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(PATENTS AND DESIGNS ACTS, 1907-8)

BY

DAVID FULTON

OF THE MIDDLE TEMPLE AND NORTHERN CIRCUIT

BARRISTER-AT-LAW

(Assoc. Mem. Inst. Civil Engineers)

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PREFACE.

THE publication of the present Fourth Edition of this book has been intentionally delayed in order that the practical working of the new provisions of the Patents and Designs Act of 1907 might have time to be judicially ascertained and settled. Thus, instead of mere speculative comments upon these novel sections, the Author has been able to record actual practice and cite reported rulings.

The enlarged jurisdiction and increased powers of the Comptroller have added considerably to the importance of his office and the responsibility of his administration, and some interesting developments in practice will be found noted in the body of the work. The Courts also have, since the advent of the altered conditions, not only discussed and interpreted the new portions of the present Statute, but have in some instances taken occasion to modify or explain the effect of certain of the older decisions. The results, as regards both administrations, are that much of the matter in existing text-books is no longer reliable.

The true interpretation of Section 27, governing the Revocation of Patents upon the ground of manufacture

mainly or exclusively abroad, has been authoritatively set forth by Mr. Justice PARKER in *Hatschek's Patents*, and the influence of his decision upon the Comptroller's practice may be traced from a study of the cases quoted in the pages which follow and comment upon that decision.

The new Order LIIIA of the Rules of the Supreme Court regulates, *inter alia*, the preparation and scope of particulars, and minimises the danger of a Patent being unexpectedly upset upon the plea of alleged prior user.

The main justification of the new Act is that the disadvantages of a scattered series of Statutes of different dates, not always reconcilable in their provisions, have been done away with, and for the first time there may be said to exist a Code of Patent Law comprising the effective sections of the Statute of Monopolies, the Act of 1907, the Patents Rules of 1908, Order LIIIA, and the International Convention.

Following the scheme adopted in the first, second, and third editions, the entire field covered by the new Patents and Designs Act has been discussed in this work. Such a course is convenient, as there are many

Sections which are common to both subjects, and it is useful to have in one compact volume the whole material of the Statute. So far, this is the only treatise extant which fulfils these conditions.

Owing to the exclusion of Trade Marks from the new Act, these are not now included in this work. Consequently, the additional matter on Patents and Designs has not increased the bulk of the volume comparatively with the last edition. The whole of the older matter has been carefully revised, and in great measure re-written. Over a hundred new cases, many of them of material importance, have been cited, and the Indexes of both the Patents and Designs portions have been re-arranged and enlarged.

DAVID FULTON.

1 GARDEN COURT, TEMPLE,
June, 1910.

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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.	Chancery (Appeal).
Ch. Ca.	Cases in Chancery.
Ch. D.	Law Reports (New Series), Chancery Division.
Cl. & F. ...	Clark & Finnelly's Reports.
C. M. & R. ...	Crompton, Meeson & Roscoe's Reports.
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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. & M.	Hemming & Miller's Reports.
H. & N.	Hurlstone & Norman's Reports.
H. of L. C.	House of Lords Cases.
How. Pr.	Howard's Practice (U.S.).
Hyde	Hyde's Indian 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. & Cr.	Mylne & Craig's Reports.
M. & G.	Manning & Grainger's Reports.
M. & W.	Meeson & Webster's Reports.
Mer.	Merivale'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 Patents, Design, and Trade Mark Cases.
Seton	Seton's Reports.
Sol. J.	Solicitors' Journal.
Stark.	Starkie's Reports.
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, A. C.	... Appeal Cases.
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.

INTRODUCTION.

PATENTS for Inventions are now granted and regulated under and by virtue of the provisions of The Patents and Designs Act, 1907, which came into force on the 1st of January, 1908. Trade Marks are no longer included, these being governed by an independent Statute: viz., The Trade Marks Act of 1905.

So far as Patents are concerned, the new Act introduces many important and valuable changes and additions. Some use has been made of the experience gained from the working of the Patent Laws of Foreign Countries, but nothing revolutionary has been attempted, and the changes are on the whole the fruit of careful and mature consideration. The section which has appealed most to the popular imagination is that which provides for the revocation of Patents that are worked wholly or mainly abroad. The results of this provision have been entirely satisfactory. Factories have been built and industries established in this country which, but for the Act, would have remained abroad. Statistics have been published which show that during the year 1909 considerably over a half-a-million of money has been expended in England by foreign firms holding British Patents, on the acquisition of land, premises and plant; and to this must be added the expenditure incurred by British firms in extending their workshops for the purpose of manufacturing under royalties or on behalf of foreign patentees. Nevertheless, as will be seen when the section comes to be discussed, so far from this beneficial provision being new, it is simply a reversion to the spirit and meaning

of Section 6 of the old Statute of Monopolies, the main object of which was the establishment of new manufactures within the realm.

Practically, the New Act is the result of the amendment and consolidation of the respective Patents Acts extending from 1883 to 1902, with certain new features, the most important of which are shortly as follows:—

(1) The Comptroller is armed with extended powers. Thus the ambit of the official search among the specifications of the last preceding fifty years is extended to include prior specifications which were unpublished at the date of the application. In cases of clear anticipation he may refuse outright the grant of a Patent. Within a certain time limit he may deal with applications for revocation upon the same grounds upon which the grant might at an earlier stage have been opposed. Again, it is the Comptroller who, in the first instance, hears applications for revocation of Patents which have been exclusively or mainly operated outside of the United Kingdom. Lastly, he is empowered to order the payment of costs by parties in proceedings before him.

(2) Supplementary applications may be made during the period of provisional protection and the whole incorporated in one Complete Specification.

(3) Unauthorised publication of an Invention, without the knowledge and consent of the Inventor, will not invalidate a Patent for the same, afterwards obtained by him.

(4) Patents of Addition may be obtained, depending upon and expiring with the mother Patent.

(5) The grounds of opposition to the grant of a Patent may now include an objection to the sufficiency and fairness of the description.

(6) Petitions for Prolongation of the term of patent right are now to be presented to the Court, instead of to the Privy Council as formerly.

(7) A Patent which has unintentionally been allowed to lapse by non-payment of the renewal fee may, at any time afterwards, on sufficient explanation of the circumstances, be restored.

(8) A Patentee may at any time surrender his Patent by notifying the Comptroller to that effect.

(9) In an Action for Infringement, a Defendant may apply by way of counterclaim for revocation of the Plaintiff's Patent, instead of having to lodge a separate Petition as formerly.

(10) In an Action for Infringement, the Defendant may escape the payment of damages by proving that he was not aware of the existence of the Patent.

(11) Where a Patent has been granted to two or more persons jointly, and one of the Patentees dies, his beneficial interest in the Patent devolves on his personal representatives, instead of passing to the surviving co-Patentee as formerly.

(12) Section 92 signalises a step towards the creation of a special court for dealing with Patent matters. It provides for the selection of a special Judge of the High Court by the Lord Chancellor to hear appeals from such decisions of the Comptroller as are appealable

to the Court, and to adjudicate upon Petitions referred or presented to such Judge. By virtue of this section, Mr. Justice Parker was appointed by an Order of May, 1908. It is further provided that the decision of such Judge in these matters is *to be final*, except where the appeal is from the decision of the Comptroller revoking a Patent on any ground upon which the grant might have been opposed under Section 26.

By an oversight it was not noticed in passing the Act that, owing to the repeal of the Act of 1883, the phrase "Petition referred or *presented* to such Judge" included Petitions for Revocation presented directly to the Court under Section 25. This would have done away with the right of appeal to a higher Court in ordinary Petitions for Revocation, which was never contemplated by the Legislature. To correct the error a short Act was passed, cited as the "Patents and Designs Act, 1908," to explain Section 92 of the Act of 1907. The Act shortly provides that, in the case of a Petition for Revocation presented under Section 25 of the Act of 1907, the decision of the Judge of first instance is *not* to be final.

As the various provisions for appeals under the Act might give rise to some confusion, it may be as well to summarise them as follows:—

(1) *The Law Officer's decision is final.*—(*a*) On appeals from the Comptroller's decision upon matters within Section 7, viz., amendments and alterations in a specification as the result of the official search; or the imposition of specific references; or the refusal of a Patent; (*b*) On appeals from the Comptroller's decision in oppositions to grant under Section 11; (*c*) On appeal from the Comptroller's decision in amendments of specifications under Section 21.

(2) *The decision of the Special Judge is final.*—(*a*) On appeal from the decision of the Comptroller *refusing* revocation of a Patent under Section 26, viz., on the grounds of Opposition to Grant set forth in Section 11; (*b*) On reference to the Court by the Board of Trade of petitions for compulsory licence with alternative of revocation under Section 24; (*c*) On appeal from the decision of the Comptroller, granting or refusing revocation of a Patent, on the ground of being worked outside the United Kingdom, under Section 27; (*d*) On a Petition for Prolongation of a Patent under Section 18; (*e*) On appeal from the refusal of the Comptroller to restore a lapsed Patent under Section 20.

(3) *Appeals may be carried to the Court of Appeal and House of Lords.*—(*a*) On any appeal from a decision of the Comptroller *revoking* a Patent under Section 26, viz., on the grounds of opposition set forth in Section 11; (*b*) From any decision by the Court revoking or upholding a Patent on Petition under Section 25 (see Patents and Designs Act, 1908); (*c*) In all actions for Infringement, Restraint of Threats, &c. Of course, these latter need not of necessity come before the specially appointed Judge, but may fall into the list of any Judge of the High Court in the Division in which they are entered.

Each of these new features will be more fully discussed in its proper place in the body of the work.

So far as the essential elements of Patent Law are concerned, the new Act has made hardly any change. In weighing the questions of invention, patentability, subject-matter, infringement, construction,

and validity, the old Rules and the effects of accepted decisions remain, generally speaking, undisturbed. Like its predecessors, the present Patent Act makes no attempt to define what is a patentable invention. The sole requisite is that it should be within the exceptions contained in the sixth Section of the ancient Statute of Monopolies.

With this short introductory reference to the main new points in the present Act, the writer will now proceed to sketch very briefly the origin and history of Patent Law generally, and will then deal with the subject more in detail from the modern standpoint, noting specially the new provisions of the Statute where these have modified the hitherto existing methods and conditions which governed the obtaining and upholding of Letters Patent for Inventions.

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.—THE PATENTS AND DESIGNS ACT, 1907.

Origin of Letters Patent for Inventions.

FROM very early times up to the date of the famous Statute of Monopolies passed in the reign of James I., the Sovereign was at liberty to exercise unchecked the prerogative of making special grants to favoured subjects, and even to foreigners.

Letters Patent for Inventions are the survival of these ancient Royal Grants.

Crown Grants.

When a monopoly was granted, it was made known by the issue of "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 followed, therefore, that any infringement of the monopoly rendered the infringer liable, no matter how ignorant he might have been of the existence of the grant, or how innocent of any intention to trench upon the rights of the monopolist. The present Patent Act for the first time challenges this privileged position of the patentee and provides, in Section 33, that in an action for infringement the defendant may escape the payment of damages by proving that he was not aware of the existence of the patent.

Early patents for new inventions.

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 discovery.

Setting aside the somewhat apocryphal account of a Patent having been issued by King Edward III. in respect of an alleged discovery of the Philosopher's Stone, it is 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.

New manufactures.

These industries may have been, and probably were, of the nature of new inventions as far as this country was concerned, and to this day valid grants for the mere importation of new inventions or manufactures still exist. But in the bulk of cases the ancient trade monopolies, such, for instance, as in the manufacture of salt, and in respect of mining operations and the like, were mere oppressive grants, fettering rather than encouraging national industry and enterprise.

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 declared that if things were allowed to go on at this rate "bread itself would be reduced to a monopoly."

Statute of Monopolies (21 Jac. I. c. 30), 1624. Monopolies abolished.

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."

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.

Reasons for fixing duration of patents.

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

After-history of Patent Law.

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

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

Enrolment of specifications.

Anne no specification seems to have been required, but about the year 1730 the enrolment of a specification became compulsory.

Disuse of provisions for working patent.

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—appear 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 as a guide to the workman 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.

Sufficiency of specification.

Consequences of filing specification.

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," was at the root of the modern complaint, that foreigners could 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 were 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 the conditions existing before the coming into force of the present Act, many a patent granted to a foreigner, so far from being an encouragement to native industry, was a positive fetter upon the wrists of those who would otherwise have found profitable employment had working in this country been made compulsory. The most important commercial

Abuses arising from non-working.

combinations in England, strongly supported by the working classes, lost no opportunity of pressing 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. At first these proposals did not find acceptance, and the only result was a compromise represented by the Compulsory Licence Clauses of the Patents Act of 1902, which however remained practically a dead letter.

Compulsory licences.

To-day, Section 27 of the new Act provides that, at any time not less than four years after the date of the Patent, and not less than one year after the passing of the Act, any person may apply to the Comptroller for the revocation of any Patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom. Thus the original intention of the Statute of Monopolies has at last been restored.

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 for United Kingdom.

One patent covered Great Britain and Ireland, the Channel Islands, and the Isle of Man. The whole business of the Commissioners of Patents was conducted in one office under a responsible head. The stages of 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 was practically revived under the Patents Act of 1902); and (4), if it had not been done at the time of application,

Steps in obtaining a patent.

First introduction of Provisional Specification.

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

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 alteration 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, 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.

Examination of Applications.

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 was with The Patents, Designs, and Trade Marks Act of 1883. By this Act the procedure was still further

Procedure simplified and fees reduced.

simplified. The fees and stamps on the obtaining of a patent were reduced from £25 to £4 (under the Act of 1902 increased to £5), while the fees for maintaining the patent in force during the full term of fourteen years were reduced from £150 to £95. This sum, added to the £5 payable as fees on the obtaining of the patent, made exactly £100 as the cost in Government fees of obtaining and keeping in force a patent for fourteen years.

One invention.

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., represented the bulk of the changes made by the Acts of 1883 to 1902.

Patents Act of 1901.

The Patents Act of 1901 (1 Edw. VII. c. 18), which came into operation on the 1st January, 1902, related solely to international arrangements. It constituted an amendment of Section 103 of the Act of 1883, and extended from seven months to *twelve months* the time within which persons who had applied for protection of an invention in a country other than the United Kingdom, and being subjects, citizens, or domiciled inhabitants of or in a State which had adhered to the International Convention or with which reciprocal arrangements had been made by the British Government, were entitled to apply for a similar privilege in the United Kingdom.

Extension of period of priority under Convention.

Convention application to be accompanied by Complete Specification.

Sub-section 2 of Section 1 provided that any such application, when made in this country, must be accompanied by a Complete Specification, with drawings (if any); and provided, 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.

Patents Act, 1902.

The Patents Act of 1902 dealt with three important amendments, which were as follows:—

Examination.

(1) Applications were made 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 had 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, was to be deemed an anticipation of the patent so granted.

Compulsory Licences.

(3) The hearing of Petitions for the Grant of Compulsory Licences, which had been formerly in the hands of the Board of Trade, was transferred to the Judicial Committee of the Privy Council.

Patents and Designs Act, 1907.

The whole of the foregoing Acts, extending from 1883 to 1902, were, with certain trifling exceptions, repealed by the new Patents and Designs Act, 1907. But these, though repealed, have not lost their significance, and in the consideration of questions raised under the new Act must frequently be referred to, were it only that the changes introduced by the new Act should be better understood and appreciated.

The next chapter will be devoted to a more detailed consideration of these new features of the present Statute, which have already been briefly indicated in the Introduction.

CHAPTER II.

THE PATENTS AND DESIGNS ACT, 1907.

Effect of the Patents and Designs Act, 1907.

THE Patents and Designs Act of 1907 is practically an amending and consolidating Act by which the piecemeal legislation extending from 1883 up to 1907 has been gathered together, unified, and extended. Taken in conjunction with the Statute of Monopolies, the Rules framed by the Board of Trade and Order 53A of the Rules of the Supreme Court, together with the effective Clauses of the International Convention, we may be said to possess for the first time a Code of Patent Statute Law.

It must be remembered that the new Act is mainly a re-enactment of the provisions of the previous and now repealed Statutes. For that reason it is not proposed in the present chapter to do more than draw attention to the salient novel features, leaving to succeeding chapters a more complete consideration of the whole law and procedure.

The question as to who may be a patentee is left untouched, but the procedure in dealing with an application is slightly modified, and the powers of the Comptroller are considerably enlarged. In the first place the limits of the official search as to novelty are extended. Under the Act of 1902 the Examiner's researches were confined to specifications *published* before the date of the application, and deposited in pursuance of applications made within fifty years preceding. The new Act has the same provisions, but, in addition, the Examiner may now include in his search specifications published *after* the filing of the application, but of prior date thereto. If in the specifications published *before* the date of the application, it should be found that the applicant's invention has been already wholly and specifically claimed, then the Comptroller may absolutely refuse the grant of a patent (see Section 7). This is a new power given specifically to the Comptroller to refuse a grant on his own motion, and as the result of the official and statutory search.

Extension of official search.

Comptroller's power to refuse.

Hitherto the Comptroller has had statutory power to refuse a grant only in cases of opposition, where he found that the subject-matter of the opposed application had already been patented in this country.

No power of refusal under Section 8.

Apparently, however, this right of refusal can only be exercised by the Comptroller under Section 7. Where an anticipation of the applicant's invention has been found in a specification of prior date which has been published *after* the date of application, the Comptroller's power is limited to requiring references in the applicant's specification. From the wording of Section 8 it would seem that these references can be required whether or not the applicant's specification has been accepted or a patent granted to him.

The difference in the consequences arising from the search under Sections 7 and 8 respectively is founded on the following considerations. A specification which has been published before the date of the application, and was at that date open to all the world, constitutes prior publication; whereas, if published only after the date of application, it would constitute, not prior publication, but prior grant, the effect of which might, in the eye of the Court, be materially different.

Chemical samples.

In chemical inventions, typical samples may be required by the Comptroller before acceptance of the Complete Specification (Section 2, Sub-section 5).

Supplementary applications.

A novel system of supplementary applications is inaugurated by the new Act (Section 16). An applicant who has lodged a Provisional Specification, and who during the six months of provisional protection devises additional improvements therein, as to which he may be doubtful whether they can be included in the Complete Specification, may file one or more additional provisionals containing these improvements. If, when the Complete Specification falls due, the Comptroller is of opinion that these supplementary improvements may properly be incorporated therewith, then, one Complete Specification will cover all, and the patent will date from the earliest of the several applications. Apparently the respective claims, when founded on the subject-matter of these supplementary applications, will bear dates to correspond (Section 16 and Sub-section 2), and these sub-dates will be taken into

Dated claims.

consideration apart from the main date of the patent, in ascertaining the novelty and validity of the respective claims.

Patents of Addition.

It seems convenient at this point to draw attention to a further new feature in the Act, viz., the facility now given under Section 19 for obtaining Patents of Addition to an existing patent. These are only granted for improvements in or modifications of the original invention. Patents of Addition are free from the payment of annual taxes and expire with the mother patent.

Comptroller's power to revoke.

Another extension of the powers of the Comptroller is created by Section 26 of the Act. It is the power of revoking a patent at any time within two years from its date, on the application of any person who would have been entitled to oppose the grant, or is the successor in interest of a person so entitled. This application to revoke is in fact no more than a belated opposition, and the grounds urged to procure revocation must be identical with the grounds of opposition enumerated in Section 11. In lieu of revoking the patent, the Comptroller may make an order to amend the specification by disclaimer, correction, or explanation; or he may dismiss the application to revoke.

Revocation for working mainly abroad.

Section 27 contains the provision which has attracted the largest share of popular attention to the Act. This section provides that any person may at any time, not less than four years from the date of the patent, apply to the Comptroller for its revocation, upon the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom. This section is aimed at all patentees alike, whether British or foreign, but in effect it is directed against the holding of restrictive monopolies in this country by foreigners who manufactured wholly abroad, and used their British patents merely as a means of stifling competition in this country, without themselves employing British labour or stimulating British industries. There is no doubt that such a practice had, in respect of certain foreign made goods, almost reached the proportions of a scandal. It was wholly adverse to the meaning and intention of the sixth Section of the Statute of Monopolies, which had for its object the establishing "of new manufactures within this realm." However, the abuse is gone.

At first the section was administered in a most drastic fashion by the Comptroller; but in the cases of *Hatschek's Patents*, (1909, 26 R. P. C. 228), and *Bremer's Patent*, (1909, 26 R. P. C. 449), which were appeals from the Comptroller's decisions to revoke the patents, Mr. Justice Parker outlined the methods which the Court intended to adopt in giving effect to the section. The terms of the learned Judge's decision will be more closely scanned in the chapter on Revocation. Briefly, he held that in considering Sub-section 1 of Section 27, the comparison instituted by the sub-section is not to be a bare comparison between what is done in this country and abroad respectively by the patentee, his licensees and agents, but the comparison is between the extent to which the subject-matter of the patent is manufactured or carried on in this country and the extent to which it is manufactured or carried on abroad, whether the articles so manufactured are or are not imported into this country. The learned Judge was further of opinion that the policy of Section 27 is directed to secure fair play between foreign industries and the industries of this country, and not to secure to home industries, during the period of the patent, a protection which they would not enjoy if no patent had been granted.

Construction of Section 27.

Policy of Section 27.

In other words, it is not the intention of the Act to substitute one abuse for another, or to cause forfeiture of a patent by insisting upon unreasonable conditions, or to penalise want of success where *bonâ fide* attempts have been made to establish the industry in this country.

The grounds of opposition to the grant of a patent remain practically unchanged, but a fresh ground has been introduced, viz., that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the Complete Specification (Section 11).

New ground of opposition.

In all proceedings before the Comptroller, where an interested party appears in opposition to the grant or amendment of a patent, or as an applicant for revocation, the Comptroller has now discretion to award costs (Section 39), and in the case of an opponent domiciled outside of the jurisdiction, he may order the giving of security for costs.

Comptroller may award costs.

Premature disclosure of invention.

Where an invention, not yet protected, has been made public without the knowledge and consent of the inventor, a patent afterwards obtained by the inventor will not be held invalid on that account, if he proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that, if he became aware of the publication before the date of his application for a patent, he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication (Section 41, Sub-section 2). In the absence of any decision upon this sub-section, it would be unsafe to generalise upon how far the inventor would be protected by its operation. An inventor has always been protected against the results of the use made of confidential disclosures, where advantage was taken of such disclosures directly by the confidential agent, but not where the information had been transmitted to third parties under no such confidential obligation. This latter hardship is cured by the sub-section. Whether it would hold good in the case of an inventor publishing abroad, for example, with the result that a description filters through to this country, may be doubted. Knowledge and consent might be implied where reasonable care was not taken by the inventor, or where publication would be the natural result of incautious disclosure.

Petitions for extension.

Petitions for the extension of Letters Patent are now to be presented to the Court, instead of to the Judicial Committee of the Privy Council as formerly (Section 18). One result of this change of tribunal will probably be that petitions are less likely to be refused upon merely technical grounds, such as insufficiency of accounts and the like. The Judicial Committee were unable to cure defects of this sort, not having any machinery for referring accounts to enquiry. The High Court labours under no such disadvantage, and incomplete or mistakenly prepared accounts can easily be referred to Chambers for correction or amplification, without prejudice to the real merits of the Petition.

Failure to pay renewal fee.

A patent upon which the renewal fee has not been paid lapses. But by the new Act (as under the repealed Statute) if the fee is paid within three months after it fell due, together with a graduated fine, the Comptroller

shall restore the patent, apparently without requiring any statement of the circumstances which brought about the omission to pay the fee when due (Section 17, Sub-section 1). This is a relaxation of the terms of the corresponding Section 17 of the repealed Act, which required that the Comptroller should be satisfied that the non-payment of the fee arose from accident, mistake, or inadvertence.

Revival of lapsed patent.

But the new Act goes further in the direction of saving lapsed patents, and provides in Section 20 that even where a patent has lapsed from non-payment of fees, and the three months' grace has expired, the patent may yet be revived on application being made to the Comptroller, with a full statement of the circumstances that led to the failure to pay the renewal fee. If it appears that the failure was unintentional, and that no undue delay has occurred in making the application, the patent may be replaced on the Register. The restoration is made subject to conditions for the protection of those persons who may have used the patent after it has been advertised in the *Patent Journal* as void.

Surrender of patent.

Another new provision is found in Section 26, Sub-section 3, by virtue of which a patentee may at any time surrender his patent by giving formal notice to the Comptroller to that effect. A patentee is thus enabled to rid himself of his patent in an inexpensive manner, should he be threatened with a petition for revocation to which he has no effective answer.

Counter-claim for revocation.

In an action for infringement, any defendant who is entitled to petition for the revocation of the plaintiff's patent, may now, under Section 32 of the new Act, apply for revocation by way of counterclaim in the action. Formerly this was not possible, and a separate petition for revocation had to be presented.

Defendant's ignorance of patent.

Under Section 33 a patentee suing for infringement of a patent granted after the commencement of the Act is not entitled to recover damages from a defendant who proves that, at the date of the infringement, he was not aware or had no reasonable means of making himself aware of the existence of the patent. Even if the articles made and sold under the patent are marked "patented" this shall not of itself be held to constitute notice of the

existence of the patent, unless the intimation is accompanied by the number and date of the patent. The section expressly leaves the defendant subject to an injunction. As "damages" alone are mentioned, some commentators on the new Act thought it possible that the section left the defendant liable to be called on for an account of profits, although it is obvious that this would only be damages under another name. But in the trade mark case of *Slazenger* v. *Spalding* (1909, 27 R. P. C. 20), Neville, J., held that where the Statute or practice barred "damages," there was only a right to an injunction and none to compensation (*Edelsten* v. *Edelsten*, 1 De G. J. & S. 185 followed).

Rights of co-patentees.

The rights of co-patentees are dealt with in Section 37 of the new Act. Therein it is provided that where, after the commencement of the Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein, as joint tenants; but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent; and if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

Right of co-patentee to grant licences.

The inclusion of Section 37 in the Act was probably prompted by a desire to mitigate the harsh effects of the known rule at law that, where there has been no severance of the joint interest, the share of a deceased joint owner passes to the survivor. The doubt that has hitherto existed, as to whether a co-patentee could grant a licence on his own responsibility, is now set at rest by the terms of the section. He cannot do so without the consent of his co-owners.

Disconformity.

Up till the coming into force of the present Act, a fruitful cause of disaster to a patentee who sought to assert his rights, lay in the danger of disconformity between the Provisional Specification and the Complete: that is to say, where the claims attached to the Complete endeavoured to secure something not indicated in the Provisional. This possible hardship has been remedied by Section 42 of the

new Act. The section provides that a patent shall not be held to be invalid on the ground that the Complete Specification claims a further or different invention to that contained in the Provisional, if the invention therein claimed, so far as it is not contained in the Provisional, was novel at the date when the Complete Specification was put in, and that the applicant was the true and first inventor thereof. Of course, if the disconforming matter claimed was old, or had been published at the date of the Complete, or had been protected in the interim by another inventor, the patent would still be bad. The section should be read in conjunction with Section 16, providing for supplementary applications during the period of provisional protection. One result of this section should be the exercise of caution in publishing, during the period of provisional protection, developments of the invention which the inventor might wrongly assume to be covered by his original application.

Unlawful conditions as to sale.

Section 38 is directed chiefly against a practice not unknown among the owners of patent rights—of imposing restrictive conditions upon their licensees and agents, as to the use and purchase, in conjunction with the patented article, of goods which are not patented. For example, compelling the licensees of a patented gas mantle to purchase or use therewith a burner which is not patented. The Act is retrospective in giving the power to cancel existing agreements of such a nature, on three months' notice, under certain conditions of compensation which, failing agreement between the parties, may be awarded by an arbitrator appointed by the Board of Trade.

The foregoing comprise the bulk of the more important new provisions in the Act. The digest is not exhaustive, but attention will be drawn to the less noteworthy new features, in the body of the work, where the sections are more fully discussed under the respective headings. The remainder of the Act is, generally speaking, merely a repetition of the repealed Statutes.

Having thus glanced broadly at the origin and development of patents for inventions, and traced the history of the successive Statutes up to the present day, the law as it now stands can be discussed with greater profit. For the purpose of preserving some order in the arrangement

of the work, it is proposed to group the different phases of the subject under the following headings:— Headings of contents.

1. Procedure in Obtaining Patents.
2. Who may be a Patentee.
3. Subject-matter of Patents.
4. The Specifications.
5. Opposition to Grant of Patent.
6. Sealing of the Patent.
7. Amendment of Specifications.
8. Action for Infringement.
9. Revocation of Letters Patent.
10. Action to Restrain Threats.
11. Extension 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 III.

PROCEDURE IN OBTAINING PATENTS.

Appleation 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 the Patent Office and 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 1) 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 1A is to be used in the case of inventions communicated from abroad to an agent in this country; and Form 1B where application is made under International and Colonial arrangements; Form 1c is used for an application for a Patent of Addition; and Form 1D for the rare instance of an application for a Secret Patent.

How to fill in forms.

Communication form.

Convention form.

Provisional protection.

If the applicant wishes to apply for provisional protection only, he will receive with the application form two unstamped copies of Form 2, 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.

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 3) can also be purchased at the Patent Office or 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 3 issued under the Patents Rules of 1908, has a footnote referring to Rule 14, 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 paper of smooth surface and good quality, each sheet to be in duplicate, size 13 inches in length by 8 to 8½ inches in width, or, if this is too small, 13 inches in length by 16 to 16½ 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. In chemical inventions, the Comptroller may require typical samples and specimens to be furnished in duplicate before the acceptance of the Complete Specification. The filing of such samples is advertised in the *Journal* in connection with the advertisement of the acceptance of the Complete Specification.

Must agree with Provisional.

Claims.

Drawings.

Chemical samples.

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 28 of 1908, require amendment, and he may also, under the same 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, 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.

Comptroller may alter date.

One invention only.

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 93 of The Patents Act, 1907—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).

Unpatentable inventions.

These preliminary points disposed of, should they crop up, the Examiner then addresses himself to the further investigations prescribed by Section 7 of the Act of 1907, *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 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. By the further examination provided for in Section 8 of the Act the investigations are now extended to specifications published after the date of the application, but deposited in pursuance of prior applications.

Examination as to novelty.

Section 7.

Section 8.

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*.

Acceptance of specification.

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 30 of 1908) within which the application must be amended and returned to the

Examiner's report.

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 7, Sub-section 4 of the Act of 1907).

Inserted reference to prior patents.

The exact wording of the inserted reference is given in Rule 32 of 1908. It runs thus: "Reference has been directed in pursuance of Section 7, Sub-section 4, of The Patents and Designs Act, 1907, to Specification No. of 19 ." The reference is inserted after the claims. Where the reference is inserted as the result of a provisional report under Rule 29 a statement to that effect shall be added to the reference.

Terms of reference.

Reference under Rule 29.

But if the Comptroller is satisfied that the invention claimed has been already wholly and specifically claimed in any specification to which the investigation under Section 7 has extended, he may refuse to grant any patent on the application.

Refusal of patent.

But no such power of refusal attaches to the result of examination under Section 8. Here the Comptroller can only order a reference to the anticipating specification or specifications. The reason for the difference of treatment under the respective sections is that under Section 7 the Comptroller is dealing with prior publication, but under Section 8 with prior grant.

Difference of procedure under Sections 7 and 8.

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

Avoidance of references.

is evident that references are not to be indiscriminately made. Thus the mere fact that a specification contains one or more elements already described in prior patents will not call for a reference to these patents, so long as it is made indisputably plain that the applicant does not claim these elements.

Appeal.

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.

Comptroller's directions under the Act and Rules.

As a general guide to the administrative carrying out of the procedure under Section 7 of the Act and the Patents Rules 28 to 32, it may be of value to reproduce the latest official notice on the subject:—

(1) Rule 30 must be complied with, but where good cause is shown time will be allowed—*e.g.*, when the applicant is abroad or the complexity of the case requires it.

(2) The interviews and correspondence between Examiner and applicant will be restricted as far as possible to the absolute necessities of the case, and will aim at bringing to a clear issue at the *earliest possible date* the differences between the applicant and the Examiner. A time limit will be imposed wherever practicable in accordance with the circumstances and complexity of the case.

(3) No hearing will be appointed unless there is a direct issue between the Examiner and the applicant, or unless the applicant fails to submit amendments or make a real endeavour to avoid the citations within the time limited. When the issues are defined or when agreement is clearly impossible, notice of a hearing for a future date will at once be given.

(4) If the applicant desires any amendments to be considered at the hearing, other than those which he has submitted to the Examiner under Rule 30, such amendments should be submitted seven days at least before the date of the hearing.

(5) At the hearing, whether attended or not by the applicant, the Comptroller may, as an

alternative to the insertion of references, prescribe amendments which will be to his satisfaction under Section 7, Sub-section (4), and in such case the applicant must elect, within such time as may be fixed by the Comptroller, whether he agrees to the prescribed amendments or to the insertion of a reference. If no commmication is received within the time prescribed, the references will be inserted. In cases requiring special treatment, a limited time may be allowed for the precise form of amendment to be settled, and the hearing adjourned if necessary.

(6) As far as possible, all questions between Examiner and applicant will be decided at the hearing and, except as indicated herein, no further opportunity of amendment will be allowed to the applicant and the specification will only be accepted with the amendments or references prescribed in the Comptroller's decision.

(7) If, after the decision has been given or the applicant has made his election under Paragraph 5, the applicant desires to amend, he must make a special application for that purpose to the Comptroller, and for this purpose Form 17, having a 30s. stamp, may be used. If the amendments suggested are satisfactory to the Comptroller, a statutory reference may be removed.

Acceptance of Complete and publication.

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.

Period for opposition.

Sealing 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.

Advantages of Provisional with application.

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, 1907, Section 13). To these should be added the consideration that, as the Provisional Specification may be a document 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.

Applicant may work invention during Provisional Protection.

Infringements after publication of Complete.

Renewal of abandoned application.

Filing Complete with application.

Secondly.—If, on the contrary, application is made accompanied by a Complete Specification, the advantages which arise from such a course are 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.

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, 1907 (Section 91), and The Patents Rules (15 to 18), 1908. An application under the Convention must be made on Form 18, and, according to Rule 15 of The Patents Rules, 1908, 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.

Applications under the Convention.

Conditions to be observed by Applicants under Convention.

It must be remembered that an applicant under the Convention can include in his specification only what has been applied for abroad. In a decision on a Convention application reported in the *Patents Journal* of the 11th August, 1909, the Comptroller says:—"It appears to me to be clear from Section 91 that an applicant applying for a Convention patent in this country is only entitled to include in his specification what has substantially been protected abroad. The language of the claim or of the description may no doubt differ, but the specification ought

Limits of Convention application.

Comptroller's directions re Convention applications.

not in my view to claim protection for anything which i not protected in the foreign country. How then is thi to be decided? I think *primâ facie* the foreign specificatio should be considered and examined on precisely the sam principles as that of an English patent, and that what i protected should be gathered from the claims as interprete by the description and the drawings. Where differen principles apply in foreign countries, to determine what is in fact protected under the terms of the patent, some *primâ facie* evidence must be given by the applicant or agent to show the foreign practice. Strict proof will not be necessary upon this point, but a *primâ facie* case must be made to secure a wider and more liberal interpretation of the foreign specification. The questions to be determined in each case are—What has in fact been protected by the foreign patent, and does the English patent apply to that and nothing more?" Since the date of this decision the Comptroller has intimated that in using the phrase "*protected* by the foreign patent" he meant "*claimed* in the foreign 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.

Patent Rules.

Rules 7, 15, 16, 18, and 83 of The Patents Rules, 1908, govern these Convention applications, and these Rules are set out in full at the end of this division of the work. Readers are advised to supplement their perusal of this chapter by an examination of the Rules.

Some reasons for the employment of Patent Agents.

In the foregoing description of the mode of procedure it has been assumed that the Provisional and Complete Specifications are prepared by the inventor himself. But if the writer may be allowed to express an opinion, grounded upon long experience, the preparation of the specification by the inventor himself is not a course to be recommended. No prudent man attempts to draw a conveyance, mortgage, will, or other legal instrument without the assistance of a properly qualified adviser, and such

care is no less essential in the case of Patent Specifications, especially in view of the increased difficulties and responsibilities thrown upon an applicant by the advent of the examination system. 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 large proportion of the applications made every year by inventors themselves 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 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. Under Sub-section 5 of Section 6 of the Act, the Complete Specification must be accepted within twelve months from the date of the application, except when the delay arises from an appeal, but the time for acceptance may be extended from one to three months on payment of the fee, which amounts to £2 for one month's, £4 for two months', and £6 for three months' extension.

Extension of time to complete application.

Extension of time for acceptance of Complete.

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

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 No. 10, bearing a stamp of £1, and on receipt of the notice, the patent is sealed and issued as of the date of the application.

Extension of time to pay sealing fee. Where there has been neglect or failure to pay the sealing fee, the applicant may apply to the Comptroller on Form 11 for an extension of one month, or two months, or three months, at respective fees of £2, or £4, or £6, within which to pay the fee. The circumstances and causes of the failure to pay must be set out in detail in the form, and if the Comptroller is of opinion that there was reasonable excuse for the failure, he may seal the patent within the extended period.

Secret patents. An application for a secret patent (Form 1D) is likely to be so rare an event that it is hardly worth discussing. The subject-matter must be some improvement in instruments or munitions of war. By Section 30 of the Act, the inventor must be a party to a contract of assignment to the Secretary of State for War or the Admiralty, who certifies that the Complete Specification and drawings are to be handed to the Comptroller in a sealed packet, instead of being left at the Patent Office in the ordinary manner. Section 30 gives full information as to the procedure.

Patents of Addition. Applications for Patents of Addition are made on Form 1C, which varies from the ordinary form in describing the subject-matter as "an improvement in or modification of" the invention for which the mother patent was granted. No renewal taxes are payable on such Patents of Addition, and they expire with the mother patent.

Duration. Patents are granted for fourteen years, and cover Great Britain and Ireland and the Isle of Man, but not the Channel Islands.

Patent Office hours. The Patent Office hours are from 10 to 4. An application handed in after 4 is dated of the following day (*Matthew's Application*, 1910, 27 R. P. C. 228).

CHAPTER IV.

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. But a corporate body alone cannot 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*,

Crown.

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.

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 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

Importers.

Rights of foreign inventors under International Convention.

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 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 David & 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 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.

Master and servant.

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 (Sections 43 and 93).

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.

Revocation of fraudulently obtained patent.

Where a patent has been applied for and granted in fraud of the true and first inventor, the latter may apply to revoke the patent on that ground, and if successful he may apply to the Comptroller to issue to him a patent in lieu of and bearing the same date as the patent so revoked (Section 15, Sub-section 2).

CHAPTER V.

SUBJECT-MATTER OF PATENTS.

Definition of "Invention."

IT has been said that in none of the repealed Patent Statutes has any attempt been made to define the meaning of the term "Invention." In all instances the reader was referred back to the ancient Statute of Monopolies. The new Act of 1907 preserves the same discretion (see Section 93). Turning, then, to Section 6 of the Statute of Monopolies, 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.

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" means both method of making and product.

"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 transmit messages, and for these devices patents will be granted.

But does not include bare 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, and modes 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

Example of the highest type of invention.

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 a lower type.

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.

Improvements in existing machinery.

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

Instances of apparently slight advance.

Moser v. *Marsden*.

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

Instances of very slight advance.

Goddard v. *Lyon*.

In *Goddard* v. *Lyon* (1894, 11 R. P. C. 354) the only essential difference between the plaintiff's disinfecting machine and similar disinfecting apparatus made before the date of the patent was, according to Lord Watson, that "in the plaintiff's, the purifying chamber is fitted with a door capable of resisting, and therefore enabling the process to be carried on with, high pressure steam. If the 'Aberdeen'" (*i.e.* the alleged anticipation) "had been made with a door to the inner chamber which would

have permitted the use of high pressure steam, the plaintiff's invention would, in my opinion, have been thereby anticipated." It may be said that, in spite of the apparent obviousness of the improvement, the patent was sustained.

To multiply examples of what have been held to be patentable improvements in existing machinery (no change being made in the purposes for which such machines are used) would be to cite more than half of all decided patent actions, and the two foregoing cases have been selected as examples of comparatively slight improvements in existing mechanism which have been upheld as patentable matter. Still, let it be noted that obvious alterations and additions, such as might occur to a man of average intelligence in constructing a machine, are not as a rule patentable. The advance must betray *invention* as well as involve *utility*. What these expressions have been held to mean will be discussed under their proper headings.

Obvious alteration not invention.

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

Improvements upon existing patents.

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

Although patents are granted for combinations, it must be said at the ontset that a combination to warrant a patent should show invention. Obvious combinations are not good subject-matter. Therefore, in every case it

Patents for combinations.

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 *prima facie* exercise invention, but only ordinary workman's skill, and in that case the machine, although perhaps the first of its kind, is not necessarily a patentable invention. Take as an example the simplest form of combination: viz., the mere coupling together of two well-known things which have heretofore acted separately, but which on being connected give a continuous operation. A good illustration of this is to be found in *Williams* v. *Nye* (1890, 7 R. P. C. 62). The plaintiff in this case had merely taken a well-known mincing machine and an equally well-known machine for filling skins and connected them together, so that the mincing and filling operations were continuous instead of being interrupted as before. The result was a sausage-making machine which was proved to be most useful, meritorious, and economical. Nevertheless, the Judges of the Court of Appeal expressed themselves as satisfied that there had been no such exercise of the *inventive* faculty as to make the plaintiff's machine subject-matter for a patent. Even where the combination was apparently not quite so easy to effect, the patent could not be upheld. In *Saxby* v. *Gloucester Waggon Co.* (1880-3. 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.

More judicious arrangement not patentable.

More putting together two known things not invention.

Williams v. *Nye*.

Saxby v. *Gloucester Waggon Co.*

Still, even this simplest type of combination—viz., the connecting of two well-known machines—might be patentable if the method and means used to connect them required invention. For example, merely to place a folding machine in line with a printing machine, so as to print

But mere coupling together if invention is required is patentable.

and fold continuously, instead of separately as before, would not be an invention if nothing more were done.

Oddly enough, although this simple illustration of a non-patentable combination was given by the author in the Second Edition of this book in 1902, a case occurred in 1906 which was strangely similar (*Northern Press, &c. v. Hoe & Co.*, 1906, 23 R. P. C. 613). The alleged invention consisted in interposing a double folding machine between two printing machines arranged end to end. The results were undoubtedly advantageous, but the Court of Appeal scarcely condescended to consider the patent seriously. As Romer, L. J., remarked: "The two separate parts of the machine are really doing each their own work, and not the less because you put them into one machine." *Northern Press v. Hoe.*

Nevertheless, if the continuous printing and folding had involved some necessary transmitting mechanism, requiring design and the exercise of invention, to pass each printed sheet separately to the folders, then the combination might well be patentable subject-matter.

Combination of a concretion and abstraction not patentable.

It is impossible to patent the combination of a concrete thing with an abstract property or qualification. Chief Baron Pollock, in trying to express this, once said: "You cannot have a valid claim for the combination of 2½d. with a pound of butter." An example will help the point to be better understood. We will suppose that rollers covered with porcelain were well known as being the best rollers that could be used for crushing grain. Suppose it were afterwards discovered that to make one roller run a little faster than the other produced a grinding as well as a crushing effect, which vastly improved the result by separating the germ from the starch part of the grain. Here is a real invention. It cannot be said that the idea is unpatentable. But, at all events, the claim that was really made—viz., "The combination of porcelain rollers with *differential velocity*"—proved to be untenable. Neither is it possible to patent a combination of two things between which no functional combination exists. In criticising a faulty claim of this nature in *Desmond's Limited* v. *Balmoral Cycle Co.* (1898, 15 R. P. C. 505) Chitty, L. J., remarked 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

Combination of things having no functional co-operation.

