential features of trade marks.
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.

## PART IV. TRADE MARKS (*continued*).

Section
70. Assignment and transmission of trade mark.
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 in defence to action in certain cases.
77A. Certificate as to exclusive use and costs thereon.

*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. Trusts 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 and certified 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.

PART V.—GENERAL *(continued)*.

Section
99. Declaration by infant, lunatic, &c.
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.
102A. Proceedings of Board of Trade.

*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 &c.
106. Penalty on unauthorised assumption of Royal Arms.

*Scotland, Ireland, &c.*

107. Saving for Courts in Scotland.
108. Summary proceedings in Scotland.
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# THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 to 1901 (Consolidated).

THE REPEALED PORTIONS OF THE ACT OF 1883 ARE PRINTED IN *italics*. THE AMENDMENTS EFFECTED BY THE SUCCEEDING ACTS ARE IN **heavy type.** THE AMENDING ACT AND SECTIONS ARE CITED IN THE MARGIN.

(46 & 47 VICTORIA, CHAPTER 57.)

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

[25th August, 1883.

**48 & 49 Vict. c. 63.—An Act to amend The Patents, Designs, and Trade Marks Act, 1883.**

**[14th August, 1885.**

**49 & 50 Vict. c. 37.—An Act to remove certain doubts respecting the construction of The Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.**

**[25th June, 1886.**

**51 & 52 Vict. c. 50.—An Act to amend The Patents, Designs, and Trade Marks Act, 1883.**

**[24th December, 1888.**

**1 Ed. VII. c. 18.—An Act to amend the Law with reference to International Arrangements for Patents.**

**[17th August, 1901.**

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.

**1.** This Act may be cited as "The Patents, Designs, short title. and Trade Marks Act, 1883."

Division of Act into parts.

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

PART I.—PRELIMINARY.

II.—PATENTS.

III.—DESIGNS.

IV. TRADE MARKS.

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.

Act 1888, s. 28.

**The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the First day of January, One thousand eight hundred and eighty-nine.**

## 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.

Act 1885, s. 5.

Power to grant Patents to several persons jointly.

**Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor: be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.**

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 be sent by post to, the Patent Office in the prescribed manner.

(2) An application must contain a declaration to the effect that the applicant is in possession of an invention

whereof he, or in the case of a joint application one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent: and must be accompanied by either a Provisional or Complete Specification.

**The declaration may be either a statutory declaration under The Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.**

Act 1885, s. 2. 5 & 6 Will. IV., c. 62.

(3) A Provisional Specification must describe the nature of the invention, and be accompanied by drawings, if required.

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

**The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the Complete Specification refers to the drawings which accompanied the Provisional Specification. And no patent heretofore sealed shall be invalid by reason only that the Complete Specification was not accompanied by drawings, but referred to those which accompanied the Provisional Specification.**

The same drawings may accompany both specifications.

Act 1886, s. 2.

(5) A specification, whether Provisional or Complete, must commence with the title, and in case of a Complete Specification must end with a distinct statement of the invention claimed.

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

Reference of application to Examiner.

*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, specification, or drawings be amended before he proceeds with the application.*

*Power for Comptroller to refuse application or require amendment.*

Repealed by Act 1888, s. 2.

*(2) Where the Comptroller requires an amendment, the applicant may appeal from his decision to the Law Officer.*

*(3) The Law Officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.*

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

*(5) If after an examination 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 applicant that he has so reported.*

*(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.]*

s. 2. Power of Comptroller to refuse application or require amendment.

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

**(2) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the Law Officer.**

**(3) The Law Officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.**

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

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

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 within nine months from the date of application.

Act 1885, s. 3.

A Complete Specification may be left within such extended time, not exceeding one month after the said nine months, as the Comptroller may on payment of the prescribed fee allow.

(2) Unless a Complete Specification is left within that time, the application shall be deemed to be abandoned.

Comparison of Provisional and Complete Specifications.

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.

Act 1885, s. 3.

**A Complete Specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the Comptroller may on payment of the prescribed fee allow.**

Repealed by Act 1888, s. 3.

(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.

Advertisement on acceptance of Complete Specification.

**10.** On the acceptance of the Complete Specification the Comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings (if any) shall be open to public inspection.

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

Repealed by Act 1888, s. 4.

[*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*],

Act 1888, s. 4.

**or on the ground that the Complete Specification describes or claims an invention other than that described in the Provisional Specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the Provisional Specification and the leaving of the Complete Specification,** but on no other ground.

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

(3) The Law Officer shall, if required, hear the 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.

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 to be sealed with the seal of the Patent Office.

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

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

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

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

Act 1885, s. 3.

**A Complete Specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively, as the Comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.**

Date of patent.

**13.** Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the Complete Specification: 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.

Specifications &c. not to be published unless application accepted.

Act 1885, s. 3.

**Where an application for a patent has been abandoned or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application shall not at any time be open to public inspection or be published by the Comptroller.**

*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.

*Protection by Complete Specification.*

Effect of acceptance of 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.

*Patent.*

Extent of patent.

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

Term of patent.

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

(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.

(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.

(4) Thereupon the Comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fees 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.

*Amendment of Specification.*

Amendment of specification.

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

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

(3) Where such notice is given, the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the Law Officer.

(4) The Law Officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the Law Officer entitled to be heard

in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

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

(6) When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the Law Officer.

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

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

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

*Repealed by Act 1888, s. 5.*

*[(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.]*

*Act 1885, s. 5.*

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

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

**19.** 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.

*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.

Advertisement of amendment.

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

*Compulsory Licences.*

Power for Board to order grant of licences.

**22.** If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

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

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

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

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

*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 licences under patents, and of amendments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

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

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

*Fees.*

Fees in Schedule.

**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 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.

*Extension of Term of Patent.*

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

**25.** (1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to Her Majesty in Council, praying that his patent may be extended for a further term: 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*, 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 in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(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, conditions, 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.

(7) 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.

*Revocation.*

Revocation of patent.

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

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

(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:

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

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

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

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

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

*Crown.*

Patent to bind 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.

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

*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 specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury 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.

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.

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

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

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

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

(6) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the

same is certified by the Court or a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

Order for inspection &c. in action.

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

Certificate of validity questioned, and costs thereon.

**31.** In an action for infringement of a patent, the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses, as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same.

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.

*Miscellaneous.*

Patent for one invention only.

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

Patent on application of representative of deceased inventor.

**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.

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

Proviso as to first inventor not invalidated by application from fraud or law.

**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.

Assignment for part of 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.

Lost 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.

Powers 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.

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, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the rights of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of

*the invention or the validity of any patent granted on the application provided that both the following conditions are complied with; namely—*

*(a)* The exhibitor must, before exhibiting the invention, give the Comptroller the prescribed notice of his intention to do so; and

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

Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

Protection of patents and designs exhibited at international exhibitions. Act 1886, s. 3.

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that Sections Thirty-nine and Fifty-seven of The Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

Publication of illustrated journal, indexes, &c.

40. (1) The Comptroller shall cause to be issued periodically an illustrated journal of patent inventions, as well as reports of patent cases decided by Courts of Law, 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.

(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, abridgements of specifications, catalogues, and other works relating to inventions, as he may see fit.

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.

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.

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.

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 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.

(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 person or persons authorised by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

*Existing Patents.*

Provisions respecting 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.

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

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

(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 after the commencement of this Act in the Patent Office.

*Definitions.*

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

**46.** In and for the purposes of this Act—

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within Section 6 of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, Chapter 3, intituled, "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention.

In Scotland "injunction" means "interdict."

## PART III.

### DESIGNS.

*Registration of Designs.*

Application for registration of designs.

**47.** (1) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act

(2) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4) The same design may be registered in more than one class.

(5) In case of doubt as to the class in which a design ought to be registered, the Comptroller may decide the question.

(6) The Comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.

(7) The Board of Trade shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

Drawings, &c., to be furnished on application.

**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.

(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.

Certificate of registration.

**49.** (1) The Comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The Comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

*Copyright in Registered Designs.*

Copyright on registration.

**50.** (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration), furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Comptroller may erase his name from the Register, and thereupon his copyright in the design shall cease.

Marking registered designs.

**51.** Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so, the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Inspection of registered designs.

**52.** (1) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the Comptroller or by the Court, and furnishing such information as may enable the Comptroller to identify the design, nor except in the presence of the Comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

Act 1883, s. 6.

**Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.**

(2) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

Information as to existence of copyright.

**53.** On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the Comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the Comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Cesser of copyright 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.

*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 *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

*Fees.*

Fees on registration &c.

**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.

*Industrial and International Exhibitions.*

Exhibition at Industrial or International Exhibition not to prevent or invalidate registration.

**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—

(*a*) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the Comptroller the prescribed notice of his intention to do so; and

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

Protection of patents and designs exhibited at International Exhibitions. Act 1886. s. 3.

And whereas it is expedient to provide for the extension of this section to Industrial and International Exhibitions held out of the United Kingdom, be it therefore enacted as follows:

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that Sections Thirty-nine and Fifty-seven of The Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an Industrial or International Exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

*Legal Proceedings.*

Penalty on piracy of registered design. Act 1888. s. 7.

58. During the existence of copyright in any design—

(*a*) It shall not be lawful for any person without the license or written consent of the registered proprietor to apply **or cause to be applied** such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and

(*b*) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction:

Act 1888. s. 7. **Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.**

Action for damages.

**59.** Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale, or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

*Definitions.*

Definition of "design," "copyright."

**60.** In and for the purposes of this Act -

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, Chapter 56).

"Copyright" means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of "proprietor."

**61.** The author of any new and original design shall be considered the "proprietor" thereof unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

# PART IV.

## TRADE MARKS.

### *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, and must be left at, or sent by post to *the Patent Office in the prescribed manner* **such place and in such manner as may be prescribed.**

Act 1888, s. 8.

(3) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered.

(4) The Comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(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.

Act 1888, s. 8.

**(6) Where an applicant for the registration of a trade mark otherwise than under an International Convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.**

Limit of time for proceeding with application.

**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*, **the Comptroller shall give notice of the non-completion to the agent employed on behalf of**

Act 1888, s. 9.

the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.

Conditions of registration of trade mark.

*64. (1) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:*

Repealed by Act 1888, s. 10.

*(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*

*(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or*

*(c) A distinctive device, mark, brand, heading, label, or ticket, or 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 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.]*

Conditions of registration of trade mark. Act 1888, s. 10.

64. (1) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

(a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

(c) A distinctive device, mark, brand, heading, label, or ticket; or

(*d*) An invented word or invented words; or

(*e*) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them; but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3) Provided as follows:

(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark before the Thirteenth day of August, One thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.

Connection of trade mark with goods.

**65.** A trade mark must be registered for particular goods or classes of goods.

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.

Trade marks not to be registered in any colour.
Act 1888, s. 11.

**67.** A trade mark may be registered in any colour **or colours**, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour **or colours.**

Advertisement of application.
Act 1888, s. 12.

**68.** Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the Comptroller, **unless the Comptroller refuse to entertain the application.**

Opposition to registration.
Act 1888, s. 13, s.s. 1, 2.

**69.** (1) Any person may within *two months*] **one month or such further time, not exceeding three months, as the Comptroller may allow,** 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.

Act 1888, s. 13, s.s. 3.

(2) Within *two months*] **one month** after receipt of such notice, or such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Repealed by Act 1888, s. 13, s.s. 4.

*(3) If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after the expiration of such time for sending evidence as may be prescribed, give to the parties an opportunity of being heard, if they desire it.*

*(4) The evidence in support of and in opposition to the application shall be submitted in such manner as may be prescribed by rules made under this Act, but the Comptroller may, in any case, allow further evidence to be given on such terms as he may think fit.*

*(5) 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 in 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.*

*(6) 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.*

Act 1888, s. 3, s.s. 4.

**(3) If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after**

hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether and subject to what conditions (if any) registration is to be permitted.

(4) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

(5) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.

(6) Where the opponent is out of the United Kingdom, he shall give the Comptroller an address for service in the United Kingdom.

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.

Conflicting claims to registration

**71.** Where each of several persons claims to be registered as proprietors 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.

Restrictions on registration

**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 make identical with one already on the register with respect to such goods or description of goods.

(2) **Except as aforesaid** the Comptroller shall not register with respect to the same goods or description of goods a trade mark *[so nearly resembling]* **having such resemblance to** a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive. Act 1888 s. 14.

**73.** It shall not be lawful to register as part of or in combination with a trade mark any words the *exclusive* use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice, or any scandalous design. Further restriction on registration. Act 1888. s. 15.

**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— Saving for power to provide for entry on register of common marks as additions to trade marks.

(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;

(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—

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.]* Repealed by Act 1888, s. 16.

(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must Act 1888, s. 16.

disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.

(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.

*Effect of Registration.*

Registration equivalent to public use. Act 1888, s. 17.

75. *[Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.]*

Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall, for the purposes of this Act, be deemed to be, and as from the First day of January, One thousand eight hundred and seventy-six, to have been, the date of the registration.

Right of first proprietor to exclusive use of trade mark.

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.

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, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the 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.

Certificate as to exclusive use, and costs thereon. Act 1883, s. 18.

77a. In an action for infringement of a registered trade mark the Court or a Judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a Judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the subsequent action certifies that he ought not to have the same.

