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BY

DAVID FULTON

OF THE MIDDLE TEMPLE AND NORTHERN CIRCUIT

BARRISTER-AT-LAW

(*Assoc. Mem. Inst. Civil Engineers*)

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PREFACE TO THE THIRD EDITION.

SINCE the last Edition of this book was published The Patents Act of 1902 has been passed, and new Patent Rules have been issued. In the present Edition those portions of the work which have been affected have been re-written and all changes in the Law and Rules have been carefully noted. The successive Statutes from 1883 to 1902 have been codified and consolidated—the respective sections of the amending Acts being interpolated in different type at the appropriate places, and the same plan has been adopted in printing the Rules.

As in former Editions, the contents have been arranged in their relative order of importance. PART I. relates to Patents; PART II. to Trade Marks; and PART III. to Designs. The corresponding Rules are printed at the end of each division.

Over three hundred additional Cases are cited, some of them of considerable importance.

A separate and independent Index has been prepared for each division, so as to facilitate reference.

The publication of this Edition has been delayed in order that all available information upon the practical working of the new system of Examination of Patent Applications (which came into force on the 1st of January, 1905), might be included. Many apprehensions as to the possibly hurtful effects of that system have been set at rest by the careful and discriminating use of their powers by the Patent Office authorities, and there is little doubt that the beneficial effects of this portion of the Statute of 1902 will in time become apparent even to those who were opponents of the innovation.

The Author has again to acknowledge his obligation to the learned Comptroller-General of Patents, C. N. Dalton, Esq., C.B., and to Ralph Griffin, Esq., the learned Registrar of Trade Marks, for much valuable information and assistance.

DAVID FULTON.

1 Garden Court, Temple,

June, 1905.

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Wilson *v.* Wilson, [1899] 16 R. P. C. 315 (*Amendment of Particulars*) 430

Winfield *v.* Snow, [1890] 8 R. P. C. 15 (*Silk Lace*) - - - 414, 433

Wittmann *v.* Oppenheim, [1884] 27 Ch. D. 260 (*China Lamp*) - 418

Woolley *v.* Broad, [1892] 9 R. P. C. 208, 429 (*Lace*) - 401, 419, 426, 430

KEY TO ABBREVIATED REFERENCES TO REPORTS.

App. Cas. (*or* A. C.) -	- Law Reports (New Series), Appeal Cases.
Atk. - - -	- Atkyn'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 (Appeal).
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.
Good. O. C. - -	- Goodeve'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. C.	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. *or* K. B.	,, ,, ,, Queen's Bench *or* King'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 & Webster's Reports.
New. L. Jou.	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.
Seb. Dig. - - -	Sebastian'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, 1886, 1888, 1901, and 1902. These Acts will be referred to generally throughout this Work as "The Patents, Designs, and Trade Marks Acts, 1883 to 1902." The union of the three species of property in the title of these Acts seems to imply a closeness of similarity which does not really exist. A few words will serve to differentiate them.

Patent.

When a Patent has been granted, say for a new description or construction 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 shape of the lamp or to the decorative stand, which could not be varied from the registered design without going outside the limit of protection.

Co-existence of Patent and Design Copyright.

In some instances it might even happen that the improved fixed shape or configuration of an article might render it patentable as well as the subject-matter of a Design, in which case the two rights might co-exist independently of each other (see *Werner* v. *Gamage*, [1904] 21 R. P. C. 621). Such instances are not unknown, but are likely to be rare.

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 1902.

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 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.

Crown 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, although existing manufactures and the supply of certain products and goods, both natural and artificial, were the chief objects of the older grants of monopoly, new inventions, new manufactures, and advances in arts and sciences were considered favourable subjects for protection by 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 grants in respect of trade monopolies or new industries not hitherto known in the realm, and not for patents for inventions.

Early trade monopolies and their abuse.

With lapse of time 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 necessary 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 (21 Jac. I. c. 30), 1624. Monopolies abolished.

Sections 5 and 6 reserve patents for inventions and become the basis of modern patent rights.

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 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 is shortly defined as "any manner of new manufactures which others at the time of making such 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.

Subject-matter and conditions of patents defined.

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.

Reasons for fixing duration of patents.

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.

After-history of Patent Law.

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

Petitions, declarations, reports, references, warrants, stamps, bills, and seals were bandied 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 itching palm. 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 immediate purview of the patentee.

Circumlocutive procedure in early times.

Lord Coke's apology.

Lord Coke instances the multiplication of fee-exacting offices as an example of "the wisdom of prudent antiquity, that whatsoever should pass the Great Seal 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 Kay's Patent* (1 Web. P. C. 568) the accounts showed the patent to have cost £500. Up to the reign of Queen Anne no specification seems to have been required,

Enrolment of specifications.

but about the year 1730 the enrolment of a specification became compulsory.

As a consequence of this enforced deposit of an exact description of the invention, the conditions in the grant requiring the establishment of the new industry and the instruction of others in its mysteries—in other words, the commercial working of the invention within the realm—

Abolition of necessity of working patent.

appears to have fallen into abeyance during the latter half of the eighteenth century. Apparently the presence on record of the exact description contained in the specification was held as a warrant that on the expiry of the patentee's monopoly, whether he worked it or not, others would be able to put the invention in practice. From this it followed that the question of construction and sufficiency of the specification became then, as now, one of the tests by which it was ascertained whether this part of the consideration for the grant had been fulfilled by the patentee.

It may be interesting to point out that the consequence of this departure from the spirit of the Statute of Monopolies, which, as is clear from the wording of Sections 5 and 6, was intended to further "the *working or making* of any manner of new manufacture within the realm," is at the root of the modern complaint, that

Abuses arising from non-working.

nowadays foreigners obtain patents in this country with no intention of working them here, but merely for the purpose of preventing competition by tying the hands of British manufacturers and enabling the patentees to manufacture abroad and import to England at prices which are often exorbitant. It is indisputable that under the Statute of Monopolies patents were not granted to inventors as a reward for being ingenious, but for the purpose of introducing new manufactures into the country and to create increased employment for the working classes. It is equally indisputable that under existing conditions many a patent granted to a foreigner, so far from being an encouragement to native industry, is a positive fetter upon the wrists of those who would otherwise find profitable employment were working in this country made compulsory. The most important commercial combinations in England, strongly supported by the working classes, have more than once pressed upon the Government the advantages of reverting to the original purposes of the Statute of Monopolies, viz. that, so far at least as concerned patents granted to foreigners, working in this realm should be made compulsory. But these proposals did not find general acceptance, and the only result has been a compromise represented in its latest form by the Compulsory Licence Clauses of the Patents Act of 1902.

Compulsory licences.

To return from this digression: 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).

The Patent Law Amendment Act, 1852.

Patent Act, 1852.

The changes effected by this Act were important.

One patent covered Great Britain and Ireland, the Channel Islands, and the Isle of Man. The whole

One patent for United Kingdom.

Steps in obtaining a patent.

business of the Commissioners of Patents was conducted in one office under a responsible head. The stages of procedure were reduced to—(1) The Application, with Provisional or Complete Specification; (2) The Giving Notice of Intention to Proceed with the Application; (3) The Applying for the Warrant and Seal (which latter step has been practically revived under the Patents Act of 1902) and, (4) if it had not been done at the time of application, The Filing of the Complete Specification.

First introduction of Provisional 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.

Fees under Act of 1852.

Under the Act of 1852 the mere stamp duties payable on obtaining a patent amounted to £25, and the sums payable at the end of the third and seventh years respectively were £50 and £100, so that the total amount payable in stamps alone on a patent obtained and kept in force for the full term of fourteen years was £175.

Agitation for alterations in Patent Law.

During the operation of the Act of 1852 considerable agitation was carried on among Patent Law reformers, whose chief objects were the reduction of the fees and the introduction of some system of examination. The former result was to some extent obtained under the Act of 1883,

Examination of Applications.

but the Examination of Applications only dates from the 1st of January, 1905, and is the result of the coming into operation of the Patents Act of 1902. As will be seen later on, this examination is not of the most complete character, but is decidedly a step in the right direction.

The Patents, Designs, and Trade Marks Acts, 1883 to 1902.

Act of 1852 not an originating Act.

If the reader has followed the foregoing historical *résumé*, he will doubtless have noticed that the Act of 1852 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 (now, under the Act of 1902, increased to £5), 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. This sum, added to the £5 payable as fees on the obtaining of the patent, makes exactly £100 as the cost in Government fees of obtaining and keeping in force a patent for fourteen years.

Procedure simplified and fees reduced.

The foregoing and sundry additional 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 1902. As regards the restriction to "one invention only," Rule 5 of The Patents Rules, 1905, provides that when a specification comprises several distinct matters they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus, or process.

One invention only.

Patents Act of 1901.

The Patents Act of 1901 (1 Edw. VII. c. 18), which came into operation on the 1st 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

Extension of period of priority under Convention.

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.

Convention application to be accompanied by Complete Specification.

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 expiration of that period.

If not accepted within twelve months from date of foreign application, Complete to be open to public inspection.

The Act of 1901 did not make it plain from what period the twelve months for acceptance of the Complete Specification were to run. But Rule 15 of The Patents Rules, 1903 (see Consolidated Rules, page 235), says that 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. 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 is to be read as "foreign or colonial" (see Rule 3 of The Patents Rules, 1903).

Patents Act, 1902.

The Patents Act of 1902, all of the provisions of which are now in force, and which will be found consolidated with the original and succeeding Statutes in Appendix C, page 483, deals with three important amendments, which are as follows:—

Examination.

(1) Applications are now subject to an examination as to novelty, the investigations dealing only with British Complete Specifications published and dated within fifty years prior to the date of the application.

Restriction on anticipation.

(2) When a patent has been granted under the Act of 1902: that is to say—on any application

made after the 1st January, 1905—no British Specification older than fifty years back from the date of the patent, and no published Provisional Specification whatsoever, can be deemed an anticipation of the patent so granted.

Compulsory Licences.

(3) The hearing of Petitions for the Grant of Compulsory Licences, which was formerly in the hands of the Board of Trade, is now transferred to the Judicial Committee of the Privy Council. The Petition still requires to be presented to the Board of Trade; but unless the Board can effect an arrangement between the parties the Petition is referred to the Judicial Committee, who will hear the parties and decide whether a licence is to be granted or not.

Operation of Act of 1902.

The amendment dealing with Compulsory Licences came into operation on the 18th December, 1902. The rest of the Act of 1902 became operative on the 1st January, 1905.

Headings under which contents are arranged.

Having thus glanced broadly at the origin and development of patents 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.

Headings under which contents are arranged—continued.

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.

15. Foreign and Colonial Patents, with a reference to the International Convention.

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) 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. Form A1 is to be used in the case of inventions communicated from abroad to an agent in this country, and Form A2 where application is made under the International Convention.

How to fill in forms.

Communication form.

Convention form.

If the applicant wishes to apply for provisional protection only, he will receive with the application form 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. The specification itself is kept secret during the term of provisional protection. No examination as to novelty takes place with regard to the Provisional Specification.

Provisional protection.

Certificate of filing Provisional.

Advertisement and acceptance of application.

Complete Specification

At any time within six 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. It should be noted that Form C, issued under the Patents Rules of 1905, has a marginal note referring to Rule 4 and urging clearness, curtness, and simplicity of language in preparing the claim or claims. The Complete should, when necessary or desirable, be accompanied by line drawings executed in absolutely black 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 to $8\frac{1}{4}$ inches in width, or, if this is too small, 13 inches in length by 16 to $16\frac{1}{2}$ inches in width. On one of the copies of the drawing (marked "Original") the reference lettering should be in black ink; the other copy, which may be on tracing linen, should be marked "True copy," and the lettering should be in black-lead 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.

Claims.

Drawings.

Certificate of filing Complete.

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

Comparison by Examiners of Provisional and Complete.

The Complete Specification is now taken in hand by the Examiner in the Patent Office, who first of all compares it with the Provisional and satisfies himself that the documents are in order, that they describe the same invention, and are properly prepared in compliance with the Rules.

If the Complete does not sufficiently clearly ascertain and claim the invention, the Comptroller may, under Rule 6 of 1905, require amendment, and he may also, under the same

Comptroller may alter date.

Rule, alter the date of the application so as to give sufficient time for subsequent procedure. The examination is also directed towards ascertaining that one invention only is included in the specification (see Rule 5 of 1905), and if more than one invention is included the applicant may be allowed to make a separate application for the surplus invention bearing the same date as the original application.

One invention only.

Unpatentable inventions.

Apparently also the Examiner, in fulfilling these duties, if the subject-matter appears to him to be unpatentable—that is to say, something which is not an "invention" within the meaning of Section 46 of The Patents Act, 1883—may report to that effect to the Comptroller, who, after hearing the applicant, may refuse the patent outright (*Cooper's Application*, [1901] 19 R. P. C. 53; *Johnson's Application*, [1901] 19 R. P. C. 56).

Examination as to novelty.

These preliminary points disposed of, should they crop up, the Examiner then addresses himself to the further investigations prescribed by the Act of 1902, *i.e.* to ascertain the novelty of the invention described and claimed. The field of examination is confined to all Complete British Specifications deposited and published or accepted in pursuance of any application for a patent made in the United Kingdom within fifty years next before the date of the application under consideration. Outside this limit the Examiner has no power to go. Provisional Specifications unaccompanied by a Complete (such, for instance, as were accustomed to be published under the old Act of 1852) are of no effect.

Limits of examination.

Acceptance of specification.

If the Examiner can find nothing to affect the novelty of the invention, he reports this to the Comptroller, who, in the absence of any other lawful ground of objection, will accept the specification, and such acceptance is notified to the applicant and advertised in the *Official Journal*.

Examiner's report.

If, on the other hand, the Examiner reports that the invention has been wholly or in part claimed or described in any such prior specification, the Comptroller advises the applicant of the objection, and specifies a time (two months according to Rule 8 of 1905) within which the application must be amended and returned to the Comptroller. If the amendment submitted is not to the

satisfaction of the Comptroller, he may require further amendments or will appoint a hearing, giving ten days' notice, to allow the applicant or his agent or counsel to attend and urge orally the merits of his case; or the applicant might be asked to attend to make oral explanations; or he may be required to send an explanatory statement in writing.

Hearing the applicant.

Unless the amendments of the specification are such as to meet the objections of the Comptroller, he has power, after hearing the applicant, to decide what references to prior patents must be made in the specification by way of notice to the public (Section 1, Sub-section 6, of the Act of 1902).

Inserted reference to prior patents.

The exact wording of the inserted reference is given in Rule 10 of 1905. It runs thus: "Reference has been directed in pursuance of Section 1, Sub-section 6, of The Patents Act, 1902, to the following specification of Letters Patent No. , granted to ." The reference is inserted after the claims. Where the reference is under Rule 7, viz. to the effect that the reference is consequent upon a provisional report based on a partial and not exhaustive search by the Examiner, who has come to the conclusion that the invention has been wholly disclosed by the indicated prior patents, a statement to that effect is added to the reference (see Rule 10 of 1905).

Terms of reference.

Reference under Rule 7.

The Comptroller has no power to refuse a patent on the ground of want of novelty, no matter how amply lack of novelty may have been shown by the examination. All that he can do is to add to the specification the reference to the patent which in his opinion anticipates it.

No power of refusal.

The applicant may so amend his specification as not to require any references to prior patents; but if he declines to do so, and insists on retaining or objects to disclaiming portions which the Comptroller regards as lacking in novelty, then the Comptroller will require references lest the public should be misled or left in the dark as to what prior patentees have described or claimed. But so far as present practice is a guide, it is evident that references are not to be indiscriminately made. Thus the mere fact that a specification contains

Avoidance of references.

one or more elements already described in prior patents will not call for a reference to those patents so long as it is made indisputably plain that the applicant does not claim these elements.

An appeal lies from the decision of the Comptroller to the Law Officer, who will appoint a hearing and either uphold, modify, or reverse the Comptroller's decision. Appeal.

On the acceptance of the Complete, such acceptance is notified to the applicant and is advertised in the *Official Journal*. About 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 applicant may then pay the sealing fee of £1, whereupon the patent is sealed and issued to the applicant. 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 within six months 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—viz. £1 instead of £4—while the applicant has six 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 Advantages of provisional with application. Applicant may work invention during Provisional Protection. Infringements after publication of Complete.

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

Renewal of abandoned application.

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 places the applicant in a position to deal with infringers as soon as he gets his patent into his hands. 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.

Only recommendable where invention is perfect.

Applications under the Convention.

The preceding remarks are intended chiefly for the guidance of British inventors and applicants. The conditions governing applications for patents by foreigners and others under the International Convention differ in some respects from home applications, and are governed by The Patents Act, 1901, and The Patents Rules, 1903

and 1905. An application under the Convention must be made on Form A2, and, according to Rule 13 of The Patents Rules, 1903, the declaration must specify the Foreign States or British Possessions in which applications have already been made, setting out the official dates. The application must be made within twelve months of the first foreign application; must be accompanied by a Complete Specification and drawings (if any); must be in the English language, and must be signed by the foreign applicant. A copy of the specification and drawings of the first foreign application must accompany the papers, and these must be certified by the official head of the Foreign Patent Office. If in a foreign language, a translation of the documents, verified by statutory declaration, must accompany the application. If not accepted by the Comptroller within twelve months from the date of the first foreign application, the Complete Specification and drawings are thrown open to public inspection at the expiration of that time. Subject to these preliminary conditions, Convention applications are then dealt with exactly as in the case of British Complete Specifications, except that the date of the British Patent will be the same as that of the first foreign application.

Conditions to be observed by Applicants under Convention.

Rules 13, 14, 15, 16, and 52 of The Patents Rules, 1903, govern these Convention applications, and these Rules are set out in full after Chapter XXVI. of this division of the work. The Rules of 1903 as printed are consolidated with the Patent Rules of 1905, and readers are advised to supplement their perusal of this chapter by an examination of the Rules.

Patent Rules.

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,

Some reasons for the employment of patent agents.

especially in view of the increased difficulties and responsibilities thrown upon an applicant by the advent of the examination system under the Act of 1902. The fatal facility with which any person, fired by some crude idea, can enter a post-office, buy a form, scribble down his inspiration, and incontinently 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.

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 six 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 seven months from the date of application—the application is considered to be abandoned. This extension is not granted as a matter of course, and the Comptroller under the Rules of 1903 has discretion to inquire narrowly into the circumstances, and to refuse the extension of time if he thinks fit. Under Sub-section 4 of Section 9 of the amended Act

Extension of time to complete application.

of 1883, the Complete Specification must be accepted within twelve months from the date of the application, except when the delay arises from a cause beyond the applicant's control: but the time for acceptance may be extended from one to three months on good cause for the delay being shown to the Comptroller, and on payment of the fee, which amounts to £2 for one month, £4 for two months', and £6 for three months' extension. Here also the Comptroller has power to inquire fully into the circumstances and to refuse the extension if he thinks fit.

Extension of time for acceptance of Complete.

Opposition.

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

Date of patent.

If no opposition is entered, or if the opposition is unsuccessful, the applicant may give notice at any time on or before the last day on which the patent can lawfully be sealed that he desires a patent to issue on his application. This notice is given on Form X. bearing a stamp of £1, and on receipt of the notice the patent is sealed and issued as of the date of the application.

Duration.

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

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. Applicants must apply in their real names, and not under assumed or trade names.

Corporate bodies.

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 frequently communicate the invention to a representative or agent in this country, who thus becomes the grantee on behalf of his foreign correspondents. Under the Convention, where a foreign corporation has applied for a patent abroad—in one of those countries where a patent can be granted to a corporate body—the corporation may apply for and obtain a patent in this country in its corporate name alone (*Carez's Application*, [1889] 6 R. P. C. 552).

Firms.

A firm as such cannot obtain a patent. The application should be made jointly by the individual members of the firm.

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. It follows from this that should the legal estate in a patent become vested in the

Crown as *bona vacantia*, apparently as the Crown cannot be a patentee under its own grant, the patent ceases to exist by merger (*per* Buckley, J., in *Taylor's Trusts*, [1904] 21 R. P. C. 715). Further, although many such patents exist, some authorities have 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.

Crown.

Clergyman.

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.

Joint patentees.

The "true and first inventor" is, in the eye of the law, the first legitimate applicant for a patent. If another person has previously discovered the invention, but has neither disclosed it in a manner sufficient to constitute publication nor applied for a patent, he cannot prevent a subsequent independent inventor from obtaining a valid patent. *A fortiori*, where two people simultaneously and independently evolve the same invention, the true and first inventor is the first applicant for a patent.

True and first inventor.

Independent inventors.

Neither is the term "inventor" 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, and if no fraud within the jurisdiction and as against the true inventor has been practised. However, if the invention

Importers.

Rights of foreign inventors under International Convention.

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 from the date of the earliest foreign application will be thrown open to public inspection.

Position of persons assisting an inventor to perfect his idea.

A person who originates the fundamental idea of an invention, and then takes it to a skilled man and employs him to work out the details, is entitled to include the suggestions of his assistant in his specification, and the assistant has no right to patent in his own name the improvements he may have made (*re Daeid & Woodley*, Griff. A. P. C. 26; *Smith's Patent*, [1904] 22 R. P. C. 57). A servant or paid assistant taking out patents in this improper manner at home and abroad may be declared trustee of the patents for the benefit of the rightful owner (*Richmond* v. *Wrightson*, [1904] 22 R. P. C. 25). But if an employer merely tells his servant to devise something to fulfil a specific function, without telling him how it is to be done, and pays him for doing so, the servant is the inventor, and he alone can properly patent it (*Marshall & Naylor's Patent*, [1900] 17 R. P. C. 553). On the other hand, the mere relationship of master and servant does not justify the master in patenting the servant's invention, even when made in the master's time and with the master's tools (*re Heald*, [1891] 8 R. P. C. 429). But when the relationship between employer and employed is of an intimate and confidential nature, and the servant has allowed his masters to use the patent in their business, the subsequent severance of their connection might not justify the ex-employé in holding and using the patent as against his former employers, much less prevent them from continuing the use of the invention in

Master and servant.

their business (*Worthington* v. *Moore*, [1902] 20 R. P. C. 41). But the actual circumstances of each case of this description must be carefully considered.

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 case 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 1902 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 gigantic patent system in force across the Atlantic.

"Manufacture" means both method of making and product.

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 '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. And apart from a principle the term also excludes any mere scientific discovery which does not result in the production of some useful tangible thing or process of manufacture. Said Lord Cranworth in *Ralston* v. *Smith* ([1860] 11 H. L. Ca., at p. 250): "It is not every useful discovery that can be made the subject of a patent, but you must show that the discovery can be brought within a fair extension of the words '*a new manufacture*'" (see also Lord Davey in *Chamberlain & Hookham* v. *Mayor of Bradford*, [1903] 20 R. P. C., at p. 687). 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 mere principle.

Discovery not "invention."

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.

"Manufacture" includes "process."

Crane v. *Price.*

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. Wireless telegraphy, where the atmosphere is made to perform the duties of the usual connecting and conducting wires, might also be cited as an epoch-making advance upon the existing electric telegraph; and the electric wave-collectors with their later synchronising and syntonising developments would all constitute new apparatus for this new purpose.

Example of the highest type of invention.

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 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.

Example of a lower type.

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.

Improvements in existing machinery.

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 apparently slight advance. *Moser* v. *Marsden*.

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.

Improvements upon existing patents.

Additions to or improvements on existing patented machinery or things, may also be made, and in their turn patented (see *Fox* 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.

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

Patents for combinations.

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 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

Mere judicious arrangement not patentable.

Mere putting together two known things not invention.

Williams v. *Nye*.

quite so easy to effect, the patent could not be upheld. In *Saxby* v. *Gloucester Waggon Co.* ([1880-3] 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.

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

But mere coupling together if invention is required is patentable.

It is impossible to patent the combintion 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. Neither is it possible to patent a combination of two things between which no real combination exists. In criticising a faulty claim of this nature in *Osmond's Limited* v. *Balmoral Cycle Co.* ([1898] 15 R. P. C. 505) Chitty, L. J., remarked

Combination of a concretion and abstraction not patentable.

that the patentee might as well have said: "I claim that gear with a hat on a man's head." Mere improved adjustment of the parts of a machine was held not to be patentable in *Kay* v. *Marshall* ([1836-41] 2 W. P. C. 39, 71, 79; 8 L. J. C. P. 261).

Combinations of known parts.

Almost the largest class of patented inventions is that of combinations of known mechanism. In *Spencer* v. *Jack* ([1862-4] 3 D. J. & S. 346; 11 L. T. N. S. 242) 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."

Patents for mere combinations of known parts usually narrow.

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 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; *Curtis* v. *Platt*, [1863-4] 35 L. J. Ch. 852; 11 L. T. N. S. 245; Good. P. C. 144; *Lambert Co.* v. *International Record Co.*, [1904] 21 R. P. C. 247; *Morrison* v. *Aspden*, [1904] 21 R. P. C. 557). An interesting example of a non-infringing deviation from the plaintiff's claimed arrangement is also to be found in *Pilkington* v. *Massey*, [1904] 21 R. P. C. 696.

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 *Deeley'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. 496) the patent was upset on proof that the patentee had only combined in double eyeglasses certain features—viz. a rigid bridge, pivoted plaequets, 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 *Hayward* 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* ([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 constituted 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 *present* case is, that in *Wood* v. *Raphael* (*supra*) all of the parts of the combination had before been used separately in a *manner*, 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

Siddell v. *Vickers.*

Combination of known parts held to show functional advantage.

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.

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 Court 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.

Commercial success.

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. 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 these rollers had been of equal length with the main printing cylinder. A baby-roller or short drum adjustable on

Taylor & Scott v. Annand.

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. 304) on the difficulty of applying the law relating to combination patents to particular cases. The deft manner in which the apparent 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 *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."

Halsbury, L. C., on combinations.

Instances of very slight advances in combination patents are to be found in *Pinnell* v. *Hannan* ([1895] 13 R. P. C. 398), which related to concrete flooring; *Haddan* v. *Lyon* ([1894] 11 R. P. C. 361), where the invention, broadly speaking, consisted in strengthening a steam dam in an otherwise old *disinfecting machine*; and *Birch* v. *Hannay* ([1898] 15 R. P. C. 451), 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 startling variation

Examples of slight combination patents.

in the mode of moving the feed ring of a piece goods sewing machine. Although the defendant used an apparently 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, 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?"

Lister v. *Leather.*

Parkes v. *Stevens.*

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. The sweeping flap replaced the old horizontally moving

Proctor v. *Bennis.*

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 *Foxwell* v. *Bostock* ([1863-64] 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. Cas. 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.*

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

If essential of combination is taken the patent is infringed.

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* ([1891] 9 R. P. C. 41).

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

But, on the other hand, if someone makes use of the combination, omitting an element which the patentee has described and claimed as an essential 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. *Higginbottom*, [1902] 19 R. P. C. 187).

New compositions of materials.

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.

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 pipings, or the production of pins.

For example in the manufacture of pile fabrics, instead of the usual plan of weaving the pile in loops and subse-

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 suppositious 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.

Examples of improvements in existing manufactures

In *Walton v. Newton* (1881), 3 H. P. C. 1889 the plaintiff had patented an improvement in the manufacture of imitation seal skins, which consisted in lining silk with the mohair fibre before opening. The silk gave smoothness and lightness, 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 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. *James* ([1863] 32 Beav. 570), held not to be subject-matter. But where the substitution of one material for mother requires adaptation and shows some ingenuity, the patent may be upheld. Thus, in *American Braided Wire Co.* v. *Thomson* ([1899] 6 R. P. C. 518; L. R. 44 Ch. D. 274), woven wire was for the first time used to make ladies' bustles, 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.*

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. *Budge* ([1894] 11 R. P. C. 463), not to be subject-matter when applied to lock the head of a bicycle at rest. In *Rose's Patents Co.* v. *W. Healy & 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 incorrosible wire rings of type covers was held in *Shaw* v. *Barlow* ([1898] 15 R. P. C. 265) to be bad subject-matter. In *Hardy* v. *Powell* ([1898] 16 R. P. C. 169) an apparatus for cutting metallic linings by clamping several layers of material between templates and cutting through the

Obvious analogous user not patentable.

Examples of obvious analogous user.

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. Cas. 654; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27), where the plaintiff had patented a channelled 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. Another case bearing on the same point is that of

Morgan v. Windover.

Morgan v. *Windover* ([1890] 7 R. P. C. 131), where a "cee" spring, long in use at the rear of a carriage, was

The "Cee" Spring Case.

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. In *Acetylene Co., Limited* v. *United Alkali Co., Limited* ([1904] 22 R. P. C. 152), Lord Halsbury, referring to these two cases, said: "Whether you look at the cases of the fish-plates or the 'cee' springs, the principle has been established beyond all doubt that, under such circumstances, finding out that a thing which is known and practically used can be applied to another purpose is not the subject-matter for a patent."

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 *Hamelt* v. *Pickeley* ([1873] Cr. 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 numerous pipings of paste, adapted so as to be used for the manufacture of metal tubing: just as in *Pickeley* v. *Hall* ([1873] 30 L. T. 337) the document

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

principle was used for the production of musical sounds and harmonics 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.

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. 489), "analogy does not go a long way in chemistry."

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

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.

No general rule applicable.

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

The Courts seem to be still in doubt as to whether a new product *per se*, and apart from the process or means used to produce it, is good subject-matter for a patent. The most reliable writers on Patent Law lean rather against the proposition. The point has never been directly and in terms decided. On the other hand some strong expressions of opinion from the highest authorities might be quoted in favour of the suggestion that a product *per se* may be validly patented. Of course it is not, and never has been, disputed that when claimed as the result of a particular process or mode of manufacture, itself new, the product so produced is protected. In *Vorcerk* 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 the product *per se*, it might be sustained. The learned Lord Justice referred to the case of *American Braided Wire Co.* v. *Thomson* ([1889] 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

Products good subject-matter for patents.

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

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

In *Riekmann* v. *Thierry* ([1896] 15 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."

Lord Davey in *Acetylene Co.* v. *Alkali Co.*

So also Lord Davey in *Acetylene Co., Limited* v. *United Alkali Co., Limited* ([1904] 22 R. P. C. 145), plainly stated that if an inventor discovers a new material having valuable commercial qualities, the material *per se* is good subject-matter; and that although the patentee is bound to describe some process by which the material can be produced, the process would matter nothing "because the merit and novelty of the invention would consist *in the substance produced itself.*"

Judicial doubt as to patentability of products.

One would suppose that in view of these expressions of opinion, it might reasonably be contended that when a product is new and useful and complies with other requirements, it can be claimed by itself and apart from any process or mode of manufacture. But apparently considerable hesitation still exists in the minds of able Judges whose doubts cannot be ignored. For example, in *Kopp* v. *Rosenwald* ([1902] 19 R. P. C., at p. 211) Mr. Justice Buckley says: "I doubt myself whether in the strict sense of the word an article can ever be treated as being *in itself* the subject of a patent."

But, with the greatest deference to this *obiter dictum*, surely there are cases where a mere product apart from the particular mode of manufacture would be the subject of a patent? What, for example, of a new metal alloy where the mere selection of the ingredients was the invention, not the melting and casting? Or a new artificial stone or floorcloth depending purely for its novelty upon the selection of the components?

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 Processes 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

Old cases on process patents.

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.

Elmslie v. *Boursier.*

Crane v. *Price.*

A patentable invention may of course be constituted by an *addition* to an existing process. As was said by Stirling, L. J., in *Ashworth* v. *English Card Co.*, [1902] 19 R. P. C 470, "A new additional step in an old process by which a better article is produced may, we think, be the subject-matter of a patent." 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."

An addition to or subtraction from a process is patentable.

A new process producing an old thing is patentable.

In the case of *Badische Anilin Fabrik* v. *Levenstein* ([1887] 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

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

unable to succeed against the defendant, who used *insoluble* nitro-cellulose.

Patent might be for process, product, and apparatus.

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.

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.*

A bare principle not patentable.

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

"Discovery" not invention.

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. 416).

Principles and their practical application.

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 principle of using a 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 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.

Neilson v. Harford.

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

Otto v. *Linford.*

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.

Example of principle claimed without apparatus.

In *Booth* v. *Kennard* ([1856-7] 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." This *dictum* of the learned Baron was quoted with approval by Lord Davey in the comparatively recent case of *Chamberlain & Hookham* v. *Mayor of Bradford* ([1903] 20 R. P. C. 684). 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 "essence" of invention.

Automatic Machine Co. v. *Knight*.

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.

Master patents.