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 ... lts 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."

Again, in *Klaber's Patents* (1906, 23 R. P. C. 461) Lord Davey said: "A proper combination for a patent is the union of two or more integers, every one of which elements may be perfectly old, for the production of an object which is either new, or at any rate is for effecting an old object in a more convenient, cheaper or more useful way. But the point in a combination patent must always be that the elements of which the combination is composed are combined together so as to produce one result."

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 re-arrangement, 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; *Nettlefolds* v. *Reynolds*, 1892, 9 R. P. C. 270; *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. 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.

Wood v. Raphael.

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 *pince-nez* case is, that in *Wood* v. *Raphael* (*supra*) *all* of the parts of the combination had before been used separately in a *pince-nez*, whereas in

Siddell v. Vickers.

Combinations of known parts must show new functional advantages.

Siddell v. *Vickers*, *one* of the elements of the combination had not been used for such a purpose before, and in addition a new functional advantage was gained by the combination. It would be unsafe, however, to deduce any general rule that no combination, the parts of which had been separately used for the same purpose, could, as a combination, be patentable subject-matter.

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

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."

Commercial success.

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.

Taylor & Scott v. *Amand.*

Thus, in *Taylor & Scott* v. *Amand 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 those

rollers had been of equal length with the main printing cylinder. A baby-roller, or short drum adjustable on a shaft, was *per se* of common knowledge for other purposes, and shafts carried in eccentric bearings are quite usual in other machinery; for instance, in throwing toothed wheels in and out of gear. In short, as far as the immediate claim of the plaintiffs against the defendants was concerned, there was no single item of the arrangement which was not old in machinery generally, and certainly invention was not strikingly evident. The Court of First Instance felt this so much that the patent was declared bad, *inter alia*, for want of subject-matter. But this judgment was reversed and the patent sustained by the *Court of Appeal and House of Lords*. *Lord Halsbury*, L. C., in his judgment, admitted that "there is nothing more difficult, when one is dealing with a mechanical combination, than to keep one's mind free from the impression created by the fact that all the elements or most of the elements are old," and further quoted with approval the dictum of Lord Herschell in *Vickers* v. *Siddell* (1890, 7 R. P. C. 304) on the difficulty of applying the law relating to combination patents to particular cases. The deft manner in which the apparently simple and obvious appliance of the plaintiffs coped with the particular requirements 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 *Fawcett* v. *Homan* (1896, 13 R. P. C. 398), which related to concrete flooring; *Goddard* v. *Lyon* (1894, 11 R. P. C. 354), where the invention, broadly speaking, consisted in strengthening a steam door in an otherwise old disinfecting machine; and *Birch* v. *Harrop* (1896, 13 R. P. C. 615), where the plaintiff, although unsuccessful in proving infringement, nevertheless successfully upheld the validity of his patent for a combination in which the only new feature appears to have been a not very striking variation

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.

The often quoted cases of *Curtis* v. *Platt*, *Nettlefolds* v. *Reynolds*, *Birch* v. *Harrop*, and others, are, therefore, instances of the narrower 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 defeated, if the alleged infringer has changed or modified 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 not have been separately claimed and 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 if on a fair construction of the plaintiff's specification it appears that he had it in his mind to claim it.

Lister v. Leather.

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 new process gives protection to each part thereof *that is new and material for that process.*" But this dictum can no longer be accepted in its entirety since the judgment of Lord Cairns in *Clark* v. *Adie* (1875, L. R. 2 App. Cas. 315), the effect of which was discussed by Moulton, L. J., in *British United Shoe Machine Co.* v. *Fussell & Sons* (1908, 25 R. P. C. 631). 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?" But to this dictum also must now be attached the further condition—Has the patentee

Parkes v. Stevens.

made its importance plain, and has he either inferentially or in terms claimed the new and material part?

Proctor v. *Bennis*.

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

Relying upon the opinion of Lord Westbury in *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 ruling of Lord Cairns, in *Harrison* v. *The Anderston Foundry Co.* (1876, L. R. 1 App. Cas. 574), wherein it was laid down that where the claim is for a combination, the combination is *ex necessitate* the invention, and no discrimination between old and new is required, a rule which holds good whether or not the combination includes new integers. The decision of the Court of Appeal in *Proctor* v. *Bennis* was not founded on the fact that the defendant in using the swinging flaps, had taken the "pith and marrow" of the plaintiff's combination, but that the combination of the defendant included the substance of the invention and was *substantially the combination of the plaintiff*. The fact is that each case of the kind will be

Novel element in combination.

Harrison v. *Anderston Foundry Co.*

considered on its own merits, and where a combination includes an important element, novel and material for the purpose, but not specifically claimed, the Court will not be astute to relieve a defendant, if by any means it can be held that his combination is substantially the plaintiff's combination, especially where the new element is of great importance and value, a fact which should be established by evidence, as was done in *Proctor* v. *Bennis*.

While on the subject of distinguishing new from old in a combination, the reader may be helped by what fell from LL. J. Vaughan Williams and Moulton in *British United Shoe Co.* v. *Fussell* (1908, 25 R. P. C. 631). *Per* Vaughan Williams, L. J.: "*Foxwell* v. *Bostock* is not overruled, and it is doubtful whether it is true to say that in a combination, the whole of which is claimed as new, there is no obligation to distinguish old from new." *Per* Moulton, L. J.: "It is not a good objection to a claim for a combination that the patentee has not distinguished old from new. *Foxwell* v. *Bostock*, so far as it laid down any duty in a patentee to distinguish what is new in a combination, is not in accordance with and must be taken to be overruled by *Harrison* v. *Anderston Foundry Co.* The dictum of Lord Campbell in *Lister* v. *Leather*, that a patent for a combination gives protection to each part thereof that is new and material, is erroneous and is now overruled."

If essential of combination is taken the patent is infringed.

Of course if the new element is specifically claimed, all of these difficulties of construction are got rid of. Thus in *Wenham* v. *May* (1887, 4 R. P. C. 303), the patentee had invented a gas lamp in which wire gauze screens were used in certain specified positions, the said gauze screens being claimed "as described and shown." The defendants also used gauze screens, but not in the same positions as in the plaintiff's lamp, their defence being, practically, that they had not infringed the specific combination claimed. It was held that, both upon the evidence and the specification, the object of the plaintiff's invention was to equalise and regulate the regenerative air-currents by means of wire gauze screens, irrespective of the specific arrangement, and that the defendants by adopting such gauze screens had infringed the essence of the plaintiff's patent. A lesson on the essentials 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).

In *Combination Hubs* v. *Seabrook* (1906, 23 R. P. C. 209), where the essence of the invention was a longitudinally sliding clutch, positively actuated through a screw from the pedals so as to drive, free-wheel, or brake, the Court held that, although adopting a materially different combination from that of the plaintiffs, the defendants had in fact taken and adopted the substance of the plaintiffs' combination, *i.e.* the longitudinally slidable part.

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 (*Bauge* v. *Higginbottom*, 1902, 19 R. P. C. 187; *Stone* v. *Broadfoot*, 1909, 26 R. P. C. 361).

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

New compositions of materials.

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

In order to differentiate the selected heads that have been set down as representing the main divisions of subject-matter, and so to avoid repetition, it will be necessary to consider the word "manufacture," not always in the broad and general terms extracted from the Statute of Monopolies, but sometimes in its narrower and more generally understood sense.

Restricted meaning of "Manufacture."

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

Examples.

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

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

Then to glance at a 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.

Example of improvement in existing manufacture.

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

Substitution of one known material for another 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.

If invention required, such substitution is patentable.

American Braided Wire Co. v. *Thomson.*

But where the substitution of one material for another requires adaptation, and shows some ingenuity, the patent may be upheld. Thus, in *American Braided Wire Co.* v. *Thomson* (1889, 6 R. P. C. 518; L. R. 44 Ch. D. 274), woven wire was for the first time used to make ladies' 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.

Obvious analogous user not patentable.

The application of a known article or apparatus to a purpose analogous to that to which it has been already applied is seldom subject-matter, and is never so held if the extension to this analogous purpose appears obvious.

Examples of obvious analogous user.

Thus an old form of locking apparatus, formerly used in cycles when in motion, was held, in *Singer* v. *Rudge* (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. *E. Braby & Co.* (1894, 11 R. P. C. 198) the use of steam pressure, in a manner analogous to the well-known oil vapour pressure in lighting apparatus of the "Wells" type, was held not patentable. So the use of a common mode of joining the abutting ends of wires by a split tube and solder, for the specific purpose of connecting the joined ends of the inextensible wire

rings of tyre covers, was held in *Shaw* v. *Barton* (1895, 12 R. P. C. 282) to be bad subject-matter. In *Dredge* v. *Parnell* (1899, 16 R. P. C. 625) an apparatus for cutting necktie linings by clamping several layers of material between templates and cutting through the mass with a band-knife, the knife being guided by the conformation of the templates, was held bad. The evidence showed that cutting piles of cloth with a band-knife was old, and also the use of guiding templates for the same purpose. There certainly were difficulties to be overcome in dealing with such soft and fluffy material, but the House of Lords, sustaining the Courts below, held that the alleged invention was merely a more skilled application of well-known tools and processes. The Judges were not unanimous either in the Court of Appeal or in the House of Lords.

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

An old and frequently quoted case on the point of analogous use, is *Harwood* v. *Great Northern Railway Co.* (1860-5, 2 B. & S. 194, 222; 11 H. L. 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* (1890, 7 R. P. C. 131), where a "cee" spring, long in use at the rear of a carriage, was claimed when applied to the front. The plaintiff failed on the ground that it was a mere analogous user, and that no sufficient invention was apparent. 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."

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

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

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 *Bamlett* v. *Picksley* (1875, Griff. P. C. 40), gave an example of

what he considered could be a patentable analogous user, by supposing the apparatus commonly in use for the making of macaroni piping of paste, adapted so as to be used for the manufacture of metal tubing; just as in *Ehrlich* v. *Ihlee* (1888, 5 R. P. 437) the Jacquard principle was used for the production of musical sounds and harmonies, instead of for weaving patterns in a loom.

Examples of users held not to be analogous.

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* wax 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 propellor 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.

Penn v. *Bibby.*

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

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. *Levenstein* (1887, 4 R. P. C. 449), "analogy does not go a long way in chemistry."

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

No general rule applicable.

of old things to analogous or apparently analogous uses, such invention and experiment have been required, and such increased utility proved, as will entitle the patentee to have his patent upheld.

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

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 *Vorwerk* 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

Products as subject-matter for patents.

there is a new thing produced, and that is useful and complies with other requirements, then in my opinion there could be a thoroughly good patent taken out for that."

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

In *Rickmann* v. *Thierry* (1896, 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 new 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 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 re-arrangement 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. 214; 8 Taunt. 375), where the process related to the manufacture of iron, said that a new combination of old materials is patentable: and in *Gibson* v. *Brand* (1841-2, Good. P. C. 211; 11 L. J. C. P. 177), where the patent related to a new process in the manufacture of silk, Coltman, J., said that a process is good subject-matter. James, V.-C., in *Elmslie* v. *Boursier* (1869, L. R. 9 Eq. 217; 39 L. J. Ch. 328), said that one of the most useful of inventions is that of a process by which

Old cases on process patents.

Elmslie v. *Boursier.*

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.

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

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

A process may be new and the product may be new, yet the process may be worked by apparatus which has been in common use before, and cannot be claimed merely because of its application to a new purpose. But in some

Patent might be for process, product, and apparatus.

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 *or* separate patent.

6. *New Principles and Modes 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 in 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

Otto v. *Linford.*

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

Hickton v. *Patents Co.*

A reiteration of the accepted views of the patentability of a new "idea," coupled with some means for giving it practical shape, took place in the recent case of *Hickton's Patent Syndicate* v. *Patents and Machinery Improvements Company* (1909, 26 R. P. C. 313). The idea embodied in the patent was the "shogging" of the comb bars in a "levers and

go-through" lace machine for the purpose of equalising the thread drawn from each bobbin. Such "shogging" was old in other types of lace machines, but had never been used for this specific purpose. It was admitted that there was no invention in the means shown to produce the "shogging." The Court of First Instance held that for this reason there was no subject-matter, although the the idea was meritorious. The learned Judge, in the course of his judgment, said: "An idea may be new and original and very meritorious, *but unless there is some invention necessary for putting the idea into practice it is not patentable.*"

A new idea carried out by obvious means is patentable.

The Court of Appeal had no difficulty in disposing of this heresy, and incidentally expressed opinions that may in the future bear fruit. Cozens-Hardy, M. R., said: "When once the idea of applying some well-known thing for a special and new purpose is stated, it may be very obvious how to give effect to that idea, and yet none the less is that a good subject-matter for a patent."

As for the judgment of Fletcher-Moulton, L. J., it is so instructive that it is worth reproduction. Said the learned Lord Justice: "After the judgment of the Master of the Rolls I do not intend to enter into the facts of the case, but I do wish to deal with the dictum of the learned Judge in the Court below, which really gives the ground for his decision. The defendants contend that although the idea of traversing by 'shogging' in order to equalise is new, yet it is not proper subject-matter for a patent, as no invention whatever was necessary to carry to ont. The learned Judge says: 'An idea may be new and original and very meritorious, but unless there is some invention necessary for putting the idea into practice it is not patentable.' With the greatest respect for the learned Judge, that, in my opinion, is quite contrary to the principles of Patent Law, and would deprive of their reward a very large number of meritorious inventions that have been made. I may say that this dictum is to the best of my knowledge supported by no case, and no case has been quoted to us which would justify it. But let me give an example. Probably the most celebrated patent in the history of our law is that of *Boulton & Watt*, which had the unique distinction of being renewed for

Moulton, L.J., on principle patents.

the whole fourteen years. The particular invention there was the condensation of the steam, not in the cylinder itself, but in a separate vessel. That conception occurred to Watt, and it was for that that his patent was granted, and out of that grew the steam engine. Now can it be suggested that it required any invention whatever to carry out that idea when once you had got it? It could be done in a thousand ways and by any competent engineer, but the invention was in the idea, and when he had once got that idea the carrying out of it was perfectly easy. To say that the conception may be meritorious and may involve invention and may be new and original, and simply because when you have once got the idea it is easy to carry it out, that that deprives it of the title of being a new invention according to our patent law, is, I think, an extremely dangerous principle and justified neither by reason nor authority. I have taken the case of *Boulton & Watt* with the condenser, but I can give another. Take the case of the safety valve for boilers. The man who first discovered the idea of a properly weighted valve in the boiler solely for the purpose of relief, if the pressure rose too high, would have been making a most valuable and meritorious invention. So soon as he conceived that idea of guarding against the danger of explosion the carrying out of the idea required no invention at all. In my opinion, invention may lie in the idea, and it may lie in the way in which it is carried out, and it may lie in the combination of the two; but if there is invention in the idea plus the way of carrying it out, then it is good subject-matter for Letters Patent. As a matter of fact in the present case I have not the slightest doubt that there is good subject-matter."

Obvious means of carrying out principle.

Apparently, in this case, the patent would have been sustained even had the inventor simply formulated his "idea" and contented himself with saying "the 'shogging' of the comb-bars may be effected in any suitable or known manner," or even if he had left this direction out. If e idea is new, and the means for carrying it out are obvious, surely it is mere pedantry to insist upon these obvious means being described and claimed as part of the consideration for the grant.

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). On the other hand, 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 or idea. 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.

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 the 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 juridicial 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." Dr. Martin's views which went rather beyond the canons accepted in 1900 have been amply justified by the dicta of the Court of Appeal in *Hicks's Patent Syndicate* v. *Patents and Machinery Improvements Company* (*supra*).

If quasi-principle exists it should be claimed.

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.

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).

Mere 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, and was so even under the late Statutes. 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.

CHAPTER VI.

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 93 of The Patent Act, 1907, "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 the quality of invention. As Bowen, L. J., said in *Lyon* v. *Goddard* (1893, 10 R. P. C. 334): "The question whether there is any ingenuity in the subject-matter of a patent is a question of fact, which depends on a true view of all the circumstances."

Attempts to define invention by the Bench.

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 have 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 (*Beavis* 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."

Moulton, L. J., on apparent triviality of inventions.

"I remember," said Moulton, L. J., in *British United Co.* v. *Fussell* (1908, 25 R. P. C., p. 646), "a machine for printing newspapers and turning them out in a folded form, in which the whole difference between hopeless failure and most valuable commercial success depended on a trivial change in the arrangement between the nose of the plough over which the sheet was bent and certain rollers which actually folded the paper after it had been thus bent, a matter which, when you read it on paper, seemed to be perfectly trivial, but which . . . . actually turned failure into success."

In the same case the learned Lord Justice dwelt on the importance of considering the conditions under which a machine was worked, such as high speed and the like, when determining whether or not a change apparently trivial was not in fact important.

Analogous application not invention.

As has already been pointed out in the preceding chapter, mere analogous application is not invention. A wheel well known before the introduction of railways cannot be patented for specific use on a railway (*Losh* v. *Hague*, 1837-9, 1 Web. P. C. 200; 8 L. J. Ex. 251).

Examples of patents held bad as mere analogous users.

A fish-plate, 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 (*Hazelhurst* 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). 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).

Example of patentable analogous user.

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); and *American Braided Wire Co.* v. *Thomson* (1889, 6 R. P. C. 518).

Examples of apparently 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 *Hudson, Scott* v. *Barringer* (1906, 23 R. P. C. 502), the plaintiffs claimed the manufacture of embossed or ornamented articles from tinplate having a grained surface obtained by omitting the cold rolling process. Such tinplate *per se* was admitted to be old. Very great commercial success was proved, but the Court held that there was no invention in taking a well-known article and applying to it ordinary processes, although the result was something commercially new. The patent was held bad. In *Williams* v. *Nye* (1890, 7 R. P. C. 62) the same

Examples of patents not saved by commercial success.

fate befel the patent for a combined mincing and filling sausage machine, although great utility and commercial success was shown. In *Riekmann* v. *Thierry* (1896, 14 R. P. C. 105), celluloid eyelets; *Wood* v. *Raphael* (1897, 14 R. P. C. 496), *pince-nez*; *Slazenger* v. *Feltham* (1888, 6 R. P. C. 130), tennis racquets; *Cooper* v. *Bædeker* (1899, 16 R. P. C. 363), felt bicycle handle covers; *Haskell* v. *Hutchison* (1907, 25 R. P. C. 194) golf balls, in which a wound elastic core which was old in other types of balls, was covered by a relatively harder shell of gutta-percha, also old. In all of these cases the patentees were unsuccessful through (*inter alia*) lack of invention, although utility and, in some of them, enormous commercial success was proved.

Whenever the Court finds a real or appreciable germ of invention, however small, it will uphold the patent.

Examples of patents upheld though showing small invention.

Thus the substitution of a round wick in a lamp, for a flat wick, was approved as patentable in *Hinks' 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.

Long felt want supplied strong argument for invention.

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

Uselessness of alleged anticipations.

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

CHAPTER VII.

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 up to fifty years next before the date of the application, 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.

Official searches to novelty.

Each claim is judged by itself.

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); *Kelvin* v. *Whyte, Thomson & Co.* (1907, 25 R. P. C. 177), 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.

Examples where rule was not relaxed.

Cropper v. *Smith.*

In *Cropper* v. *Smith* (1884, 1 R. P. C. 81) the plaintiff's third claim was for a bed-plate connecting the end standards of a lace-making machine. This was manifestly old, but Pearson, J., in the Court of First Instance, thought that such a claim came under the ruling in *Plimpton* v. *Spiller* (*supra*), and upheld the patent. The Court of Appeal,

however, was of a different opinion, and held that the third claim was a separate claim, and had no functional connection with the rest, and that being for an old thing the patent was invalid. Again, in *Cassel Gold Extracting Co.* v. *Cyanide Gold Syndicate* (1895, 12 R. P. C. 232), the first claim was for any strength of cyanide of potassium solution "substantially as described," while the second was for a solution of a given strength. Strong efforts were made to get the Court to read the first claim (which, as it stood alone, was bad) as if it were 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 aken 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 Extracting Co. v. *Cyanide Gold Syndicate.*

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

Kynoch v. *Webb.*

Where the invention is a process, the novelty is in the whole process, not in 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, where the new feature can be held to have been claimed, even a new combination which included the novel feature, would be an infringement.

Process claims.

Combination claims.

General rule as to novelty.

The broad rule with regard to novelty is, that if the invention has by any means whatever become known in this country to 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.

Unauthorised prior disclosure.

Section 41, Sub-section 2, of the new Act relieves the inventor from a possible wrong that might be inflicted on him by the premature public disclosure of his invention without his knowledge or consent. In that case the patent will not be held invalid if the inventor proves that such publication was in fact made without his knowledge and consent, and that if he became aware of the publication before the date of his patent, he applied for and obtained protection with all reasonable diligence.

CHAPTER VIII.

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. In most cases it is advisable that the inventor should not, even experimentally, *use his invention for profit* before protecting it. Thus, in *Germ Milling Co.* v. *Robinson* (1886, 3 R. P. C. 254, 399), 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).

Mere experimental use or confidential disclosure is not publication.

Must not be used even experimentally for profit.

But otherwise if goods not sold before date of application.

It is commonly maintained, on the authority of the latter two cases, that any continued secret operation of an invention *for profit* before the date of the patent amounts to such prior user as to cause invalidity. This would be true if the novelty lies in the goods produced and sold, unless perhaps in an isolated user experimentally, but incidentally beneficial to the inventor. Thus in *Newall* v. *Elliot* (1858, 27 L. J. C. P. 337; Good. P. C. 326), where, as a fact, experimental use in the presence of others, and necessarily for profit, had taken place, the patent was upheld. Said Byles, J.: "Is an experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the particular instance, necessarily a gift of the invention to the world? We think it is not." And again, "The coincidence of an experiment with actual immediate profit or advantage from it is unavoidable." In this case, be it remembered, the nature of the invention was apparent on the face of it.

Qy. If secret user for profit of necessity invalidates patent?

But take another example where the product is old and known, and the novelty lies entirely in the machine or process by which it is produced. Suppose, for instance, that the product is an ordinary machine-made cigarette, differing in no respect from the ordinary commercial article. Assume that the machine is novel and that the inventor instead of patenting his apparatus uses it secretly in his factory to manufacture cigarettes, and sells the cigarettes in the ordinary way of business, the workpeople who operate the machine being expressly warned against divulging the invention. Can it be said that the manufacture and sale of the cigarettes is a disclosure of the novel and unseen apparatus? Clearly not. And if the inventor should afterwards patent his machine, it is none the less a new invention to the public, although it has been secretly used by the inventor for profit for some time prior to the application.

Germ Milling case differentiated.

Those who uphold the contrary proposition on the authority of the *Germ Milling* case, are directed to the specification and report of the proceedings, from which it would appear that the claims of the specification covered not only the process but the products. It was admitted by the plaintiffs that these products had been sold before the date of the patent, which would, of course, account

for the adverse judgment. In *Betts* v. *Menzies* (1857-62, 10 H. L. Cas. 117; Good. P. C. 45), the patent was held good, although a quantity of the capsules forming the invention had been made in the plaintiff's own works by his own workmen, *but none sold or sent out*. 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. One of the reasons alleged 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). Another reason that has been advanced is that by secret user the inventor prolongs his monopoly, but there is nothing illegal in this, if he chooses to run the risk.

Secret use 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 fire-place 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 *Dewrance* 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

Discontinued prior user.

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

about eight years before the date of the patent, corroborated by two witnesses who had not a perfectly clear idea of what they had seen, was held to invalidate the patent, although in this case also the anticipating apparatus was no longer in existence. *Household* v. *Neilson* (1842-3, Good. P. C. 265; 9 Cl. & F. 788), *Guilbert-Martin* v. *Kerr & 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 *Orley* 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 4 of the present Act. It is true that Section 8 of the Act of 1852 said that during

Publication during provisional protection afterwards abandoned.

Orley v. *Holden*

Lister v. *Norton.*

provisional protection the invention might be "used and published without prejudice to *any* Letters Patent to be granted for the same"; whereas Section 4 of the present Act (which allows of publication under the current application) says "without prejudice to *the* Patent to be granted for the invention." 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 5, Sub-section 1, of the Act says that the applicant may 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. Sub-section 1 provides for the extension of time for leaving the Complete, to seven months instead of six. It would therefore appear that 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.

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. 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 IX.

ESSENTIALS IN SUBJECT-MATTER.

Novelty as Affected by Prior Publication.

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

What constitutes publication.

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 later case of *The Electric Construction Co.* v. *The Imperial Tramways Co.* (1900, 17 R. P. C. 537).

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

Mosaic of anticipations.

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

Skilled workman test.

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.

A specification less complete than the plaintiff's and never used might be an 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 crucial test of prior publication"; *i.e.* it may be insufficient as a specification but sufficient as an anticipation

Even an insufficient specification might anticipate.

(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 publications.

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 abridgments of subject-matter which, together with the specifications, may be consulted at the Patent Office Library and at the public libraries of most large towns, render such a task comparatively easy.

Limitation of anticipatory specifications.

By Section 41 of The Patents Act, 1907, 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 X.

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 alone not sufficient.

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."

Must be useful for the indicated purpose.

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.

Failure of utility avoids the patent.

In *Sirdar Rubber Co.* v. *Wallington* (1907, 24 R. P. C. 539) 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."

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

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

Utility a question of fact.

Commercial success not conclusive.

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

Amount of utility may be small yet sufficient.

The amount of utility in an invention may be very small, but yet enough to support the patent. This was held in *The American Braided Wire Co.* v. *Thomson* (*supra*), and in *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."

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

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

Non-utility in one claim invalidates the whole.

Care should be taken in preparing the specification to keep the claims confined only to those parts of the invention which carry utility, remembering that non-utility in the subject-matter of one claim will wreck the whole. In *United Horse Shoe Nail Co.* v. *Swedish Horse Nail Co.* (1888, 6 R. P. C. 1) the plaintiff's patent was declared void because the sixth claim referred to a mode of punching nail blanks which the evidence demonstrated could not be carried out in an economical and useful manner. In *Parkinson* v. *Simon* (1895, 12 R. P. C. 403) non-utility in

the sense of not being effective for the indicated purpose caused the subject-matter of two claims, and consequently the whole patent, to be held bad. 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.

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.

Old case on non-utility of one subordinate claim.

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."

Infringement as evidence of utility.

CHAPTER XI.

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 III). 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. *Greares* (1829, Good. P. C. 193); *Rex* 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 XII.

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 ear-mark 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 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

Object of provisional protection.

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.

It is apparent, in view of cases that already have occurred under the examination system now in force, 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 ear-marked. 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. Nevertheless, where the modification indicated in the Provisional but not included in the Complete is an obvious variation of what is claimed, the infringer will not be able to shelter himself behind this plea. For instance, in *Sandow* v. *Szalay* (1905, 23 R. P. C. 6) 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 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

Necessity for careful drafting of Provisional under Act of 1907.

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

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. From this view the House of Lords dissented and held that the plaintiff had not deliberately excluded air springs from his Complete and claims, and that the defendant had infringed.

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.

Supplementary applications.

If during the six months of provisional protection the inventor devises modifications of his invention he may put in one or more supplementary Provisionals, and if the Comptroller is of opinion that the original Provisional and the supplementary applications may properly be said to constitute one invention, he may accept one Complete in respect of the whole and grant a single patent. In determining validity, the Court or the Comptroller may have regard to the respective dates of these supplementary Provisionals (Section 16, page 486).

CHAPTER XIII.

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."

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. Before the present Act, if such a state of matters arose, disconformity was the result, and disconformity between the Provisional and Complete Specification was under any circumstances fatal to the validity of the patent. But, as will shortly be pointed out, under the present Act the plea of disconformity has shrunk into very narrow limits, if it has not, in fact, disappeared altogether.

Disconformity.

Former practice.

Before detailing the new Section and discussing its effects, it may be advisable to ascertain the practice under the former Statutes, since it has been said the plea of disconformity has not wholly disappeared.

Disconformity fatal to patent.

Said Lord Halsbury, in *Vickers* v. *Siddell* (1890, 7 R. P. C. 292; 15 App. Cas. 496): "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."

Old examples of disconformity.

As examples of cases in which disconformity was held to have been proved, the following may be of interest:—

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 was only where the substantial purpose of the inventor had been departed from or exceeded, and something like a new invention introduced, that disconformity held good. Improvements in details, so long as these were not of the nature of separate inventions but were directed towards and confined to the main object of the improvement, never were 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."

Disconformity no longer a serious objection.

These instances are given as examples of the working of the doctrine of disconformity up to the 1st of January, 1908. At the present day their interest is chiefly academic.

Section 42 of the new Act provides that "A patent shall not be held to be invalid on the ground that the Complete Specification claims a further or different invention to that contained in the Provisional, *if the invention therein claimed, so far as it is not contained in the Provisional, was novel at the date when the Complete Specification was put in, and the applicant was the first and true inventor thereof.*"

Probably it is right to say that this section causes disconformity, as generally understood, to disappear. In almost every one of the examples of disconformity given above, the disconforming element had been evolved during the period of provisional protection, and was, either *per se* or in combination, new at the date when the Complete Specification was put in; so that under present conditions the patents would have been held good. In future the issue of disconformity, if raised at all, will be confined to those cases where the element of disconformity had been publicly used or published or protected by some other inventor prior to the date of the Complete, in which case lack novelty, or "not true and first inventor," rather than disconformity would appear to be the proper objection.

Disconformity now merged in anticipation.

As the Comptroller is the arbiter as to what post-provisional improvements may and may not be included in the Complete, as coming within the limits of the Provisional, it would be as well in doubtful cases to resort to the system of supplementary applications provided for by the Act, so as to secure the actual date of the improvement. Otherwise, if the Comptroller rejects the additional matter in the Complete as being in excess of the Provisional, he may, at the desire of the applicant, but at his risk as to novelty, treat this excess as a new application made on the date at which the Complete Specification was left (Section 6, Sub-section 3).

Precautionary course in dealing with improvements.

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

Complete 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 branch of faith, which only requires to be laid bare to destroy the privilege. *Per* the Earl of Halsbury in *British Ore Concentration Syndicate* v. *Minerals Separation, Limited* (1909, 27 R. P. C. 33): "The Statute requires the specification to be a distinct statement of what is the invention. In construing a specification one has to remember that it is a document not only assuring a monopoly to the patentee, which but for the Statute would be contrary to the Common Law, but also prohibiting anyone, other than the patentee, doing what he would be free to do but for the right which is granted subject to the condition, among other things, that the patentee states distinctly what his invention is. If he designedly makes it ambiguous the patent would be bad on that ground; but even if negligently, or unskilfully, he fails to make distinct what his invention is, I am of opinion that the condition is not fulfilled, and the consequence would be that the patent would be bad."

Requirements of a Complete Specification.

Must not be ambiguous.

Under present practice the Comptroller insists upon the removal of ambiguities and obscurities from the specification. The inclusion of irrelevancies he may hold not to constitute a "fair" description of the invention (*Francis' Application*, 1909, 27 R. P. C. 86).

"Unfair" description.

So, too, if a general disclaimer, or words purporting to describe the existing state of the art, can be held to set forth as common knowledge something which is in fact the subject of a prior existing patent, the Comptroller might hold this not to be "fair" description, and require amendment accordingly (*Hamilton's Application*, 1901, 19 R. P. C. 33).

Accordingly, all specifications should be prepared in as transparently honest a manner as possible, and with every mark 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 patentee will not be excused for shortcomings on account

Complete must be prepared in good faith.

Reasonable skill and knowledge.

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 *Harmar* 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 weftfork, 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."

Test 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." At the same time let it be noted that it is only ordinary trade knowledge and skill that can be drawn upon to clear doubtful points in a specification. The present tendency in infringement actions is rather to overshoot these limits, especially in chemical and process patents, and submit the interpretation to very highly skilled experts. It is questionable whether this is not being carried too far, and Lord Shaw, in *British Ore Concentration Syndicate* v. *Minerals Separation, Limited* (1909, 27 R. P. C., at page 94), sounded a not unneeded warning against pushing the indulgence to extremes.

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*, 1907, 24 R. P. C. 539).

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 *Laurence* 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 3 of Section 2 of the present Act empowers the Comptroller to require drawings if he deems it desirable with either Provisional or Complete Specifications or at any later period. 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

Comptroller may require drawings.

Advantages of drawings.

of the thing itself, and, besides, a faithful and careful drawing is of use in explaining what might otherwise be an ambiguity in the description. Thus, if the descriptive part were to tell the reader something which is absurd—perhaps something so misleading that if it stood alone the very validity of the patent might be imperilled—if that misleading statement is coupled with a reference to the drawing, the error in the description can be cured, 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), and in *Tyne Lamp Syndicate* v. *Bryant Trading Syndicate* (1908, 25 R. P. C. 461), an obvious error in the drawing, which would not have deceived an expert, 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

Essential feature illustrated but not described held within claim.

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." The learned Lord Justice's opinion was approved in the House of Lords (23 R. P. C. 192).

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. The Comptroller has very wisely set his face against the practice of unnecessarily loading the specification with redundant matter. In *Francis' Application* (1909, 27 R. P. C. 86) the Comptroller says:—"Where an invention is confined to a detail or a small feature of a well-known machine, apparatus, or process, the applicant should no doubt describe the best way of carrying his invention into effect, and may give all necessary and reasonable directions to show its connexion with other parts of the machine, but in my opinion it is not his duty to describe or illustrate in detail special parts of or a special form of the machine with which his invention has no connexion, or to include matter which is wholly irrelevant to the claims."

Hints on the preparation of drawings.

Comptroller's warning against redundancy.

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 specifications 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 unmistakeably indicate the part referred to.

Provisional drawings may serve for Complete.

It should be mentioned 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.

Chemical samples.

In chemical inventions the Comptroller may require typical samples or specimens to be furnished in duplicate. Particulars of the form in which these samples are to be filed are given in Rule 36 of the Patent Rules, 1908, which follow this portion of the book.

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 wishes 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

Harrison v. *Anderston Foundry Co.*

known combination, it was the duty of the patentee, if he wished to claim this integer apart from the described combination, to lay his finger on the new part and tell the public that this was his improvement. Generally speaking, when describing an invention, differentiation of the new from the old need not be carried out, where common knowledge or the knowledge of the ordinary skilled workman is sufficient to identify the old parts.

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 held not to be obligatory.

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." *Per* Moulton, L. J., in *British United Shoe Co.* v. *Fussell* (1908, 25 R. P. C., page 656): "If what you have claimed, and the monopoly which you have obtained, is for a combination, that combination is the novelty, and you have no obligation beyond accurately defining it. In my opinion that is the law as it now stands."

Goddard v. *Lyon.*

Hookham v. *Johnson.*

New combinations of well-known parts.

In combination claim, no obligation to define old from new.

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

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. Apart from the mere descriptive portion of the specification, differentiation of old from new in combination claims will be fully discussed in the next chapter.

Inutility of alternative method avoids patent.

When two or three methods of carrying an invention into effect are described and claimed 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.

Construction of specifications.

In construing specifications of Letters Patent for inventions, the practice of the Courts seems to have gone through a pendulum-like swing before settling down to the present rule of reasonable and fair construction. In former times Letters Patent for inventions suffered from the vestiges of that odium which attached to the bad old monopolies. As a result, when a patent came into Court it was subject to the most keen and searching scrutiny. The leaning of the Court was always dead against the patentee and in favour of the public. This might be termed the period of *malevolent* construction of specifications. But early in the last century more liberal conceptions concerning the inventor and his mission began to prevail, and the practice of the Courts swung into what has been called the *benevolent* construction.

Former modes of 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.

In *Cropper* 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 that 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."

Chitty, J., on construction.

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 XIV.

CLAIMS.

Claims required by the Act of 1883.

NEXT to a clear and comprehensive setting forth of the invention in the body of the Complete Specification, the most important task of the patentee is the framing of the claims, by which he points out and fences off the real fruits of his brain. Prior to the Act of 1883 it was not obligatory 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 2, Sub-section 4).

Claims must be clear and succinct.

The requirement of the Statute is reinforced by the Rules of 1908 which under Rule 14 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 foot-note on Form 3 (which is the Form for the Complete) draws attention to this Rule 14, and requires that "any unnecessary multiplicity of claims or prolixity of language should be avoided."

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

Powers of Comptroller to require claims in Complete.

The Comptroller has power to require that something in the shape of a claim shall be appended to the Complete, and apparently, as the Rules of 1908 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 under the new Act will have 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, unless he considers that the unamended claims bring the applicant's invention wholly

and specifically within the limits of some prior specification in terms of Section 7, Sub-section 4. The utmost he can do is to insert such disclaimers, and, if need be, references to prior patents as in his judgment would neutralise the unacceptable form of claim.

References.

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.

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

Claim must refer to invention as described.

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 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."

Object of claim is to define invention.

Harrison v. *Anderston Foundry Co.*

Danger of "fishing" claims.

Dick v. *Ellam.*

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

Claims must not be too wide.

Stevens v. *Keating.*

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 particular 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 too wide. The same objection proved fatal in *Scott's Patent* (1902, 20 R. P. C. 257).

Minter v. *Mower.*

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's claim, instead of being confined to his own invention, was wide enough to cover the anticipatory chair 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

Court will not extend claims beyond their reasonable construction.

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."

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

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

Or failure in alternative arrangement.

Simpson v. *Holliday*.

Pether v. *Shaw*.

Kurtz v. *Spence*.

Claim may be limited by 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.

True meaning of claim sometimes matter for evidence.

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.

Gandy v. *Reddaway*.

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 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

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

Lord Alverstone on colourable alterations.

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."

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 V., 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 described, 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); *Jupe* v. *Pratt* (1837, Good. P. C. 274); and *Hickton's Patent Syndicate* v. *Patents and Machinery Improvements Company* (1909, 26 R. P. C. 313).

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

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 too wide. Said the learned Judge: "If the claim is in general terms for every mode of carrying the principle into effect, it becomes

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

a claim to the principle itself, and therefore fails." This was already noted by Lord Abinger in *Neilson* v. *Harford* (*supra*). For the latest pronouncements on the subject, the reader is referred to the judgment of the Court of Appeal in *Hickton's* case (*supra*).

Court will not extend claim.

It seems reasonable to submit that a claim which the patentee has not ventured to make for himself will not be made for him by the Court, and that a specific 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. For instance, in *Harrison's Patents Co.* v. *Nicholson* (1908, 25 R. P. C. 393) it was held that where a specification described a particular machine, varied as therein stated, and the patentee contended that rotating round a common centre so as to get parallelism was the governing idea of the patent, that if he desired to claim all arrangements which would produce that result, he ought in his specification to have stated and claimed in explicit terms that principle.

A claim is not a disclaimer.

Parkinson v. *Simon.*

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."

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 VII., to which the reader is referred.

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

The risk and uncertainty attending the interpretation of a claim of this dubious nature are 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 is obviously 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).

Kynoch v. Webb.

Electric Construction Co. v. Imperial Tramways Co.

Tubes, Limited v. Perfecta Co.

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. The same conclusion was arrived at in the cases of *True Lamp Syndicate* v. *Bryant* (1908, 25 R. P. C. 461) and *Lynch et al.* v. *Phillips & Co.* (1908, 25 R. P. C. 694).

Examples where apparently bad subsidiary claim was upheld.

Parker v. Satchwell.

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

Principles deducible from the cases.

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.

A claim is bad which claims a combination of two or more things in a mechanical combination, or it might be steps in a process, between which no functional or interacting combination exists. For example, in *Osmonds*,

Limited v. *Balmoral Cycle Co.* (1898, 15 R. P. C. 505), the patentee had claimed a chain-adjusting gear in combination with a footstep which was entirely distinct from and had no co-relation to the gear, Chitty, L. J., remarked that the patentee might as well have said "I claim that gear with a hat on a man's head."

Construction of combination claims.

The construction of combination claims so frequently occupies the attention of the Courts that the question requires more than a passing notice, especially as some misunderstanding still exists among authorities. For instance, it is often erroneously said that if a combination contains one or more subordinate integers which are new and useful for the purpose, and the patentee has claimed simply the combination, without any earmarking or setting aside of the new subordinate integers, the Court will help him against an infringer who has taken the new integers and combined them with an arrangement for the same purpose, which arrangement may be substantially different from and not a mere equivalent for the combination of the patentee. But Moulton, L. J., in *British United Shoe Co.* v. *Fussell* (1908, 25 R. P. C. 631) expressly stated that the dictum of Lord Campbell in *Lister* v. *Leather* (1875-8. 8 E. & B., at p. 1023), that a patent for a combination containing *inter alia* old parts gives protection to each part thereof that is new and material for the purpose, without any express claim for the said parts, was erroneous and is now over-ruled. A more modern case which is sometimes cited in support of this erroneous contention is *Proctor* v. *Bennis* (1887, 4 R. P. C. 333). It is true that in Proctor's specification and claim he had nowhere referred to or particularised the pivotted flaps as being the real essence of his invention. As Cotton, L. J., pointed out, "he had cut himself down to the combination—the combination of three, lumped together with another—namely, his flaps or doors." The defendant had varied the particular combination described by the patentee, but the actions and results were the same. The Court held that the variations did not in fact take the defendant outside of the plaintiff's *combination*, and the decision was founded upon the ruling that the *combinations* were substantially the same, not merely that the defendant had taken the substance of the plaintiff's invention. It is quite evident that had the

defendant taken this substance, or "pith and marrow" as it has been called, and incorporated it with a combination *undeniably* different, the plaintiff would probably not have succeeded. Now all of this trouble would have been saved and the action probably averted, had the plaintiff put in a separate and specific claim for the pivotted flaps as a new element for the purpose, irrespective altogether of the particular combination he had described. Not having done so the Court had to exercise its ingenuity to save him from the consequences of his omission.

New subordinate integer should be specifically claimed.

Combinations fall into two classes:—

First.—Where the combination is simply a more or less novel arrangement or re-arrangement of old parts or groups of parts, evincing invention in the combination and producing either an improved result or an old result in an improved or more expeditious or economical manner; such a combination as formed the subject-matter of the patents in *Curtis* v. *Platt* (1863-4, 35 L. J. Ch. 852) and *Nettlefolds* v. *Reynolds* (1892, 9 R. P. C. 270). In such a combination the patentee is tied down substantially to the arrangement he has shown and described.

Narrow type of combination.

Second.—Where the improved combination contains, in addition to old parts or groups, some element or group which is new and useful for the purpose of the invention independently of the combination actually described, as, for instance, in *Proctor* v. *Bennis* (*supra*).

Broader type of combination.

In the first place there is one general rule applying to both of these circumstances, viz., that the inventor should in each case claim the combination. Under the first head, viz., a combination of old parts, this is usually enough, because the combination and the combination alone is *ex necessitate* the invention, and there is no need to point out what is new and what is old. *Per* Moulton, L. J., in *British United Co.* v. *Russell* (1908, 25 R. P. C. 631): "If what you have claimed and the monopoly which you have obtained is for a combination, that combination is the novelty, and you have no obligation beyond accurately defining it. In my opinion that is the law as it now stands."

Rule in claiming narrow combination.

Rule in claiming broader combination.

But under the second head, viz., where the combination includes new subordinate integers, the inventor should do more if he desires to secure independent protection for these new integers. He should, in addition to his claim for the combination, claim separately and independently the novel subordinate or subsidiary integers. If he does so, then an infringer who plucks the new element or group from the described combination, and re-clothes it in another substantially different combination of parts, will not do so with impunity.

Unluckily this counsel of perfection has not been followed in many existing specifications of valuable patents where the combination includes a novel element or essence or "pith and marrow." In many such combination patents, the inventor has simply claimed the entire combination without laying his finger on this "pith and marrow," and saying, "Mind you, this element is new for the purpose, and although I claim it as part of the described combination, I warn all the world that it can be used in other combinations for the same purpose, and I will consider anyone who so uses it an infringer." By not doing so the inventor leaves the world in doubt as to what is new and what is old in his combination, and although there is no obligation upon him to so differentiate (if he is content to secure the combination only) he pays the penalty if someone takes the really novel part of his combination and dresses it up in another combination which is undeniably different from his own.