*Register of Trade Marks.*

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.

Removal of trade mark after fourteen years unless fee paid.

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 (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2) If such fee be not paid before the expiration of such fourteen years, the Comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the Register, and so from time to time at the expiration of every period of fourteen years.

(3) If before the expiration of the said three months the registered proprietor pays the said fee, together with the

additional prescribed fee, the Comptroller may without removing such trade mark from the Register accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4) Where after the said three months a trade mark has been removed from the Register for nonpayment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade mark to the Register on payment of the prescribed additional fee.

(5) Where a trade mark has been removed from the Register for nonpayment of the fee or otherwise, such trade mark shall nevertheless, for the purpose of any application for registration during *the first years* **one year** next after the date of such removal, be deemed to be a trade mark which is already registered, **unless it is shown to the satisfaction of the Comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark.**

Act 1888, s. 19, s.s. 1.

Act 1888, s. 19, s.s. 2.

*Fees.*

Fees to be prescribed by Act.

**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.

*Sheffield Marks.*

Registration by Cutlers' Company of Sheffield marks.

**81.** With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called "the Cutlers' Company"), and the marks or devices (in this Act called "Sheffield marks") assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

(1) The Cutlers' Company shall establish and keep at Sheffield a new Register of Trade Marks (in this Act called "the Sheffield Register"):

[(2) *The Cutlers' Company shall enter in the Sheffield Register, in respect of 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 used before the commencement of this Act, but which have not been entered in the Register established under The Trade Marks Registration Act, 1875:*

Repealed by Act 1888, s. 20, s.s. 1.

(2) The Cutlers' Company shall enter in the Sheffield Register, in respect of metal goods as defined in this section, all the trade marks entered before the First day of January, One thousand eight hundred and eighty-nine, in respect of metal goods either in the Register established under The Trade Marks Registration Act, 1875, or in the Register of Trade Marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield Register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the First day of January, One thousand eight hundred and eighty-four, but which have not been entered in either of the said other Registers:

Act 1888, s. 20, s.s. 1.

38 & 39 Vict. c. 91.

(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* on metal goods shall, if made after the commencement

Act 1888, s. 20, s.s. 2.

of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5) If the Comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6) Upon the registration of a trade mark in the Sheffield Register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the Register of Trade Marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day:

Repealed by Act 1888, s. 20, s.s. 3.

*(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 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:*

Act 1888, s. 20, s.s. 3.

**(7) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to**

the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly, with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield Register, for the Comptroller, the Patent Office, and the Register of Trade Marks respectively; and notice of every entry, cancellation, or correction made in the Sheffield Register shall be given to the Comptroller by the Cutlers' Company: provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register:

(8) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used *on cutlery, edge tools, or on saw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*, on metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company: Act 1888, s. 20, s.s. 2.

(9) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' Register of Corporate Trade Marks, and thereupon all marks entered therein shall, unless entered in the Sheffield Register, be deemed to have been abandoned:

(10) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of two or more trade marks:

(11) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act

relating to the Cutlers' Company) be registered in the Sheffield Register as proprietor of a trade mark or trade marks:

(12) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the Comptroller shall be subject to a further appeal to the Court:

(13) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks: that is to say, the Fifth Section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield Register:

Act 1888, s. 20, s.s. 4.

**(14) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal:**

**(15) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield Register a certificate under the hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the Comptroller.**

## PART V.

## GENERAL.

### *Patent Office and Proceedings thereat.*

Patent Office.

**82.** (1) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, "the Patent Office."

(2) Until a new Patent Office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of Patents, Designs, and Trade Marks, who shall act under the superintendence and direction of the Board of Trade.

(4) Any act or thing directed to be done by or to the Comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

Officers and clerks.

**83.** (1) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the Comptroller-General of Patents, Designs, and Trade Marks, and so many Examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of Patent Office.

**84.** There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in Register.

**85.** There shall not be entered in any Register kept under this Act, or be receivable by the Comptroller, any notice of any trust, expressed, implied, or constructive.

Refusal to grant patent &c. in certain cases.

**86.** The Comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in Registers.

**87.** Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person

to be entered as proprietor of the patent, copyright in the design, or trade mark, in the Register of Patents, Designs, or Trade Marks, as the case may be. The person for the time being entered in the Register of Patents, Designs, or Trade Marks as proprietor of a patent, copyright in a design, or trade mark, as the case may be, shall, subject to **the provisions of this Act and to** any rights appearing from such Register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Act 1885. s. 21.

Inspection of and extracts from Registers.

Act 1888. s. 22.

**88.** Every Register kept under this Act shall at all convenient times be open to the inspection of the public, subject to **the provisions of this Act and to** such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such Register shall be given to any person requiring the same on payment of the prescribed fee.

Printed and certified copies to be received in evidence.

**89.** Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from Registers and other books kept there, shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Power to rectify Register by Court.

Act 1888. s. 23.

**90.** (1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person **or of any other particulars** from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry as the Court thinks fit; or the Court may refuse the application: and in either case may make such order with respect to the costs of the proceedings as the Court think fit.

(2) The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide for the rectification of a Register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3) Any order of the Court rectifying a Register shall direct that due notice of the rectification be given to the Comptroller.

Power for Comptroller to correct clerical errors.

**91.** The Comptroller may, on request in writing, accompanied by the prescribed fee -

(*a*) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark; or

(*b*) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark.

(*c*) Cancel the entry or part of the entry of a trade mark on the Register: provided that the applicant accompanies his request by a statutory declaration, made by himself, stating his name, address, and calling, and that he is the person whose name appears on the Register as the proprietor of the said trade mark.

(*d*) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered. Act 1888, s. 24.

Alteration of registered mark.

**92.** (1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant, and the Comptroller shall be entitled to be heard on the application.

(3) If the Court grants leave, the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the Register to be altered in conformity with the order of leave.

**93.** If any person makes or causes to be made a false entry in any Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such Register,

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.

Exercise of discretionary power by Comptroller.

**94.** Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Power of Comptroller to take directions of Law Officers.

**95.** The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the Law Officers for directions in the matter.

Certificate of Comptroller to be evidence.

**96.** A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima 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.

Application and notices by post.

**97.** (1) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post

Provisions as to [illegible] and notices [illegible]

**98.** Whenever the last day [illegible] by this Act, or by any rule for the time being in force, for leaving any [illegible] or giving any [illegible] at the Patent Office shall fall [illegible] or [illegible] day, [illegible] Friday, or [illegible] Monday, or any day observed as a [illegible] Parliament or any day [illegible]

thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

Declaration by infant, lunatic, &c

**99.** If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or, if there be none, any person appointed by any Court or Judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Transmission of certified printed copies of specifications &c

**100.** Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make rules

**101.** (1) The Board of Trade may from time to time make such general rules and do such things as they shall consider expedient, subject to the provisions of this Act

(a) For regulating the practice to be followed under this Act:

(b) For classifying goods for the purposes of the registration of trade marks:

(*c*) For making or requiring duplicates of specifications, amendments, drawings, or other documents:

(*d*) For securing and regulating the publishing and selling of copies, and at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments, and other documents:

(*e*) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(*f*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(*g*) Generally, for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

(2) Any of the forms in the First Schedule to this Act may be altered or amended by Rules made by the Board as aforesaid.

(3) General Rules may be made under this section at any time after the passing of this Act [illegible] to take effect [illegible] of this Act, and shall [illegible] if they were contained in this Act, and shall be judicially noticed.

[illegible]

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.

Proceedings of Board of Trade.

Act 1888, s. 25.

**102a. (1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a Secretary or an Assistant Secretary of the Board.**

**(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a Secretary or Assistant Secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.**

**(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.**

*International and Colonial Arrangements.*

**103.** [illegible]

Act 1901, s. 1, s.s. 2.

**An application under this section shall be accompanied by a Complete Specification, which, if it be not accepted within the period of twelve months, shall, with the drawings (if any), be open to public inspection at the expiration of that period.**

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his Complete Specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2) The publication in the United Kingdom or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act.

(4) The provisions of this section shall apply only in the case of those Foreign States with respect to which His Majesty shall from time to time by Order in Council declare that the provisions of this section shall apply, and so long as any such Order in Council remains in force with respect to that State.

Power to extend time.

**104.** (1) Where it is made to appear to the [illegible]

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," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Penalty on unauthorised assumption of Royal Arms,

**106.** Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal Arms, or Arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding forty pounds.

*Scotland, Ireland, &c.*

Application to Scotland.

**107.** In the application of this Act to Scotland the following provisions shall have effect, that is to say,

[illegible]

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.

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.

General saving for jurisdiction of Courts.

**111.** (1) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks: and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said Court: and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2) If any rectification of a Register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the Order, Decree, or other authority for the rectification shall be served on the Comptroller, and he shall rectify the Register accordingly.

Isle of Man.

**112.** This Act shall extend to the Isle of Man, and—

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts.

(2) The punishment for a 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.

Jurisdiction of Lancashire Palatine Court. Act 1883, s. 26.

112a. The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as Her Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly.

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.

*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.

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.

(2) The Registers of Designs and of Trade Marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of Designs and the Register of Trade Marks kept under this Act.

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.

*General Definitions.*

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.

Register of Patent Agents. Act 1888, s. 1.

(1) After the First day of July, One thousand eight hundred and eighty-nine, a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of Section One hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

# SCHEDULES.

## THE FIRST SCHEDULE.

### FORMS OF APPLICATION &c.

Section 5.

### FORM A.

[£1 Stamp.] FORM OF APPLICATION FOR PATENT.

(See *Forms A. A 1. and A 2. Patents Rules, 1890 to 1901. Consolidated.*)

### FORM B.

FORM OF PROVISIONAL SPECIFICATION.

(See *Form B. Patents Rules, 1890 to 1901. Consolidated.*)

### FORM C.

[£3 Stamp.] FORM OF COMPLETE SPECIFICATION.

(See *Form C. Patents Rules, 1890 to 1901. Consolidated.*)

Section 33.

### FORM D.

FORM OF PATENT.

Form of Letters Patent.

EDWARD, by the grace of God, of the United Kingdom of Great Britain and Ireland King, Defender of the Faith: To all to whom these presents shall come greeting:

Whereas *John Smith*, of 20 *Perry Street, Birmingham*, in the county of *Warwick*, *Engineer*, hath declared that he is in possession of an invention for "*Improvements in Sewing*

*Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief: Form of Letters Patent.

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his Complete Specification particularly described the nature of his invention:

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents, for us our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate

Form of Letters Patent.

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 be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our Letters Patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these Letters Patent, or in respect of any matter relating thereto, at the time or times, and in manner for the time being by law provided: and also if the said patentee shall not supply or cause to be supplied, for our service, all such articles of the said invention as may be required by the officers or Commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our Letters Patent and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And, lastly, we do by these presents, for us, our heirs and successors, grant unto the said patentee that these our Letters Patent shall be construed in the most

beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our Letters to be made patent, and to be sealed as of the
One thousand nine hundred and

Form of Letters Patent.

C. N. DALTON.

*Comptroller-General of Patents, Designs, and Trade Marks.*

Seal of Patent Office.

## FORM E.

Section 17.

FORM OF APPLICATION FOR REGISTRATION OF DESIGN.

(See *Form E, Designs Rules, 1890 to 1898, Consolidated.*)

## FORM F.

Section 62.

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

(See *Form F, Trade Marks Rules, 1890 to 1898, Consolidated.*)

*All the forms relating to Patents will be found in the Second Schedule to The Patents Rules, 1890 to 1901 (Consolidated), which immediately follow. The forms relating to Trade Marks and Designs are set forth in the Schedules attached to the Consolidated Rules of 1890 to 1898, which respectively regulate the administration of these divisions.*

# THE SECOND SCHEDULE.

## FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

[ALTERED IN ACCORDANCE WITH THE PATENTS RULES, 1892.
SECOND SET.