Another example, where the claimed essence or quasi-principle of an invention was held to constitute the patent a master or pioneer patent in respect of that essence, occurred in the case of *Brown* v. *Hastie* ([1904] 22 R. P. C. 85). The plaintiff's patent was for a means of preventing leakage past the controlling valve of a steam steering engine. The improvement consisted of an auxiliary double beat valve placed in the steam supply passage in front of the controlling valve. The opening of the auxiliary valve was effected by the opening of the controlling valve. The auxiliary valve, though old in form for other purposes, was new for this specific purpose. The defendants had applied an auxiliary valve for the same purpose and in the same position, but differing structurally and in the mode of operation. The Court held in substance that the plaintiff's was a pioneer patent in respect of this new notion of shutting off the steam automatically from the controlling valve when closed, and that any auxiliary valve in this position for the indicated purpose was an infringement, no matter what differences in detail might exist. The vibrating flap, in *Proctor* v. *Bennis*, is another instance of essence or quasi-principle, or pith and marrow in an invention, constituting the patent a master or pioneer patent in respect of this essence.

Distinction between "principle" and "essence."

The indicated distinction between the broad term "principle" and its narrower subdivision of "essence" or "quasi-principle" was briefly referred to by the writer in former Editions 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."

If quasi-principle exists it should be claimed.

Nevertheless, if there is an essence or quasi-principle disclosed in the specification which the patentee desires to claim, apart from the actual operating means shown, the claim should make such intention reasonably clear (*per* Cozens-Hardy, L. J., in *Ackroyd* v. *Thomas*, [1904] 21 R. P. C. 750), and the addition of a limiting phrase such as "substantially as set forth" to the claim might defeat so wide an interpretation of the claim.

7. *Unpatentable Subject-matter.*

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. 80). But a patent may be obtained for an article the *shape* of which enables it to fulfil a useful purpose (*Werner* v. *Gamage*, [1904] 21 R. P. C. 621).

More schemes and systems not patentable.

A mere scheme or system is not good subject-matter for a patent, however new or useful it might be. It is

within the province of the Comptroller to refuse a patent for such a thing. Thus in *Johnson's Application* ([1901] 19 R. P. C. 56) a system of business correspondence or, as the Law Officer called it, "a plan for the conduct of business in a particular way," was held not to be fit subject-matter within Section 46 of The Patents Act, 1883, although the claim sought to disguise the real invention as a printed envelope constituting a new article of manufacture.

No patent for illegal or immoral objects.

Inventions having illegal or immoral objects are unpatentable. Thus an improved burglar's jemmy or an instrument or medicine for procuring abortion would be refused protection.

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. *Dania* ([1869] 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." *Per* Buckley, J., in *Reynolds* v. *Herbert Smith* ([1902] 20 R. P. C., at p. 126), "Invention necessarily involves also the suggestion of an act to be done, and it must be an act which results in a new product or a new result, or a new process, or a new combination for producing an old product or an old 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

Attempts to define invention by the Bench.

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."

The alleged obvious nature of an invention may be rebutted 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.

Mere novelty does not imply invention.

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 adaptive modification is not invention.

In *Nicoll* v. *Swears* ([1893] 10 R. P. C. 240) Wright, J., decided that the mere prolongation of a burstable 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 (*Bearis* v. *Rylands*, [1900] 17 R. P. C. 704).

An invention might be accidental.

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

Amount of invention not material 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 *Rickmann* v. *Thierry* (*supra*): "No smallness or simplicity will prevent a patent from being valid"; and *per* Lord Davey in

Patent Exploitation, Limited v. *Siemens & Co.* ([1904] 21 R. P. C. 549): "It may be that the invention is a small one, but slight differences in these cases sometimes produce large results." 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 *Otto* v. *Linford* ([1881] 46 L. T. N. S. 35); and Bramwell, L. J., in *Hayward* v. *Hamilton* ([1881] Griff. P. C. 115), 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 appliation 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).

Examples of patents held bad as mere analogous users.

A fishplate, used before the date of railways to connect wooden beams, cannot be patented for connecting iron 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 (*Hazlehurst* 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*, [1890] 7 R. P. C. 131). Driving the screen of a stone breaker from the top was held not to constitute a patentable alternative to the old bottom driving (*Baxter* v. *Marsden*, [1904] 22 R. P. C. 18). 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 (*Case* v. *Cressy*, [1901] 18 R. P. C. 419).

Example of patentable analogous user.

But the application of trunnions to a cylinder used in the production of photo-prints so as to secure rotation on its transverse axis was held good subject-matter, although the combination of trunnions and cylinders for other purposes was well known (*Halden* v. *Hall*, [1904] 21 R. P. C. 609).

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 well-known "Puttee Gaiter" Case (*Stohwasser* 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.

Stohwasser v. Humphreys.

Commercial success does not prove invention.

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), *American Braided Wire Co.* v. *Thomson* ([1889] 6 R. P. C. 518), and *Arnot* v. *Dunlop* ([1904] 22 R. P. C. 105). In the last case the application of pocket footholds, old in driving bags, to ordinary driving aprons was upheld as valid subject-matter.

Examples of apparent analogous user sustained.

Mere evidence of commercial success, and even of increased utility, will not excuse the absence of invention (see *Stohwasser* 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 *Rickmann* 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. *Bedeker* ([1899] 16 R. P. C. 363), felt bicycle handle covers; the patentees were all unsuccessful through (*inter alia*) lack of invention, although utility and commercial success were proved.

Examples of patents not saved by commercial success.

Whenever 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 Co.* ([1876] L. R. 4 Ch. D. 607; 46 L. J. Ch. 185). In *Perry* v. *Société des Lunetiers* ([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.

Examples of patents upheld though showing small 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.

Long felt want supplied strong argument for invention.

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.

Uselessness of alleged anticipations.

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.

Methods of ascertaining novelty.

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. Under the system of examination now in force at the Patent Office, inventions of doubtful novelty are not so likely to be patented as formerly. But it must not be forgotten that not only do the authorities take no responsibility and give no assurance that the patent is valid, but the field of examination is restricted to published British Specifications of prior date, and no investigations among other published sources of information are undertaken. Therefore, although the provisions for preliminary examination are most valuable they are by no means exhaustive.

The whole of the claimed matter must be novel.

The novelty of every part claimed must be sustained in an action for infringement, and 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 *Murchland* 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."

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.

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

Plimpton v. *Spiller*.

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.

British Dynamite Co. v. *Krebs*.

In *British Dynamite Co.* v. *Krebs* ([1879] Good P. C. 88; also reported as an Appendix in 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

Examples where rule was not relaxed.

Cropper v. *Smith*.

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 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 from want of novelty, 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."

Cassel Gold Co. v. *Cyanide Gold Syndicate.*

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

Kynoch v. *Webb.*

Process claims. Where the invention is a process, the novelty is in the whole process, not in 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. Combination claims.

The broad rule with regard to novelty is that if the invention has by any means whatever become known in this country to one or more 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. General rule as to novelty.

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 (*Electro-Plating Co.* v. *Holland*, [1901] 18 R. P. C. 521). 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, 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 *Betts* v. *Menzies* ([1857-62] 10 H. L. Cas. 117; Good. P. C. 45) the patent was held

Mere experimental use or confidential disclosure is not publication.

Must not be used even experimentally for profit.

But otherwise if goods not

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 *Cornish* v. *Keene*, [1835-7] Good. P. C. 127).

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 (*Blank* v. *Footman*, [1888] 5 R. P. C. 653), and by offering for sale 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 as sample.

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 *Dearance* 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, 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

Discontinued prior user.

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

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 & Jubb* ([1887] 4 R. P. C. 18), and *re Sinnette'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), *Moseley* v. *Victoria Rubber Co.* ([1886] 4 R. P. C. 241; 55 L. T. N. S. 482), and *Electro-Plating Co.* v. *Holland* ([1901] 18 R. P. C. 521). It was said in *Daw* 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.

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 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 said that during provisional protection the invention might be "used

Publication during provisional protection afterwards abandoned.

Oxley v. *Holden.*

Lister v. *Norton.*

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* 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. As to the period of time which represents "provisional protection," Section 8, Sub-section 1, of the Act of 1883 (now modified by Section 1, Sub-section 8, of the Act of 1902) says that the applicant must leave his Complete within six months from the date of the application, and that (Sub-section 2) unless he does so the application shall be deemed to be abandoned. Section 3 of the Act of 1885 provides for the extension of time for leaving the Complete to seven months instead of six. It would therefore appear that in the case of patents dated after the 1st of January, 1905, the period of "provisional protection" is six months, capable of extension to seven months if application for extension of time for filing the Complete is made. In the case of patents of earlier date the old period of provisional protection would hold good.

Possible reading of present section.

Abandonment of Provisional.

Present period of provisional protection.

All circumstances considered, it would apparently be the best course to file the new and amplified Complete Specification accompanying the new application within six (or with extension seven) months from the date of the original application, and, if need be, by pressing representation of the facts to the Comptroller, get him to seal the patent on the new application within twelve months from the date of the original application. Such a course would seem to fulfil the requirements under the above-mentioned decisions. But in the case of important inventions it would be more prudent to eliminate risks by completing the original application and making a fresh application for the improvements.

In no case is it possible to maintain or keep alive one's claim to an invention which has been published or publicly used *under the original provisional protection* by a series of over-lapping provisional applications.

Over-lapping provisional applications.

CHAPTER VIII.

ESSENTIALS IN SUBJECT-MATTER.

Novelty as Affected by Prior Publication.

What constitutes 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.

Publication by public lecture.

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

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

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, 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—*Plimpton* v. *Malcolmson* ([1875-6] Good. P. C. 374; L. R. 20 Eq. 37); *Otto* v. *Steel* ([1885-6] 3 R. P. C. 109; L. R. 31 C. 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 *Herrburger* 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).

Mosaic of anticipations.

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 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 C. D. 230; 60 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

Hills v. *Evans.*

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."

Philpott v. *Hanbury.*

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 workman" to indicate the subsequent invention, it will suffice as an anticipation.

Skilled workman test.

A specification less complete than the plaintiff's and never used might be 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, Brown* (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 specification for that purpose does not afford a crucia

Even an insufficient specification might anticipate.

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. 364).

Résumé 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.

For those who are not content to rely absolutely on the investigations of the examiners in the Patent Office, 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 abridgements 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.

Limitation of anticipatory specifications.

By Section 2 of The Patents Act, 1902, no British specification of a date more than fifty years prior to the date of any patent granted, on an application made on or after 1st January, 1905, can be deemed to be an anticipation of a patent so granted and published. Provisional specifications of any date are absolutely barred as anticipations. But it must be remembered that the foregoing privilege attaches only to patents applied for since the 1st of January, 1905.

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 *Sirdar Rubber Co.* v. *Wallington* ([1905] W. N. 37) the directions given in the specification failed to produce a tyre sufficiently firm in the rim to give a useful result. In *Tubeless Tyre Co.* v. *Trench* ([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 the purpose for which the inventor designed it." Incidentally, this case establishes the proposition that a patentee cannot call in subsequent invention to make

Utility alone not sufficient.

Must be useful for the indicated purpose.

Failure of utility avoids the patent.

Subsequent improvement cannot be called in to

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).

make up absent utility.

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).

Utility a question of fact.

Commercial success not conclusive.

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 *Day* v. *Davies* ([1904] 22 R. P. C., at page 44). 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."

Amount of utility may be small yet sufficient.

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.

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

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

Non-utility in one claim invalidates the whole.

caused the subject-matter of two claims, and consequently the whole patent, to be held bad. In *Wilson* v. *Wilson* ([1902] 20 R. P. C. 1) the invention consisted in folding over upon itself the upper edge of a spun metal bobbin ferrule, which folded over edge, in applying the ferrule to the bobbin, was forced by pressure into the wood of the bobbin so as to hold the ferrule on by the sunken edge. Stress was laid in the specification on the advantage gained by not needing to nick or recess the bobbin with any tool to receive the folded over edge. A folded over edge at the other end of the ferrule had existed prior to the date of the patent, and a knife edge projecting at right angles at exactly the same point on the ferrule had been previously patented by the plaintiffs themselves. In practice it was found that the folded edge of the ferrule could not be forced into the substance of the bobbin, and a tool had to be used to recess the bobbin to receive the edge. It was held that non-utility for the chief indicated purpose had been established, and the patent was declared invalid. Lord Robertson said that "the invention as described in the specification had not only not been used by the alleged infringer, but it had not been used by the inventor, or, as far as appeared, by anyone else."

Non-utility in respect of ear-marked advantage.

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.

Title to be properly descriptive.

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 any 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 carried out 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); *Ree* v. *Metcalf* (1 Web. P. C. 141 n.); *Campion* v. *Benyon* (6 B. Moo. 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 title.

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 title would be "An Improved Bottle Stopper"; "Improvements in Billiard Cues," &c.

CHAPTER XI.

THE PROVISIONAL SPECIFICATION.

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

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.

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 Byles, J., said in *Newall* v. *Elliott* ([1858] Good. P. C. 326; 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] Good. 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."

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

Necessity for careful drafting of Provisional under Act of 1902.

It is apparent, in view of cases that already have occurred under the examination system now in force by virtue of the Act of 1902, that greater care and more forethought will have to be exercised in preparing Provisional Specifications than has hitherto been the case. The invention must be more precisely ascertained, and the actual advance clearly earmarked. Already in many instances the results of examination or of opposition have shown the dangers of both over laxity and over particularity in the Provisional. For example, if an applicant omits specific mention of what he might at the time consider an obvious modification of his invention, he might find himself unable successfully to oppose an after application by another inventor for that modification, or might himself be prevented from including it in his Complete by the opposition of an applicant interposing between his Provisional and Complete. On the other hand, if he mentions a modification in his Provisional and omits, or fails to elaborate it, in his Complete, he might be unable to stop an infringement based on this modification if the defendant makes capital of the fact that the modification appears to have been discarded in the Complete and therefore left derelict. An instance of this occurred in *Sandow* v. *Szalay* [1904] 21 R. P. C. 333). Here the inventor of the well-known spring dumb-bell mentioned in his Provisional "compressed air springs" as an obvious alternative to his flat or spiral metal springs. In the Complete he confined himself to a description of flat and

Feature mentioned in Provisional but dropped in Complete not within claims.

spiral metal springs, but the claims were in general terms for a divided dumb-bell with "springs or resilient means." Common sense would indicate that an inflated rubber ball was a mere equivalent for a spiral spring; but the Court of Appeal held otherwise, and thought that the inference to be drawn from the Patentee's omission to mention air springs in the Complete was that he did not intend to claim them, and had in fact discarded them. Apparently, had the patentee said nothing in his Provisional about air springs, these would have been held mere equivalents coming within the scope of his Complete and general claims.

Advantages need not be set out.

According to Mr. Justice Romer, in *Pneumatic Tyre Co.* v. *East London Rubber Co.* ([1896] 14 R. P. C. 77): "It is not necessary in the Provisional to detail the advantages of the invention."

Provisional a secret document.

The Provisional Specification remains a secret document until published with the Complete. If no Complete is filed the Provisional is deemed to be abandoned, but the Patent Office apparently preserves the Provisional for some time, as in *Pneumatic Tyre Co.* v. *English Cycle Co.* ([1897] 14 R. P. C. 851) 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.

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 8, 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 true scope of the Provisional—that is to say, does not describe and claim an invention not fairly indicated in the Provisional. If it does, disconformity would be the result, and disconformity between the Provisional and Complete Specification 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."

Examples of disconformity.

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 examples of cases in which disconformity was held to have been proved.

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.

Nuttall v. Hargreaves.

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.

Cera Light Co. v. Dobbie.

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 and claimed it as in metallic *contact* therewith. The patent was held bad for disconformity.

Brooks v. Lamplugh.

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.

Castner-Kellner v. Commercial Development Co.

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.

Tubeless Tyre Co. v. Trench.

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.

Lane-Fox v. Kensington &c. Co.

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

Legitimate development not disconformity.

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 disconformity not made out.

Lucas v. *Miller.*

Thus, in *Lucas* v. *Miller* ([1885] 2 R. P. C. 155), 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. 166), 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. 573). There is no doubt that at the date of the Provisional the inventor contemplated the application of his improved wire-edged cover to solid 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. *Balmoral Cycle Co.* ([1898] 15 R. P. C. 505) 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, L. 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. *Balmoral 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 *Proctor* 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 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. 225).

Nuttall v. *Hargreaves.*

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. He should also see to it that his Specification clearly indicates and claims just what he has invented and no more, remembering the ordeal of examination as to novelty to which Complete Specifications are now subjected. Reasonable skill and knowledge must be apparent in the preparation of the specification, and a

Reasonable skill and knowledge.

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. In *Allen* v. *Duckett* ([1893] 10 R. P. C. 397) 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 judgment 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."

Example of bad specification. *Allen* v. *Duckett*.

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 *Harman* v. *Playne* ([1807] Good. 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 pre-suppose 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.

Specification addressed to skilled persons.

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."

Construction of sufficiency of specification.

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] Good. 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. 136) 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." But lack of exactness in the description which leads to a result short of the full useful effect contemplated by the patentee will vitiate the patent on the ground of insufficiency (*Sirdar Rubber Co.* v. *Wallington*, [1905] W. N. 37).

Evident errors not fatal.

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 non-evident.

This was the opinion of Lord Westbury, L. C., in *Simpson* v. *Holliday* ([1865-6] 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 variation.

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 360). 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 Subsection 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*, [1896] 13 R. P. C. 90). 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

Advantages of drawings.

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. 185; Good. P. C. 252); but in *Otto* v. *Linford* ([1881] 46 L. T. N. S. 35; Good. P. C. 343) an obvious error in the drawing which would not have deceived an engineer was not allowed to prejudice the patent.

Hinks v. Safety Lighting Co.

Otto v. Linford.

But where the description and claim are in general terms, and so wide as to include different types of apparatus, the fact that the drawing illustrates one particular type of apparatus will not entitle the patentee to contend that his claims must be limited to the use of the particular apparatus he illustrates. Thus, in *Scott's Patent* ([1902] 20 R. P. C. 257) the description and the first claim referred to condensers generally, while the drawing showed a multitubular water condenser. The Court refused to limit the claims to condensers of this type only, and declared the patent invalid from want of novelty, condensers of other types having been used for the same purpose prior to the date of the patent.

Ambit of wide claim not limited by drawing.

On the other hand it has been held that where *an essential feature* of the invention is clearly shown in the drawings, but not referred to at all in the specification, a general claim for the combination includes and protects this essential feature (*Hattersley* v. *Hodgson*, [1904] 21 R. P. C. 517). In this case Mathew, L. J., said: "I should be loth to accept for a moment the suggestion that has been made that although a drawing may be sufficient to indicate what the patentee intended, unless he incorporated in his letterpress what he intended to convey by his drawing, his patent is invalid. There is no such rule, and I have not the least anticipation that such a rule will ever be laid down."

Essential feature illustrated but not described held within claim.

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.

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 for publication.

As the drawings attached to the specification are now reproduced by zincography, 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 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 unmistakenbly indicate the part referred to.

Provisional drawings may serve for Complete.

It should be mentioned that under Sub-section 4 of Section 5 of the Consolidated Act (Section 2 of the Act of 1886) it is provided 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.

Differentiating 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 differentiating the old from the new in a specification, especially where a combination is concerned. As Cresswell, J., said in *Gibson* v. *Brand* ([1841-2] 1 Web. P. C. 627; 11 L. J. C. P. 177; Good. P. C. 211): "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."

Present-day necessity of differentiating new from old.

In view of the powers given to the Comptroller under the present examination system the differentiating of the old from the new is desirable if the applicant desires to escape the disagreeable necessity of having references to one or more prior patents endorsed on his specification.

Macfarlane v. Price.

In *Macfarlane* v. *Price* ([1816] 1 Web. P. C. 74; 1 Stark. 199; Good. P. C. 294) 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 drawing, 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.

Foxwell v. Bostock.

So in *Foxwell* v. *Bostock* ([1863-4] 4 De G. J. & S. 298; 10 L. T. N. S. 144; Good. P. C. 200) 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. Cas. 574), in which *Foxwell* 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 differentiation may be unnecessary.

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 any 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

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." In *Patent Exploitation, Limited* v. *Siemens* ([1904] 21 R. P. C. 547) Lord Davey said: "In a patent for a combination of *well-known elements* there is no room for the common objection that the patentee has not sufficiently distinguished the old from the new, the combination itself constituting the novelty."

held not to be obligatory.

Goddard v. *Lyon.*

Hookham v. *Johnson.*

New combination of well-known parts.

Nevertheless, the old and useful rule cannot always be safely disregarded, as was 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.

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

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] Good. 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.

Inutility of alternative method avoids patent.

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 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

Construction of specifications.

Former modes of construction.

to prevail, and the practice of the Courts swung into what has been called the *benevolent* construction.

Present practice in construing specifications.

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

Chitty, J., on construction.

In *Clapper* v. *Smith* ([1884] 1 R. P. C. 81; 26 Ch. D. 700; 10 App. Cas. 249) Bowen, L. J., gives an excellent exposition of the rules governing the Courts at this date. Chitty, J., in *Lister* v. *Norton* ([1886] 3 R. P. C. 203), speaking of the construction of a specification, said: "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." The whole modern principles of construction were crystallised by Lord Davey in *Patent Exploitation, Limited* v. *Siemens* ([1904] 21 R. P. C. 549): "My lords, I disclaim putting either a benevolent or malevolent interpretation on the specification, or being astute either to uphold or invalidate the patent. I am of opinion that a specification, like any other document, should be construed by the Court according to the fair meaning of the language used, after being informed by evidence of the nature of the subject-matter, the state of knowledge at the date of the patent, and the meaning of any scientific or technical words that are found in it."

Cozens-Hardy, J., on construction.

Lord Davey on modern principles of construction.

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

CHAPTER XIII.

CLAIMS.

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).

Claims required by the Act of 1883.

The requirement of that Statute is reinforced by the Rules of 1905, which under Rule 4 (98 of Consolidation) require that "The statement of the invention claimed, with which a Complete Specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification." A marginal note on Form C (which is the Form for the Complete) draws attention to this Rule 4, and asks that "any unnecessary multiplicity of claims or prolixity of language should be avoided."

Claims must be clear and succinct.

Simple as these requirements 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.

The Comptroller has power to require that something in the shape of a claim shall be appended to the Complete, and apparently, if the Rules of 1905 are to be construed as one with the Statute, these powers are to be exercised more stringently than heretofore. It is therefore to be expected that patents granted after the 1st January, 1905, will have

Powers of Comptroller to require claims in Complete.

claims much less difficult of construction than those of earlier and existing patents. But even under present conditions, if the applicant presses for the acceptance of his claim in the form he prefers, the Comptroller has apparently no power to refuse acceptance. The utmost he can do is to insert such reference to prior patents as in his judgment would neutralise the unacceptable form of claim. Therefore to some extent, even in the case of present-day specifications, the old authorities would hold good, and, of course, in the case of patents dated prior to 1st January, 1905, these authorities are undisturbed.

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

It appears that in any case 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. 268), 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. Lord Halsbury, in *Vickers* v. *Siddell* ([1890] 7 R. P. C. 292; 15 App. Cas. 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).

Claim must refer to invention as described.

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

Object of claim is to define invention.

Harrison v. *Anderston Foundry Co.*

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. Cas. 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

Danger of "flashing" claims.

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 invention 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."

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.

Claims must not be too wide.

In *Stevens* v. *Keating* ([1847] 2 Web. P. C. 175; 19 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 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 being too wide.

Stevens v. *Keating.*

Again, in *Minter* v. *Mower* ([1837] 6 A. & E. 735; Good. P. C. 304), 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 v. *Mower.*

Minter's claim, instead of being confined to his own invention, was wide enough to cover the anticipatory claim also, and was therefore bad. The same error of claiming a useful appliance in such broad terms as to cover a principle in mechanics which was shown to be old caused the patent to be declared invalid in *Bowden's Patent* ([1904] 22 R. P. C. 49).

On the other hand, if the claim as drawn is narrower than it need have been, the Court will not expand the ambit of the claim so as to cover the ground which might have been but was not claimed. *Per* Romer, J., in *Nobel's Explosives Co., Limited* v. *Anderson* ([1894] 11 R. P. C. 128): "In order to make out an infringement it must be established to the satisfaction of the Court that the alleged infringer, dealing with what he is doing, as a matter of substance, is taking the invention claimed by the patent, not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification." So if the invention really involves a novel essence or principle, but the claim covers only the actual construction described, the Court will not stretch the claim to cover the principle. *Per* Cozens-Hardy, L. J., in *Ackroyd* v. *Thomas* ([1904] 21 R. P. C. 737): "If a patentee intends to claim a general principle, it is his duty to make that intention reasonably clear by his specification."

Court will not extend claims beyond their reasonable construction.

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

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

Or failure in alternative arrangement.

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." 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. Similarly, in *Pether* v. *Shaw* ([1893] 10 R. P. C. 293), 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. 33 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.

Simpson v. Holliday.

Pether v. Shaw.

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. *Reddaway* ([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

True meaning of claim sometimes matter for evidence.

Gandy v. Reddaway.

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.

"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 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 Gear 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. Nevertheless, where the claim is not intended to be broad and general but to refer to something the same, or practically the same, as the thing described and claimed, it is better to add the words "as described and shown" or "substantially as described and shown."

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

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] Good. P. C. 321; 8 M. & W. 806); *Otto* v. *Linford* ([1881] Good. P. C. 343; 46 L. T. N. S. 35); and *Jupe* 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 *Jupe* 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 should be for principle, coupled with mode of carrying into effect.

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., 404), a claim is also a disclaimer; but, *per* Lord Herschell, in *Parkinson* v. *Simon* ([1895] 12 R. P. C., 406), "it is no longer correct to speak of a claim as a disclaimer."

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

Apparently bad subsidiary claim not necessarily fatal.

The question as to how far a subordinate claim, *primâ 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.

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-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 (*i.e.* 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. Where the feature omitted from the claim is an essential and necessary part of the mechanism, or necessary to the continuity of an operation, the omitted feature may be read into the claim by the Court (*Tubes, Limited* v. *Perfecta Tube Co.*, [1902] 20 R. P. C. 77).

When evidently separate and independent a bad subsidiary claim is fatal.

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

Tubes, Limited v. Perfecta Co.

Examples where apparently bad subsidiary claim was upheld. *Parker* v. *Satchwell.*

Where a claim, although susceptible of being construed to have been made in gross, is plainly subsidiary to the main invention, and intended to be used only in combination with it, lack of novelty as a separate and independent thing will not cause invalidity (*per* Farwell, J., in *Parker* v. *Satchwell*, [1901] 18 R. P. C. 299). In this case the learned Judge was guided by the decision in *British Dynamite Co.* v. *Krebs*, already referred to.

Principles deducible from the cases.

If any principle can be deduced from the decisions in *Plimpton* v. *Spiller* and *British Dynamite Co.* v. *Krebs*, it might be fairly stated to consist in this: That where it is undeniable that it would be absurd and ridiculous to suppose from the then state of common knowledge *and from the contents of the specification* that the patentee could have intended to claim *per se* something which is 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 *primâ 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 Syndicate, Limited* v. *Andrews & Co., Limited.*

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. *Andrews & Co., Limited* ([1901] 18 R. P. C. 85), the plaintiff's 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 *intended* to cover the second modification in his claim, Lord Davey said: "With great respect to the learned Lord Justice, that is a *petitio principii*, and assumes the very point to be decided." The result was that the defendants, who were using the second but not the first method, were held not to have infringed.

Omitted part may be read with claim where essential to continuity of operation.

The Court of Appeal may have had this direction in mind when dealing with an apparently similar question in *Tubes, Limited* v. *Perfecta Tube Co.* ([1902] 20 R. P. C. 77). Here the Court of Appeal held the patent bad because they thought there was no ground for inferring that the water cooling and expelling apparatus was *intended* to be included in the claim, there being no specific mention of such apparatus in the claim. But the House of Lords differed from them, and held that this apparatus, being an essential step in the process, was intended to be included in the claim, and upheld the patent.

The apparent contradiction is, however, susceptible of explanation. In the "Gas Engine" Case there were two independent modes of ignition, of which one only was claimed; whereas in the "Tubes" Case the water cooling and expelling were essential and constant elements in the continuity of the process, which would have been incomplete without them.

The presumption is that no two claims are co-extensive.

It is presumed that no two claims are co-extensive (*per* Lord Esher, M. R., and Kay, L. J., in *Parkinson* v. *Simon*, [1894] 11 R. P. C. 493). Therefore, when a patent has several claims, these claims must be construed so as to give an effective meaning to each. But if a claim, when exhaustively construed, evidently covers and means no more than a preceding claim, what is its effect? The answer seems to be found in the dictum of Brett, L. J., in *Plimpton* 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.

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

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

Where a part of a combination is claimed separately and *per se*, that part by itself being useless and fulfilling no useful function, the claim is bad (*per* Smith, M. R., in *Wilson* v. *Wilson*, [1900] 18 R. P. C. 152).

Combinations may be either of moving parts or of chemical agents.

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 fit subject-matter for claims.

Combination of materials.

When the invention refers to a combination of materials mechanically mixed or combined so as to produce a new concrete or a new alloy or a waterproof fabric, or where the combination is chemically effected so as to produce a new dye or agent, the proper claim to frame is for the special product made from the materials and in the manner described.

Novel parts of combinations.

When the invention refers to combinations of machinery not only should the combination as a whole be claimed, but those parts of the combination which are new should also be separately claimed for the specific purpose. It has, however, been held that where a part of a combination which is undoubtedly new has not been so separately claimed, but figures only as an *integer* in the combination, such part cannot be taken and used for a similar purpose, even though wrapped up in a different combination.

Differentiation of essential novel part.

This was the dictum of Lord Campbell in *Lister* v. *Leather* ([1857-8] Good. P. C. 283; 8 E. & B. 1004), and a similar view was taken in *Proctor* v. *Bennis* ([1887] 4 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.

Rules for the preparation of claims.

The following rules may be useful as guides in 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 unmistakeably 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 as described, and the method of producing it should also be claimed if that also involves invention and is novel.

(5) In combination claims, if the invention consists purely of a combination of old parts, the combination only should be claimed. If the combination contains new parts, or parts new as applied to the purposes of the invention, these parts also should be separately claimed for the indicated purposes.

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 invites 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.

Effect of examination system on oppositions.

There is no doubt that the system of examination as to novelty now in force under the Act of 1902 has affected and will materially affect cases of opposition to the grants of patents. The cutting down of specifications to the actual invention concerned, and the introduction of general statements as to public knowledge, with, if need be, special references to prior patents, are enforced by the Comptroller in such a manner as to satisfy many persons interested, who would otherwise have entered opposition.

Nevertheless the provisions in the Statute as to oppositions remain unaltered, and the practice is untouched

except in this respect that the Comptroller and Law Officer may possibly hold themselves relieved from the reluctance they formerly had to insert special references to an opponent's patent if reasonable grounds for such special reference exist outside of the matter disclosed by the Comptroller's examination. The determination of the Office is that the general public must not be hoodwinked or left in the dark as to the true meaning and ambit of the applicant's claims. It is right that it should be so, and the Patent Act of 1902 has this for its chief object.

With this explanation and reminder, the questions of who may oppose a grant, and upon what grounds opposition can be based, may now be considered.

Persons entitled to oppose.

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

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 *Reg.* v. *Comptroller, ex parte Tomlinson* ([1899] 16 R. P. C. 233; [1899] 1 Q. B. 909), 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 is the legal representative.

(2) That the invention has been patented in this country on an application of prior date.

(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 under the second ground 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*, [1896] 13 R. P. C. 627).

Opponent on first ground cannot include patents in which he has no interest.

But where a grant is opposed upon the ground that the applicant has obtained the invention from the opponent, and also upon the ground that the invention has been patented on an application of prior date, the opponent must be able to show an interest in the prior patent, or one of the prior patents, upon which his second ground of opposition is based (*J. & J's. Application*, [1902] 19 R. P. C. 555).

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 of 1903 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 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 thus opposing (*re L'Oiseau and Pierrard*, [1887] Griff. A. P. C. 36; Good. O. C. 75). 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 76 of the Patents Rules 1903 to amend either before or at the hearing (see *re Airey*, [1888] 5 R. P. C. 348; *re Lake*, [1887] Griff. A. P. C. 35; Good. O. C. 10; *re Faucett*, [1889] Good. O. C. 10; *re Daniel*, [1888] 5 R. P. C. 413; Good. O. C. 9; *re Welch*, Good. O. C. 10; *re Jones*, Good. O. C. 11; Griff. A. P. C. 33).

Applicant whose Complete Specification has been accepted may oppose.

Practice in amending slight defects in notice of opposition.

Declarations by opponent in support of opposition.

On receiving the notice of opposition the Comptroller transmits the unstamped copy to the applicant. If the opponent intends to follow up his notice of opposition by 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 copies 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 copies to the opponent; and within a further period of fourteen days the opponent may leave declarations in reply, again sending copies to the applicant. 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.