Judicial comments on the plea of non-differentiation of old from new.

It is this condition of dubiety which has given birth to the plea, so often used by a defendant, that the patentee has not distinguished the old from the new. Moulton, L. J., in *British United Co.* v. *Russell* (*supra*) argued that this is an obsolete plea, and in reviewing the judgment of Lord Cairns, in *Clarke* v. *Adie* (1875, L. R., 2 App. Cas. 315), he sought to crystallise what Lord Cairns had said by the remark: "In other words, you may have a monopoly for these subordinate integers, *but they must be claimed.*" If by this the learned Lord Justice meant that these novel subordinate integers must be specifically ear-marked by separate and independent claims, then he went further than Lord Cairns, for nowhere does the latter say that "they must be claimed." What Lord Cairns did say in discussing whether new subordinate integers included in

Fletcher Moulton, L. J., in *British United* v. *Russell.*

a general combination were or were not entitled to independent protection, was simply that—"The invention must be described in that way, it must be made clear to ordinary apprehension, upon the ordinary rules of construction, that the patentee *has had it in his mind and has intended to claim* protection for those subordinate integers."

Lord Cairns in *Clarke* v. *Adie*.

So also in *Harrison* v. *Anderston Foundry Co.* (1876, 1 App. Cas. 574) Lord Cairns said (see page 578): "If it is clear that the claim is for a combination and nothing but a combination, there is no infringement unless the whole combination is used, and it is in that way immaterial whether any or which of the parts are new. If, indeed, it were left open on the specification to the patentee to claim, not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate or subsidiary parts are new and material, as it was held a patentee might do in *Lister* v. *Leather* (1857-8, 8 E. & B. 1604), then it might be necessary to see that the patentee had carefully distinguished these subordinate or subsidiary parts, and had not left it *in dubio* what claim to parts, in addition to the claim for combination, he meant to assert."

Lord Cairns in *Harrison* v. *Anderston Foundry*.

In other words in the absence of a specific claim for the disputed matter, the Court must resort to the body of the specification, and if the new subordinate integer is there found ear-marked or particularised in any such way as Lord Cairns contemplated, so as to make it obvious that the patentee "had it in his mind" that he regarded this integer as new and material, the Court will put such a gloze upon the general combination claim as will enable it to say—"Here is the 'pith and marrow' or substance of the combination, and we shall not allow the defendant to re-clothe it in an equivalent or different combination and then contend that he does not infringe." This is something considerably less than saying that the subordinate integer "must be claimed," and Vaughan-Williams, L. J., was apparently right in doubting whether it was true to say that, in a case where new subordinate integers are wrapped up in a combination ascertained in a specification which claims the whole combination as new, "there is no obligation to distinguish what is new from what is old." At least, although it may be as Moulton, L. J., says, "that

Vaughan-Williams in *British United* v. *Funnell*.

this objection has become merged in others," the plea saddles the plaintiff with the onus of showing that it is so distinguished in his specification. Probably what Moulton, L. J., meant was that a fair construction of the body of the specification must enable the Court to credit the general combination claim with the intention to ear-mark the new subordinate integer, which would thus be in that sense "claimed." This is borne out by the other parts of his judgment, and notably where he said—"I should say that a man must distinguish what is new from what is old *by* his claim, but he has not got to distinguish what is new from what is old *in* his claim."

Differentiation of new from old *by* claim but not *in* claim.

Of course, it is always open to the Court to hold (where the defendant has taken the substance of the combination claim) that the defendant's combination, though alleged to be different, is substantially the same (*Proctor* v. *Bennis*, *supra*; *British United Co.* v. *Thompson*, 1904, 22 R. P. C. 177; *Linch* v. *Phillips*, 1909, 26 R. P. C. 389). But as in combinations of old parts it has been held that there is no room for the doctrine of mechanical equivalents (*Curtis* v. *Platt*, *supra*; *Nettlefolds* v. *Reynolds*, *supra*; *Birch* v. *Harrop*, 1896, 13 R. P. C. 615), it would be dangerous to depend upon the same rule not being held applicable to combinations containing one or more unclaimed new subordinate integers. Whether the Court would construe the claim favourably to the patentee would probably depend upon the importance of the integers as established by evidence.

Dictum of Moulton, L. J., on duties of patentee.

The duties of a patentee in preparing his specification and claims are thus outlined by Moulton, L. J., in *British United Co.* v. *Russell* (*supra*): "He must first make a useful invention; he must next, with the fullest *bonâ fides*, describe to the public the best way of carrying out that invention: and, thirdly, he must leave the public in no doubt whatever as to what constitutes the invention which he claims as his monopoly. The performance of these things completes his duty to the public."

Rules for the preparation of claims.

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

(1) The claims should not embrace more than the actual invention, and 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 vague and speculative phrases.

(3) If the invention discloses a new principle, the claim should be for the principle, coupled with means for carrying it into effect, even when such means are obvious and involve no invention.

(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, in addition to the combination claim, these parts also should be separately claimed for the indicated purposes.

CHAPTER XV.

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 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.

It now becomes necessary to discuss the questions of who may oppose a grant; and upon what grounds opposition can be based.

Persons entitled to oppose.

The words of the Act (Section 11) are that "any person" may oppose, but it has now been finally settled by the

Court of Appeal in *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:— *Reg. v. Comptroller, ex parte Tomlinson.*

(*a*) That the applicant obtained the invention from the opponent, or from a person of whom he is the legal representative. Grounds of opposition.

(*b*) That the invention has been claimed in any Complete Specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent.

(*c*) That the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the Complete Specification.

(*d*) That the Complete Specifiention 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.

The expression "legal representative" in Clause (*a*) (where the opponent alleges that the invention was obtained from him) means executor or administrator, and excludes an assignee even where the assignment purports to convey the "invention," the subject-matter of the application or patent (*Spiel's Patent*, 1888, 5 R. P. C. 281; *Edmund's Application*, Griff. P. C. 281; *Gascoine's Patent*, 1909, 27 R. P. C. 78).

Clause (*b*) gives a wider ground than the corresponding Clause in the Act of 1883, and includes specifications coming under the extended search by virtue of Section 8 of the Act.

Clause (*c*) is new.

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

An opponent once entitled to oppose under the second ground, Clause (*b*), may include in his grounds of opposition not only the prior specification or specifications in which he may be personally interested, but also any other patents or specifications 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, Form 8, which bears a ten shilling stamp, must set forth the grounds upon which the opponent intends to rely. The Patent Rules of 1908 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 the ground of opposition or one of them is that the applicant's invention has been claimed in any Complete Specification, the number and date of the specification should be given.

Security for costs.

If the opponent is out of the jurisdiction, the Comptroller may order him to give security for costs, and if he does not do so, the opposition may be treated as abandoned (Section 39, Sub-section 2).

Supplementary statement with notice of opposition.

Where the person giving notice of an opposition recognises that he cannot insist upon the refusal of the grant, but wishes merely that the specification should be amended by disclaimer or limitation, or otherwise, the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect, indicating as far as can conveniently be done, the general nature of the amendments desired, and the portions of the earlier specifications, if any, relied upon as necessitating such amendments (Rule 40).

Insufficient description.

Similarly, when the ground of opposition is that the nature of the invention is not sufficiently or fairly described, the opponent should point out in what respects the description is insufficient or unfair. 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. Even after the expiry of the two months, the notice of opposition may be amended so as to include other specifications as grounds of opposition (see "Notes of Rulings by Comptroller," 1910 (C), 27 R. P. C., Appendix II.), and the Comptroller has power, under Rule 108 of the Patents Rules, 1908, to amend generally either before or, where there are strong reasons for allowing it, 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 Fawcett*, 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). However, in the "Note" above referred to, the Comptroller takes care to say, "I desire in no way to weaken the Rule which calls for the opponent's case at the earliest possible moment. I am strongly of opinion that this should continue to be the practice insisted on, and if the opponent desires any amendment which will prejudice or inconvenience the applicant, he will have to pay the penalty by costs and an adjournment at his expense in proper cases."

Practice in amending defects in notice 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 opponent in support of opposition.

Within fourteen days from the date of receiving the opponent's declarations, 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 applicant in support of application.

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 41 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 the Comptroller or 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 specification, 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 41, the opposition is deemed to have been abandoned. Under Rule 109 an enlargement of time for filing evidence other than that referred to in Rule 41 may be obtained.

Declarations essential in opposition under Clause (a).

Parties may cite prior specifications or public knowledge to limit claims.

Where the grant of a patent has been opposed on the ground that the invention has already been claimed in a British specification, either party may, under Rule 47, produce any evidence of public knowledge or prior patents or specifications which will tend to limit the ambit of the opponent's or applicant's specification. But he does so at the risk of having those publications directed against himself, for the Comptroller will not disregard any matter that is in evidence before him, simply because it injures the party who brought it to his notice.

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 at least five days 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. 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.

Exhibits.

Illustrative samples.

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

Opposition may be founded on expired patent.

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. This procedure is not without inconvenience in many cases, as the opponent is practically the plaintiff, and the applicant may have to open a good deal in the dark as to what parts of his specification he may be called upon to defend. Under such circumstances it is clearly advisable that the opponent should open and point out his objections in the first instance. The applicant may then concentrate his attention upon the real issues, and much time might thus be saved. Where the *onus probandi* lies on the opponent—as, for example, where the applicant is charged with fraud, or with obtaining

Hearing before Comptroller.

the invention from the opponent—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 by the opponent upon the applicant (*re Bailey*, Griff. P. C. 269; Good. O. C. 25; but see also the Comptroller's Note, 1910 (c)). If the Comptroller is made aware at the hearing, by the Examiner, of an anticipatory specification not cited by the opponent, he has discretion to use it against the applicant (*Hughes & Kennaugh's Application*, 1910, 27 R. P. C. 281).

Opponent confined to grounds of opposition in notice

According to Rule 47 of 1908, 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.

Notice of additional publications.

Under Section 77 of the Act, the Comptroller may take evidence *viva voce* in lieu of or in addition to the declarations or allow any declarant to be cross-examined on his declaration. In requiring such attendances and taking such evidence on oath the Comptroller is in the same position as an Official Referee of the Supreme Court.

Evidence *viva voce*.

The Comptroller, who is generally assisted by one or two of the Chief Examiners, seldom gives his considered 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 47.)

Decision.

Under Section 39 of the Act, the Comptroller has now power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a Rule

Comptroller's power to order costs.

Costs' order may be made a Rule of Court.

of the Court. Should these costs not be paid, execution cannot be issued under the Comptroller's order, until it has been made a Rule of the Court. The usual procedure is for the party in whose favour the order is made to issue a specially endorsed writ and obtain judgment under Order XIV; or he might apply to the specially appointed Judge (Parker, J.) and have the order drawn up by the Chancery Registrar.

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 Act, he shall, within fourteen days from the date of the decision appealed against, file in the Patent Office a notice of such his intention.

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 Chief Clerk, Law Officer's Department, at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

4. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the Chief Clerk, Law Officer's Department, 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 give 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 Chief Clerk, Law Officer's Department, 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 applicant as the case may be.

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 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 40 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 Law Officer's Department.

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

Appeal a rehearing. Cross appeal.

The proceedings before the Law Officer amount to a rehearing of the case. When the Comptroller has decided 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 the other.

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. Under the old Rules further evidence was admitted at the hearing of the appeal as to matters which had occurred or come to the knowledge of either party since the date of the decision appealed against. But the new Rules are silent upon any such indulgence as a matter of right, and the admission of any fresh evidence is now left to the discretion of the Law Officer (Rule 8). In *re Bailey's Patent* (Griff. P. C. 269; Good. O. C. 25) Davey, S.-G., decided that the 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.

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 fourth 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 and third grounds of opposition are considered—viz., that the invention has already been claimed in a British specification, or that the invention is insufficiently or unfairly described. Seeing that the expression "any person" is unqualified in the first sub-section, it might have 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 in terms to opponents before the Comptroller.

Assignee of or manufacturer under lapsed patent.

The same terms were used in the corresponding section of the Act of 1883 and the matter was soon raised when that 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).

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. Persons about to manufacture under prior patent.

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

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. Foreign grantee of antedated patent under Convention.

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, and Section 11, Sub-section 1, Clause (*b*), now specifically provides for this. Applicant under provisional protection. Concurrent applications.

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

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. Ruling in *Reg.* v. *Comptroller, ex parte Tomlinson*. Law Officer the final authority.

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 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.

what points the Law Officer has pronounced, and by these the Comptroller is now 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 beneficial 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.

It has already been pointed out that a person having a right to oppose under Clause (*b*), viz., on the ground that the invention sought to be patented has already been claimed in the Complete Specification of some prior British patent or application, may include in his opposition other specifications in which he has no personal interest. It is obvious that he may also include Clause (*c*) as a ground of opposition, viz., that the nature of the invention is not sufficiently or fairly described. But a person claiming a *locus standi* under Clause (*a*), viz., that the applicant had obtained the invention from him, could not include Clause (*b*) unless he had, in fact, some personal or beneficial interest in one at least of the specifications he relied on as anticipating the applicant (*J. & J.'s Application*, 1902, 19 R. P. C. 555).

Opponent must show that invention has been claimed.

Opposition cannot be founded upon mere description in a prior specification. The invention must be *claimed* (*re von Buch*, Griff. A. P. C. 40; Good. O. C. 17).

The Law Officer usually allows a sum for costs to the successful party. The average allowance is from five to ten guineas, but considerably larger sums have been awarded where costs have been heavy. An appellant who withdraws, without reason given, before the hearing, is liable to pay costs (*re Knight*, Griff. A. P. C. 35; Good. O. C. 26).

Costs on withdrawal.

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; *re McNeil*, 1907, 24 R. P. C. 680). The phrase "obtained from the opponent" means knowingly, but not necessarily fraudulently, obtaining from him, either directly or through his agent. Where the invention has been handed on through intermediate parties, so that the applicant has received it in entire innocence of the fact that it owed its origin to the opponent, it cannot be said that the applicant has obtained the invention from the opponent (Comptroller's Note, 1910 (A), 27 R. P. C., Appendix I.). There must be some connection known and recognised by the law between the applicant and opponent, and not merely a casual connection in which no proof of knowledge or notice is shown against the applicant, and no agency or fiduciary relationship exists between him and the opponent.

Only transactions in this country considered.

Invention must have been knowingly obtained from opponent.

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 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

Test of evidence in fraud.

Patent might be issued jointly to applicant and opponent.

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).

Declarant may be cross-examined before Comptroller and Law Officer.

The old Rule, which gave the Comptroller power to request or allow a declarant to attend at a hearing, was abandoned at the passing of the present Act. Section 77 now empowers the Comptroller, in any case in which he thinks proper, to take evidence *viâ voce* in lieu of or in addition to evidence by declaration, or to allow any declarant to be cross-examined on his declaration. In the matter of requiring the attendance of witnesses, and taking evidence on oath, the Comptroller is in the same position in all respects as an Official Referee of the Supreme Court. This evidence can, of course, be used in the appeal to the Law Officer or the Law Officer may, on the request of either party, order the attendance at the appeal of any declarant or witness, for further examination or cross-examination.

Master and servant.

Re Heald.

The relationship of master and servant does not give the master any rights in the servant's invention, even if the servant works out the invention in his master's time and with his master's tools. Thus, in *re Heald* (1891, 8 R. P. C. 429; Good. 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

David and Woodley.

plainly stated by Davey, S.-G., in *re David and Woodley* (Griff. A. P. C. 26). Said the Solicitor-General: "I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, these suggestions are the property of his 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 (*b*), viz., that the invention has been claimed in a Complete Specification for a British patent which is or will be of prior date to the patent, the grant of which is opposed, 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 person giving notice of an opposition does not claim that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect indicating, as far as can conveniently be done, the general nature of the amendments desired, and the portions of the earlier specifications (if any) relied upon as necessitating such amendments (Rule 40).

Limiting statement by opponent.

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 *Cumming* (Griff. P. C. 277), although, as James, L.J., 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 by the Law Officer there is no appeal, and that if the applicant's

Resemblance to prior patent must be very close.

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.

Validity of opponent's patent never considered.

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

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

Slight alteration may serve in lieu of disclaimer.

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).

General disclaimers.

The insertion of a general disclaiming clause, and even of a special reference, 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 is 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.

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

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 opponent's is master patent.

So also if the opponent's patent is a pioneer or master patent, or describes and claims something the like of which has not been done before, a specific reference is inserted. Webster, A.-G., in *re Hill* (1888, 5 R. P. C. 599), said: "It is not prudent or desirable to insert special references to particular prior patents unless there is,

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

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. If the applicant, confronted with what is alleged to be a master patent, wishes to limit the apparently general nature of the opponent's claim, by reference to publications other than British specifications, he may do so. But to render these available he must give at least five days' notice to the Comptroller and to the other party, and specify, with details, each publication to which he intends to refer. Prior to the present Act it was the practice to admit such publications, and now Rule 47 of the Patents Rules, 1908, specially provides for their introduction.

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

Opponent alleging master patent must support by evidence.

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 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.

But even when all this is done the limits of the opponent's patent may be deducible from the claim, for 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 have been drawn in wider terms. Indeed, the addition to a claim of the usual phrase "as described" may prevent the patentee from alleging it to 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."

But limits of master patent deducible from claims.

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

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

It was the practice under the former Acts to refuse special references in the case of concurrent applications (*re Greenhalgh*, 1897, 14 R. P. C. 387); but Sections 7 and 8 of the present Act clearly provide for such references (Comptroller's notes, 1910 (G), 27 R. P. C., Appendix VIII). But a reference under Section 8 is conditional on the grant of a patent on the earlier application.

Reference to concurrent application.

Even if the applicant's invention would be an infringement of the opponent's patent, that is not *per se* a reason for a special reference (*re Marsden*, 1896, 13 R. P. C. 87). Although the patent quoted by the opponent may have expired, 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. Special references are intended to protect the public, and when the public are not likely to be misled by anything appearing in the claims as they stand in conjunction with the specification, a reference will not be ordered (*Per* Evans, S.-G., in *Brockie's Application*, 1908, 25 R. P. C. 813).

Nor even when applicant's invention would infringe.

Reference to expired patent.

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 specification or claims (*Hamilton's Application*, 1901, 19 R. P. C. 33).

Comptroller's Note on special references.

Before leaving the subject of specific references, the reader is invited to peruse the following carefully reasoned decision on the subject by the present Comptroller (W. Temple Franks). The note appears as a ruling in a revocation case (*re Hopkin's Patent*, 1909, 27 R. P. C. 72). The learned Comptroller, in discussing and defining the principles upon which specific references are inserted, proceeds as follows:—

"With regard to the whole question of specific references—including in the term all references by name and number, whether inserted in the more formal way before the claims or in the less formal description of the invention at the beginning of the specification—I have carefully considered the various decisions and reported cases upon the subject. As a result of such consideration, I do not find it easy to formulate any very clear or definite principle from the various decisions referred to, and in my opinion much of the reasoning and many of the principles enunciated have become less relevant or less applicable at the present time for the following reasons. Before the powers of search and the extensive powers of amendment in regard to the description and claim were conferred on the Comptroller, it was not the practice to call on a patentee to alter his description or his claims to any considerable extent. The specification was left as far as possible in its original form, and, as a consequence, a specific reference often became a necessity both in the interests of the public and of a prior patentee. There was no other way of attaining the desired object of distinguishing, as far as possible, between new and old. But where a specification is properly and scientifically drawn, there would appear to be, as a general rule, little or no need for specific references or disclaimers. The ideal specification would claim and claim only in clear and succinct language the patentee's invention, and distinguish it in the description from what had gone before, or show its relation to previous inventions. Matter which was irrelevant would be excluded, and only such matter inserted as would be reasonably necessary for showing the best form of, or the best method of carrying

Former reasons for specific references.

out, the invention sought to be protected. In a specification so framed there could be no ambiguity, and no need, as a rule, for further protection of the public or prior patentees. Under existing circumstances it ought, I think, to be the aim of the office to secure, as far as possible, that specifications shall be so framed, and thus obviate the necessity for inserting references and disclaimers, which, in many instances, are only inserted as a rough and unscientific method of defining the real scope of the invention and its relation to former invention and discovery.

Principles governing references and disclaimers.

"After careful consideration of the whole subject, I think it will be for the general convenience if I attempt to formulate the principles which, in my view, ought to regulate the practice of this office in the future in directing specific references or disclaimers by name and number, and which, as at present advised, I desire to apply in all cases which come before me. Such principles can of course be only very generally suggested, and must be open to exception in special cases, but I think some definite practice is better than none, and may tend to prevent disputes and disagreements in the future. It is generally conceded that the real object of such references is not to advertise a prior patentee but to guide the public, to define the true scope of an invention, and to bring into clear light the relationship and importance of one patent to another. What is requisite is to ascertain the true values of the inventions involved: and I think the real underlying principle which should govern the insertion of specific references is this—'Is the governing idea or basic principle of an invention, sought to be protected, claimed or protected in a specific earlier patent?' In other words, the condition necessary is that the new invention should be based on a definite invention already protected, and the earlier invention should be clearly and unequivocally repeated or involved in the new specification.

True object of specific references.

Test of when a specific reference is necessary.

"Applying this general principle to more specific instances, it would seem that there are two classes of cases to be considered—(1) where what is called a 'master patent' is involved: (2) where there is no claim to a 'master patent' as such.

"Assuming that the specification is clear and unambiguous and otherwise free from objection, I think the

principle which calls for a specific reference in either of these cases is substantially the same, although the method of applying it may differ in the two cases.

Master patent.

"(1) To take first the case of a 'master patent.' I think that in all discussions in regard to specific references this term should be strictly construed and confined to cases where there has been the discovery of a new and important pioneer principle—so to speak—which has been embodied in practical form or shape and claimed in general terms. There should be some wide and governing principle not hitherto claimed or described, to bring the invention within the meaning of the term 'master patent.' Used in this sense a specific reference is rightly inserted if the new invention is *merely* an improvement or amendment on the 'master patent' and for this reason. The 'master patent,' *ex concessis*, stands alone, it has broad claims which, in view of the importance of the principle involved, are allowed a wide construction. It may be said to comprehend and foreshadow any construction embodying the principle or providing any similar means for carrying it into effect. Thus any later patent, which amends or improves, may be rightly looked upon as merely defining or shaping an invention already specifically or generally claimed in the 'master patent.' The governing principle of the later patent is found in the former and the reference is rightly inserted in accordance with the principle stated above because the earlier invention is, in effect, taken and appropriated as the basis of the later.

"It is not indeed every case where a 'master patent' is concerned that will call for such references, but only when a wide and generous construction of the 'master patent' claimed appears to involve or foreshadow the later invention. The mere connection of an invention with a 'master patent' will not necessarily be sufficient. The later invention must be formed directly or by implication on the former patent.

Reference may be superfluous where master patent is of common knowledge.

"Further, there may possibly be cases where time and notoriety have made the 'master patent' so well known that a specific reference may become superfluous and unnecessary.

"Where a 'master patent' in this sense is claimed, the proper notice should be given under the Rule so that an

adequate search may be made both by the office and the applicant. The office search at the examination stage must not be relied on as conclusive on this point.

Conditions of reference more severe in case of *quasi* "master patent."

"In the cases where there is no proper 'master patent' involved, I think the same general principle in regard to specific references applies; but the conditions are stricter and more severe. I think in such cases a specific reference should only be allowed where the following conditions are present:—(*a*) The patent to which reference is asked should be clear and distinct in its own field and, as far as can be gathered, free from anticipation. (*b*) The invention claimed therein must be clearly and unequivocally claimed or included in the later specification. (*c*) It must be claimed or included substantially as a whole and not merely in part. (*d*) The improvement or addition claimed by the applicant must be small and insignificant and the governing principle, so to speak, must come from the prior patent.

"The danger to be guarded against in these cases is the undue preference which may be given by the naming of one patent which is not alone in the field, and I think the practice should, therefore, be confined generally within the limits indicated above. In such cases a specific reference is necessary, because the prior invention is distinct, and is re-claimed *in toto* in the later patent; it is the principal or governing factor, and there is little or no advance in inventive power. In many such cases such a reference would be an alternative to the refusal of the patent or of a specific claim. In these cases I think that, generally speaking, the office search will be sufficient to raise a *primâ facie* case under (*a*) as to absence of anticipation, &c.

Gereral disclaimers.

"In my opinion specific references ought in general to be confined to the two classes of case indicated above; and that in all other cases general disclaimers only should be inserted in the later patent, embodying, if need be, the substance of any prior patent which appears involved, but without name or number. In this connection I think it is clearly important in the interests of the public that what is the subject of a recent and existing patent should not be stated as if it was a matter of common knowledge, and I think protection should be given to prior patentees when

this is the case, by suitable amendment or disclaimer. I do not indeed think that it is any part of the Comptroller's duty to consider the question of infringement; or that the public can ask this Office to protect it by special reference or otherwise where infringement is likely or possible. This has been clearly laid down in many reported cases. I think, however, the public have a right to be warned, as far as possible, of what is special and what is matter of common knowledge. In certain cases also it may amount to a disparagement of the invention of a prior patentee to state it in terms of common knowledge, and the practice is thus rightly open to objection.

Ambiguous specifications.

"(3) So far I have dealt with specifications which are clear and unambiguous or can be made so by proper amendment; there remains the class of case where the specification is ambiguous, and it is difficult or impossible to introduce amendments or disclaimers, or to rewrite it so as to disclose the true scope of the invention and distinguish it from what has gone before. In these cases it may still be necessary to protect the public, and do justice to prior patentees by the rough and ready means of inserting specific references in certain special cases. It should, however, I think, be borne in mind that this is not the best or most scientific method, and that it is merely employed to save time and trouble in cases where other amendment seems impracticable.

"It should further be added that in the early examination stages, specific references must, of course, still be inserted where necessary to penalise a patentee who cannot or will not meet the objections of the Office. Finally, in all that has been said above on the question of specific references, it has been assumed that there is some patentable invention involved in the proposed patent, and that it has escaped rejection on the ground of complete anticipation."

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; *Hodgkin's Application*, 1906, 23 R. P. C. 527). 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 ruling in *Todd's Case*. *Bridge's Case* can only apply where there is obviously no invention and no new result in the stringing together of old things. Where there is any doubt, or any appreciable reason for urging that there is a better result or any *scintilla* of invention, a patent will not be refused (*Krupp's Application*, 1908, 25 R. P. C. 809). Subject-matter.

The mere selection of the best conditions for carrying out a known process already covered by a claim susceptible of being construed as covering broadly the selected conditions was held not to constitute invention in the *Deutsche Gasglühlicht's Application* (1908, 26 R. P. C. 101). In this case the opponents' claim was for treating tungsten filaments by an electric current, not distinguishing between an alternating and a direct current. The applicant found out that a direct current was much the more advantageous, but a patent was refused on the ground that the opponents' claim inferentially covered both. Almost the same question arose in *Bosch's Application* (1909, 26 R. P. C. 710) and this patent also was refused. Mere selection of known conditions.

Quantum of invention was also considered in *Van Wye's Application* (1909, 26 R. P. C. 490) the patent being refused on the ground that there was no distinguishable or inventive advance in merely reducing the number of supports to a single support, in a vacuum insulated vessel. Quantum of invention.

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 Applicant may obtain patent for residuum of original claim.

But residuum must have been within original claim.

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 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, 16 R. P. C. 154) Finlay, S.-G., made some observations to the same effect. In *re Mills* (1901, 18 R. P. C. 322) Carson, S.-G., also decided that an applicant whose claim *as originally drawn* is anticipated by the patent relied on by the opponent, even where the applicant's specification contains something that may distinguish his alleged invention from the patent of his opponent, will not be allowed to amend his claim by introducing or substituting such distinguishing

Applicant not allowed to shift his ground.

matter; still less so when the distinguishing feature left is not to be found in the Provisional (*Lancaster's Application*, 1902, 20 R. C. P. 366).

If after the opponent has done his worst, there still remains something apparently novel of the original claim of the applicant, a patent may be granted on such restricted claim, either with or without a general disclaimer or special reference. But where the residuum of the applicant's claim appears to be trifling and immaterial, the patent is and ought to be refused outright.

The doctrine of mechanical equivalents may be considered.

In comparing the applicant's and opponent's specifications, questions of mechanical equivalents will be considered; and if it is obvious that the applicant's alleged improvements are merely mechanical equivalents for the opponent's parts, the application will be refused (*per* Clarke, S.-G., in *re Haythornthwaite*, 1889, 7 R. P. C. 70); and in *re Smith* (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.

Invention not properly described.

The third ground of opposition (Clause (*c*)) is that the nature of the invention, or the manner in which it is to be performed, is not sufficiently or fairly described in the Complete Specification. This is a new ground of opposition introduced by the Act of 1907. According to Rule 41 the notice of opposition should be accompanied by a written statement indicating, as far as can conveniently be done, in what respects the invention is alleged to be insufficiently or unfairly ascertained. The scope of enquiry opened by this ground of opposition must of necessity be wide. It may include actual poverty of description, leaving the reader uncertain of the exact meaning of the applicant; or it may mean insufficiency of differentiation between what has been claimed by the opponent and others and what is intended to be claimed by the applicant. In the latter case it might merge in the grounds of opposition set forth under Clause (*b*). Probably, under this ground, consideration of the questions involved would be largely governed by (A) the rulings of the High Court upon the issues of insufficiency, and (B) by the impression made upon the mind of the Comptroller or Law Officer by the reading of the applicant's specification. From the common-sense point of view, if the specification

is obviously deficient or misleading in accurately ascertaining the meaning and ambit of the invention, further description and particularisation will be ordered. But, if the state of the art has to be taken into consideration, copious evidence may be necessary to show that, although the specification may seem insufficient and even unintelligible to the ordinary reader, it is perfectly clear to the expert or skilled workman in the specific industry to which the invention relates (Fletcher Moulton, L. J., in *British Ore Syndicate* v. *Mineral Separation*, 1909, 26 R. P. C., p. 138). In such a case all of the authoritative decisions of the High Court as to sufficiency may require to be considered. Thus, a specification dealing with a chemical invention would have its sufficiency determined by the evidence and construction of skilled chemists; a mechanical or electrical contrivance, by the evidence of expert mechanicians or electricians; a specification relating to any particular branch of industry by the evidence of skilled workmen in that specific branch (*Beard* v. *Egerton*, 1846, Good. P. C. 39). The test is that a skilled person, versed in the particular art to which the specification relates, should have no difficulty in carrying out the invention from the description (*Edison* v. *Woodhouse*, 1887, 4 R. P. C., p. 108), even although he may have to correct errors in the description from his own acquired knowledge of the subject (*Edison* v. *Holland*, 1889, 6 R. P. C. 243; *Otto* v. *Linford*, 1881, 46 L. T. N. S. 35).

Skilled workman test.

But where the specification, construed on the foregoing lines, still falls short, and leaves the reader in doubt, or puts upon him the onus of experimenting before he can carry out the alleged invention, insufficiency will be held to exist.

Cases in which the patent has been held void for insufficiency are *Coles* v. *Baylis* (1886, 3 R. P. C. 178); *Harmar* v. *Playne* (1870, Good. P. C. 219); *Hastings* v. *Brown* (1853, Good. P. C. 229); *Owen's Patent* (1899, 17 R. P. C. 68); *Hinks* v. *Safety Co.* (1876, L. R., 4 Ch. D. 607); *Bailey* v. *Robertson* (1878, 3 App. Cas. 1055); and *Sirdar Rubber Co.* v. *Wallington* (1907, 24 R. P. C. 539).

Cases in which the alleged insufficiency was not proved were *Crossley* v. *Beverley* (1829, Good. P. C. 136); *Beard* v. *Egerton* (1846, Good. P. C. 39); *Otto* v. *Linford* (1881,

46 L. T. N. S. 35); *Edison* v. *Holland* (1889, 6 R. P. C. 243); and *Leonardt* v. *Kallé* (1894, 11 R. P. C. 534).

It would be incorrect to say that the question of sufficiency and fairness of description has not been hitherto a constant element in the consideration of specifications by the Comptroller and Law Officer. On the contrary, one of their most valuable functions has been that of clearing up uncertainties and remedying deficiencies in specifications. But heretofore mere insufficiency has never been a separate ground of opposition. In the absence of specific reported rulings under Clause (*c*) it is impossible to discuss the practice that will govern the consideration of the objection in question. But much light may be gained from the reported decisions under the other grounds of opposition.

Unfairness of description.

As to the question of unfairness in a description, this might be held to exist where, for instance, the state of the art was set forth in such a manner as apparently to include under common knowledge something which was in fact the subject-matter of a prior patent. In such a case it might well be that the Comptroller would require either amendment of the objectionable passage, or else, a specific reference to the prior patent.

Fourth ground of opposition.

The last of the four grounds of opposition—Clause (*d*)—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 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 originally introduced by the Amending Act of 1888, and now forms part of the present Act. 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 claims for certain features were struck out although the specifications made it clear that the opponents had not originally, in their Provisional Specification, contemplated these improvements, for which the applicant had thereafter made provisional application.

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

Description without claiming.

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

Re Hetherington.

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.

Applications of same date.

Obviously this is not a ground of opposition that can exist between parties where both applications were filed on the same date (Comptroller's Note, 1910 (*a*) 27 R. P. C., Appendix I.)

But applicant still allowed to develop invention under Provisional.

This ground of opposition is not, however, allowed to interfere with the privilege which the inventor has of developing the invention upon the general lines laid down in his Provisional Specification. Thus, in *re Millar and Miller* (1898, 15 R. P. C. 718), the patent was unsuccessfully opposed on these grounds, Webster, A.-G., holding that the applicants had merely described a legitimate development of the invention indicated in their Provisional Specification. The same was held in *re Edwards* (1894, 11 R. P. C. 461). But where any doubt exists in the applicant's mind as to whether the development may come within the original Provisional, he should file a supplementary application. If the Comptroller thinks this development can legitimately be included in the Complete, he will allow it to be so included. If not, the development may be separately patented, either independently of the first or as a Patent of Addition.

Utility of supplementary applications.

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

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

Bogus oppositions.

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).

Belated opposition.

If the period has expired within which opposition can be entered under Section 11, the right to oppose under that section is gone. But as will be seen in the chapter on "Revocation" a person who would have been entitled to oppose under Section 11, or his successor in interest, may apply to the Comptroller under Section 26 to revoke the patent within two years from its date upon the same grounds as in Section 11. The successor in interest of a person so entitled to apply under Clause (*a*), Section 11, must be his legal representative. His assignee would not be so entitled (*Gascoine's Patent*, 1909, 27 R. P. C. 78). On an application to revoke, the Comptroller may revoke or amend or correct the challenged patent as he may think fit. Such an application to revoke may therefore be described as a belated opposition.

Costs.

One word more on the question of costs. The Law Officer has always had the power to award costs. By Section 39 of the present Act, the Comptroller also can now give costs. Discussion sometimes arises when the opponent has asked for the refusal of the grant, with no alternative suggestion in default of success. In such a case the Comptroller, although he may not accede to the refusal of the grant, has complete discretion to amend the applicant's specification or insert a specific reference. When such happens the Comptroller may still, and usually does, give costs to the opponent (Comptroller's Notes, 1910 (H). 27 R. P. C., Appendix X.). Generally speaking, even when refusal of grant is asked, it is better to add an alternative proposal for amendment of the applicant's specification. If the applicant offers, prior to the hearing, to adopt one of the suggested courses, and the opponent presses the matter to an issue on his more drastic demands, he may lose his costs if he does not succeed in obtaining *substantially more* than the opponent offers. The determining questions are--(*a*) Was the opposition justifiable? and (*b*) Has the opponent been successful to a sufficiently substantial extent?

CHAPTER XVI.

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 Rule 48 of the Patent Rules of 1908 an additional fee of £1 is payable on the sealing of the Patent. Form 10 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.

Disuse of Great Seal.

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. Nevertheless it is provided in Section 12 of the Act that, where the Comptroller has granted an extension of time for the leaving or for the acceptance of the Complete, under Section 5 or Section 6, a further extension of four months is allowed for sealing. Where the sealing is delayed by opposition or by an appeal to the Law Officer, the patent may be sealed at such time as the Law Officer directs. Again, where the applicant has died before the time for sealing has expired and the patent is granted to his legal representative, the patent may be sealed within twelve months from the death of the applicant. Lastly, where the applicant has neglected or failed to seal the patent within the time allowed by Section 12, he may apply on Form 11 for an extension of time not exceeding three months within which to pay the sealing fee. The Comptroller has discretion, governed by the circumstances of each case, as to whether he will or will not grant the extension.

Patent may be issued to legal representative of deceased inventor.

Extension of time for sealing.

The latter provision is new and is intended to prevent loss of the patent by forgetfulness or other excusable circumstances. Delay artificially created by the applicant may cause refusal to seal (*A. B.'s Application*, 1902, 19 R. P. C. 403, 556).

Duration of patent.

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

Annual taxes.

	£	s.	d.
Before the expiry of the fourth year, and in respect of the fifth year ...	5	0	0
Before the expiry of the fifth year, and in respect of the sixth year ...	6	0	0
Before the expiry of the sixth year, and in respect of the seventh year ...	7	0	0
Before the expiry of the seventh year, and in respect of the eighth year ...	8	0	0
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 or otherwise the payment of the annual tax has been overlooked or neglected, 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

Restoration of lapsed patent.

If these periods have passed and the fee remains unpaid, the patent becomes void, and formerly could only be revived by a special Act of Parliament. Not so, however, under the present Act. Section 20 makes special provision for the restoration of lapsed patents. Where a patent has been unintentionally allowed to lapse, the patentee may apply to the Comptroller for an order for

its restoration. In this application, all of the circumstances which led to the omission of the payment of the renewal fee must be stated. The stamp on the application (Form 15) is £20. Accompanying declarations must be filed verifying the statements in the application. If the Comptroller entertains the application, he causes it to be advertised in the *Journal*, and invites opposition within two months from the date of advertisement. If opposition is entered the opponent must leave declarations, verifying his intended evidence, within fourteen days after leaving his notice of opposition. Within fourteen days of this the applicant must leave declarations in answer to which the opponent must reply within fourteen days. A hearing is then appointed and the Comptroller gives his decision, which is subject to an appeal to the Court.

Conditions of restoration.

If the patent is ordered to be restored, the order shall contain conditions protecting those who may have availed themselves of the invention after the patent has been announced as void in the *Journal*. (See Rules 55 to 59 inclusive, of the Patents Rules of 1908).

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-patentees.

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, however, is not now subject to the right of survivorship. Section 37 of the new Act provides that where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants; but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit, without accounting to the others, but shall not be entitled to grant a licence without their consent; and if any such person dies, his beneficial interest in the patent shall devolve on his personal representative as part of his personal estate.

Joint interest.

Devolution of interest.

It is to be noted that the section is not retrospective so that all patents granted before the 1st of January, 1908, are still subject to the old Rule at law.

Co-ownership in patents dated prior to Act.

It is therefore necessary to state the still existing conditions of co-ownership under which patents are held, when of a date prior to the 1st of January, 1908.

In all such patents the co-owner holds a joint interest which passes by survivorship, unless there has been severance of the joint estate (*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 such 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 apparently can also grant licences under his own hand, although this point is doubtful. 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. Section 37 now settles the matter so far as patents under the new Act are concerned.

Steers v. *Rogers.*

The ruling in *Mathers* v. *Green* was approved and followed in the House of Lords in the later 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.

As the new Section definitely empowers each co-owner to work the patent for his own profit independently of the others, and as such a situation might be productive of great injustice, it would be advisable that where there is a possibility of disputes arising from this cause co-patentees should, as the section suggests, clearly define their relative positions and rights by means of a properly prepared agreement or such severance of the joint interest as 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 a just or specified share 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 in the case of patents granted before the Act, severance of joint interest should be effected by the co-patentees.

Severance of interest.

Register of Patents.

A Register of Patents is kept at the Patent Office in accordance with Section 28 of the Patents Act. Every patent upon being sealed is entered upon this Register, and all dealings with the patent, whether by assignment, licence, amendment, extension, or revocation, and, in short, everything affecting the validity or proprietorship of the patent, should be entered on the Register by those concerned.

Entries on the Register.

Documents affecting patent only registrable after sealing.

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

Notices of trusts not entered on Register.

Apparently 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.

Query as to agreements made before application.

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

Registration of assignments and licences.

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

Entries by joint patentees.

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

Entry of mortgages.

A notification of a mortgage of a patent may be entered on the Register (Section 71, Sub-section 2), 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 70 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.

Change of name.

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 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.

Certified extracts *primâ facie* evidence.

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 72 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 (Patent Form 32).

CHAPTER XVII.

AMENDMENT OF SPECIFICATION.

THIS chapter is intended to deal more particularly with the amendment of the specification at the instance of the patentee by the Comptroller or by the Court after the patent has been issued. The preceding chapters have already dealt with the minor and ministerial amendments to which the specification may be subjected in the earlier part of its career. For example, the Provisional Specification might be required to be amended, clerically and otherwise, by the Comptroller prior to acceptance; or the applicant may amend his Provisional by discarding part of it at any time before the acceptance of the Complete, in which case the discarded part is not published. The Complete may also be amended before acceptance on the suggestion of the Examiner or at the request of the applicant, these amendments not being advertised or notified in the printed copy. Or the Complete may be amended as the result of an opposition to the grant under Section 11, or an application to revoke under Section 26, in which cases the specification bears a notification that it has been amended; or it may be amended after acceptance as a result of the extended search under Section 8. (See Chapter III. on "Procedure in Obtaining Patents.")

Amendments before sealing at instance of Comptroller.

But what is intended to be dealt with in this chapter is the amendment of the specification by the Comptroller or by the Court upon the initiative of the patentee himself. Section 21 provides for amendment by the Comptroller where there are no proceedings before the Court in respect of the patent. Section 22 provides for the amendment by the Court while such proceedings are going on.

Amendment by patentee.

Dealing first with amendments competent to be made on application to the Comptroller, it often happens that after the Complete Specification has been filed, or after the patent has been granted, the applicant or patentee

Reasons for amendment.

finds that he has claimed something which turns out to be old, or that in some other respect his specification requires amendment.

Section 21, Sub-section 1.

Provision for such amendment has been made in Section 21, Sub-section 1, of the Patent Act:—

"An applicant or a patentee may at any 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 and the reasons for the proposed amendment."

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 93) 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 "at any time" in Section 21 imports that a specification may be amended and re-amended more than once. But repeated disclaimers are not encouraged, and where amendment has succeeded amendment 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 21 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.

Amendment must not extend patent.

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.

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

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).

Ambiguous claim may sometimes be corrected.

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).

Clear error may be amended.

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.

Error in claim.

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).

Claim for combination cannot be made claim for details.

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 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. *Heatlman* (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, and in view of Sub-section 7

of Section 21, which provides that leave to amend shall be conclusive as to the right of the party to make the amendment, except in case of fraud, the Comptroller or Law Officer is more strict, and no doubt amendments which might formerly have been accepted with some dubiety will not now be allowed. Nevertheless, it is sometimes contended that, to get at the true meaning of an amended specification, the text of the unamended specification can 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. 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), but on appeal to the House of Lords the unamended specification was taken into consideration by Lord Lindley (1906, 23 R. P. C., p. 204). It is therefore tolerably clear that the struck out parts of an amended specification may for certain purposes be referred to (*per* Buckley, J., in *Klaber's Patents*, 1904, 22 R. P. C. 10).

Reference to unamended specification.

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.

Reasons for amendment.

Request to amend may be corrected.