(A) *Up to Sealing.*

| | £ | s. | d. | £ | s. | d. |
|---|---|---|---|---|---|---|
| On application for Provisional Protection .. | 1 | 0 | 0 | | | |
| On filing Complete Specification . . | 3 | 0 | 0 | | | |
| | | | | 4 | 0 | 0 |

*Or*

| | | | |
|---|---|---|---|
| On filing Complete Specification with first application | 4 | 0 | 0 |

(B) *Further Annual Renewal Fees, beginning before End of Fourth Year from Date of Patent.*

| | £ | s. | d. |
|---|---|---|---|
| Before the expiry of the fourth year from the date of the patent, and in respect of the fifth year ... | 4 | 0 | 0 |
| Before the expiry of the fifth year from the date of the patent, and in respect of the sixth year ... | 6 | 0 | 0 |
| Before the expiry of the sixth year from the date of the patent, and in respect of the seventh year ... | 7 | 0 | 0 |
| Before the expiry of the seventh year from the date of the patent, and in respect of the eighth year ... | 8 | 0 | 0 |
| Before the expiry of the eighth year from the date of the patent, and in respect of the ninth year ... | 9 | 0 | 0 |
| Before the expiry of the ninth year from the date of the patent, and in respect of the tenth year ... | 10 | 0 | 0 |
| Before the expiry of the tenth year from the date of the patent, and in respect of the eleventh year ... | 11 | 0 | 0 |
| Before the expiry of the eleventh year from the date of the patent, and in respect of the twelfth year ... | 12 | 0 | 0 |
| Before the expiry of the twelfth year from the date of the patent, and in respect of the thirteenth year... | 13 | 0 | 0 |
| Before the expiry of the thirteenth year from the date of the patent, and in respect of the fourteenth year | 14 | 0 | 0 |

# THE THIRD SCHEDULE.

ENACTMENTS REPEALED (*See Section 113*).

| | | |
|---|---|---|
| 21 James 1. c. 3. [1623.] | The Statute of Monopolies. In part; namely — Sections Ten, Eleven, and Twelve. | |
| 5 & 6 Will. 4. c. 62. [1835.] In part. | The Statutory Declarations Act, 1835. In part; namely — Section Eleven. | |
| 5 & 6 Will. 4. c. 83. [1835.] | An Act to amend the law touching Letters Patent for inventions. | |
| 2 & 3 Vict. 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 Vict. c. 100. [1842.] | An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture. | |
| 6 & 7 Vict. c. 65. [1843.] | An Act to amend the laws relating to the copyright of designs. | |
| 7 & 8 Vict. c. 69.[1] [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 Vict. c. 104 [1850.] | An Act to extend and amend the Acts relating to the copyright of designs. | |
| 15 & 16 Vict. c. 83. [1852.] | The Patent Law Amendment Act, 1852. | |
| 16 & 17 Vict. 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 certain indexes of specifications. | |

[1] Sections Six and Seven of this Act are repealed by The Statute Law Revision (No. 2) Act, 1874.

| | |
|---|---|
| 16 & 17 Vict. 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 Vict. 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 designs for ornamenting articles of manufacture. |
| 22 Vict. c. 13. 1858. | An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war. |
| 24 & 25 Vict. c. 73. 1861. | An Act to amend the law relating to the copyright of designs. |
| 28 & 29 Vict. c. 3. 1865. | The Industrial Exhibitions Act, 1865. |
| 33 & 34 Vict. c. 27. 1870. | The Protection of Inventions Act, 1870. |
| 33 & 34 Vict. c. 97. 1870. | The Stamp Act, 1870.<br>In part: namely<br>Section Sixty-five, and in the Schedule the words and figures:<br>"Certificate of the registration of a design. . £5 0 0<br>And see Section 65." |
| 38 & 39 Vict. c. 91. 1875. | The Trade Marks Registration Act, 1875. |
| 38 & 39 Vict. c. 93. 1875. | The Copyright of Designs Act, 1875. |
| 39 & 40 Vict. c. 33. 1876. | The Trade Marks Registration Amendment Act, 1876. |
| 40 & 41 Vict. c. 37. 1877. | The Trade Marks Registration Extension Act, 1877. |
| 43 & 44 Vict. c. 10. 1880. | The Great Seal Act, 1880.<br>In part: namely—<br>Section Five. |
| 45 & 46 Vict. c. 72. 1882. | The Revenue, Friendly Societies, and National Debt Act, 1882.<br>In part: namely—<br>Section Sixteen. |

# APPENDIX G.

# PATENTS RULES, 1890—1901 (CONSOLIDATED).

NOTE.—THE RULES REPEALED ARE PRINTED IN ITALICS. THE SUBSTITUTED MATTER FROM THE RULES OF 1892, 1898, AND 1901 IS IN HEAVIER TYPE.

BY virtue of the provisions of The Patents, Designs, and Trade Marks Acts, 1883 to 1901, the Board of Trade do hereby make the following Rules:—

## Short Title.

1. These Rules may be cited as The Patents Rules, 1890. Short Title.

*Note.*—The Rules of 1892 to 1901, incorporated herewith, are to be cited as The Patents Rules, 1892 (Second Set); those of 1898 as The Patents Rules, 1898; and those of 1901 as The Patents Rules, 1901.

## Commencement.

2. These Rules shall come into operation from and immediately after the 31st day of March, 1890. Commencement.

*Note.*—The Rules of 1892 came into operation on the 30th September, 1892; those of 1898 on the 15th September, 1898; those of 1901 on the 1st January, 1902.

## Interpretation.

3. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

## Fees.

4. The fees to be paid under the above-mentioned Acts shall be those specified in the list of fees in the First Schedule to these Rules. Fees.

*Note.*—By the Rules of 1892 certain fees were substituted for the list in this Rule referred to.

## Forms.

5. The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A1, A2, B, and C in the Second Schedule to these Rules. Forms: alterations.

Application.

**6.** (1) An application for a patent containing the declaration mentioned in Sub-section 2 of Section 5 of the Act of 1883 and Section 2 of the Act of 1885 shall be made either in the Form A, or the Form A1, or the Form A2, set forth in the Second Schedule to these Rules, as the case *may be*.

Specification.

(2) The Form B in such Schedule of Provisional Specification and the Form C of Complete Specification shall respectively be used.

Other forms.

(3) The remaining Forms other than A, A1, A2, B, and C set forth in the Second Schedule to these Rules, may, as far as they are applicable, be used in any proceedings under these Rules.

GENERAL.

Hours of business.

**7.** The Patent Office shall be open to the public every weekday between the hours of ten and four, except on the days and times following:

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.*

Patents Rules, 1898.

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, but the Comptroller shall not be bound to recognise as such agent, or to receive further communication from any person whose name, by reason of his having been adjudged guilty

of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of The Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

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, except statutory declarations and affidavits, sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in large and legible characters, and, unless otherwise directed, in the English language, upon strong wide-ruled paper (on one side only), of a size of 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 documents shall at any time be left, if required by the Comptroller.

Exercise of discretionary power by Comptroller.

**11.** Before exercising any discretionary power given to the Comptroller by the said Acts 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. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

Notice of hearing.

**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 in writing 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.

Decision to be notified to parties.

**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.

Industrial or International Exhibitions.

**15.** 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 the Board of Trade have issued a certificate that the Exhibition is an industrial or international one, give to the Comptroller notice in writing of his intention to exhibit, publish, or use the invention, as the case may be.

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.

Power of amendment &c.

**16.** Any document for the amendment of which no special provision is made by the said Acts 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.

Postal communication with the Comptroller.

**16a.** 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 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.

Manner in which, and persons before whom, declaration is to be taken.

**17.** The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as *follows*:—

(*a*) In the United Kingdom, before any Justice of the Peace, or any Commissioner or other officer authorised by law 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.

Headings &c. of declarations.

**17a.** Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall, so far as possible, be confined to one subject.

*Note.*—All statutory declarations under the Patents Acts now require a 2s. 6d. impressed Revenue stamp.

## Application with Provisional or Complete Specification.

Order of recording applications.

**18.** Applications for patents sent 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.

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

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

Application by representative of deceased inventor.

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

Notice and advertisement of acceptance.

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

Inspection on acceptance of complete specification.

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

APPLICATION FOR COMMUNICATION FROM ABROAD.

Communication from abroad.

**23.** An application for a patent for an invention communicated from abroad shall be made in the Form A1 set forth in the Second Schedule to these Rules.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

Foreign application.

**24.** The term "foreign application" shall mean an application by any person for protection of his invention in a Foreign State or British Possession to which by any

Order of His Majesty in Council for the time being in force the provisions of Section 103 of The Patents, Designs, and Trade Marks Act, 1883, have been declared applicable. Patents Rules, 1901.

**25.** An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made, and shall specify all the Foreign States or British Possessions in which foreign applications have been made, and the official date or dates thereof respectively. The application must be made within **twelve** months from the date of the first foreign application, and must be **accompanied by a Complete Specification, and** signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any. Requirements in foreign applications under Convention. Patents Rules, 1901.

**26.** The application in the United Kingdom shall be made in the Form A2 in the Second Schedule to these Rules, and, in addition to the **Specification** left with such application, must be accompanied by—

(1) A copy or copies of the Specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such Foreign State or British Possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller. To be accompanied by certified copies of original foreign specifications.

(2) A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the Specification or document corresponding thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

Entry of foreign applications.

**27.** On receipt of such application, together with the prescribed Specification and the other document or documents accompanying the same, required by the last preceding Rule, and with such other proof (if any) as the Comptroller may require of or relating to such foreign application or of the official date thereof, the Comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

Acceptance within twelve months.

Patents Rules, 1901.

**27a. If the Complete Specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall, with the drawings, if any, be open to public inspection at the expiration of that period.**

General.

Patents Rules, 1901.

**28. Save as aforesaid,** all proceedings in connection with such application shall be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications.

Entry of date in Register.

**29.** The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

## Sizes and Methods of Preparing Drawings Accompanying Provisional or Complete Specifications.

Drawings for specifications.

**30.** The Provisional or Complete Specification need not be accompanied by drawings if the specification sufficiently describes the invention without them: but if drawings are furnished, they should accompany the Provisional or Complete Specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for letterpress should appear in the specification itself.

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

Requirements as to paper &c.

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

Size of drawings.

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

Quality of ink.

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

Scale of drawings.

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

Drawings to bear name of applicant &c.

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

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

Restrictions as to wood engravings.

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

Copies of drawings.

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

Provisional drawings used for Complete Specification.

**33.** If an applicant desires to adopt the drawings lodged with his Provisional Specification as the drawings for his Complete Specification, he should refer to them as those "left with the Provisional Specification."

## Opposition to Grants of Patents.

Notice of opposition.

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

Copy for applicant.

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

Particulars of prior patent.

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

Opponent's evidence.

**37.** Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of a Complete Specification, the opponent may

leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

Applicant's evidence.

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

Evidence 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.

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

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

Notice of hearing.

**41.** On completion of the evidence, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If the applicant or opponent desires to be heard, he must forthwith send the Comptroller an application on Form E. The Comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard, the Comptroller shall decide the case and notify his decision to the parties.

Disallowance of opposition in certain cases.

**42.** On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is

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

No extension of time allowed for filing evidence where fraud alleged.

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

Decision to be notified to parties.

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

Repealed.

*Certificates of Payment or Renewal.*

**45.** *If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to keep the same in force, he shall before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee of £50 or £100, as the case may be.*

**46.** *In the case of patents granted before the commencement of the said Acts, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."*

**47.** *If the patentee intends to pay annual fees in lieu of the above-mentioned fees of £50 and £100, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the thirteenth year thereof, pay the prescribed fee.*

*The Form J in the Second Schedule, duly stamped, should be used for the purpose of this and the payment referred to in Rule 45.*

## PAYMENT OF ANNUAL FEES FOR CONTINUANCE OF PATENT.

If a patentee intends at the expiration of the fourth year from the date of his patent to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance. Patent Rules 1892. (Second Set). Rules 4 and 5.

The Form J in the Second Schedule, duly stamped, should be used for the purpose of this payment.

## FEES.

For the fees specified in the First Schedule to The Patent Rules, 1890, shall be substituted the fees specified in the Schedule hereto. Fees.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made. Certificate of payment.

## ENLARGEMENT OF TIME.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement. Enlargement of time for payment.

50. An application for enlargement of time for leaving or accepting a Complete Specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the Comptroller may require the applicant to substantiate such allegations by such proof as the Comptroller may think necessary. Extension of time for leaving and accepting Complete Specification.

In other cases.

**51.** The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he thinks 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.

**52.** A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter, in Rules 54, 55, and 57, called "the applicant"), and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.

Advertisement.

Notice of opposition.

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

Copy for applicant.

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

Opponent's evidence.

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

Further proceedings.

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

57. Where leave to amend is given, the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31. Requirements thereon.

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

59. Every amendment of a specification shall be forthwith advertised by the Comptroller in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may direct. Advertisement of amendment.

## Compulsory Licences.

60. A petition to the Board of Trade for an order upon a patentee to grant a licence shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order. Petition for compulsory grant of licences.

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

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

63. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a Procedure.

Petitioner's evidence.

day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Patentee's evidence.

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

Evidence in reply.

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

Further proceedings.

**66.** 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.

**67.** Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request for entry of subsequent proprietorship.

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

Request to be signed.

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

Particulars to be stated in request.

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

Production of documents of title and other proof.

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

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.

Copies for Patent Office.

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

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

Body corporate.

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

Entry of Orders of the Privy Council or of the Court.

**74.** Where an order has been made by Her Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been

made by the Court for the revocation of a patent or the rectification of the Register under Section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The Register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the Register, as the case may be.

Entry of payment of fees on issue of certificate.

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

Entry of failure to pay fees.

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

Entry of licences.

**77.** An attested copy of every licence granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the Register. The licensee shall cause the accuracy of such copy to be certified as the Comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

Hours of inspection of Register.

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

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

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

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

Certified copies of documents.

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

## Power to Dispense with Evidence &c.

**80.** 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.

## Repeal.

Repeal.

**81.** All general Rules heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application then pending.

Dated the 31st day of March, 1890.

M. E. HICKS-BEACH,
*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 Acts, he shall within fourteen days from the date of the decision appealed against file in the Patent Office a notice of such his intention.

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 Officer's clerk at Room 54B, 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 Officer's 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 Officer's 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 Section 38 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 Officer's clerk under these Rules may be sent by a prepaid letter through the post.

HENRY JAMES, A.-G.

FARRER HERSCHELL, S.-G.

# FIRST SCHEDULE.

(AMENDED IN CONFORMITY WITH THE PATENT RULES, 1903.)