Declarations by opponent in reply.

Time for filing declarations may be extended; but never to opponent who alleges fraud.

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 33 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 concise as possible: otherwise if the opposition goes to appeal, the Law Officer may mulct the diffuse declarant in costs (*Brand's Application*, [1895] 12 R. P. C. 102).

Declarations should be concise.

Declarations not always necessary.

As to the advisability or non-advisability of filing declarations, it may be said that this depends greatly on the grounds of opposition. Where the grounds are simply a reference to a prior patent, declarations are seldom necessary, as the question will, after all, be decided upon a comparison of the two specifications. But where the grounds are that the applicant obtained the invention from the opponent, or wherever fraud is alleged, declarations are absolutely necessary as evidence in support. If no evidence under this head is filed within the time stated, then under Rule 33, the opposition is deemed to have been abandoned. Under Rule 77 an enlargement of time for filing evidence other than that referred to in Rule 33 may be obtained. Rule 34 provides that where the ground of opposition is that the applicant has obtained the invention from the opponent or his legal representative, the Comptroller

Power of Comptroller to request attendance of declarants.

may request or allow any person who has made a statutory declaration in the matter to attend before him at the hearing of the case and make oral explanations with respect to such matters as the Comptroller may require.

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

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.

Thus, in *re Jones* (Griff. A. P. C. 33; Good. O. C. 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. All models or samples referred to in the declarations of both sides should be constituted exhibits.

Exhibits.

Illustrative samples.

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 Application* (Griff. P. C. 293; Good. O. C. 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 (Gorst) said it assisted him very much to see the specimen, and he would look at it to better his understanding of the drawings.

Opposition may be founded on expired patent.

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

Hearing before Comptroller.

When the evidence is complete 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 should begin, although in practice, the Comptroller is not accustomed to vary the order of beginning, even where fraud is alleged. At the hearing, the opponent must confine himself strictly to the grounds of opposition stated in his notice. Fresh grounds of opposition cannot be sprung without notice upon the applicant (*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.

Opponent confined to grounds of opposition in notice.

Notice of additional publications.

According to Rule 41 of 1903, if either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, or in any statutory declaration filed in the case, he must give five days' notice to the other party and to the Comptroller of his intention, and must specify the publication to which he means to refer.

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. The attendance of the parties or their representatives at the hearing before the Comptroller is not an absolute necessity. If either should not desire to be heard he should let the Comptroller know this as soon as possible. But either of the parties may attend in the absence of the other, in which case the Comptroller will hear him. After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing the Comptroller will decide the case and notify his decision to the parties. (See Rule 41.)

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.

Rules regulating appeals to Law Officer.

The Rules regulating the practice and procedure on appeals to the Law Officer are as follows:—

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

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

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

4. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the Law Officer's clerk all the papers relating to the matter of the application in respect of which such appeal is made.

5. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the Law Officer.

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

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

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

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

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

11. Where the Law Officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

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

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

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

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 allowed new evidence before Law Officer.

In *re Hampton and Facer* (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 L. 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.

Cross appeal.

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.

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.

Rules as to further evidence.

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.

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

Further consideration of persons entitled to oppose.

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 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 Glossop* (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 Everitt* (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 licence 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.

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).

Opponent must show that invention has been claimed.

Costs.

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.

First ground of opposition: Invention obtained from applicant.

This ground of opposition only holds good in respect of transactions in this country. If the information has been acquired abroad, and no fraud has been practised within the jurisdiction, 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).

Only transactions in this country considered.

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.

Neither the Comptroller nor the Law Officer will stop a patent except upon evidence so conclusive that in their

Test of evidence in fraud.

Patent might be issued jointly to applicant and opponent.

estimation no jury could fail to find for the opponent (*re Stuart*, [1892] 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 Luke* (Griff. P. C. 294), *re Garthwaite* (Griff. P. C. 284), and *re Evans and Ottway* (Griff. P. C. 279).

Declarants may be cross-examined before Law Officer.

Although Rule 34 of the Patent Rules, 1903, enables the Comptroller to "request or allow" a declarant to attend at the hearing and "make oral explanations" the Rule gives him no power to compel such attendance and no power to subject the declarant to cross-examination. Accordingly when the evidence is conflicting the Comptroller usually adopts 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 Ottway, supra*).

Master and servant.

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. O. 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

Re Heald.

David and Woodley.

completed, these suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them." In the later cases of *Richmond* v. *Wrightson* ([1904] 22 R. P. C. 25), and *re Smith's Patent* ([1904] 22 R. P. C. 57), the same principle was upheld. The relationship of master and servant in the evolution of an invention was also considered in the 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 Cumming* (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 Neuman*, [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

Validity of opponent's patent never considered.

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.

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 were formerly difficult to obtain from 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). Now that the insertion of special

Slight alteration may serve in lieu of disclaimer.

references under the existing examination system are so common and so beneficial, the Comptroller or Law Officers will probably insert such a reference even where the opponent's patent is not a master patent, if it should seem advisable for the guidance or protection of the public.

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, as already observed, the special reference has hitherto been sparingly used. As was said by Webster, A.-G., in *re Guest and Barrow* ([1888] 5 R. P. C. 313; Good. O. 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." But under present practice the general applicability of this rule is likely to be largely relaxed unless the applicant is willing to make such concessions as will make special references unnecessary.

When a special reference may be ordered.

One of the principles still governing the insertion of such special references is 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 Hoskins*, Griff. P. C. 291), a special reference will be ordered. Webster, A.-G., practically adhered to this rule in the 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 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.

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 is inserted. Webster, A.-G., in *re Hill* ([1888] 5 R. P. C. 599),

Where opponent's is master patent.

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 Thornborough and Wilks* ([1896] 13 R. P. C. 115), 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.

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

But the mere validity of opponent's patent cannot be gone into.

When an opponent represents his patent to be a master patent "it is his duty," said Webster, A.-G., in *re Southwell and Head* ([1899] 16 R. P. C. 361), "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

But limits of master patent deducible from claims.

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. 484) 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."

Where applicant's invention is narrow master patent to be liberally construed.

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., 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).

Reference to expired patent.

Although the patent quoted by the opponent may have 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.

Where an invention is merely an improvement upon previously patented inventions, general words capable of being construed to mean or cover anything already patented must not be used in the claims (*Hamilton's Application*, [1901] 19 R. P. C. 33).

It must, however, be remembered that now that the Patents Act of 1902 enables the Comptroller, on his own initiative, to insert special references to prior patents, the applicant who finds his grant opposed cannot look for any particular tenderness as regards specific references, if the circumstances of the case at all warrant them; nor need the opponent's be a master patent if, in fact, it contains matter which, without disclaimer or specific reference, might be considered as included wholly or in part in the applicant's specification and claims.

Quantum of applicant's invention sometimes considered.

Although apparently the Law Officer will not consider whether or not the applicant's invention is subject-matter for a patent unless on an appeal by an applicant from the decision of the Comptroller on the point of bad subject-matter, 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*, [1892] 9 R. P. C. 487). This discretion of the Law Officer to adjudicate upon the quantum of the applicant's invention was 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*.

Subject-matter.

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 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*), and in *Crist's Application*, ([1903] 20 R. P. C. 475.) As Finlay, S.-G., said when

But residuum must have been within original claim.

refusing a patent in *re Lupton and Place* ([1896] 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 Prevost* ([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. See also *Crist's Application* (*supra*). In *re Garnett* ([1899] 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, even where the applicant's specification contains something that may distinguish his alleged invention from the patent of his opponent, he will not be allowed to amend his claim by introducing or substituting such distinguishing matter, still less so when the distinguishing feature left is not to be found in the Provisional (*Lancaster's Application*, [1902] 20 R. P. C. 366).

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.

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

The doctrine of mechanical equivalents may be considered.

parts, the application will be refused (*per* Clarke, S.-G., in *re Haythornthwaite*, [1889] 7 R. P. C. 70); and in *re Smith* ([1896] 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 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. In *re Hudson's Application* ([1904] 22 R. P. C. 218) the same ground of opposition was considered and acted upon.

Re Hetherington.

But applicant still allowed

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).

to develop invention under Provisional.

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 Perrot*, [1898] 15 R. P. C. 257).

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

Bogus oppositions entered collusively with the applicant for the purpose of delaying the sealing for ulterior purposes may result in the grant of the patent being refused (see *A. B.'s Application*, [1902] 19 R. P. C. 403, 556).

Bogus oppositions.

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.

Under the Patent Rules of 1905 an additional fee of £1 is payable on the sealing of the Patent (see Rule 12: viz., 5B of Consolidation). Form X. is made use of for this purpose, and the request to seal must be made on or before the last day on which a patent can lawfully be sealed.

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 should be effected within fifteen months from the date of application, except 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. But delay artificially created by the applicant may cause refusal to seal (*A. B.'s Application*, [1902] 19 R. P. C. 403, 556).

Patent may be issued to legal representative of deceased inventor.

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 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).

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

	£	s.	d.
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
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

If these periods have passed and the fee remains unpaid the patent can only be revived by a special Act of Parliament.

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

Joint interest.

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).

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.

Steers v. *Rogers.*

The decision in *Mathers* v. *Green* was approved and followed in the House of Lords in the more recent case of *Steers* v. *Rogers* ([1893] 10 R. P. C. 245; [1893] App. Cas. 233; 63 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 in respect of 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.

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.

Register of Patents.

Entries on the Register.

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.

Documents affecting patent only registrable after sealing.

No notice of any trust can be entered on the Register (*Haslett* v. *Hutchinson*, [1891] 8 R. P. C. 457); 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.

Notices of trusts not entered on Register.

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

Query as to agreements made before application.

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. 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 application by the party prejudiced, be expunged by the Court (*Horsley and Knighton's Patent*, [1869] L. R. 8 Eq. 475; 39 L. J. Ch. 157).

Entries by joint patentees.

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*, [1890] 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, licence, 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, licence, 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 *ex parte New Ormonde Cycle Co.*, [1896] 2 Ch. 523; 13 R. P. C. 475). In the case of a body corporate 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. The Register is *primâ facie* evidence of any matters directed or authorised to be inserted

Certified extracts *prima facie* evidence.

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). Any person interested in a particular patent may, on payment of a small fee, leave a request at the Office to be informed when any attempt is made to register any dealings in connection with the patent in question (see Comptroller's letter to Kekewich, J., in *Viola* v. *Sharpe*, [1904] 22 R. P. C. 24).

Duplicate Letters Patent.

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 or issued on payment of a fee of £2.

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 of 1883, and the Complete Specification might similarly be required to be amended under Section 9 of the same Act or under Section 1 of the Act of 1902. The former 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. The latter amendments, under Section 1 of the Act of 1902, are those which may be required as a result of examination. 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.

Insufficient description.

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 (*Nordenfelt'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 (*Nairn's Patent*, [1891] 8 R. P. C. 444; *Lang's Patent*, [1890] 7 R. P. C. 471).

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*, [1895] 13 R. P. C. 24).

Error in claim.

General claims for subordinate features cannot be turned into one claim for a combination; nor can a claim for one feature be enlarged by the addition of another feature so

Claim for combination cannot be made claim for details.

as to make it a combination claim including both, especially where the proposed addition has not been claimed or has previously been disclaimed (*Hattersley and Jackson's Patent*, [1904] 21 R. P. C. 233). The Law Officer in this case expressed an opinion which does not seem unfavourable to the contention that in certain circumstances separate claims might by amendment be consolidated into one combination claim. *Kelly* v. *Heathman* ([1890] 7 R. P. C. 343), was quoted as an example. A claim for a combination cannot be altered to a claim for details described in the specification (*Serrell'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. It has sometimes been contended that to get at the true meaning of an amended specification the text of the unamended specification might be referred to. In delivering judgment in *Moser* v. *Marsden* (*supra*), Lord Watson compared parts of the

amended with the unamended specification, and from this it was argued in *Birmingham Pneumatic Tyre Co.* v. *Reliance Tyre Co.* ([1902] 19 R. P. C. 312) that it was legitimate to do so for the purpose of getting at the true meaning of the amended specification. But in *Hattersley* v. *Hodgson* ([1904] 21 R. P. C. 517) Collins, M. R., declined to allow any reference to the unamended specification, basing his ruling on the commercial contract case of *Inglis* v. *Buttery* (3 App. Cas. 552). Still it is by no means clear that the struck out parts of an amended specification may not for certain purposes be referred to (*per* Buckley, J., in *Klaber's Patents*, [1904] 22 R. P. C. 10).

Reasons for amendment.

Request to amend may be corrected.

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 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. 3), 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.

The request for leave to amend a specification must be signed by the applicant or patentee, and must contain an address for service in the United Kingdom. When not made in pursuance of an order of the Court or a Judge the request must, where a patent has been sealed, contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. This latter provision is new, and appears in Rule 42 of the Patents Rules, 1903, apparently to obviate such an accident as became apparent in *Brooks and Co.* v. *Lycett* ([1904] 21 R. P. C. 651), where a patent had been amended under the mistaken idea that the action had been discontinued, whereas it was still pending though asleep. The amendment thus obtained was held invalid.

Procedure in amending.

The amendment or amendments should be shown in red ink on an officially 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

Advertisement.

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 or 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. 568). In *Bell's Patent* (Good. O. 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 (*Brooks & Co. v. Lycett*, [1904] 21 R. P. C. 651) 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.

> "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."

Section 19.

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.

By disclaimer only.

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. 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 Court of Appeal will not interfere with the exercise of the Judge's discretion unless satisfied that injustice has

Leave usually granted.

Sometimes refused.

Conditions within discretion of Court.

been done (*Woolley* v. *Broad*, [1892] 9 R. P. C. 492; *Wilson Bros.* v. *Wilson & Co.*, [1899] 16 R. P. C. 515; *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 *Fusee 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. Where application to amend has been made, there being at the time no action for infringement or petition for revocation pending, the application to amend may proceed without the leave of Court under Section 19, notwithstanding that an action for infringement or proceeding for revocation may *subsequently* have been commenced (*Woolfe* v. *Automatic Picture Gallery, Limited*, [1902] 19 R. P. C. 425). But an amendment obtained while an action or petition is effectively pending, although dormant, is invalid (*Brooks and Co.* v. *Lycett*, [1904] 21 R. P. C. 651).

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 (*Fusee Vesta Co.* v. *Bryant & May*, *supra*) unless under exceptional circumstances (*Codd* v. *Bratby*, [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.

Deeley v. *Perkes*.

Exceptional circumstances might, however, bring about the imposition of more severe conditions. For example, in *Deeley* v. *Perkes* ([1896] 13 R. P. C. 581) 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 Pitt's Patent*, [1900] 17 R. P. C. 745), thought himself bound by the decision in *Deeley* 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 *Deeley* 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).

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

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.

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.

In *Corrigall* v. *Armstrong Whitworth* ([1903] 20 R. P. C. 523) the plaintiff had been aware of the infringement for nine years, but had delayed taking action although he had carried on correspondence about it. Swinfen-Eady, J., gave leave to amend, but only on terms that no relief be given in the action for any infringements committed prior to the action.

Present practice as to terms.

The present general tendency of the Courts seems to be in favour of imposing terms in the bulk of cases that no action shall be brought or maintained for infringement of the patent in respect of any goods made prior to the date of the order (*Jandus Arc Lamp Co.* v. *Arc Lamp Co.*, [1904] 21 R. P. C. 115).

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 (*Kane* v. *Boyle*, [1901] 18 R. P. C. 325). Such damages are never given in cases where the patent has prior to amendment 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 Dellwik's Patent*, [1896] 13 R. P. C. 591).

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. O. C. 64), 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 *Frearson* v. *Loe*, [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.

More user is infringer.

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.

User in foreign vessel.

Necessary use of an infringing article in a foreign vessel touching at a British port is not an infringement unless the vessel is under the flag of a Foreign State which denies corresponding privileges to British vessels (Patent Act, Section 43).

Sale or offering for sale is infringement.

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 a dictum of 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 *Frearson* v. *Loe* (*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). Even where the infringement has been slight, say to the extent of one article only, and has been discontinued, an injunction has been granted. As was said by Cotton, L. J., in *Proctor* v. *Bailey*, [1889] 6 R. P. C. 538: "When a patent is infringed the patentee has a *primâ facie* case for an injunction, for it is to be presumed that an infringer intends to go on infringing, and that the patentee has a right to an injunction to prevent his doing so." Again, if there has not been any infringement but an intention to infringe has been shown, an injunction will be granted.

Harsh proceedings not encouraged.

But the Court will not countenance harsh proceedings, or proceedings maintained vindictively or obviously to make costs. Therefore where full submission has been made, and it is manifest the defendant has no intention of continuing the infringement — where, in short, the defendant has offered all the plaintiff is entitled to—no injunction will be granted, and the defendant may get costs from the date of his offer (*Proctor* v. *Bailey*, *supra*; *Jenkins* v. *Hope*, [1895] 13 R. P. C. 57).

Infringement of part of combination.

The sale of a component part (not *per se* protected) of a patented combination, even where the vendor knows that the purchaser intends to use the article for the purpose of infringing the patent, is not an infringement by the vendor of the part (*Sirdar Rubber Co.* v. *Wallington*, [1905] W. N. 37; *Dunlop Pneumatic Tyre Co.* v. *Moseley & Sons*, [1904] 21 R. P. C. 274; *Townsend* v. *Haworth*, [1875] 12 Ch. D. 831 *n.* followed). But a vendor selling all the component parts of a patented combination ready to be put together would apparently infringe (*per* Pearson, J., in *United Telephone Co.* v. *Dale*, [1883] 25 C. D. 778).

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 Car 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). But where the defendant had fitted a rubber tyre to a rim the section of which was patented, and which rim had been supplied by the plaintiffs, no infringement was held (*Sirdar Rubber Co.* v. *Wallington*, [1905] W. N. 37).

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 personal 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 on a condition as to use or sale (*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. 272).

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, 442; 6 H. of L. 319; 34 L. J. Ch. 289, 291).

Indirect infringement: use of patent materials abroad in making imported product.

In *Saccharin Corporation, Limited* v. *Anglo-Continental Works, Limited* ([1900] 17 R. P. C. 307; [1901] 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. *Cunard Co.*, [1889] 6 R. P. C. 398), but mere custom house agents not having possession or control of the goods are not (*Nobel* v. *Jones*, [1882] 8 A. C. 5).

Carriers.

Customs agents.

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 dispute (see Section 117, Sub-section 1, and *Reg. v. County Court Judge of Halifax*, [1891] 8 R. P. C. 338; 60 L. J. Q. B. 550).

Action for infringement.

Threats.

Clearing for action.

Preliminary negotiations.

Chancery Division for patent actions.

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

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

Endorsement of writ.

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. If the defendant is neither a British subject nor in British dominions, leave may be obtained to serve him with notice of the writ, and Order XI., Rule 4, indicates the evidence which should be given in support of an application to serve such notice. In conjunction with this Rule the observations of Lords Macnaghten and Davey in *Chemische Fabrik* v. *Badische Anilin Fabrik* ([1904] 21 R. P. C. 539) as to the nature of such evidence should be carefully read. As to what may constitute domicile, where a Foreign corporation exhibited a car at the National Cycle Show in London, service of the writ upon the person in charge of the stand was held good (*Dunlop Co.* v. *Actien Gesellschaft &c.*, [1902] 19 R. P. C. 46).

Service abroad.

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 (*Sheehan* v. *Great Eastern Railway Co.*, [1880] Good. P. C. 425; *Day* v. *Davies*, [1904] 22 R. P. C. 34). 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 (*Renard* v. *Levinstein*, [1864-5] 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. Apparently an assignee might sue alone for damages for infringements committed before the date of his assignment if he succeeds to the rights and property of his predecessor in title (*United Horse Nail Co.* v. *Stewart*, [1888] *per* Lord Macnaghten on p. 269 of 5 R. P. C.). But it would be wise to join the assignor.

Co-owner.

Licensee.

Assignee.

Joinder of assignor.

Unregistered assignee may sue.

When the plaintiff is an assignee it is not essential that his assignment should have been registered. Section 77 of the Act of 1883 differs from the corresponding section of the Act of 1852, under which *Chollett* v. *Hoffman* ([1857] 7 Ell. & B. 686) and *Hassall* v. *Wright* ([1870] L. R. 10 Eq. 509; Good. P. C. 229) were decided. *Ihlee* v. *Henshaw* ([1886] 3 R. P. C. 15) decided that a legal assignee may sue, although not on the Register. But a mere equitable assignee, for example, a person to whom the benefits of an invention provisionally protected had been assigned before the grant of the patent, cannot sue without joinder of the registered owner (*Bowden's Syndicate, Limited* v. *Herbert Smith & Co.*, [1904] 21 R. P. C. 438).

Equitable assignee may not.

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).

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. 398). A corporation, and also its servants, can be sued for infringement.

Entering appearance by defendant.

The defendant should enter an appearance within eight days. 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

Interlocutory injunction.

Interim injunction never granted where defendant discontinues.

established, the plaintiff is, generally speaking, entitled to an interlocutory injunction (*Shillito* v. *Larmuth*, [1884] 2 R. P. C. 1; Jessel, M. R., in *Dudgeon* v. *Thompson*, [1877] L. R. 3 App. Cas. 34). The same may also be said where the validity of the plaintiff's patent has been upheld in a former action (*Heine* v. *Norden*, [1904] 21 R. P. C. 513), 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 (*Spencer* v. *Holt*, [1903] 20 R. P. C. 142; *Holophone, Limited* v. *Berend*, [1898] 15 R. P. C. 18). Undue delay in bringing an action after knowledge of the infringement will also prejudice the plaintiff's claim to an interlocutory injunction (*Borill* v. *Crate*, [1865] L. R. 1 Eq. 388; *North British Rubber Co.* v. *Gormully Co.*, [1894] 12 R. P. C. 17; *Leonhardt* v. *Kallé*, [1894] 11 R. P. C. 534), unless there are special circumstances which excuse delay (*United Telephone Co.* v. *Equitable Telephone Co.*, [1888] 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. *Kallé*, *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. Cas. 61).

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.

Even where the defendant appears and consents to an injunction the Court may still use its discretion. For example, in *Dover, Limited* v. *New Tornend Cycle Co.*, [1904] 21 R. P. C. 135), Buckley, J., said: "I have recently heard that sometimes in patent cases injunctions are taken by consent upon terms which are arranged between the parties, and then these injunctions are advertised as if they had been granted by the Court in

Undertaking by defendant in lieu of injunction.

an opposed matter. That ought not to be done. 'The defendant appearing and undertaking' of course precludes that."

In this case the order was drawn in the form suggested by the Judge.

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 plaintiff possesses a certificate that the validity of his patent has been challenged 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. *Chisholm*, [1896] 13 R. P. C. 488.)

Statement of claim.

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

Contents of statement of claim.

Certificate of validity if existing should be pleaded.

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 infringement are not admitted they must be proved.

Particulars of breaches to contain alleged instances of infringement.

The allegations of infringement should be, generally speaking, unqualified. Such words as "in particular" or

Particulars should, as a rule, be unqualified.

"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).

The defendant must also deliver with his defence, and in accordance with Section 29, Sub-section 2, particulars of objections to the patent.

Particulars of objections should clearly point out and limit grounds for attacking validity of 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. As far as anticipatory specifications are concerned, it must be remembered that where the plaintiff's patent has been applied for and granted since the 1st of January, 1905, no British specification of older date than fifty years back from the date of the plaintiff's patent can be deemed to be an anticipation (Section 2 of The Patents Act, 1902). If the prior anticipatory specification or publication cited by the defendant 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.

Scotch practice.

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). 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. 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 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, 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.*, [1900] 18 R. P. C. 4).

Should indicate the claims attacked.

Present practice in applications for further and better particulars.

Prior publications.

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*, [1889] 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.

Prior user as an objection.

No particulars need be given of general common knowledge.

Holliday v. *Heppenstall.*

Prior specifications cited are part of common knowledge.

A specification indicated in the particulars of objections may be referred to at the trial on the question of the state of public knowledge (*Sutcliffe* v. *Abbott*, [1903] 20 R. P. C. 50; see also *English and American Machinery Co.* v. *Union Boot Co.*, [1894] 11 R. P. C. 367). If he

Disconformity.

pleads disconformity the defendant must point out exactly where the Complete Specification differs from the Provisional (*Heathfield* v. *Greenway*, [1893] 11 R. P. C. 17); see also directions of Cotton, L. J., in *Crompton* v. *Anglo-American Brush Co.*, [1887] 4 R. P. C. 200). If he pleads

Non-utility. Insufficiency.

non-utility or insufficiency he ought to point out the portion he is prepared to prove inoperative, or the exact parts of the specification he contends to be insufficient (*Heathfield* v. *Greenway*, *supra*; *Crompton* v. *Anglo-American Brush Co.*, *supra*). As a rule particulars of non-utility are not ordered.

Denial that plaintiff is true and first inventor.

Where the defendant denies that the plaintiff is the true and first inventor it is not customary to order the defendant to state who is, unless fraud is alleged. The plea is usually an idle one. The meaning of it generally is that the prior patentee or prior user (cited in another paragraph) is the first inventor. No other evidence than this on the bare plea would be admitted at the trial.

Fraudulent obtaining from real inventor.

If the plaintiff is accused of having wrongfully obtained the invention from another, the name and address of the alleged true inventor must certainly be given. The more exact and full the defendant is in his particulars of objections the less he is 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 prior grant might be pleaded.

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 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. The question might be asked whether the plaintiff should be allowed by the Court to attack the validity of a patent belonging to a third person not a party to the action and having no notice?

Section 26, Sub-section 3.

It is doubtful whether particulars of such prior grant would be ordered by the Court. The point was raised

Query whether particulars

of prior grant would be ordered.

but not settled in *Birmingham Tyre Syndicate* v. *Reliance Tyre Co.* ([1900] 17 R. P. C. 277). Personally the writer is inclined to think that if it were a question of serious embarrassment to the plaintiff particulars would be ordered. These claims of the plaintiff, against which the alleged prior grant is directed, must certainly be specified (*Birmingham Tyre Syndicate* v. *Reliance Tyre Co.*, *supra*).

Defence under Statute of Monopolies.

The defences indicated practically exhaust the grounds by which a defendant may seek to justify his conduct. Other points have been raised, but without avail. In *Badische Fabrik* v. *Thompson* ([1904] 21 R. P. C. 473) the defendants, while admitting the validity of the patent, pleaded that the patentee did not, and never intended to, manufacture in this country, and only made use of his patents to prevent others from doing so, and that he exacted exorbitant prices for the dyestuffs. The contention did not impress the Court.

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

By summons and sometimes at trial.

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.

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*, [1895] 12 R. P. C. 530; 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 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 occasioned by the amendment (*Parker* v. *Maignen*, [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* ([1899] 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.,

Form of order in the case of repeated amendments.

Wilson v. *Wilson.*

differentiated this case from that of *Ehrlich* v. *Ihlee* ([1887] 4 R. P. C. 115), which was relied on by the appellants, 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.

Notice of trial.

Notice of trial given by a defendant consequent to the non-delivery of a reply by a plaintiff is not "a proceeding in the action," which by Rule 1 of Order XXVI. prevents the plaintiff from discontinuing his action under that Rule by a notice served after the receipt of the defence.

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.*, [1868] 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 (*Germ Milling Co.* v. *Robinson*, [1884] 1 R. P. C. 217). The defendant may resist such an order on general grounds, and particularly if he practices any particular 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. The solicitors of the parties may arrange for an inspection without obtaining an order, and the costs of such inspection, *if shown to be necessary*, may be allowed to the successful party (*Ashworth* v. *English Card Co.*, [1904] 21 R. P. C. 353).

Inspection without order.

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.

Interrogatories.

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 rarely 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 (*Hoffman* v. *Postill*, [1869] L. R. 4 Ch. 673). See also Farwell, J., in *General Electric Co.* v. *Safety Lift Co.* ([1903] 21 R. P. C., on p. 114).

Province 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 (*Hoffman* 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 defendants 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 *Benno 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. General admissions in reply to specific questions are to be discouraged. In *Wilson* v. *Wilson* ([1902] 20 R. P. C. 1) the defendants were allowed to admit generally that they had done the acts suggested in the interrogatories. At the trial the defendants contended that their general admissions were subject to a reservation of their own upon the construction of the plaintiff's patent. When this became apparent, Lord

General admissions to interrogatories.

Halsbury said: "I do hope we shall have no more admissions in this form. If you mean to make an admission you had better make one in plain terms" (see p. 14 of Report).

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. Summons for discovery by defendant must stand over till after defence is delivered (*Woolfe* v. *Automatic Gallery*, [1902] 19 R. P. C. 161).

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 (*Bown* v. *Sanson*, [1888] 5 R. P. C. 510); see also 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.

Mode of trial.

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.

Assessor.

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.

Proof of infringement.

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

Expert evidence.

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).

Expert must not construe specification.

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.

Evidence on mechanical equivalents.

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.

Evidence as to insufficiency.

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.

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 *Barcroft* v. *Smith* ([1896] 14 R. P. C. 172), where unwary cross-examination elicited proof of an anticipation of the plaintiff's patent which not did appear in the particulars of objections, the surprised party should apply 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.

Adjournment on surprise evidence.

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 *Haggenmacher* v. *Watson*, [1897] 14 R. P. C., at p. 634, line 6).

New trial on ground of surprise.

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.

Action may be remitted to a referee.

The defendant may in certain circumstances be estopped from denying the validity of the plaintiff's patent. This

Estoppel.

is so if the defendant has submitted to judgment in a previous action for infringement of the same patent (*Goucher* v. *Clayton*, [1864-5] Good. P. C. 214); or if he has worked the patent in partnership with the plaintiff (*Muntz* v. *Grenfell*, 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. Cas. 249).

Assignment by bankrupt's trustee not estoppel.

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 (*Daw* 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 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. *Ancoats 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.

Results of judgment for plaintiff.

Effect of result of subsequent judgment on injunction.

More manufacture without sale is infringement.

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 (*Vavasour* v. *Krupp*, [1870] L. R. 9 Ch. D. 351). But the defendants cannot set off the value of such

Goods delivered up are not plaintiff's property.

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).

Only infringing part delivered up.

Damages.

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. *Todal 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 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 Retort Co.* v. *Mayor of Salford*, [1897] 14 R. P. C. 450).

Not merely loss of profit.

Different persons liable.

Account of profits.

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 cost 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*, [1889] 41 Ch. D., at p. 493; *re De Falbe*, *Ward* v. *Tyler*, [1901] 1 Ch. D. 523). It seems that an agreement of solicitors as to shorthand notes is

Shorthand notes.

Between solicitor and client.

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 the 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.

Costs of inspection without order.

The costs of inspection of apparatus, the subject-matter of the action, will not be disallowed merely because the inspection has been arranged between the solicitors of the parties without an order for it having been obtained under Rule 3 of Order L. of the Rules of the Supreme Court (*Ashworth* v. *English Card Co.*, [1904] 21 R. P. C. 353).

Three counsel.

Where the case is heavy the costs of three counsel may be allowed, and the Court will not, as a rule, interfere with the discretion of the Taxing Master in allowing items unspecified in the Rules of the Supreme Court (*re Burroughs Wellcome's Marks*, [1904] 22 R. P. C. 164).

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 particulars of breaches and objections.

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. *Chisholm* ([1896] 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. 304) a certificate was granted only in respect of these 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. "These particulars of objections which the defendant has raised as affecting the validity of the plaintiff's patent will only be allowed if the patent is declared invalid. If the defendants win on non-infringement only, the certificate of their objections ought to be strictly limited to this issue of non-infringement" (*per* Vaughan-Williams, L. J., in *Pilkington* v. *Massey*, [1904] 21 R. P. C. 712). In *Wilcox & Gibbs* v. *Janes* ([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 *American Steel Co.* v. *Glover* ([1902] 19 R. P. C. 111) the plaintiffs appeared, but withdrew when the action came on for trial. The defendant asked for a certificate of their particulars of objections, but Farwell, J., refused (see also Buckley, J., in *Acetylene Co.* v. *United Alkali Co.* ([1902] 19 R. P. C. 233). 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.

Practice in granting certificates.

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

General principles upon which certificates

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. *Janes*, *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 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. *Morley*, [1893] 11 R. P. C. 1).

Costs for particulars are granted.

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."

Certificate that validity of patent has been challenged.

"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. 168). 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. *Chisholm*, [1896] 13 R. P. C. 488).

"Subsequent action."

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. *Kramm*, [1901] 18 R. P. C. 211). But in *Webb Lamp Co.* v. *Atkinson* ([1902] 19 R. P. C. 599), where the validity of the patent was impeached on eleven prior specifications set out in the defence, the defendants did not appear at the trial. Nevertheless, Buckley, J., refused to grant the plaintiffs a certificate of validity.