Although Sub-sections 4 and 5 of Section 21 give the Comptroller and 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)

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

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 23 of the Act.

Section 23.

Power of Court to impose conditions in action for infringement.

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.*

Relief for infringements before amendment.

So jealous is the Court of giving damages for things done before amendment, that in only two cases have damages for breaches before amendment been given. These are *Hopkinson* v. *The St. James' and Pall Mall Electric Light Co.* (1892, 10 R. P. C. 46); and *Brooks* v. *E. Lycett, Limited* (1903, 20 R. P. C. 390). In the latter case the defendant did not appear at the trial, and Buckley, J., granted the necessary certificate that the original specification had been framed in good faith and with reasonable skill and knowledge.

Fees on amendment.

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.

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

Procedure in amending.

The request for leave to amend a specification (Form 17) must be signed by the applicant or patentee, must give an address for service in the United Kingdom, and, where a patent has been sealed, must contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. This latter provision was made, apparently to obviate such an accident as became evident 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.

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 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.

Advertisement.

According to Section 21, 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.

Persons entitled to oppose amendment.

Decision rests with Law Officer.

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 (Form 18) 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.

Limit of time for opposing.

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 by the Court 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 and Co.* v. *Lycett*, 1904, 21 R. P. C. 651), apply to the Comptroller to amend. Before the present Act the plaintiff had to apply to the Court for leave to amend on the usual terms, and then having obtained that leave he went to the Comptroller who decided the question of amendment with a right of appeal to the Law Officer. The Court itself had nothing to do with the material of the amendment. That they left to what Cozens-Hardy, M. R., called, "the proper tribunal appointed by Statute to decide that question" (*Alsop's Patent*, 1905, 23 R. P. C. 65). Under the present Act the procedure is changed, and by Section 22 it is provided that—

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

Amendment is in the hands of the Court.

> "In any action for infringement of a patent or proceedings before a Court for the revocation of a patent, the Court may by order allow the patentee to amend his specification *by way of disclaimer* in such manner and subject to such terms as to costs, advertisement, or otherwise, as the Court may think fit.
>
> "Provided that no amendment shall be so 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 the amendment; and where an application for such an order is

made to the Court, notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court."

Thus the duty of considering the actual terms of the proposed amendment is taken out of the hands of the Comptroller and left in the hands of the Court. The reader will note that the scope of the proposed amendment must be more limited than in Section 21. It is to be by way of *disclaimer* only. It should also be observed that the provision in Section 21, Sub-section 7, to the effect that leave to amend shall be conclusive as to the right of the party to make the amendment, except in case of fraud, is absent in Section 22.

Disclaimer only.

The section does not indicate how the order of the Court is obtained. But Order 53A, R. S. C., Rule 23, provides:—

Order 53A, R. S. C.

"Where an application is made by a patentee for leave to amend his specification by way of disclaimer under Section 22 of the Act, the following Rules shall apply:—

(*a*) "The application shall be made by motion in the proceedings pending before the Court, and notice of such motion, together with a King's Printers' copy of the specification showing in red ink the amendment proposed to be made, shall be served on the parties to such proceedings, and in the first instance upon such parties only.

(*b*) "On the hearing of such motion the Court shall decide whether, and on what terms as to costs or otherwise, the application shall be allowed to proceed, and, if the application be allowed to proceed, shall give directions as to whether such application shall be heard on oral or affidavit evidence, and, if on affidavit evidence, shall fix the times within which affidavits shall be filed by the parties respectively, and by any other person entitled to be heard under the Act or these Rules.

(*c*) "If the application be allowed to proceed, the applicant shall forthwith serve the Comptroller with a copy of the notice of motion, together with such copy specification as aforesaid, and also a copy of the order allowing the application to proceed, and also with the name and address of the applicant's solicitor, and the proposed amendment shall be advertised in the *Illustrated Official Journal* (*Patents*), such advertisement stating that any person desiring to oppose the amendment must, within fourteen days of the issue of the advertisement, give notice in writing of such desire to the applicant's solicitor, whose name and address for that purpose shall also be stated in the advertisement. Any person giving such notice shall be entitled to be heard upon the hearing of the motion.

(*d*) "Within seven days after the receipt of any such notice, the applicant shall, if the person giving such notice shall have stated therein an address for service within the United Kingdom, serve on such a person a copy of the notice of motion together with such copy of the specification as aforesaid, and also a copy of the order allowing the application to proceed. Such service may be made by prepaid registered letter sent to such person through the post at his address for service.

(*e*) "In the case of an application directed to be heard on oral evidence, the applicant shall as soon as he shall have complied with the requirements of the preceding Rules, set the same down for hearing in the witness list and, in the case of an application directed to be heard on affidavit evidence, the applicant shall after such compliance as aforesaid, and after the times fixed for filing evidence have expired, set the same down for hearing in the non-witness list, and the application so set down shall be heard and disposed of in due course.

(*f*) "Where the Court allows a specification to be amended, the applicant shall forthwith lodge with

the Comptroller an office copy of the order allowing such amendment, and the Comptroller shall advertise the same once at least in the *Illustrated Official Journal* (*Patents*). He shall also, if required so to do by the Court or by the Comptroller, leave at the Patent Office a new specification and drawings as amended, the same being prepared, as far as may be, in accordance with the Rules of the Patent Office for the time being in force."

As the motion will be heard before the Judge who is hearing the action, he will be in an excellent position to decide what amendment he should allow and upon what terms. As the Court of Appeal will not interfere with the exercise of the Judge's discretion, unless satisfied that injustice has been done (*Woolley* v. *Broad*, 1892, 9 R.P.C. 492; *Wilson Bros.* v. *Wilson & Co.*, 1899, 16 R. P. C. 315; *re Allison's Patent*, 1900, 17 R. P. C. 513) it is necessary to present the evidence on the hearing of the motion with the greatest care. The patentee and his experts should seek to show that reasonable skill and knowledge were exercised in preparing the original specification and claims. If the Court decides to allow the amendment, the conditions as to costs may be varied in accordance with what has been done in the action. 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 to amend and consequent upon the amendment should be paid by the plaintiffs in any event. But in *Haslam Foundry Co.* v. *Goodfellow* (1887, 5 R. P. C. 28; L. R. 37 Ch. D. 118), where the pleadings had been closed and the action set down for trial before the application was made, the plaintiffs were ordered to pay in any event the costs of the application and the costs of and occasioned by the disclaimer, except so far as the proceedings in the action might be utilised for the purposes of the trial, other costs being reserved.

Conditions vary in accordance with circumstances.

Where application to amend has been made to the Comptroller, 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 21, 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).

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

The order giving leave to amend 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 (*Huslam 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.*

The further conditions usually imposed, must, of necessity vary with each case, and exceptional circumstances will increase or modify the severity of the conditions. For example in *Deeley* v. *Perkes* (1896, 13 R. P. C. 581) the House of Lords imposed the 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 the 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.

Considerations in imposing 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 or damages be given in the action for any infringements committed prior to the amendment.

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. Damages were also given in *Brooks* v. *E. Lycett, Ltd.* (1903, 20 R. P. C. 370). 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.

The defendant in an action for infringement of the patent, as well as others having the required *locus standi*, may oppose the amendment as provided for in the Order, and appear at the hearing in opposition.

CHAPTER XVIII.

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.

Mere 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; but no damages can be recovered against him if he can prove that he was not aware of the existence of the patent (Section 33).

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 48).

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 unless he can bring himself, so far as damages are

concerned, under the protection of Section 33. 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.

Possession with view to sale.

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 *prima 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.

Unauthorised advertising is ground for injunction.

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).

Harsh proceedings not encouraged.

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, 22 R. P. C. 257; *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

Infringement of part of combination.

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, 22 R. P. C. 257).

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.

Formerly, a patentee in selling his goods or licensing their sale could impose any conditions however harsh: for instance, in compelling the purchasers of a gas mantle to use with it a burner which is no part of the patent (*Incandescent Co.* v. *Brogden*, 1899, 16 R. P. C. 179). It was held that such conditions were binding only on those to whose notice the conditions had been brought when purchasing (*Incandescent Co.* v. *Cantelo*, 1895, 12 R. P. C. 272), but others who were aware of but disregarded the conditions were liable as infringers.

Section 38 on restrictive conditions.

Now, however, by Section 38 of the new Act, it is declared that it shall not be lawful to impose certain unduly restrictive conditions in selling or licensing patented goods. This section will be separately discussed in the chapter on "Licences."

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.

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 customs house agents, not having possession or control of the goods, are not (*Nobel* v. *Jones*, 1882, 8 A. C. 5).

Customs agents.

Action for infringement.

When the owner of a patent discovers that it is being infringed by manufacture, or use, or sale, or importation, or that the invention is otherwise being dealt with in a manner constituting infringement, he may seek his remedy by instituting an action for infringement. He must not threaten unless he means business. If he does he may find the tables turned by having an action brought against him by the threatened party under Section 36 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

Threats.

Clearing for action.

Preliminary negotiations.

Chancery Division for patent actions.

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 92, Sub-section 1, and *Reg.* v. *County Court Judge of Halifax*, 1891, 8 R. P. C. 338; 60 L. J. Q. B. 550).

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

Endorsement of writ.

The writ should be endorsed with a claim for—(1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's Patent No. of 19 ; (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).

Co-owner.

Licensee.

In *Day* v. *Davies* (1904, 22 R. P. C. 34), the plaintiff was owner of one half share only of the patent. 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

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.

Joinder of assignor.

When the plaintiff is an assignee, registration of his assignment is not a condition precedent to his right to take action. Apparently, under the Act of 1852, it was (*Chollett* v. *Hoffman*, 1857, 7 Ell. & B. 686; and *Hassall* v. *Wright*, 1870, L. R. 10 Eq. 509; Good. P. C. 229). *Ihlee* v. *Henshaw* (1886, 3 R. P. C. 15) decided, under the Act of 1883, that a legal assignee of a trade mark was entitled to sue, although not on the Register. To prevent vexatious questions arising, it is always better that the assignment should be registered preferably before the issue of the writ or at least immediately after. 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 (*Borden's Syndicate, Limited* v. *Herbert Smith & Co.*, 1904, 21 R. P. C. 438). Where an agreement to assign exists without the assignment having been executed, the proposed or equitable assignee may bring an action, joining the patentee as defendant to a claim against him for specific performance of the agreement (*Spennymore* v. *Catherall*, 1909, 26 R. P. C. 822).

Unregistered assignee may sue.

Equitable assignee may not.

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).

No action till patent sealed.

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.

Defendant.

Default of appearance.

If defendant is in default of appearance to the writ, a statement of claim, accompanied by affidavit of service, should be delivered by filing in default at the writ department or district registry. After the expiration of ten days, notice of motion may be served by filing in default in the same way and the motion set down. Beyond this, and proof of service of notice of motion, no evidence is required on the hearing of the motion (*Webster* v. *Vincent*, 77 L. T. 167). The relief claimed in the statement of claim and notice of motion should be exactly in the terms of the relief asked for by the writ (*Kingdon* v. *Kirk*, 37 C. D. 141). But where appearance has been made, and there has been default in defence, the relief asked for in the statement of claim may be wider in its terms than the writ, and such judgment shall be given as upon the statement of claim the Court may consider the plaintiff entitled to (A. P. Order 27, Rule 11). The particulars of breaches may be considered as part of the statement of claim for the purposes of this rule (*United Telephone Co.* v. *Smith*, 61 L. T. 617).

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 within this time. If the case is of great urgency leave might be obtained to serve notice of motion with the writ, or an *ex parte* application might be made before appearance for an interlocutory injunction, but exceptionally good cause would require to be shown. After appearance of the defendant the plaintiff might apply for an interlocutory injunction, but this is very seldom granted, since, if the defendant has any defence at all, it would necessitate going into the whole question of the cause of action, which at this stage could not conveniently be done. No interlocutory injunction will be granted if the Court is satisfied that the defendant has no intention of continuing the infringement (*Lyon* v. *Mayor of Newcastle*, 1894, 11 R. P. C. 218). If the patent is of some age and its novelty has not previously been challenged, and a *primâ facie* case of infringement is established, the plaintiff is, generally speaking, entitled to an interlocutory injunction (*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),

Interlocutory injunction.

Interim injunction never granted where defendant discontinues.

Depends on standing of patent and proof of infringement.

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).

Offer of defendant to keep account.

Any order granting an interlocutory injunction should, and generally does, in the defendant's interest, 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 Townend 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 an opposed matter. That ought not to be done. 'The defendant appearing and undertaking' of course precludes that."

Undertaking by defendant in lieu of injunction.

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

Statement of claim.

Particulars of breaches.

to deliver at the same time particulars of breaches, showing the particular instances of infringement of which he complains. In his statement of claim the plaintiff should allege (1) 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 allege (2) that the Letters Patent are valid and subsisting (although this is not necessary), and state generally (3) that the defendant has infringed. The concluding claim should be similar to that endorsed on the writ: viz. (1) 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; (2) damages or an account; and (3) delivery up or destruction of the infringing articles.

Contents of statement of claim.

Certificate of validity if existing should be pleaded.

If the plaintiff possesses a certificate that the validity of his patent has been challenged in a former action, then he should claim (4) 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).

Particulars of breaches to contain alleged instances of infringement.

In the particulars of breaches delivered with the statement of claim, all the alleged instances of infringement known to the plaintiff should be set out with date, place, and name (Order 53A, R. S. C., Rule 13). 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 should, as a rule, be unqualified.

The allegations of infringement should be, generally speaking, unqualified. Such words as "in particular" or "by way of example and not of limitation" or the like are liable to be struck out (*Haslam* v. *Hall*, 1887, 4 R. P. C. 203). When the plaintiff's patent contains more than one claim, he should point out the claim or claims alleged to be infringed, and should give at least one instance of each type of infringement of which complaint is made (Order 53A, R. S. C., Rule 16). 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 (*Henser* 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; and if he disputes the validity of the patent he must deliver with his defence particulars of the objections on which he relies in support of his challenge to the validity (Order 53A, R. S. C., Rule 14). 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. Other available defences are that the defendant was not aware, nor had reasonable means of making himself aware of the existence of the patent (see Section 33). If the defendant succeeds upon this plea, the plaintiff is not entitled to recover any damages for infringement of a patent granted after the 1st of January, 1908, but he will not escape an injunction. Apparently the word "damages" in the section covers any form of compensation. Therefore the plaintiff is not entitled to an account of profits (*per* Neville, J., in *Slazenger* v. *Spalding*, 1909, 27 R. P. C. 26). The defendant may also plead the existence of any contract made by the patentee which by virtue of Section 38 was null and void (see Sub-section 4 of Section 38). A counterclaim for the revocation of the plaintiff's patent may now be incorporated in the defence (Section 32), but if the defendant is not entitled as of right to petition for the revocation of the patent, he should first obtain the Attorney-General's fiat. The defendant must also deliver with his defence particulars of objections to the patent. The particulars of objections should be divided into paragraphs, and must give full particulars of the grounds upon which the defendant disputes the validity of the patent.

Contents of defence.

Counterclaim for revocation.

Particulars of objections.

Particulars of objections should clearly point out and limit grounds for attacking validity of patent.

Order 53A of the Rules of the Supreme Court was specially framed in pursuance of Section 98, Sub-section 1, Clause (*b*), of the Act of 1907, and is intended to govern procedure in actions for infringement of patents and other legal proceedings under the Act. The whole object of the Rules is to narrow the issues and place both parties in complete

New Rules of Supreme Court.

Order 53A, R. S. C.

possession of the exact points they will have to meet at the trial of the action. Rule 17 of the Order provides that:—"Particulars of objections (whether delivered with the defence in an action for infringement of a patent, or with a petition for revocation under Section 25 of the Act, or with a counter-claim for revocation under Section 32 of the Act) must state every ground upon which the validity of the patent is disputed, and must give such particulars as will clearly define every issue which it is intended to raise."

Rule 18 continues:—"If one of the objections taken in the particulars of objections be want of novelty, the particulars must state the time and place of the previous publication or user alleged, and if it be alleged that the invention has been used prior to the date of the patent, must also specify the names of the person or persons who are alleged to have made such prior user, and whether such prior user is alleged to have continued down to the date of the patent, and, if not, the earliest and latest dates on which such prior user is alleged to have taken place, and shall also contain a description (accompanied by drawings if necessary) sufficient to identify such alleged prior user, and if such user relates to any machinery or apparatus shall specify whether the same is in existence and where the same can be inspected.

New Rule as to particulars of prior user.

Evidence strictly limited by particulars.

"No evidence at variance with any statement contained in the particulars shall be given in support of any objection, and no evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent, and which is in existence at the date of the delivery of the particulars, shall be receivable unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or, if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings."

It will be noted that Rule 17 says that the particulars of objections must state *every ground* upon which the validity of the patent is disputed, while Rule 18 shows with what exactness the particulars of want of novelty as regards alleged prior user must be set out.

It will, therefore, be advisable to refer seriatim to the grounds upon which validity can be disputed, and

indicate how far particulars of objections require to be carried in each case.

Prior specifications.

Thus, if the defendant pleads prior publication, he must clearly identify the prior specifications, books, or publications he depends on by time, name, and place. 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 41, Sub-section 1 of The Patents Act, 1907). 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. According to Scotch practice it was 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 more than one claim, the defendant should point out the particular claim or 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; *Holliday* v. *Heppenstall*, 1889, 6 R. P. C. 320; *Sidebottom* v. *Fielden*, 1891, 8 R. P. C. 266). 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 with regard to prior publication are insufficient or too vague, he may apply by summons for further and better particulars (Order 53A, Rule 20). It must, however, be said that under present practice it is 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.

Scotch practice.

Should indicate the claims attacked.

Present practice in applications for further and better particulars.

Prior publications.

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 equivalent to a partial trial of 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).

Prior user as an objection.

If the defendant relies upon prior user he must, in his particulars conform to all of the instructions set forth in Rule 18, which Rule has been set out in full (*supra*). The whole object of the particulars is to identify the alleged prior user both by description and by the aid of drawings if necessary. If the apparatus is in existence exactly or substantially similar to the condition it was in before the date of the patent, and is offered for inspection so that the plaintiff can satisfy himself, no description or drawings will be ordered (*Crossthwaite Fire Bar Syndicate* v. *Senior*, 1909, 26 R. P. C. 260). Such offer to inspect should be made at the time of delivery of the particulars of objections. The extent to which particulars should be carried in inventions relating to process and machinery patents was discussed by Cozens-Hardy, M. R., in *Minerals Separation, Limited* v. *Ore Concentration Co., Limited* (1909, 26 R. P. C., pp. 421-3).

No particulars need be given of general common knowledge.

Holliday v. *Heppenstall.*

If the defendant relies on general common knowledge he need plead no specific instances of prior publication or user if the publications are contained in well known journals or text-books and the user is of common trade knowledge (*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. Also if he relies on any specifications as part of common knowledge he must set them out (*English and American Machinery Co.* v. *Union Boot Co.*, 1894, 11 R. P. C. 367).

Prior specifications cited are part of common knowledge.

A specification or specifications 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 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). But it must be remembered that a patent will not now be held invalid on the ground that the Complete Specification claims a further or different invention to that contained in the Provisional, if the invention therein claimed, so far as it is not contained in the Provisional, was novel at the date when the Complete Specification was put in and the applicant was the first and true inventor thereof (Section 42). To prove disconformity the defendant must, therefore, show that the feature alleged to constitute disconformity was published or publicly used, or invented and protected by some one else before the filing of the Complete.

Disconformity.

New provision re disconformity.

If the defendant pleads non-utility, particulars are not necessary and will not be ordered. If insufficiency of the specification is pleaded, or unworkability of the process or apparatus as described, the defendant 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*).

Non-utility, and insufficiency.

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.

Denial that plaintiff is true and first inventor.

If the plaintiff is accused of having obtained the invention from another, the name and address of the alleged true inventor must certainly be given, together with all particulars of time, place, and circumstances bearing out the allegation. Drawings of the invention alleged to have been taken should also be supplied and information given as to whether any concrete example was ever constructed, and whether or not the same is in existence. Rule 18 does not distinguish this as a case

Fraudulent obtaining from real inventor.

for particulars, but there is no doubt the fullest disclosure would be ordered. 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.

Distinguishing old from new.

It is sometimes pleaded that the patentee has failed in his specification to distinguish old from new. If this is alleged, full particulars must be given, but according to Moulton, L. J., in *British United Shoe Co.* v. *Fussell* (1908, 25 R. P. C. 631), this plea is now obsolete in combination claims. Nevertheless, cases might arise when the objection would prove effective, and it cannot be wholly disregarded.

Defence of prior grant.

A further defence is that of prior grant of a patent to another inventor for the same invention. This defence is not often used, but the circumstances under which it might be

Circumstances under which prior grant might be pleaded.

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

Section 25, Sub-section 2.

is had to Section 25 of the Act, which says (Sub-section 2) that every ground on which (Clause (*a*)) a patent might, immediately before the first day of January, 1884, have been repealed by *Scire Facias* shall be available by way of defence to an action of 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. 499). 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), and in *Robertson* v. *Purdey* (1907, 24 R. P. C. 273).

Query whether particulars of prior grant would be ordered.

There is no doubt that particulars of such prior grant would be ordered by the Court. The point was raised but not settled in *Birmingham Tyre Syndicate* v. *Reliance Tyre Co.* (1900, 17 R. P. C. 277). But 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.

Before the coming into force of the present Act, the defences indicated practically exhausted the grounds by which a defendant might have sought to justify his conduct. Other points were sometimes raised, but without avail. As an instance of intelligent anticipation of a defence which has since been created by the present Act, 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 then impress the Court.

Further statutory defences.

Now by Section 25, Sub-section 2, every ground on which (Clause (*b*)) a patent may be revoked under this

Act, either by the Comptroller or as an alternative to the grant of a compulsory licence, shall be available by way of defence to an action of infringement. Under Section 26 the Comptroller may, within two years from its date, revoke a patent on the grounds set forth in Section 11, whereby a person might have successfully opposed the grant. That is one of the additional statutory defences. Again, under Section 27, the Comptroller may revoke a patent, not less than four years from its date, on the ground that the patented article or process is carried on exclusively or mainly outside the United Kingdom. That is another of the additional statutory defences. Then comes Section 24, which provides that where a petition has been presented to the Board of Trade for a compulsory licence and the petition has been referred to the Court, and it is proved that the reasonable requirements of the public have not been satisfied, licences may be enforced *or the patent may be revoked*, and the grounds for such revocation form the third new statutory defence under Section 25. It is evident that particulars of all of these defences must be given in every case where the novelty and validity of the patent are assailed. Where the defence was pleaded that the article, the subject of the said Letters Patent, is manufactured wholly or mainly abroad, the plaintiffs applied for "particulars of the alleged manufacture abroad, stating at what time it is alleged that the said articles are or were wholly or mainly manufactured abroad, and the place or places of such manufacture, and whether it is or was of articles sold in this country, and if so whether the whole of the manufacture of such articles is alleged to be carried on abroad, or if not the whole what stages of the manufacture." These particulars were ordered by the Court of Appeal (*Thermos, Limited* v. *Isola, Limited*, 1910, 27 R. P. C. 195).

Defence under Section 26.

Defence under Section 27.

Defence under Section 24.

Working patent abroad.

Of course, the defendant must strictly conform to the requirements as to *locus standi* under the different Sections (24, 25, 26, and 27) behind which he seeks refuge. For instance, under Section 26 he must be properly entitled to oppose (under Section 11), and he must be within time —two years. Under Section 27 the plaintiff's patent must be at least four years old, to be subject to revocation by the Comptroller, and under Section 24 the defendant must not only be a "person interested," but, to be subject to

Locus standi of defendant.

revocation under Section 24, the plaintiff's patent must be three years old. When cross references are made to the different sections, and the difficulties of meeting the various requirements become apparent, it may begin to dawn upon defendants that the advantages of Clause (*b*), Sub-section 2, of Section 25, are capable of being over estimated.

Restrictive conditions.

Section 38 of the Act, which provides for the avoiding of certain restrictive conditions imposed by the patentee or his agents on the sale or working of any patented invention recites, in Sub-section 4, that "The insertion by a patentee in a contract made after the passing of this Act of any condition which, by virtue of this section, is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates, brought while that contract is in force."

Particulars of illegally restrictive contract.

In pursuance of this section, Rule 10 of Order 53A provides that:—"If a defendant in an action for infringement of a patent intends to rely as a defence to such action on the insertion by the patentee in any contract or contracts of any condition, which by virtue of Section 38 of the Act is null and void, he shall deliver with his defence full particulars of the dates of and parties to all contracts on which he intends to rely as containing any such condition, and of the particular conditions in any such contracts on which he intends to rely as being by virtue of that section null and void, and, save as appears from such particulars, no defence shall be available to him in such action under Sub-section 4 of that section. Provided that particulars delivered under this rule may be from time to time amended by leave of the Court."

This is an entirely new defence created by the Act, and must be backed in the particulars of objections by the disclosures required.

Counter-claim for revocation.

Another point that may have to be dealt with in the defence and particulars of objections is where the defendant counterclaims for the revocation of the plaintiff's patent in accordance with Section 32 of the Act. When this is done, Rule 15 of Order 53A falls to be considered. The said rule provides that a defendant in an action for infringement of a patent, who under Section 32 of the Act counterclaims in the action for the revocation of the patent, shall with his counterclaim deliver particulars of

any objection to the validity of the patent on which he relies in support of his counterclaim.

It must be remembered that every defendant is not entitled to raise such a counterclaim as of right. He must be entitled under Section 25 (3*b*) to present a petition for revocation. If not—indeed in any case—he should apply to the Attorney-General for his fiat, and then proceed by way of counterclaim. The particulars of objection accompanying the counterclaim should, where novelty is an issue, be as full as those prescribed by Rule 18.

Particulars in counter-claim.

It may now be useful to the reader shortly to recapitulate the available heads of the defence, and then tabulate the available particulars of objections, old and new, pointing out which of them do or do not require to be verified by specific particularisation:—

HEADS OF DEFENCE.

Heads of Defence.

1. Plaintiff not the legal owner of patent.
2. No infringement.
3. Patentee not the first and true inventor.
4. Patent invalid for the reasons set forth in the annexed particulars of objections. (This general plea covers the issues of want of novelty, insufficiency of specification, no utility, lack of subject-matter, unworkability, not distinguishing between old and new, prior grant, disconformity, common knowledge; and the three pleas in defence under Section 25, Sub-section 2 (*a*) and (*b*); and liability to revocation).
5. Defendant not aware of existence of patent.
6. Existence of illegal contracts under Section 38.
7. Counterclaim for revocation of plaintiff's patent.

Of these heads of defence Nos. 4, 5, 6, and 7 must be fortified by particulars of objections, and the same applies to No. 3 if there is any substance in it.

PARTICULARS OF OBJECTIONS.

Particulars necessary.

Prior Publication.—Particulars as prescribed by Order 53A, Rule 18.

Prior User.—Particulars as prescribed by Order 53A, Rule 18.

Common Knowledge.—No particulars; but if certain specifications are also relied on, these should be cited. Point out plaintiff's claims affected.

No Subject-matter.—No particulars; the defendant relying on common knowledge and the specifications, publications, and instances of prior user cited, together with the plea of lack of invention.

Patentee not First and True Inventor.—No particulars (unless defendant can point out who was the real inventor).

Invention not Useful.—No particulars.

Specification Insufficient or Misleading.—Particulars.

Not distinguishing between Old and New.—No particulars.

Apparatus or Process, as described, Unworkable.—Particulars.

Disconformity.—Particulars.

Prior Grant.—Particulars.

Defendant not aware of existence of Patent.—As the onus of proof is on the defendant, it is probable that particulars of the allegations upon which he relies would be ordered, or interrogatories allowed.

Pleas under Sections 25, 26, and 27.—Particulars (Section 27, see *Thermos* case).

Illegal Contract (Section 38).—Particulars (Rule 10, Order 53A).

Counterclaim for Revocation.—Particulars (Rule 15, Order 53A).

Reply.

In many cases it is obvious the plaintiff must deliver a reply.

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 (see Rule 19 of Order 53A). The application is usually made by summons at chambers, but if the advisability of so amending should have been just then discovered, the application might be made at the trial of the action. For example, in *Badische Anilin Fabrik* v. *Société Chimique* (1897, 14 R. P. C. 875) the defendants were allowed to introduce a new objection at the trial. The Court of Appeal, by Order LVIII, Rule 4, of the Rules of the Supreme Court, has jurisdiction to amend

By summons and motion at trial.

In Court of Appeal.

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. In applications to amend at the trial, 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. *Mallings*, 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.*

Costs.

Form of order in the case of repeated amendments.

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., 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.

Wilson v. *Wilson.*

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. A notice of discontinuance was held to be bad which had been given after the defendants had delivered a defence and after the plaintiffs had delivered an amended statement of claim, the amendment not being merely formal (*Vickers* v. *Coventry Ordnance*, 1907, 25 R. P. C. 207).

Notice of trial.

By Section 34 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. 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,

Inspection.

Procedure and grounds for inspection order.

and particularly if he practises 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.

Inspection without order.

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).

Interrogatories.

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

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

Province of interrogatories.

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).

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. Thus, an interrogatory which asks a plaintiff to swear to the construction of his own specification, or which practically seeks an admission that he is wrong in his action, will not be allowed (*Bibby and Baron* v. *Duerden*, 1910, 27 R. P. C. 283).

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. 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

Interrogatories framed on plaintiff's specification.

Names of customers.

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 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).

General admissions to interrogatories.

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 (*Bourn* v. *Sansom*, 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 tried without a jury (Section 31), although by the same section the Court has power to direct that they shall be tried with a jury.

Assessor.

Under Section 31 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 has 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 did not 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.

New trial on ground of surprise.

The granting of an adjournment on the ground of surprise is always a matter for the discretion of the Court. A new trial on the ground of surprise cannot be

obtained unless there is an affidavit alleging surprise (*per* Lord Esher in *Haggenmacher* v. *Watson*, 1897, 14 R. P. C., at p. 634, line 6).

Action may be remitted to a referee.

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

Estoppel.

The defendant may in certain circumstances be estopped from denying the validity of the plaintiff's patent. This is so if the defendant has submitted to judgment in a previous action for infringement of the same patent (*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.

Results of judgment for plaintiff.

If satisfied of the validity of the plaintiff's patent and that infringement has been established, the Court will grant an injunction and damages, or an account of profits, with costs, and sometimes delivery up or destruction of the infringing goods. An injunction only holds good while the plaintiff's patent is in force, and if the patent should be declared invalid in some subsequent action the injunction comes to an end (*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).

Effect of result of subsequent judgment on injunction.

More manufacture without sale is infringement.

Committal for breach of injunction.

Breach by corporation.

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.

Goods delivered up are not plaintiff's property.

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 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).

Only infringing part delivered up.

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).

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. *Tootal Broadhurst*, 1894, 11 R. P. C., at p. 184).

Not merely loss of profit.

Different persons liable.

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.

Account of profits.

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).

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.

Shorthand notes.

The costs of shorthand notes are

usually not allowed; but in the Court of Appeal, in the absence of a direction to the contrary, the costs of an appeal include the costs of the shorthand writer's notes of the judgment (*re Medland*, 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 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. 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). 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).

Between solicitor and client.

Costs of inspection without order.

Three counsel.

Order 53A. (Rule 22) provides that:—

Taxation of costs.

On taxation of costs in any action or counterclaim for infringement of patent, or in any petition for revocation of a patent under Section 25 of the Act, or in any counterclaim for revocation of a patent under Section 32 of the Act, the following provisions shall apply: that is to say—

Particulars to be certified by Court.

If the action, petition, or counterclaim proceeds to trial on any patent, no costs shall be allowed in respect of any issues raised in the particulars of breaches or particulars of objection and relating to that patent, to the parties delivering the same respectively, except in so far as such particulars are certified by the Court to have been proven, or to have been reasonable and proper without regard to the general costs of the case; but subject as aforesaid, the costs of the issues raised by the particulars of breaches and the particulars of objections shall be in the discretion of the Taxing Master.

The short meaning of the rule is—If the cause goes to trial, the judge's certificate of the costs of particulars must be obtained. If it does not, these costs are in the discretion of the Taxing Master, and it is the latter provision which is new.

Practice in granting certificates of costs in particulars of breaches and objections.

Premising then, that the action has been tried, 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 fully 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 sufficient trial of the action, owing to the premature collapse of one side or the other, such certificates may be 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 *Gall* v. *O'Neill* (1909, 27 R. P. C. 18), where the defendant did not appear at the trial, a certificate as to the particulars of breaches was granted, but a certificate that the validity of the patent had come in question was refused. In *Allen* v. *Oates* (1898, 15 R. P. C. 304) a certificate was granted only in respect of those particulars of breaches relied on at the trial. As touching particulars of objections, a certificate was granted in *Chamberlain* v. *Mayor of Bradford* (1900, 17 R. P. C. 493) in respect only of those particulars referred to at the trial. "Those 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

Costs certificates in particulars of objections.

reasonable and proper or not; now the Taxing Master would make the inquiry. 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 defendants asked for a certificate of their particulars of objection, 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.

Practice in granting certificates.

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

Even where actions have gone to trial, the cases are various and sometimes apparently conflicting, but the broad rule to be deduced is that, where the Court has had no opportunity of judging of the reasonableness of the particulars, a certificate will seldom be granted, and the Court will not enter into a sort of half trial of the action in order to see whether or not the particulars of objections are reasonable (*per* Romer, L. J., in *Wilcox & Gibbs* v. *Jones*, *supra*). This is likely to work hardship if the old practice is adhered to, for apparently if the action "proceeds to trial," though the case may break down without the particulars having been gone into, the section leaves the granting of the certificate in the discretion of the Judge. 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 the 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. So where the plaintiff succeeds on infringement and fails on validity, certificates may be granted to both sides, and an order for apportionment made (*Kay* v. *Chubb*, 1887, 4 R. P. C. 289;

Cassel Gold Co. v. *Cyanide Recovery Co.* 1894, 11 R. P. C. 638). Or, conversely, where the plaintiff succeeds on validity, but fails on infringement (*Dunlop Co.* v. *Wapshare Co.* 1900, 17 R. P. C., p. 458; *Robertson* v. *Purdey* 1907, 24 R. P. C. 273). Sometimes the Judge will allot the costs in definite proportions between the parties (*Incandescent Co.* v. *Sunlight Co.* 1896, 13 R. P. C. p. 345; *Monnet* v. *Beck*, 1897, 14 R. P. C., p. 850; *Ralston's Patent*, 1909, 26 R. P. C. 313). 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).

Certificate that validity of patent has been challenged.

If the validity of the plaintiff's patent has been impeached by the defendant and has not been destroyed at the trial, the plaintiff should apply under Section 35 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 may certify that the validity of a patent came in question; and if the Court so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client."

"Subsequent action."

"Any subsequent action" means any action started after the certificate in the earlier action has been granted. This was held in *Automatic Weighing Machine Co.* v. *International Hygienic Society* (1889, 6 R. P. C. 475), and in *Pneumatic Tyre Co.* v. *Leicester Pneumatic Co.* (1898, 6 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).

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. *Krumm*, 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 (see also *Gall* v. *O'Neill*, *supra*).

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*). Even when the patent has expired before the trial, a certificate may be granted (*Sunlight Incandescent Gas Lamp Co.* v. *Incandescent Gas Light Co.*, 1897, 14 R. P. C. 757; *Kane* v. *Boyle*, 1901, 18 R. P. C. 325).

Certificate in expired patent.

No appeal on certificate.

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

Certificate in Judge's discretion.

The granting or refusing of a certificate is always a matter for the Judge's discretion, and even where a certificate has been granted, the Court or a Judge in a subsequent action is not bound to give solicitor and client costs to a successful plaintiff (*Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 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 (*Fawcett* v. *Homan*, 1896, 13 R. P. C. 398).

Costs on the 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; *Carnegie* v. *Bell*, 1909, 26 R. P. C., 265; *Müller's Patent*, 1907, 24 R. P. C. 465). 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.

Public Authorities Protection Act.

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, it is possible that 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

Stay of enquiry.

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.

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 the 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). Section 31 (Sub-section 2) of the Patents Act provides that the Court of Appeal may, if they think fit, in any proceeding before them, call in the aid of a specially qualified assessor.

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.

Practice in Scotland.

In the application of the Act to Scotland, Section 94 (Sub-section 1) provides that:—

> "In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried, without a jury, unless the Court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of Courts in Scotland in such an action, or in any action or proceeding respecting a patent hitherto competent to these Courts; and for the purposes of the provisions so applied, 'Court of Appeal' shall mean any Court to which such action is appealed" (see also Sub-section 4).

Ireland, and Isle of Man.

Section 95 provides for the application of the Act in Ireland, and Section 96 to the Isle of Man.

CHAPTER XIX.

REVOCATION OF PATENTS.

Old means of obtaining revocation.

UNDER the repealed Acts there was practically but one mode of obtaining revocation of a patent, viz.: by petition to the Court. A secondary possibility of obtaining revocation lay in the petition to the Board of Trade for a compulsory licence, which, when referred to the Judicial Committee of the Privy Council, might have resulted in the revocation of the patent. This was provided for by The Patents Act, 1902, but the provision proved barren of results, and the section remained a dead letter.

Present means of revocation.

Now, under the present Act, there are in effect four methods of revoking patents upon more or less different grounds and by different administrations. For example, a patent may be revoked by the Comptroller *within two years of its date*, on any one or more of the grounds on which the grant of the patent might have been opposed (Section 26). The Comptroller may also revoke a patent at any time, *not less than four years from its date*, on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom (Section 27).

By Comptroller.

By the Court.

In addition to these two methods, a patent may, under Section 25, be revoked by petition to the Court on the usual grounds which will be hereinafter set forth, and, apart from an independently initiated petition, the Court may revoke a patent on a counterclaim by the defendant in an action for infringement (Section 32).

Counterclaim.

As alternative to compulsory licence.

Further, under Section 25, when a person interested petitions the Board of Trade for a compulsory licence or, in the alternative, revocation of the patent, and the Board refers the petition to the Court, the latter may, in certain circumstances, order revocation of the patent (Section 24). Thus there may be said to exist four modes of obtaining revocation orders which may be tabulated as follows:—

Four methods of obtaining revocation.

(1) Revocation by Comptroller within two years of date, on grounds of opposition set forth in Section 11 (Section 26).

(2) Revocation by Comptroller not less than four years from date, on ground of sole or excessive manufacture abroad (Section 27).

(3) Revocation by petition to the Court on all available grounds (Section 25; see also Section 24).

(4) Revocation by the Court on defendant's counterclaim in action for infringement (Section 32).

These will now be considered in their order, and first:—

Revocation on grounds of opposition, in Section 11.

(1) *Revocation by the Comptroller within two years of the date of the patent upon the grounds of opposition as set forth in Section 11.*

This is governed by Section 26 of the Act, which sets forth that—

26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner, apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed:

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any Court, an application under this section shall not be made except with the leave of the Court.

(2) The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

(3) A patentee may at any time, by giving notice in the prescribed manner to the Comptroller, offer to surrender his patent, and the Comptroller may, if after giving notice of the offer and hearing all parties who

desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court.

Persons entitled to apply.

It should be noted that the person who may apply to the Comptroller for revocation under Section 26 must belong to the class who would have been entitled to oppose the grant, and the grounds of his application to revoke must be the same grounds upon which opposition to the grant could have been entered. As has already been said, an application to revoke under Section 26 partakes of the nature of a belated opposition to the grant. To discover what the grounds of application are, we must return to Section 11, and to save repetition the reader is referred to Chapter XV. (Opposition to Grant of Patent), where the whole practice relative to opposition is fully set out. To succeed in his application to revoke, the applicant must adduce the same evidence which would have justified the Comptroller in refusing to seal a patent, and if sufficient reason is shown the Comptroller may, instead of revoking the patent, cause the specification to be amended by disclaimer, correction, or explanation. Presumably also, if good cause is shown, a special reference to the applicant's patent will be inserted. In short, the whole practice as to parties, procedure, and the cases governing the Comptroller in coming to a decision will be found in Chapter XV. The "successor in interest" of a person who would have been entitled to oppose, as referred to in Sub-section 1 of Section 26, must, in the case of an applicant under Clause (*a*) of Sub-section 1 of Section 11 (viz., that the invention had been obtained from the applicant), be the "legal representative," as in Clause (*a*), in the ordinary meaning of the term: *i.e.* executor or administrator. The term does not include an assignee or the holder of a power of attorney (see *Spiel's Patent*, 1887, 5 R. P. C. 281; *Edmund's Patent*, 1888, Griff. P. C. 281). For a decision of the Comptroller to this effect see *Gascoine's Patent* (1909, 27 R. P. C. 78). Except with the leave of the Court, an application to revoke under this section will not be entertained if any action for infringement of the patent or petition for revocation is pending in any other Court.

Grounds of revocation.

"Successor in interest."

The Patents Rules of 1908 (Nos. 75 to 77) relating to the procedure in such applications, are as follows:— Patents Rules.

PROCEDURE UNDER SECTION 26 OF THE ACT.

75. An application for the revocation of a patent under Section 26 of the Act shall be made on Patents Form No. 22, and shall be accompanied by an unstamped copy of the form, which shall be transmitted by the Comptroller to the patentee. Where the ground of application is that the applicant for the patent obtained the invention from the person applying for the revocation of the patent, evidence by way of statutory declaration in support of such allegation shall be left at the Office at the same time as the application for the revocation, or as soon as may be thereafter. In other cases such evidence may be so left by the applicant for revocation if he desires. Copies of any declarations left at the Office under this rule shall be delivered by the applicant to the patentee. Application under Section 26 of the Act.

76. Upon such declarations being left and delivered the provisions of Rules 13 to 77 shall apply *mutatis mutandis* to the furnishing of further evidence and to the hearing of the case before the Comptroller. Procedure.

77. A notice of an offer by a patentee to surrender his patent under Section 26 of the Act shall be given on Patents Form No. 23, and shall be advertised by the Comptroller in the *Journal* and in such other manner, if any, as he deems desirable. Surrender of patent.

If revocation is refused by the Comptroller, the applicant may appeal to such Judge of the High Court as the Lord Chancellor may select for the purpose, and his decision shall be final. But if the Comptroller revokes the patent, the patentee may appeal to the Court, and thereafter either party may proceed on appeal to the Court of Appeal or to the House of Lords (Section 92, Sub-section 2). Appeal to special Judge.

The provision in Sub-section 3 of Section 26, enabling a patentee to surrender his patent, was intended to obviate the hardship of a patentee being obliged to figure as respondent and pay the costs of an undefended petition to revoke a patent admittedly bad. Surrender of patent.

(2) *Revocation by the Comptroller not less than four years from the date of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.* Revocation of patents worked outside the United Kingdom.

This form of application to revoke is governed by Section 27 of the Act, which runs as follows:—

27. (1) At any time not less than four years after the date of a patent and not less than one year after Section 27.

the passing of this Act, any person may apply to the Comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2) The Comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Comptroller may make an order revoking the patent either—

(*a*) forthwith; or

(*b*) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent:

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the Comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the Law Officer or such other counsel as he may appoint shall be entitled to appear and be heard.

Reasons for provision.

Section 27 is a new provision made to meet the growing feeling of discontent that was felt at the spectacle of numerous foreign patentees using their monopoly in this country, not to further its industrial interests, but solely to close the market in Great Britain to all but the patentee or his agents. Of the total number of patents issued in this country annually, more than one third were granted to foreigners, patents for dyes being almost exclusively granted to aliens. In very few cases were these patents worked in the United Kingdom, so that, as far as production was concerned, neither British labour nor capital was benefited. Thus, for a fee of £100, a foreign importer was able to stamp out all competition for fourteen years without bettering the trade of this country a whit, save in the way of buying and selling. The whole practice was utterly adverse to the spirit of Section 6 of the Statute of Monopolies, which was intended to foster the "*working* or *making* of any manner of new manufactures within this realm."