## 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 | | | |
| | | | | 4 | 0 | 0 |
| or | | | | | | |
| 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 appellant and by opponent respectively ... ... ... ... | | | | 1 | 0 | 0 |
| On application to amend specification:— | | | | | | |
| 7. Up to sealing. By applicant ... .. ... | | | | 1 | 10 | 0 |
| 8. After sealing. By patentee ... ... ... | | | | 3 | 0 | 0 |
| 9. On notice of opposition to amendment. By opponent | | | | 0 | 10 | 0 |
| 10. On hearing by Comptroller. By applicant and by opponent respectively ... ... ... ... | | | | 1 | 0 | 0 |
| 11. On application to amend specification during action or proceeding. By patentee ... ... ... | | | | 3 | 0 | 0 |
| 12. On application to the Board of Trade for a compulsory licence. By person applying ... ... ... | | | | 5 | 0 | 0 |
| 13. On opposition to grant of compulsory licence. By patentee ... ... ... ... ... ... | | | | 5 | 0 | 0 |
| On certificate of renewal:— | | | | | | |
| 14. Before the expiration of the fourth year from the date of the patent, and in respect of the fifth year ... ... ... ... ... ... ... | | | | 5 | 0 | 0 |

| | £ | s. | d. |
|---|---|---|---|
| 15. Before the expiration of the fifth year from the date of the patent, and in respect of the sixth year ... ... ... ... ... ... ... | 6 | 0 | 0 |
| 16. Before the expiration of the sixth year from the date of the patent, and in respect of the seventh year ... ... ... ... ... ... ... | 7 | 0 | 0 |
| 17. Before the expiration of the seventh year from the date of the patent, and in respect of the eighth year ... ... ... ... ... ... ... | 8 | 0 | 0 |
| 18. Before the expiration of the eighth year from the date of the patent, and in respect of the ninth year ... ... ... ... ... ... ... | 9 | 0 | 0 |
| 19. Before the expiration of the ninth year from the date of the patent, and in respect of the tenth year ... ... ... ... ... ... ... | 10 | 0 | 0 |
| 20. Before the expiration of the tenth year from the date of the patent, and in respect of the eleventh year ... ... ... ... ... ... .. | 11 | 0 | 0 |
| 21. Before the expiration of the eleventh year from the date of the patent, and in respect of the twelfth year ... ... ... ... ... ... ... | 12 | 0 | 0 |
| 22. Before the expiration of the twelfth year from the date of the patent, and in respect of the thirteenth year ... ... ... ... ... ... ... | 13 | 0 | 0 |
| 23. Before the expiration of the thirteenth year from the date of the patent, and in respect of the fourteenth year ... ... ... ... ... ... ... | 14 | 0 | 0 |
| On enlargement of time for payment of renewal fees:— | | | |
| 24. Not exceeding one month ... ... ... ... | 1 | 0 | 0 |
| 25. ,, two months ... ... ... ... | 3 | 0 | 0 |
| 26. ,, three months ... ... ... ... | 5 | 0 | 0 |
| 27. For every entry of an assignment, transmission, agreement, licence, or extension of patent ... | 0 | 10 | 0 |
| 28. For duplicate of letters patent ... ... ... each | 2 | 0 | 0 |

| | | £ | s. | d. |
|---|---|---|---|---|
| 29. | On notice to Comptroller of intended exhibition of a patent under Section 39 ... ... ... ... | 0 | 10 | 0 |
| 30. | Search or inspection fee ... ... ... ... each | 0 | 1 | 0 |
| 31. | For office copies ... ... ... every 100 words (but never less than one shilling) | 0 | 0 | 4 |
| 32. | For office copies of drawings, cost according to agreement. | | | |
| 33. | For certifying office copies, MSS. or printed, each | 0 | 1 | 0 |
| 34. | On request to Comptroller to correct a clerical error up to sealing | 0 | 5 | 0 |
| | after sealing | 1 | 0 | 0 |
| 35. | For certificates of Comptroller under Section 36 ... | 0 | 5 | 0 |
| 36. | For altering address in register ... ... ... ... | 0 | 5 | 0 |
| 37. | For the enlargement of time for filing Complete Specification, not exceeding one month ... ... ... | 2 | 0 | 0 |
| 38. | For enlargement of time for acceptance of Complete Specification :— | | | |
| | Not exceeding one month ... ... ... | 2 | 0 | 0 |
| | ,, two months ... ... ... | 4 | 0 | 0 |
| | ,, three months ... ... ... | 6 | 0 | 0 |

M. E. HICKS-BEACH,

*President of the Board of Trade.*

*11th July, 1892.*

Approved :—SIDNEY HERBERT,

HERBERT EUSTACE MAXWELL,

*Lords Commissioners of Her Majesty's Treasury.*

# SECOND SCHEDULE.

## FORMS.

A. Form of Application for Patent.
A1. „ „ „ communicated from abroad.
A2. „ „ „ under International and Colonial Arrangements.
B. „ Provisional Specification.
C. „ Complete „
D. „ Opposition to Grant of Patent.
E. „ Application for Hearing by Comptroller.
F. „ „ to Amend Specification or Drawings.
G. „ Opposition to Amendment of Specification or Drawings.
H. „ Application for Compulsory Grant of Licence.
H1. „ Petition for Compulsory Grant of Licences.
I. „ Opposition to Compulsory Grant of Licence.
J. „ Application for Certificate of Payment or Renewal.
K. „ Application for Enlargement of Time for Payment of Renewal Fee.
L. „ Request to Enter Name upon the Register of Patents.
M. „ Request to Enter Notification of Licence in Register.
N. „ Application for Duplicate of Letters Patent.
O. „ Notice of Intended Exhibition of Unpatented Invention.
P. „ Request for Correction of Clerical Error.
Q. „ Certificate of Comptroller-General.
R. „ Notice for Alteration of an Address in Register.
S. „ Application for Entry of Order of Privy Council in Register.
T. „ Appeal to Law Officer.
U. „ Application for Extension of Time for Leaving a Complete Specification.
V. „ Application for Extension of Time for Acceptance of a Complete Specification.

# PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1901.

[*N.B.—This Heading should appear at the top of each of the following Forms.*]

## Form A.

[*To be accompanied by two copies of Form B or of Form C.*]

APPLICATION FOR PATENT.

I (*or* We) [*here insert name and full address and calling of applicant or applicants*] do hereby declare that I am (*or* we are) in possession of an invention the title of which is [*here insert title of invention*]: that [*in the case of more than one applicant state whether all or if not who is or are the inventor or inventors*] I am (*or* we are) the true and first inventor (*or* inventors) thereof: and that the same is not in use by any other person or persons to the best of my (*or* our) knowledge and belief: and I (*or* we) humbly pray that a Patent may be granted to me (*or* us) for the said invention.

Dated the day of 190 .

[*To be signed by applicant or applicants. In the case of a firm each member of the firm must sign.*]

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

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NOTE.—Where application is made through an Agent (Rule 8), an authorisation to the following effect should be signed by the applicant or applicants:—

I (*or* We) hereby appoint of
to act as my (*or* our) Agent in respect of the accompanying application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

Dated the day of 190 .

[*To be signed by applicant or applicants.*]

*To* The Comptroller &c.

NOTE.—Where application is made without an Agent (Rule 9), a request to the following effect should accompany the application:—

I (*or* We) hereby request that all notices, requisitions, and communications in respect of the accompanying application for a Patent may be sent to me (*or* us) at .

Dated the day of 190 .

[*To be signed by applicant or applicants.*

To The Comptroller &c.

## Form A1.

[*To be accompanied by two copies of Form B or of Form C.*]

APPLICATION FOR PATENT FOR INVENTIONS COMMUNICATED FROM ABROAD.

I (*or* We) [*here insert name and full address and calling of applicant or applicants*], of . in the county of . do hereby declare that I am (*or* we are) in possession of an invention the title of which is [*here insert title of invention*], which invention has been communicated to me (*or* us) by [*here insert name, address, and calling of communicant*]; that I (or we) claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my (*or* our) knowledge and belief; and I (*or* we) humbly pray that a Patent may be granted to me (*or* us) for the said invention.

Dated the day of 190 .

[*To be signed by applicant or applicants.*]

To The Comptroller &c.

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

## Form A2.

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

I (*or* We) [*here insert name and full address and calling of applicant or of each of the applicants*] do hereby declare that I (*or* we) have made foreign applications for protection of my (*or* our)

invention of [*here insert title of invention*] in the following Foreign States and on the following official dates: viz. [*here insert the name of each Foreign State, followed by the official date of the application in each respectively*], and in the following British Possessions and on the following official dates: viz. [*here insert the name of each British Possession, followed by the official date of the application in each respectively*].

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the [*here insert the official date of the earliest foreign application*] to the best of my (or our) knowledge, information, and belief: and I (or we) humbly pray that a Patent may be granted to me (or us) for the said invention in priority to other applicants, and that such Patent shall have the date [*here insert the official date of the earliest foreign application*].

[*To be signed by applicant or applicants.*]

To The Comptroller &c.

NOTE.—In accordance with the Patents Act of 1901, the above application must be accompanied by a Complete Specification.

## Form B.

[*To be issued with Forms A and A1.*]

PROVISIONAL SPECIFICATION.

[*To be furnished in duplicate.*]

[*Here insert title as in declaration.*]

I (or We) [*here insert name and full address and calling of applicant or applicants as in declaration*] do hereby declare the nature of this invention to be as follows:—[*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 190 ."

To The Comptroller &c.

## Form C.[1]

COMPLETE SPECIFICATIONS.

[*To be furnished in duplicate, one unstamped.*]

[*Here insert title as in declaration.*]

I (*or* We) [*here insert name and full address and calling of applicant or applicants as in declaration*] do hereby declare the nature of this invention and in what manner the same is to be performed to be particularly described and ascertained in and by the following statement [*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 (*or* our) said invention, and in what manner the same is to be performed, I (*or* we) declare that what I (*or* we) claim is—

1 to 3. [*Here state distinctly the features of novelty claimed.*]

NOTE.—The introduction to this document forms 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 190 ."

*To* The Comptroller &c.

## Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

[*To be accompanied by an unstamped copy.*]

I (*or* We) [*here state name and full address*] hereby give notice of my (*or* our) intention to oppose the grant of Letters Patent upon Application No. of 190 , 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*].

[*To be signed by opponent or opponents.*]

*To* The Comptroller &c.

[1] Where Provisional Specification has been left, quote number and date:—
No. . Date .

## Form E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

[*In cases of Refusal to Accept, Opposition, or Application for Amendments, &c.*]

SIR,—I (*or* We), of [*here insert address*], hereby apply to be heard in reference to

and request that I (*or* we) may receive due notice of the day fixed for the hearing.

I am (*or* We are), Sir,

Your obedient Servant (*or* Servants),

[*To be signed by applicant or applicants.*]

*To* The Comptroller &c.

## Form F.

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

I (*or* We) [*here state name and full address of applicant or patentee*] seek leave to amend the specification of Letters Patent No. of 190 , as shown in red ink in the copy of the original specification hereunto annexed.

My (*or* Our) reasons for making this amendment are as follows:—

[*Here state reasons for seeking amendment, and where the applicant is not the patentee state what interest he possesses in the Letters Patent.*]

[*To be signed by applicant or applicants.*]

*To* The Comptroller &c.

## Form G.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

[*To be accompanied by an unstamped copy.*]

I (*or* We) [*here state name and full address of opponent or opponents*] hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. of 190 for the following reason [*here state reason of opposition*].

[*To be signed by opponent or opponents.*]

*To* The Comptroller &c.

## Form H.

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENCE.

[*To be accompanied by an unstamped copy.*]

I (*or* We) [*here state name and full address of applicant or applicants*] hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a licence to me (*or* us) by [*here state name and address of patentee, and number and date of his patent*].

[*To be signed by applicant or applicants.*]

*To* The Comptroller &c.

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. (See Form H1.)

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## Form H1.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENCES.

*To* THE LORDS OF THE COMMITTEE OF PRIVY COUNCIL FOR TRADE.

THE PETITION of [*here insert name, full address, and description*], of , in the county of , being a person interested in the matter of this petition as hereinafter described:

SHOWETH as follows:—

1. A Patent dated No. of 190 was duly granted to for an invention of [*here insert title of invention*].

2. The nature of my interest in the matter of this petition is as follows:—[*here state fully the nature of petitioner's interest*].

3. [*Here state in detail the circumstances of the case under Section 22 of the Act, and show that it arises by reason of the default of the patentee to grant licences on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.*]

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licences on reasonable terms [*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*[1]:

Your petitioner therefore prays that an Order may be made by the Board of Trade [*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*], or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

## Form I.

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENCE.

I (*or* We) [*here state name and full address*] hereby give notice of objection to the application of
for the compulsory grant of a licence under Patent No.
of 190 .

[*To be signed by opponent or opponents.*]

*To* The Comptroller &c.

## Form J.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

I (*or* We) hereby transmit the fee prescribed for the continuation in force of [*here insert name of patentee*] Patent No. of 190 for a further period of

[*Here insert name and full address.*]

*To* The Comptroller &c.

[*This part of the Form to be filled in at the Patent Office.*]

CERTIFICATE OF PAYMENT OR RENEWAL.

Letters Patent No. of 190

190

This is to certify that did this day of , 190 , make the prescribed payment of £ in respect of a period of from and that by virtue of such payment the rights of the patentee remain in force.[1]

Seal.