Query, whether 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 has been granted in respect of the remaining good claims (*Badische Aniline Fabrik* v. *Société Chimique*, [1897] 14 R. P. C. 892; *Haslam* v. *Hall*, [1887] 5 R. P. C. 1). But under present practice it seems doubtful that a certificate of the validity of the patent having been called in question can be granted in respect of a patent declared invalid; certainly never where all of the claims have been held invalid (*Acetylene Co.* v. *United Alkali Co.*, [1902] 19 R. P. C. 213, where Buckley, J., plainly stated that such a certificate cannot be given where the patent is held invalid, and flatly declined to follow *Haslam* v. *Hall*, *supra*).

Certificate in expired patent.

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).

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*, [1891] 8 R. P. C., at p. 352). Apparently such costs are not given where validity is not disputed in a subsequent action (*Saccharin Corporation* v. *Dawson*, [1902] 19 R. P. C. 169; *Edison-Bell* v. *Waterfield*, [1902] 19 R. P. C. 329).

Court of Appeal may grant certificates.

Of course, where the patent has been declared invalid in the Court below and this is reversed by the Court of Appeal, the latter Court will grant a certificate (*Faweett* v. *Homan*, [1896] 13 R. P. C. 398).

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). But the acts done by the public authority must be plainly within the scope of their public duties. Thus in *New Conveyer Co., Limited* v. *Edinburgh Gas Commissioners* ([1904] 21 R. P. C. 147), solicitor and client costs were refused to the successful defendants by the Inner House of the Scottish Courts of Session on the ground that the adventurous infringement of patents for the manufacture of gas did not arise out of the exercise of public duties.

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 against the judgment in the action 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. 459). 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. An application to stay enquiry as to damages pending appeal by the defendant is as a rule granted on terms (*Anti-Vibration Lighting Co.* v. *Crossley*, [1904] 22 R. P. C. 157), but may, in the discretion of the Judge, be refused (*Evans* v. *Hoskins*, [1904] 21 R. P. C. 675; *Hyam* v. *Terry*, 29 W. R. 32 followed). 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.

Stay of enquiry.

Appeal is a rehearing.

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 *Riekmann* 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. 45). 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.

Meaning of "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.

Persons entitled to 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* (*Dege's Patent*, [1895] 12 R. P. C. 448; *Morgan's Patent*, [1888] 5 R. P. C. 186).

Petitioner's grounds.

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* ([1894] 11 R. P. C. 657), 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. 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 *Gale'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. In lieu of this, the Court may declare the defendant trustee for the plaintiff in respect of such patents, British or foreign, as the defendant may have obtained (*Richmond* v. *Wrightson*, [1904] 22 R. P. C. 25).

Wrongful patentee made trustee for plaintiff.

Apart from fraud, 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*, [1884] 2 R. P. C. 3). 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.

Proof of priority of true inventor.

Query as to imported invention.

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 *Haddan's Patent* ([1885] 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 *Scott's Patent* ([1902] 20 R. P. C. 257) the petitioners proved prior use in the course of their business of a condenser which was held to be within the terms of the

Prior public user.

Use in private house.

first general claim of the specification. 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 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 (*Vaisey's Patent*, [1894] 11 R. P. C. 591).

Petitioner cannot plead estoppel on

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 (*Deeley'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's 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. In a proceeding for revocation of a patent the Court of Appeal will not review the exercise by a Judge of the discretion given to him by Section 19 of the Act as to the terms and conditions of an order for revocation, where the Judge has exercised his discretion with a full knowledge of all the circumstances of the case (*Geipel's Patent*, [1904] 21 R. P. C. 379). Respondent may amend bad patent. Conditions of amendment.

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

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. The petition must not go into the witness list till it is capable of being heard (*Borrowman's Patent*, [1902] 19 R. P. C. 159). When the evidence is by Order of procedure at hearing.

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). Apparently an order for revocation cannot be made in chambers; it must be made in Court (*Clifton's Patent*, [1904] 21 R. P. C. 515).

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 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. It has been suggested that a way out of the difficulty would be for the patentee to disclaim or strike out everything in his specification, thus leaving nothing for the petitioner to go upon.

Hardship of present regulation as to revocation.

Appeal.

Revocation of a patent may be stayed pending appeal to the Court of Appeal and the 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 and a claim to treble damages at Common Law to any person "hindered, grieved, disturbed, or disquieted by pretext of any monopoly or letters patent," and although it is clear from the remarks of Mathew, J., in *Peck* v. *Hindes* ([1898] 15 R. P. C. 113) that such a right of action existed and exists, 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.

Patentee's 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). 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,

A general warning not a threat.

But may be made so by circumstances.

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.

One threat enough.

Threats or a threat—for only one threat has led to the granting of an injunction (see *Webb* v. *Lerinstein*, [1898] 15 R. P. C. 78)—may be by letters (*Willoughby* v. *Taylor*, [1893] 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*, [1888] 5 R. P. C. 161), or by solicitor's letter (*Crampton* v. *Patents Co.*, [1888] 5 R. P. C. 393; *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 (*Dawson* 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. *Pintsch*, [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 (*Dawson* v. *Drosophore*, [1894] 11 R. P. C. 536; *Lycett* v. *Brooks*, [1904] 21 R. P. C. 656). 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

Remedy of persons threatened.

Threatened persons may challenge validity of patent.

Particulars of threats.

practice that such can be done. The plaintiff must give particulars of the threats complained of; and where these have been verbal statements made by the defendant's servants or agents, the names of the persons by and to whom the threats were spoken must be given (*Dowson* v. *Drosophore*, [1894] 11 R. P. C. 536). If in his statement of 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.

If patent attacked, particulars of objection required.

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. *Eadie*, [1899] 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 (*Dowson* v. *Drosophore*, [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 (*Herrburger* v. *Squire*, [1888] 5 R. P. C. 581).

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. *Hart*, [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 (*Peck* v. *Hinde*, [1898] 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; *Haskell* v. *Hutchison*, [1904] 21 R. P. C. 497). Three months has been considered a fair period for the exercise of due diligence (*Colley* v. *Hart*, *supra*). In *Herrburger* v. *Squire* ([1888] 5 R. P. C. 581) fourteen months was held too long a delay; but in reckoning time the circumstances of each case must always be considered.

Due diligence.

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. 367), 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."

Separate actions discouraged.

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

Procedure advisable in threats actions.

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 (*Edlin* v. *Pneumatic Tyre Agency*, [1893] 10 R. P. C., at p. 316). But this is only in consonance with the remarks of North, J., in *Colley* 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. *Radie*, [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 (*Colley* 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 *Waite* 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 threatener must take action.

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).

Breaches alleged need not coincide with subject-matter of threats.

So long as the action is commenced in respect of the patent owned by the party who has used the threats, the particulars of breaches need not necessarily refer to the specific parts or modifications of the invention ear-marked by the threats. Thus, in *Lycett* v. *Brooks* ([1904] 21 R. P. C. 656) the threats referred in two instances to a certain saddle called "L 16," and in one instance to three saddles called respectively "L 5," "L 14," and "L 16"; but in the action brought to justify the threats, infringement of these types was not alleged. The plaintiffs, in their action to restrain threats, alleged *mala fides*, but Warrington, J., held that the infringement action as brought satisfied the substance of the section.

Interim injunction.

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.

Measure of damages.

Damages are measured by the actual loss sustained by reason of the threats. These may be assessed by the Court or an enquiry as to damages may be instituted. Loss of profits under a contract repudiated because of the threats has been assessed as damages (*Hoffnung* v. *Salsbury*, [1899] 16 R. P. C. 375).

Appeal.

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

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.

Sub-section 5 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 terms 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 to impose.

"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

Mortgagee.

(*Hopkinson's Patent*, [1896] 14 R. P. C. 5). A 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

Profit and loss accounts must be full and exact.

loss accounts, so that approximately exact results of the working under the patent may be laid before the Committee (*Saxby's Patent*, [1870] Good. P. C. 565; *Bett's Patent*, [1862] Good. P. C. 548; *Duncan and Wilson's Patent*, [1884] 1 R. P. C. 257; *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 (*Clarke'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).

Bona fides of petitioner.

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.

Time for presenting petition.

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).

Prosecuted with effect.

It must be "prosecuted with effect": *i.e.* some definite step must have been taken by the Judicial Committee before the patent expires.

Rules.

The Rules at present 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:—

Advertisements.

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 in local journals.

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 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*.

Affidavits 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 their 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. Cas. 176). The fact that foreign patents have been allowed to lapse, or have expired by effluxion of time, is a point against, though not fatal to, prolongation (*Semet & 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 (*Hazeland'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 obviously bad. Therefore evidence of anticipation by the opponent will be received and given effect to (*Cocking'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 *Stanfield'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 (*Barff and Bower's Patent*, [1895] 12 R. P. C. 383).

Remuneration of foreign inventor.

In *Peach's Patent* ([1901] 19 R. P. C. 65) the invention had been communicated from abroad. The petition was made by the patentee and assignees. As the accounts contained no information as to the remuneration of the foreign inventor, prolongation was refused; an application for adjournment to prepare further accounts and obtain information from the foreign inventor was also dismissed.

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*, [1896] 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

Prolongation must benefit original inventor.

further benefit from the prolongation. Lord Macnaghten, in refusing prolongation, referred to what had been said in the *Barff-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 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 *Barff-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 £20,000 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 (*Davies's Patent*, [1893] 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* ([1894] 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 (*Dolbear's Patent*, [1896] 13 R. P. C. 203; *Pieper's Patent*, [1895] 12 R. P. C. 292; *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*, [1887] 4 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 trenching in any manner on the subject-matter of his patent (*Lieet'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*, [1895] 7 C. B. N. S. 209).

District assignments.

Further, by a direct provision in Section 36 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. *Temler*, [1900] 18 R. P. C. 6).

Executory 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). If the assignor in contracting to sell his patent gives a warranty of validity, and it is afterwards found that the patent is bad, the assignee may claim rescission of the contract and the return of the money paid, together with damages. But rescission of the contract will not be ordered if the parties cannot be restored to their original positions (*Berchem* v. *Wren*, [1904] 21 R. P. C. 683).

No implied warrant of validity.

Future improvements on patent.

It is sometimes considered prudent to insert in the assignment an express covenant as to any improvements upon the patent which may thereafter be made by the assignor (see *Pneumatic Tyre Co.* v. *Dunlop*, [1896] 13 R. P. C. 553; *London Hosiery Co.* v. *Grisewold*, [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.

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.

Limitation of co-owners' rights and duties.

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 (*Mathers* v. *Green*, [1865] L. R. 1 Ch. 29; 34 Beav. 170; Good. P. C. 298). 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 *Mathers* v. *Green* (*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 assignable to a body corporate.

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.

Infringement action by assignee.

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 *Dunnicliff* v. *Mallett* ([1859] 7 C. B. N. S. 209, 227).

Entry on Register.

All assignments should be entered in the Register of Patents.

Mortgagee.

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*, [1890] 7 R. P. C. 208). He need not join the mortgagee as co-plaintiff. There is no provision for entering a mortgagee on the Register as proprietor; but the equitable assignee is entitled to have a notification of his equitable right entered on the Register.

Forms of assignment.

A few short precedents of Assignments of Letters Patent will be found in Appendix B, commencing at page 458.

CHAPTER XXII.

LICENCES.

Nature of licence.

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.

Species of licences.

Licences may be classed as *Exclusive*, *General*, and *Restricted*.

Exclusive.

An *Exclusive* Licence is a licence which is granted to one person or firm only. The patentee may reserve the continued use of the invention to himself personally, or he may exclude himself and his assigns. The exclusive licence may be for a fixed period, or it may be terminable by notice, or upon the happening of a contingency, or it may be for the full term of the patent and without power of revocation, in which case it amounts to, and for some purposes is treated as, an absolute assignment.

General.

A *General* Licence is a licence which is granted to several different licensees.

Restricted.

A *Restricted* Licence may be described as a licence to use only a part of the invention, or to use it only for a certain purpose or within a certain district.

Implied licence to resell.

A licence to a manufacturer to make a patented article implies a licence to those who purchase the goods from him to resell to the public without direct authority from the licensor (*Thomas* v. *Hunt*, [1864] 17 C. B. N. S. 183).

Licence not assignable.

A licence is a personal right granted to the licensee, and cannot, therefore, be assigned or transferred by him (*Bowcer* v. *Hodges*, [1853] 22 L. J. C. P. 194), unless the licence is granted to the licensee and his assigns, or unless a power of assignment or transfer is specifically granted in the instrument. But if a licensee assigns his licence and the licensor accepts royalties from the assignee he is

Acquiescence in transfer of licence.

estopped by such acceptance from disputing the validity of the assignment (*Lawson* v. *Macpherson*, [1897] 14 R. P. C. 696). Even in the absence of payment and receipt of royalties the terms of the judgment in *Lawson* v. *Macpherson*, taken in conjunction with the ordinary rules of law, warrant the conclusion that other circumstances, such as acquiescence or *laches* on the part of the licensor, would have the same effect. Sub-licences cannot be granted by a licensee, unless the power to do so is expressly conferred.

Seizure of licensed article under distress.

A patented article used by a licensee under his licence cannot be seized under a distress and used by another to whom the licence does not extend (*British Mutoscope* v. *Homer*, [1901] 18 R. P. C. 177).

Form of licence.

Licences should be under hand and seal (see form of Patent grant), although this is not essential if the licence has been kept and worked under (*Chanter* v. *Dewhurst*, [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 betwixt 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.

Oral licence.

Terms 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 (*African Gold Co.* v. *Sheba Gold Co.*, [1897] 14 R. P. C. 660). Generally speaking, the mere relationship 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 or hindered from denying a matter already stated or admitted by him. Consequently estoppel might take effect even where the licence was not under seal, or merely in the form of a letter, or even where the licence is verbal. As a rule such estoppel would exist only while the licence remained in force, or until the patent had been declared void in legal proceedings between the licensor and third parties, although even then if the licensee still continued to work the

Licensee estopped from questioning validity of patent while licence in force.

invention without formally revoking the licence he might possibly be liable for royalties. The delivery of the defendant's defence in an action taken by the licensor against his licensee cannot be taken as a notice to determine the licence (*Cheetham* v. *Nuthall*, [1893] 10 R. P. C. 321).

Consequences of licence for full term of patent.

Where more than the ordinary covenants have been imported into the instrument, or where the licence is for the full term of the patent, or where the taker of the licence agrees not to question the validity of the patent, the fettering of the licensee might be correspondingly severe, and complete estoppel set up.

Determining licence.

In the absence of such restrictive terms in the licence, a licensee who wishes to discontinue should give immediate notice in writing to the licensor, and at the same time cease to use the invention (*Redges* v. *Mullner*, [1892] 10 R. P. C. 21; *Crossley* v. *Dixon*, [1863] 10 H. L. 293).

Licensee released from licence may afterwards challenge patent.

Where 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 require 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 defendants have been guilty of breaches (see *Ward* v. *Livesey*, [1888] 5 R. P. C. 105; *Guyot* v. *Thomson*, [1894] 11 R. P. C. 541).

Points to be considered in granting and accepting licences.

A rehearsal of the indicated possible difficulties points to the conclusion that, as it is to the interest of the licensor to bind the licensee as much as possible by the terms of the instrument, it is on the other hand to the interest of the licensee to decline to accept anything that may too greatly hamper him in the future. Therefore the question of estoppel consequent upon recitals and statements in a licence, and actual or implied admissions on the part of the licensee, should be carefully considered before acceptance of the licence. In ordinary circumstances the most prudent course is to provide for discontinuance of the licence on reasonable notice or on the patent being declared invalid, and expressly to bar admissions of the validity of the patent.

Again, from the point of view of the licensor it may be said that equal caution is required, lest, in seeming to guarantee more than can be substantiated, the question of failure of consideration should leave the licensee at liberty to dispute the licence.

Safeguards for licensor.

Further, if the licence is exclusive, and no rent reserved, the licensor might well object to be too stringently bound by covenants for title and for validity, seeing that his only advantage from the licence will depend upon the enterprise of the licensee. At the same time he should have power of revocation for breaches of covenants or in case the royalties do not reach a reasonable minimum figure per annum within a given period, otherwise an interested manufacturer might take an exclusive licence for the express purpose of locking the patent up.

Payment of renewal fees should be provided for.

In the case of an exclusive licence, 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 these, and the responsibilities of the licensee might continue, although the patent had lapsed.

Unless provided for no obligation to pay taxes on either party.

Mills v. Carson.

An instance of this occurred in the case of *Mills* v. *Carson* ([1892] 10 R. P. C. 9). Here an exclusive licence was granted to the defendants by the patentee for the then unexpired term of patent right for the consideration of £100 per annum. Nothing was said in the licence, nor was there any other arrangement as to who should pay the renewal fees. Neither of the parties paid the next renewal fee, so that the patent lapsed. The licensee then declined to pay the next instalment of annuity to the plaintiff. On action being taken by the patentee's assignee, it was held by the Recorder, by the Divisional Court, and by the Court of Appeal, that nothing having been said in the deed about the payment of those fees, the licensee had no right to throw the onus of payment upon the patentee, and that he must pay and continue to pay the annuity prescribed in the deed for the term of years for which the patent would have lasted had it not been allowed to lapse. An ordinary licensee cannot sue alone in respect of infringements, but may join with the patentee. Even in the case of an *exclusive* licensee, his right to sue alone

Mere licensee cannot sue for infringements.

has never been expressly admitted by the Court, although it would seem he may use the patentee's name for this purpose (*Renard* v. *Levinstein*, [1864-5] 11 L. T. N. S. 79, 505). The proper course is to make the patentee co-plaintiff.

When licence may be virtual assignment.

When the licence, in addition to being exclusive, is irrevocable, and no payments are being made under it, the licence is virtually an assignment, and it seems reasonable to submit that the licensee may sue for infringements without making the licensor a party, although even this has never been directly decided. It would seem from an 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 Cycle 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.

Fraud by 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 licences 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* stamp is required, whether the licence is by deed or otherwise. Where the licence contains a provision for the payment of a minimum royalty, the revenue authorities require the payment of duty upon the gross minimum royalty reserved, although the licence may contain power for either of the parties to terminate the licence at any time.

Forms of Licences.

One or two simple forms of Licences will be found in Appendix B, page 458.

COMPULSORY LICENCES.

Old provisions *re* Compulsory Licences.

Up to the 18th December, 1902, petitions for the grant of Compulsory Licences were made under Section 22 of the Act of 1883. The privilege was but little taken advantage of. From 1883 to 1897 only three applications appear to have been made, and none of these reached a hearing. After that date, however, a few petitions were heard, and the reports of these are the only examples of practice at present available.

Practice now in force.

By Section 3 of The Patents Act, 1902, the hearing of these petitions is taken out of the hands of the Board of Trade and is relegated to the Judicial Committee of the Privy Council. Section 22 of the Principal Act being repealed. At the present time the petition is still presented to the Board of Trade, which acts as a species of filter before the petition is referred to the Judicial Committee.

Functions of Board of Trade.

The duties of the Board are to consider the petition and to endeavour to adjust the differences between the parties. If this cannot be done, the Board, if satisfied that a *primâ facie* case has been made out, refers the petition to the Judicial Committee.

Reference to Judicial Committee.

If the petitioner satisfies the Judicial Committee that the reasonable requirements of the public have not been met, or if it is proved that the patent is worked mainly or exclusively abroad so as to defeat the reasonable requirements of the public, or so as to prejudice existing industries or prevent the establishment of new ones, then the Committee have the power to order Compulsory Licences, or, if they think fit, to revoke the patent. The awarding of costs is in the discretion of the Committee.

Restraint of trade.

Petitioner's interest.

According to Sub-section 1 of Section 3 of the Act of 1902, "any person interested" may present the petition, and Rule 69 of the Patents Rules, 1903, provides that the petition shall show clearly the nature of the petitioner's interest and the grounds upon which he claims to be entitled to relief. As the terms of the new rule do not essentially differ from those of the old rule it is to be presumed, in the absence of reports of proceedings under the Act of 1902, that the decisions under the former section will act as a guide as to what 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 reasonable requirements of the public with respect to the invention have not been satisfied, 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 (*Hulton 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 patent (*Continental Gas Glühlicht Petition*, [1898] 15 R. P. C. 727).

Grounds of petition.

It would seem that any member of the public who can show that the non-working of the patent or the non-supply to the public, or the withholding of licences on reasonable terms, prejudicially affects his business, has sufficient interest to entitle him to petition.

Procedure under Rules 69 to 75.

The procedure governing the presentation of petitions for compulsory licences to the Board of Trade may be gathered from Rules 69 to 75 of the Patents Rules, 1903. These Rules are as follows:—

Petition for grant of compulsory licence or revocation of patent.

69. A petition to the Board of Trade for an order under Section 3 of The Patents Act, 1902, 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, and the name and address of the patentee and any other person who is alleged in the petition to have made default.

Petition and evidence left at Patent Office.

70. The petition and an examined copy thereof shall be left at the Patent Office accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition, together with any documentary evidence in support, and the petitioner shall simultaneously with or as soon as may be after the leaving of such petition deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.

Opponent's evidence.

Evidence in reply.

71. The persons to whom such copies are delivered by the petitioner may, within fourteen days after being invited to do so by the Board of Trade, leave at the Patent Office the affidavits or statutory declarations in answer, and if they do so shall deliver copies thereof to the petitioner; and the petitioner may within fourteen days from the date of such last-mentioned delivery leave at the Patent Office his affidavits or statutory declarations in reply, and if he does so shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default, such last-mentioned affidavits or statutory declarations being confined to matters strictly in reply.

The times prescribed by this Rule may be altered or enlarged by the Board of Trade, if they think fit, upon such notice to parties interested and upon such terms, if any, as they may direct.

Closing of evidence.

72. No further evidence than as aforesaid may be left by either side at the Patent Office except by leave or requisition of the Board of Trade and upon such terms, if any, as the Board may think fit.

Board of Trade may dismiss petition.

73. The Board of Trade shall consider the petition and the evidence, with a view to satisfying themselves whether a *primâ facie* case has been made out for proceeding further with the petition, and if they are not satisfied they shall dismiss the petition.

Arrangement between parties.

74. If they are so satisfied, they shall consider whether there is any probability of an arrangement being come to between the parties, and if it appears to them that there is any reasonable probability that such an arrangement can be come to, they may take such steps as they consider desirable to bring it about, and in the meanwhile may defer the reference of the petition to the Judicial Committee of the Privy Council.

Reference to Judicial Committee.

75. If the Board are not of opinion that there is a reasonable probability of any arrangement being come to between the parties, and are satisfied that a *primâ facie* case has been made out by the petitioner, they shall refer the petition to the Judicial Committee, with copies of any affidavits, statutory declarations, or other documentary evidence which may have been furnished under the foregoing Rules, and with certified copies of all entries in the Register of Patents relating to the patent in question, and any

other information in the possession of the Board which it appears to them may be of service to the Judicial Committee in ascertaining what persons should be made parties to the proceedings before the Committee, and the Board shall give written notice to the parties that the petition has been referred to the Judicial Committee.

Proceedings before Judicial Committee.

The proceedings before the Judicial Committee are regulated by the Privy Council Rules, 1903, which are as follows:—

RULES TO BE OBSERVED IN PROCEEDINGS BEFORE THE JUDICIAL COMMITTEE OF THE PRIVY COUNCIL UNDER THE PATENTS ACT, 1902, SECTION 3.

Application for hearing.

I. On receiving written notice from the Board of Trade that a petition has been referred to the Judicial Committee of the Privy Council, the petitioner shall, after satisfying the requirements of Rules II. and IV., apply to the Judicial Committee to fix a time for hearing the petition.

Formalities to be observed by petitioner.

II. (*a*) No application to fix a time for hearing the petition shall be made unless the petitioner shall have previously given notice to the patentee, to the opponents, and to any other person claiming an interest in the patent as exclusive licensee or otherwise, that the petition has been referred to the Judicial Committee, that it is his intention to apply to the Judicial Committee on a specified day (which day shall be not less than four weeks from the date when the notice was served or sent) to fix a time for hearing the petition, and that any person desiring to be heard before the Judicial Committee at the time so fixed must enter a *caveat* at the Council Office on or before the day so specified.

Service of petitioner's notice.

(*b*) The said notice shall be served in the usual way, but where the person to be served resides or has his principal place of business outside the United Kingdom, it may be sent to him by post in a registered envelope.

Formalities to be observed by respondents.

III. (*a*) Any person claiming an interest in the patent as exclusive licensee or otherwise, whether he has received the notice prescribed by Rule II. or not, shall, if he desires to be heard before the Judicial Committee, enter a *caveat* at the Council Office on or before the day specified by such notice, provided always that, if he has not received the said notice, or if he resides or has his principal place of business outside the United Kingdom, he may apply to the Judicial Committee to extend the time for entering his *caveat* on the ground that the time limited by such notice is insufficient.

(*b*) Every *caveat* shall specify the caveator's address for service, which address shall be within four miles of the Council Office.

Application to fix time of hearing.

IV. An application to the Judicial Committee to fix a time for the hearing of the petition shall be accompanied by eight printed copies of the specification, and by an affidavit of the petitioner showing the persons to whom, and the manner in which, the notice prescribed by Rule II. has been given.

Advertisement of hearing Order.

V. The time for hearing a petition shall be fixed by an Order of the Judicial Committee, and shall be not less than four weeks from the day on which the application for fixing the same is made. The petitioner shall, immediately after the issue of such Order, give public notice thereof by advertising the same once at least in the *London Gazette* and in the *Times*, and in such other newspaper or newspapers (if any) as the Judicial Committee may direct. *After completing such advertisements, the petitioner shall forthwith* lodge an affidavit thereof at the Council Office.

Statements in affidavits may be disputed.

VI. The statements contained in the affidavits required by Rules IV. and V. may be disputed upon the hearing.

Objections of respondents to be served on petitioner.

VII. The petitioner shall be entitled to be served by the caveators, not less than three weeks before the day of hearing, with notice of the grounds of their respective objections, if such grounds are different from or additional to those taken by them in the proceedings before the Board of Trade. Copies of all objections, or additional objections, so served as aforesaid, shall be lodged at the Council Office not less than fourteen days before the day fixed for the hearing.

Documents to be printed.

VIII. (*a*) All petitions and other documents lodged at the Council Office shall (unless the Judicial Committee otherwise direct) be printed in the form prescribed by the Patents Rules of the Board of Trade which are in force for the time being, and the parties shall furnish as many copies of the documents lodged by them as shall be required by the Judicial Committee

(*b*) Parties shall be entitled to have copies of all papers lodged in respect of the petition at their own expense.

Persons entitled to conduct proceedings before Committee.

IX. No solicitor or agent shall be entitled to conduct proceedings under this Act before the Judicial Committee unless he is a solicitor or agent admitted to practise before the Privy Council in accordance with Her late Majesty's Order in Council of the 6th March, 1896. Such solicitor or agent shall be allowed the same fees, and the same Council Office fees shall be chargeable in respect of proceedings under this Act, as are prescribed by the general Rules applicable to proceedings before the Judicial Committee.

Application to fix hearing.

X. Applications to the Judicial Committee to fix a time for hearing the petition and on other matters of procedure shall be addressed in the first instance to the Registrar of the Privy Council, who shall take their Lordships' instructions thereon and

communicate the same to the parties. In cases of doubt the Registrar may, or, if so requested by any of the parties, he shall, enter the application for hearing before their Lordships' Board.

Relaxation of Rules.

XI. The Judicial Committee may excuse the parties from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice and otherwise as they shall consider to be just and expedient.

Evidence furnished to Board of Trade may be used before Committee.

XII. (*a*) Any affidavits, statutory declarations, or other documentary evidence which may have been furnished to the Board of Trade, or any copies thereof which may be referred by the Board to the Judicial Committee, may be received in evidence in proceedings under this Act before the Judicial Committee, subject to such cross-examination of any of the deponents as may be permitted by the Judicial Committee. The Judicial Committee may require the production of any original documents copies of which are tendered in evidence under this Rule.

(*b*) The parties may tender before the Judicial Committee such further documentary or other evidence as they may be advised.

Reference for report.

XIII. The Judicial Committee may refer any matters in connection with proceedings under this Act to be examined and reported on in the same manner as matters may be referred by them under Section 17 of the Act 3 & 4 Will. IV. c. 41 (Judicial Committee Act, 1833).

Privileges of counsel appearing for Crown.

XIV. The Judicial Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition. Counsel on behalf of the Crown 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 Committee.

Costs.

XV. Costs incurred in the matter of any petition under this Act shall be taxed by the Registrar of the Privy Council or other officer deputed by the Judicial Committee to tax the same, 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.

The Act of 1902 will be found consolidated with the Principal Act in Appendix C, page 499.

Provisions for revocation.

It should be noted that the provisions for revocation of the patent as a result of a petition for compulsory licence under Sub-sections 3 and 5 of Section 3 of The Patents Act, 1902, are new. By Sub-section 4 of Section 3, on the hearing of any petition under the section, not only the patentee, but any person claiming an interest in the patent as exclusive licensee or otherwise, may be made party to the proceeding.

Interested parties other than patentee.

The repealed section of the Principal Act made no express provision for the intervention of interested third parties (other than the patentee) as opponents to the petition, but it has been the practice to allow licensees so to appear (*Gormully and Jeffery, re Dunlop's Patents*, [1899] 16 R. P. C. 641). The mere fact that a patentee had granted a licence, even when such licence was exclusive, never, however, influenced the Board against granting additional licences (*Hulton and Bleakley's Petition*, [1898] 15 R. P. C. 749), and probably will not influence the Judicial Committee.

Satisfaction of reasonable requirements of public.

The provision in Sub-section 5 of Section 3 for ordering compulsory licences or revoking the patent where it is not worked in the United Kingdom are, it will be noticed, always subject to its being proved that the reasonable requirements of the public are not being satisfied. The sub-section does not make it obligatory that a foreign patentee, for example, should work his British patent in the United Kingdom, or even that he should grant licences. As the next Sub-section (6) indicates, if the reasonable requirements of the public are met (*e.g.* by sufficient importation and sale at a reasonable price), so long as no native industry is unfairly prejudiced or fettered, no actual working of the invention in this country will be required. It remains to be seen what view the Judicial Committee will take of the "reasonable requirements" phrase, but it may be presumed that no arbitrary pressure will be put upon a foreign patentee to compel him to work his invention in the United Kingdom.

Reasonable efforts to arrange with patentee should be made before petitioning.

A consideration of Sub-section 9 as to the discretion of the Judicial Committee in awarding costs makes it plain that before presenting his petition the petitioner should make every effort to obtain a licence from the patentee upon reasonable terms. This was also the rule under the repealed section (*Levinstein's Petition*, [1898] 15 R. P. C. 732).

Since the coming into force of Section 3 of The Patents Act, 1902, up to the time of going to press, only two petitions for compulsory licences have been made, and both of these were settled before the hearing. There are therefore no reports of hearings under the new procedure at present available.

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.

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.

Agreement prior to application.

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. 339).

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 (*per* Farwell, J., in *Jandus* v. *Johnson*, [1900] 17 R. P. C. 361), 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 (*Cartwright* v. *Amatt*, [1799] 2 B. and P. 43).

No property in patent till sealed.

When a sole licensee agrees to sell his rights, and the Letters Patent are afterwards assigned to another party subject to the rights of the licensee, the concurrence of the assignee of the Letters Patent is not necessary in completing the sale of the sole licence (*Frentzell* v. *Dougill & Meyer*, [1904] 21 R. P. C. 641).

Agreement to sell sole licence.

The question of the registrability of agreements of the foregoing nature will be referred to in the following chapter on the Register of Patents.

As a groundwork for drafting Agreements relating to Letters Patent the reader is referred to the short precedents which are to be found in Appendix B, at page 458.

Forms of Agreements.

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.

Registration of assignments.

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. 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 Lrion Co.* v. *Spilsbury*, [1898] 15 R. P. C., at p. 571).

Registration necessary to protect assignee.

Register as evidence.

The Register is *primâ 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 *Stewart* 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 Patents 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 sealing.

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 application.

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.

Instance of non-registrable document.

The pre-application document must identify invention.

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.

Registrable matter must be in writing.

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).

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 the Patents Rules, 1903) as affecting the proprietorship of the patent (*Stewart* v. *Casey*, [1891] 9 R. P. C. 9): 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 *Bayer* v. *Connell* ([1897] 14 R. P. C. 275), disclaimed jurisdiction, the Court of Session in Scotland, in *Cowie* v. *Herbert* ([1897] 14 R. P. C. 436), was of opinion that it had jurisdiction to entertain a petition for rectification of the Register. If the registered proprietor is a foreigner domiciled abroad, 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. 446).