Act of 1902.

An attempt was made to cope with the abuse by Section 3 of the Patents Act of 1902, but, on account of the uncertainty of the remedy and the expense of enforcing it, no one ever tried to take advantage of the suggested cure.

Effects of Section 27.

A very different result has attended the coming into force of the present measure. Numerous applications have been and are being made to revoke patents the owners of which had failed to comply with the conditions. At first the Comptroller was excessively drastic in his interpretation of the section, and a number of patents were revoked irrespective of many circumstances that would probably have saved them under the present milder views adopted by the Court.

Objects of the section.

If the section is examined it will be found that it never was intended to be pitiless in its operation, nor to create such injustice as would have meant the replacing of one abuse by another. In the first place Sub-section 2 modifies Sub-section 1 by providing that if the patentee proves that the invention is manufactured *to an adequate extent* in this country, or can give *satisfactory reasons* why it is not so manufactured or carried on, revocation will not be ordered; and even if the patentee is unable at the moment to justify

Time may be given to comply with section.

his position, time may be given him to comply with the section (see Clause (*b*) of Sub-section 2). Beyond this, if the extension of time under Clause (*b*) should prove insufficient, the patentee may under Sub-section 3 obtain a further extension if he can show satisfactory reasons for not having complied with the first order.

Hatschek's Patents.

Thus a great deal is left to the discretion of the Comptroller, and, as has already been said, that discretion was at first exercised with considerable severity against the defaulting foreign patentee. However, the question soon came before the Court in the form of an appeal from the Comptroller's decision, and in *Hatschek's Patents* (1909, 26 R. P. C. 228), Mr. Justice Parker made a number of illuminating general observations on the construction of the section, which has modified the Comptroller's practice very considerably. In the first place the learned Judge swept away the notion that the section was to be administered with undue severity.

Policy of section.

He pointed out that the policy of Section 27 is directed to secure fair play between foreign industries and the industries of this country, and not to secure to the latter, during the period of the patent, a protection which they would not enjoy if no patent had been granted. The learned Judge also intimated that Sub-section 1 of Section 27 must not be considered conclusive in every case in which the patented article or process is manufactured or carried on to a greater extent outside than inside the United Kingdom; if the article or process be manufactured or carried on within the United Kingdom, not only to a substantial extent, but to an extent as substantial as may reasonably be expected having regard to what is done abroad, the state of circumstances contemplated by Sub-section 1 does not exist; that the comparison suggested by Sub-section 1 is not between what is done by the patentee in this country and abroad respectively, but between the *extent* of manufacture here and the *extent* of manufacture abroad respectively, whether the results of the manufacture abroad are or are not imported into this country; that the section is meant to hit any abuse of the monopoly the object or result of which is to benefit foreigners at the expense of the traders within the United Kingdom; that the "adequacy" of the manufacture in this country.

Section directed against abuse of monopoly.

and the "satisfactory" nature of the reasons given for not complying with the section are governed by the circumstances of each case, and must in each case be considered by the Comptroller or the Court; that the applicant, being the person upon whom the onus lies of proving non-compliance with the section, should be the first to tender evidence.

Applicant must show good cause.

The whole judgment is so full of valuable suggestions, and is so obviously intended as an authoritative guide to the principles and procedure governing applications to revoke under Section 27, that it is reproduced here *in extenso*:—

Judgment of Parker, J., in *Hatschek's Patents*.

Parker, J.: "Before dealing with the facts of this case, I propose to make certain general observations on the construction to be placed upon Section 27 of The Patents and Designs Act, 1907. I think this course will be convenient, not only for the purpose of the proceedings now pending before the Comptroller, but for the enlightenment of patentees whose patents may hereafter be attacked under the provisions of this section, and who, at the present moment, labour under the disadvantage of not knowing certainly the circumstances in which such an attack is possible or the nature of the evidence to be adduced to meet it. Some of the points on which I shall touch were not raised in this case, but they have been argued fully in another case (see *Bremer's Patent*, *infra*) which I have had before me, and which I have adjourned for further evidence, and I have devoted a considerable time to the study of the section, being fully aware of its importance both to patentees and to the public. Whatever difficulty there may be in ascertaining the precise meaning of some of the expressions in Section 27, it is at least clear that a patentee, since that section became law, cannot be certain of retaining his patent rights after the period mentioned in the section unless his patented process is being worked, or his patented article is being manufactured, within the United Kingdom to an extent which the section describes as adequate, or unless he can give satisfactory reasons why this is not the case. The mischiefs which Section 27 and Section 24 of the Act were intended to meet are well known. It was felt to be intolerable that Letters Patent for inventions which create monopolies and are therefore

Monopolies in restraint of trade.

in themselves contrary to the spirit of the Common Law as being restraints on trade, and which were only excepted from the operation of the Statute of Monopolies for the encouragement of trade and inventions useful in trade, and in consideration of the disclosure of such inventions to the public, should be used (as they had in fact been used) to prevent the development of new industries or to fetter existing industries in this country. Sections 24 and 27 of the Act are intended to prevent this being any longer possible. Section 24 deals primarily with cases where the trade of this country has been injured by an abuse of the monopoly conferred by the patent, irrespective of anything which is being done abroad. Section 27 deals primarily with cases where the object or effect of the use of such rights, in the way they have been used, has been to favour the development of industries abroad at the expense of industries in the United Kingdom. The sections may sometimes overlap, but this is the broad dividing line between them.

Scheme of Section 27.

"The scheme of Section 27, considered as a whole, is quite simple, but for all its simplicity it is exceedingly drastic. Anyone, whether having any real interest in the development of British industries or not, whether a foreigner or a British subject, and whatever be his motive, can, by satisfying the Comptroller of the existence of the state of circumstances contemplated in Sub-section 1, impose on a patentee the onus of justifying the use he has made of his monopoly—the onus of proving, in order to save his patent from revocation, that his patented process is carried on, or his patented article manufactured to an adequate extent within the United Kingdom, or of giving a satisfactory reason why it is not so carried on or manufactured. The keynote of the section is, in my opinion, forfeiture for abuse of the monopoly at the instance of even a common informer, the abuse being in certain circumstances presumed unless disproved.

Any person may apply to revoke.

Circumstances contemplated by section.

"The first question is this, what is the state of circumstances the existence of which imposes this serious liability on a patentee? In the words of Sub-section 1 it it is whenever 'the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.' There is no difficulty in the use of the

word 'exclusively,' but the use of the word 'mainly' gives rise to the difficulty. The sub-section may, and it was argued that it did, include every case in which the patented article or process is manufactured or carried on to a greater extent outside than inside the United Kingdom. If that is the true meaning, then in every case in which more than fifty per cent. of the patented articles manufactured anywhere are manufactured abroad, the patentee can be called upon to justify the use he has made of his monopoly and to defend his patent rights. I cannot think that this is the true meaning of the sub-section. However great may be one's belief in the industrial supremacy of the inhabitants of these islands, it would at least be somewhat arrogant to assert that wherever the manufacture of a patented article in the United Kingdom is less than one half of the total manufacture of the whole world, there arises a presumption that British trade has not had fair play—a presumption that the patentee has been abusing his monopoly. If the patented article be manufactured in the United Kingdom to as great an extent as can reasonably be expected, having regard to the industrial development of other countries, I do not think any presumption against the patentee can fairly arise, nor do I think that the Legislature intended it should arise. The word 'mainly' is used in the sub-section in close connection with and as an alternative to the word 'exclusively,' and, having regard to this fact, I do not think that a process or article can be said to be mainly carried on or manufactured abroad, merely because it is carried on or manufactured abroad to a somewhat greater extent than within the United Kingdom. For example, if the total manufacture in the United Kingdom were one thousand two hundred and the total manufacture elsewhere one thousand two hundred and fifty, giving a total of two thousand four hundred and fifty in all, I do not think it could be said that the manufacture was mainly abroad within the meaning of the section; to come within the sub-section the disparity must, in my opinion, be greater than a mere small percentage, and, indeed, if the article be manufactured, or the process be carried on within the United Kingdom, not only to a substantial extent, but to an extent as substantial as may reasonably be expected, having regard to what is

"Mainly" and "exclusively" contrasted.

done abroad, I do not think the state of circumstances is that contemplated by Sub-section 1.

Comparison instituted by Sub-section 1.

"It was further argued before me that Sub-section 1 institutes a comparison, not between the extent to which an article or process, the subject of a British patent, is manufactured or carried on in this country and the extent to which it is so manufactured or carried on abroad, but between the number of patented articles made abroad, either in accordance with the specification or by means of the process described in the specification, and imported into this country, and the number of such articles so made in this country. This argument was based on the use of the word 'patented,' it being contended that the use of this word showed that the Legislature was only referring to what was done within the area of the monopoly created by the patent, and that the manufacture of the articles, or the carrying on of the processes, abroad did not come within the area of the monopoly, unless and until the goods manufactured, or the goods resulting from the process, were imported into this country. I cannot conceive that if the Legislature had meant this it would not have said it in plainer words. In my opinion, therefore, the sub-section institutes a comparison between the extent to which the article or process, the subject of the patent, is manufactured or carried on in this country, and the extent to which it is manufactured or carried on abroad, whether the articles so manufactured or resulting from the process so carried on abroad are or are not imported into this country. I have come to this conclusion more easily because the real strength of the argument to the contrary consisted in considering how far-reaching would be the effect of the section if I gave the words in the section their *primâ facie* meaning, and at the same time held that, whenever the article or process was manufactured or carried on to a greater extent abroad than in the United Kingdom, the case was within Sub-section 1. As I have already held that this is not so, there is nothing to justify me in departing from the plain words.

"It has also been suggested that the sub-section only institutes a comparison between what is being done abroad and at home respectively by the patentee, his licensees

and agents, and that what is done otherwise may be left out of account. I cannot think that is the true meaning of the section. Suppose the patentee had no foreign patents, and yet for some reason of his own chose to prevent the industry arising here, while industries in the patented article or process were being developed abroad, I think the section would apply. It seems to me that the section is meant to hit any abuse of the monopoly, the object or result of which was to benefit foreigners at the expense of the traders within the United Kingdom.

"I will pass now to the other sub-section, assuming that the applicant has satisfied the Comptroller that the state of circumstances contemplated by the first sub-section has arisen. The patentee is then clearly on his defence, and must either prove that the article or process is manufactured or carried on in the United Kingdom to an adequate extent, or give satisfactory reasons why it is not so manufactured or carried on. The difficulty in construing these provisions arises from the use of the somewhat elastic expressions 'adequate' and 'satisfactory,' the meaning of which depends largely on the point of view from which the facts which may be proved are considered. In my opinion the Legislature has used these somewhat vague expressions advisedly, it being left to the Comptroller, subject to an appeal to the Court, to determine in each case, and having regard to all the circumstances, whether the extent to which the article or process is manufactured or carried on is adequate, and, if not, whether the reasons put forward are satisfactory. I shall not, therefore, attempt to define the meaning of these expressions, but in considering any case which may arise, there are, in my opinion, one or two general observations which ought to be borne in mind. First, as I have already said, the patentee is on his defence, and this being so I do not think the extent to which the article is manufactured, or the process carried on, can be considered adequate if it be less than it would have been but for the fact that the patentee has exercised the rights conferred by his patent to the hurt of British industry—for example, the fact that he has given the foreign traders a preference over British

Sub-section 2.

"Adequate" and "satisfactory."

traders. Similarly, I do not think that any reasons can be satisfactory which do not account for the inadequacy of the extent to which the patented article is manufactured or the patented process is carried on in this country by causes operating irrespective of any abuse of the monopoly granted by the patent. The first thing, therefore, for the patentee to do is, by full disclosure of the manner in which he has exercised his patent rights, to free himself from all suspicion of having done anything to hamper the industry of the United Kingdom. When once he has satisfied the Comptroller of this, he will have gone a long way towards proving what he has to prove, and even if he cannot prove adequacy, he ought to be able to show satisfactory reasons for inadequacy. This construction of the Act is in accordance with Article II. of the 1902 Convention, which provides that no patent is to be revoked in any country, which is a party to the Convention, until three years at least from the date of application for the patent, and then only if the patentee cannot show reasonable cause for his inaction. It is, therefore, the conduct of the patentee which is in question. Has he done anything which he ought not to have done, or omitted to do anything which he ought to have done, having regard to his obligations towards the traders of this country? In considering the conduct of a patentee various questions may arise as to whether he has or has not exercised his rights fairly and properly, having regard to the interests of the trade of the United Kingdom, and for the most part these questions must be decided with reference to all the circumstances of the particular case, including, I think, the nature of the patented invention. But a patentee certainly ought not to give foreigners any preferential terms in the grant of licences or otherwise, nor ought he to utilise the period prescribed by Sub-section 1 in developing foreign industries as opposed to the industries of the United Kingdom, and at the end of the period seek to defend his conduct by offering to grant licences in this country on the same terms as he has granted them abroad. If he exercises his rights in such a way as to give other countries four years' start of this country in developing a new industry, he is not, in my opinion, exercising his rights fairly as

Article II. of Convention.

Nature of invention must be considered.

regards the trade of this country. He must at least take the same pains to develop the new industry here as he does abroad.

"The question was much discussed as to whether anything more could be required of a patentee than to deal with this and other countries on the same terms and in the same manner, or whether the patentee is bound to exclude foreign goods altogether for the benefit of the trade of this country. It was argued that the mere fact that a patentee has allowed goods made abroad, whether under the patent or resulting from the patented process, to be imported into this country, and to compete in this country with goods made here, is an improper use of his patent rights. In other words, it was argued that the policy of Section 27 is not only to secure fair play for the traders of the United Kingdom, but to give such traders a preference over foreign traders and prevent the latter from entering into competition with the former on equal terms so far as the patentee can, by an exercise of his monopoly, secure inequality. This argument, in effect, asserts that the policy of the Act is a protective and not a free trade policy. Whatever be one's own personal views as to the advantage or disadvantage of a protective policy compared with a free trade policy, I am not prepared to hold that a patentee who has allowed part of the demand in this country to be supplied by the importation of goods from abroad has necessarily precluded himself from proving that the manufacture of the patented article, or the use of the patented process, in this country is adequate within the meaning of the 27th Section, or from giving satisfactory reasons why it is not adequate. If this had been the meaning of the Legislature, I think that, on so important a matter of principle, clearer words would have been used. The policy of the section appears to me to be directed to securing fair play between foreign industries and the industries of this country, and not to secure for the latter during the period of the patent a protection which they would not enjoy if no patent had been granted, and which the Legislature can always secure for them, either temporarily or permanently, if and when it considers fit.

Patentee not bound to exclude foreign goods.

Policy of Act not protective.

Foreign patentee not precluded from partial importation.

Meaning of the term "adequate."

"It follows from what I have said above that 'adequate' cannot mean simply adequate to supply the demand in this country, or be considered only with reference to the demand in this country for the patented article, or the article produced by the patented process. The demand in this country may in some cases not only be a demand for the patented article, but a demand for the patented article as made by a particular firm, or as made abroad. If, for example, the patent be for a new article, and such article be manufactured both here and abroad, and part of the demand here be for the article made abroad, because it is got up more to the taste of a section of the public, I do not think that the manufacture here could on that account alone be said to be inadequate. To so hold would, in effect, be to force a patentee to use his patent rights to exclude altogether the import of foreign goods. I agree that the demand and supply in this country are to be considered, though they are not the only facts to be considered upon the question of adequacy. If there was insufficient manufacture here to meet the demand for the home-made article, it might well be that the manufacture might be held to be inadequate, but, even if there were no demand here at all, the manufacture might be inadequate because the rights of the patentee might have been so exercised as to preclude the growth of a demand by the imposition of unreasonable prices or unreasonable terms for licences, or simply because the patentee had wholly neglected this country in his efforts to develop a foreign trade. Every case must be considered on its own merits and with reference to its own attendant circumstances.

Lack of demand here might arise through default of patentee.

"It was suggested that if a patentee could prove that an industry in a patented article, or founded on a patented process, could not be carried on in this country, or as profitably as it could be carried on abroad owing to difference in the cost of material or labour, or other local conditions, he would have given a satisfactory reason within the the meaning of the section. I do not think this suggestion is entirely correct. Certainly the fact that persons who were carrying on the industry in this country would make smaller profits than persons carrying it on abroad would, in my opinion, be no satisfactory reason at all. I can conceive cases in which a patentee, having obtained a patent,

may find it impossible to work it in the United Kingdom because of the nature of the invention, or because of local conditions which prevail here, but not in other countries, although these cases must, I think, be rare, and may be exceedingly difficult to prove. The extra cost of labour or material may well be counter-balanced by superior skill, or in other ways. But it can never, in my opinion, be sufficient for a patentee, defending himself under the section, to prove that he cannot now start an industry with any chance of profit. The question really is: Could he have done so if he had used his monopoly fairly as between home and foreign trade, or if he had devoted the time and money which he has expended in developing a foreign industry to developing a home industry? It may well be that having developed the industry abroad, and given foreigners several years' start, he may find it difficult, if not impossible, to develop an industry on the same lines here, and yet such an industry might well have arisen but for the preference he has given to foreign countries. It was also suggested that the section only contemplates revocation if revocation would lead to the establishment of a new industry or the further development of an existing industry in this country, so that if the patentee had by an abuse of monopoly succeeded in precluding the possibility of such establishment or development his patent ought not to be revoked. I dissent entirely from this suggestion. I see no reason why the section should not have been intended to penalise a patentee who has abused his monopoly, and by a revocation of the patent this country becomes at any rate free from restraint on its trade which is opposed to the spirit of its Common Law. I desire next to say a word or two upon the arguments addressed to me in support of the proposition that patentees who obtained their patents before the Act of 1897 are in a better position than patentees who obtained their patents after the passing of that Act. These arguments were all founded on this suggestion, that patentees who obtained their patents before the Act had vested interests, and that in default of a provision for compensation I ought to construe the Act, as far as I reasonably can, so as to preserve these interests. Let us see whether there is really any substance in these arguments. The only express

Patents dated before Act have no preferential treatment.

provision in favour of patentees who obtained their patents before the Act consists in the one year limit, a sort of period of grace in which the patentee may, if he desires to save his patent, take means to secure that his patented article is manufactured, or his patented process carried on, in this country. In all other respects the Act puts all patentees in the same position, whether they obtained their patent before or after the Act. It is, in my opinion, impossible to construe the provisions of the Statute in one way as to patents acquired before the Act, and in another way as to patents acquired after the Act. All patentees are subjected to the same liabilities. The only possible distinction between patentees who obtained their patents before, and patentees who obtained their patents after the Act, is that the Comptroller or Court might possibly accept as satisfactory, in the case of the former, reasons for not manufacturing the article or carrying on the process in this country which would be regarded as unsatisfactory in the case of the latter. I am of opinion that to a limited extent there may be reasons satisfactory in the one case which would not be satisfactory in the other, but I totally dissent from the contention that, if a patentee has before the Act precluded himself by contract from working his patent in this country, the existence of such a contract is a satisfactory reason within the meaning of the section for not working here. As I have said before, no such reason can be satisfactory which does not operate independently of any misuse which the patentee has made of his property. There is an historical reason for making no distinction in this respect in favour of existing patents. The mischiefs aimed at by the section arose to a great extent, at any rate, from the patentee exercising his exclusive right of sale without exercising his exclusive right of manufacture, contenting himself with preventing manufacture by others in this country and importing articles manufactured abroad. The Statute of Monopolies reserves only the right of the Crown to grant for fourteen years the sole right of working or making the invention, and says nothing about the sole right of sale. The Crown has, however, always granted by virtue of this reservation the sole right of sale, as well as the sole right of working and making. This has been held to be justified on the

Patents must be treated alike irrespective of date.

Existence of restraining contract no excuse for non-working.

ground that the sole right of sale is an ancillary right to the sole right of manufacture, and it might possibly at one time have been open to the Courts to refuse to protect the sole right of sale unless exercised as an aid to the sole right of manufacture in this country. The form of Letters Patent granted by the Crown has, however, invariably, so far as I can discover, contained a clause providing that if at any time during the term of the patent it should be made to appear to the King, or any six or more members of his Privy Council, that the grant was prejudicial or inconvenient to the King's subjects, the Letters Patent should be void. There is an instance of this clause in a patent granted in 1618, several years before the Statute of Monopolies, and cited in the case of the *Attorney-General* v. *Simpson* (1901, 2 Chancery; at pages 675 and 676), and it appears from that case that the Privy Council entertained jurisdiction under the clause to regulate charges made by the patentee. (See the same case in the House of Lords, 1904 Appeal Cases, at p. 483). In my opinion, Letters Patent have always been voidable under this clause if worked by the patentee to the prejudice or inconvenience of the King's subjects in general, and, but for the fact that the jurisdiction of the Privy Council under this clause has fallen into disuse, a patentee, by abusing his monopoly, would always have incurred the risk of losing his patent rights. This, I think, affords a good reason for the fact that modern legislation, designed to prevent the abuse of patent rights, has never drawn any distinction between existing patents and patents to be granted in future. This was the case with regard to the compulsory licence clause of the Act of 1902, which enabled the Privy Council to revoke a patent in every case in which the patent was worked, or the patented article manufactured, exclusively or mainly outside the United Kingdom, unless the patentee could show that the reasonable requirements of the public had been satisfied, and which provided that such reasonable requirements should not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent, or manufacture his patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, any existing industry, or the establishment of any new industry, was unfairly prejudiced, or the demand

Compulsory liconce clause in Act of 1902.

for the patented article was not reasonably met. These provisions are nearly, if not quite, as drastic as the provisions of Section 27 of the Act of 1907, by which they have been superseded, and were expressly made applicable to existing patents. Unfortunately they were never put into operation, possibly because the procedure by way of petition to the Privy Council was too cumbrous a remedy. If they had been, I doubt whether the necessity for Section 27 of the present Act would have arisen. It would, in my opinion, clearly be wrong to treat a patentee as in a better position under Section 27 of the present Act than he would have been upon petition to the Privy Council under the Act of 1902, and upon such a petition his patent would have been revocable if, by reason of his default in working his patent in this country, or granting licences on reasonable terms, no industry in the patented article or founded on the patented process had arisen in this country, or such an industry had been unfairly hampered.

Patent Rules and procedure.

"Lastly, I desire to make one or two observations on the Patent Rules which govern the procedure before the Comptroller under Section 27 of the Act. As those Rules at present stand, the applicant applies for revocation, merely stating in the application that the patented article is manufactured or the patented process is worked exclusively or mainly abroad, and he need give no evidence in support of his statement, though the onus of satisfying the Comptroller of the truth of these statements rests in the first instance, in my opinion, at any rate, on him. The application is served on the patentee, who has thereupon, within fourteen days, to declare on oath whether the statement is or is not correct; and if he says the statement is incorrect he must further declare on oath to what extent, and in what place the patented article or process is manufactured or carried on within the United Kingdom: and if such extent is inadequate, the reasons for the inadequacy. The applicant has a certain time to file, but need not file, statutory declarations in answer; and then the matter comes before the Comptroller, there being possibly up to this point no evidence that the case is within the section at all, for neither party is bound to give evidence of any manufacture abroad. The question whether the patent is or is not to be revoked is disposed of at the same hearing, and I am told that the

patentee has to open his case and give his evidence before the applicant gives any evidence at all. This procedure clearly and, in my opinion, wrongly, puts the patentee on his defence before the Comptroller has been satisfied by the applicant that the state of affairs contemplated by Sub-section 1 has arisen; and such a procedure, besides being, in my opinion, most unfair to the patentee, is obviously open to very serious abuse. Even if the patented article or process is not manufactured or carried on abroad at all, yet, if anyone makes an application under this section, the unfortunate patentee has to disclose, perhaps to some competitor or intending competitor, particulars of his business which he may not desire to disclose, and to give evidence in defence of his conduct before any case raising a presumption against him has been made out. If, for example, the patent belongs to a firm like Messrs. *Armstrong & Co.* and is for some improvement in some small part of the mechanism of, say, a machine gun, anyone desiring to find out how many of such machine guns were manufactured in this country, might make the necessary application for revocation; and, without tendering any evidence that the case was within the section, force the patentee to disclose on oath the extent to which the article protected by the patent was manufactured in this country. Having obtained that information, he might elect to withdraw the application. Inasmuch as an application under the section can be made by any one, whatever may be his motive, and the section, in effect, penalises patentees who have abused their monopoly, it is, in my opinion, all the more necessary, in order to prevent the section being improperly used, to insist that every applicant shall give at any rate *primâ facie* evidence of the existence of the state of affairs contemplated by Sub-section 1 before the patentee is put to the trouble and expense of finding out and proving the extent to which the patented process or article is manufactured or carried on in this country or abroad, and of explaining and justifying everything he has done since the grant of his patent. It must be remembered that not only can any person apply under the section, but he can apply from time to time as he pleases. Failure on one application would be no bar to another application a year later, and, although the section was no doubt passed in the

Possible abuse of present procedure.

interests of the public, still, if it be worth while retaining any patent system at all in this country, it ought, I think, to be construed to give reasonable protection to patentees; and for this purpose the applicant, who may be a mere common informer, ought to be required to prove what even a common informer has to prove: namely, some case requiring an answer. In my opinion the proper course for the Comptroller to pursue, when he receives an application under Section 27, is to inquire whether the patentee admits that the state of affairs contemplated by Sub-section 1 has arisen. If this is not admitted, he should inquire into the matter in the presence of both parties, and the applicant, being the person on whom the onus lies, should be the first to tender evidence. It may well be that the patentee knows nothing about what is being done abroad, nor what is being done in this country, in the way of manufacturing the patented article or carrying on the patented process. There is no particular reason why he should know what is being done abroad, unless he has foreign patents, or is himself manufacturing the article or carrying on the process abroad. Even as to the extent to which the article or process is being manufactured or carried on here, he may have no information; for he may have sold licences outright, and not confined the use to the reservation of royalties. I do not say that he may not, in the course of the inquiry, be compelled to say what he does know; but at least the applicant ought at first to be called upon to make out some case requiring an answer, and at any rate, until he has given some evidence that the case is within the section, I do not see what answer is required. If, on the other hand, the patentee admits that the state of affairs contemplated in Sub-section 1 has arisen, or if after inquiry the Comptroller is satisfied that it has arisen, the patentee may fairly be called on to state, first, what his defence is, and then to prove it. It would be convenient that, in stating what the defence is, the patentee should state the reasons on which he intends to rely, if the extent to which the patented article or process is manufactured or carried on is inadequate; and the particular facts on which he intends to rely, if he contends that it is adequate. As a general rule, I think that, on appeal, the patentee ought to be confined to his case as made before the Comptroller, and not allowed

Suggested procedure on applications to revoke.

to set up a fresh case or adduce further evidence. In one case which I have heard I did allow further evidence to be adduced, but only on the ground that, until I had construed the Act, patentees could hardly be expected to realise the nature of the burden thrown on them by the section, and the nature of the evidence required to discharge it. But I do not think any such indulgence ought to be granted as a general rule,

Present effect of Patent Rules.

"I should like to point out that, even as the Patent Rules now stand, it appears to me that the Comptroller can call upon the applicant for evidence of the truth of the statement contained in the application, enlarging the time for the patentee to put in his evidence till this is done; and if the applicant does not furnish evidence sufficient to call for an answer, may refuse to proceed further with the matter. Similarly, he can, I think, enlarge the time for filing evidence which can only be relevant for the patentee's defence, until he is satisfied that there is a case for calling on the patentee to defend himself. But under these circumstances it appears to be desirable that the Rules should be altered. It must be remembered that the section is in its nature a penal section, that the patentee is on his trial, that mere accusation raises no presumption of guilt, and that the Comptroller is a Court exercising judicial functions. It is not merely the case of a departmental inquiry. The Comptroller is in the position of a Judge, and not of a commissioner employed to take evidence, and with power to summon before him and examine any person he pleases. The procedure therefore, I think, should be clearly specified in the Rules, and should be a procedure adapted to the circumstances having regard to the onus which the Act throws on the applicant and the patentee respectively.

Desirability of altering Rules.

Necessity for amplifying Rules.

"I come now to the facts of this particular case. The patents in question were granted in 1900 for inventions relating to a process of manufacturing thin imitation stone slabs or tiles—I need not describe the process. The important point is that, though in commercial operation in Germany, France, and Belgium, it has never been worked in this country. Clearly, therefore, the patentee is put on his defence, and the only question is whether he has given satisfactory reasons for this state of affairs. It appears

Facts of *Hatschek's* case.

that, having in 1900 obtained his patent rights and corresponding patents in the countries I have mentioned, he devoted himself to the establishment abroad of industries in which the patented process was carried on; using the monopoly conferred upon him by his patents in this country not for the purpose of establishing a new industry here, but in order to secure to some foreign licensee the monopoly of selling in this country articles manufactured abroad. In my opinion, a new industry might have arisen in this country, but for the manner in which the patentee has exercised his patent rights; but it is quite enough to say that there is no satisfactory evidence that a new industry would not have arisen here if the patentee had exercised his patent rights fairly as between this country and foreign countries. Nothing has been proved, either as to the relative cost of material, or wages, or as to difference in local conditions, which points to the economic impossibility of such an industry having grown up in the United Kingdom if no preference had been conferred on foreigners. Possibly a manufacturer in this country might have had to be content with smaller profits than a manufacturer abroad; but even this is not proved. It was said that the demand here was too small to justify the expense entailed in laying down the necessary plant; but there is no evidence, or at any rate no satisfactory evidence, that the demand would have not been much greater than it is but for the manner in which the patentee has used his monopoly. It is to my mind abundantly clear that, if these patents had been granted after the passing of the Act of 1907, they ought to have been revoked. And the only question is whether, having regard to the fact that they were granted in 1900, and to what occurred before the passing of the Act of 1907, any indulgence ought to be granted to the patentee. It is to be observed that, on the 26th of January, 1905, the patentee granted what is, in effect, an exclusive licence for this country to a manufacturing company in Belgium. The licence provided that the Belgian Company might either import into this country the goods made by them in Belgium, or erect factories here; but the patentee precluded himself from granting licences here. The licensee has exercised the powers granted to him by the licence not to erect factories here, but to import his foreign-made goods

No industry created here.

Improper use of patentee's monopoly.

Exclusive licence for Great Britain to foreign company.

Foreign importation.

into this country—excluding any competition between such goods and the goods made in this country or elsewhere abroad. The state of things which has resulted would, I think, have rendered the patent revocable under the Act of 1902, for it does not seem to me that the patentee could have discharged the onus imposed on him by that Act any more than, in my opinion, he has discharged the onus imposed on him by Section 27 of the existing Act. There is no reason, therefore, why the patentee should be entitled to any indulgence, even if indulgence could be granted. Stress was laid on the fact that the patentee, in conjunction with his licensee, has recently, in advertisements and circulars, expressed his willingness to sell or enter into working arrangements for the manufacture of goods in this country under the patented process. That was, however, done at the last moment, and I am not surprised that under the circumstances no one willing to buy or take a licence has been found. Even if it had been done forthwith, after the Act, and the possibility of a sale being made or licences granted had been made known much more thoroughly in this country, I do not think the fact that no one has been found willing to buy or take up a licence and manufacture here could have proved very much. I do not know what the terms were under which the patentee and his licensee contemplated selling or granting licences, or whether the terms of the licences included protection against Belgian imports. If they did not, possibly manufacturers might very well be deterred by the fact that the Belgian firms had had so long a start, and an intending purchaser or licensee might well be deterred also by the uncertainty of the patent remaining, under the circumstances, unrevoked for a sufficient time to start a new industry.

Patent revocable under Act of 1902.

Death-bed repentance will not avail.

"Under all the circumstances, I think the revocation of the patents was amply justified; and, further, I am of opinion that the refusal of the Comptroller to suspend the revocation of the patent was also right. It would be wrong to suspend the revocation of a patent, merely on the chance of an industry springing up here under some licence which some manufacturer may possibly in future be willing to take. If the patentee himself, or the Belgian licensees had been prepared themselves to start the industry here, and had utilised their year of grace in *bonâ fide* preparations with

that end in view, but had found the year too short a period, the revocation might well have been suspended; but upon the evidence, I do not believe that either the patentee or the Belgian Company has now, or ever had, an intention of manufacturing by the patented process in this country, or of allowing any one else to do so, unless the purchaser or licensee will accept a licence from them on terms which they may consider reasonable, but which possibly no prudent purchaser or licensee would accept, and as to the nature of which I am not informed. I therefore affirm the Comptroller's decision, and dismiss the appeal with costs, including the costs of the Attorney-General."

The Patent Rules to which the learned Judge refers, and in which he recommends that alterations should be made are Rules 78 to 81, which run as follows:—

Revocation of Patents worked outside the United Kingdom.

Revocation of patents worked outside the United Kingdom.

78. An application for the revocation of a patent under Section 27 of the Act shall be made on Patents Form No. 24. The applicant shall simultaneously with, or as soon as may be after, the leaving of such application at the Office deliver, or cause to be delivered, to the patentee or his agent a copy of such application, and furnish the Comptroller with evidence of such delivery.

Procedure.

79. The patentee shall within fourteen days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what place the patented article or process is manufactured or carried on in the United Kingdom; and setting out in the event of the article or process not being manufactured or carried on in the United Kingdom to an adequate extent, the reasons why it is not so manufactured or carried on. The patentee shall deliver, or cause to be delivered, copies of such evidence to the applicant, and furnish the Comptroller with evidence of such delivery.

Within fourteen days from the delivery of such copies, or within such further time as the Comptroller may allow, the applicant shall, if he decides to proceed with his application, leave at the Office statutory declarations in answer, and on so leaving shall deliver to the patentee or his agent copies thereof, and furnish the Comptroller with evidence of such delivery.

Closing of evidence.

80. No further evidence shall be left at the Office on either side except by leave, or on the requisition of the Comptroller, and upon such terms, if any, as the Comptroller may think fit.

81. On completion of the evidence or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and give the parties ten days' notice at least of such appointment and in the event of deciding to take evidence *viva voce* in lieu of or in addition to the evidence by declaration, or to allow any declarant to be cross-examined on his declaration, he may require the attendance of any declarant or other person whose evidence he may consider desirable. Hearing.

These Rules have not been altered, but in accordance with the suggestions of the Court in *Hatschek's Patent*, certain additional Rules of Procedure were prepared and advertised in the *Patents Journal* of the 28th of April, 1909. It will be seen that the possible abuse of proceedings pointed out by the Judge is provided against by the new procedure, which is to the following effect:—

Procedure under Section 27 and Patents Rules 78 to 81.

In all cases of applications for revocation under Section 27 the following procedure will in future be adopted:—

(1) The applicant should, simultaneously with his application on Patents Form 24, leave at the Office evidence by way of statutory declaration, stating the particulars upon which he relies in support of the allegations contained in the application; the copy of the application delivered to the patentee or his agent, in accordance with Patents Rule 78, should be accompanied with copies of such evidence. Applicant must give particulars of his allegations.

(2) The patentee should, within fourteen days from the delivery of such copy or within such further time as the Comptroller may allow, leave at the Office evidence by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and if they are incorrect, giving the particulars upon which he intends to rely in answer to the allegations made by the applicant. Copies of such evidence should at the same time be delivered to the applicant. Patentee's reply with particulars.

(3) Should the applicant then decide to proceed with his application, he may then leave and deliver further statutory declarations in answer, in accordance with the provisions of the latter part of Rule 79. Applicant's further declarations.

(4) The Comptroller will then intimate to the parties whether, having regard to the circumstances of the case, he considers it desirable and intends to hold a preliminary hearing on the question whether a *primâ facie* case has been made in support of the allegations in the application or whether he intends in ordinary course to deal at one hearing with the whole case, including the further questions whether the patentee can prove that the patented article or process is manufactured or carried Comptroller to decide whether *primâ facie* case made out.

on to an adequate extent in the United Kingdom, or can give satisfactory reasons why the article or process is not so manufactured or carried on.

Procedure following preliminary hearing.

(5) Should the Comptroller think fit to hold a preliminary hearing as aforesaid, and as a result of such hearing decide that a *prima facie* case has been made in support of the allegations in the application, or should he determine to proceed in ordinary course to deal at one hearing with the whole case including the further questions mentioned in Head (4), then, and in either of the said cases, he will give to the patentee further time for leaving at the Office and delivering to the applicant, pursuant to Rule 79, evidence by way of statutory declaration with regard to such further questions or either of them, and will subsequently give to the applicant under Rule 79, and thereafter if necessary to the patentee under Rule 80, further time for leaving further evidence by way of statutory declaration with regard to such questions or either of them in answer or reply as the case may be.

Costs, where the application is uncontested.

(6) In the event of an application under Section 27 being uncontested by the patentee, the Comptroller in deciding whether costs should be awarded to the applicant will consider whether proceedings under the section might have been avoided, if reasonable notice had been given by the applicant to the patentee before the application was filed.

W. TEMPLE FRANKS,
Comptroller-General.

NOTE.—The above procedure, with the necessary modifications, will apply to applications under Section 58 (Cancellation of Designs manufactured exclusively or mainly abroad).

Bremer's Patents.

The other revocation case to which Parker, J., referred in his decision on *Hatschek's Patent*, was an appeal from the Comptroller in the matter of *Bremer's and Högner's Patents*, (1909, 26 R. P. C. 449). An application had been made to the Comptroller under Section 27, by G. B., a manufacturer and exporter, carrying on business in London, to revoke a patent for "Improvements in electric arc lamps" granted to H. B., on the ground that the patented article was manufactured exclusively or mainly outside the United Kingdom. The application was opposed by the proprietors of the patent. The lamps were alleged to be made to some extent in England by the proprietors of the patent, but were admittedly imported to a much larger extent by their licensees, who did not manufacture in the United Kingdom. The licensees were a German Company, who under their

Facts in *Bremer's Patents.*

licence paid a royalty to the proprietors of the patent on every lamp made under the patent and imported by them. It was contended before the Comptroller that adequate working exists when the patentees supply such demand as remains after the importation of large numbers of the patented article, and in support of this contention Article 5 of the International Convention of 1883 was relied on. It was further contended that the proprietors of the patent had no control over their licensees, and that the existence of the licence, which could not expire until 1911, was a satisfactory reason why the patented article was not manufactured to a greater extent in the United Kingdom.

Högner's Patent.

An application was made under the same section, and on the same ground by G. B., to revoke a patent for "Improvements in electric arc lamps" granted to P. H. The application was opposed by a German Company, who employed the grantee as chief engineer, and it was agreed that under the circumstances they should be treated as the patentees for the purposes of the case. The lamps were made to a comparatively small extent by licensees of the patentees in England, but they were imported to a very large extent by an English Company, the lamps so imported being made by the patentees in Germany. The patentees alleged infringement of the patent by numerous English manufacturers, against whom no proceedings had been taken under the patent, and contended that, taking into consideration the infringing lamps, more lamps were made in the United Kingdom than abroad.

It was held by the Comptroller, on the second application, that the patented article had been manufactured mainly outside the United Kingdom; and on each of the applications that it had not been proved that the patented article had been manufactured to an adequate extent in the United Kingdom; and that satisfactory reasons had not been given why it had not been so manufactured. In each case an order was made revoking the patent forthwith, and seventy-five guineas costs were in each case awarded to the applicant.

Leave to adduce further evidence.

The respondents to each application appealed, and in one case obtained leave to adduce further evidence on the appeal.

***Bonâ fide* attempt to establish industry.**

Held, by Parker, J., that, as to the patent of H. B., the patentees were making a *bonâ fide* attempt to establish in

this country an industry in arc lamps, and that the licence granted by them was conducive to that end; that the Patents &c. Act of 1907 was not intended to penalise want of success where a patentee had done his best; and, as to the patent of P. H., that the reasons given for the smallness of the extent to which the patent had been worked were satisfactory; and that neither of the patents ought to be revoked. The decisions of the Comptroller were reversed, but his directions as to costs were undisturbed. No costs of the appeals were allowed, except those of the Attorney-General, which were ordered to be borne, in each case, equally by the applicant and the respondents.

Result of decisions.

The result of these decisions of the Court has been largely to modify the more stringent practice of the Comptroller, and the section is now being construed in a very reasonable and fair spirit. The question of the "adequacy" of the manufacture and the "satisfactory" nature of the reasons for non-manufacture obtains careful consideration. The circumstances of each case are weighed and given their just value, and although it may be long before the section is exhaustively construed and applied relatively to every contingency, at least the main principles of its application have already been ascertained. In *Osborn's Patent* (1909, 26 R. P. C. 819) the Comptroller refused to revoke the patent, although its non-working in the United Kingdom was admitted. The reason given was that the patent was of little or no commercial value, and that there was no demand for it in this country. These reasons were held to be sufficiently satisfactory.

Osborn's Patent

No commercial value.

It will be noted that Parker, J., in his decision in *Hatschek's Patent*, expresses the opinion that, had the Compulsory Licence Clause of the Act of 1902 been less cumbrous and unsatisfactory in its operation, the necessity for Section 27 of the Act of 1907 would probably never have arisen. Unfortunately, as the learned Judge points out, the procedure in the Act of 1902 was by petition to the Privy Council, a tribunal unsuited for such proceedings and which had already been proved and found wanting in the hearing of petitions for prolongation. Thus the 1902 Compulsory Licence Clause never had a fair trial. It must be remembered that under the 1902 Act revocation could be ordered as an alternative to a compulsory licence, but

Parker, J., on the Compulsory Licence Clause of 1902.

only as a last resource. One cannot help wondering whether the re-enactment alone of this milder provision, with a simplified and cheaper procedure, would not have acted more fairly than the statutory destruction of patents that has taken place under Section 27, often at the instance of applicants whose notices are purely selfish, and, in isolated cases, merely vindictive. Probably, as time goes on, a still more benevolent interpretation of "adequate" manufacture and "satisfactory" reasons for non-manufacture will arise. Already the Comptroller refuses to revoke patents which would certainly have gone, under the earlier practice. In *Weber's Patent* (1909, 26 R. P. C. 300) where it was admitted that the process had been carried on exclusively abroad, the circumstances were such that the Comptroller held over revocation for eight months, and on the resumption of the hearing (27 R. P. C. 30) held that the patentee had satisfied the section. In *Boult's Patent* (1909, 26 R. P. C. 383) it was admitted there was no manufacture in the United Kingdom at the date of the application, but shown that at the date of the hearing there was a manufacture sufficient to meet a considerable portion of the British demand. Revocation was refused. In *Lake's Patent* (1909, 26 R. P. C. 443) the applicants alleged that the sound boxes (old in form) of a sound-magnifying horn, which was the novel part of a claimed combination of horn and box, were all manufactured abroad, though the horn itself was substantially manufactured here. The patentee alleged that the horn was the only "patented article" under the section which it was obligatory to manufacture here, and further, disputed the *locus standi* of the applicant as he had raised no *primâ facie* case. Held, by the Comptroller, that on a proper construction of the specification, the real invention of the patentee was the improved sound-magnifying horn, and that although a sound box was claimed in combination, there was no claim for any special form of sound box; that it was not necessary therefore for the sound box to be manufactured in this country to escape the provisions of Section 27: that the evidence adduced by the applicant was irrelevant and insufficient to discharge the onus cast upon him under Sub-section 1. The application was therefore dismissed with costs.

Revocation held over to allow of working.

Partial satisfaction of the section.

Manufacture of the claimed part of combination.

Applicant must now make out *primâ facie* case.

In the same case it was held that until a *primâ facie* case is made out by the applicant under Sub-section 1 of Section 27 in accordance with the decision in *Hatschek's Case*, and the new rules founded thereon, the patentee cannot be called upon to produce his witnesses for cross-examination, or for examination by the Comptroller.

Nature of invention to be considered.