*Patent Office, London.*

[1] See Section 17 of The Patents, Designs, and Trade Marks Act, 1883.

## 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 190 .

The circumstances in which the payment was omitted are as follows (*see Rule 49*) :—

I am, Sir,

Your obedient Servant,

[*Here insert name and full address to which receipt is to be sent.*]

*To* The Comptroller &c.

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## Form L.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS.

I (*or* We) [*here insert name, full address, and description*] hereby request that you will enter my name (*or* our names) in the Register of Patents.

I (*or* We) claim to be entitled [*here insert the nature of the claim*] of the Patent No. of 190 , granted to [*here give name and address &c. of patentee or patentees*] for [*here insert title of the invention*], by virtue of [*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 (*or* we) transmit the accompanying [*here insert the nature of the document*], with an attested copy thereof.

[*Where any document which is a matter of record is required to be left, a certified or official copy in lieu of an attested copy must be left.*]

I am (*or* We are), Sir,

Your obedient Servant (*or* Servants),

[*To be signed by claimant or claimants.*]

*To* The Comptroller &c.

## Form M.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENCE IN THE REGISTER OF PATENTS.

SIR,—I hereby transmit an attested copy of a Licence granted to me by
under Patent No. of 190 , as well as the original Licence for verification, and I have to request that a notification thereof may be entered in the Register.

I am, Sir,

Your obedient Servant,

[*Here insert name and full address.*]

*To* The Comptroller &c.

## Form N.

APPLICATION FOR DUPLICATE OF PATENT.

[*Date*] 190 .

SIR,—I regret to have to inform you that the Letters Patent dated [*here insert date of Patent*], No. [*here insert number*], granted to [*here insert name and full address of patentee*] for an invention of [*here insert title of invention*] have been [*here insert the word* "destroyed" *or* "lost" *as the case may be*].

I beg therefore to apply for the issue of a duplicate of such Letters Patent [*here state interest possessed by applicant in the Letters Patent*].

[*To be signed by applicant.*]

*To* The Comptroller &c.

## Form O.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

I (*or* We) [*here state name and full address of applicant or applicants*] hereby give notice of my (*or* our) intention to exhibit a
of at the Exhibition,
which [*state* opened *or* is to open] on the day of
190 , under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

I (*or* We) herewith enclose [*insert brief description of invention, with drawings if necessary*].

[*To be signed by applicant or applicants.*]

*To* The Comptroller &c.

## Form P.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

SIR,—I hereby request that the following clerical error (*or* errors) in the [*here state whether in Application, Specification, or Register*] No. of 190 may be corrected in the manner shown in red ink in the certified copy of the original [*Application, Specification, or Register*] hereunto annexed.

[*Here insert name and full address.*]

*To* The Comptroller &c.

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## Form Q.

CERTIFICATE OF COMPTROLLER-GENERAL.

Patent Office, London, 190 .

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that &c.

*To* [*name and full address of person requiring the information*].

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## Form R.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

SIR,—I (*or* We) [*here state name or names and full address of applicant or applicants*] hereby request that address now upon the Register may be altered as follows:—[*Here insert full address.*]

I am (*or* We are), Sir,

Your obedient Servant (*or* Servants),

[*To be signed by applicant or applicants.*]

*To* The Comptroller &c.

## Form S.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

I (*or* We) [*here state name and full address of applicant or applicants*] hereby transmit an office copy of an Order in Council with reference to [*here state the purport of the Order*].

I am (*or* We are), Sir,

Your obedient Servant (*or* Servants),

[*To be signed by applicant or applicants.*]

*To* The Comptroller &c.

## Form T.

FORM OF APPEAL TO LAW OFFICER.

I (*or* We) [*here insert name and full address of appellant or appellants*] hereby give notice of my (*or* our) intention to appeal to the Law Officer from [*here insert* the decision *or* that part of the decision *as the case may be*] of the Comptroller of the day of , 190 , whereby he [*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*] No. [*here insert number*] of the year 190 .

[*To be signed by appellant or appellants.*]

Dated the day of , 190 .

NOTE.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of the same to the Law Officer's Clerk at Room 549, Royal Courts of Justice, London.

## Form U.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR LEAVING A COMPLETE SPECIFICATION.

SIR,—I (*or* We) hereby apply for extension of time for one month in which to leave a Complete Specification upon application.

No. . Dated 190 .

The circumstances in and grounds upon which this extension is applied for are as follows. (See Rule 50.)

I am [*or* We are], Sir.

Your obedient Servant.

[*To be signed by applicant or applicants or his or their agent.*]

*To* The Comptroller &c.

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## Form V.

Form of Application for Extension of Time for Acceptance of a Complete Specification.

Sir,—I (*or* We) hereby apply for an extension of time for month for the acceptance of the Complete Specification upon application No. , dated .

The circumstances in and grounds upon which this extension is applied for are as follows. (See Rule 50.)

I am [*or* We are], Sir.

Your obedient Servant.

[*To be signed by applicant or applicants or his or their agent.*]

*To* The Comptroller &c.

M. E. HICKS-BEACH,

*President of the Board of Trade.*

*31st March, 1890.*

# APPENDIX H.

## DESIGNS RULES, 1890, 1893, & 1898 (Consolidated).

**NOTE.** THE RULES REPEALED ARE PRINTED IN ITALICS. THE SUBSTITUTED MATTER FROM THE RULES OF 1893 AND 1898 IS IN HEAVIER TYPE.

BY VIRTUE of the provisions of The Patents, Designs, and Trades Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

### PRELIMINARY.

Citation of Rules.

**1.** These Rules may be cited as The Designs Rules, 1890, and shall come into operation from and immediately after the 31st day of March, 1890.

*Note.*—The Designs Rules of 1893 are cited as such, and came into operation from the 30th November, 1893; those of 1898 came into operation on the 15th September, 1898.

### INTERPRETATION.

Interpretation.

**2.** In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

### FEES.

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.

Repealed.

[*4. An application for the registration of a design shall be made in the Form E or Form O in the Second Schedule hereto. The remaining Forms in such Schedule may be used in all cases to which they are applicable.*]

Forms. Designs Rules, 1893.

4. An application for the registration of a design for articles not being lace shall be made in the Form E or Form O in the Second Schedule hereto. An application for one design to be applied to lace shall be made in the Form E1 in the Second Schedule hereto, and for one design to be applied to a set of lace articles shall be made in the Form O1 in the Second Schedule hereto. A request for registration of the name of any subsequent proprietor of a lace design or set of lace designs shall be made in the Form K1 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 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.]*

Designs Rules, 1898.

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, but the Comptroller shall not be bound to recognise as such agent, or to receive further communication from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of The Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

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.

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.

**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.

Nature of design.

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.

Certificate of registration.

**10.** If the Comptroller determines to register a design, he shall as soon as may be send to the applicant a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office.

Applications may be sent by post.

**11.** Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller or to any other person under these Rules may be sent by a prepaid letter through the post,

and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

EXERCISE OF DISCRETIONARY POWERS.

Hearing by Comptroller.

**12.** Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for registration of a design the Comptroller shall (if so required by the applicant within one month from the date of the Comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

Hearing by Comptroller.

**13.** 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.

**14.** 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.

**15.** Where the Comptroller refuses to register a design, and the applicant intends to appeal to the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office (Designs Branch) a notice of such his intention.

Statement on appeal.

**16.** 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.

**17.** The applicant shall forthwith, on leaving such notice, send a copy thereof to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London.

Directions by Board of Trade.

**18.** The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal for the Board of Trade.

Notice of time of hearing.

**19.** Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal, shall be given to the Comptroller and the applicant.

## Register of Designs.

Registering designs.

**20.** Upon the sealing of a certificate of registration the Comptroller shall cause to be entered in the Register of Designs the name, address, and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller, which day shall be deemed to be the date of the registration.

Subsequent proprietors.

**21.** Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design either exclusively or otherwise, a request 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).

Signature to request.

**22.** Every such request shall, in the case of an individual, be made and signed by the person requiring to be registered as proprietor; and in the case of a firm or partnership, by some one or more members of such firm or partnership, or, in either case, by his or their agent respectively, duly authorised to the satisfaction of the Comptroller; and in the case of a body corporate, by their agent, authorised in like manner.

Particulars in request.

**23.** Every such request shall state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law by virtue of which the request is made, so as to show the manner in

which and the person or persons to whom the design has been assigned or transmitted, or the person or persons who has or have acquired such right as aforesaid, as the case may be.

Statutory declaration with request.

**24.** Every such request shall be accompanied by a statutory declaration, to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the design or the right to apply the same, as the case may be, as claimed by such request.

Proof of title if required.

**25.** The claimant shall furnish to the Comptroller such other proof of title as he may require for his satisfaction.

Corporate name.

**26.** A body corporate may be registered as proprietor by its corporate name.

Notice to Comptroller of application to rectify Register.

**27.** Four clear days' notice of every application to the Court under Section 90 of The Patents, Designs, and Trade Marks Acts, 1883 to 1888, for rectification of the Register of Designs, shall be given to the Comptroller.

Notice of order of Court.

**28.** Where an order has been made by the Court, under Section 90 of the said Acts, 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.

## Power to Dispense with Evidence.

Comptroller's discretion as to 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 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.

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 marks.

*[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" 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 "RD."]*

Registration mark.

Designs Rules, 1893.

**32. Before 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 Class 13 or Class 14 in the Third Schedule hereto,**

cause each such article to be marked with the abbreviation "Regd.," and shall, if such article is included in any of the Classes 1 to 12 in the Third Schedule hereto, cause each such article to be marked with the abbreviation "Rd.," and also, in the case of articles other than lace, with the number appearing on the certificate of registration.

### 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.

### 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.

### Searches on Production of Sketch or Design.

Search.

**35.** The Comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the Patent Office, and inform any person requesting him so to do whether a particular design produced by such person, and to be applied to goods in any particular class, is or is not identical with or an obvious imitation of any registered design applied to such goods of which the copyright is still existing.

## 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.

## Repeal.

Repeal of previous Rules.

**37.** All general Rules as to the registration of designs heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, 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.

M. E. HICKS-BEACH,
*President of the Board of Trade.*

*31st March, 1890.*

# SCHEDULES.

## FIRST SCHEDULE.

(Amended in conformity with The Designs Rules, 1883.)

FEES.

| | £ | s. | d |
|---|---|---|---|
| 1. On application to register one design to be applied to single articles in each class, not being lace, and except articles in Classes 13 and 14 ... ... ... | 0 | 10 | 0 |
| 2. On application to register one design to be applied to lace or 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, not being lace, for each class of registration ... ... ... ... ... ... | 1 | 0 | 0 |
| 3a. On application to register one design to be applied to a set of lace articles ... ... ... ... ... | 0 | 2 | 0 |
| 4. On notice of appeal to Board of Trade against refusal of Comptroller to register ... ... ... ... | 1 | 0 | 0 |
| 5. Copy of certificate of registration, each copy ... ... | 0 | 1 | 0 |
| 6. On request for Certificate of Comptroller for legal proceedings or other special purpose ... ... | 0 | 5 | 0 |
| 7. On request to enter name of subsequent proprietor ... | *same as registration fee.* | | |
| 8. On notice to Comptroller of intended exhibition of an unregistered design ... ... ... ... ... | 0 | 5 | 0 |
| 9. Inspection of design in any case in which inspection is permitted by The Patents, Designs, and Trade Marks Acts, 1883 to 1888, and the Designs Rules thereunder, for each quarter of an hour ... ... ... | 0 | 1 | 0 |

| | | | |
|---|---|---|---|
| 10. Copy of one such design ... ... ... | ( Cost according to agreement. | | |
| | £ | s. | d |
| 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 1s.) | 0 | 0 | 4 |
| 15. For certifying office copies, MSS. or printed | 0 | 1 | 0 |

NOTE.—The term "set" to include any number of articles ordinarily on sale together, irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article.

M. E. HICKS-BEACH.

*President of the Board of Trade.*

*Approved*:—R. E. WELBY.

For the Lords Commissioners of Her Majesty's Treasury.

*31st March, 1890.*

# SECOND SCHEDULE.

(Amended in conformity with The Designs Rules, 1903.)

## Forms.

Form of Application to Register.

.. Appeal to Board of Trade.

.. Certificate of Registration.

.. Application for Copy of Certificate of Registration.

.. Request for Certificate for use in Legal Proceedings.

.. Certificate for use in Legal Proceedings.

.. Request to enter Name of Subsequent Proprietor.

.. Notice of intended Exhibition of Unregistered Design.

.. Request for Correction of Clerical Error or for entry of New Address.

.. Request for Search under Section 53.

.. Application to Register for a set of Articles.

.. Application for Registration of a Lace Design in Class 9.

.. Application for Registration of a Lace Design to be applied to a set.

.. Request to enter Name of Subsequent Proprietor of a Lace Design or set of Lace Designs.

# PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 to 1888.

[N.B.—THE ABOVE HEADING SHOULD APPEAR AT THE TOP OF EACH OF THE FOLLOWING FORMS.]

## Form E.

APPLICATION FOR REGISTRATION OF DESIGN IN CLASS .

You are hereby requested to register the accompanying Design in Class , in the name of *here insert legibly the name, address, and description of the individual or firm*, who claims to be the proprietor thereof, and to return the same to

Statement of nature of design *such as whether it is applicable for the pattern or for the shape*.