Jurisdiction of Scottish and Irish Courts.

Service abroad.

An appeal lies from the Court of First Instance to the Court of Appeal.

Appeal.

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 60).

Entry of order in Register.

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.

The request should be made according to Form "L," and should be signed by the person requesting to be registered as proprietor.

Form of request to enter on Register.

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.

Body corporate.

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.

Documents to accompany request.

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.

Any person desiring to have due notice given him of any application or request to alter the Register may advise the Comptroller of his desire, whereupon the Comptroller will notify him as and when occasion arises.

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 (*Ransome* 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 "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.

Complete Specification accepted.

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 93 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* ([1893] 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 Patents 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 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. *Eli*, [1898] 15 R. P. C. 259). A person *bonâ 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. Cas. 347). In the latter case it was held that the Patent 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 1891.

Persons entitled to registration.

Annual fee payable.

Rules of 1889.

Rules of 1889.

The Register of Patent Agents Rules of 1889, as amended by the Rules of 1891, are the Board of Trade Rules now in force which relate to the admission and regulation of Patent Agents.

Rules of 1903.

By Rule 81 of the Patents Rules of 1903 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.

CHAPTER XXVI.

FOREIGN AND COLONIAL PATENTS, AND THE INTERNATIONAL CONVENTION.

THE International Convention and the enabling Patents Act of 1901 have already been shortly referred to in Chapters I. and II. 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 international rights, chiefly to the abstract species of industrial property constituted by Patents for Inventions, Copyright in Designs, Trade Marks, and Trade Names. The original 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 as originally concluded was that if 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 or wrongful appropriation of the invention in a foreign country, if such had taken place in the interim, and causing the different patents to start from an equal date. But at the conference held under the Convention on the 14th December, 1900, some of the original provisions were 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—

The International Convention of 1883.

(1) The extension of the time within which subjects and citizens of countries, members of the Convention, might mutually make applications for

Proposed amendments on the Convention.

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 party 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, page 450.

The Convention as affecting British Inventors.

The Convention is of importance to the British inventor who, having protected his invention in this country, desires also to obtain patents abroad. As the Digest of Foreign and Colonial Laws which appeared in former editions of this book has not been included in the present edition, a few words of general advice may not come amiss. If the British inventor takes advantage of the terms of the International Convention he may file a foreign application, based upon his British Complete Specification, at any time within twelve months from the date of his British application. But let it be noted that this applies only to those countries which are parties to the Convention or with whom the British Government has made reciprocal arrangements.

Patents obtainable independently of the Convention.

If on the other hand the applicant lets his opportunity slip, by allowing the twelve months to elapse without making a foreign application, there are still certain countries, some of them members of the Convention, in which patents may be obtained (*a*) before the publication of the Complete Specification in this country, and (*b*) after the publication of the Complete Specification and the issue of the British patent.

Advantages of applying under the Convention.

As a guide to those inventors who adopt the wiser course of filing their foreign applications within twelve months of the British application in accordance with the Convention, or in virtue of reciprocal arrangements made with the British Government in terms of the Convention, a list of the countries and colonies in which they may so apply is appended. The advantage of making application under the Convention is that the foreign patent is dated as of the date of the original British application. The full term of the foreign patent is granted independently of the lapsing of the British patent from whatever cause. Publication, or the prior application of another person for the same invention in the foreign country

after the date of the British application, would have no hurtful effect. A common minimum period of three years is fixed within which no foreign patent is forfeited for non-working in those States where working the patent is a statutory requirement.

In the following list of countries, those which are adherents to the International Convention are marked with an asterisk (*), and those outside of the Convention, but between whom and Great Britain a reciprocal arrangement exists, are marked with a dagger (†):—

List of countries adhering to Convention.

America (U.S.),* Belgium,* Brazil,* Cuba,* Denmark,* France,* Germany,* Honduras,† Italy,* Japan,* Mexico,* New Zealand,* Netherlands,* Norway,* Paraguay,† Portugal,* Queensland,* Servia,* Spain,* Sweden,* Switzerland,* Tasmania,† Tunis,* Uruguay,† Western Australia.†

The principal countries in which a valid patent may be obtained after the publication of the Complete Specification in Great Britain but before the Complete has been introduced abroad (and in some cases even after the Complete has made its appearance abroad and after the sealing of the British patent) are—

Countries in which patents may be obtained apart from Convention under varying conditions.

Argentine Republic, Bahamas, Belgium* (for patents of importation), British Guiana, British Honduras, British South Africa, Canada (if application is made within twelve months from actual sealing of British patent), Cape Colony, Ceylon (if application is made within twelve months of actual sealing of British patent), Chili, Columbia, Costa Rica, Ecuador, Hong Kong, India (if application is made within twelve months of actual sealing of British patent), Italy,* Jamaica, Luxemburg, Natal, Newfoundland, New South Wales, New Zealand,* Norway,* Orange River Colony, Peru, Portugal* (patents of importation), Queensland,* Russia, South Australia, Spain,* Straits Settlements, Switzerland,* Transvaal, Trinidad, Turkey, Venezuela, Victoria, West Australia.†

It will be noticed that some of these countries are adherents to the Convention. Of course, it must be understood that the above does not exhaust the list of countries in which the British inventor may obtain

patents. There are other States which, like Austria, for example, are neither members of the Convention nor adherents to any special arrangement, and in which patents can only be obtained under their own laws and before any publication has taken place in Great Britain. Any patent agent will supply a complete list of such countries, or the reader is directed to former editions of this work, in which digests of the laws of each foreign country are set out.

In America it is possible, apart from the Convention, to obtain a valid patent after the twelve months and after the filing of the Complete in this country if the U.S. application is made before the acceptance and publication of the British Complete, and if the sealing of the British patent can be delayed until after the issue of the U.S. patent. But this is usually almost a physical impossibility, as the British patent is sealed as soon as may be after the expiring of the period for opposition. Formerly it was possible for an astute applicant to delay the sealing of his British patent by getting up a bogus opposition and so delaying the grant. But that can no longer be done with impunity (see *A. B.'s Application*, [1902] 19 R. P. C. 403).

Disadvantages of non-Convention patents.

In all of these countries, under the conditions of the second list, the patent would be dated as of the day of application abroad, and not from the date of the original British application as would be the case under the Convention. This, of course, subjects the applicant to additional risks, and the patent being granted not independently of but subject to the British patent, the patentee is left to fulfil the conditions of "working" proper to each country, and the length of grant is in most cases determined by the life of the British patent, except in America, where the patent is always granted independently of other patents for seventeen years without renewal taxes or without any conditions as to working.

Subject-matter in foreign countries.

In most foreign countries patentable "subject-matter" is the same as in Great Britain, except that in France pharmaceutical compositions and medicines of all kinds cannot be patented. In Germany articles of food, drinks, pharmaceutical compositions, and the products of chemical processes cannot be patented, although chemical processes

are patentable. In Switzerland no patents are granted for inventions which do not in themselves represent a visible and tangible marketable article. Therefore new processes and methods of manufacture are unpatentable, although the products of new processes may be patented. In America processes which consist solely in the operation of a machine are not patentable (*Risdon* v. *Medart*, [1895] 71 Off. Gaz. 751; since upheld in *Travers* v. *Gem Hammock Co.*, 75 Off. Gaz. 678). 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. It used to be the Office rule in America never to allow the inclusion in one patent of claims for a process and claims for apparatus to carry out the process, no matter how interdependent these might be. Two separate patents were always required. But in *U.S.* v *Allen*, [1904] Off. Gaz., vol. cix., p. 549, the Supreme Court decided that the Patent Rule 41, which forbade such inclusion, was *ultra vires* and invalid. In accordance with this decision henceforth claims for a process and claims for the apparatus necessary to carry on the process may be included in one patent.

New American Office Rule as to process with apparatus patents.

Conditions for keeping foreign patents in force.

With the exception of the United States most foreign countries require the payment of annual taxes to keep the patent in force, and certain countries require the patent to be "worked" at stated intervals or continuously. These and other onerous requirements are, however, so various, and changes in practice are so frequent, that the inventor is advised to consult some experienced patent agent who is in daily contact with matters affecting foreign patents.

The text of the Convention as amended in 1900, together with the qualifying Final Protocol, will be found set out at length in Appendix A, page 450.

PATENTS RULES, 1903 TO 1905

(CONSOLIDATED.)

NOTE.—*The repealed Rules of 1903 are omitted, and the substituted and added matter from the Rules of 1905 is printed in heavier type.*

BY virtue of the provisions of The Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Board of Trade do hereby make the following Rules:—

SHORT TITLE.

Short title.

1. These Rules may be cited as "The Patents Rules, 1903."[1]

Commencement.

2. These Rules (*i.e.* the Rules of 1903) shall come into operation from and immediately after the 12th day of January, 1903.[2]

Interpretation.

3. In the construction of these Rules—

"United Kingdom" includes the Isle of Man.

"Foreign Application" means an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order in Council for the time being in force the provisions of Section 103 of the Act of 1883 as amended by any subsequent Act have been declared applicable.

"Convention Application" means an application in the United Kingdom under the provisions of Section 103 of the Act of 1883 as amended by any subsequent Act.

Rule 3 of 1905.

Save as aforesaid, in the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

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[1] The Rules of 1905 incorporated herewith may be separately cited as "The Patents Rules, 1905," or the Rules may be cited as "Consolidated."

[2] The Rules of 1905 came into operation on the 1st of January, 1905.

Fees.

First Schedule.

4. The fees to be paid under the said Acts shall be those specified in the List of Fees in the First Schedule to these Rules.[1]

Sealing of Patent and Payment of Fee.

Sealing of patent and payment of fee.

Rule 12 of 1905.

4a. If the applicant for a patent desires to have a patent sealed on his application, he must, on or before the last day on which a patent can lawfully be sealed, pay the prescribed sealing fee; and if such fee be not paid, no patent shall be sealed.

First Schedule.

Rule 13 of 1905.

4b. To the fees specified in the First Schedule to the Patents Rules, 1903, shall be added the fee specified in the First Schedule hereto [i.e. *the sealing fee of £1 on Form X*].

Forms.

Second Schedule.

5. The forms contained in the Second Schedule to these Rules may, as far as they are applicable, be used in any proceedings under the said Acts or under these Rules, and so far as they relate to the same subject-matter shall be substituted for the forms in the First Schedule to the Act of 1883.[2]

Second Schedule.

Rule 14 of 1905.

Claims.

5a. To the forms contained in the Second Schedule to the Patents Rules, 1903, shall be added the Form X contained in the Second Schedule hereto; and in the Form C contained in the first mentioned Schedule the following direction shall be added in a marginal note, namely:—"In the preparation of the claim or claims careful attention should be paid to the terms of Rule 4 of the Patents Rules, 1905. Any unnecessary multiplicity of claims or prolixity of language should be avoided."

Rule 12 of 1905.

5b. The prescribed sealing fee should be paid by leaving a the Patent Office Form X in the Second Schedule to these Rules, duly stamped.

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[1] The Rules of 1905 imposed an additional sealing fee of £1.

[2] The Rules of 1905 add a new Form X for the payment of the sealing fee. *The forms are not printed in this book, as they may be purchased duly stamped in any post-office.*

APPLICATIONS FOR PATENTS.

Application by representative of deceased inventor.

6. In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, the probate of his will, or the letters of administration granted of his estates and effects, or an official copy of such probate or letters, shall be produced at the Patent Office in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require.

Address for service.

7. Every application for a patent shall be accompanied by a statement of an address (hereinafter referred to as "the address for service") to which all notices, requisitions, and communications of every kind may be sent by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant until a substituted address for service shall be furnished by him to the Comptroller. The Comptroller may in any particular case require that the address for service be in the United Kingdom.

Order of recording applications.

8. 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.

One invention.

Rule 5 of 1905.

9. When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus, or process.

Applications for separate patents by way of amendment.

Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings, or any of them, so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

Split-up applications to bear original date.

Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the said Acts and by any Rules thereunder for the time being in force

Date may be altered to give time for procedure.

Where the Comptroller has required or allowed any application, specification, or drawings to be amended as aforesaid, such application shall, if the Comptroller at any time so direct, bear such date, subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

Power of Comptroller to post-date.

Rule 6 of 1905.

9a. If after the leaving of any Complete Specification the Examiner reports that the nature of the invention is not sufficiently disclosed and defined to enable him to make the investigation prescribed by Sub-section 1, and the Comptroller has required amendment of the specification and drawings, or either of them, the application shall, if the Comptroller at any time so direct, bear such date, subsequent to its original date and not later than the date when the requirement is complied with, as the Comptroller may consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

Claims.

Rule 4 of 1905.

9b. The statement of the invention claimed, with which a Complete Specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification.

Provisional report in case of complete anticipation.

Rule 7 of 1905.

9c. When the Examiner, in prosecution of the investigation prescribed by Sub-section 1, finds that the invention claimed in the specification under examination has been wholly claimed or described in one or more specifications within the meaning of the sub-section in question, he shall, without any further prosecution of the investigation, make a provisional report to that effect to the Comptroller.

If the provisional report of the Examiner made under this Rule be not reversed or altered, it shall be deemed a final report, and the application shall be dealt with as provided by

Sub-section 6. If, however, such provisional report be reversed or altered, the investigation prescribed by Sub-section 1 shall be continued, and a further report shall be made to the Comptroller, and the specification shall be dealt with as provided in Sub-section 5 or Sub-section 6, as the case may require.

Time for leaving amended specification.

Rule 8 of 1905.

9d. The time within which an applicant may leave his amended specification under Sub-section 2 shall be two months from the date of the letter informing him that the invention claimed has been wholly or in part claimed or described in any specification or specifications within the meaning of Sub-section 1.

Extension of time.

In any special case the Comptroller may, if he think fit, enlarge the time prescribed by this Rule.

Hearing by the Comptroller under Sub-section 6.

Rule 9 of 1905.

9e. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provision of Sub-section 1, and the time allowed by Rule 8 for amendment of his specification has expired, the Comptroller, if he is not satisfied that no objection exists to the specification on the ground that the invention claimed therein has been wholly or in part claimed or described in a previous specification within the meaning of that sub-section, shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and, if so, what, prior specification or specifications by way of notice to the public.

Decision with or without hearing.

Reference to prior specification.

Rule 10 of 1905.

9f. When under Sub-section 6 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows and shall be inserted after the claims:—

> Reference has been directed in pursuance of Section 1, Sub-section 6, of The Patents Act, 1902, to the following specification of Letters Patent No. granted to .

Reference under Rule 7.

Where the reference is inserted as the result of a provisional report under Rule 7, a statement to that effect shall be added to the reference.[1]

APPEAL.

Appeal to Law Officer.

Rule 11 of 1905.

9g. Every decision of the Comptroller under the foregoing Rules shall be subject to an appeal to the Law Officer.

Extension of time for leaving and accepting Complete Specification.

10. An application for extension of time for leaving or accepting a Complete Specification shall be made on Form U or on Form V, as the case may require, and 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.

Notice and advertisement of acceptance.

11. On the acceptance of a Provisional or Complete Specification the Comptroller shall give notice thereof to the applicant, and shall advertise the acceptance of every Complete Specification in the official journal of the Patent Office.

Inspection of Complete Specification.

12. Upon such 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.

APPLICATIONS UNDER THE INTERNATIONAL CONVENTION.

Convention Applications.

13. Every Convention Application shall contain a declaration that foreign application has been made for protection of the invention to which such Convention Application relates, and shall specify all the Foreign States or British Possessions in which such 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

[1] Rule 7 corresponds to Rule 9c in the present Consolidation.

application was made. If such person, or any of such persons, be dead, the application must be signed by the legal representative of such dead person, as well as by the other applicants, if any.

Foreign specification &c. to accompany Application.

14. Every Convention Application, in addition to the specification left therewith, must be accompanied by a copy or copies of the specification, and drawings or documents 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. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto, and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

Public inspection.

15. 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.

Proceedings.

16. Save as aforesaid and as provided by Rule 52, all proceedings in connection with a Convention Application shall be taken within the times and in the manner prescribed by the said Acts or these Rules for ordinary applications.

17. For Rule 17 of the Patents Rules, 1903, the following Rule shall be substituted:—

Size &c. of documents.

Rule 15 of 1905.

All documents and copies of documents, except drawings, sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written, typewritten, lithographed, or printed in the English language (unless otherwise directed) in large and legible characters with deep permanent ink upon strong white paper, and, except in the case of statutory declarations and affidavits, on one side only, of a size of approximately thirteen inches by eight inches,

leaving a margin of at least one inch and a half on the left-hand part thereof, and the signatures thereto must be written in a large and legible hend. Duplicate documents shall at any time be left, if required by the Comptroller.

At the top of the first page of a specification a space of about two inches should be left blank.

Drawings accompanying Specifications.

Rule 16 of 1905.

18. For Rules 18 to 24 of The Patents Rules, 1903, the following Rules shall be substituted:—

Drawings.

As the drawings are printed by a photo-lithographic process, the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of such process, and calculated to give the best results in the interests of inventors, of the Office, and of the public. The following requirements should, therefore, be strictly observed, as non-compliance therewith will be certain to cause delay in the progress of an application for a patent.

General.

Rule 17 of 1905.

19. Drawings, when furnished, should accompany the Provisional or Complete Specification to which they refer, except in the case provided for by Rule 24. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed should appear in the specification itself.

Requirements as to paper.

Rule 18 of 1905.

20. Drawings may be made by hand or lithographed, printed, &c. They must be made on pure white, hot-pressed, rolled, or calendered strong paper of smooth surface, good quality, and medium thickness without washes or colours, in such a way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings must not be used.

Size of drawings and arrangement of figures.

Rule 19 of 1905.

21. Drawings must be on sheets which measure thirteen inches from top to bottom and are either from eight inches to eight and a quarter inches or from sixteen inches to sixteen and a half inches wide, the narrower sheets being preferable.

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, but no more sheets should be employed than are necessary, and the figures should be numbered consecutively throughout and without regard to the number of sheets. The figures should not be more numerous than is absolutely necessary. They should be separated by a sufficient space to keep them distinct.

Drawings to be suitable for reproduction.

Rule 20 of 1905.

22. Drawings must be prepared in accordance with the following requirements:—

(*a*) They must be executed with absolutely black ink.

(*b*) Each line must be firmly and evenly drawn, sharply defined, and of the same strength throughout.

(*c*) Section lines, lines for effect, and shading lines should be as few as possible, and must not be closely drawn.

(*d*) Shade lines must not contrast too much in thickness with the general lines of the drawing.

(*e*) Sections and shading should not be represented by solid black or washes.

(*f*) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, &c., should appear as effects this purpose. If the scale is given, it should be drawn, and not denoted by words.

Reference letters and figures, and index numerals used in conjunction therewith, must be bold, distinct, and not less than one-eighth of an inch in height. The same letters should be used in different views of the same parts. Where the reference letters are shown outside the figure, they must be connected with the parts referred to by fine lines.

Drawings to bear the name of applicant &c. but no descriptive matter.

Rule 21 of 1905.

23. 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 consecutive 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. Neither the title of the invention nor any descriptive matter should appear on the drawings.

Copies of drawings.

Rule 22 of 1905.

24. A facsimile or "true copy" of the original drawings must be filed at the same time as the original drawings, prepared strictly in accordance with the above Rules, except that it may be on tracing cloth and the reference letters and figures should be in black-lead pencil.

Marking of originals and true copies.

The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet.

Delivery of drawings.

Rule 23 of 1905.

24a. Drawings must be delivered at the Patent Office, so as to be free from folds, breaks, or creases which would render them unsuitable for reproduction by photography.

Provisional drawings used for Complete Specifications.

Rule 24 of 1905.

24b. 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 in the Complete Specification as those left with the Provisional Specification.

STATUTORY DECLARATIONS AND AFFIDAVITS.

Form &c. of statutory declaration and affidavit.

25. The statutory declarations and affidavits required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate, and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject. Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written or printed bookwise and shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

Manner in which, and persons before whom, declaration or affidavit is to be taken.

26. The statutory declarations and affidavits 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 His Majesty's Dominions, before any Court, Judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(C) If made out of His Majesty's Dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or before a notary public, or before a Judge or magistrate.

INDUSTRIAL OR INTERNATIONAL EXHIBITIONS.

Industrial or international exhibitions.

27. 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, may, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Form O 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 inventor 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.

EXERCISE OF DISCRETIONARY POWERS BY THE COMPTROLLER.

Exercise of discretionary powers by Comptroller.

Notice of hearing.

28. Before exercising any discretionary power given to the Comptroller by the said Acts or these Rules 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.

Notice by applicant.

29. 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.

30. 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.

31. 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 to any other person who appears to him to be affected thereby.

Opposition to Grants of Patents.

Notice of opposition.

32. 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 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, which copy shall be transmitted by the Comptroller to the applicant.

Copy for applicant.

Evidence in support of allegation that invention has been obtained from opponent.

33. 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 fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's Complete Specification, the opposition shall be deemed to be abandoned.

Attendance of declarant before Comptroller.

34. 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, the Comptroller may request or allow any person who has made a statutory declaration in the matter to which the opposition relates to attend before him at the hearing of the case and make oral explanations with respect to such matters as the Comptroller may require.

Particulars of prior patent.

35. 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.

36. Except in the case provided for in Rule 33, statutory declarations need not be left in connection with an opposition, but the opponent may, within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's Complete Specification, leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Applicant's evidence.

Evidence in reply.

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

Applicant's evidence if opponent does not leave statutory declarations.

38. If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do), within three months from the date of the advertisement of the acceptance of his Complete Specification, leave at the Patent Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Opponent's evidence.

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

Evidence in reply.

Closing of evidence.

40. No further evidence shall be left on either side except by leave, or on the requisition, of the Comptroller.

Hearing.

41. On completion of the evidence, if any, 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 either party does not desire to be heard he shall as soon as possible notify the Comptroller to that effect; if either party desires to be heard he must leave Form E at the Patent Office. The Comptroller may refuse to hear either party who has not left Form E prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory declaration already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing the Comptroller shall decide the case and notify his decision to the parties.

Notice of intention to refer to additional evidence.

Decision.

Amendment of Specification.

Request for leave to amend.

42. A request for leave to amend a specification must be signed by the applicant and shall contain an address for service in the United Kingdom. When not made in pursuance of an Order of the Court or a Judge

the request must, where a patent has been sealed, also contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. The request must be accompanied by a duly certified 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.

Leave by Order of Court.

43. Where a request for leave to amend is made in pursuance of an Order of the Court or a Judge, an office copy of the Order shall be left with the request at the Patent Office.

Notice of opposition.

44. A notice of opposition to the amendment shall be on Form G, and 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, which copy shall be transmitted by the Comptroller to the applicant.

Copy for the applicant.

Opponent's evidence.

45. 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 copies thereof.

Further proceedings.

46. Upon such declarations being left, and such copies being delivered, the provisions of Rules 37, 40, and 41 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Applicant's evidence if opponent does not leave statutory declarations.

47. If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do), within two months from the date of the first advertisement of the application for leave to

amend, leave at the Patent Office statutory declarations iu support of his application, and on so leaving shall deliver to the opponent copies thereof.

Further proceedings.

48. Upon such declarations being left, and such copies being delivered, the provisions of Rules 39, 40, and 41 shall apply to the case, and further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Requirements on amendment.

49. 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 17 to 23.

Advertisement of amendment.

50. Every amendment of a specification shall be advertised forthwith by the Comptroller in the official journal of the Patent Office, and in such other manner, if any, as the Comptroller may direct.

Register of Patents.

Entry of grant.

51. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and calling of the patentee as the grantee thereof, and the title of the invention, together with the address for service.

Entry in respect of Convention Application.

52. The patent granted on any Convention Application shall be entered in the Register 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.

Alteration of address.

53. If a patentee send to the Comptroller on Form R notice of an alteration in his address, the Comptroller shall cause the Register to be altered accordingly, and may require the altered address to be in the United Kingdom.

Request for entry of subsequent proprietorship.

54. Where a person becomes entitled to a patent, or to any share or interest therein, by assignment, 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.

Form and signature of request.

55. Such request shall be on Form L, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietors, or by his agent duly authorised, to the satisfaction of the Comptroller, and in the case of a body corporate by its agent, authorised in like manner.

Particulars to be stated in request.

56. Every such request shall state the name, address, and calling of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be, and the particulars of the assignment, transmission, or other operation of law, by virtue of which he claims 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.

57. 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, unless the Comptroller in his discretion otherwise directs, be produced to him together with the request, and such other proof or 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.

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

Body corporate.

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

Entry of Orders of the Privy Council or of the Court.

60. Where an Order has been made by His 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 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 date of payment of fees on issue of certificate.

61. Upon the issue of a certificate of payment under Rule 68, the Comptroller shall cause to be entered in the Register a record of the date of payment of the fee on such certificate.

Entry of failure to pay fees.

62. If a patentee fails to make any prescribed payment within the prescribed time, or any enlargement thereof duly granted, there shall be duly entered in the Register a notification of such failure.

Entry of notification of licence or other document.

63. An attested copy of every licence granted under a patent, or of any other document purporting to affect the proprietorship of a patent, shall be left at the Patent Office with a request on Form M that a notification thereof may be entered in the Register. The accuracy of such copy shall be certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Patent Office if required for further verification.

Hours of inspection of Register.

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

(*a*) Christmas Day, Good Friday, the day observed as His 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.

65. 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.

Payment of Fees for Continuance of Patent.

Payment of fees for continuance of patent.

66. 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.

The Form J in the Second Schedule, duly stamped, should be used for the purpose of this payment.

Enlargement of time for payments.

67. 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.

Certificate of payment.

68. On due compliance with the terms of Rule 66, 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.

Compulsory Licences and Revocation of Patents.

Petition for grant of compulsory licence or revocation of patent.

69. A petition to the Board of Trade for an order under Section 3 of The Patents Act, 1902, 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, and the name and address of the patentee and any other person who is alleged in the petition to have made default.

To be left with evidence at Patent Office.

70. The petition and an examined copy thereof shall be left at the Patent Office accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition, together with any other documentary evidence in support, and the petitioner shall, simultaneously with or as soon as may be after the leaving of such petition, deliver to the patentee and any other person who is alleged in the petition to have made default copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.

Opponent's evidence.

71. The persons to whom such copies are delivered by the petitioner may within fourteen days after being invited to do so by the Board of Trade leave at the Patent Office their affidavits or statutory declarations in answer, and if they do so shall deliver copies thereof to the petitioner; and the petitioner may within fourteen days from such last-mentioned delivery leave at the Patent Office his affidavits or statutory declarations in reply, and if he does so shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default, such last-mentioned affidavits or statutory declarations being confined to matters strictly in reply.

Evidence in reply.

The times prescribed by this Rule may be altered or enlarged by the Board of Trade, if they think fit, upon such notice to parties interested and upon such terms, if any, as they may direct.

Closing of evidence.

72. No further evidence than as aforesaid may be left by either side at the Patent Office except by leave or on requisition of the Board of Trade and upon such terms, if any, as the Board may think fit.

Power of Board of

73. The Board of Trade shall consider the petition and the evidence, with a view to satisfying themselves

whether a *primâ facie* case has been made out for proceeding further with the petition, and if they are not so satisfied they shall dismiss the petition. Trade to dismiss petition.

74. If they are so satisfied, they shall consider whether there is any probability of an arrangement being come to between the parties, and if it appears to them that there is any reasonable probability that such an arrangement can be come to, they may take such steps as they consider desirable to bring it about, and in the meanwhile may defer the reference of the petition to the Judicial Committee of the Privy Council. Arrangements between parties.

75. If the Board are not of opinion that there is a reasonable probability of any arrangement being come to between the parties, and are satisfied that a *primâ facie* case has been made out by the petitioner, they shall refer the petition to the Judicial Committee, with copies of any affidavits, statutory declarations, or other documentary evidence which may have been furnished under the foregoing Rules, and with certified copies of all entries in the Register of Patents relating to the patent in question and any other information in the possession of the Board which it appears to them may be of service to the Judicial Committee in ascertaining what persons should be made parties to the proceedings before the Committee, and the Board shall give written notice to the parties that the petition has been referred to the Judicial Committee. Reference of petition to Judicial Committee.

GENERAL.

76. Any document 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 and on such terms as the Comptroller may think fit. Power of amendment &c.

77. The times prescribed by these Rules for doing any act or taking any proceedings thereunder, other than the times for lodging evidence referred to in Rule 33 or in the procedure in these Rules relating to compulsory licences and revocation of patents, may be enlarged by General power to enlarge time.

the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Power to dispense with evidence.

78. 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.

Hours of business.

79. The Patent Office shall be open to the public every week-day except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:—

Christmas Day, Good Friday, the day observed as His Majesty's birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office.

Leaving documents.

80. 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.

AGENCY.

Agency.

81. With the exception of the signing of the following documents—namely, applications for patents, requests for leave to amend applications, specifications, or letters patent, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, notices of abandonment of or of intention not to proceed with applications, surrenders of letters patent, and petitions for compulsory licence and revocation of patent—all communications to the Comptroller under the said Acts and these Rules may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require it, resident in the United Kingdom. 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. In any particular case the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

REPEAL.

Repeal.

82. All general Rules relative to patents heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1901, and in force on the Twelfth day of January, 1903, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application or other matter then pending.

Dated the 12th day of January, 1903. Rules of 1903.

Dated the 20th day of October, 1904. Rules of 1905.

G. W. BALFOUR,
President of the Board of Trade.

FIRST SCHEDULE.

LIST OF FEES PAYABLE ON AND IN CONNECTION WITH LETTERS PATENT.

		£	s.	d.	£	s.	d.
1.	On application for Provisionnl Protection	1	0	0			
2.	On filing Complete Specification	3	0	0	5	0	0
3.	On notice to seal patent	1	0	0			
	or						
4.	On filing Complete Specification with first application	4	0	0	5	0	0
5.	On notice to seal patent	1	0	0			
6.	On appeal from Comptroller to Law Officer. By appellant				3	0	0
7.	On notice of opposition to grant of patent. By opponent				0	10	0
8.	On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
	On application to amend specification :—						
9.	Up to sealing. By applicant				1	10	0
10.	After sealing. By patentee				3	0	0
11.	On notice of opposition to amendment. By opponent				0	10	0
12.	On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
13.	On application to amend specification during action or proceeding. By patentee				3	0	0
14.	On application to the Board of Trade for a compulsory licence. By person applying				1	0	0
15.	On opposition to grant of compulsory licence. By opponent				1	0	0
	On certificate of renewal :—						
16.	Before the expiration of the fourth year from the date of the patent and in respect of the fifth year				5	0	0
17.	Before the expiration of the fifth year from the date of the patent and in respect of the sixth year				6	0	0
18.	Before the expiration of the sixth year from the date of the patent and in respect of the seventh year				7	0	0
19.	Before the expiration of the seventh year from the date of the patent and in respect of the eighth year				8	0	0
20.	Before the expiration of the eighth year from the date of the patent and in respect of the ninth year				9	0	0
21.	Before the expiration of the ninth year from the date of the patent and in respect of the tenth year				10	0	0
22.	Before the expiration of the tenth year from the date of the patent and in respect of the eleventh year				11	0	0

		£	s.	d.
	On certificate of renewal (*continued*):—			
23.	Before the expiration of the eleventh year from the date of the patent and in respect of the twelfth year -	12	0	0
24.	Before the expiration of the twelfth year from the date of the patent and in respect of the thirteenth year	13	0	0
25.	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:—			
26.	Not exceeding one month - - - - - - -	1	0	0
27.	„ two months - - - - - -	3	0	0
28.	„ three months - - - - - -	5	0	0
29.	For every entry of an assignment, transmission, agreement, licence, or extension of patent - - - - -	0	10	0
30.	For duplicate of letters patent - - - - - each	2	0	0
31.	On notice to Comptroller of intended exhibition of a patent under Section 39 - - - - - - - -	0	10	0
32.	Search or inspection fee - - - - - - each	0	1	0
33.	For office copies - - - - - every 100 words (but never less than one shilling)	0	0	4
34.	For office copies of drawings (cost according to agreement)			
35.	For certifying office copies, MSS. or printed - - - each	0	1	0
36.	On postal request for printed specification - - - -	0	0	8
	On request to Comptroller to correct a clerical error:—			
37.	Up to sealing - - - - - - - - -	0	5	0
38.	After sealing - - - - - - - - -	1	0	0
39.	For certificate of Comptroller under Section 96 - - -	0	5	0
40.	For altering address in Register - - - - - -	0	5	0
41.	For enlargement of time for filing Complete Specification, not exceeding one month - - - - - - -	2	0	0
	For enlargement of time for acceptance of Complete Specification:—			
42.	Not exceeding one month - - - - - - -	2	0	0
43.	„ two months - - - - - -	4	0	0
44.	„ not exceeding three months - - -	6	0	0

G. W. BALFOUR,
President of the Board of Trade.

12th January, 1903.