The nature of the invention and the demand in the United Kingdom will always influence the question of "adequate" manufacture or "satisfactory" reasons for deficiencies in this respect. Thus, in *Kent's Patent* (1909, 26 R. P. C. 666), there had been one milling machine only made in Great Britain before the application. But the demand here did not exceed two machines per annum. Manufacturing agents had been appointed in Great Britain, and were prepared to turn out any number required. Revocation was refused. (See also *Boult's Patent*, 1909, 25 R. P. C. 383.)

Surrender of patent.

When the patentee acts promptly in notifying his intention not to contest the application he may escape the imposition of costs. (*Taylor's Patent*, 1909, 26 R. P. C. 381.)

Preliminary notice to patentee.

By Rule 6 of the new procedure (*supra*) the Comptroller, in considering the question of costs, will take into account whether proceedings might not have been avoided by reasonable notice given by the applicant to the patentee before filing the application.

Appeals.

Appeals from the decision of the Comptroller upon applications to revoke made under this section are made to the Court, and the decision of the Court is final (see Section 92).

Commercial effect of Section 27.

Although there is a considerable division of opinion as to the wisdom and ultimate effects of Section 27, the practical result has been that many factories have been built, occupied, and put to work in this country by foreigners for the purpose of carrying on new manufactures of their patented goods within the realm, in accordance with the Statute.

Revocation by petition.

(3) *Revocation by Petition to the Court.*

This is governed by Section 25 of the Act, which provides that—

25. (1) Revocation of a patent may be obtained on petition to the Court.

(2) Every ground on which—

(*a*) A patent might, immediately before the First day of January, One thousand eight hundred and eighty-four, have been repealed by *Scire Facias*; or

(*b*) A patent may be revoked under this Act either by the Comptroller or as an alternative to the grant of a compulsory licence;

shall be available by way of defence to an action of infringement, and shall also be a ground of revocation under this section.

(3) A petition for revocation of a patent may be presented— Persons entitled to petition.

(*a*) By the Attorney-General or any person authorised by him; or

(*b*) By any person alleging—

(i) That the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) 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; or

(iii) 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.

Clause (*b*) of Sub-section 2 extends the grounds of revocation, and is new. A consideration of this clause will involve referring again to the grounds upon which the Comptroller may revoke a patent under Sections 26 and 27 as well as those upon which the Court might order revocation under Section 24. Clause (*b*) Sub-section 2.

First as to the grounds under Clause (*a*) of Sub-section 2, these as will be seen from Clause (*b*) of Sub-section 3, are the old grounds from the Act of 1883.

Scire Facias abolished.

The action of *Scire Facias* having been abolished by the Act of 1883, revocation of a patent was then, as it may be 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, and grounds of revocation.

Summarizing the different enabling sections of the Act, 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; or by—

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 any invention included in the claim of the patentee.

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 always 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; *Müller's Patent*, 1907, 24 R. P. C. 465).

Petitioner's grounds.

In *Morgan's Patent* (*supra*), Chitty, J., held that, granted the petitioner is qualified to present the petition himself as of right 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.

Costs.

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 (*Vicker's Application, re Siddell's Patent*, Griff. P. C. 320).

In Scotland by action of reduction.

Section 94 (Sub-section 4) of the Patent Act provides with reference to proceedings in Scotland that—

> "Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown

only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of the Act."

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.

Master and servant.

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 (see also *Ralston's Patent*, 1909, 26 R. P. C. 313).

Substitution of true inventor as patentee (Section 15, Sub-section 2).

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 the patent revoked, and expiring at the same time as the original revoked patent would have expired (Section 15, Sub-section 2). But it is provided that no action shall be brought for any infringement of the patent so granted, committed before the actual date when such new patent was

granted. In lieu of transferring the patent to the successful petitioner as indicated, the Court may declare the defendant, or respondent, trustee for the plaintiff in respect of such patents, British or foreign, as the defendant or respondent may have obtained (*Richmond* v. *Wrightson*, 1904, 22 R. P. C. 25).

Wrongful patentee made trustee for plaintiff.

Apart from fraud, where the petitioner merely 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 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

Prior public user.

Use in private house.

as would serve as a successful defence in an action for infringement. In *Edmund'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 (see Order 53A. R. S. C. Rule 18). 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.

Cost of particulars must be certified.

By the new Order 53A (Rule 22) the costs of the particulars accompanying the petition will not be allowed by the Taxing Master unless certified by the Judge. Formerly in revocation proceedings these need not have been so certified.

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 25, Sub-section 2, Clause (*a*)).

Pharmacy Act.

The fact that the patent was taken out to evade the provisions of the Pharmacy Act is not a ground for revocation (*Paisay's Patent*, 1894, 11 R. P. C. 591).

Petitioner cannot plead estoppel on respondent's patent.

A defendant in an infringement action, in which certain of the patentee's claims have been held bad, cannot, in the event of his petitioning for revocation, set up that the patentee is estopped by the former judgment from denying that the said claims are bad (*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 may amend bad patent.

Under Section 22 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 22 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 (*Heipel's Patent*, 1904, 21 R. P. C. 379). Chapter XVIII., on "The Amendment of the Specification," gives further information on these points.

Conditions of amendment.

It will be noted that Section 22 admits of amendment by disclaimer only.

Limits of amendment.

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 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).

Order of procedure at hearing.

When an order of revocation has been made, the order is taken to the Comptroller at the Patent Office by the

Revocation order should be noted on Register.

successful petitioner, and a note of revocation is placed on the Register.

Appeal.

Revocation of a patent may be stayed pending appeal to the Court of Appeal and the House of Lords. This right of appeal beyond the Court of First Instance was expressly preserved or rather reinstated by The Patents and Designs Act, 1908. The necessity of this Act arose from the faulty wording of Section 92 of the Act of 1907. The

Act of 1908.

operative section of the Act of 1908 is that:—

> "It is hereby declared that so much of Sub-section 2 of Section 92 of The Patents and Designs Act, 1907, as provides that a decision of a Judge of the High Court to whom a petition is presented by virtue of that Act is to be final, does not apply in the case of a petition for the revocation of a patent under Section 25 of that Act."

Further grounds of revocation.

Having thus discussed the grounds of revocation under Clause (*a*) of Sub-section 2 of Section 25, viz., the grounds covered by the old action of *Scire Facias*, we next proceed to Clause (*b*), under which a patent may be revoked (1) either upon the gromnds on which it might have been revoked by the Comptroller; or (2) on the grounds upon which it might be revoked as an alternative to the grant of a compulsory licence, *i.e.*, by the Court.

The grounds by virtue of which a patent might be revoked by the Comptroller are those under Sections 26 and 27. The grounds under Section 26 are those set out in Section 11, and must be such as would, if sustained. have justified the Comptroller in refusing the grant had opposition been entered under Section 11.

Shortly, these grounds are:—

(1) That the respondent had obtained the invention from the petitioner or from a person of whom the petitioner is the legal representative, *i.e.* the executor or administrator of the deceased inventor.

(2) That the respondent's invention has been claimed in a patent of prior date. (Here the petitioner would require to show an interest.)

(3) That the respondent's invention is not sufficiently or fairly ascertained. (Petitioner's interest must be shown.)

(4) That the respondent's specification includes an invention of the petitioner or the person he represents, which invention was protected in the interim between the respondent's Provisional and Complete.

The effect of these grounds has already been discussed in Chapter XV. ("Opposition to Grant of Patent") and in the first part of the present chapter. When employed in petitioning the Court for revocation they would form the materials for the particulars of objections accompanying the petition, and would be given in evidence at the hearing. Again, it would seem that, to render these grounds effective, the petition in which they appear would require to be lodged within two years of the date of the patent (see Section 26).

Time limit of certain grounds.

So, also, the grounds under Section 27, viz., non-manufacture within the United Kingdom, could not be included in a petition lodged earlier than four years from the date of the respondent's patent.

The other ground for revocation by petition, under Clause (*b*) of Sub-section 2 of Section 25, is that the patent may be revoked under this section as an alternative to the grant of a compulsory licence. Here, again, it appears that no order for revocation could be made before the expiry of three years from the date of the respondent's patent.

Some of these grounds under Clause (*b*) of Sub-section 2 overlap the grounds for revocation under Clause (*a*), and most of those that remain are so embarrassing as to time and circumstance, and so little likely to prove effective (except, perhaps, the grounds under Section 27) that petitions under Clause (*b*) are not likely to materialise in many cases into active practice.

Proceedings in respect of compulsory licences, and the circumstances which might lead to the alternative of the revocation of the patent by the Court, as provided in Sub-section 3 of Section 24, will be discussed in Chapter XXIII., on "Licences."

(4) *Revocation by the Court on defendant's counterclaim in action for infringement.*

Revocation by counter-claim.

Section 32 of the Act provides that:—

32. A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for

the revocation of a patent, may, without presenting such a petition, apply in accordance with the Rules of the Supreme Court by way of counterclaim in the action, for the revocation of the patent.

Until the coming into effect of the present Act, the only way a defendant could obtain revocation of the plaintiff's patent was by a separate petition. Now he may seek revocation by way of counterclaim. But note: he must be a person entitled as of right to present a petition (see Section 25). If he is not, he should obtain the fiat of the Attorney-General, and then proceed with his counterclaim. This power of counterclaiming for revocation was introduced to save costs in those cases where it was desirable to seek revocation of the patent. It must be remembered that although the defence might prove the absolute invalidity of the patent, this did not operate to revoke, and the owner of an invalid patent might pay the renewal taxes and might with impunity continue to advertise his goods as "Patent," often to the detriment of his successful opponent, who could only get rid of the nuisance by a petition for revocation.

Defendant may require fiat of A.-G.

In prosecuting a counterclaim for revocation, Rule 15 of Order 53A says:—"A defendant in an action for infringement of a patent who, under Section 32 of the Act, counterclaims in the action for the revocation of the patent shall, with his counterclaim, deliver particulars of any objection to the validity of the patent on which he relies in support of his counterclaim."

Order 53A, Rule 15.

Particulars of objection.

According to Rule 17 of the same order, these particulars must state every ground upon which the validity of the patent is disputed, or must give such particulars as will clearly define every issue which it is intended to raise.

For instructions as to the degree of particularity with which objections as to want of novelty must be stated, the reader is referred to Rule 18 of Order 53A, and to Chapter XVIII., on "Action for Infringement."

Amendment of specification.

Just as in a petition for revocation, the patentee may amend his specification on leave being obtained from the Court on the usual terms.

CHAPTER XX.

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. *Hinde* (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.

Section 32 of the Act of 1883, gave a remedy against such threats which was largely taken advantage of, and now Section 36 of the present Act almost repeats the terms of the older section.

Section 36 runs as follows:—

Section 36.

36. (1) Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damages, (if any) as he has sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not, in fact, an

infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Threats must now be backed by action.

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

Grounds for threats.

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

A general warning not a threat.

As Bowen, L. J., put it, in *Challender* v. *Royle* (1887, 4 R. P. C. 363; L. R. 36 Ch. D. 425): "A merely general warning to pirates not to pirate and to infringers not to infringe," coupled with an intimation that the patentee has a patent which he means to enforce, is not in itself an actionable threat. But it depends on the manner in which even such a general statement is circulated, and on the class of persons to whose notice it is brought. Thus, a general notice that violations of a certain patent were rife, and that

But may be made so by circumstances.

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 (*Herburger* v. *Squire*, 1888, 5 R. P. C. 581). As to the possible effect of general advertisements see also the remarks of Bowen, L. J., in *Skinner* v. *Perry* (1892, 10 R. P. C., at p. 8). The gist of the decisions and *obiter dicta* in the matter may be summed up in this, that although *primâ facie* a mere general advertisement or circular is not in itself an actionable threat, still the manner in which it is put forward or distributed, the circumstances

which surround it, and the ascertainable evidence of *mala fides* or malice will all be considered and weighed.

One threat enough.

Threats or a threat—for only one threat has led to the granting of an injunction (see *Webb* v. *Levinstein*, 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 or patent agent'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; *Craig* v. *Dowding*, 1908, 25 R. P. C. 259).

By letter.

Solicitor's letter.

To customers.

Such letters may be sent to the principals or to their customers (*Dowson* 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 (*Douglas* 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 (*Dowson* 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).

Verbal threat.

Reply to enquiry.

Remedy of persons threatened.

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 *Herbarger* v. *Squire*, 1888, 5 R. P. C. 581); and it is now settled practice that such can be done. The plaintiff must give particulars of the threats complained of; and where these have been verbal statements made by the defendant's

Threatened persons may challenge validity of patent.

Particulars of threats.

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 patent attacked, particulars of objection required.

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 other grounds upon which he depends.

Defence.

If the plaintiff does not challenge the validity of the patent, the defendant (although not bound to do so) must almost of necessity, by way of counterclaim, assert infringement of his patent and the validity thereof, seeing that, according to the section, no injunction or damages can be obtained by the plaintiff if the defendant succeeds in showing that, in fact, the defendant has a valid patent, and that the plaintiff has infringed it.

Counter-claim for injunction and damages.

By his counter-claim 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).

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 (*Herburger* 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

Due diligence.

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.

Separate actions discouraged.

As to the expediency of pressing to trial two separate actions, one for restraint of threats by the threatened party, and another for infringement of his patent by the party threatening, the Lord Chancellor and Lords Justices Cotton and Fry, in *Automatic Machine Co.* v. *Combined Weighing Machine Co.* (1889, 6 R. P. C. 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."

Procedure advisable in threats actions.

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

been tried out. Of course, if he succeeds in establishing infringement and validity, the threats action is gone.

Example of apparent delay held to be due diligence.

If the parties have been in correspondence for a long time, and the threatened parties at last take action for restraint, a cross action taken by the patentee after inspection has been held to have been taken with due diligence, although three years had passed since the initial threat (*Edlin* v. *Pneumatic Tyre Agency*, 1893, 10 R. P. C., at p. 316). But this is only in consonnce 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,

Example where due diligence held absent.

if it is evident that the action is not taken *bonâ fide* but only to comply technically with the section, or if it is evident that the action would never have been taken had not the patentee's hand been forced by the threats action, the Court might declare that there was no due diligence (*Appleby's Twin Roller Chain Co.* v. *Eadie*, 1899, 16 R. P. C., at p. 330; see also Cotton, L. J., on *bona fides* in respect of such actions, *Challender* v. *Royle* (*supra*), and Cozens-Hardy, M. R., in *Craig* v. *Hoarding*, 1908, 25 R. P. C., p. 263).

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

One action will do.

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

Action not brought *bonâ fide*.

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. But although threats neither withdrawn nor qualified are "continuing threats" (*Driffield* v. *Waterloo Mills Co.*, 1886, L. R. 31 Ch. D., p. 643) a patentee who has brought his action with due diligence and has discontinued, cannot be forced to withdraw or qualify such threats, unless *mala fides* at the time the threats were issued can be proved (*English and American Machinery Co.*

v. *Gare*, 1894, 11 R. P. C. 627). Chitty, J., when his attention was directed to the *Fusee Vesta Co.* v. *Bryant & May* (1887, 4 R. P. C. 189), pointed out that in that case the threats were made subsequent to the temporary stay of the action.

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 that there was no evidence to show that the second action brought by the patentee was not being prosecuted with due diligence. In *Craig* v. *Dowding* (*supra*) Kekewich, J., held that the patentee's action was only a sham, but the Court of Appeal held there was no evidence of this.

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. It seems uncertain whether a

Threats *pendente lite*.

patentee who has brought and prosecuted his action with "due diligence" is to be allowed to issue fresh threats while

the infringement action is pending. The Courts are rather inclined to look askance on such renewed threats. As Kekewick, J., said in *Fenner* v. *Wilson* (1893, 10 R. P. C. 283), it is hardly "playing the game." And an undertaking is sometimes extracted from the patentee that he will discontinue such threats (*Goulard* v. *Gibbs*, 1887, 4 R. P. C. 181). When the infringement action is hung up for a time by the patentee pausing to amend his specification, fresh threats will certainly be restrained (*Fusee Vesta Co.* v. *Bryant & May*, 1887, 4 R. P. C. 189), and such restraint should be incorporated in the order giving leave to disclaim (*Alsop's Patent*, 1906, 23 R. P. C., page 78).

Threats by defeated patentee.

A fortiori it may be taken that a defeated patentee, who has brought his action and had his patent declared invalid, will not be allowed to issue threats subsequent to the adverse judgment, although he may have appealed. This point has, however, not been directly decided.

A plaintiff in a threats action might join with it the old Common Law action referred to at the beginning of the chapter, but damages and an injunction cannot be obtained under this head unless the plaintiff can prove *mala fides* on the part of the defendant (*Sugg* v. *Bray*, 1885, 2 R. P. C. 223).

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 (*Hoffmann* 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 XXI.

PROLONGATION OF PATENTS.

Reasons for prolongation.

It sometimes happens that, owing to difficulties and drawbacks beyond the control of the patentee, he has failed to realise an adequate return from his invention during the fourteen years of patent right. In such circumstances, if the patent is of importance and is meritorious, he might apply for an extension of the term, and in earlier days this was usually obtained by a special Act of Parliament. Owing to the great cost of such a mode of extension the jurisdiction in such matters was handed over to the Privy Council, and the power of this tribunal to grant extensions was confirmed by Section 25 of the Act of 1883.

Former jurisdiction of Privy Council.

Disadvantages of Privy Council as tribunal.

But experience of the working of the Privy Council in hearing petitions soon uncovered defects that militated greatly against its usefulness. It is essentially an Appeal Court and is ill adapted for undertaking the investigations of figures and for dealing with *viva voce* evidence that must govern its decision. Its time was precious and the interests with which it dealt in considering petitions were purely private. Everything must go without jar or stop or the petition was wrecked. The accounts must be full, accurate, and easily understood, for, if their Lordships could not themselves grasp them, they had no Official Referees or Masters to whom the accounts could be submitted for unravelling. No application for adjournment to amplify and render the accounts more clear was ever entertained (*Peach's Patent*, 1901, 19 R. P. C. 65). And if the accounts were considered insufficient the petition was dismissed at once (*Hughes' Patent*, 1898, 15 R. P. C. 370). The limitations of the Privy Council for hearing these petitions became in the end so apparent that, in framing the present Act, their jurisdiction was transferred to the Court, where, there is no doubt, a meritorious petitioner will have a fair and patient hearing, and will not have his petition thrown out on a mere technicality or informality.

Petitions now heard by Court.

Patentee may petition the Court for prolongation.

In pursuance of this change of tribunal, Section 18 of the new Act of 1907 provides that a patentee may present a petition to the Court 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.

Grounds for prolongation.

Sub-section 5 is to the effect that if it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of the patent for a further term, not exceeding seven or, in exceptional cases, fourteen years; or may order the grant of a new patent for such term as may be specified in the order, and containing any restriction, conditions, and provisions the Court may think fit.

"Patentee" means those entitled to benefit of patent.

As the term "patentee" includes, under Section 93, 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 assignee of a patentee who has sold his interest. An assignee is not, however, to be placed on the same favourable footing as the original patentee, and if the patentee has been paid a reasonable sum for his patent the assignee cannot be favourably considered because he has made a bad bargain (*Hopkinson's Patent*, 1896, 14 R. P. C. 5). A mortgagee 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.

Position of assignee.

Mortgagee.

The Section *in extenso* runs as follows:—

Section 18.

18. (1) A patentee may, after advertising in manner provided by the Rules of the Supreme Court his intention to do so, present a petition to the Court 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 give notice to the Court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice

of objection shall be made parties to the proceeding, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the Court.

(4) The Court, in considering its decision, shall 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 it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the Court may think fit.

Statement in petition must be full and exact.

In presenting a petition for extension, the applicant must state fully and fairly everything relating to the patent, and be prepared with complete sets of profit and loss accounts, so that approximately exact results of the working under the patent may be laid before the Court (*Saxby's Patent*, 1870, Good. P. C. 565; *Bell'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). Any suppression or confusion will result in the dismissal 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; *Laurence's Patent*, 1910, 27 R. P. C. 252).

Profit and loss accounts must be full and exact.

Bona fides of petitioner.

It is much better to state an apparently damaging fact plainly rather than to try to suppress it.

Time for presenting petition.

A petition for the extension of a patent requires to be presented at least 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 the 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).

Order 53A, Rule 3.

Order 53A of the Rules of the Supreme Court contains the new Rule 3 governing the procedure in petitions for extension under Section 18 of the Act. The Rule is divided into clauses lettered from (*a*) to (*x*) inclusive, and these clauses are as follows:—

Procedure.

(*a*) A party intending to apply by petition, under Section 18 of the Act, shall give public notice by advertising three times in the *London Gazette*, and once at least in a London daily newspaper, the price of which is not less than one penny.

Advertisement.

(*b*) 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 *such* place of business, then, if he carries on the manufacture of anything made under his specification in the United Kingdom 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 *such* place of business, and carries on no such manufacture in the United Kingdom, then, if he resides in the United Kingdom at a distance of fifty miles or more of Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

Local requirements in advertising.

Notice of application to fix hearing.

(*c*) The applicant shall in his advertisements state the object of his petition, and shall give notice of the day (which, if the Court is for the time being a Judge of the Chancery Division, shall be an ordinary petition day) on which he intends to apply to the Court for a day to be fixed before which the petition shall not be in the paper for hearing (hereinafter called "the appointed day"), which first mentioned 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*. Every such advertisement shall state an address within the United Kingdom for service on the applicant of any document requiring service under this Rule. He shall also give notice that notices of objection must be lodged as hereinafter provided [*on or*] before such day so named in the said advertisements. A copy of such advertisement shall be forwarded by the applicant to the Solicitor for the Board of Trade at the same time as the first advertisement is sent to

the *London Gazette*, and the Board of Trade shall thereupon cause such advertisement to be inserted in the three following issues of the *Illustrated Official Journal* (*Patents*).

Presentation of petition.

(*d*) A petition, under Section 18 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*, and a copy of the petition must within the same time be furnished to the Solicitor to the Board of Trade. Such petition shall be made returnable for the day named in the advertisements.

Copy for Board of Trade.

Affidavit of advertisement.

(*e*) The petition must be accompanied by an affidavit or affidavits of advertisements having been published by the petitioner according to the requirements of Rules (*a*), (*b*), and (*c*) hereof. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

Entry in List.

(*f*) Upon the day named in the advertisements the petition shall appear in the Court List, and the petitioner shall apply to the Court to fix the appointed day.

Advertisement of hearing.

(*g*) The petitioner shall forthwith after the appointed day has been fixed give public notice of the same by advertising once at least in the *London Gazette*.

Copies of petition and specification lodged at Judge's Chambers.

(*h*) A party presenting a petition, under Section 18 of the Act, must lodge as hereinafter provided a copy thereof with two printed copies of the specification of his patent.

Copies of accounts lodged at Judge's Chambers.

(*i*) The petitioner shall also lodge as hereinafter provided, not less than three weeks before the appointed day, two 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 Court at the hearing. He shall also at the same time furnish three copies of the specification and of the said balance sheet to the Solicitor to the Board of Trade, and shall, upon receiving two days' notice, give the Solicitor to the Board of Trade, 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 or from which the materials for making up the said balance sheet have been derived.

Copies for Board of Trade.

Opposition to petition.

(*j*) Any person desirous of opposing the prayer of a petition, under Section 18 of the Act, shall lodge as hereinafter provided a notice that he intends so to oppose, and giving an address in the United Kingdom for service of any document requiring service under this Rule. Such person shall at the same time serve upon the petitioner a copy of such notice. Such notices shall be respectively

lodged and served before the day named in the petitioner's advertisements as that on which he intends to apply to the Court for the appointed day to be fixed.

Copy of petition to opponent.

(*k*) The petitioner shall forthwith upon receipt of such notice serve a copy of his petition upon each person giving such notice.

Copies of opponent's objections for Board of Trade.

(*l*) Every person giving such notice as aforesaid shall, within three weeks after service of the petition upon him, lodge, as hereinafter provided, two copies, and serve upon the petitioner one copy, and lodge with the Solicitor of the Board of Trade three copies in writing of particulars of the objections upon which he intends to rely against the granting of the prayer of the petition.

Abandonment of opposition.

(*m*) Any person who shall not, within the said three weeks, lodge and serve such particulars of objections as aforesaid shall be deemed to have abandoned his opposition.

Opposition limited to grounds set forth.

(*n*) No person who has delivered such particulars of objections shall be entitled to oppose the granting of the prayer of the petition on any grounds not stated in such particulars.

Notice of hearing to opponent.

(*o*) Any person who has lodged notice that he intends to oppose the granting of the prayer of the petition shall be entitled to be heard on the application to fix the appointed day, and every person who has lodged and served particulars of objection shall be served by the petitioner with notice of the appointed day.

Setting down, and affidavit of service.

(*p*) The petition shall not be entered in the list for trial until the expiration of the time limited for the lodging and service of the particulars of objections, and shall only be entered for trial on the lodging of an affidavit on behalf of the petitioner that all persons who have served him with notice of intention to oppose the prayer of his petition have been served with copies of the petition. The petition shall, if and so long as the Court is a Judge of the Chancery Division and subject to any direction of the Court to the contrary, be set down in the same manner as if it had been a witness action assigned to that Judge, and shall be marked in the witness list not before the day of , 19 , being the appointed day.

Copies of accounts to opponent.

(*q*) Any persons who have delivered particulars of objections shall be entitled, at their own expense, to obtain from the petitioner copies of the accounts which have been lodged by him.

Papers to be lodged at Judge's Chambers.

(*r*) All petitions, documents, and copies by these Rules required to be lodged shall, if and so long as the Court is a Judge of

the Chancery Division, be lodged at the chambers of the Judge, and, subject as aforesaid, shall be lodged with such person and at such place as the Court may from time to time direct.

Court's discretion in matters of procedure.

(s) The Court may excuse petitioners and opponents from compliance with any of the requirements of those Rules, and may give such directions in matters of procedure and practice under Section 18 of the Act as it shall consider to be just and expedient.

Appearance of Comptroller.

(t) The Comptroller, if he elects or is directed to appear on the question of granting the prayer of any petition under Section 18 of the Act, shall not be 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 Court.

Costs.

(u) The Court may, in cases where opposition has been entered to the prayer of a petition under Section 18 of the Act, give costs to or against such opponents.

One set of costs.

(v) In the event of the Court refusing the prayer of the petition, the Court shall not, except under special circumstances, give more than one set of costs amongst all the opponents.

No costs to Comptroller or Board of Trade.

(w) The Comptroller-General and the Board of Trade shall not be entitled to any costs on or in relation to their appearance on or opposition to the granting of the prayer of a petition.

Service of documents.

(x) Service of any document requiring service under this Rule may be made by enclosing such document in a prepaid registered letter and posting such letter to the person required to be served at his address for service.

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 or the Court.

Opponent's particulars of objections.

It is necessary that the opponent should state fully all the particulars of objections to the extension upon which he will rely. Under the earlier practice 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. But Rule (*u*) now expressly restricts the opponent to the particulars of his notice of opposition, although Rule (*s*) gives the Court a certain amount of discretion in matters of procedure and practice.

Free hand of Crown.

The Comptroller, usually represented by the Attorney-General, may give evidence of objections on behalf of the Crown, irrespective of 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 Comptroller, if he has elected or has been directed to appear, is always present to watch the case in the interests of the Crown or public, and may interpose, even although no *caveat* has been entered.

Merits of invention considered.

In examining the request for extension the Court 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 Court 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 or by the Comptroller will be received and given effect to (*Cocking's Patent*, 1885, 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 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

Prolongation must benefit original inventor.

granted an extension of a patent to an assignee, which did not directly or indirectly tend toward 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 *Buff-Bauer* 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.

No prolongation where inventor sufficiently remunerated.

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 (*Dalbeau's Patent*, 1896, 13 R. P. C. 203; *Pieper's Patent*, 1895, 12 R. P. C. 202; *Henderson's Patent*, 1901, 18 R. P. C. 449). But this might be capable of explanation, for even where the invention had never been brought into actual use, through illness and other causes, the patent was prolonged (*Pieper'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 Court will grant the petition (*Kay's Patent*, Good. P. C. 516).

Petitioner should show validity of patent.

In order that the Court 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 (*Livet's Patent*, 1892, 9 R. P. C. 327).

Defective accounts.

An application for an adjournment to supplement defective accounts was not ordinarily granted by the Privy Council (*Yates and Kellett's Patent*, 1887, 4 R. P. C. 150; *Peach's Patent*, 1901, 19 R. P. C. 65), but now that the Court is the tribunal, the same difficulty will not be encountered.

Costs.

The Court may, in cases where opposition has been entered, give costs to or against an opponent (Clause (*a*) of Rule 2). The Court will in its discretion balance the merits of the petition against the merits of the opposition. If the opposition is unnecessary, or has only tended to prolong the inquiry, while on the other hand the petition has been honestly and fairly prepared and prosecuted, it does not follow that the opponent will get costs even if the petition fails. At the same time, if the opposition is fair and *bonâ fide*, and has assisted to put the Court in possession of all that can be alleged against the continuance of the patent, the opponent will get costs (*Field's Patent*, 1871, Good. O. C. 572).

Costs of opponents.

Very often when there are several opponents, as in *Hopkinson's Patent* (1896, 14 R. P. C. 5), to simplify matters the Court will award a lump sum to be divided among the opponents (*Ferranti's Patent*, 1901, 18 R. P. C. 518).

Now by Clause (*c*) of Rule 2, if the petition is refused, the Court shall not, except under special circumstances, give more than one set of costs amongst all of the opponents.

Comptroller's costs.

By Clause (*e*) of Rule 2, the Comptroller and Board of Trade are not entitled to costs when appearing in opposition.

Abandoned petition.

If the petition is abandoned, those who have entered notices of opposition will generally get their costs.

Court's capacity to deal with imperfect accounts.

Now that petitions for extension of patents are decided by a tribunal having ample machinery at its command for the adjustment and correction of accounts, it is probable that shortcomings in the accounts arising from *bonâ fide* ignorance or error will not be fatal to the petition.

No appeal.

There is no appeal from the decision of the Court.

CHAPTER XXII.

ASSIGNMENT OF PATENTS.

Meaning of "Patentee."

THE form of Patent Grant uses the term "patentee" to cover the terms "inventor," together with his "executors, administrators, *and assigns*," and in Section 93 of the Act "patentee" is defined to mean the person for the time being entitled to the benefit of the patent.

Power to assign.

Thus assignment of the patent from one proprietor to another is clearly contemplated, and is in practice regularly carried out.

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 receiver, trustee, or assignee in bankruptcy. As has already been said in the chapter on Infringement, the legal successors in interest of the bankrupt patentee may sue for infringement, re-assign, and otherwise deal with the patent as the patentee himself might have done.

Patent cannot be taken in execution.

Goods made under a patent may be seized by the sheriff under a writ of *fi. fa.* or under distraint and sold, but Letters Patent could not be so seized and disposed of. The mere paper and seal of the grant might be considered a chattel and taken, but the right conferred by the grant is a chose in action which "has no location, and is incapable of manual seizure" (Farwell, J., in *British Mutoscope* v. *Homer* (1901, 18 R. P. C. 177).

Disposal by will.

On the death of a person who is sole patentee or owner of a patent, he may bequeath his interest, or it passes to his executors or administrators, as the case may be, like the rest of his personal estate. If an

Devolution of "invention."

inventor dies in possession of an invention, for protection of which he has not yet applied, his legal representative may apply for a patent at any time after the inventor's death (Section 43).

Before the present Act, it was the rule that if one of two or more co-patentees died without having effected

any severing of the joint interest, his share by the *jus accrescendi* devolved by survivorship upon the remaining co-patentee or patentees (*National Co.* v. *Gibbs*, 1899, 16 R. P. C. 339). Now, by Section 37 of the present Act, although co-patentees still hold as joint tenants, nevertheless, a co-patentee may dispose of his share by will, and if he dies intestate or intestate as to his share in the patent, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

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 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). Even a parole agreement to assign can be enforced if clearly proved. An agreement to assign might be made and enforced in respect of an invention not yet protected, the agreement providing for the assignment of the patent when the same shall have been obtained. But the invention to be subsequently patented would require to be very carefully ear-marked in the agreement (*Parnell's Patent*, 1888, 5 R. P. C. 126).

Assignment of part of a patent.

Not only is a patent assignable as a whole, but any part or share of a 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). Further, by a direct provision in Section 14 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.

District assignments.

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).

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.

Recital of grant.

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. *Condor*, 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. *Grisenold*, 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.

It has always been admitted that a co-patentee or part owner of a patent could, apart from any contract to the contrary, use the invention for his own profit without accounting to the others (*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 was therefore doubtful. Now, however, by Section 37 of the present Act, it is provided that although each co-patentee may use the invention for his own profit without accounting to the others, he shall not be entitled to grant a licence without their consent.

Co-patentees must unite in granting licences.

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 above, 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 an equitable assignee is entitled to have a notification of his equitable right entered on the Register.

Equitable assignee.

Forms of assignment.

A few short precedents of Assignments of Letters Patent will be found in Appendix A.

CHAPTER XXIII.

LICENCES.

(Voluntary and Compulsory.)

Statutory provision for licences.

THE terms of the grant of a patent, while prohibiting the exercise of the invention by anyone except the patentee, provides 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."

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 (*Bower* 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 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 original licensor, would have the same effect. Sub-licences cannot be granted by a licensee, unless the power to do so is expressly conferred. Such sub-licences may, however, become effective and undisputable by condonation or confirmation expressly, or by implication, by the over-licensor.

Acquiescence in transfer of licence.

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. *Hurhurst*, 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.

Before proceeding further, it will be useful to refer to the new provisions of the present Act as bearing upon the terms of licences.

It having been ascertained from the terms of the grant that the giving of licences by the patentee is lawful, the reader may now turn to the section which is intended to prevent abuse of the privilege.

Co-patentees must join in licence.

In Section 37 it is enacted that where there are two or more co-patentees, no one of the co-patentees shall be entitled to grant a licence without the consent of the other or others.

Section 38 provides that:—

Avoidance of certain conditions

38. (1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or

lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be— Clauses attached to the sale, &c. of patented articles.

(*a*) To prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor, or his nominees; or

(*b*) To require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy;

Provided that this sub-section shall not apply if— Exceptions saving operation of clause.

(i) The seller, lessor, or licensor proves that at the time the contract was entered into, the purchaser, lessee, or licensee had the option of purchasing the article, or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) The contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing, and on payment in compensation for such relief in the case of a purchase, of such sum, or in the case of a lease or licence, of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may, at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to Contracts based on patents becoming void.

the other party; but, where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

Retrospective effect on contracts made before the Act.

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void, may, at any time before the contract is determinable under the last preceding sub-section, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party; but where any such notice is given, the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

Illegal condition as defence in action.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which, by virtue of this section, is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates, brought while that contract is in force.

(5) Nothing in this section shall—

(*a*) Affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(*b*) Be construed as validating any contract which would, apart from this section, be invalid; or

(*c*) Affect any right of determining a contract or condition in a contract exercisable independently of this section; or

(*d*) Affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

Section 38 makes it plain that the terms of a proposed licence should be very carefully scanned by the intending licensor as well as by the intending licensee: otherwise in the event, for example, of the patent being held invalid or cancelled, he may find himself estopped from taking advantage of this, 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 invention without formally revoking the licence he would probably 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).

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

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.

Consequences of licence for full term of patent.

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

Determining licence.

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

Licensee released from licence may afterwards challenge patent.

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.

Guarantee of validity.

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. Thus, in *Henderson* v. *Shields* (1906, 24 R. P. C. 103), the guarantee of the validity of the patent was held to be the basis of the agreement to licence. The patent proved invalid, and it was ruled that the defendant (the licensee) was not estopped from denying the validity.

Illegal conditions in licence.

The licensor must also take care not to overreach himself by importing into the licence any contract obnoxious to Section 38 of the new Act. It is perfectly well known that this section was inspired by the unfair dealing of licensors such as was brought to light in the cases of *Incandescent Co.* v. *Cantelo* (1895, 12 R. P. C. 262), and *Incandescent Co.* v. *Brogden* (1899, 16 R. P. C. 179). There the patentees of a gas mantle had forced their licensees and those who bought from their licensees to use the mantles only in conjunction with a certain burner, not patented, but which the patentees also supplied and which must be bought from them. This ingenious method of increasing the profits of their monopoly had evidently

attracted the attention of the Legislature, and now Section 38 puts the practice down. Not only does it make such a contract or condition null and void, but it makes the existence of such a contract available as a defence in an action for infringement of the patent (Sub-section 4), or as a ground of possible revocation under Section 24. Any such unfairly burdened licences now existing and made before the passing of the Act, may be determined by three months' notice upon terms of compensation to be fixed by an arbitrator appointed by the Board of Trade.

The saving clauses whereby a condition attached to a licence or user of a patented article, and *primâ facie* unfair, may be nevertheless upheld, are to be found in Clauses (i.) and (ii.) of Sub-section 1 of Section 38, to which the reader is directed.

Safeguards for licensor.

Retracing one's steps from the abnormal to the normal conditions of a licence, 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 would, until the present Act, have continued, although the patent had lapsed.

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

Mills v. *Carson*.

An instance of this occurred under the repealed Act 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 about the payment of the renewal fees nor was there any other arrangement as to who should pay them. 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. Now, however, the repetition of such a hardship to the licensee is prevented by the operation of Sub-section 2, Section 38, which says that where a licence exists, and during its subsistence the patent *ceases to be in force*, the licence may be terminated by three months' notice. Plainly this is so only when the patent ceases to be in force by non-payment of renewal fees, or revocation or surrender. Apparently the sub-section would not apply if the patent were only held invalid in an action for infringement, for then it would remain on the Register and would, in fact, remain in force although useless to protect the licensee from non-licensed competition.

Mere licensee cannot sue for infringements.

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 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.

Improvements in licensed invention.

A licence may include an undertaking by the licensor to allow the licensee to use any improvements in or additions to the invention which may afterwards be made by the licensor. An "improvement" of a patented machine includes any machine which, while retaining some of the characteristic parts of the original invention, yet by addition, omission, or alteration better achieves the desired results. This is so whether the improvement would infringe the original invention or not (*Linotype* v. *Hopkins*, 1910, 27 R. P. C. 109).

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. Nevertheless, it would be risky to do so, especially in the face of the observation of Lindley, L. J., in *Gaydol* 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 part not 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 feature which is 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 A.

COMPULSORY LICENCES.

By Act of 1907 the Court adjudicates.

In spite of the exceedingly cold welcome hitherto extended by men of business to the provisions for obtaining Compulsory Licences, the Legislature has evidently continued faith in their efficacy. In the present Act, Parliament attempts to make the privilege a little more attractive by dethroning the Privy Council as the tribunal and installing the High Court in their place, just as was done in the case of petitions for extensions.

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 under the 1902 Act.

By Section 3 of The Patents Act, 1902, the hearing of these petitions was taken out of the hands of the Board of Trade and was relegated to the Judicial Committee of the Privy Council, Section 22 of the Principal Act *being repealed*.

Present practice.

Under the present Act the petition is still presented to the Board of Trade, which acts as a species of filter before the petition is referred to the Court. 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 Court. If the petitioner satisfies the Court that the reasonable requirements of the public, with reference to the patented invention, have not been satisfied, the patentee may be ordered by the Court to grant licences on such terms as the Court may think just, or if the Court is 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 of the Court (Section 24, Sub-section 3).

Functions of Board of Trade.

Reference to Court.

Revocation.

In Sub-section 5 of Section 24, Clause (*b*) sets forth, as one of the reasons for the Court's finding that the

reasonable requirements of the public had not been satisfied, that:—

"Any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act, to the purchase, hire, or use of the patented article, or to the using or working of the patented process." Unfair conditions.

Compare this with the terms of Section 38.

Order 53A (Rule 7) contains the following instructions as to procedure under Section 24 of the Act:—

7. In all petitions referred by the Board of Trade to the Court under Section 24 of the Act the following rules shall apply— Procedure under Order 53A.

(*a*) No evidence shall be given upon any issues other than those raised upon the original petition before the Board of Trade.

(*b*) Every person who has given notice of opposition in accordance with The Patent Rules, 1908, shall be entitled to be heard on such petitions, and the Court may direct the petitions to be served or notice thereof to be given to such other person or persons as may be thought desirable.

(*c*) The petition shall, if and so long as the Court be a Judge of the Chancery Division, and subject to any direction of the Court to the contrary, be set down in the same manner as if it were a witness action assigned to such Judge.

(*d*) The petition shall be heard by the Court as a witness action, and shall come on in due course in the witness list.

Rule 7 should be considered in conjunction with the Patents Rules 68 to 74 inclusive, which are as follows:—

COMPULSORY LICENCES AND REVOCATION OF PATENTS.

68. A petition to the Board for an order under Section 24 of the Act shall be made on Patents Form No. 20, and 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 for grant of compulsory licence or revocation of patent.

To be left with evidence at Office.

69. The petition and an examined copy thereof shall be left at the office with a request on Patents Form No. 19, and shall be 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.

70. The persons to whom such copies are delivered by the petitioner may give notice of opposition on Patents Form No. 21, and may, within fourteen days after being invited to do so by the Board, leave at the 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 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 if they think fit upon such notice to parties interested and upon such terms (if any) as they may direct.

Closing evidence.

71. No further evidence than as aforesaid may be left by either side at the office except by leave or on requisition of the Board, and upon such terms (if any) as the Board may think fit.

Power of Board of Trade to dismiss petition.

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

Arrangements between parties.

73. 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 Court.

Reference of petition to the Court.

74. If the Board are of opinion that there is no reasonable probability of any arrangement being come to between the parties, and are satisfied that a *prima facie* case has been made out by the petitioner, they shall refer the petition to the Court, 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 Court in ascertaining what persons should be made parties to the proceedings before the Court, and the Board shall give written notice to the parties that the petition has been referred to the Court.

Petitioner's interest.

According to Sub-section 1 of Section 24, "any person interested" may present the petition, and Rule 28 of The Patent Rules, 1908, 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 it is to be presumed, in the absence of reports of proceedings under the Act of 1907, that the decisions under the former sections 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).

Grounds of petition.

A petitioner who asserts that the patent is not being adequately 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).

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.

Interested parties other than patentee.

The repealed section of the Act of 1902 made provision for the intervention of interested third parties (other than the patentee) as opponents to the petition, and the present Act does the same. It has always 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 Court now.

Satisfaction of reasonable requirements of public.

The provisions in Sub-section 3 of Section 24 for ordering compulsory licences or revoking the patent are, it will be noticed, always subject to its being proved that the reasonable requirements of the public are not being satisfied. Such default might be brought about by inadequacy of manufacture or supply, or anything that would tend unfairly to prejudice the establishment of any new industry in the United Kingdom. Clause (*b*) of Sub-section 5 indicates unfair conditions attached to the working or sale of the patented article or process as a failure to satisfy reasonable requirements.

Costs.

Rule 9 of Order 53A puts the costs in the discretion of the Court.

In the absence of reported cases under the present Act of petitions for compulsory licences, it is impossible to do more than has been done, viz., to indicate the Rules and procedure, without attempting to speculate upon how the Court will interpret them.

CHAPTER XXIV.

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 dispute or 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.

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

Joint applicants or patentees.

have an undue advantage over his co-patentees. Formerly, some severance of joint ownership was necessary to 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); but this is now provided against by Section 37 of the new Act.

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.

An assignment of Letters Patent frequently contains an agreement on the part of the inventor or assignor that further improvements in the same subject-matter are to become the property of the assignee on certain terms, or that he is to have an exclusive licence to use them. In *Linotype* v. *Hopkins* (1909, 25 R. P. C. 665), it was held by the Court of Appeal that an "improvement" in a patented machine includes any machine which, while retaining any of those essential parts of the machine which are the subject of the patent, yet, by addition, omission, or alteration, better achieves the desired results, irrespective of whether the new machine infringes the patented one or not.