(Signed)

*To be signed by the applicant.*

Dated the day of 18 .

To The Comptroller &c.

## 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 [*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*] for the decision of the Board of Trade.

I am, Sir,

Your obedient Servant.

To The Comptroller &c.

## Form G.

CERTIFICATE OF REGISTRATION OF DESIGN.

(Registered 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 , 190 , in pursuance of The Patents, Designs, and Trade Marks Acts, 1883 to 1888, in respect of the application of such Design to articles in Class . for which a copyright of five years is granted.

## 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 , 190 .

*To* The Comptroller &c.

## Form I.

REQUEST FOR CERTIFICATE FOR USE IN LEGAL PROCEEDINGS.

SIR,—I hereby request you to send me for the purpose of use in the suit of [*here state the title of the legal proceeding or the other purpose for which the Certificate is required*] a Certificate that the design of which a copy is herein enclosed was [*here state the entry, matter, or thing which the writer wishes certified*].

(Signed)

Dated the day of , 190 .

*To* The Comptroller &c.

## 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 &c.

Witness my hand and seal this day of . 190 .

*Comptroller.*

Patent Office &c.

## Form K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF DESIGN, WITH DECLARATION IN SUPPORT THEREOF.

I [*here insert name, full address, and description*] hereby request that you will enter my name in the Register of Designs as Proprietor of the Design No. in Class .

I am entitled as to the said Design [*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 . 190 . made between so-and-so of the one part"*].

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said Design as above claimed.

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of The Statutory Declarations Act, 1835. [*This paragraph is not required when the declaration is made out of the United Kingdom*].

[*To be signed here by the person making the declaration.*]

Declared at this day of . 190 .
before me [*signature and title of the authority before whom the declaration is made*].

To The Comptroller &c.

## Form L.

NOTICE OF INTENDED EXHIBITION OF AN UNREGISTERED DESIGN.

I [*here state name and address of applicant*] hereby give notice of my intention to exhibit a

of at the

Exhibition, which [*state "opened" or "is to open"*] on . 19 . under the provisions of The Patents, Designs, and Trade Marks Acts of 1883 to 1888 [*insert brief description of Design, with drawing*], and I hereby enclose a

(Signed)

Dated the day of 190 .

*To* The Comptroller &c.

## Form M.

REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR ENTRY OF NEW ADDRESS.

SIR,—I hereby request that [*state particulars*].

(Signed)

Dated the day of . 190 .

*To* The Comptroller &c.

## Form N.

REQUEST FOR SEARCH UNDER SECTION 58.

SIR,—I hereby request that a search may be made in Class [*state object of search*].

(Signed)

Dated the day of . 190 .

*To* The Comptroller &c.

## Form O.

APPLICATION FOR REGISTRATION OF DESIGN TO BE APPLIED TO A SET.

You are hereby requested to register the accompanying Design for [*here set out the trade description of the articles in the set, as "a toilet set"*], being a set of articles in Class in the

name of *here insert legibly the name, address, and description of the individual or firm*], who claims to be the proprietor thereof, and to return the same to

Statement of nature of Design [*such as whether it is applicable for the pattern or for the shape*].

[*To be signed by the applicant.*]

Dated the day of , 190 .

*To* The Comptroller &c.

## Form E1.

Application for Registration of a Lace Design in Class 9.

You are hereby requested to register, without search, the accompanying Design in Class 9 in the name of [*here insert legibly the name, address, and description of the individual or firm*], who claims to be the proprietor thereof, and to return the same to .

The nature of the Design is the pattern.

Signed [*to be signed by the applicant or his agent duly authorised. When signed by an agent there should be added to the signature "Agent duly authorised by authorisation dated the day of , 190 "*].

Dated the day of , 190 .

*To* The Comptroller &c.

## Form O1.

Application for Registration of a Lace Design to be Applied to a Set.

You are hereby required to register, without search, the accompanying Design for a Set of Lace Articles in Class 9 in the name of [*here insert legibly the name, address, and description of the individual or firm*], who claims to be the proprietor thereof, and to return the same to .

The nature of the Design is the pattern.

Signed [*to be signed by the applicant or his agent duly authorised. When signed by an agent, there should be added to the signature "Agent duly authorised by authorisation dated the day of , 190 "*].

Dated the day of , 190 .

*To* The Comptroller &c.

## Form K1.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF A LACE DESIGN OR SET OF LACE DESIGNS.

The Comptroller is requested to enter the name of [*here insert legibly the name, address, and description of the individual or firm*], in respect of the proprietorship of the Registered Lace Design [or Set of Lace Designs] No. in Class 9 in place of the name of at present appearing in the Register.

[*To be signed by the registered proprietor and by the assignee*].

Dated the day of . 190 .

To The Comptroller &c.

# THIRD SCHEDULE.

CLASSIFICATION OF ARTICLES OF MANUFACTURE AND SUBSTANCES.

Classes

1. Articles composed wholly or chiefly of metal, not included in Class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, papier mâché, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware, or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including book-binding, of all materials.
7. Paper-hangings.
8. Carpets and rugs in all materials, floorcloths, and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework on muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece goods.
14. Printed or woven designs on handkerchiefs and shawls.

M. E. HICKS-BEACH.
*President of the Board of Trade.*

*31st March, 1880.*

# APPENDIX I.

# TRADE MARKS RULES, 1890, 1897, AND 1898

## (CONSOLIDATED).

**NOTE.** THE RULES REPEALED ARE PRINTED IN ITALICS. THE SUBSTITUTED RULES OF 1897 AND 1898 ARE IN HEAVIER TYPE.

BY VIRTUE of the provisions of The Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

### Preliminary.

Citation of Rules.

**1.** These Rules may be cited as "The Trade Marks Rules, 1890," and shall come into operation from and immediately after the 31st day of December, 1890.

*Notes.* The Rules of 1897 and 1898 came into operation respectively on the 31st of December, 1897, and the 15th September, 1898.

### Interpretation.

Interpretation.

**2.** In the construction of these Rules any words to which used defined by the said Acts shall have the meanings thereby assigned to them respectively.

### Fees.

Fees.

**3.** The fees to be paid in pursuance of the said Acts, so far as they relate to trade marks, shall be the fees specified in the First Schedule hereto.

### Forms.

Forms.

**4.** The Form F in the First Schedule to The Patents, Designs, and Trade Marks Act, 1883, shall be altered or amended by the substitution therefor of the Form F in the Second Schedule to these Rules.

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.

## Classification of Goods.

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.

If any doubt arises as to what class any particular description of goods belongs, the doubt shall be determined by the Comptroller.

## Application for Registration.

Application by firm.

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.

If the application be made by a body corporate, it may be signed by the secretary or other principal officer of such body corporate.

Address of application.

8. Where a trade mark for registration of which application is made is in Classes 23, 24, or 25 of the Third Schedule to these Rules, the applicant shall address and send his application to the Manchester Trades Marks Branch, 48 Royal Exchange, Manchester. Other applications (except applications which under Section 81 of the said Acts should be made to the Cutlers' Company) shall be addressed and sent to the Patent Office, Trade Marks Branch, 25 Southampton Buildings, Chancery Lane, London, W.C.

Agency.

9. *An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.*

Trade Marks Rules, 1898.

9. An application for registration and all other communications between the applicant and the

Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, but the Comptroller shall not be bound to recognise as such agent, or to receive further communications from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of The Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

Acknowledgment of application.

**10.** On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

**11.** Where application is made to register a trade mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in respect of the goods mentioned in the application.

Size &c. of documents.

**12.** Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed, or other documents required by the said Acts or by these Rules to be left with or sent to the Comptroller or to the Cutlers' Company shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Representations of trade mark. *Repealed.*

**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 Trade Marks.

13. Every application for registration of a Trade Mark shall contain a representation of the mark affixed to it in the square which the Form F contains for that purpose.

Trade Marks Rules, 1897.

Where the representation exceeds such square in size the representation shall be mounted upon linen, tracing cloth, or other material that the Comptroller may consider suitable. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded over.

With every application for registration sent to the Manchester Trade Marks Branch there shall be supplied four additional representations of each mark on the Form G, exactly corresponding with that on the Application Form F, and noted with all such particulars as may from time to time be required by the Comptroller or by the Keeper of Cotton Marks at Manchester. Such particulars shall, if required, be signed by the applicant or his agent.

In the case of marks applied for in any of the Classes 5, 6, 7, 11, 12, 13, 14, 22, 26, 27, 28, 29, 30,

31, 32, 33, 34, and 35, there shall be sent with the application four additional representations of each mark on the Form G, exactly corresponding with that affixed to the application in Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

In the case of marks applied for in any other class there shall be sent with the appiication three additional representations of each mark on the Form G, exactly corresponding to that affixed to the Application Form F, and noted with all such particulars as may from time to time be required by the Comptroller. Such particulars shall, if required, be signed by the applicant or his agent.

All representations of marks must be of a durable nature, but the applicant may in case of need supply in place of representations on the Form G half sheets of strong foolscap of the size aforesaid with the representations affixed thereon and noted as aforesaid.

Applications for the registration of the same mark in different classes shall be treated as separate and distinct applications.

The Comptroller, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to him to be substituted before proceeding with the application.

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 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.

Representation of a series of trade marks. *Repealed.*

**14.** *When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in Section 64 of the said Acts, a representation of each trade mark of the series shall be made or affixed upon the form of application, and also upon each of the separate half-sheets of paper aforesaid.*

Trade Marks Rules, 1897.

14. When application is made for the registration of a series of trade marks under Section 66 of The Patents, Designs, and Trade Marks Act, 1883, a representation of each trade mark of the series shall be affixed, as aforesaid, to the application upon Form F, and to each of the accompanying Forms G.

Translation of foreign characters. *Repealed.*

**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.*

Trade Marks Rules, 1897.

15. When a trade mark contains a word or words in other than Roman characters, there shall be endorsed on the application in Form F, and on each of the accompanying representations in Form G, a sufficient transliteration and translation to the satisfaction of the Comptroller of each of such words, and every such endorsement shall be signed by the applicant or his agent.

Where a trade mark contains a word or words in a language other than English, the Comptroller may ask for an exact translation thereof, and if he so requires such translation shall be endorsed and signed as aforesaid.

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 Acts adversely to the applicant for registration of a trade mark, the Comptroller shall (if so required by the applicant within one month from the date of the Comptroller's objection) give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

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.

APPEAL TO THE BOARD OF TRADE.

Notice of appeal.

**20.** When any person intends to appeal to the Board of Trade from a decision of the Comptroller in any case in which an appeal is given by the said Acts, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade Marks Branch, a notice of such his intention.

Grounds of appeal to be stated.

**21.** Such notice shall be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

Transmission of notice.

**22.** A copy of the notice of intention to appeal, accompanied by a statement of the case, shall also be forthwith sent to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London; and where there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

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.

Hearing of appeal.

**24.** Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and to the appellant, and where there has been an opposition before the Comptroller to the opponent or applicant as the case may be.

No appeal unless notice duly given.

**25.** No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

Evidence on appeal.

**26.** Subject to the directions and leave of the Board of Trade, the evidence to be used on an appeal to the Board of Trade in the matter of an opposition shall be the same as that used at the hearing before the Comptroller.

ADVERTISEMENT OF APPLICATION.

Advertisement of application.

**27.** Every application shall be advertised by the Comptroller in the official paper during such times and in such manner as the Comptroller may direct, unless he refuse to entertain the application.

If no representation of the trade mark be inserted in the official paper in connection with the advertisement of an application the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade mark is deposited for exhibition.

Definition of official paper.

**28.** The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Means of advertising trade mark to be supplied to official paper.

**29.** For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent may require a fresh block or electrotype before proceeding with the advertisement.

Advertisement of series.

**30.** When an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in Section 64 of the said Acts, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; and the Comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

## Opposition to Registration.

Notice of opposition.

**31.** (1) A notice of opposition to the registration of a trade mark shall state the ground or grounds on which the opponent intends to oppose the registration, and be signed by him or by his solicitor, and shall also contain an address for service in the United Kingdom, and shall be in the Form J in the Second Schedule to these Rules, with such variations as circumstances may require.

Opposition on the ground of trade mark already on the Register.

(2) Where the ground or one of the grounds of opposition is that the applicant is applying for the registration of a trade mark identical with one already on the Register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the notice shall state the date of registration, and the number on the Register of such trade mark already on the Register.

Opponent's evidence.

(3) Within two months after the expiration of one month or such further time not exceeding three months as the Comptroller may allow from the date of the advertisement of the application the opponent shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.

Applicant's evidence.

(4) [1] Within one month from the delivery of the opponent's copies of his statutory declarations the applicant shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in answer, and deliver to the opponent copies thereof, and within seven days from such delivery, the opponent shall leave at the Patent Office, Trade Marks Branch, his evidence by way of statutory declaration in reply, and deliver to the applicant copies thereof. Such last-mentioned evidence shall be confined to matters strictly in reply.

Evidence in reply.

Closing of evidence.

(5) No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller given on an application made to him.

Applications for leave to adduce further evidence.

(6) Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Appointment of time for hearing.

(7) On the completion of the evidence the Comptroller shall, upon application by either party, upon Form E in the Second Schedule to these Rules, and upon payment of the prescribed fee, appoint a time for the hearing of the case, and shall give the parties at least seven days' notice of such appointment.