Approved—

H. T. ANSTRUTHER,
H. W. FORSTER,
Lords Commissioners of His Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

A. Form of Application for Patent.
A1. „ „ „ communicated from abroad.
A2. „ Application for Patent under International and Colonial arrangements.
B. „ Provisional Specification.
C. „ Complete „
C1. „ Postal request for Printed Specification.
D. „ Opposition to Grant of Patent.
E. „ Notice that Hearing will be attended.
F. „ Application to amend Specification.
G. „ Opposition to Amendment of Specification.
H. „ Application for Grant of Compulsory Licence or Revocation of Patent.
H1. „ Petition for Grant of Compulsory Licence or Revocation of Patent.
I. „ Opposition to Petition for Grant of Compulsory Licence or Revocation of Patent
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 or other Document in Register.
N. „ Application for Duplicate of Patent.
O. „ Notice of Intended Exhibition of Unpatented Invention.
P. „ Request for Correction of Clerical Error.
Q. „ Certificate of Comptroller.
R. „ Notice for Alteration of an Address in Register.
S. „ Application for Entry of Order of Privy Council in Register.
T. „ Appeal to Law Officer.
U. „ Application for Extension of Time for leaving a Complete Specification.
V. „ Application for Extension of Time for Acceptance of Complete Specification.
W. „ Patent.
X. „ Notice of Desire to have Patent Sealed.

FORM W.

FORM OF PATENT.

EDWARD VII., by the Grace of God, of the United Kingdom of Great Britain and Ireland, and of the British Dominions beyond the Seas, King, Defender of the Faith, Emperor of India: To all to whom these presents shall come greeting:

WHEREAS

hath declared that he is in possession of an invention for

that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention:

And whereas the said inventor (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as "the said patentee") hath by and in his Complete Specification particularly described the nature of his invention:

And whereas We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted

on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned:

Provided that these our Letters Patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our Letters Patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these Letters Patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at or 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

[*Here is to be inserted the name of the Comptroller-General.*]

Comptroller-General of Patents, Designs, and Trade Marks.

Seal of Patent Office.

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. At Charlton, once a centre of the ancient wool industry, a number of leaden seals were recently discovered, dating from the fourteenth century, and formerly used in packing bales of wool. Most of these carried a distinctive mark, one of them (by way of example) bearing the device of a goat together with the letters "M.S." Such marks 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

Mediæval merchants' marks.

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 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 abonte
Wyth merkes of merchauntes
Y-medeled betwene."

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 last 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

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*.

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.

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. 827):—"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

Persons entitled to acquire and use trade marks.

(*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* 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; *Radde* v. *Norman*, [1872] L. R. 14 Eq. 348).

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.

Trade Marks Registration Acts, 1875 to 1877.

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

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.

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 — Additions and disclaimers.

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:—

Not necessary to disclaim name or address.

(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.

Section 74 of the Act, which must be considered in conjunction with Section 64, and which deals with the somewhat complicated question of "added matter" in old and new marks, and the duty of disclaimer by the applicant, will be explained in the latter part of this chapter.

Definitions amplified.

The foregoing definitions under Section 64 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, so long as the later manufacturer takes care to distinguish his goods from those of his older and better-known rival in business. 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 when the defendant's name is in fact the same as the plaintiff's, 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 *Brooks* 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

Restraints upon the use of a man's own name.

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, in certain circumstances, be restrained from using his own name at all or in a certain way in connection with specific goods which have become specifically identified with the name of an old-established firm of the same name, although no fraud is proved. In *Valentine* v. *Valentine* ([1900] 17 R. P. C. 673) the defendant company were enjoined from using their corporate name "Valentine" in connection with "Meat Extract," a well-known commercial article, and indeed the only article they manufactured. In *Cash* v. *Cash* ([1902] 19 R. P. C. 181) the defendant was restrained from using his own name in connection with certain goods which had become specifically identified with the plaintiff's name, such as "Cash's Frillings," or "Cash's Woven Names and Initials," &c., although he was not restrained from trading in other small-ware goods under his own name so long as he clearly distinguished his goods from those of the plaintiff. The order in the Court below had practically restrained him from using his own name at all in this class of trade; but this was modified by the Court of Appeal. Apparently the Court will not restrain a person absolutely from carrying on business in his own name, although there are conceivable circumstances where even this might be done. 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.

Valentine v. *Valentine.*

Cash v. *Cash.*

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 registrable *per se*, is a trade mark maintainable at Common Law, but subject to this disadvantage, that the owners cannot always prevent others of the same name from using

Burgess v. *Burgess.*

it also for the same class of business, so long as such others use it honestly and in such a manner as to clearly distinguish their goods.

Name only registrable when reproduced in distinctive manner.

However, as has 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. But the written signature must be the personal trading name of the individual or firm, not merely the fancy trading name. Thus a written signature of "The Tip-top Tea Coy." would be bad. But a trade name distinctively printed or a written signature complying with the requirements and 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; that is to say, the trading name of "The Tip-top Tea Coy." might be registered if printed or produced in some particular and distinctive manner.

Signature.

Signature must be actual name.

Thirdly.—(c) A distinctive device, mark, brand, heading, label, or ticket.

Device, brand, &c.

Distiuctiveness.

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, 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 (*Rowland* v. *Michell*, [1897] 1 Ch. 71; 14 R. P. C. 37).

But a well-known or a notorious portrait or picture might not be "distinctive" as a registered device for application to goods, especially if it had been used by others in connection with the same class of goods, although never as a mark placed on the goods. For instance, a copy of Gainsborough's portrait, "The Duchess of Devonshire," was held not distinctive as a trade mark applied to millinery goods, it having been used pictorially and for the purposes of advertisement in other businesses of the same nature prior to registration (*Louise* v. *Gainsborough*, [1902] 20 R. P. C. 61).

It seems that "device" does not include a word or arrangement of letters however distinctively combined (*ex parte Stephens*, [1876] 3 Ch. D. 659).

Marks for subdivision. 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 (*Dausman* 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. Even when arranged as a monogram or design alone or in combination with some device the registrability of initials seems doubtful (per Jessel, M. R., in *Lucke* v. *Webster*, [1879] unreported).

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" refers to adhesive or other papers bearing the trade mark and capable of being secured to 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 or firmly attached to the goods. Sometimes the term "label" or "ticket" is used indifferently to describe the same attachment. The examples of "tickets" which most readily suggest themselves are the tickets pinned to the wares of a fancy goods dealer or a clothier.

Fourthly.—(*d*) An invented word or invented words.

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 "Acilyton"; 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

Fancy words under the Act of 1883.

In re Van Duzer.

Definition of "fancy words."

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 "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 Courts 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

House of Lords on bygone decisions *re* fancy words.

"*Satinine*" Case.

Erroneous reading of Sub-section (*d*) by Patent Office.

register the invented word "Somatose," which had been refused, the majority of the Court of Appeal sustained the Comptroller in his refusal. "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 fanciful 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.

"*Somatose*" Case.

Increasing difficulties in registering invented words.

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's Photographic Co.'s Application*, [1898] 15 R. P. C. 476). Any person 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 upon 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 "Sólio" was audaciously descriptive of the character of the goods, and for this reason the application was refused. The Court of First Instance and also the Court of Appeal sustained the Comptroller in his refusal to register, but the House of Lords were of a different opinion, and ordered registration. In their judgment the House took a revolutionary view of the question as compared with the existing practice, and 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

"*Solio*" Case. Reversal of the former practice.

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.

covert allusion to the character or quality of the goods. The word need not be wholly meaningless. In short, almost all of 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.

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. *Wagel*, [1900] 17 R. P. C. 266).

"*Savonal*" for soap.

"*Tachytype*" for type machines.

"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. But before taking this as an accepted ruling the reader should consider the later case of *Hommel* v. *Gebrüder Bauer* ([1904] 22 R. P. C. 43). Here the word "Hæmatogen" was applied by the plaintiff to a proprietary medicine and registered as an invented word. But on proof that the word had been invented seven years previously by a German chemist, and had been used in one or two scientific publications as describing a new scientific product, both before and after registration, the action was dismissed and the mark removed from the Register. According to Vaughan Williams, L. J., in this case, if the word has a primary meaning even when limited to the members of one learned profession, it is difficult to establish that in a particular trade it has lost its primary meaning and acquired the secondary meaning indicating the goods of a particular maker. "Tabloid," as applied to small medicinal tablets, was upheld as having been a distinctive fancy word not known or in common use at the date of registration in 1884 (*Burroughs, Wellcome & Co.'s Marks*, [1904] 21 R. P. C. 217). But the word "Bioscope" for cinematographic apparatus was struck off as having been used to describe such apparatus before registration, and therefore not an invented word (*Warwick Co.* v. *Urban*, [1904] 21 R. P. C. 240). "Electrozone" for electrically

Limited prior use of registered word.

"*Tabloid*" Case.

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. 477).

Limitation of general application of "Solio" judgment.

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. "Absorbine," which was registered as a trade mark for an absorbent ointment, was removed from the Register as not being an invented word within the Statute (*Christy* v. *Tipper*, [1904] 21 R. P. C. 755). 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* ([1902] 19 R. P. C. 281) 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; probably had the "Solio" Case been decided, Mr. Justice North might not have held, as he did in *Mealy* v. *Triticine Co.* ([1897] 15 R. P. C. 1), that the mark "Triticumina" 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 *Bovril Trade Mark* ([1896] 13 R. P. C. 382), in which the word "Bovril" was held by the Court of Appeal to be a fancy word not in common use at the date of registration, and not descriptive, and therefore properly registered. It

Syllabic terminations or misspellings.

"Uneeda" Case.

"Pirle" Case.

"Triticumina" Case.

"Bovril" Case.

might have been thought that "Bovril" suggested concentrated beef to the ordinary mind much more than "Triticumina" suggested ground wheat. But in the "Bovril" 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 may be registered.

The meaning of the fifth heading—Sub-section (*e*)—was discussed in the Court of Appeal in *Holt & Co.'s Trade Mark* ([1896] 13 R. P. C. 118). The registered mark 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. "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. 699). "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).

Examples of selected words as trade marks.

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 that 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.

Geographical words excluded.

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, or as an essential particular of a trade mark, by a rival manufacturer. Hence a possible discouragement to trade, which it is no part of the public policy to countenance.

Reason for exclusion.

Present-day 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 present-day 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. 651). 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 (*e*), 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 *Van 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 such connection 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; *Grand Hotel Co. of Caledonia Springs* v. *Wilson*, [1904] 21 R. P. C. 117).

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, reasonably well known, 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. *A fortiori*, 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 still 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 unregistrable, 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, 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 and read together 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. In either case, just as in Section 64, the applicant must state what are the essentials of his trade mark, and must disclaim any right to the exclusive use of the added matter save 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.

Sections 64 and 74, as amended by the Act of 1888, and their interdependence, have been considered by the Courts in several important cases. Apart from the provisions as to old marks under the heading (*a*), and the provision giving effect to the "three mark rule" in Sub-section 3 of Section 74, it almost seems as if the remainder of Section 74 is unnecessary in view of Section 64 as amended by the Act of 1888. Section 64 says distinctly that the applicant must state the essential features of his mark, and must disclaim the added letters, words, or figures which he does not consider essential. Section 74 (Sub-section 2) repeats the latter part of Sub-section 2 of Section 64 verbatim, the only apparent difference being that in (*b*) of Sub-section 1 of

Distinction between Sections 64 and 74.

Section 74 the word "distinctive" is used to qualify the phrase "word or combination of words" which might appear as matter added to a new mark. As a matter of fact, the discussions in Court of these two sections and their differentiation have all raged round this word "distinctive." The term as used in the section does not mean unique or novel, or for the first time distinctive in itself,

Meaning of "distinctive" in Section 74.

i.e. something which in itself could be registered as a trade mark, for such a conclusion is negatived by the phrase in (*c*) Sub-section 1 of Section 74, "though the same is common to the trade." It is clear, as Chitty, J., pointed out in *Burland* v. *Broxburn Oil Co.* ([1889] 6 R. P. C. 482), that if common to the trade it cannot be "distinctive" in that sense, for then it might be an essential particular. The real meaning as imputed by this section is "distinguishing" as compared with the goods of other makers, or "descriptive," which sometimes carries the same qualification, and if so it cannot be an "essential particular" of the mark, and would be liable to disclaimer under Sub-section 2 of Section 64. For these reasons it might well be maintained that Section 74 (saving the clauses as to old marks or the three mark rule) is already covered by Section 64.

"Distinctiveness" as interpreted by the Court.

The decided cases bear out this contention, for wherever the added words or combination of words have proved to be mere harmless, non-distinguishing, or non-descriptive (in the sense that anyone might use the same descriptive term), or non-geographical words, they were held to be "non-distinctive," and therefore not subject to disclaimer; and exactly the same result would have followed under Section 64. Thus in *Smokeless Powder Co.'s Trade Mark* ([1892] 9 R. P. C. 109) the words "Smokeless Powder" were part of the label. 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" were not "distinctive" words—*i.e.* not "distinguishing" words (though common to the trade)—were not so in fact, because they were so common to the trade; that they were part of the applicant's trade name and formed *part of the label*, and that no disclaimer was necessary, and that the motion should be refused. In *re Trade Mark of Clement & Cie.* ([1899] 16 R. P. C. 611) the Court of Appeal held that the words "St. Raphael" written across the label were not a "distinctive" or distinguishing, or descriptive or geographical, addition to the mark, but were part of it, and that no disclaimer was required. But

"Smokeless Powder" Case.

here again it should be noted that "St. Raphael" formed part of the name of the registering company. Another decision under the same sections, but as amended by the Act of 1888, occurred in *re Faulder's Trade Mark* ([1901] 18 R. P. C. 535). The mark consisted of the firm's signature with the added word "Silverpan," which was found common or open to the trade to this extent, that other makers had, prior to registration by Messrs. Faulder, described their goods as prepared in silver pans. The defendants had been sued for infringement of the mark and 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 in a measure 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 registration intended to be "distinctive" within the Statute, that it should have been disclaimed on application, and that the mark must be expunged. If the test that has been proposed is applied to this latter case, it will be found to hold good. The evidence showed that others besides the plaintiffs had used so-called silver pans in boiling jam, before the date of registration, that they had said so in their advertisements, and would therefore have been justified in using the words in describing their manufacture. In addition to this the term was clearly descriptive and "distinguishing," as seeking to distinguish the plaintiffs' goods from those of others by the superior mode of manufacture. Therefore the word was "distinctive" within the section. Besides, being descriptive and consisting of two ordinary English words run together, it was clearly unregistrable as a trade mark *per se*. Unaided by some such test as the writer has ventured to suggest, a consideration of the various cases is apt to leave a somewhat confused impression on the mind, and some of the most able Judges have remarked upon the extreme difficulty of deciding what should or should not be disclaimed in the

"Silverpan" Case.

case of labels and marks having accompanying or superimposed added matter or words or combinations of words. Perhaps it will assist the reader if a selection of reasonably typical cases is put before him. These would include the following:—*Burland's Trade Mark*, [1889] 6 R. P. C. 482 ("Washerine"); *Smokeless Powder Co.'s Trade Mark*, [1892] 9 R. P. C. 109 ("Smokeless Powder"); *Clement's Trade Mark*, [1899] 16 R. P. C. 611 ("St. Raphael"); *Faulder's Trade Mark*, [1901] 18 R. P. C. 535 ("Silverpan"); *Royal Baking Powder Co.'s Application*, [1902] 19 R. P. C. 261 ("Royal").

Typical "distinctive" additional cases.

In *Burland's Case* the word "Washerine" appeared on the label in conjunction with the firm's signature. Held, that it was a "distinctive" word, being also descriptive and not registrable *per se* as a "fancy" word, and therefore subject to disclaimer.

"Washerine."

In *Faulder's Case* the word "Silverpan" was registered in conjunction with the firm's signature. Held, that the word was distinctive (*i.e.* distinguishing) and descriptive and not in itself registrable as a trade mark, and should have been disclaimed.

"Silverpan."

In the *Smokeless Powder Co.'s Case* the company had registered a label carrying the design of a target and the words "Smokeless Powder Co., Ltd." Held, that the words "Smokeless Powder" were not descriptive (non-distinguishing), were a part of the applicants' trade name, and need not be disclaimed.

"Smokeless Powder."

In *Clement's Case* the words "St. Raphael" appeared written across the ornamental device, and also appeared on a separate label of directions. Held, that as to the ornamental label the words were non-distinguishing, non-geographical, not an addition to the mark but part of it, and need not be disclaimed. *Per* Romer, L.J., that the separate direction label was an addition within Section 64, and was not *primâ facie* "distinctive" (*i.e.* "distinguishing") under Section 74, and need not be disclaimed. At this point, let it be remembered, the learned Lord Justice was speaking of the unamended Section 64 of the Act of 1883, which said nothing about disclaimer. *Per* Lindley, M. R.: "I am not going to lay down any general

"St. Raphael."

principle for distinguishing what are parts of the mark or what are additions to it. I can easily see that there may be cases in which it is extremely difficult to say which is which." *Per* Romer, L. J.: "I desire to say this, that this judgment will in no way, I think, give rise to any idea that it would sanction the registration of words which in themselves would not constitute a proper trade mark merely because some flourishes were colourably put around them to try and make out a distinctive label—a compound label—when in fact what was really sought to be registered and intended to be registered were the words alone."

"Royal Baking Powder."

In the *Royal Baking Powder Co.'s Case* the company applied to register what they called "a distinctive label" consisting of a device portion with the superimposed words "Royal Baking Powder," and another part containing directions for use together with the words "Royal Baking Powder." The Comptroller required the applicants to disclaim all the added matter except their own name and the devices. On reference to the Court it was held that the direction portion of the label was "added matter" which should, under Section 64 as amended by the Act of 1888, be disclaimed, and this disclaimer extended to the words "Royal Baking Powder" on the device portions. It appeared that what the applicants were really seeking to reserve to themselves was the phrase "Royal Baking Powder," which they meant to be "distinguishing" and which they could not register *per se*. So in *Faulder's Case* the plaintiffs were really seeking to secure the unregistrable word "Silverpan." It therefore appears that the warning of Romer, L. J., just quoted in *Clement's Case*, was by no means uncalled for.

An essential particular is not added matter.

Of course if the added word or combination of words is novel, unique, and capable of registration *per se* as a trade mark, that is to say complies with all of the requirements of Section 64, then it is not "added matter," but is an "essential particular" of the label or mark, and being pointed out in the application as such is not subject to disclaimer. Any such essential particular of a label, if taken by another, would justify an action for infringement. But, generally speaking, a registered

label containing letterpress can only be infringed by imitating the label, not by appropriating the letterpress. As was plainly laid down in *Hudson's Marks* ([1885] 3 R. P. C. 155), and in *Atkin's Mark* ([1886] 3 R. P. C. 164), no one by registering descriptive words in common use as an addition to a device can under the Statute acquire any right to the exclusive use of such words.

Practical directions as to disclaimer.

To crystalise the foregoing matter into plain directions to an applicant for a mark of this compound nature at the present day, in considering the mark the questions should always be asked—Is the added matter "distinctive" within the Statute, *i.e.* does it distinguish or point to the character of the goods as compared with those of other manufacturers?; or, if not "distinguishing" in this sense is it, or at any time was it, *primâ facie* distinguishing, or has it acquired or is it open to be contended that it has acquired a distinguishing significance in the trade?; or is it descriptive or eulogistic?; or geographical?; or an invented word not fulfilling the requirements of Section 64?; or not registrable in itself as a trade mark? If the answer to any one of these questions is in the affirmative, then, generally speaking, the added matter should be disclaimed. When a device label is accompanied by printed instructions for use, this portion should be disclaimed. The applicant can no longer shelter himself under the plea that *the whole label*, including added matter of this nature, is the "essential particular." This contention was waived aside by the Court in the *Royal Baking Powder Co.'s Case* (*supra*). In *Clement's Case* (*supra*) the directions portion of the label was saved by the date of registration. The amendments as to disclaimer now incorporated in Section 64 did not then exist.

Old marks.

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 not within the definitions of Act of 1883.

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 them out from registration would have meant the infliction of considerable hardship. A side door was, therefore, opened by Section 64, Sub-section 3 (ii), 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.

More transit of the goods not user.

Similarity of many old marks.

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.

Three Mark Rule.

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 (*re Hughes and Young's Trade Mark*, [1893] 10 R. P. C. 369).

If in use by more than three persons mark now held common to the trade.

Three Mark Rule adopted in Act of 1883.

This Three Mark Rule is given effect to in Section 74, Sub-section 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 *Thewlis and Blakey's Application* ([1893] 10 R. P. C. 369) 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 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*.

But must be expressly disclaimed.

Rule 18 of the "Instructions" issued by the Comptroller runs as follows:—

Comptroller's Rules as to common additions in old and in new marks.

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 Bryne in *Wright and Crossley's Application* ([1900] 17 R. P. C. 399), "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*, [1889] 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 placed him in a position to sue for infringement of his trade mark in addition to and independently of his Common Law rights.

Certificate of refusal to register.

Section 77 of the The Patents Act, 1883, preserves this arrangement, and is as follows:—

Section 77.

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 as 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 (*re König & Ebhardt*, [1896] 13 R. P. C. 449).

(*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. Inter-national Conven-tion.

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 require-ments.

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 *Californian 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 character of 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.

Consent of prior registered owner.

In a doubtful case the Comptroller 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.

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.

"*Dome Blacklead*" Case.

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).

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.

Name marks.

The remaining forms a trade mark may assume are—

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.

Summary of prohibitive rules as to trade marks.

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:—

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 words 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, "Bunter'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. 570, 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. *McAdam*, [1866] 36 L. J. Ch. 228; *Ransome* v. *Graham*, [1882] 51 L. J. Ch. 897); and in any proceedings by the owner this would be a most effectual weapon in the hand of a defendant (*Cheavin* v. *Walker*, [1877] 5 Ch. D. 850). 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. 638), 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 registor.

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 marking 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.

Representation of mark.

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 which follow the last chapter of this portion of the work at p. 382.

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

Marks registered for miscellaneous goods.

Registering marks for goods not traded in.

directly in the interests of applicants, seeing that registration in respect of goods not traded in may afterwards be 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 *Batt* v. *Dunnett* ([1899] 16 R. P. C. 411). The right of aggrieved persons to expunge marks improperly registered for goods in which no trade was done, has been not even questioned. (See also *Suter, Hartmann's Marks*, [1901] 19 R. P. C. 42.)

Edwards v. *Dennis.*

Even where the owner of the registered mark actually deals in certain goods included in the registration, if he does not apply the mark to such goods his registration may afterwards be limited to the actual use he makes of it (*Hart's Mark*, [1902] 19 R. P. C. 569).

Practically, there is no difficulty in getting the Court to expunge or limit a trade mark registered in this improper manner.

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.

Three 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 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 an 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 non-conformity 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.

Appeal to Board of Trade.

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.

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.

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.

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. Should either of the parties be dissatisfied with the decision he may appeal to the Board of Trade. Notice

Appeal to Board of Trade.

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.

Hearing by Board.

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 Cutler's 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 Act of 1883.

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, 1889, 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

Renewal.

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 an additional fine of 10s. is imposed. But even if the three

Restoration of mark to Register.

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

The intention to abandon must be apparent.

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. *Boehm*, [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 (*re Grossmith*, [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.

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).

A misrepresentation that a mark is "registered," when in fact it is not so, might also cause refusal to register in the event of application being made to the Comptroller. But if such misrepresentation has been made under a *bonâ fide* mistake the Court will generally order the application to be proceeded with (*Altman's Application*, [1904] 21 R. P. C. 753).

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 Amendment 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 (*re Ralph*, [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 by the applicant or by another trader on the same class of goods and prior to registration is no reason for removing it from the Register (*Monson* v. *Boehm*, [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. 369) under the "Three Mark Rule" (see p. 283), 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).

American rule *re* originality of mark.

As to mere prior publication of a word which has been registered as a trade mark see Mr. Justice Cozens-Hardy's remarks in *Linotype Company's Application* (No. 2) ([1900] 17 R. P. C. 380). But where the substance of the mark has been commonly used for advertising or pictorial purposes (although never actually applied to goods) by others in the same trade prior to registration, the mark is liable to be expunged (*Louise* v. *Gainsborough*, [1902] 20 R. P. C. 61). In *Verity's Trade Mark and Hall and Woodhouse's Application* ([1901] 19 R. P. C. 58) the applicants had registered a "Badger" for beer in 1875. In 1882 they extended their business to aerated waters but did not apply the mark to such goods, although it

Prior publication of word mark.

Advertisement may destroy distinctiveness.

Mere advertisement not user.

was advertised generally in their circulars. In 1901 they applied to extend the mark to aerated waters, but the application was refused because of *Verity's* registration of a "Badger" for such goods in 1888. The applicants' motion to expunge *Verity's* entry and put their own mark on the Register was dismissed, the Court holding that mere advertisement did not constitute prior user which would oust *Verity* and entitle the applicants to registration.

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 *primâ 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. *Rawson*, [1890] 8 R. P. C. 89).

But registration must have been *ab initio* good.

If not, it is clear that the title can be challenged, even after the expiry of five years. As Jessel, M. R., 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.

Rectification of Register. Sections 90, 91, 92.

There are three sections in the Act which provide for rectification of the Register. Section 90 relates to cases wherein any persons 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.

Section 90 is as follows:—

Expunging or varying registered mark.

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.

Trial of issue.

(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.

Notice of order to Comptroller.

(3) Any order of the Court rectifying a Register shall direct that due notice of the rectification be given to the Comptroller.

Persons aggrieved.

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 anyone's mark—then, as was said in *Rose* v. *Evans* ([1879] 48 L. J. Ch. 618), "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. Cas. 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 Rivière* ([1884] 26 Ch. D. 48), 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." An extreme illustration of a merely "sentimentally" aggrieved person is to be found in *Ellis & Co.'s Marks* ([1904] 21 R. P. C. 617), where the Society of Friends applied to remove from the Register the word "Quaker" for use on fermented liquors or spirits. Lord Justice Fry, in *Apollinaris Co.'s Case* ([1891] 2 Ch. 186), 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

The grievance must not be merely in gross.

Must refer to a real or probable injury or loss.

in the future exclude, a rival from a portion of that trade into which he desires to enter, this rival is an aggrieved person."

Defendant in an action is aggrieved.

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 of the plaintiff or opponent expunged (*re Ralph*, [1883] 25 Ch. D. 194; *re Wragg*, [1885] 29 Ch. D. 551; *re Hughes and Young*, [1893] 10 R. P. C. 369).

Grounds for application to expunge.

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 & Butler*, [1886] 32 Ch. D. 247; *Barlow* v. *Johnson*, [1890] 7 R. P. C. 395). 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 showed some connection between cameras and cycle fittings, and therefore fitted in with the remarks of Fry, L. J., in the *Apollinaris Co.'s Case* (*supra*).

The same mark might be registered by another person for different goods.

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."

Reasons for expunging mark.

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.

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.

Device marks expunged for similarity to other marks.

As regards devices, in *Anglo-Swiss Milk Co.* v. *Metcalf* ([1886] 31 Ch. D. 454; 3 R. P. C. 28) the word "Dairymaid," with a half-length stencilled 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 mark for cider consisting of half an apple with the word "Pomril" written across it was held too near to a circular 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. As to colour in marks it may be said in passing that Romer, L. J., in *Bass, Ratcliff & Gretton's Marks* ([1902] 19 R. P. C. 539), stated that "It is wrong to say that in the case of old marks the question of colour can be wholly disregarded—the question must be left open for further consideration." In *Marechal* v. *M'Colgan* ([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

Question of of colour in marks.

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* ([1874] 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 *Goodwin* v. *Ivory Soap Co.* ([1900] 17 R. P. C. 682) 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." In *McCue* v. *Nickols* ([1903] 21 R. P. C. 15) "Securine" was held to infringe "Secotine." 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) "Oomoo" was held different from "Enu." In *Coleman* v. *Brown* ([1899] 16 R. P. C. 619) "Vinealis" was held different from "Winearnis." In *Meaby* 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 ("File Label"); *re Palmer*, [1883] 24 Ch. D. 504 ("Braided Fixed Stars"); *re Hayward*, [1885] 54 L. J. Ch. 1003 ("Coker Mats"); *Thompson* v. *Montgomery*, [1891] 8 R. P. C. 361 ("Stone Ale"); *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 improperly registered.

Marks common to the trade: *Re Wragg*, [1885] 29 Ch. D. 551 ("Syphon and Glass"); *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 classes of goods not traded in: *Edwards* v. *Dennis*, [1885] 30 Ch. D. 455 ("Neptune"); *re Apollinaris Co.*, [1891] 2 Ch. 186 ("Friedrichshall Water"); *Batt* v. *Dunnett*, [1899] 16 R. P. C. 411 ("Butterfly" for Oats); *Anglo Swiss Milk Co.* v. *Pearks, Gunston & Tee*, [1904] 21 R. P. C. 261 ("Milkmaid Brand" for Butter). Marks improperly registered for goods not traded in.

Marks improperly registered by someone other than principal.

Marks improperly registered by agent without owner's consent: *Ex parte Lawrence & Co.* ([1878] 44 L. T. N. S. 98, *n.*); and by foreign importer's agent, *re Apollinaris Co.* ([1891] 2 Ch. 186).

Non-distinctive and possessive name marks.

Name marks not registered in distinctive form: *Re Edge*, [1891] 8 R. P. C. 207 ("Edge's Filtered Blue"); *re Gianaclis*, [1889] 6 R. P. C. 476 ("Gianaclis' 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: *Re Palmer*, [1883] 24 Ch. D. 504 ("Braided Fixed Stars," Vestas); *re Arbenz*, [1887] 4 R. P. C. 143 ("Gem," Air Guns); *re Talbot*, [1894] 11 R. P. C. 77 ("Emolliolorum," Saddle Paste); *re Davis*, [1897] 14 R. P. C. 903 ("Compactum," Umbrellas); *Burland* v. *Broxburn Co.*, [1889] 6 R. P. C. 482 ("Washerine," Soap); *re Edge*, [1891] 8 R. P. C. 207 ("Filtered Blue"); *Meaby* v. *Triticine Co.*, [1897] 15 R. P. C. 1 ("Triticumina," Meal), but this latter is more than doubtful since the "Solio" Case.

Proprietor having no established business.

Marks improperly registered, proprietor having no business established: *Re Ralph* (*supra*) ("Homewasher"); *Batt* v. *Dunnett* (*supra*).

Marks exactly similar to other marks in cognate classes.

Mark exactly similar to mark already registered in other classes of goods held calculated to deceive: *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. *Lambert & Butler*, [1886] 3 R. P. C. 81; 32 Ch. D. 247 ("Eton" Cigarettes made in London); *re Hill*, [1893] 10 R. P. C. 112 ("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 *Batt* v. *Dunnett* (*supra*); or by entering a disclaimer of certain parts, as in *Baker* v. *Rawson* and *re Edge* (where the word "Filtered" was ordered to be disclaimed).

Applicant to expunge connot 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 is also 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 to make unimportant alterations.

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.

Proprietor may delete trade mark from Register.

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.

Section 92 provides—

Registered proprietor may apply to Court to alter mark in non-essential particulars.

92. (1) The registered proprieto. 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.

Procedure in applying to the Court.

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 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 was afterwards 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 Holbrooks' Marks*, [1901] 18 R. P. C. 447). Generally speaking, alterations in firm style, business appellations, addresses, and statements that may by lapse of time or change of circumstances have become inaccurate, are allowed to be corrected; and the Comptroller will not always instruct counsel to appear on his behalf if suitable undertakings are given (*re Davenport's Mark*, [1904] 21 R. P. C. 726). It was held in *New Ormonde 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*, [1888] 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 Ermen 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. 449). Necessary

Addition of "Limited" to proprietor company's name.

alterations are allowed if possible. For instance, the addition of "Limited" to the name of a company which has become limited is always allowed (*Guinness & Co.'s Trade Mark*, [1888] 5 R. P. C. 316); and in *Maw's Mark* ([1902] 19 R. P. C. 260) the word "Thompson" was struck out and "Sons" inserted in an old mark. An application to omit the words "Trade Mark" from an old mark has been refused (*Phillips' Trade Marks*, [1891] 8 R. P. C. 469); 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).

Striking out of word "Patent."

Alteration of non-essential particulars from one language to another.