Further improvements.

But where the "improvement," alleged so to be, is a separate and distinct invention, though applicable to the same type of apparatus, it may be outside of the agreement (*Davies* v. *Davies Boiler Co.*, 1909, 25 R. P. C. 823).

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 (*Frentzill* 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. Forms of agreements.

CHAPTER XXV.

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, agreements, 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 Lion Co.* v. *Spilsbury*, 1898, 15 R. P. C., at p. 571), unless he can establish his equitable right.

Registration necessary to protect assignee.

Register as evidence.

The Register is *primâ facie* evidence of any matters inscribed therein (Section 28, Sub-section 3).

Trusts not entered.

No notice of any trust, express, implied, or constructive, will be entered on the Register (Section 66), 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 of that Act only excluded 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 assignments of a patent, or of a share in a patent, may be entered on the Register as documents affecting the proprietorship.

Equitable assignments.

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 many 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. The reason is that the Comptroller may have great difficulty in satisfying himself 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, to 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 (Section 71, Sub-section 2). The express provision with respect to mortgages in this sub-section is new, but it only justifies the established practice of the Patent Office.

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 71 of the Act, in combination with Rule 85 of the Patents Rules, 1908) 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.

It has been held that the Comptroller has power under Section 71 (Section 87 of the old Act) 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; and now see Patent Rule 84).

Correction of clerical errors.

Clerical errors in the name or address of a registered proprietor of a patent may be corrected under Section 70 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 72 to make, expunge, or vary entries in the Register on the application of any person aggrieved. The application may be made by summons or notice of motion, and the prescribed notice of the application must be given to the Comptroller, who shall have the right to appear, and must appear if so directed by the Court. 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

Jurisdiction of Scottish and Irish Courts.

proceedings are generally instituted in the High Court. However, it is well to note here that although the Irish Court, in *Bayer* v. *O'Donnell* (1897, 14 R. P. C. 275), disclaimed jurisdiction, the Court of Session in Scotland, in *Curie* 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). Service abroad.

An appeal lies from the Court of First Instance to the Court of Appeal and House of Lords. Any Order of the Court rectifying the Register shall direct that notice of the rectification be served on the Comptroller in the prescribed manner, who shall, upon the receipt of such notice, rectify the Register accordingly (Sub-section 4 of Section 72). Appeal.

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. Request for entry.

The request should be made on Form 27, 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.

Any request for entry upon or rectification of the Register should be accompanied by the original assignment, licence, order, or other document, and by an attested copy of the same, which is retained by the Comptroller. Documents to accompany request.

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 or copies must be left with the Comptroller. Collateral documents.

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 week-day. Thus a proposing purchaser or licensee can satisfy himself concerning all registered dealings with the patent. Certified extracts.

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. Notice by Comptroller.

CHAPTER XXVI.

MISCELLANEOUS.

Offences and Penalties: Patent Agents: Patent Medicines:

Offences and Penalties.

SECTIONS 89 and 90 in the new Act of 1907 take the place of Sections 93, 105, and 106 of the Act of 1883.

Sub-section (1) of Section 89 provides that—

Offences.

89. (1) If any person makes or causes to be made a false entry in any Register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such Register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of misdemeanour.

Civil remedy.

As regards the civil remedy, a person whose rights have been affected by any fraudulent entry on the Register, is clearly a person "aggrieved," within the meaning of Section 72, and could apply to the Court for rectification of the wrongful entry.

Sub-sections (2) and (3) are as follows:—

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the

article is patented, or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article, or that the design applied thereto is a registered design.

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 10 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.

Marking "patent" as notice to public.

Section 33 of the Act creates a new reason for clearly and unmistakeably marking patented articles with both number and date. By the terms of the said Section 33, patentees are warned that in an action for infringement any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, will not be answerable in damages in any suit by the patentee. Further, the section provides that merely to mark the article with the word "Patent" or "Patented," or any other word or words implying that the article is patented, will not suffice to constitute notice of the existence of the patent, *unless the intimation is accompanied by the year and number of the patent.* Of course, the provision does not affect the plaintiff's right to an injunction.

The section only applies to patents obtained after the 1st January, 1908.

Where the patented feature is only a portion or item of the machine or article, the patentee must take care to mark that portion, and that portion only. Otherwise he might have a difficulty in showing that he had complied *bonâ fide* with the section. In a design case, where marking is obligatory, the proprietor of a cuff-link design applicable to the shank only of the link, had marked the link on another part. Farwell, J., pointed out that 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 (*Morton's Design*, 1900, 17 R. P. C. 117). Probably the same reasoning will be applied in the marking of patented articles.

Misleading marking.

But if the invention is a new combination of old parts, the invention being the combination, a marking plate on the standard or other prominent part of the machine would do.

Section 90 provides that—

Use of Royal Arms.

90. (1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms, or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connexion with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive), in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Act to a fine not exceeding twenty pounds:

Provided that nothing in this section shall be construed as affecting the right (if any) of the proprietor of a trade mark containing such arms to continue to use such trade mark.

Patent Agents.

The continuation of the Register of Patent Agents is provided for by Section 84 of this Act, and Rules for the regulation of the Register are authorised by Section 85.

Register of patent agents.

84. (1) A person shall not be entitled to describe himself as a Patent Agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a Patent Agent in pursuance of this Act or an Act repealed by this Act.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the Twenty-fourth day of December, One thousand eight hundred and eighty-eight, he had been *bonâ fide* practising as a Patent Agent shall be entitled to be registered as a Patent Agent in pursuance of this Act.

(3) If any person knowingly describes himself as a Patent Agent in contravention of this section he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section "Patent Agent" means exclusively an agent for obtaining patents in the United Kingdom.

Comptroller's power to refuse recognition to offending agents.

85. (1) Rules under this Act may authorise the Comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the Register of Patent Agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the Register of Patent Agents, to have his name erased therefrom; and may authorise the Comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the Comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents such rules as aforesaid may authorise the Comptroller to refuse to recognise the company or firm as agent if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The Comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Rule 9 of The Patents Rules, 1908, was framed in pursuance of Section 85, and gives the Comptroller power to deal with offending agents or persons acting as agents.

To the above sections may be added Sub-section (5) of Section 89 to the effect that—

Description of office as "Patent Office."

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

By Clause (*g*) of Sub-section 1 of Section 86 the Board of Trade are authorised to make such general rules and do such things as they think expedient for *inter alia* "regulating the keeping of the Register of Patent Agents under this Act."

Under the Patents Act of 1888 it was originally provided that after the 1st July, 1889, no person should 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 was registered as a Patent Agent. Sections 84 and 85 of the present Act practically repeat the provisions of the Act of 1888, with some not very material additions. 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. Now that the Roll has been in existence for so long, it may fairly be said that the great body of the profession as it now stands has

Penalty for false description as "Patent Agent."

attained a very high standard of efficiency. Admission to the Roll is 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.

Admission to Roll by examination.

It seems that, by the very narrow interpretation of the Act of 1888 and presumably of the present section, 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). Nevertheless, although a person acting as an agent may not be on the Register, Section 85 and Patents Rule 9 empower the Comptroller to deal with him in the event of misbehaviour. A person *bonâ fide* in business as a Patent Agent before the commencement of the Act of 1888 is entitled to registration, but if he continues to practice without being registered he commits an offence (*Starey* 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 as a "Patent Agent," 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 *Starey* 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.

The Register of Patent Agents Rules of 1908 are the Board of Trade Rules now in force which relate to the admission and regulation of Patent Agents.

Rules of 1908.

Under Section 85, Rule 9 authorises the Comptroller to refuse to recognise or to communicate with any person as Patent Agent whose name has been struck off the Roll for malpractices.

Comptroller may refuse to recognise Agent.

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

Chartered Institute of Patent Agents.

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.

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."

CHAPTER XXVII.

FOREIGN AND COLONIAL PATENTS, AND THE INTERNATIONAL CONVENTION.

The International Convention.

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—

Enlargement of Convention, 1900.

Proposed amendments on the Convention.

(1) The extension of the time within which subjects and citizens of countries, members of the Convention, might mutually make applications for the protection of patents, trade marks, and designs in countries other than that in which the original application was made, so as to secure the original date.

(2) The fixing of a common period of time in all of those countries which require patents to be

worked, within which patents would not be liable to forfeiture because of non-working.

(3) Regulations as to the registration of trade marks.

(4) Mutual provisions against dishonest competition by fraudulent use of trade marks and trade names.

After a voluminous correspondence, which is to be found set forth at length in the Blue Book containing the papers and correspondence relative to the Conference (published in 1901, price 7½d.), the delegates met at Brussels, and the following alterations in the terms of the Convention were agreed to:—

Amendments made at the Convention in 1900.

(1) That the seven months' period of priority for patents be extended to *twelve* months, and that the three months' period of priority for trade marks and designs be extended to *four* months.

(2) That patents applied for in the various contracting States by persons admitted to the benefits of the Convention under the terms of Articles II. and III. shall be independent of patents obtained for the same invention in other States, whether 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 D.

In order to give effect to and ratify these alterations in the Convention so far as concerned the United Kingdom, the short Patents Act of 1901 was passed. This latter

Act was repealed by the present Act, Section 91 of which makes provision for International and Colonial arrangements.

The section is as follows:—

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International and Colonial arrangements.

91. (1) If His Majesty is pleased to make any arrangement with the Government of any Foreign State for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that State shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or The Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the Foreign State.

Provided that—

(*a*) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the Foreign State; and

(*b*) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his Complete Specification is accepted, or his design or trade mark is registered, in this country.

(2) The patent granted for the invention, or the registration of a design or trade mark, shall not be invalidated—

(*a*) In the case of a patent by reason only of the publication of a description of, or use of, the invention; or

(*b*) In the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design; or

(c) In the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or The Trade Marks Act, 1905: Provided that—

(*a*) In the case of patents the application shall be accompanied by a Complete Specification, which, if it is not accepted within the twelve months from the application for protection in the Foreign State, shall, with the drawings, if any, be open to public inspection at the expiration of that period; and

(*b*) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin, may be registered under The Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those Foreign States with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each State as the Order in Council continues in force with respect to that State.

(5) Where it is made to appear to His Majesty that the Legislature of any British Possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that Possession, with such variations or additions, if any, as may be stated in the Order.

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. This, of course, 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.

List of countries adhering to Convention.

The following list of the countries which are to-day parties to the Convention, has been taken from the latest information issued by the Patent Office:—Austria, Belgium, Brazil, Cuba, Denmark with the Faröe Islands, France with Algeria and Colonies, Germany, Great Britain, Australia, Ceylon, New Zealand, Trinidad, Tobago, Hungary, Italy, Japan, Mexico, Netherlands with the Dutch

East Indies, Surinam, and Curaçoa, Norway, Portugal with the Azores and Madeira, Santo Domingo, Servia, Spain, Sweden, Switzerland, Tunis, United States of America. Of course, it must be understood that the above does not exhaust the list of countries in which the British inventor may obtain patents, apart from the Convention. There are other States which 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 generally 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.

U.S.A. applications.

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).

Applications by foreign patentees in Great Britain.

As to the rules that govern foreign applications in this country under the Convention, every such application should 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 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.

In addition to the specification left with every Convention Application, a copy or copies of the specification or specifications 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, must be left at the Office at the same time as the application or within such further time thereafter, not exceeding three months, as the Comptroller may allow. 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.

Any application for extension of time for leaving the copy or copies of the foreign specification or specifications, drawings or documents, should be made on Patents Form No. 5.

Public inspection.

If the Complete Specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall be open to public inspection at the expiration of that period.

Proceedings.

Except for the foregoing differences and as provided by Rule 83, which relates to the dating of the application, all proceedings in connexion with a Convention Application shall be taken within the times and in the manner prescribed by the Act and Rules for ordinary applications. The claims in the British Complete Specification of a foreign applicant must not cover more than the claims of the original foreign application. This does not necessarily mean the claims as finally allowed in the foreign patent when issued, for in many cases the foreign application is still under consideration when the British patent is granted, so that the British claims, as allowed, might in fact be wider than the *foreign claims as finally accepted abroad*. But in no case can the British claims be wider than the foreign claims as originally filed. This is the true meaning of the Comptroller's ruling (1910 (B)), for although he says in the report that a Convention applicant "is only entitled to include in his specification what has substantially been

Limits of claims in Convention Application.

protected abroad" he has since explained that what he intended to express was "*claimed*" abroad.

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 D.

STATUTORY RULES AND ORDERS. 1907.

No. 950.

PATENTS.

THE PATENTS RULES, 1908, DATED 17TH DECEMBER, 1907.

BY VIRTUE of the provisions of The Patents and Designs Act, 1907 (hereinafter referred to as "the Act"), the Board of Trade (hereinafter referred to as "the Board") do hereby make the following Rules:—

SHORT TITLE.

Short title.

1. These Rules may be cited as "The Patents Rules, 1908."

COMMENCEMENT.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st December, 1907, with the exception of such of them as relate to procedure under Section 8 of the Act, which shall come into operation at such date as the Board may by Order direct.

INTERPRETATION.

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 91 of the Act are applicable.

"Convention Application" means an application in the United Kingdom under Section 91 of the Act.

"Office" means the Patent Office.

"*Journal*" means the *Illustrated Official Journal (Patents)*.

Fees.

First Schedule.

4. The fees to be paid under the Act, so far as it relates to patents, shall be those specified in the List of Fees in the First Schedule to these Rules.

Forms.

Second Schedule.

5. The forms herein referred to are those contained in the Second and Third Schedules to these Rules, and such forms shall be used in all cases to which they are applicable, and shall be modified as directed by the Comptroller to meet other cases.

Documents.

Size, &c., of documents.

6. All documents and copies of documents, except drawings, sent to or left at the Office or otherwise furnished to the Comptroller or to the Board 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 hand. 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.

Leaving and serving documents.

7. Any application, notice, or other document authorised or required to be left, made, or given at the Office, or to the Comptroller, or to any other person under the Act or these Rules, may be sent by a prepaid or official paid 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 sending or service, it shall be sufficient to prove that the letter was properly addressed and put into the post.

A letter addressed to a patentee at his address as it appears on the Register of Patents, or at his address for service, or to any applicant for or opponent to the grant, revocation, or restoration of a patent at the address

appearing on the application or notice of opposition, or given for service, as hereinafter provided, shall be deemed to be sufficiently addressed.

Address for service.

8. Every applicant for and opponent to the grant of a patent, or the revocation of a patent, or the restoration of a lapsed patent, or the amendment of a specification, and every person who shall hereafter become a patentee, shall give an address for service in the United Kingdom, and such address may be treated, for all purposes connected with the patent, as the actual address of such applicant, opponent, or patentee.

If any patentee desires to have two addresses for service entered in the Register, a request therefor shall be made on Patents Form No. 26.

The Comptroller may require any existing patentee, who does not reside in the United Kingdom, to give an address for service within the United Kingdom, and such address may be treated as the actual address of the patentee for all purposes connected with such patent.

Agency.

Agency.

9. With the exception of the signing of the following documents—namely, applications for patents, or for the revocation of patents or the restoration of lapsed patents, requests for leave to amend applications, specifications, or Letters Patent, authorisations of agents, notices of oppositions, requests for issue of duplicate Letters Patent, and surrenders of Letters Patent—all communications to the Comptroller under the Act and these Rules relating to patents 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 resident or having a place of business in the United Kingdom. The Comptroller shall not be bound to recognise as such agent, or to receive further communications in respect of any business under the Act relating to patents from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of the Act, and not since restored; or any person who is proved to the satisfaction of the Board, after being given an opportunity

of being heard, to have been convicted of such an offence, or to have been guilty of such misconduct, as would have rendered him liable, if his name had been on the Register of Patent Agents, to have his name erased therefrom; or any company which if it had been an individual the Comptroller could refuse to recognise as agent, or any company or firm, if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company, or is a partner in the firm. In any particular case the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

Applications for the Grant of Patents.

Form of application.

10. An application for a patent, other than a Patent of Addition or a Secret Patent, shall be made on one of the Patents Forms, Nos. 1, 1A, or 1B, as the case may be. An application for a Patent of Addition shall be made on Patents Form No. 1c, and an application for a Secret Patent on Patents Form No. 1D.

Application by representative of deceased inventor.

11. 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 estate and effects, or an official copy of such probate or letters, shall be produced at the Office in proof of the applicant's title as such legal representative, and be supported by such further evidence as the Comptroller may require.

Order of recording applications.

12. 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 Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Office.

One invention.

13. (1) 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.

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. Applications for separate patents by way of amendment.

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 Act and by these Rules.

Where the Comptroller has required or allowed any application or specification or drawings, or any of them, 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.

(2) Where the same applicant has put in two or more Provisional Specifications for inventions which he believes to be cognate or modifications one of the other, and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the Complete Specification left in connexion with his application into such number of Complete Specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions.

14. 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. Claims.

APPLICATIONS UNDER THE INTERNATIONAL CONVENTION.

15. Every Convention Application shall contain a declaration that foreign application has been made for Convention Applications.

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 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.

16. In addition to the specification left with every Convention Application a copy or copies of the specification or specifications 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, must be left at the Office at the same time as the application or within such further time thereafter, not exceeding three months, as the Comptroller may allow. 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.

An application for extension of time for leaving the copy or copies of the foreign specification or specifications, drawings, or documents shall be made on Patents Form No. 5.

Public inspection.

17. If the Complete Specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall be open to public inspection at the expiration of that period.

Proceedings.

18. Save as aforesaid and as provided by Rule 83, all proceedings in connection with a Convention Application shall be taken within the times and in the manner prescribed by the Act or these Rules for ordinary applications.

Drawings.[1]

General.

19. Drawings, when furnished, should accompany the Provisional or Complete Specification to which they refer, except in the case provided for by Rule 26. 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, &c.

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.

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 figure 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. The figures should be numbered consecutively throughout and without regard to the number of sheets, and 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.

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.

[1] Note.—Copies of Instructions as to the Preparation of Drawings may be had on application to the Patent Office.

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

(d) Shading 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 name of applicant, &c., but no descriptive matter.

23. Drawings must bear the name of the applicant (and, in the case of drawings left with a Complete Specification after one or more Provisional Specifications, the numbers and years of the applications) 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.

24. A facsimile or "true copy" of the original drawings should 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.

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

26. If an applicant desires to adopt the drawings lodged with his Provisional Specification as the drawings or part of the drawings for his Complete Specification, he should refer to them in the Complete Specification as those left with the Provisional Specification. Provisional drawings used for Complete Specifications.

EXTENSION OF TIME FOR LEAVING COMPLETE SPECIFICATION.

27. An application for one month's extension of time for leaving a Complete Specification shall be made on Patents Form No. 6. Extension of time for leaving Complete Specification.

PROCEDURE UNDER SECTION 7 OF THE ACT.

28. 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 requires amendment of the specification and drawings, or any 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 dyte 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. Power of Comptroller to post-date.

29. 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, he shall, without any further prosecution of the investigation, make a provisional report to that effect to the Comptroller. Provisional report in case of complete anticipation.

If the provisional report of the Examiner made under this Rule be not reversed or altered, it may be deemed a final report, and the application shall be dealt with as provided by Sub-section 4. If, however, such provisional report be reversed or altered, the investigation 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 3 or Sub-section 4, as the case may require.

30. The time within which an applicant may leave his amended specification under Sub-section 2 shall be two Time for leaving amended specification.

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.

Hearing by the Comptroller under Sub-section 4.

31. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provisions of Sub-section 1, and the time allowed 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, and in the event of the invention claimed being wholly and specifically claimed in any specification to which the investigation has extended, whether he should refuse to grant a patent.

Reference to prior specification.

32. When, under Sub-section 4, 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 7, Sub-section 4, of The Patents and Designs Act, 1907, to specification No. of 1 .

Where the reference is inserted as the result of a provisional report under Rule 29, a statement to that effect shall be added to the reference.

Procedure under Section 8 of the Act.

Procedure under Section 8.

33. Where, on the extended investigation provided for by Section 8 of the Act, it appears that the invention claimed in any specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall be informed of the result of such extended investigation, and shall, within two months from the date of the letter so informing him, apply for leave to amend his specification by way of disclaimer, stating specifically what amendments he is prepared to make in it to remove the objection of anticipation, or if he considers no amendments are necessary, inform the Comptroller accordingly.

The Comptroller shall consider any amendments submitted by the applicant for this purpose, and may allow the necessary amendments to be made.

Hearing by Comptroller.

If, at the expiration of the said two months, or such further time as the Comptroller may allow, the Comptroller is not satisfied that the invention claimed by the applicant is not wholly or in part claimed in the specification or specifications cited he 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.

Reference to prior specification.

34. When, under Sub-section 2, the Comptroller determines that 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 8, Sub-section 2, of The Patents and Designs Act, 1907, to Specification No. of 1 .

Advertisement of amendments.

35. When, after any accepted specification has been published, any amendment has been made or any reference inserted therein, under either of the last two preceding Rules, notice thereof shall be advertised in the *Journal*.

CHEMICAL INVENTIONS.—TYPICAL SAMPLES AND SPECIMENS.

Chemical inventions —Typical samples and specimens.

36. Where, under Section 2, Sub-section (5), of the Act, before the acceptance of the Complete Specification left on any application for a patent for a chemical invention, the Comptroller in any particular case considers it desirable to require typical samples or specimens to be furnished, such samples or specimens must, if so required by the Comptroller, be supplied in duplicate.

The fact that such samples or specimens have been furnished shall be notified to the public by a statement to that effect on the Complete Specification, and in connexion with the advertisement of acceptance of same in the *Journal*.

The samples or specimens must, unless other directions are specially given, be supplied in glass bottles of a total height not exceeding three inches, and of an external diameter of one and a half inches, and the bottles must be securely closed by well-fitting stoppers and sealed. Each bottle must have an adhesive or otherwise securely attached label bearing a description which clearly identifies the sample with the substance described in the specification. Labels which are not secured to the bottle by an adhesive should be three inches wide and not more than four inches long.

Where samples or specimens of colouring matter are required to be supplied, they must be accompanied by samples or specimens of materials printed or dyed with such colouring matters; such last-mentioned samples or specimens must be as flat as possible, and firmly attached to cards thirteen inches long by eight inches broad. The cards must bear a full description of the processes by which the respective dyed or printed effects were produced, including the compositions and strengths of the various baths, the temperatures, duration of treatment, degree of exhaustion of the dye baths, in the case of dyed fabrics the percentage of colouring matter fixed on, in the case of prints

the composition of the printing paste, and other necessary information. This description must also clearly identify the substance used with that described in the specification.

Samples of poisonous, corrosive, explosive, or easily inflammable substances must be clearly marked as such.

Acceptance of Specifications.

Extension of time for accepting Complete Specification.

37. An application for extension of time for accepting a Complete Specification shall be made on Patents Form No. 7.

Notice and advertisement of acceptance.

38. 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 *Journal*.

Inspection of specification.

39. 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 Office upon payment of the prescribed fee.

Opposition to Grants of Patents.

Notice of opposition.

40. A notice of opposition to the grant of a patent shall be given on Patents Form No. 8, 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 be accompanied by an unstamped copy, which shall be transmitted by the Comptroller to the applicant.

Copy for applicant.

Where the person giving notice of an opposition does not desire that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect, indicating so far as can conveniently be done the general nature of the amendments desired, and the portions of the earlier specifications, if any, relied upon as necessitating such amendments.

Statement of amendments desired.

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

41. (1) 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 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, or such future time as the Comptroller may in any special case allow, the opposition shall be deemed to be abandoned.

(2) Where the ground of the opposition is that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the Complete Specification, the notice of opposition should be accompanied by a written statement indicating so far as can conveniently be done in what respects the invention is alleged to be insufficiently or unfairly described or ascertained.

Opponent's evidence.

42. Except in the case provided for in Rule 41 (1), statutory declarations need not be left in connexion 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 Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Applicant's evidence.

43. Within fourteen days from the delivery of such copies the applicant may leave at the 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 Office his statutory declarations in reply, and on so leaving shall deliver to the applicant copies thereof. Such declarations shall be confined to matters strictly in reply.

Evidence in reply.

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

44. If the opponent does not leave any 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 Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Opponent's evidence.

45. Within fourteen days from the delivery of such copies the opponent may leave at the 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 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.

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

Hearing.

47. 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 must leave Patents Form No. 9 at the Office. The Comptroller may refuse to hear either party who has not left Patents Form No. 9 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.

Sealing of Patent and Payment of Fee.

Sealing of patent, and payment of fee.

48. If the applicant for a patent desires to have a patent sealed on his application, he shall, within the period allowed by Section 12 of the Act, pay the sealing fee by leaving at the Office Patents Form No. 10, duly stamped.

Where in consequence of the neglect or failure of the applicant to pay such fee, a patent cannot be sealed within the period allowed by Section 12, the applicant may apply

to the Comptroller on Patents Form No. 11 or Patents Form No. 12, as the case may be, for an extension of such period not exceeding three months, where the period allowed for the sealing of the patent expires after the commencement of the Act, and not exceeding three months after the commencement of the Act, where the period allowed for the sealing of the patent expired before the commencement of the Act.

The Comptroller shall consider such application, and, if the circumstances of the case appear to him to warrant the granting of the extension, he may seal the patent within such extended period.

Where the period allowed for the sealing of the patent has expired before the commencement of the Act, no proceedings shall be taken in respect of an infringement committed after the failure to pay the fee, and before the sealing of the patent.

Form of Patent.

Form of patent.

49. A patent, except in the cases provided for in Rules 50 and 51, may be in the Form A, in the Third Schedule to these Rules.

Form of patent of addition.

50. A patent of addition may be in the Form B, in the Third Schedule to these Rules.

Form of patent to legal representatives of deceased inventor and others.

51. Where, after the commencement of the Act, a patent is granted to the legal representatives of a deceased inventor, or in any case in which the applicants have asked to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in such patent as joint tenants, the form of the patent shall be modified so as to show clearly that the persons to whom the grant is made are to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in the patent as joint tenants.

Renewal Fees.

Renewal fees.

52. If a patentee intends, at the expiration of the fourth year from the date of his patent or of any succeeding year during the term of the patent, to keep the same in force, he shall, before the expiration of such

year, pay the prescribed annual renewal fee by means of Patents Form No. 13. The patentee may pay all or any of such prescribed annual renewal fees in advance. An application for an enlargement of time for payment of any fee under this Rule shall be made on Patents Form No. 14.

Certificate of payment of fee.

53. On due compliance with the terms of Rule 52, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

Notice as to renewal fees.

54. At any time not less than one month before the date when any renewal fee will become due in respect of any patent, the Comptroller shall send to the patentee or patentees, whose names appear in the Register of Patents, at his or their address or addresses for service, or to the address of the person or persons who paid the last renewal fee, a notice reminding him or them of the date when such fee will become due, and of the consequences of the non-payment thereof.

Restoration of Lapsed Patents.

Restoration of lapsed patents.

55. Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller on Patents Form No. 15 for an Order for the restoration of the patent. Every such application shall be accompanied by one or more statutory declarations verifying the statements contained in such application. If the Comptroller entertains the application, he shall advertise it in the *Journal*, and in such other manner as in his opinion is desirable. At any time within two months from the first of such advertisements in the *Journal* any person may give notice of opposition at the Office on Patents Form No. 16, and a copy of such notice shall be transmitted by the Comptroller to the applicant.

Opponent's evidence.

56. Where such notice is given the opponent shall within fourteen days after leaving the notice leave at the Office one or more statutory declarations verifying any evidence on which he relies in support of the grounds of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Further procedure.

57. Upon such declarations being left and delivered, the provisions of Rules 43, 46, and 47 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repeated.

Order.

58. In every Order of the Comptroller restoring a patent, provision shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent has been announced as void in the *Journal*. Such provisions shall restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage:—

(1) In respect of any infringement of the patent which shall have taken place after the date on which the patent was announced in the *Journal* to be void and before the date of the Order.

(2) In respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process, or operation actually made or carried on within the United Kingdom, or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the said announcement and before the date of the Order: Provided that such use, purchase, sale, or employment is by the person or corporation by or for whom such machine or machinery or article was *bonâ fide* manufactured or made, or such mechanism, machine, machinery, process, or operation was *bonâ fide* made or carried on, his or their executors, administrators, successors, or vendees, or his or their assigns respectively.

(3) In respect of the use, employment, or sale at any time thereafter by any person or corporation entitled for the time being under the preceding sub-section to use or employ any machine, machinery, mechanism, process, or operation or any improved or additional machine, machinery, mechanism, process, or operation, or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent: Provided that the use or employment of any such improved or additional machine, machinery, mechanism, process, or operation shall be limited to the buildings,

works, or premises existing at the time being or afterwards erected of the person or corporation by or for whom such machine, machinery, mechanism, process, or operation was made or carried on within the meaning of the preceding Paragraph, his or their executors, administrators, successors, or assigns.

Compensation.

59. The Order shall further provide that if any person within one year after the date thereof make an application to the Board for compensation in respect of money, time, or labour expended by the applicant upon the subject-matter of the patent in the *bonâ fide* belief that such patent had become and continued to be void, it shall be lawful for the Board, after hearing the parties concerned or their agents to assess the amount of such compensation if in their opinion the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

Amendment of Specification.

Request for leave to amend.

60. A request to the Comptroller for leave to amend a specification, except when such request is made under Rule 33, shall be made on Patents Form No. 17. The request must be accompanied by a duly certified copy of the original specification and drawings, showing in red ink the proposed amendment in such manner as to indicate clearly the alteration desired, and shall be advertised by publication of the request and the nature of the proposed amendment in the *Journal*, and in such other manner, if any, as the Comptroller may in each case direct.

Notice of opposition.

Copy for the applicant.

61. A notice of opposition to the amendment shall be on Patents Form No. 18, and shall be accompanied by an unstamped copy, which copy shall be transmitted by the Comptroller to the applicant.

Opponent's evidence.

62. 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 Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Further proceedings.

63. Upon such declarations being left, and such copies being delivered, the provisions of Rules 43, 46, and 47 shall apply to the case, and the further proceedings shall be regulated in accordance with such provisions as if they were herein repeated.

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

64. 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 Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Further proceedings.

65. Upon such declarations being left, and such copies being delivered, the provisions of Rules 45, 46, and 47 shall apply to the case, and further proceedings therein shall be regulated in accordance with such provisions as if they were herein repeated.

Requirements on amendment.

66. 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 Office a new specification and drawings as amended, to be prepared in accordance with Rules 6 and 19 to 25.

Advertisement of amendment.

67. Every amendment of a specification shall be advertised forthwith by the Comptroller in the *Journal*, and in such other manner, if any, as the Comptroller may direct.

Compulsory Licences and Revocation of Patents.

Petition for grant of compulsory licence or revocation of patent.

68. A petition to the Board for an Order under Section 24 of the Act shall be made on Patents Form No. 20 and 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 Office.

69. The petition and an examined copy thereof shall be left at the Office with a request on Patents Form No. 19.

and shall be 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.

70. The persons to whom such copies are delivered by the petitioner may give notice of opposition on Patents Form No. 21, and may, within fourteen days after being invited to do so by the Board, leave at the 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 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, if they think fit, upon such notice to parties interested and upon such terms, if any, as they may direct.

Closing of evidence.

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

Power of Board of Trade to dismiss petition.

72. The Board 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.

Arrangements between parties.

73. 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 Court.

Reference of petition to the Court.

74. 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 Court, 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 Court in ascertaining what persons should be made parties to the proceedings before the Court, and the Board shall give written notice to the parties that the petition has been referred to the Court.

Procedure under Section 26 of the Act.

Application under Section 26 of the Act.

75. An application for the revocation of a patent under Section 26 of the Act shall be made on Patents Form No. 22, and shall be accompanied by an unstamped copy of the Form, which shall be transmitted by the Comptroller to the patentee. Where the ground of application is that the applicant for the patent obtained the invention from the person applying for the revocation of the patent, evidence by way of statutory declaration in support of such allegation shall be left at the Office at the same time as the application for the revocation, or as soon as may be thereafter. In other cases such evidence may be so left by the applicant for revocation if he desires. Copies of any declarations left at the Office under this Rule shall be delivered by the applicant to the patentee.

Procedure.

76. Upon such declarations being left and delivered, the provisions of Rules 43 to 47 shall apply, *mutatis mutandis*, to the furnishing of further evidence and to the hearing of the case before the Comptroller.

Surrender of patent.

77. A notice of an offer by a patentee to surrender his patent under Section 26 of the Act shall be given on Patents

Form No. 23, and shall be advertised by the Comptroller in the *Journal* and in such other manner, if any, as he deems desirable.

Revocation of Patents worked outside the United Kingdom.

Revocation of patents worked outside the United Kingdom.

78. An application for the revocation of a patent under Section 27 of the Act shall be made on Patents Form No. 24. The applicant shall simultaneously with, or as soon as may be after, the leaving of such application at the Office deliver, or cause to be delivered, to the patentee or his agent a copy of such application, and furnish the Comptroller with evidence of such delivery.

Procedure.

79. The patentee shall within fourteen days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what place the patented article or process is manufactured or carried on in the United Kingdom; and setting out in the event of the article or process not being manufactured or carried on in the United Kingdom to an adequate extent, the reasons why it is not so manufactured or carried on. The patentee shall deliver, or cause to be delivered, copies of such evidence to the applicant, and furnish the Comptroller with evidence of such delivery.

Within fourteen days from the delivery of such copies, or within such further time as the Comptroller may allow, the applicant shall, if he decides to proceed with his application, leave at the Office statutory declarations in answer, and on so leaving shall deliver to the patentee or his agent copies thereof, and furnish the Comptroller with evidence of such delivery.

Closing of evidence.

80. No further evidence shall be left at the Office on either side except by leave or on the requisition of the Comptroller and upon such terms, if any, as the Comptroller may think fit.

Hearing.

81. On completion of the evidence or at such other time as he may see fit, the Comptroller shall appoint a

time for the hearing of the case, and give the parties ten days' notice at least of such appointment, and in the event of his deciding to take evidence *viva voce* in lieu of or in addition to the evidence by declaration, or to allow any declarant to be cross-examined on his declaration, he may require the attendance of any declarant or other person whose evidence he may consider desirable.

Register of Patents.

Entry of grant.

82. 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, the title of the invention, the date of patent, and the date of the grant thereof, together with the address for service.

Entry in respect of Convention Application.

83. 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. The date of the application in this country shall also be entered in the Register.

Alteration of address.

84. If a patentee send to the Comptroller on Patents Form No. 25 notice of an alteration in his name or address, or address for service, 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.

85. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to any interest therein, as mortgagee, licensee, or otherwise, a request for the entry in the Register of his name as proprietor of the patent, or of a notice of such interest, as the case may be, shall be addressed to the Comptroller and left at the Office.

Form and signature of request.

86. Such request shall be on Patents Form No. 27 or Patents Form No. 28, as the case may be, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent, and in the case of a body corporate by its agent.

Particulars to be stated in request.

87. Every such request shall state the name, address, and calling of the person claiming to be entitled to the patent, or to any 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 have entered in the Register his name as proprietor or a notice of such interest, so as to show the manner in which, and the person or persons to whom, the patent, or such interest therein as aforesaid, has been assigned or transmitted.

Production of documents of title and other proof.

88. 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 he may call for such other proof of title as he may require for his satisfaction.

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

Copies for Office.

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

Entry of notice of interest.

90. The notice of interest in the patent of any person other than the proprietor, entered in the Register in pursuance of the request, shall be such as may appear applicable to the circumstances of the particular case.

Entry of notification of document.

91. Where it is desired to enter in the Register a notification of any document purporting to affect the proprietorship of a patent, an attested copy of such document shall be left at the Office with a request on Patents Form No. 29 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 Office if required for further verification.

Entry of date of payment of fees on issue of certificate.

92. Upon the issue of a certificate of payment under Rule 53, 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.

93. 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.

Hours of inspection of Register.

94. The Register of Patents shall be open to the inspection of the public on every day on which the Office is open to the public during the time it is so open, except at such times when the Register is required for any purpose of official use.

Correction of Clerical Errors.

Correction of clerical errors.

96. A request for the correction of a clerical error in or in connection with an application for a patent, or in any patent or specification, or in any matter which is entered upon the Register of Patents, shall be made on Patents Form No. 30.

Certificates.

Certificates and certified copies of documents.

96. A request for a certificate of the Comptroller as to any entry, matter, or thing which he is authorised by the Act or any of these Rules to make or do, shall be made on Patents Form No. 31.

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 Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

Secret Patents.

Secret patents.

97. When it has been decided by the Secretary of State for War or the Admiralty that it is advisable to take out a secret patent for any invention assigned under Section 30 of the Act, and an application for such patent has been made on Patents Form No. 15, accompanied by a certificate of the Secretary of State or the Admiralty, under Section 30, Sub-section 3, of the Act, the Comptroller shall not communicate the application or any documents relating thereto to any member of his staff other than a deputy or special examiner or examiners, who shall make the required investigations and reports required by the Act to be made in the case of other applications for patents.

Unless and until such invention is re-assigned to the inventor by the Secretary of State or the Admiralty—

(1) No copy of any specification or any other document or drawing relating thereto shall in any manner whatever be published or open to the inspection of the public.

(2) The application for the patent, and the acceptance of any specification relating to the invention, shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under Section 11 of the Act; but the Comptroller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the Complete Specification relating thereto.

(3) Every such secret patent shall be registered in a Confidential Register at the Office, and no details or particulars relating thereto shall at any time be published as required by the Act for ordinary patents, nor shall any entry be made in the ordinary Register of Patents in respect of any such patent or any assignment thereof.

(4) No fees shall be payable in respect of any secret patent, and every such patent, notwithstanding the non-payment of such fees, shall remain in force for the full period of fourteen years from its date.

Certificate of secrecy after application.

98. When an application has been made, otherwise than as provided by the last preceding rule, for a patent for an invention, and such application is still pending, and a certificate under Section 30, Sub-section 3, of the Act is furnished to the Comptroller by the Secretary of State or the Admiralty, the provisions of such Rule shall, so far as is practicable, having regard to the date of such certificate, apply to such application and to all documents relating thereto.

Re-assignment.

99. In the event of any secret patent being re-assigned to the inventor by the Secretary of State or the Admiralty, it shall be removed from the Confidential Register of secret

patents; all fees that would have been thereafter payable if the same had not been a secret patent shall be paid in respect thereof, and the patent shall remain in force only for the same term and subject to the same conditions as to payment of fees and otherwise, as if it had not been a secret patent.

Lost Patent.

Lost patent.

100. An application for a duplicate of a patent which has been lost or destroyed shall be made on Patents Form No. 32, and in accordance with the directions thereon.

Industrial or International Exhibitions.

Industrial or international exhibitions.

101. 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 have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Patents Form No. 33 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.

102. Before exercising any discretionary power given to the Comptroller by the Act 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 of hearing.

Notice by applicant.

103. Within five days from the date on which 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.

104. 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.

105. 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.

Statutory Declarations and Affidavits.

Form, &c., of statutory declaration and affidavit.

106. 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.

107. The statutory declarations and affidavits required by the Act 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.

General

Power of amendment, &c.

108. Any document for the amending of which no special provision is made by the Act may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

General power to enlarge time.

109. The times prescribed by these Rules for doing any act, or taking any proceeding thereunder, other than the times for lodging evidence referred to in Rules 68 to 74, or the times prescribed by Rules 16, 41 and 55, 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.

Days and hours of business.

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

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

Excluded days.

111. Whenever the last day fixed by the Act, or by these Rules, for doing any thing shall fall on a day when the Office is not open or on a Saturday, which days shall be excluded days for the purposes of the Act and these Rules, it shall be lawful to do any such thing on the day next following such excluded day, or days if two or more of them occur consecutively.

Power to dispense with evidence, signature, &c.

112. 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 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 to 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, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Applications to and Orders of Court.

Applications to Court.

113. Four clear days' notice of every application to the Court under Section 72 of the Act for rectification of the Register of Patents shall be given to the Comptroller.

Orders of Court.

Where any Order has been made by the Court under the Act revoking a patent or extending the term of a patent, or allowing a patentee to amend his specification or affecting the validity or proprietorship of a patent, the person in whose favour such order has been made shall forthwith leave at the Office an office copy of such Order together with Patents Form No. 34. The specification shall thereupon be amended or the Register rectified, or the purport of such Order shall otherwise be duly entered in the Register as the case may be.

Repeal.

Repeal.

114. All general Rules relative to patents heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1902, and in force on the Thirty-first day of December, 1907, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application or other matter then pending.

Dated the 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

THE FIRST SCHEDULE.

LIST OF FEES PAYABLE IN RESPECT OF THE GRANT OF PATENTS AND OF OTHER MATTERS WITH RELATION THERETO.

	£ s. d.	£ s. d.	Corresponding Form.
1. On application accompanied by Provisional Specification	1 0 0		Patents Form No. 1, 1A, 1B, or 1C.
2. On filing Complete Specification thereafter	3 0 0		Patents Form No. 3.
		4 0 0	
or			
3. On application accompanied by Complete Specification.		4 0 0	„ „
4. On appeal from Comptroller to Law Officer. By appellant.		3 0 0	Patents Form No. 4.
5. For extension of time under Rule 16:—			Patents Form
Not exceeding one month		2 0 0	No. 5.
„ two months		4 0 0	„ „
„ three months		6 0 0	„ „
6. For extension of time for leaving Complete Specification not exceeding one month.		2 0 0	Patents Form No. 6.
7. For extension of time for acceptance of Complete Specification:—			Patents Form
Not exceeding one month		2 0 0	No. 7.
„ two months		4 0 0	„ „
„ three months		6 0 0	„ „
8. On notice of opposition to grant of patent. By opponent.		0 10 0	Patents Form No. 8.
9. On hearing by Comptroller. By applicant and by opponent respectively.		1 0 0	Patents Form No. 9.
10. On sealing of patent		1 0 0	Patents Form No. 10.
11. For extension of time for sealing of patent where period allowed for the sealing of the patent will expire after the commencement of the Act:—			Patents Form
Not exceeding one month		2 0 0	No. 11.
„ two months		4 0 0	„ „
„ three months		6 0 0	„ „
12. For extension of time for sealing a patent where period allowed for the sealing of the patent has expired before the commencement of the Act.		10 0 0	Patents Form No. 12.
On certificate of renewal—			
13. Before the expiration of the fourth year from the date of the patent and in respect of the fifth year.		5 0 0	Patents Form No. 13.
14. Before the expiration of the fifth year from the date of the patent and in respect of the sixth year.		6 0 0	„ „

	£	s.	d.	Corresponding Form.
On certificate of renewal (*continued*)—				
15. Before the expiration of the sixth year from the date of the patent and in respect of the seventh year.	7	0	0	Patents Form No. 13.
16. Before the expiration of the seventh year from the date of the patent and in respect of the eighth year.	8	0	0	,, ,,
17. Before the expiration of the eighth year from the date of the patent and in respect of the ninth year.	9	0	0	,, ,,
18. Before the expiration of the ninth year from the date of the patent and in respect of the tenth year.	10	0	0	,, ,,
19. Before the expiration of the tenth year from the date of the patent and in respect of the eleventh year.	11	0	0	,, ,,
20. Before the expiration of the eleventh year from the date of the patent and in respect of the twelfth year.	12	0	0	,, ,,
21. Before the expiration of the twelfth year from the date of the patent and in respect of the thirteenth year.	13	0	0	,, ,,
22. Before the expiration of the thirteenth year from the date of the patent and in respect of the fourteenth year.	14	0	0	,, ,,
23. On enlargement of time for payment of renewal fees:—				
Not exceeding one month	1	0	0	Patents Form No. 14.
,, two months	3	0	0	,, ,,
,, three months	5	0	0	,, ,,
24. On application for restoration of a lapsed patent.	20	0	0	Patents Form No. 15.
25. On notice of opposition to application for restoration of lapsed patent.	1	0	0	Patents Form No. 16.
26. On hearing by Comptroller. By applicant and by opponent respectively.	1	0	0	Patents Form No. 9.
27. On application to amend specification:—				Patents Form
Up to sealing. By applicant	1	10	0	No. 17.
After sealing. By patentee	3	0	0	,, ,,
28. On notice of opposition to amendment. By opponent.	0	10	0	Patents Form No. 18.
29. On hearing by Comptroller. By applicant and by opponent respectively.	1	0	0	Patents Form No. 9.
30. On application to the Board of Trade for a compulsory licence. By person applying.	1	0	0	Patents Form No. 19.
31. On opposition to grant of compulsory licence. By opponent.	1	0	0	Patents Form No. 21.
32. On application to Comptroller to revoke a patent under Section 26.	2	0	0	Patents Form No. 22.
33. On hearing by Comptroller. By applicant and by patentee respectively.	2	0	0	Patents Form No. 9.
34. On offer to surrender a patent under Section 26	1	0	0	Patents Form No. 23.
35. On hearing by Comptroller. By applicant and by opponent respectively.	1	0	0	Patents Form No. 9.