Disallowance of opposition in certain cases.

(8) On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice

[1] The counter-statement required by the Acts must also be delivered by the applicant within one month from the date of the receipt of the opponent's notice of opposition (Section 69, Subsection 2).

of opposition, and where the ground or one of the grounds of opposition is that registration is being applied for in respect of a trade mark identical with one already on the Register with respect to the same goods or description of goods, or having such resemblance to a trade mark already on the Register with respect to such goods or description of goods as to be calculated to deceive, the opposition shall not be allowed upon such ground, unless the date of registration and the number on the Register of the said trade mark already on the Register have been duly specified in the notice of opposition.

Decision to be notified to parties.

(9) The decision of the Comptroller in the case shall be notified to the parties.

REGISTER OF TRADE MARKS.

Time of registration of trade marks.

**32.** As soon as may be after the expiration of one month from the date of the advertisement of the application, the Comptroller shall, subject to opposition to the application and the determination thereof, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, 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.

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

**33.** In case of the death of any applicant for a trade mark after the date of his application, and before the trade mark applied for has been entered on the Register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the Register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

Entries to be made in Register.

**34.** Upon registering any trade mark the Comptroller shall enter in the Register the date on which the application for registration was received by the Comptroller, and such other particulars as he may think necessary.

Notice of registration.

**35.** The Comptroller shall send notice to the applicant of the registration of his trade mark, together with a reference to the advertisement of such trade mark in the official paper.

Request by and notice to proprietor.

**36.** Where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, a request for the entry of his name in the Register as proprietor of the trade mark shall be addressed to the Comptroller, and left at the Patent Office, Trade Marks Branch.

Signature of request.

**37.** Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively, duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised in like manner.

Contents of request.

**38.** Every such request shall state the name, address, and description of the person claiming to be entitled to the trade mark (hereinafter called "the claimant"), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the Register as proprietor, so as to show the manner in which, and the person or persons to whom, the trade mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which the trade mark has been registered.

Declaration to accompany request.

**39.** Every such request shall be accompanied by a statutory declaration, to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade mark as claimed by such request.

Further proof of title if required.

**40.** The claimant shall furnish to the Comptroller such other proof of title and the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction.

Body corporate.

**41.** A body corporate may be registered as proprietor by its corporate name.

Definition of applicant.

**42.** The term "applicant" in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade mark.

Comptroller may require statement from rival claimants.

**43.** Whether all such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by Section 71 of the said Acts, require such persons, or any or either of them, to submit a statement in writing within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Submission to Court of contesting claims.

**44.** Where each of several persons claims to be registered as proprietor of the same trade mark, and the Comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the Comptroller, or, if the Comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

Settlement of special case.

**45.** Where the special case is to be submitted by the parties it may be agreed to by them, or, if they differ, may be settled by the Comptroller on payment of the prescribed fees.

Order of Court.

**46.** 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 Acts;

(*b*) Disallowing an opposition to registration under Section 69; or

(*c*) Under the provisions of Sections 72, 90, or 92 of the said Acts,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office, Trade Marks Branch, an office copy of such order. The Register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the Register, as the case may be.

Removal of mark from Register.

**47.** Where a trade mark has been removed from the Register for nonpayment of the prescribed fee or otherwise, under the provisions of Section 79 of the said Acts, the Comptroller shall cause to be entered in the Register a record of such removal and the cause thereof.

Alteration of address in Register.

**48.** If the registered proprietor of a trade mark send to the Comptroller, together with the prescribed fee, notice of an alteration in his address, the Comptroller shall alter the Register accordingly.

Notice to Comptroller of applications to rectify Register.

**49.** Four clear days' notice of every application to the Court under Section 90 of the said Acts, for rectification of the Register, shall be given to the Comptroller.

Publication of rectification or variation of Register.

**50.** Whenever an order is made by the Court for making, expunging, or varying an entry from or in the Register, the Comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the Register.

Notice to Comptroller of Order of Court for alteration of trade mark under Section 92 of Acts.

**51.** Whenever the registered proprietor of any trade mark intends to apply for the leave of the Court to add to or to alter such trade mark, under Section 92 of the said Acts, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If

leave be granted on such application, the applicant shall forthwith supply to the Comptroller such a number of representations of the trade mark, as altered, as he may deem sufficient.

INSPECTION OF REGISTER.

Hours of inspection.

**52.** The Register of Trade Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week-day, between the hours of ten and four, except on the days and at the times following:—

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

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

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

POWER TO DISPENSE WITH EVIDENCE.

Dispensing with evidence.

**53.** Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

## Amendments.

Amendment of documents.

**54.** Any document or drawing or other representation of a trade mark for the amending of which no special provision is made by the said Acts 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.

## Enlargement of Time.

Comptroller may enlarge time.

**55.** The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

## Cutlers' Company.

Sheffield applications duplicate.

**56.** All applications to the Cutlers' Company for registration of a trade mark, under Section 81 of the said Acts, shall be in duplicate, accompanied by the prescribed fees and representations.

Notice to Comptroller.

**57.** The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Time within which Comptroller may object to application made at Sheffield.

**58.** (1) The time within which the Comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for 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.

Advertisement of application made at Sheffield.

(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 Acts shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

Similarity of proceedings at London and Sheffield.

**59.** The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

## CERTIFICATES.

Certificate by Comptroller.

**60.** The Comptroller, when required to give a certificate as to any entry, matter, or thing which he is authorised by the said Acts or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, but every certificate of registration shall have specified on the face thereof whether the same is to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country, or for purposes other than use in legal proceedings or obtaining registration in a foreign country.

## DECLARATIONS.

Manner in which, and persons before whom, declaration is to be taken.

**61.** The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

(*a*) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(*b*) In any other part of Her Majesty's dominions, before any Court, Judge, Justice of the Peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a Notary Public, or before a Judge or Magistrate.

Notice of seal of officer taking declaration to prove itself.

**62.** Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made 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.

REPEAL.

Previous Rules repealed.

**63.** All general Rules as to the registration of trade marks heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of December, 1889, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application pending at the said date.

M. E. HICKS-BEACH,

*President of the Board of Trade.*

# 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. For registration of a trade mark for one or more articles in one class ... ... ... ... ... | 1 | 0 | 0 |
| 3. For registering a series of trade marks, for every additional representation after the first in each class | 0 | 5 | 0 |
| 4. On appeal from Comptroller to Board of Trade— | | | |
| by appellant ... ... ... ... ... ... | 1 | 0 | 0 |
| 5. On notice of opposition for each application opposed — | | | |
| by opponent ... ... ... ... ... ... | 1 | 0 | 0 |
| 6. On hearing by Comptroller — by applicant and by opponent respectively ... ... ... ... ... | 1 | 0 | 0 |
| 7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark | 1 | 0 | 0 |
| 8. For every additional mark assigned or transmitted at the same time ... ... ... ... ... | 0 | 2 | 0 |
| 9. For continuance of mark at expiration of 14 years ... | 1 | 0 | 0 |
| 10. Additional fee where fee is paid within three months after expiration of 14 years ... ... ... ... | 0 | 10 | 0 |
| 11. Additional fee for registration of trade mark where removed for nonpayment of fee ... ... ... | 1 | 0 | 0 |
| 12. For altering address on the Register, for every mark... | 0 | 5 | 0 |
| 13. For every entry in the Register of a rectification thereof or an alteration therein, not otherwise charged ... ... ... ... ... ... ... | 0 | 10 | 0 |
| 14. For cancelling the entry or part of the entry of a trade mark upon the Register, on the application of the owner of such trade mark ... ... ... | 0 | 5 | 0 |
| 15. On request to Comptroller to correct a clerical error, or permit amendment of application under Section 91 ... ... ... ... ... ... | 0 | 5 | 0 |

| | £ | s. | d. |
|---|---|---|---|
| 16. For certificate of refusal to register a trade mark under Section 77 ... ... ... ... ... | 1 | 0 | 0 |
| 17. For certificate of refusal at the same time for more than one trade mark, for each additional trade mark after the first ... ... ... ... ... | 0 | 10 | 0 |
| 18. For certificate of registration to be used in legal proceedings ... ... ... ... ... ... | 1 | 0 | 0 |
| 19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries ... ... ... ... ... ... | 0 | 5 | 0 |
| 20. For certificate of Comptroller under Section 96, other than certificate of registration to be used in legal proceedings, or for the purpose of obtaining registration in a foreign country ... ... ... | 0 | 5 | 0 |
| 21. For copy of notification of registration ... ... ... | 0 | 2 | 0 |
| 22. Stating a special case by Comptroller ... ... ... | 2 | 0 | 0 |
| 23. For inspecting Register, for every quarter of an hour | 0 | 1 | 0 |
| 24. For making a search amongst the classified representations of trade marks, for every quarter of an hour ... ... ... ... ... ... | 0 | 1 | 0 |
| 25. For office copy of documents, for every 100 words (but never less than one shilling) | 0 | 0 | 4 |
| 26. For certifying office copies, MS. or printed ... ... | 0 | 1 | 0 |
| 27. In cases where the wood block or electrotype of the trade mark exceeds two inches in breadth or depth, or in breadth and depth—For every inch or part of an inch over two inches in breadth ... | 0 | 2 | 0 |
| For every inch or part of an inch over two inches in depth... ... ... ... ... ... ... | 0 | 2 | 0 |
| 28. Manchester Trade Marks Office ... ... ... ... | 0 | 2 | 0 |
| 29. Sheffield Marks ... ... ... ... ... ... | 0 | 2 | 0 |
| 30. On appeal from Cutlers' Company, Sheffield, to Comptroller ... ... ... ... ... ... | 1 | 0 | 0 |

M. E. HICKS-BEACH.

*President of the Board of Trade.*

*Approved:* FRANK MOWATT.

*Assistant Secretary for the Lords Commissioners of Her Majesty's Treasury.*

# SECOND SCHEDULE.

## FORMS.

Form of Application for Hearing by Comptroller.

" Application for Registration.

" Additional Representation of Trade Mark.

" Appeal to Board of Trade.

" Transmission of Registration Fee.

" Notice of Opposition.

" Request to Enter Name of Subsequent Proprietor of Trade Mark.

" Request for Certificate of Refusal.

" Notice of Application for Alteration of Address.

" Notice of Order of Court for Rectification of Register.

" Application to Cancel Entry on Register.

" Declaration in Support of Application to Cancel Entry.

" Request to Comptroller for Correction of Clerical Error, or for Permission to Amend Application under Section 91.

" Request for Certificate of Registration for Use in Obtaining Registration Abroad.

" Request for Certificate of Registration for Use in Legal Proceedings.

" Application for Settlement of a Special Case.

" Request for General Certificate of Comptroller

" General Certificate of Comptroller.

" Request for Copy of Notification of Registration.

" Appeal from Cutlers' Company.

" Application for Continuance on Register.

" Transmission of Additional Fee.

" Application for Restoration to Register.

" Application for Registration of Old Corporate Trade Mark.

# PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

NOTE.—THIS HEADING SHOULD APPEAR AT THE TOP OF EACH OF THE FOLLOWING FORMS.

## Form E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

*(In Cases of Opposition &c.)*

SIR,—I [*here insert name*], of [*here insert address*], hereby apply to be heard in reference to , and request that I may receive due notice of the day fixed for the hearing.

I am, Sir,

Your obedient Servant,

[*Signature of applicant.*]

Dated the day of 19 .

*To* The Comptroller.
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London.

## Form F.

APPLICATION FOR REGISTRATION OF TRADE MARK.

One representation to be fixed within this square, and two others to be sent on separate half-sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

You are hereby requested to register the accompanying Trade Mark in Class in respect of [*only goods contained in one and*

*the same class should be set out here; a separate application form is required for each separate class*] in the name of [*here insert legibly the full name, address, and description of the individual, firm, or company; add trading style, if any*], who claims to be the proprietor thereof. [*Alter to* who claim to be the proprietors thereof *in the case of a firm or company.*]

(The essential particulars of the Trade Mark are the following:—[*see Sub-sections 2 and 3 of Section 64 of the Acts*], and I (*or* we) disclaim any right to the exclusive use of the added matter.)

[*Signature of applicant or agent duly authorised.*]

Dated the day of , 19 .

*To* The Comptroller,
Patent Office, Trade Marks Branch,
25 Southampton Buildings, London;

*Or*, Where the application is for a Mark in Classes 23, 24, or 25,

*To* The Comptroller,
Manchester Trade Marks Branch,
48 Royal Exchange, Manchester.

NOTE.—If the Trade Mark has been in use in respect of the goods since before 13th August, 1875, state length of such user.

## Form G.

ADDITIONAL REPRESENTATION OF TRADE MARK, TO ACCOMPANY APPLICATION FOR REGISTRATION.

One representation of the Trade Mark to be affixed within this square.

It must correspond EXACTLY, in all respects, with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto.

Two of these additional representations of the Trade Mark must accompany *each* Form of Application.

In the case of a Trade Mark claimed in one of the Classes 23 to 35, four of these additional representations of the Mark must accompany the Form of Application.

## Form H.

FORM OF APPEAL FROM THE COMPTROLLER TO THE BOARD OF TRADE.