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 Brown's Marks*, [1894] 11 R. P. C. 365); and *Maw's Mark* (*supra*). In *Cockle's Mark* ([1903] 20 R. P. C. 353) an old label mark was allowed to be altered by changing the address and adding "Great Britain" beneath "London."

Alteration of possibly misleading item in label.

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). But in the later case of *Bass's Marks* ([1902] 19 R. P. C. 529) Romer, L. J., disapproved of any general application of the dictum of Fry, L. J., in the *Apollinaris Case* (*supra*), and

Re Colman's Marks.

said: "It ought not to be assumed in every case whenever you see the words 'trade mark' on a label that it must be intended solely to refer to the particular part of the label on which it is placed."

Rectification proceedings usually taken in Chancery.

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.

Jurisdiction of Irish and Scotch Courts.

The Irish Court has held that it has no jurisdiction 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 (*Coerie* 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 (*Thewlis and Blakey's Mark*, [1893] 10 R. P. C. 369).

Discovery.

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).

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 may 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 assignee what it indicated in hands of assignor.

When the mark is indicative of origin, it must, in the hands of the assignee, indicate what it indicated in the 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 these goods which are dealt with in that part of the business, and the use of the marks will be restricted to these 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, 1869, 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 (*Condy* v. *Mitchell*, [1877] C. A. 37; L. T. N. S. 767). But a former partner in a dissolved partnership was, in *Hanson* v. *Game 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*, [1885] 53 L. T. N. S. 1; *Robinson* v. *Finlay*, [1878] 9 Ch. D. 487).

But former partners in dissolved partnership may each carry on and use 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 register as owner.

Form of request.

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 "Dent Diamonds" case, *Hunt* v. *Goodall & Hutton*, [1892] 62 L. T. 217).

Licensing another to use a 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 or substantially 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.

A registered trade mark not being a franchise, some authorities have contended that an action for infringement could properly be tried in a County Court where the damages claimed did not exceed £50. But in *Bone* v. *Hart* ([1905] 22 R. P. C. 222), the Court of Appeal held that although a registered trade mark was not a franchise within Section 58 of The County Courts Act, 1888, the County Court had no jurisdiction, either under that Act or under The Judicature Act, 1873, to entertain an action for infringement of a trade mark.

County Court no jurisdiction.

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

Chancery Court

Provision that the mark should be registered

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."

Or refused.

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.

Statutory right.

Certificate of registration or of refusal.

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 the infringing mark may be easily mistaken for 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.*"

Features of infringement.

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* ([1876] 34 L. J. Ch. 586).

Resemblance.

The actual resemblance may be brought about in labels by arranging the general lines of the printing, colouring, and other general

Resemblance must be considered as a whole.

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 (*Balfour* v. *Kilburn*, 1 Hyde 270); "Rottgen" with two crosses for "Rodgers" with a star and a cross (*Rodgers* v. *Rottgen*, 5 T. L. R. 678). A mustard-tin label, with grouping, colours, and arms similar to that of the plaintiff's, was held to infringe in *Colman* v. *Farrow* ([1897] 15 R. P. C. 198). In words a deceptive similarity may also be created: as, for example, "Condisanitas" for "Sanitas" (*Sanitas Co.* v. *Condy*, [1887] 4 R. P. C. 195, 530); "Steinberg" for "Steinway" (*Steinway* v. *Henshaw*, [1887] 5 R. P. C. 77); "Apollinis" for "Apollinaris" (*Apollinaris Co.* v. *Herrfeldt*, [1887] 4 R. P. C. 478). But there was held to be sufficient difference between "Winearnis" and "Vinealis" (*Coleman* v. *Brown*, [1899] 16 R. P. C. 619). In device marks similarity was held to exist between a bell and a beehive (*Bell and Black* v. *Bell*, Seb. Dig. 514); a diamond containing a "K" and a diamond without a "K" (*Curtis* v. *Pape*, [1888] 5 R. P. C. 146). 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* ([1882] 7 App. Cas. 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.

Instances of general resemblance.

Labels.

Words.

Devices.

Inutility of precedents in deciding cases of resemblance.

Orr-Ewing v. *Johnston*.

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.

Mere physical resemblance not the only guide.

Saxby v. *Powerscourt*.

Lord Cranworth, in his judgment in *Saxby* v. *Powerscourt* ([1868] 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. *Richardson* ([1881] 45 L. T. N. S. 54), where the beer of the plaintiffs having 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'.

Name echo of device.

"Dog's Head Beer" Case.

Another example is to be found in *Orr-Ewing* v. *Johnston* ([1882] 7 App. Cas. 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.

Orr-Ewing v. *Johnston.*

"Two Elephant" Yarn Label.

The infringing use of the mark must be in respect of goods for which the plaintiff has registered and 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*, [1858] 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

The infringement must be on goods similar to plaintiff's.

Modes of applying infringing mark.

Advertisement is infringement.

Jay v. *Ladler.*

a slip among the goods, or even printing the mark on a circular or catalogue offering the goods for sale, will amount to wrongful use of the mark (*Jay* v. *Ladler*, [1889] 6 R. P. C. 136; *Bourne* v. *Swan & Edgar*, [1902] 20 R. P. C. 105; or on posters (*Price's Candle Co.* v. *Jeye*, [1901] 19 R. P. C. 17).

Old bottles refilled.

Old cases or bottles or casks bearing the genuine mark must not be used to convey and cover spurious goods (*Barnett* v. *Leuchars*, [1865] 13 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 that the use of the bottles constituted an infringement (*Rose* v. *Loftus*, [1878] 47 L. J. Ch. 576; *Allen* v. *Richards*, [1882] 26 Sol. Jo. 658), and an offence against the Merchandise Marks Act (*Thwaites* v. *McErilly*, [1904] 21 R. P. C. 397).

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 (*Paine* v. *Daniels*, 10 R. P. C. 217; [1893] 2 Ch. 567).

Nor of fraudulent intent.

Neither is there any necessity to prove 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.

Innocent infringer.

He may have acted innocently and without 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 has infringed.

Ultimate deception.

All 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*, [1824] 3 B. & C. 541). Consequently all that has to be done is to show that the trade mark has been taken. *Sykes* v. *Sykes.*

This is the gist of a deliverance by Sir G. Jessel, M. R., in *Singer Manufacturing Co.* v. *Wilson* ([1875-7] 2 Ch. D. 434; 3 App. Cas. 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. 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*, [1863-5] 4 De G. J. & S. 137). Jessel, M.R., in *Singer Manufacturing Co.* v. *Wilson.*

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 Interlocutory injunction should be promptly applied for.

was necessary to secure the requisite evidence to establish the plaintiff's case (*Isaacson* v. *Thompson*, [1871] 41 L. J. Ch. 101).

Usually advisable to warn infringer.

It is advisable, although not necessary, 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.

Endorsement of writ.

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 [------] 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 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 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 upon which the infringing mark had been placed.

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* ([1834] 3 M. & Cr. 338) the defendants, having inadvertently made use of the plaintiff's 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 *Carnuchs* 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

Examples of practice in the case of innocent infringers.

Millington v. *Fox.*

Colburn v. *Simms.*

Plaintiff must act reasonably.

Upmann v. *Elkan.*

Carnuchs v. *Highmoor.*

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 a 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. *Glover* ([1893] 10 R. P. C. 141), and *Rutter* v. *Smith* ([1900] 18 R. R. C. 49), where an application for an injunction, in respect of an isolated sale of an ounce of tobacco under plaintiff's 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.

Jenkins v. Hope.

Rutter v. Smith.

Clarke v. Hudson's Executors.

But submission by defendant must be full and such as plaintiff has a right to expect.

But if the offer made by the defendant under such circumstances falls short of the terms of the writ, or appreciably short of such terms as the plaintiff is entitled to obtain, an injunction will be granted with costs (*McAndrew* v. *Bassett*, [1864] 10 L. T. 65; *Fennessy* v. *Day & Martin*, [1886] 55 L. T. 161). In *Slazenger* v. *Pigott* ([1895] 12 R. P. C. 439), 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.

Practice and a consideration of the cases makes it plain that where the defendant has made reasonable submission, although he may not have granted every whit claimed by the plaintiff, or indeed every tittle to which the plaintiff is legally entitled, the plaintiff may find himself saddled

with the increased or unnecessary costs incurred by his pressing matters to extremes.

Delay in applying for injunction.

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 non-conclusive 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 *primâ facie* evidence of the proprietor's right to the exclusive use of it, while at the expiry of five years such *primâ 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 breadth, and in the case of a mark registered for more than five years would apparently plead something which it is incompetent to plead.

Conclusive or non-conclusive right of plaintiff.

Form of defence.

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 (*Tiuto* v. *Badman*, [1891] 8 R. P. C. 181). 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 Sections 64 and 74 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

Examples of pleas in defence.

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, for instance, as the word "patent" when there is no patent.

Where plaintiff's mark 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).

Limitations of defence.

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,

Application to expunge cannot be by counterclaim.

and a motion to expunge or vary cannot be added to the defence by way of counterclaim (*Pinto* 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. 70) Stirling, J., adjourned a motion for interlocutory injunction to enable the defendant to prosecute a counter application to register his own mark and to move to rectify the Register by expunging the plaintiff's.

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's 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 (*Carter* v. *Pinto Leite*, [1871] L. R. 7 Ch. 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

Names of customers.

Discovery of sales.

customers and all goods sold is usually enforced (*Leather Cloth Co.* v. *Hirschfeld*, [1863] 1 H. & M. 295).

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.

Costs governed by circumstances.

On the other hand, a defendant, even when successful, may be refused his costs if his conduct should not commend itself to the Court. Thus in *Warsop* v. *Warsop* ([1904] 21 R. P. C. 481) the defendant was refused costs because of his misrepresentation that the mark he used was "registered." In *King* v. *Gillard* ([1904] 21 R. P. C. 589) the successful defendants were refused their costs because of untrue statements made upon the

label complained of, but this was reversed on appeal ([1905] 22 R. P. C.).

Costs on higher scale.

Where the case is of great importance and the issues complicated, costs on the higher scale may be given (*Great Tower Street Tea Co.* v. *Smith*, [1889] 6 R. P. C. 165).

Certificate of validity of plaintiff's claim to trade mark.

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 as consolidated, or Section 18 of the Act of 1888). 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.

Costs as between solicitor and client in subsequent action.

Certificate should be pleaded 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. *Chisholm*, [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).

Appeal.

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.

Advancement of appeal.

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).

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*, [1882] W. N. 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 (*Mellin* v. *White*, [1895] App. Cas. 154).

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 or unfair trading 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. *Looy* ([1882] 18 Ch. D. 395; 8 App. Cas. 15), after referring to frauds committed by the infringement of registered trade marks, "There is another way in which goods not the

Name trade mark.

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 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*, [1893] 10 R. P. C. 297.)

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 & Co.* v. *Bentham Hemp Spinning Co.* ([1892] 9 R. P. C. 503), and the latest writers have adopted this term 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.

Reddaway and Co. v. Bentham Hemp Spinning Co.

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), and is so important and so often quoted that a full history of the proceedings may not be out of place. The defendants contended that as the words "Camel Hair Belting" truly described their goods, which were composed substantially of camel hair, they could not

Reddaway v. Banham.

When a certain name has become identified with the goods of a

particular maker its use by others will be restrained.

be restrained from using these words, even without the addition of their name as manufacturers. But the House of Lords were of a different opinion, and held that when words which although properly descriptive of an article have come to have the secondary meaning of denoting 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 descriptive of the goods.

Terms of order in *Reddaway* v. *Banham*.

The order was in the form approved by the House in *Johnstone* v. *Orr-Ewing* (7 App. Cas. 219), and restrained the defendants from using the words "Camel Hair" on belting, *without clearly distinguishing such belting from the belting of the plaintiffs*. Of course, as was pointed out by Herschell, L. C., it was not proposed to prohibit the use of the words "Camel Hair" altogether. The meaning of the order was that the words "Camel Hair," alone and without qualification, meant Reddaway's manufacture and no other. But it left it open to other makers to use the term so long as they made it clear that the belting was not as a matter of fact of Reddaway's make. Thus, "Camel Hair Belting, manufactured by Banham and Co.," or "Banham's Camel Hair Belting" would not have been within the terms of the injunction (*Reddaway* v. *Ahlers*, [1901] 19 R. P. C. 12; *Reddaway* v. *Frictionless Packing Co.*, [1902] 19 R. P. C. 505; *Reddaway* v. *Stevenson*, [1902] 20 R. P. C. 276). In *Reddaway* v. *Stevenson* (*supra*) it was held to be within the terms of the injunction to sell belting as "Camel Hair" even when the words were prefixed by the special brand or fancy name trade mark of the vendor—*e.g.* "Phœnix Camel Hair Belting." In the same case the learned V.-C. went so far as to restrain the use of the words "Stevenson's Camel Hair Belting." But he founded this part of his decision on the fact that the defendants had made certain untrue statements in their circulars, describing themselves as manufacturers and the proprietors of works, whereas they were merely agents or dealers in mill furnishings. Otherwise it must have been difficult to reconcile his decision with his own remarks in the earlier case of *Reddaway* v. *Frictionless Packing Co.* (*supra*), where he declined to draw a distinction between a

manufacturer and a mere agent or dealer. Apparently the Court has discretion to make either party suffer where untrue statements and lack of good faith are brought home to him. Thus, Kekewich, J., in *King* v. *Gillard* ([1904] 21 R. P. C. 589) deprived a successful defendant of his costs because of untrue statements as to medals and awards made upon the labels complained of (see also *Warsop* v. *Warsop*, [1904] 21 R. P. C. 481). But this part of the decision in *King* v. *Gillard* was reversed in the Court of Appeal ([1905] 22 R. P. C.).

"Camel" mark both descriptive and geographical.

The case of *Reddaway* v. *Banham* has been thus fully referred to, partly because although so often quoted its full import is sometimes missed, and partly because it constitutes a salient example of the building up of a right of property in a Common Law trade mark which was both unregistered and unregistrable, seeing that it was not only a geographical name but was also 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] 8 R. P. C. 361), 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.

"Glenfield Starch" Case.

Similar considerations weighed in deciding *Wotherspoon* v. *Currie* ([1872] L. R. 5 H. L. 508), the "Glenfield 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. Cas. 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 "Holbrook'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."

Secret recipe.

A person making his goods from a secret recipe has a right to the sole use of the name so long as he preserves his secret.

"Angostura Bitters" Case.

the composition of which was a secret (*Siegert* v. *Findlater*, [1878] 7 C. D. 801). 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; *Escourt* v. *Escourt Hop Essence Co.*, [1875] L. R. 10 Ch. 276). But this holds good only where a positive breach of trust has occurred.

Improper use of trade secret.

The "Camel Hair" Case is thus representative of that class of Common Law mark which by original and continued user becomes, *per se* and in its unqualified form, 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, except with the addition of some qualification which will clearly point out its source of origin and distinguish it from the goods of the owner of the unqualified mark. 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, and the appropriated name of which they cannot use either with or without distinguishing qualifications. But the acquirement of such Common Law rights, and the stamping of a term, especially when descriptive, with the secondary meaning which connects it in the mind of the public with the goods of a particular manufacturer, is generally a matter of time and undisturbed possession. In *Weingarten* v. *Bayer* ([1903] 20 R. P. C. 649) the unregistered term "Erect Form" as applied to corsets was held descriptive, and not to have been so long identified with the plaintiffs' goods as to have acquired the secondary meaning entitling them to hold it in its unqualified form against others. The plaintiffs had only begun the use of the name in the U.S. in 1900. In the beginning of 1901 they had imported quantities of the corsets into England and these were extensively sold and advertised as "Erect Form Corsets." About the end of 1901 the defendants began to

Comparison of typical cases of Common Law marks.

"*Erect Form*" *Corset Case.*

use the name, avowedly with the intention of preventing the plaintiffs from acquiring a prescriptive monopoly. The plaintiffs' action to restrain them was unsuccessful. The adoption by the defendants of a specially printed scroll label carrying the words "Erect Form" was characterised by the Court of Appeal as injudicious, but as the defendants had ceased to use it after issue of the writ, an injunction in respect of this also was refused. On appeal by the plaintiffs to the House of Lords the gist of the judgment of the Court of Appeal was left untouched, but an injunction and inquiry in respect of the scroll was granted ([1905] 22 R. P. C.; see also report in *Times*, 12th April, 1905).

New trade names applied to newly invented products.

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 *Cellular Clothing Co.* v. *Maxton and Murray* ([1899] 16 R. P. C. 397): "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 attached to it during the time when he had the legal monopoly of the manufacture. But, my Lords, the same thing in principle must apply where a man has not taken out a patent, as in the present case, but has a virtual monopoly, because other manufacturers, although they are entitled to do so, have not in fact commenced to make the article. He brings the article before the world; he gives it a name descriptive 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."

The monopoly under a patent cannot be prolonged under a trade mark.

And the monopoly in the new name of a new product which is not patented cannot be retained by the author.

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). 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. This was illustrated in the "Vaseline" Case (*Chesborough Manufacturing Co.'s Marks*, [1902] 19 R. P. C. 342), where the Court of Appeal held that the petroleum jelly to which the name "Vaseline" had been applied was at the date of its baptism a known product open to all the world to make, and that the name "Vaseline" was an invented word applied to an existing and known product, and therefore not within the principle of the "Linoleum" and "Cellular" decisions.

"Linoleum" Case.

"Vaseline" Case.

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," "Cordite," and "Roburite," and which obtains a world-wide fame under that name, and that name only, it would never do to vest the original makers or patentees with a perpetual right to the only name by which the article is, or possibly can be, known to the public.

Decisions directed against the principle of perpetual monopoly.

When a new name is given to a new article of manufacture—such, for example, as "Gramophone" to designate a new type of talking machine, or "Neostyle" to designate

Accessories of patented apparatus sold under new name.

a new type of duplicating machine—it is sometimes asked whether unpatented *accessories* for such machines (such, for instance, as "Gramophone Needles" or "Neostyle Ink") can be sold by others than the owners and sole producers of the new machine or article. The balance of opinion seems to be that they can, especially when the get-up is distinctive (*Neostyle Co.* v. *Ellams*, [1904] 21 R. P. C. 569); *a fortiori* if the name of the actual maker of the accessories is shown on the goods or packets thus—"Horlock's Gramophone Needles" or "Neostyle Ink, made by Ellams & Co."—the right of anyone to make and sell such accessories is unquestionable.

Common Law trade mark: name of locality.

Where a person uses the name of a district as his Common Law mark, the extent of his remedy is usually 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.

"Glenfield Starch" Case must be regarded as exceptional.

Where the goods are a natural product and derive their name from the locality where they are found, the mere name of the locality cannot be appropriated to one vendor.

"Whitstable Oyster" 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); see also *Grand Hotel of Caledonia Springs* v. *Wilson*, [1904] 21 R. P. C. 117).

The use of words too similar to the

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. *Carron Co.* ([1896] 13 R. P. C. 108) the defendants were restrained from using the word "Stafford" to designate their stoves, as being too near the plaintiff's mark "Trafford"; the use of "Savoline" was held to infringe "Savonol" for soap (*Field* v. *Wagel*, [1900] 17 R. P. C. 266); and "Securine" was restrained as a colourable imitation of "Seccotine" (*McCaw* v. *Nickols*, [1903] 21 R. P. C. 15).

plaintiff's mark will be 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 goods of the person who originated that particular get-up. Mr. Justice Kekewich said, in *Jones* v. *Hallworth* ([1897] 14 R. P. C. 225), that in this class of case "the eye is the ultimate judge, guided, of course, or assisted rather, by the various facts which are available." Mr. Justice Byrne, in *Clark* v. *Sharp* ([1898] 15 R. P. C. at p. 146), also said that in cases depending upon what is called "get-up" or "dressing" of the goods the actual issue is not so much whether the Judge or members of the jury might be personally 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. 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, Blue, and Green Coffee Tin" Case (*Payton* v. *Snelling*, [1899] 17 R. P. C. 48, 628). But even when the plaintiff's "get-up" is comparatively recent he may succeed in getting an injunction where intention to imitate is proved and intent to deceive can be inferred from the circumstances, such, for example, as the instructions of the defendant to a designer to make a get-up "exactly like" the plaintiff's (*County Chemical Co.* v. *Frankenburg*, [1904] 21 R. P. C. 722). In this case the plaintiffs began in 1902 to pack repair outfits for tyres in boxes of a certain shape, size, colour, and design. In 1903 the defendant imitated the get-up nearly exactly, though with some slight difference in the lettering. No case of actual deception was proved, but Alverstone, L. C. J., said that the question was: "Is this selection of such similarity as there is, a mere accident

General "get-up."

Deceptive imitative "get-up" will be restrained.

The test is, will the ordinary customer be deceived?

"Red, Blue, and Green Coffee Tin" Case.

Relief against imitation of recent "get-up" may be obtained.

or an innocent act done without any intention of passing off; or is it done in order to imitate the plaintiffs' goods?" As a result an injunction was granted. In *Rowland* v. *Michell* ([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 that 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 *Lever* v. *Goodwin* ([1887] 4 R. P. C. 492) the plaintiffs succeeded entirely on the issue of get-up. Their soap tablets were put upon the market wrapped in imitation parchment printed with instructions in broken or spaced letterpress. The defendants used the same parchment wrapper material printed with instructions of their own composition, but arranged in the same broken or spaced manner as the plaintiffs'. This was held to be a fraudulent imitation. But in another action by the same plaintiffs (*Lever* v. *Bedingfield*, [1898] 16 R. P. C. 3), although the Court of Appeal recognised that some parts of the plaintiffs' wrapper had been taken, yet the general resemblance between the wrappers was not sufficiently close to constitute passing off, and an injunction was refused. The same result was arrived at in *King* v. *Gillard* ([1904] 21 R. P. C. 589), being an action taken by the proprietors of "Edwards' Desiccated Soup" against the defendants for copying their "get-up." Here the resemblance was sufficiently close to cause Joyce, J., in the plaintiffs' motion for interlocutory injunction to give an opinion that the defendants had "distinctly and obviously copied the plaintiffs' labels in certain respects," and to express his surprise that "respectable people should do this sort of thing." Nevertheless, at the trial it was held that the plaintiffs' get-up was not distinctive of their goods only; that the points of

A "get-up" may deceive though details are not copied.

***Per contra* details may be copied without creating deceptive general appearance.**

resemblance between their get-up and that of the defendants were common to the trade; that the defendants' get-up was not calculated to deceive; and that no case of actual deception had been proved. To mark his disapproval of certain untrue statements on the defendants' labels, Kekewich, J., deprived them of their costs, but the Court of Appeal dissented from this ([1905] 22 R. P. C.). In *Schweppes* v. *Gibbens* ([1904] 22 R. P. C. 113) the plaintiffs attempted to restrain the defendant from using a narrow chocolate and white bottle label with red centre piece, which they alleged imitated their own well-known label. Here, again, chocolate and white bottle labels proved to be common property, and no fraudulent imitation of the plaintiffs' details was shown.

Narrow Red Band Cigar Case.

In the *Imperial Tobacco Co.* v. *Parnell* ([1904] 21 R. P. C. 598) the plaintiffs had been accustomed to get up their cigars with a very narrow red band in contradistinction to the wider bands of other makers. At the trial it was proved that other makers had simultaneously used such narrow red bands, and the Court of Appeal held that the plaintiffs had no exclusive right to such narrow bands as distinguishing their cigars from those of other manufacturers.

Prior user of get-up.

In *Colley's Patents, Limited* v. *British Paper Co.* ([1904] 21 R. P. C. 689) the defendants were able to prove that the label, which the plaintiffs contended was an imitation of their get-up, had been used by them and their predecessors in business at a date prior to that when the plaintiffs first used their label, and the action was dismissed.

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 own 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 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 that 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 co-defendant Valentine was restrained from using his own name in any such business *without clearly distinguishing his goods from the plaintiffs'*, but the injunction against the company to which Valentine had given his name was, as pointed out, of a more sweeping nature. In *Dewar* v. *Dewar* ([1900] 17 R. P. C. 341) 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 plaintiffs 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

Qualification by Byrne, J., in *Jamieson* v. *Jamieson*.

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.

Dewar v. *Dewar*.

a man from carrying on business in certain goods under his own name was discussed by the Court of Appeal in *Cash* v. *Cash* ([1902] 19 R. P. C. 181), and there the defendant was restrained from vending certain goods, such as frillings and woven initials, as "Cash's Frillings" &c., but the Court declined to say that under any circumstances, apart from fraud or restraint of another description, a man could be absolutely enjoined from carrying on business in his own name.

Cash v. *Cash*.

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. 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.

"Chivers' Table Jelly."

Plaintiff must always prove long exclusive user.

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 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 recur 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

Names which have *become* public property.

Instances of names which have become *publici juris*.

category. These and other name marks similarly situated would have been of enormous value had their original owners maintained 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 in a measure 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. Cas. 376), the Courts declined to continue a patent monopoly 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.

But where the owners of the name still carry on business it must appear 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 *publici 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 the statutory privilege acquired by 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

No statutory right in action for "passing off."

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 in showing infringement of his registered mark, 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. One instance only of passing off without any intention to continue doing so, or any proof of damage to the plaintiff, has been held not to constitute a ground of action (*Knight* v. *Crisp*, [1904] 21 R. P. C. 670). 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 such alleged deception (*London Omnibus Co.* v. *Lavell*, [1900] 18 R. P. C. 74).

Plaintiff must prove deception or extreme probability of deception.

In action on registered trade mark it is desirable to add claim for passing off.

In delivering his defence the defendant, in addition to a 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

Further points in defence.

abandonment, or for any other reason the defendant may be able to allege. Of course, if the defendant can show he has used the get-up complained of prior to or concurrently with the plaintiff the action must fail (*Colley's Patents, Limited* v. *British Paper Co.*, [1904] 21 R. P. C. 689).

Relief in action for passing off.

If a 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 (*Churton* v. *Douglas*, [1859] Johns. 174; *Holloway* v. *Holloway*, [1850] 13 Beav. 209). As James, L.J., said in *Hendriks* v. *Montague* ([1880] 17 Ch. D. 638): "All the Court requires is to be satisfied that the names are so similar as to be calculated to 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. Cas. 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.

Court must be convinced of the probability of deception.

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 *Foot* v. *Lee*, 13 Ir. Eq. 484). 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

"Get-up" of business premises.

Public vehicles.

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 should 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).

Distinguishing names for business premises.

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 the 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; *Boulnois* v. *Peake*, [1868] 13 Ch. D. 513, *note*; *Bodega Co., Limited* v. *Owens*, [1889] 7 R. P. C. 31).

The right to use the trade name of certain premises may co-exist in different parties in the same trade (*Cooper* v. *Maclachlan*, [1901] 19 R. P. C. 27); and where the proprietor of the "Black Swan Distillery," where gin was made, sold the goodwill and trade mark (a Black Swan) to the plaintiff and the freehold of the premises to the defendant, the defendant was held entitled to carry on the business of a *whisky* distiller at the premises he had bought, and to continue to use the old title and sign of a "Black Swan," and to advertise it as the "Black Swan Distillery" (*Nicholson* v. *Buchanan*, [1900] 19 R. P. C. 321).

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*," 5th ed., p. 539); "The Oldfield Lane Doctor" (*Milner* v. *Reed*, [1870] Sebas. Dig. 328):

Fancy name assumed by plaintiff.

or "Madame Louise" (*Isaacson* v. *Thompson*, [1871] 41 L. J. Ch. 101), where the plaintiff only missed getting an injunction by her own delay.

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."

In *Aerators, Limited* v. *Tollit et al.* ([1902] 19 R. P. C. 418) the plaintiffs sought to restrain the registration of a company as "The Automatic Aerator Patents Limited," but on proof that there was no similarity in the goods dealt in by the defendants with those of the plaintiffs the action was dismissed. Farwell, J., characterised the action of the plaintiffs as an attempt to monopolise generally an ordinary English word.

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. *Montague*, [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 *Tussaud* v. *Tussaud* ([1890] 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 *Tussaud* v. *Tussaud* (*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. *Lee* 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.

A proposal by the defendants to modify the style complained of will be entertained at the hearing, as in

Army and Navy Co-operative Society, Limited v. *Army, Navy, and Civil Service Co-operative Society of South Africa* ([1902] 19 R. P. C. 574). Here the defendants on appeal undertook to change their name to "Naval, Military, and Civil Service Co-operative Society of South Africa, Limited," and submitted to their appeal being dismissed.

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. 153) 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

(*c*) 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— — Vendors 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 1888.

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.

Meaning of "innocently."

But although he may have had no intent to defraud, a defendant is not on that account held to have acted "innocently." As Lord Coleridge said in *Wood* v. *Burgess* (L. R. 24 Q. B. D. 162), "An intent to defraud the purchaser is not a necessary ingredient of the offence charged." Thus a mineral water manufacturer who fills bottles bearing another manufacturer's name moulded thereon is not held to have acted "innocently," although he may have no intention to pass off the contents of the bottles as other than his own manufacture, or although he places his own label on the bottles. The cases dealing with the interpretation of the term "innocently" under the Statute are discussed by Porter, M. R., in the Irish case of *Thwaites* v. *McErilly* ([1903] 20 R. P. C. 663).

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.

Rules of evidence in criminal proceeding based upon those in the civil suit.

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. 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 as would guide the plaintiff seeking an injunction in the High Court, as already explained in foregoing chapters.

Cases under the Act.

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 Sergeant (Sir Forrest Fulton), both the traders who labelled and disposed of the goods and the printer of the labels being found guilty and sentenced.

Reg. v. *Hughes.*

The prosecution was instituted by James Epps & Co., 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.

Reasons for exonerating innocent retailer.

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.

Applying false trade description.

"Hand-made Cigarette" Case.

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 *Kirshenboim* v. *Salmon & Gluckstein* (Div. Ct., [1898] 2 Q. B. 19) 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. But it has been held that to describe children's toy books as being made of "untearable linen" when in fact made of cotton did not constitute a trade description, which was false "in a material respect" (*Rex.* v. *Stoneham*, "*Daily Telegraph*," 19th January, 1905).

False description need not be actually applied to goods.

The false description need not be actually applied to goods. A false description in an invoice referring to the goods is within the Statute (*Budd* v. *Lucas*, Div. Ct., [1891] 1 Q. B. 408; *Coppen* v. *Moore*, Div. Ct., [1898] 2 Q. B. 300; *Cameron* v. *Wiggins*, 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 additional Article X. *bis.* ought to 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.

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, 1889.

Note.—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 herein 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 of 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.

6. For the purposes of trade marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

If any doubt arises as to what class any particular description of goods belongs, the doubt shall be determined by the Comptroller.

Application for Registration.

7. An application for registration of a trade mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be. Application by firm.

If the application be made by a body corporate, it may be signed by the Secretary or other principal officer of such body corporate.

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. Address of application.

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. *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, 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 Trade Marks Rules, 1898.

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 application 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 66 of the said Acts, a representation of each trade mark of the series shall be made or affixed upon the form of application, and also upon each of the separate half-sheets of paper aforesaid.*

Trade Marks Rules, 1887.

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. *Whenever a mark consist 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 66 of the said Acts, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade marks constituting the series; and the Comptroller may, if he thinks fit, insert with

the advertisement of the application a statement of the manner in respect of which the several trade marks differ from one another.

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

Evidence in reply.

[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).

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.

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 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 subsequent 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 conflicting 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 provision 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 in 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.

(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. Advertisement of application made at Sheffield.

(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. Manner of notifying to Cutlers' Company application received by Comptroller.

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. Similarity of proceedings at London and Sheffield.

Certificates.

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. Certificate by Comptroller.

Declarations.

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:— Manner in which, and persons before whom, declaration is to be taken.

(*a*) In the United Kingdom before any justice of the peace or any commissioner, or other officer

authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding.

(*b*) In any other part of Her Majesty's dominions before any Court, Judge, Justice of the Peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a Notary Public, or before a Judge or Magistrate.

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	(*Form F*)	0	5	0
2. For registration of a trade mark for one or more articles in one class	(*Form I*)	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	(*Form H*)	1	0	0
5. On notice of opposition for each application opposed—by opponent	(*Form J*)	1	0	0
6. On hearing by Comptroller—by applicant and by opponent respectively	(*Form E*)	1	0	0
7. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	(*Form K*)	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	(*Form X*)	1	0	0
10. Additional fee where fee is paid within three months after expiration of 14 years ...	(*Form Y*)	0	10	0
11. Additional fee for registration of trade mark where removed for nonpayment of fee ...	(*Form Z*)	1	0	0
12. For altering address on the Register, for every mark	(*Form M*)	0	5	0

		£	s.	d.
13. For every entry in the Register of a rectification thereof or an alteration therein, not otherwise charged	(*Form N*)	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 ...	(*Form O*)	0	5	0
15. On request to Comptroller to correct a clerical error, or permit amendment of application under Section 91	(*Form Q*)	0	5	0
16. For certificate of refusal to register a trade mark under Section 77	(*Form L*)	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	(*Form L*)	0	10	0
18. For certificate of registration to be used in legal proceedings	(*Form S*)	1	0	0
19. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	(*Form R*)	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 ...	(*Form T*[1])	0	5	0
21. For copy of notification of registration		0	2	0
22. Settling a special case by Comptroller ...	(*Form T*)	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

	£	s.	d.
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.

This Schedule contains the various Forms under the Rules. Printed and stamped copies of the Forms are on sale at most Post Offices and Law Stationers. To save space the Forms are not set out here, but, as a guide, the identifying letters of the principal Forms have been annexed to the corresponding fees in the foregoing First Schedule.

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 Carringes; Waggons; Railway Trucks; Bicycles; Bath Chairs.

CLASS 23.—(*a*) Cotton Yarn, and Sewing Cotton not on spools or reels. (*b*) Sewing cotton on spools or reels.

CLASS 24.—Cotton Piece Goods of all kinds. Such as Cotton Shirtings; Long Cloth.

CLASS 25.—Cotton Goods not included in Classes 23, 24, or 38. Such as Cotton Lace; Cotton Braids; Cotton Tapes.

CLASS 26.—Linen and Hemp Yarn and Thread.

CLASS 27.—Linen and Hemp Piece Goods.

CLASS 28.—Linen and Hemp Goods not included in Classes 26, 27, and 50.

CLASS 29.—Jute Yarns and Tissues, and other Articles made of Jute not included in Class 50.

CLASS 30.—Silk, spun, thrown, or sewing.

CLASS 31.—Silk Piece Goods.

CLASS 32.—Other Silk Goods not included in Classes 30 and 31.

CLASS 33.—Yarns of Wool, Worsted, or Hair.

CLASS 34.—Cloths and Stuffs of Wool, Worsted, or Hair.

CLASS 35.—Woollen and Worsted and Hair Goods not included in Classes 33 and 34.

CLASS 36.—Carpets, 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.

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 Registor 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

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.

"ornamental" and "useful."

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.

Distinction now abolished.

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.

Utility not considered.

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.

Hecla Foundry v. *Walker.*

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

The only test is that of novelty and originality.

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 remaining 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. It has not been considered necessary to print the forms in this work. 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, E^1 and O^1, 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 lace 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 7 in. by 3 in. 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 Buildings,
Chancery Lane,
London, W.C.

Classification of goods.

The goods to which designs are applicable are divided into fourteen classes. The following is a list of the 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 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 £1. For sets of lace designs in Class 9 a special form, O[1], 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.

Appeal from refusal to Board of Trade. The decision of the Comptroller consequent upon the hearing is then notified to the applicant.

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 on Form F of his intention to appeal. 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.

Reference to Court.

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 "N," 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.

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

Comptroller's certificate not evidence.

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 on 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," 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 in 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 *primâ facie* evidence of any matters directed or ordered by the Act to be entered therein.

Register of Designs *primâ 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," 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, in the former case, give the Comptroller seven days' notice of his intention to exhibit, and such notice must be given upon Form "L," 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. In the case of an international exhibition held out of the United Kingdom and certified by an Order in Council (see Section 57) notice to the Comptroller is excused.

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 54 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 C). 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 450).

CHAPTER III.

PERSONS QUALIFIED TO REGISTER AND TO BE REGISTERED AS 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."

Master and servant.

Exclusive licensees to sell cannot register as proprietors. *Lazarus* v. *Charles*.

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 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 consideration. 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. 404) 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 (*Guiterman's Design*, [1886] 55 L. J. Ch. 309).

***Bonâ 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. 139). 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 of the same date as the original wrongful entry. Failing this, apparently the best course would be for the Court to declare the wrongful proprietor trustee for the rightful owner.

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, on Form "K," be registered as proprietor.

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 (*Jewitt* v. *Eckhardt*, *supra*).

Licensee for sale cannot sue for infringement.

A bare licensee cannot sue for infringement (*Woolley* v. *Broad*, [1892] 9 R. P. C. 208). In the latter case, where unregistered verbal licensees joined with the proprietor in an action for infringement, judgment for the defendants was given so far as the licensees were 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*, [1891] 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."

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 by 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).

Must be capable of application to some article of manufacture.

Ornament.

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 metal on articles or glass or plastic material or furniture, or tiles or worked or woven, as in lace; or it may be for

Shape.

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

Design may combine ornament, pattern, and shape.

cravat or motor-cycle frame; or, as the Act says, the design may contain two or all of the foregoing elements—*i.e.* ornament, pattern, shape, and configuration.

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.

Hecla Foundry v. Walker, Hunter & Co.

In the case of *Hecla Foundry Co.* v. *Walker*, *Hunter & Co.* ([1889] 6 R. P. C. 554), 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. *Tree*: Woven Basket Case.

The judgment in the above case was resorted to for guidance in *Moody* v. *Tree* ([1892] 9 R. P. C. 333) by the Divisional Court; and in *Cooper* v. *Symington* ([1893] 10 R. P. C. 264) 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 *Morton'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."

Cooper v. *Symington*: Corset Case.

Farwell, J., on utility in *Morton's Design*: Cuff-link.

Instance of very slight subject-matter.

Walker v. *Scott*.

The case of *Walker* v. *Scott* ([1892] 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 for 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. In *Werner Motors, Limited* v. *Damage* ([1904] 21 R. P. C. 621), it was expressly held that rights under a patent and in a design may co-exist in respect of the same article. The subject-matter in the latter case was a motor-bicycle frame.

Patent right and design copyright may co-exist.

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. *Tree* ([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 secured 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

But a patentable invention might be bad subject-matter for design.

Moody v. *Tree.*

Cooper v. *Symington.*

A design must be judged from its appearance, not its uses.

same as the old laced-up corset, which indeed it was designed and intended to imitate. Accordingly, Chitty, J., ordered the design to be expunged.

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* ([1859] 29 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 *Hothersall* 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.

Hothersall 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 *Rivett* v. *Grimshaw* ([1894] 11 R. P. C. 351) a combination of a bassinette and mailcart was held to be a good registrable design.

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."

Mere slight changes in style and shape of common article not subject-matter.

Le May v. *Welch.*

In *Gillard* v. *Worrall* ([1904] 22 R. P. C. 76) the design consisted in merely bending the moveable feed gas tube of a stand jet for a baker's oven so as to lie close to the wall of the oven mouth and carry the light round the corner. As Hall, V.-C., said: "Nothing more than a twist of the tube to carry the gas round a corner." The registration was held invalid.

Example of bad subject-matter.

In the case of *Le May* v. *Welch* (*supra*), 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

Some invention must be apparent.

Smith v. *Hope Bros.*

Commercial success may help to sustain design.

of Lords 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 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 or 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,

Adaptation of well-known objects and personages as subject-matter for designs.

Adams v. Clementson.

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 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.

Portrait on earthenware.

Saunders v. *Wiel*.

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. *Wiel* (*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.

Westminster Abbey spoon handles.

A modelled view of West-minster 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

Lindley, L. J., on new and original designs.

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 why is it not? Has such a design applicable to metals ever been seen before? If you ask that question you are told this—'Yes, if you mean by design, public buildings, or if you mean cathedrals and churches, they are common enough'; therefore there is no novelty in the idea. But if you ask a little closer whether anybody has previously taken this particular aspect of Westminster Abbey and used it as a design applicable to things in Class 1 or to any things like it, the answer is, 'No, that is new and never has been published before.' That answer seems to me to bring the 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* ([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 lampshades 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 p. 491), a design founded upon and even incorporating the whole or part of a previous design may be good in its totality.

Slightness of change

How slight a change may constitute a well-known article subject-matter for a registrable design might be instanced

in *Walker* v. *Scott* ([1892] 9 R. P. C. 482), where the mere rounding of the edges of an oil-can of well-known shape constituted the subject-matter of the design. In *Rollason's Design* ([1898] 15 R. P. C. 441), the coffin plates in respect of which registration had been effected were exceedingly similar to alleged anticipations both in shape and in ornament. The alleged distinctive features of Rollason's plates—viz., the 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 constitute subject-matter.

Drawing not conclusive as 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 & Gresswell's Design*, [1889] 6 R. P. C. 471), and the same was held in *Bach'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.

Novelty destroyed by prior exhibition.

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.

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. *Footmann* ([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 publication had taken place. It would seem that the mere

Disclosure for the purpose of doing business destroys novelty.

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* ([1878] W. N. 79). An examination of the report of the more recent and very similar case of *Winfield* v. *Snow* ([1890] 8 R. P. C. 15), and a consideration of the remarks of Hawkins, J., will also help to show how far confidential communications 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 globe 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 *Smout* v. *Slaymaker* ([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. It may, however, be said that in the rare case where a patent and a design co-exist for the same article a patent provisionally applied for and not completed before the registration of the design does not anticipate the design if no publication has taken place (*Werner Motors, Limited* v. *Gamage*, [1904] 21 R. P. C. 621).

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 *Hothersall* 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 Gresswell'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 "R^{D}" 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 "REG^{D}" 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. *Bastendorff* ([1893] 10 R. P. C. 160) the plaintiff had marked his tables "REG^{D}" instead of "R^{D}". 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 "R^D" 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 "REG^D" 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 *Hothersall* 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 *Rollason's Design* the registered number had been wrongly stamped on certain of the coffin plates as No. 252,908 instead of No. 232,908, 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 *Wittmann* v. *Oppenheim* ([1884] 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. Almost exactly the same remissness in marking destroyed the copyright in *Lea* v. *Price* ([1904] 22 R. P. C. 122). Here the thing registered was a lamp head separable and distinct from the other parts. But instead of marking the head the plaintiffs had marked a binding ring situated at the foot of the globe. The ring was not registered, and was no part of the design. On the other hand, in *Ingram* v. *Edwards* ([1904] 21 R. P. C. 463) a registered gas bracket was marked not on the body of the bracket itself but on a detachable cup. Nevertheless, it was held that as the cup was an integral part, without which the bracket would not have been complete, the marking was sufficient.

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. 79).

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. *Hawley*, [1883] 48 L. T. N. S. 639) 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.

Exported goods.

Even if sold outside of the limits of the United Kingdom, goods to which a registered design is applied must be marked (*Sarazin* v. *Hamell*, [1863] 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 unlicensed 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. *McCrea* ([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

Test of the eye.

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 *Hothersall* 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.

Need not be an exact copy.

In *McCrea* v. *Holdsworth* ([1870] L. R. 6 Ch. 418), and in *Oliver* v. *Thornley* ([1896] 13 R. P. C. 490) 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,

General resemblance may constitute infringement.

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. This is equivalent to saying that no one can register a general appearance. The question of detail and the judgment of the eye must decide whether infringement has arisen. Thus in *Holden* v. *Hodgkinson* ([1904] 22 R. P. C. 102) the tombstone design of the plaintiff, consisting of a slab with rounded top and flanked by black

porcelain pillars, was held not to be infringed by a slab with a pinnacle and ogle top, and also flanked by black porcelain pillars. The minor details also differed.

Obvious and fraudulent imitation.

An obvious and fraudulent imitation might be created, and the inference that it was so would be largely augmented, 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 (*Grafton* v. *Watson*, [1884] 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.

Grafton v. *Watson.*

Harper v. *Wright.*

Manisty, J., on "obvious" and "fraudulent" imitations.

In *Sherwood* v. *Decorative Tile Co.* ([1887] 4 R. P. C. 207), Manisty, 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."

Sherwood v. *Decorative Tile Co.*

In the case last quoted the same Judge came to the conclusion that the defendant's design, although not an "obvious," was on the other hand a "fraudulent," imitation.

If manufacturer has applied the design he 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 refuge for innocent retailer.

The case is, however, different with the retailer of the goods, and to succeed the plaintiff must show that the defendant knew 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*, [1859] 1 E. & E. 765, 28 D. J. Q. B. 225; *Smith* v. *Roberts*, [1888] 5 R. P. C. 611).

Sufficiency of notice to retailer.

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 plaintiff's 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.,

Intention of the section is to protect innocent retailer.

Smith v. Roberts.

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.

Penalties now limited in amount (Act of 1888).

In the case of *Sherwood* v. *Decorative 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.

Trumpery actions not encouraged.

In *Jan* v. *Grossman* ([1895] 12 R. P. C. 537), 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.

Manufacture without sale before 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 (*McCrea* v. *Holdsworth*, [1848] 2 De G. & Sm. 496).

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 justice 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.

Injunction.

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 most convenient.

Jury.

If trial by jury is desired, or the action is for damages, as under Section 59, 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.

Therefore although a licensee alone under a patent cannot sue in respect of infringements, although notice of his licence 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 licence must be in writing (*Jewitt* v. *Eckhardt*, [1878] L. R. 8 Ch. D. 404) and the licensee on the Register; otherwise he has no cause of action (*Woolley* v. *Broad*, [1892] 9 R. P. C. 208).

Licence to apply design must be in writing.

Practice in designs actions similar to practice in patent actions.

In *Morris Wilson* v. *Coventry Machinists' Co.* ([1891] 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.

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.

Endorsement of writ.

The writ alleging infringement should be endorsed with a claim for—

Penalty. (*a*) The penalties against the defendant for infringement of the plaintiff's registered design;

Injunction. (*b*) An injunction to restrain the defendant, his servants and agents, from infringing the design; and

Delivery up. (*c*) Delivery up or destruction of all articles in the possession or under the control of the defendant.

Damages in lieu of penalties (Section 59).

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—

Title of plaintiff.

(*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*];

Infringement by defendant.

(*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

Particulars of breaches.

Statute to give such particulars, but under Order XIX., Rule 7, of the Rules of the Supreme Court, they may be ordered, and as a rule they are given.

Defence. In his defence the defendant should 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 prior to the date of registration by &c. (*here set forth all prior publications of similar designs with full particulars*).

(*c*) That prior to the date of registration the design had been publicly used within the realm by &c. (*here set forth all instances of prior user with names, addresses, and dates*). 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*, [1889] 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.

But this rule might be relaxed.

No alleged anticipation of a registered design can be relied on at the trial unless pleaded (*Walker* v. *Hecla Foundry Co.*, [1887] 5 R. P. C. 71). In *Rivett* 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.

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 (*Germ Co.* v. *Robinson*, [1884] 1 R. P. C. 217), nor will the Court order a roving inspection (*Cheetham* v. *Oldham*, [1888] 5 R. P. C. 617). As Lord Halsbury, L. C., said in *MacDougall* v. *Partington* ([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.

Mere suspicion not enough to justify inspection order.

No order made that may prejudice business of other party.

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. *Wiel*, [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.

Where penalties are claimed interrogatories not allowed.

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*, [1869] 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. *Decorative Tile Co.* ([1887] 4 R. P. C. 207), where the Court was of opinion that a

Judge's discretion as to costs.

good deal of the successful plaintiff's evidence was unnecessary and improper, the defendants were ordered to pay two thirds only of the plaintiff's costs. And where, as in *Blank* v. *Footmann* ([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 *Winfield* 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 be prescribed; and

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

Section 90. Provisions 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 *Bayer* 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 *Cowie* 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 application to rectify.

"Persons aggrieved."

The question as to who may be rightly considered a "person aggrieved" within the Statute has already 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. It is therefore no uncommon incident in an action for infringement for the defendant to move to expunge the design from the Register. 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 from 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 54). With regard to this section it might be asked whether mere importation of the goods from abroad would constitute "use" within the section?

Prior registered proprietor.

Defendant in an action.

Grounds of rectification.

No home 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 re-registration 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.

Grocott's Design.

Fraudulent as compared with inadvertent registration.

This was done in the case of *Grocott'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* ([1891] 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.

Heinrich's Design.

Power of Comptroller to alter changed name of proprietor on Register.

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 *re New 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 to rectify 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.

Service of respondent without the jurisdiction.

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.

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 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 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 El in the Second Schedule hereto, and for one design to be applied to a set of lace articles shall be made in the Form Ol 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 Kl in the Second Schedule hereto. The remaining Forms in such Schedule may be used in all cases to which they are applicable.

Classification of Goods.

Classification of goods.

5. For the purposes of the registration of designs and of these Rules, goods are classified in the manner appearing in the Third Schedule hereto.

Application for Registration.

Agents.

[6. All communications between an applicant for the registration of a design and the Comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the Comptroller.]

Designs Rules, 1893.

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

Nature of design.

the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable.

When sketches, drawings, or tracings are furnished they must be fixed.

When the articles to which designs are applied are not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs shall be furnished.

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 design.

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 Secton 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 declaratian 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 mark.

[32. Before the delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in any of the classes one to twelve in the Third Schedule hereto, cause each such article to be marked with the abbreviation "R^D" and the number appearing on the certificate of registration, and shall, if such article is included in the classes thirteen or fourteen in the Third Schedule hereto, cause each such article to be marked with the abbreviation "REG^D."

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 OF 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.

FIRST SCHEDULE

(Amended in conformity with The Designs Rules, 1893.)

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 ... (*Form E*)	0	10	0
2. On application to register one design to be applied to lace or to single articles in Classes 13 and 14 ... ... (*Form E1 or E*)	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 ... ... (*Form O*)	1	0	0
3*a*. On application to register one design to be applied to a set of lace articles ... ... (*Form O1*)	0	2	0
4. On notice of appeal to Board of Trade against refusal of Comptroller to register ... ... (*Form F*)	1	0	0
5. Copy of certificate of registration, each copy (*Form H*)	0	1	0
6. On request for Certificate of Comptroller for legal proceedings or other special purpose (*Form I*)	0	5	0
7. On request to enter name of subsequent proprietor (*Form K*)	*Same as registration fee.*		
8. On notice to Comptroller of intended exhibition of an unregistered design ... ... (*Form L*)	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 ...	(*Form M*)	0	5	0
12. On request for search under Section 53	(*Form N*)	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 Commisioners of Her Majesty's Treasury.

31st March, 1890.

SECOND SCHEDULE.

FORMS.

In this Schedule the different Forms are set out *in extenso*; but as these are printed, stamped, and on sale at most post-offices and law stationers it has been considered unnecessary to set them out here. In the foregoing First Schedule the identifying letters of the chief Forms are annexed to the corresponding fees.

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, 1890.

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, Cuba, Denmark with the Faröe Islands, France and her Colonies, Germany, Great Britain, Holland with East Indian Colonies, Italy, Japan, Mexico, New Zealand, Norway, Portugal with the Azores and the Madeiras, Queensland, Servia, Spain, Sweden, Switzerland, and Tunis.

The countries which are not members of the Convention but which have concluded mutual arrangements with Great Britain under Section 103 of the Patent Act of 1883 in terms akin to those of the Convention are as follows:—Paraguay and Uruguay, Roumania, Ecuador, Greece (Trade Marks and Designs only), the Republic of Honduras, Tasmania, and Western Australia.

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 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 any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention or by the working of it, by the sale of copies of the design or model, or by use of the trade mark. The abovementioned terms of priority shall be **twelve** months for patents, and **four** months for industrial designs and 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 objects 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 proper 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 goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention. **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 expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central

Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

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 successively held in one of the Contracting States by Delegates of the said States.

ARTICLE XV.—It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present Convention.

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 procés-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 II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

3 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 of the Union from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State: provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The 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. (*Relates to the expenses and ministerial conduct of the International Office, and is otherwise of no interest*).

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.*]

NOTE.—Before signing this Protocol the British Delegates put on record a declaration that the registration of Foreign Marks in the United Kingdom under the Convention was to be governed by the Statute and practice in force in this country.

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 prolixity which many draftsmen still affect. The Author has therefore, in drawing these Precedents, endeavoured to make them as concise as possible.

One notable 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).

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 invention and patent, 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 invention 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 would 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 Lancashire, 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 representatives 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 in, to, and under the Patent to be applied for.

Memorandum of Agreement made this day of , 19 , BETWEEN ISAAC JENKINS, of No. 17 Tuer 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 obtained 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 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 each of 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.*]

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, 1905, 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 should be endorsed by the Comptroller with such references to prior patents as would, in the opinion of the said Oliver Paley, render any patent thereunder valueless, or should after acceptance 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 8.

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 holding 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.*

Form 6.

ASSIGNMENT (Absolute) of Invention and Letters Patent by the Patentee to a Purchaser.

An Indenture made the day of , 19 , BETWEEN ROBERT SHEDDON, 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, 1903: 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, 1900, 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 KINGHORN 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 His Majesty's Letters Patent in the United Kingdom for "An Improved Telephonic Transmitter," No. 328, dated 14th January, 1903: 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, or 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 85 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 DICKENSON, 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.

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 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 Licensor agrees to accept, an exclusive licence upon the following terms:—

1. The licence hereby granted shall continue to 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, 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. 12,333[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, 1898, 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 on 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.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 to 1902 (Consolidated).

The Acts contain 118 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 consider and of Judicial Committee 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 of 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. Cessor 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.
109. Proceedings for revocation of patent in Scotland (action of reduction).
110. Reservation of remedies in Ireland.
111. General saving for jurisdiction of Courts.
112. Isle of Man.
112A. Jurisdiction of Lancaster Palatine Court.

Repeal; Transitional Provisions; Savings.

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

General Definitions.

117. General Definitions.

Register of Patent Agents.

117A. Register of Patent Agents.

THE FIRST SCHEDULE.—Forms of Application &c.

THE SECOND SCHEDULE.—Fees on instruments for obtaining patents, and renewal.

THE THIRD SCHEDULE.—Enactments repealed.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 to 1902 (Consolidated).

THE REPEALED PORTIONS OF THE ACT OF 1883 ARE OMITTED EXCEPT IN THE CASE OF THE TRADE MARKS DIVISION. THE AMENDMENTS EFFECTED BY THE SUCCEEDING ACTS ARE INTRODUCED AT THE APPROPRIATE PLACES AND ARE IN **heavy type.** THE CORRESPONDING AMENDING ACT AND SECTIONS ARE CITED IN THE MARGIN, WHERE THE INTERPOLATED MATTER OCCURS.

(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 Edw. VII. c. 18.—An Act to amend the Law with reference to International Arrangements for Patents.

[17th August, 1901.

2 Edw. VII. c. 34.—An Act to amend the Law with reference to Applications for Patents and Compulsory Licences, and other matters connected therewith.

[18th December, 1902.

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, and Trade Marks Act, 1883." Short title.

The Act of 1902 may be cited as "The Patents Act, 1902," and may be cited and shall be construed as one with The Patents, Designs, and Trade Marks Acts, 1883 to 1901. Act 1902, s. 5.

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

PART I.—PRELIMINARY.
II.—PATENTS.
III.—DESIGNS.
IV.—TRADE MARKS.
V.—GENERAL.

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

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. Act 1888, s. 26.

NOTE.—*The Acts of 1885 and 1886 commenced respectively on the 14th August, 1885, and 25th June, 1886. The Act of 1901 commenced on the 1st January, 1902. The Patents Act, 1902, came into operation as regards Sections 3, 4, and 5 on the 18th December, 1902. By an Order of the Board of Trade, Sections 1 and 2 became operative as from the 1st of January, 1905.*

PART II.

PATENTS.

Application for and Grant of Patent.

4. (1) Any person, whether a British subject or not, may make an application for a patent. Persons entitled to apply for 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.

Act 1885, s. 2. 5 & 6 Will. IV. s. 62.

The declaration may be either a statutory declaration under The Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

(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.

Act 1886, s. 2. The same drawings may accompany both specifications.

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.

(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.

Reference of application to Examiner.

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.

Act 1888, 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.

Act 1902, s. 1. Examination of previous Specifications in United Kingdom on applications for

7a (1)[1] Where an application for a patent has been made and a Complete Specification has been deposited by the applicant, the Examiner shall forthwith, in addition to the inquiries which he is directed to make by The Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as "the Principal Act"), make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a Provisional Specification not followed by a

[1] By Order of the Board of Trade this Section of the Act of 1902 came into operation on the 1st January, 1905.

patents. 46 & 47 Vict. c. 57. Complete Specification) published before the date of the application, and deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) The Examiner shall report to the Comptroller the result of his investigations in such manner as the Board of Trade may direct.

(4) The provisions of Sub-section 5 of Section 9 of the Principal Act, as amended by any subsequent enactment, shall apply to reports under this section.

(5) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(6) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection be removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what, prior specifications ought to be made in the specification by way of notice to the public.

(7) An appeal shall lie from the decision of the Comptroller under this section to the Law Officer.

48 & 49 Vict. c. 63. (8) Section 8 of the Principal Act and Section 3 of The Patents, Designs, and Trade Marks (Amendment) Act, 1885 (which regulate the time for depositing a Complete Specification), shall have effect as if references therein to the period of nine months were references to the period of six months.

(9) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of

Trade or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon.

(10) The Board of Trade, with the sanction of the Treasury, may prescribe an additional fee not exceeding One Pound in respect of the investigation mentioned in this section, which shall be payable on the sealing of the patent.

(11) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the Order shall be laid before both Houses of Parliament.

(4) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant. Act 1888, s. 2, s.s. 4.

(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. s.s. 5.

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 consequent time within six months from the date of application. Act 1902, s. 1, s.s. 8.

A Complete Specification may be left within such extended time, not exceeding one month after the said six months, as the Comptroller may on payment of the prescribed fee allow. Act 1885, s. 3. Act 1902, s. 1, s.s. 8.

(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 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, 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. Act 1888, s. 4.

(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 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. Act 1902, s. 1, s.s. 8. A Complete Specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said six 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.

18. 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) When 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.

(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. Act, 1888, s. 5.

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. Power to disclaim part of invention during action &c.

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. Restriction on recovery of damages.

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

Compulsory Licences.

22. Section 22 of the Principal Act (relating to the grant of Compulsory Licences by the Board of Trade) is hereby repealed, and the following provisions shall be substituted therefor:— Amendment of Law relating to Compulsory Licences. Act 1902, s. 3.

(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention

have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves, the Board of Trade, if satisfied that a *primâ facie* case has been made out, shall refer the petition to the Judicial Committee of the Privy Council, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licences on such terms as the said Committee may think just, or, if the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by Order in Council.

Provided that no Order of revocation shall be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the Law Officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) If it is proved to the satisfaction of the Judicial Committee that the patent is worked or that the patented article is manufactured exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public have been satisfied, the petitioner shall be entitled either to an Order for a compulsory licence or, subject to the above proviso, to an Order for the revocation of the patent.

(6) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, (*a*) any existing industry or the establishment of any new industry is unfairly prejudiced, or (*b*) the demand for the patented article is not reasonably met.

(7) An Order in Council directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

(8) His Majesty in Council may make Rules of Procedure and Practice for regulating proceedings before the Judicial Committee under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council or any Order made by the Judicial Committee under this Act may be enforced by the High Court as if it were an Order of the High Court.

(9) The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but in awarding costs on any application for the grant of a licence the Judicial Committee may have regard to any previous request for, or offer of, a licence made either before or after the application to the Committee.

(10) For the purposes of this section three members of the Judicial Committee shall constitute a quorum.

(11) This section shall apply to patents granted before as well as after the commencement of this Act.

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 *primâ facie* evidence of any matters by this Act directed or authorised to be inserted therein.

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

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 Judical 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:

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

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

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

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

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

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.

Limitation as to anticipation. Act 1902, s. 2.

(4) An invention covered by any patent granted on an application to which Section 1 of this Act applies shall not be deemed to have been anticipated by reason only of its publication in a specification deposited pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for a patent therefor, or of its publication in a Provisional Specification of any date not followed by a Complete Specification.

(5) 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.

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

(7) 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 seem 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.

Patent to first inventor not invalidated by application in fraud of him.

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

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

Loss or destruction of patent.

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

Proceedings and costs before Law Officer.

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

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.

Protection of patents and designs exhibited at international exhibitions. Act 1886, s. 3.

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.

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, abridgments 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 invention.

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 "inventions."

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 1888, 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 *primâ facie* evidence of any matters by this Act directed or authorised to be entered therein.

Fees.

86. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct. Fees on registration &c.

Industrial and International Exhibitions.

87. The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with: namely— Exhibition at industrial or international exhibition not to prevent or invalidate registration.

(*a*) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the Comptroller the prescribed notice of his intention to do so; and

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

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: 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.

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.

60. In and for the purposes of this Act— Definition of "design," "copyright."

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (Fifty-fourth George the Third, Chapter 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.

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. Definition of "proprietor."

PART IV.

TRADE MARKS.

[*In view of the continuing importance of the repealed portions of the Trade Marks division of the Act, these repealed portions are shown in italics in their original position.*]

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.

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 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.**

Limit of time for proceeding with application.

Act 1888, s. 9.

[**64.** (*1*) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:—*

Conditions of registration of trade mark.

(*a*) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*

***Repealed by* Act 1888, s. 10.**

(*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, 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 comprising a series shall be deemed and treated as registered separately.

Trade marks may 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 refuses 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 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.

(4) If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.]

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 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 mark identical with one already on the Register with respect to such goods or description of goods.

Act 1888, s. 14.

(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.

Further restriction on registration.

Act 1888, s. 15.

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.

Saving for power to provide for entry on Register of common marks as additions to trade marks.

74. (1) Nothing in this Act shall be construed to prevent the Comptroller entering on the Register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(*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.

Repealed by **Act 1888, s. 16.**

[(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.*]

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 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.

76. [*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 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 Thirteenth day 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 1888, 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 five 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.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees for registration &c.

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:— Registration by Cutlers' Company of Sheffield marks.

(1) The Cutlers' Company shall establish and keep at Sheffield a new Register of Trade Marks (in this Act called "the Sheffield Register"):

[(2) *The Cutlers' Company shall enter in the Sheffield Register, in respect of cutlery, edge tools, or raw steel, and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel, and such goods in the Register established under The Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such Register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually 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 Act 1888, s. 20, s.s. 1.

38 & 39 Vict. c. 91.

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 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. 2.

(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 of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5) If the Comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6) Upon the registration of a trade mark in the Sheffield Register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the Register of Trade Marks; and such registration shall bear

date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day:

[(7) *The provisions of this Act, and of any general rules made under this Act, with respect to 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*:]

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 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.

Act 1888, s. 20, s.s. 3.

(8) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used [*on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*] **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:

(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 metal: Act 1888, s. 20, s.s. 4.

(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.

82. (1) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, "the Patent Office." Patent Office.

(2) Until a new Patent Office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of Patents, Designs, and Trade Marks, who shall act under the superintendence and direction of the Board of Trade.

(4) Any act or thing directed to be done by or to the Comptroller may 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

Act 1888, s. 21.

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.

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.

Sealed 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.

Rectification of Registers 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.

Act 1888, s. 24.

(*d*) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.

Alteration of registered mark.

92. (1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant, and the Comptroller shall be entitled to be heard on the application.

(3) If the Court grants leave, the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the Register to be altered in conformity with the order of leave.

Falsification of entries in Registers.

93. If any person makes or causes to be made a false entry in any Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such Register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a 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 *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Applications and notices by post.

97. (1) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as to days for leaving documents at Office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or, if there be none, any person appointed by any Court or Judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Transmission of certified printed copies of specifications &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or

extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

101. (1) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(*a*) For regulating the practice of registration under this Act:

(*b*) For classifying goods for the purposes of designs and trade marks:

(*c*) For making or requiring duplicates of specifications, amendments, drawings, 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, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4) Any Rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in Session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next Session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

(5) If either House of Parliament, within the next forty days after any Rules have been so laid before such House, resolve that such Rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such Rules or Rule or to the making of any Rules or Rule.

Annual reports of Comptroller.

102. The Comptroller shall before the first day of June in every year cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general Rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

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.

International arrangements for protection of inventions, designs, and trade marks.

103. (1) If Her Majesty is pleased to make any arrangement with the Government or Governments of any Foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such State shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the **date of the application** in such Foreign State.

Act 1885, s. 6.

Provided that his application is made, in the case of a patent within **twelve** months, and in the case of a design or trade mark within **four** months, from his applying for protection in the Foreign State with which the arrangement is in force.

Act 1901, s. 1, s.s. 1.

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.

Act 1901, s. 1, s.s. 2.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his Complete Specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2) The publication in the United Kingdom or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the

publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

(4) The provisions of this section shall apply only in the case of those Foreign States with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State.

Provision for colonies and India.

104. (1) Where it is made to appear to Her Majesty that the Legislature of any British Possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time by Order in Council to apply the provisions of the last preceding section, with such variations or additions (if any) as to Her Majesty in Council may seem fit, to such British Possession.

(2) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark

applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Penalty on unauthorised assumption of Royal Arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal Arms, or Arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland, Ireland, &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109. (1) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

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 Lancaster Palatine Court. Act 1888, 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.

117a. (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.

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