I [*here insert full name and address of appellant*] hereby give notice of my intention to appeal to the Board of Trade from [*here insert* the decision *or* that part of the decision *as the case may be*] of the Comptroller of the day of , 19 . whereby he [*here insert the decision complained of*].

Accompanying this notice is a statement of my case for the decision of the Board of Trade.

[*Signature of appellant.*]

Dated the day of , 19 .

*To* The Comptroller &c.

And to [*Name of Respondent to Appeal*].

## 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,

[*Signature of applicant.*]

*To* The Comptroller &c.

## 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

I [*here state full name and full address*] hereby give notice of my intention to oppose the registration of the Trade Mark advertised under the above number for Class in *The Trade Marks Journal* of the day of . 19 . No. . page .

The grounds of opposition are as follows:—[*Here insert particulars.*]

[*Signature of opponent.*]

Dated the day of 19 .

Address for Service—

*To* The Comptroller &c.

## Form K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF TRADE MARK UPON THE REGISTER, WITH DECLARATION IN SUPPORT THEREOF.

I [*here insert name, full address, and description*] hereby request that you will enter my name in the Register of Trade Marks as proprietor of the Trade Mark No. in Class .

I am 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.

[*Here state whether Trade Mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof, as e.g.* "by deed dated the day of . 19 , made between So-and-so of the one part &c."]

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.

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. [*This paragraph is not required when the declaration is made out of the United Kingdom.*]

[*Signature of person making the declaration.*]

Declared at this )
day of . 19 . )

Before me [*signature and title of the authority before whom the declaration is made*].

*To* The Comptroller &c.

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## Form L.

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A TRADE MARK IN USE BEFORE 13TH 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 the day of , 19 .

*To* The Comptroller &c.

## 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 .

[*Signature of proprietor.*]

Dated the day of . 19 .

*To* The Comptroller &c.

## Form N.

NOTICE OF ORDER OF COURT FOR ALTERATION OR RECTIFICATION OF REGISTER OF TRADE MARKS.

In the Matter of the Trade Mark No. ,
registered in Class in the name of .

SIR.—Notice is hereby given that by an Order of the Court made on the day of , 19 . 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.

[*Signature of person interested, or his agent.*]

Dated the day of . 19 .

*To* The Comptroller &c.

## 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. . page .

Name of Registered Proprietor or Firm .

Place of Business .

I the undersigned . of [*or* I the undersigned , a member of the firm of , of ,

on behalf of my said firm], apply that the entry upon the Register of Trade Marks in Class of the Trade Mark No. may be cancelled.

[*Signature of applicant.*]

Dated the day of . 19 .

This is the statement marked "O" referred to in the Declaration of made before me the day of 19 .

A Commissioner &c.

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## 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 , 19 , 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 proprietors 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.

[*Signature of person making the declaration.*]

Declared at
this day of . 19 ,

Before me [*signature and title of the authority before whom the declaration is made.*]

If the declaration be made before a Commissioner to Administer Oaths, it will require to be stamped with a 2s. 6d. impressed Inland Revenue stamp.

## Form Q.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR PERMISSION TO AMEND APPLICATION UNDER SECTION 91.

SIR,—I hereby request that *[insert particulars of error]*.

*[Signature of claimant.]*

Dated the day of , 19 .

*To* The Comptroller &c.

## 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]*.

I am, Sir,

Your obedient Servant,

*[Signature of applicant.]*

Dated the day of 19 .

*To* The Comptroller &c.

## Form S.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK TO BE USED IN LEGAL PROCEEDINGS.

In the Matter of the Trade Mark No. , registered in Class in the name of .

SIR,— I, , of , the registered proprietor of the above Trade Mark, hereby request you to furnish me with your Certificate of Registration to be used in legal proceedings.

*[Signature of applicant.]*

Dated the day of 19 .

*To* The Comptroller &c.

## 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, , of , are unable to agree upon the facts on which the opinion of the Court is to be taken, and that we request you to fix a day on which we may attend before you and obtain your finding on the matters of fact to be submitted to the Court as settled.

*[To be signed by both parties.]*

Dated the day of 19 .

To The Comptroller &c.

## Form T1.

REQUEST FOR GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).

In the Matter of the Trade Mark No. .
in Class .

SIR,—I, , of , hereby request you to furnish me with your Certificate that *[here set out the particulars which the Comptroller is requested to certify.]*

*[Signature of requisitionist.]*

Dated the day of 19 .

To the Comptroller &c.

## Form U.

GENERAL CERTIFICATE OF COMPTROLLER (OTHER THAN CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR FOR USE IN OBTAINING REGISTRATION ABROAD).

Patent Office, Trade Marks Branch,
London, 19 .

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify *[particulars to be inserted]*.

## 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 of applicant.*]

Dated the day of 19 .

*To* The Comptroller &c.

## 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. [*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 of appellant.*]

Dated the day of 19 .

*To* The Comptroller &c.

## Form X.

CONTINUANCE OF MARK AT EXPIRATION OF FOURTEEN YEARS FROM THE DATE OF REGISTRATION.

SIR,—In pursuance of the notice received from you, I hereby transmit the prescribed fee of One Pound for continuance on the Trade Marks Register of the Trade Mark No. in Class .

[*Signature of proprietor.*]

Dated the day of 19 .

*To* The Comptroller &c.

## Form Y.

*(Additional Fee of Ten Shillings to accompany "Continuance Fee," Form X, within Three Months after expiration of Fourteen Years.)*

SIR,—In pursuance of the notices issued by you, and of the provisions of Section 79 (3) of the above Acts, I hereby transmit the additional fee of Ten Shillings (along with Form X) for the continuance on the Trade Marks Register of the Trade Mark No. in Class .

[*Signature of proprietor.*]

Dated the day of 19 .

*To* The Comptroller &c.

## Form Z.

RESTORATION OF TRADE MARK WHERE REMOVED FOR NONPAYMENT OF FEE.

*(To accompany Form X.)*

SIR,—In pursuance of the notices issued by you, and of the provisions of Section 79 (4) of the above Acts, I hereby transmit the additional fee of One Pound (along with Form X) for restoration to the Trade Marks Register of the Trade Mark No. in Class

[*Signature of proprietor.*]

Dated the day of , 19 .

*To* The Comptroller &c.

## Form AA.

APPLICATION FOR REGISTRATION OF OLD CORPORATE TRADE MARK.

You are hereby requested to register the accompanying old Corporate Trade Mark in Class , in respect of , in the name of , who claims to be the proprietor thereof.

[*Signature of applicant.*]

Dated the day of , 19 .

*To* The Cutlers' Company,
Cutlers' Hall, Sheffield.

M. E. HICKS-BEACH,
*President of the Board of Trade.*

# 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 Comptroller may desire.

## CLASSIFICATION OF GOODS.

NOTE.—The goods referred to in the following classes are mentioned by way of illustration, and not as an exhaustive list of the contents of the class.

**CLASS 1.**—Chemical Substances used in Manufactures, Photography, or Philosophical Research, and Anti-corrosives. Such as Acids, including vegetable acids; Alkalies; Artists' Colours; Pigments; Mineral Dyes.

**CLASS 2.**—Chemical Substances used for Agricultural, Horticultural, Veterinary, and Sanitary purposes. Such as Artificial Manure; Cattle Medicines; Deodorisers; Vermin Destroyers.

**CLASS 3.**—Chemical Substances prepared for use in Medicine and Pharmacy. Such as Cod Liver Oil; Medicated Articles; Patent Medicines; Plasters; Rhubarb.

**CLASS 4.**—Raw or partly prepared Vegetable, Animal, and Mineral Substances used in Manufactures not included in other classes. Such as Resins; Oils used in manufactures and not included in other classes; Dyes, other than mineral; Tanning Substances; Fibrous Substances (*e.g.* Cotton, Hemp, Flax, Jute); Wool; Silk; Bristles; Hair; Feathers; Cork; Seeds; Coal; Coke; Bone; Sponge.

**CLASS 5.**—Unwrought and partly wrought Metals used in manufacture. Such as Iron and Steel—pig or cast. Iron—Rough; Bar and Rail, including rails for railways; Bolt and Rod; Sheet, and Boiler and Armour Plates; Hoop. Lead—Pig; Rolled; 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; and Instruments and Apparatus for Teaching. Such as Mathematical Instruments: Gauges; Logs; Spectacles; Educational Appliances.

**CLASS 9.**—Musical Instruments.

**CLASS 10.**—Horological Instruments.

**CLASS 11.**—Instruments, Apparatus, and Contrivances, not Medicated, for Surgical or Curative purposes, or in relation to the Health of Men or Animals. Such as Bandages; Friction Gloves; Lancets; Fleams; Enemas.

**CLASS 12.**—Cutlery and Edge Tools. Such as Knives; Forks; Scissors; Shears; Files; Saws.

**CLASS 13.**—Metal Goods not included in other classes. Such as Anvils; Keys; Basins (metal); Needles; Hoes; Shovels; Corkscrews.

**CLASS 14.**—Goods of Precious Metals (including Aluminium, Nickel, Britannia Metal, &c.) and Jewellery, and Imitations of such Goods and Jewellery. Such as Plate; Clock Cases and Pencil Cases of such metals; Sheffield and other Plated Goods; Gilt and Ormolu Work.

**CLASS 15.**—Glass. Such as Window and Plate Glass; Painted Glass; Glass Mosaic; Glass Beads.

**CLASS 16.**—Porcelain and Earthenware. Such as China; Stoneware; Terra Cotta; Statuary Porcelain; Tiles; Bricks.

**CLASS 17.**—Manufactures from Mineral and other Substances for Building or Decoration. Such as Cement; Plaster; Imitation Marble; Asphalt.

**CLASS 18.**—Engineering, Architectural, and Building Contrivances. Such as Diving Apparatus; Warming Apparatus; Ventilating Apparatus; Filtering Apparatus; Lighting Contrivances; Drainage Contrivances; Electric and Pneumatic Bells.

**CLASS 19.**—Arms, Ammunition, and Stores not included in Class 20. Such as Cannon; Small-arms; Fowling-pieces; Swords; Shot and other Projectiles; Camp Equipage; Equipments.

**CLASS 20.**—Explosive Substances. Such as Gunpowder; Gun-cotton; Dynamite; Fog Signals; Percussion Caps; Fireworks; Cartridges.

**CLASS 21.**—Naval Architectural Contrivances and Naval Equipments not included in Classes 19 and 20. Such as Boats; Anchors; Chain Cables; Rigging.

**CLASS 22.**—Carriages. Such as Railway Carriages; Waggons; Railway Trucks; Bicycles; Bath Chairs.

**CLASS 23.**—(*a*) Cotton Yarn, and Sewing Cotton not on spools or reels. (*b*) Sewing cotton on spools or reels.

**CLASS 24.**—Cotton Piece Goods of all kinds. Such as Cotton Shirtings; Long Cloth.

**CLASS 25.**—Cotton Goods not included in Classes 23, 24, or 38. Such as Cotton Lace; Cotton Braids; Cotton Tapes.

**CLASS 26.** Linen and Hemp Yarn and Thread.

**CLASS 27.**—Linen and Hemp Piece Goods.

**CLASS 28.**—Linen and Hemp Goods not included in Clauses 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, Floorcloth, and Oilcloth. Such as Drugget; Mats and Matting; Rugs.

**CLASS 37.**—Leather, Skins unwrought and wrought, and Articles made of Leather not included in other classes. Such as Saddlery: Harness; Whips; Portmanteaus; Furs.

**CLASS 38.**—*Articles of Clothing.* Such as *Hats of all kinds*; Caps and Bonnets; Hosiery: Gloves: Boots and Shoes; other Ready-made Clothing.

**CLASS 39.**—Paper (except Paper-hangings), Stationery, and Book-binding. Such as Envelopes, Sealing Wax, Pens (except gold pens), Ink, Playing Cards, Blotting Cases, Copying Presses.

**CLASS 40.**—Goods manufactured from India-rubber and Gutta-percha not included in other classes.

**CLASS 41.**—Furniture and Upholstery. Such as Paper-hangings: Papier-mâché: Mirrors; Mattresses.

**CLASS 42.**—Substances used as Food or as ingredients in Food. Such as Cereals, Pulses, Olive Oil, Hops, Malt, Dried Fruits, Tea, Sago; Salt, Sugar, Preserved Meats, Confectionery, Oil-cakes, Pickles, Vinegar, Beer Clarifiers.

**CLASS 43.**—Fermented Liquors and Spirits. Such as Beer: Cider; Wine; Whisky; Liqueurs.

**CLASS 44.**—Mineral and 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 Powder; 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. (1) Goods manufactured from Ivory, Bone, or Wood not included in other classes. (2) Goods manufactured from Straw or Grass not included in other classes. (3) Goods manufactured from Animal and Vegetable substances not included in other classes. (4) Tobacco Pipes. (5) Umbrellas, Walking-sticks, Brushes, and Combs. (6) Furniture Cream, Plate Powder. (7) Tarpaulins, Tents, Rickcloths, 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.

(Signed) M. E. HICKS-BEACH,
*President of the Board of Trade.*

# INDEXES.

**NOTE.—The following Indexes are arranged separately under the three different headings of Subject Matter: viz.—Patents, Trade Marks, and Designs. An alphabetical list of the Foreign Countries and British and Foreign Colonies, the laws of which are dealt with in Part IV., will be found in the Table of Contents at the beginning of the book.**

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