	£ s. d.	Corresponding Form.
36. On application under Section 27 to Comptroller to revoke a patent worked outside the United Kingdom.	2 0 0	Patents Form No. 24.
37. On hearing by Comptroller. By applicant and by patentee respectively.	2 0 0	Patents Form No. 9.
38. For altering name or address, or address for service, in Register.	0 5 0	Patents Form No. 25.
39. For entry of two addresses for service in Register	0 5 0	Patents Form No. 26.
40. On request to enter name of subsequent proprietor in the Register of Patents.	0 10 0	Patents Form No. 27.
41. On request to enter notice of interest in the Register of Patents.	0 10 0	Patents Form No. 28.
42. On request to enter notification of a document in the Register of Patents	0 10 0	Patents Form No. 29.
43. On request to Comptroller to correct a clerical error:—		
Up to sealing	0 5 0	Patents Form No. 30.
After sealing	1 0 0	" "
44. For certificate of Comptroller under Section 78	0 5 0	Patents Form No. 31.
45. For duplicate of Letters Patent	2 0 0	Patents Form No. 32.
46. On notice to Comptroller of intended exhibition of an invention under Section 45.	0 10 0	Patents Form No. 33.
47. On notice of Order of Court for amendment of specification or rectification of Register.	0 10 0	Patents Form No. 34.
48. On postal request for printed specification ..	0 0 8	Patents Form No. 35.
49. Search or inspection fee	0 1 0	
50. For Office copies ... ... every 100 words (but never less than one shilling)	0 0 4	
51. For Office copies of drawings, cost according to agreement.		
52. For certifying Office copies, MSS. or printed, each	0 1 0	

D. LLOYD GEORGE,

President of the Board of Trade.

Dated the 17th day of December, 1907.

Approved—

JOSEPH A. PEASE,

J. H. WITLEY,

Lords Commissioners of His Majesty's Treasury.

THE SECOND SCHEDULE.

FORMS.	Corresponding Fee.
Patents Form No. 1.—Application for Patent	£1.
,, No. 1A.—Application for Patent communicated from abroad.	£1.
,, No. 1B.—Application for Patent under International and Colonial arrangements.	£1.
,, No. 1C.—Application for Patent of Addition ...	£1.
,, No. 1D.—Application for Secret Patent	—
,, No. 2.—Provisional Specification	—
,, No. 3.—Complete ,, ...	£3.
,, No. 4.—Appeal to Law Officer	£3.
,, No. 5.—Application for extension of Time under Rule 16.	£2, £4, or £6.
,, No. 6.—Application for extension of Time for leaving Complete Specification.	£2.
,, No. 7.—Application for extension of Time for acceptance of Complete Specification.	£2, £4, or £6.
,, No. 8.—Opposition to Grant of Patent	10s.
,, No. 9.—Notice that Hearing will be attended ...	£1 or £2.
,, No. 10.—Notice of Desire to have Patent sealed ...	£1.
,, No. 11.—Application for extension of Time for sealing of Patent, where period allowed for sealing of Patent will expire after commencement of Act.	£2, £4, or £6.
,, No. 12.—Application where period allowed for the sealing of the Patent has expired before the commencement of the Act.	£10.
,, No. 13.—Application for Certificate of Payment of Renewal.	£5 to £14.
,, No. 14.—Application for Enlargement of Time for Payment of Renewal Fee.	£1, £3, or £5.
,, No. 15.—Application for restoration of a lapsed Patent.	£20.
,, No. 16.—Notice of opposition to an application for restoration of a lapsed Patent.	£1.
,, No. 17.—Application to amend Specification ...	£1 10s. or £3.
,, No. 18.—Opposition to Amendment of Specification	10s.
,, No. 19.—Application for Grant of Compulsory Licence or Revocation of Patent.	£1.
,, No. 20.—Petition for Grant of Compulsory Licence or Revocation of Patent.	—
,, No. 21.—Opposition to Petition for Grant of Compulsory Licence or Revocation of Patent.	£1.
,, No. 22.—Application to the Comptroller for an Order for the Revocation of a Patent under Section 26 of the Act.	£2.
,, No. 23.—Offer to Surrender a Patent	£1.
,, No. 24.—Application for Revocation of a Patent under Section 27 of the Act.	£2.

FORMS.	Corresponding Fee.
Patents Form No. 25.—Notice of Alteration of Name or Address, or Address for Service, in Register.	5s.
„ No. 26.—Request to enter two Addresses for Service in Register.	5s.
„ No. 27.—Request to enter Name upon the Register of Patents.	10s.
„ No. 28.—Request to enter Notice of Interest in the Register.	10s.
„ No. 29.—Request to enter Notification of Document in Register.	10s.
„ No. 30.—Request for Correction of Clerical Error	5s. or £1.
„ No. 31.—Request for Certificate of Comptroller ...	5s.
„ No. 32.—Application for Duplicate of Patent ...	£2.
„ No. 33.—Notice of Intended Exhibition of Unpatented Invention.	10s.
„ No. 34.—Application for Entry of Order of Court...	10s.
„ No. 35.—On postal request for printed Specification	8d.

FORM A.

THE THIRD SCHEDULE.

FORM OF PATENT.

GEORGE V., 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 claims to be 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 always that these Letters Patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking Letters Patent granted by Us and the same may be revoked and made void accordingly: Provided also that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these Letters Patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our Letters Patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, We do by these presents for us, our heirs and successors, grant unto the said patentee that these our Letters Patent shall be construed in the most beneficial sense for the advantage of the said patentee.

In witness whereof We have caused these our letters to be made patent and to be sealed as of the
one thousand nine hundred and

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

Seal of Patent Office.

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

FORM B.

FORM OF PATENT OF ADDITION.

GEORGE V., 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 claims to be 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 that the said invention is an improvement in or modification of his invention for which a patent was applied for on and numbered and on which a patent (hereinafter called "the original patent") has been granted for which he was the applicant (or of which he is the patentee):

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 hath requested that the term limited in such patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired:

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 day of , being the date of the said original patent No. , or so much of that term as is unexpired: 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 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 always that these Letters Patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking Letters Patent granted by Us, and the same may be revoked and made void accordingly: Provided also that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of the said original Letters Patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided: and also if the said patentee shall not supply or cause to be supplied for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our Letters Patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted:

And lastly, We do by these presents for us, our heirs and successors, grant unto the said patentee that these our Letters Patent shall be construed in the most beneficial sense for the advantage of the said patentee.

In witness whereof We have caused these our letters to be made patent and to be sealed as of the one thousand nine hundred and

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

Seal of Patent Office.

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

Dated the 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

STATUTORY RULES AND ORDERS, 1907.

No. 951.

PATENTS.

THE REGISTER OF PATENT AGENTS RULES, 1908. DATED DECEMBER 17, 1907.

BY VIRTUE of the provisions of The Patents and Designs Act, 1907 (hereinafter referred to as "the Act"), the Board of Trade (hereinafter referred to as "the Board") do hereby make the following Rules:—

1. These Rules may be cited as "The Register of Patent Agents Rules, 1908."

Register to be kept.

2. A Register of Patent Agents shall be kept by the Chartered Institute of Patent Agents (hereinafter called "the Institute"), subject to the provisions of these Rules and to the Orders of the Board, for the registration of Patent Agents in pursuance of Section 84 of the Act. The Register of Patent Agents existing at the commencement of the Act shall be incorporated and form part of the Register of Patent Agents under the Act.

Contents of Register.

3. The Register shall contain in one list all Patent Agents who are registered under the Act and these Rules.

Such list shall be made out according to the surnames of the registered persons, and shall also contain the full name of each registered person, with his address, the date of registration, and a mention of any honours, memberships, or other additions to the names of the registered persons which the Council of the Institute may consider worthy of mention in the Register. The Register shall be in the Form 1 in Appendix A., with such variations as may be required.

Printed copies to be published annually, and to be evidence of contents of Register.

4. The Institute shall cause a correct copy of the Register, but with the names arranged alphabetically, to be printed under their direction and published and placed on sale. Such correct copy shall be printed and published not later than the end of February in each year. A copy of the Register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the Register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act or any Act repealed by the Act.

Registrar.

5. The Institute shall continue in office or appoint a Registrar, who shall keep the Register in accordance with the provisions of the Act and these Rules, and, subject thereto, shall act under the directions of the Institute and the Board.

Registration of persons who were Patent Agents prior to the passing of this Act.

6. A person who is desirous of being registered in pursuance of the Act on the ground that prior to the 24th day of December, 1888, he had been *bonâ fide* practising as a Patent Agent, shall produce or transmit to the Board a statutory declaration in the Form 2 in Appendix A: Provided that the Board may, in any case in which they shall think fit, require further or other proof that the person had prior to the passing of the Act been *bonâ fide* practising as a Patent Agent. Upon the receipt of such statutory declaration, or of such further or other proof to their satisfaction, as the case may be, the Board shall transmit to the Registrar a certificate that the person therein named is entitled to be registered in pursuance of the Act, and the Registrar shall on the receipt of such certificate cause the name of such person to be entered in the Register.

Final qualifying examination for registration.

7. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board that prior to the 24th day of December, 1888, he had been *bonâ fide* practising as a Patent Agent, no person shall be entitled to be registered as a Patent Agent unless he has passed, and produces or transmits to the Registrar a certificate under the seal of the Institute

that he has passed, such final examination as to his knowledge of Patent Law and Practice and of the duties of a Patent Agent as the Institute shall from time to time prescribe.

Exemption of pupils and assistants from preliminary examination.

8. Any person who has been for at least five years engaged as a pupil or technical assistant to one or more registered Patent Agents, and any person for the time being entitled to practise as a Solicitor of the Supreme Court of Judicature in England or Ireland, or as a Law Agent before the Court of Session in Scotland, shall be entitled to be registered without passing any examination other than the final examination provided for in the last preceding Rule.

Qualifications of persons generally for registration.

9. Any person who is not qualified under Rule 8 must, in order to be entitled to present himself for the final qualifying examination, be—

A person who has passed one of the preliminary examinations which the Institute shall by regulation prescribe.

Final qualifying examinations to be held by the Institute.

10. The Institute shall hold at least once in every year a final qualifying examination which shall be the final qualifying examination required under Rules 7 and 8; and the Institute shall, subject to these Rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters: that is to say—

(*a*) The subjects for and the mode of conducting the examination of candidates;

(*b*) The times and places of the examinations, and the notices to be given of examinations;

(*c*) The certificates to be given to persons of their having passed the examinations;

(*d*) The appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and

(*e*) Any other matter or thing as to which the Institute may think it necessary to make regulations for the purpose of carrying out this Rule.

Corrections of names and addresses in Register.

11. The Registrar shall from time to time insert in the Register any alteration which may come to his knowledge in the name and address of any person registered.

Erasure of names of deceased persons.

12. The Registrar shall erase from the Register the name of any registered person who is dead.

Erasure of names of persons who have ceased to practise.

13. The Registrar may erase from the Register the name of any registered person who has ceased to practise as a Patent Agent, but not (save as hereinafter provided) without the consent of that person. For the purposes of this Rule the Registrar may send by post to a registered person to his registered address a notice inquiring whether or not he has ceased to practise or has changed his residence, and if the Registrar does not within three months after sending the notice receive an answer thereto from the said person, he may, within fourteen days after the expiration of the three months, send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the Registrar; and if the Registrar either before the second notice is sent receives the first notice back from the dead letter office of the Postmaster-General, or receives the second notice back from that office, or does not within three months after sending the second notice receive any answer thereto from the said person, that person shall, for the purpose of this Rule, be deemed to have ceased to practise, and his name may be erased accordingly.

Erasure of name for non-payment of fees.

14. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the Registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered Patent Agent shall not within one month from the day named in such notice pay the registration fee so due from him, the Registrar may erase his name from the Register: Provided that the name of a person erased from the Register under this rule may be restored to the Register by direction of the Institute or the Board on payment by such person of the fee or fees due from him, together with such further

sum of money, not exceeding in amount the annual registration fee, as the Institute or the Board (as the case may be) may in each particular case direct.

Registrar to act on evidence.

15. In the execution of his duties the Registrar shall, subject to these Rules, in each case act on such evidence as appears to him sufficient.

Erasure of incorrect or fraudulent entries.

16. The Board may order the Registrar to erase from the Register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

Erasure of names of persons convicted of crimes, and persons found guilty of disgraceful conduct.

17. If any registered person shall be convicted in His Majesty's Dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanour, or, after due inquiry, is proved to the satisfaction of the Board to have been guilty of disgraceful professional conduct, or having been entitled to practise as a Solicitor or Law Agent shall have ceased to be so entitled, the Board may order the Registrar to erase from the Register the name of such person: Provided that no person shall be adjudged by the Board to have been guilty of disgraceful professional conduct unless such person has received notice of, and had an opportunity of defending himself from, any charge brought against him.

Restoration by Board of erased name.

18. Where the Board direct the erasure from the Register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the Register, except by order of the Board.

The Board may in any case in which they think fit restore to the Register such name or entry erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee, as the Board may from time to time fix, and the Registrar shall restore the name accordingly.

Inquiry by Board of Trade before erasure of name from Register.

19. For the purpose of exercising in any case the powers of erasing from and of restoring to the Register the name of a person, or an entry, the Board may appoint a committee consisting of such persons as they shall think fit. Every application to the Board for the erasure from, or restoration to, the Register of the name of any Patent

Agent shall be referred for hearing and inquiry to the committee, who shall report thereon to the Board, and a report of the committee shall be conclusive as to the facts for the purpose of the exercise of the said powers by the Board.

Restoration by Institute of erased name.

20. The name of any person erased from the Register at the request or with the consent of such person shall, unless it might, if not so erased, have been erased by order of the Board, be restored to the Register by the Registrar on his application and on payment of such fee, not exceeding the registration fee, as the Institute shall from time to time fix.

Appeal to Board of Trade.

21. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board.

Notice of appeal.

22. A person who intends to appeal to the Board under these Rules (in these Rules referred to as the appellant) shall, within fourteen days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the Institute a notice in writing signed by him of such his intention.

Case on appeal.

23. The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

Transmission of notice of appeal to Board of Trade.

24. The appellant shall also, immediately after leaving his notice of appeal at the Institute, send by post a copy thereof, with a copy of the appellant's case in support thereof, addressed to the Secretary of the Board of Trade, 7 Whitehall Gardens, London.

Directions as to hearing appeal.

25. The Board may thereupon give such directions, if any, as they may think fit for the purpose of the hearing of the appeal.

Notice of hearing of appeal.

26. Seven days' notice, or such shorter notice as the Board may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the Institute and the Registrar.

Hearing and decision of appeal.

27. The appeal may be heard and decided by the Board, and such decision may be given or order made in reference to the subject-matter of the appeal as the case may require.

Fees.

28. The fees set forth in Appendix B to these Rules shall be paid in respect of the several matters, and at the times and in the manner therein mentioned. The Board may from time to time alter any of, or add to, the fees payable under these Rules.

Alteration of regulations.

29. Any regulation made by the Institute under these Rules may be altered or revoked by a subsequent regulation. Copies of all regulations made by the Institute under these Rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board, and if, within twenty-eight days after a copy of any regulation has been so transmitted, the Board by an order signify their disapproval thereof, such regulation shall be of no force or effect; and if, after any regulation under these Rules has come into force, the Board signify in manner aforesaid their disapproval thereof, such regulation shall immediately cease to be of any force or effect.

Report to Board of Trade.

30. The Institute shall once every year, in the month of March, transmit to the Board a report stating the number of applications for registration which have been made in the preceding twelve months, the nature and results of the final examinations which have been held, and the amount of fees received by the Institute under these Rules, and such other matters in relation to the provisions of these Rules as the Board may from time to time require.

Commencement.

31. These Rules shall come into operation from and immediately after the 31st December, 1907, and all general rules relative to the Register of Patent Agents in force on the 31st December, 1907, shall be and are hereby repealed as from that date without prejudice nevertheless to any thing done under such Rules or to any application or other matter then pending.

Dated the 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

PART II.

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 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 thirteen enactments were passed relating to the protection of designs, the bulk of these Acts being indicated in the Third Schedule of the now repealed Act of 1883, and in the Second Schedule of the present Act of 1907.

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, 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

Extension to Ireland.

Creation of Register of Proprietors.

Metal work designs.

time extended the field of articles to which 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 particularised. The different goods susceptible of treatment were classified, and, in addition to the recovery of penalties for piracy, the proprietor was given a statutory right of action for damages.

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.

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.

Provisional registration.

Acts of 1858 to 1875.

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.

Register entrusted to Commissioners of Patents.

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

The whole of these prior Acts then surviving were repealed by the Patents, Designs, and Trade Marks Acts of 1883 to 1901. These in turn were displaced by the present Patents and Designs Act, 1907, and it is by virtue of this Act, together with the Designs Rules of 1908, that the registration of designs is regulated and governed at the present day.

Formerly two types of design "ornamental" and "useful."

The reader will note that, prior to the repealed Act of 1883, 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.

Distinction now abolished.

By the Act of 1883, and under the present Act of 1907, this distinction between "ornamental" and "useful" designs is abolished, and a design is registered for the ornament or pattern, or for the shape or configuration, the latter not necessarily meaning a beautiful or artistic shape or configuration.

Utility not considered.

As to any *useful effect* that may be brought about by the shape or configuration of a design, registration gives no claim in respect of this. The shape or design must appeal to and be judged by the eye alone, and the Court will disregard all reference to the useful effect, if any such exists.

Heela Foundry v. Walker.

Thus, in *Heela Foundry Co.* v. *Walker, Hunter & Co.* (1889, 6 R. P. C. 554), the Lower Courts, hampered probably by some reminiscences of the extinct Useful Designs registration, instanced the useful effect of the registered design of a kitchen range fire-door as one of the reasons for recognising and maintaining the validity of the registration. But the Judges in the House of Lords, while upholding the decision of the Courts below, expressly pointed out that the *utility* of the design must not be allowed to influence the question in any respect.

The only test is that of novelty and originality.

The propriety of this view has never since been doubted, and in *re Morton's Design* (1900, 17 R. P. C. 117) Mr. Justice Farwell, when the question of utility was raised, said: "What you have to see is whether, tested by the eye, the design is novel or original within the meaning of the Act. That it may be useful seems to me to be immaterial, because I think it must be admitted that, however useless a novel design may be, it would still be within the meaning of the Act if it were novel or original."

Question of utility abolished.

Let it then be clearly understood that under the present Statute, as under the repealed Act of 1883, 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. It must be something appreciable by the eye, and the representation or sample must convey full knowledge of what the design is. *Per* Moulton, L. J., in *Bayer's Design* (1906, 24 R. P. C., p. 77), "Nothing in my opinion is a good design but that of which full knowledge is given when you have once shown to the eye what your design is. It may be shape or configuration that is given by a specimen or by a proper drawing, and the eye can see it, and the eye can recognise whether it has been imitated. It may be a pattern to which the same applies. It may be an ornament to which the same applies. But in my opinion nothing beyond that, can rightly be called a design within the meaning of the Statute." Examples instanced in the succeeding pages will show how small a difference may constitute a good 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.

Moulton, L. J., *re*, requisites of design.

New features of present Act.

As compared with the repealed Acts, the present Statute of 1907 has made no very essential changes, and except in one or two instances, which will be pointed out in their proper place, the law relating to designs, as established by existing decisions, is not materially altered. The chief points of novelty in the new Act are as follows:—

Publication of design in other classes.

(1) Publication of a design registered in one class will not act as anticipation of the registration by the same proprietor of the same design in another class (Section 50).

Extension of copyright.

(2) The period of copyright in a design (five years) can be extended for another period of five years by the proprietor on payment of a fee: and may, at the discretion of the Comptroller, be extended for a third period of five years (Section 53).

Effects of failure to mark.

(3) Failure to mark each article with the sign of registration before delivery on sale will not,

as formerly, *ipso facto*, cause the copyright to cease, but will merely deprive the proprietor of the right to recover any penalty or damages against an infringer, unless he shows (*a*) that he took all proper steps to ensure the marking, or (*b*) proves that the infringer at the date of the infringement knew of the existence of the copyright in the design (Section 54).

Confidential disclosure.

(4) Confidential disclosure before registration, or acceptance of a confidential order, will not constitute prior publication (Section 55).

Manufacture abroad: cancellation of copyright.

(5) Copyright in a design may be cancelled at any time after registration on the application of any person, on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom. In such an application the provisions of the Act with respect to the revocation of patents under Section 27 shall apply with the necessary modifications, the decision of the Comptroller to be final (Section 58).

Certificate of validity.

(6) In actions for the infringement of designs, a plaintiff may obtain a certificate that the validity of his registration has been called in question (Section 61).

Threats action.

(7) Any person who has been subjected to groundless threats by the proprietor of a registered design may take action for the restraint of such threats as in the case of patents.

Penalty for marking after expiry of copyright.

(8) Any person who marks an article as "registered" after the copyright has expired, is liable to a fine not exceeding five pounds (Section 89, Sub-section 4).

Following the convenient arrangement of the preceding portion 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.

Classification of goods.

Under the Designs Rules of 1908, goods to which registered designs may be applied are divided into sixteen classes, and the fees vary according to the class. The following Schedule shows the classification of the goods, and in each class the corresponding Form is indicated, together with the fee payable:—

CLASSIFICATION OF GOODS.

CLASS 1.—Articles composed wholly of metal, or in which metal predominates, not included in Class 2. (Form 2. Fee 5s.)

CLASS 2.—Jewellery. (Form 2. Fee 5s.)

CLASS 3.—Articles composed wholly of wood, bone, ivory, papier maché, or other solid substances not included in other classes, or of materials in which such substances predominate. (Form 2. Fee 5s.)

CLASS 4.—Articles composed wholly of glass, earthenware, or porcelain, bricks, tiles, or cement, or in which such materials predominate. (Form 2. Fee 5s.)

CLASS 5.—Articles composed wholly of paper (except paper hangings), cardboard, millboard, or strawboard, or in which such materials predominate. (Form 2. Fee 5s.)

CLASS 6.—Articles composed wholly of leather, or in which leather predominates, and bookbinding of all materials. (Form 2. Fee 5s.)

CLASS 7.—Paperhangings. (Form 2. Fee 5s.)

CLASS 8.—Carpets and rugs in all materials, floorcloths, and oilcloths. (Form 2. Fee 2s. 6d.)

CLASS 9.—Lace. (Form 4. Fee 1s. If for a set, on Form 5. Fee 2s.)

CLASS 10.—Hosiery. (Form 2. Fee 5s.)

CLASS 11.—Millinery and wearing apparel, including boots and shoes. (Form 2. Fee 5s.)

CLASS 12.—Ornamental needlework on muslin or other textile fabrics. (Form 2. Fee 5s.)

CLASS 13.—Printed or woven designs on textile piece goods (other than checks or stripes). (Form 1 (Manchester). Fee 2s. 6d.)

CLASS 14.—Printed or woven designs on handkerchiefs and shawls (other than checks or stripes). (Form 1 (Manchester). Fee 2s. 6d.)

CLASS 15.—Printed or woven designs (on textile piece goods or on handkerchiefs or shawls), being checks or stripes. (Form 4. Fee 1s.)

CLASS 16.—Goods not included in other classes. (Form 2. Fee 5s.)

Application forms.

Stamped forms of application to register 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, as these would have merely increased the bulk of the book without sufficiently corresponding advantages. By following the marginal instructions on the application forms, no mistake need be made by the applicant in filling in the particulars.

Formerly, a statement was required of the "nature" of the design, and whether it was applicable for the "pattern or for the shape."

No statement of "nature" of design.

The present Rules require no such statement, except that by Rule 30 the applicant may, and if the Comptroller requires it must, state what is the novelty in his design. This requirement, if it arises, will undoubtedly necessitate care on the part of the applicant, as a mis-statement might be fatal to the validity of registration.

Object of simplification of Rules.

It is evident that this stripping away from the Rules and forms of the former obligations imposed upon the applicant of making statements concerning the nature of his design is the logical result of the view the Courts take of designs, and their constant references to the eye as being the ultimate Court of Appeal. Practically, all that the applicant need do is to materialise a picture or sample of his design, state the goods to which it is to be applied; and without comment or explanation leave it to the eye of the Court to decide whether it has been imitated or not.

The following directions will assist applicants in preparing their papers:—

Signature of application.

The form of application for registration of a design should be signed by the applicant for registration or by his authorised agent.

Form of application.

Except as regards applications in Classes 13, 14, and 15, an application for registration of a design shall be lodged at the Office,

and (except as regards applications for lace designs in Class 9) shall be on Form Designs No. 2, or in the case of a set, on Form Designs No. 3.

Lace designs.

An application for registration of a lace design in Class 9 is made on Form Designs No. 4, or in the case of a set on Form Designs No. 5.

Acknowledgment of application.

On or after receipt of an application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Class.

An application should state the class in which the design is to be registered, and where it is desired to register the same design in more than one class, a separate application shall be made in each class. In that case each application shall be numbered separately and shall be treated as a separate and distinct application.

Application of design.

Every application shall state the article or articles to which the design is to be applied, and, where the Comptroller so requires, the applicant shall further state for what purpose the article to which the design is to be applied is used and the material or the predominating material of which the article is made.

Statement of novelty.

The applicant may, and shall if required by the Comptroller in any case so to do, indorse on the application a brief statement of the novelty he claims for his design, and where representations are furnished shall indorse each with such statement, if any.

Representations.

Except as regards applications in Classes 13, 14, and 15, there shall be furnished, in connection with an application for the registration of a design to be applied to a single article, three exactly similar drawings, photographs, tracings or other representations of the design, or three specimens.

Representations for set, and in Classes 13, 14, and 15.

There shall be furnished, in connection with an application for the registration of a design to be applied to a set, four exactly similar drawings, photographs, tracings, or other representations of the design, or four specimens: in connection with an application in any one of the Classes 13, 14, and 15, there shall be furnished six such representations, or six specimens.

Nature of representations.

Each representation of the design, or set of designs, must be upon paper of the prescribed size and not on cardboard, and must appear on one side only of the paper. The figure or figures must be placed in an upright position on the sheet. When more figures than one are shown, these should where possible be on one and the same sheet, and each should be designated on the sheet (*e.g.*, front view, side view).

Drawings, &c., must be in ink.

When drawings or tracings are furnished, they must be in ink, and if on tracing cloth or tracing paper must be mounted on paper of the prescribed size.

Representations for set.

When the design is to be applied to a set, each of the representations accompanying the application should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

Special representations.

When the specimens are not, in the Comptroller's opinion, of a kind which can be conveniently pasted into books, representations shall be furnished for insertion in the register and for official purposes.

Words, &c., on designs.

Where words, letters, or numerals are not of the essence of the design, they shall be removed from the representations or specimens.

Repeat of pattern.

Each representation of a design which consists of a repeating surface pattern must show the complete pattern and a sufficient portion of the repeat in length and width, and ought not to be of less size than seven inches by five inches.

Specimens of designs.

Where *representations are supplied*, the *Comptroller shall also* be supplied, if in any case he so requires, with a specimen.

Additional representations or specimens.

The Comptroller shall be furnished with more representations or more specimens of any design if he requires them.

Representations of living persons or persons recently dead.

Where the names or representations of living persons appear on a design, the Comptroller shall, if he so require, be furnished with consents from such persons before proceeding to register the design. In the case of persons recently dead, the Comptroller may call for consents from their legal representatives before proceeding with registration of a design on which their names or representations appear.

When the papers have been completed, they should be delivered or sent by post to:—

The Comptroller,
Patent Office (Designs Branch),
25 Southampton Buildings,
Chancery Lane,
London, W.C.

Acceptance.

Upon receipt of an application for registration, the Comptroller shall consider it, and if he thinks there is no objection to the design being registered, he may accept it.

Objections.

If, after consideration of the application, any objections appear, a statement of these objections shall be sent to the applicant in writing, and unless within one month the applicant applies for a hearing, he shall be deemed to have withdrawn his application.

Decision of Comptroller.

The decision of the Comptroller at such hearing as aforesaid shall be communicated to the applicant in writing, and if he objects to such decision, he may within one month, should he consider it necessary for the purpose of appeal, apply upon Form Designs No. 7 requiring the Comptroller to state in writing the grounds of his decision, and the materials used by him in arriving at the same.

Appeal to Board of Trade.

Upon receipt of such form the Comptroller shall send to the applicant such statement as aforesaid in writing, and the date when such statement is sent shall be deemed to be the date of the Comptroller's decision for the purpose of appeal; but if the applicant does not apply for the grounds of the Comptroller's decision, appeal shall be lodged within one month from the date of the decision.

Non-completion within twelve months.

Where an application for registration of a design is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Comptroller shall give notice to the applicant in writing of such non-completion, and if the applicant has an agent, shall send a duplicate of such notice to such agent. If, after fourteen days from the date when such notice was sent

the application is not completed, the application shall be deemed to be abandoned, but the Comptroller may with such notice, where the applicant lives at such distance from the Office that he cannot reasonably be expected to do what is necessary within such fourteen days, give a further time after such fourteen days for the completion of such application.

Death of applicant before registration.

In case of the death of any applicant for the registration of a design after the date of his application, and before the design applied for has been entered in the Register, the Comptroller may, on being satisfied of the applicant's death, enter in the Register, in place of the name of such deceased applicant, the name, address, and description of the person owning the design, on such ownership being proved to the satisfaction of the Comptroller.

Appeal to Board of Trade.

It will have been noted that in the event of the Comptroller refusing to register any design the applicant may appeal to the Board of Trade within one month from the date of the decision, or within one month from the sending of the Comptroller's grounds for his decision, if these have been required. This is in accordance with Rules 33 and 34, which are based on Sub-section 3 of Section 49 of the Act. According to the sub-section "the Board shall, after hearing the applicant and the Comptroller, if so required, make an order determining whether, and subject to what conditions, if any, registration is to be permitted." The Designs Rules regulating appeals to the Board of Trade are as follows:

Rules regulating appeals.

Appeals to the Board of Trade.

Appeal to Board of Trade.

89. When any person intends to appeal to the Board of Trade he shall, before doing so, apply to the Comptroller for a hearing, and may, if he considers it necessary, obtain the grounds of the Comptroller's decision. Within one month from the date of such decision, or from the date of the issue of the grounds thereof, if such have been issued, he shall, if he is advised to appeal to the Board of Trade, lodge a notice of such his intention on Form Designs No. 25, accompanied by a copy of the form of application and six representations of the design applied for and a copy of the grounds of the Comptroller's decision, if any grounds have been issued.

Grounds of appeal to be stated.

90. Such notice shall also be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

Transmission of notice.

91. A copy of the notice and all the accompanying documents shall also be forthwith sent by the appellant to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London.

92. The Board of Trade may thereupon give such directions, if any, as they may think fit with respect to parties and evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade. Directions by Board.

93. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given by the Board of Trade to the Comptroller and to the appellant. Hearing of appeal.

94. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade. No appeal unless notice duly given.

The decision of the Board of Trade is final. There is no provision as to costs. Registration, when effected, is as of the date of application. Final decision.

When registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered. During the existence of the whole five years' copyright in a design in Classes 13, 14, and 15 (*i.e.* textile piece goods designs, and designs on handkerchiefs and shawls), 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. In the case of the remaining Classes, the period after which the design shall be open to inspection under the same conditions is limited by Designs Rule 69 to two years from the date of registration. 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 is still in force, and when and by whom it was registered, may obtain the information he requires by producing or sending the design to the Comptroller, and paying the prescribed fee. If he can supply Searches by Comptroller.

the Comptroller with the registration number, the enquiry is made on Form 19 with a fee of one shilling. If the enquirer cannot supply the registration number, Form 20 is used, and the fee is two shillings and sixpence.

A still more valuable pr ision in Rule 60 empowers the Comptroller, on payment of a fee of two shillings and sixpence, to make a search among the registered designs for the purpose of finding whether a design produced by the person requesting the search is, in the Comptroller's opinion, identical with, or an obvious imitation of, any registered design still in force.

Comptroller's certificate not evidence.

This is a precautionary measure that might be recommended to manufacturers who contemplate the production of a design, concerning which they may have any doubt. It must, however, be said that if, even after receiving the Comptroller's certificate that it is *not* an obvious imitation, the owner of a registered design should take action on the ground that it *is* an obvious imitation, the Comptroller's certificate is not admitted as evidence on the defendant's behalf, and has no weight with the Court.

Register of Designs.

Proprietor entered 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 13, is stamped with ten shillings. The assignment or licence must be in writing. Where a person so entitled makes application for an entry in the Register, conjointly with the registered proprietor, they should apply on Form 11, with a fee corresponding to the original registration fee in the class to which the design belongs.

Request for entry.

In either case, together with the application, the claimant must leave a statement giving full particulars of the assignment, mortgage, licence, instrument, or other transfer under which he claims entry on the Register. If the Comptroller thinks the applicant entitled, he may still call on him for a statutory declaration on Form 14 verifying the several statements, and, if satisfied, will enter his interest on the Register.

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.

Duty of person in whose favour order of Court has been made.

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, together with the Form 26 if required, 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.

Register of Designs *primâ facie* evidence.

The Register of Designs shall be *primâ facie* evidence of any matters directed or ordered by the Act to be entered therein.

Certificate of entry.

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 22, which is stamped with five shillings.

Industrial and International Exhibitions.

Exhibition of unregistered designs.

Any person desirous of exhibiting an unregistered design or publishing a description of such design at an industrial or international exhibition, certified so to be by the Board of Trade in pursuance of Section 59 of the Act, should give the Comptroller notice of his intention to exhibit, and such notice must be given upon Form 24, 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 59, Sub-section 2) notice to the Comptroller is excused.

Duration of Copyright.

Duration of copyright.

The *Duration of Copyright* is limited to five years from the date of resignation. Before the coming into force of the present Act there was no provision for extension of this time. Now, however, by Section 53, Sub-sections 2 and 3, the original term of five years can be extended to a further term of five years on payment of a fee of one pound (Form 8). The Comptroller has no discretion to refuse such an application to extend, for the sub-section says that he "shall" do it on payment of the fee. But this does not exhaust the possible period of extension, for Sub-section 3 says that on the expiration of the second five years, application may be made for a further five years extension. But here the discretion of the Comptroller is given play, for the sub-section only says that the Comptroller "may" extend the period. What will govern the Comptroller in the exercise of his discretion it is at present impossible to say: Perhaps the same considerations that weighed with the Privy Council in petitions for extensions of patents. The Rules are silent on the reasons that may influence the Comptroller, and no provisions are made for advertising the application to prolong. For the final extension the fee on application (Form 9) is ten shillings, and on extension (Form 10) thirty shillings.

Extension of term.

Section 58 of the present Act replaces Section 54 of the Act of 1883, and in effect applies the patent revocation provisions of Section 27 to designs.

The terms of this section are as follows:—

Cancellation of registration of designs used wholly or mainly abroad.

58. (1) At any time after the registration of a design any person may apply to the Comptroller for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom, and where such an

application is made, the provisions of this Act with respect to the revocation of patents worked outside the United Kingdom (including those relating to costs) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the Comptroller.

(2) Such ground as aforesaid shall be available by way of a defence to an action for infringement of the copyright in the design.

Copyright extends only to United Kingdom.

It might be thought needless to say that the protection accorded to designs by The Patents and Designs Act, 1907, 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 E).

A tort created by a British Statute must, to be actionable, have been committed in this country.

The Act extends to the Isle of Man, but nothing in the Act 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 96 of the Act, Appendix B). Copyright in a registered design does not cover the Channel Islands.

International and Colonial Arrangements.

Convention applications.

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 91 and Appendix E).

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 or sold it to another person for a good or valuable consideration.

To be precise, the words of Section 93 of the Act which purport to define the "Proprietor" of a design are as follows:—

PROPRIETOR OF A NEW AND ORIGINAL DESIGN

Definition of "Proprietor."

(*a*) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and

(*b*) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(*c*) In any other case, means the author of the design; and

where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

Master and servant.

Section 5 of the old Act of 1842, and Section 61 of the Act of 1883 were much to the same effect, and under the older 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 designer 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 plaintiffs' title."

Exclusive licensees to sell cannot register as proprietors. *Lazarus* v. *Charles*.

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.

Jewitt v. *Eckhardt*.

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).

Agent for foreign principals.

Where a design was mistakenly registered by an agent of the designer in his own name instead of in that of his principal, but without any fraudulent intent, the Court ordered the principal's name to be substituted for

Bonâ fide mistaken and non-fraudulent registration may be

cured by substitution of true author's name.

Grocott's Design.

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. If in the meantime the design had been published, the rightful proprietor of the design might claim the protection of Section 55 against the wrongful disclosure. Otherwise re-registration by the true author would be futile, unless the Court were to order that the new registration should be of the same date as the original wrongful entry, as where a patent has been revoked on the ground of fraud upon the true inventor (Section 15, Sub-section 2). Failing either of these remedies, 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 13, 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 registor 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 93 of the Act to mean any design (not being a design for a sculpture or other thing within the protection of The Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined.

Must be capable of application to some article of manufacture.

"Article."

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial or partly natural.

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 on metal 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 cravat or motor-cycle frame; or, as the Act says, the

Design may combine ornament, pattern, and shape.

design may contain two or all of the foregoing elements—*i.e.* ornament, pattern, shape, and configuration.

Qy. as to architectural designs.

At the present day an agitation is being carried on to secure the protection of architectural designs so that any person who designs or owns a house, for example, may register its appearance and so prevent an imitator from building another precisely similar, next door or in close proximity to the original. The Patent Office apparently thinks that the design of an edifice is registrable. In

Staples v. *Warwick* (1906, 23 R. P. C. 609) the plaintiff had registered the design of a tower having certain architectural characteristics. In an action brought by the proprietor to restrain imitation, although he failed to prove infringement, the Court of Appeal assumed that the registration was good, that point not being before it for decision. It is arguable that the word "article," which is defined in the section as "any article of manufacture" might be held to include a building fixed to the soil. If parts of a building, such as a doorway, mantelpiece, or the like, can be made valid subject-matter of copyright, why not the whole? As the period of copyright can now be prolonged to fifteen years, there is some temptation to register the design of a building, and a test case would be interesting. If a man's representatives can prevent the design of his tombstone from being copied (*Holden* v. *Hodgkinson*, 1904, 22 R. P. C. 102) why should not the man himself, while living, be able to prevent his dwelling place from being imitated?

No utility necessary.

To return to surer ground, 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.

Range fire-door.

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*

"Shape" in design.

to be registered." The defendants (the appellants in the House of Lords) had infringed by using a similar fire-door.

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 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."

Utility must not be considered.

The eye to be the judge.

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."

Moody v. *Tree*: Woven Basket Case.

Cooper v. *Symington*: Corset Case.

Farwell, J., on utility in *Morton's Design*: Cuff-link.

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

Instance of very slight subject-matter. *Walker* v. *Scott*.

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 in the pocket 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. *Gamage* (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.

But a patentable invention might be bad subject-matter for design.

Moody v. *Tree*.

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 a 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. A similar decision was arrived at in *Bayer's Design* (1907, 25 R. P. C. 56), where registration of the design of a corset was upset in the House of Lords on the ground that the so-called design was merely a pictorial representation of a method of manufacture (*per* Lord Macnaghten). The same learned Lord said in the course of his judgment: "Although a design properly so-called and duly registered may incidentally protect a method of manufacture, it is clear that a mere method of manufacture cannot be registered as a design under the Act."

Method of manufacture not registrable.

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 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.

Cooper v. *Symington.*

A design must be judged from its appearance, not its uses.

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

Combination designs.

Harrison v. *Taylor.*

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.

The combination must show some ingenuity.

There is no doubt whatever that when a combination of old elements produces a new effect, although it may not involve the exercise of any great taste or 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 novelty or originality in the combination, the result is not so likely to be upheld as a good registrable design. 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 *Ricell* v. *Grimshaw* (1894, 11 R. P. C. 351) a combination of a bassinette and mailcart was held to be a good registrable design.

Mere slight *changes in* style and shape of common article not subject-matter.

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,

Le May v. *Welch.*

and make the Patents, Designs, and Trade Marks Acts a trap to catch honest traders."

Example of bad subject-matter.

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.

Some originality must be apparent.

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. *Welsh* (*supra*), and quoted with approval the remarks 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.

Smith v. *Hope Bros.*

Commercial success may help to sustain design.

The question of what constitutes good subject-matter for registration as a design would be incomplete without a reference to the adaptation of existing and well-known

things, such as famous objects or buildings, to the purposes of design, as applied to manufactured goods. It seems only reasonable to suppose that if someone adapts a view or picture of some thing, or some personality, whether it be a flower, or landscape, a building, or a statesman, and applies that representation or picture to some article of manufacture, he should be allowed to register it as a new design, and should be protected in such a specific adaptation. His right may perhaps be open to cavil if the representation he made use of was common and well known, such as a well-known photograph or engraving, although even this might not affect his right. But suppose the particular representation or view he uses is one produced or procured by himself, it might be asked why such adaptation should not be fit subject-matter for registration as a design for application to certain specified manufactured goods, according to the Act. It used to be said in text-books upon the subject of Designs Copyright that a copy of a photograph of a well-known public character applied to manufactured objects is not a new or original design within the meaning of the Act. The decision upon which this assertion is based occurred in the case of *Adams* v. *Clementson* (1879, 12 Ch. D. 714). But this case turned on the old Act of 5 & 6 Vict. c. 100, Section 3, which was differently worded from the corresponding section 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.

Adaptation of well-known objects and personages as subject matter for designs.

Adams v. *Clementson*.

Saunders v. *Wiel*.

Portrait on earthenware.

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.

A modelled view of Westminster Abbey on spoon handle held good subject-matter.

In the Court of Appeal the decision of the Lower Court was upheld, and the adverse remarks of Cave, J., upon the decision in *Adams* v. *Clementson* were strongly endorsed by Lindley and Bowen, L. JJ. As was said by Lindley, L. J.: "What we have to consider is this: whether this registered design—for a design of some sort of course it is—is a design applicable for the pattern and for the shape to things in Class 1, and in particular forks and spoons, and whether it is a new or original design not previously published in the United Kingdom. Now 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."

Lindley, L. J., on new and original designs.

Present restriction on the registration of names and portraits.

So common has it become to incorporate the portrait or name of some celebrity in designs, that Rule 30 of the new Designs Rules requires that where the names or representations of living persons or of persons recently dead appear on a design, the Comptroller may require the consent of the living person or of the legal representative of the dead person before proceeding with the registration.

Mere substitution of one material for another in the same article does not make it a new design.

It has 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.

Nevertheless, 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 may constitute subject-matter.

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*:

Drawing not necessarily conclusive as to form of design.

Lord Herschell on variations from known designs.

"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."

Defects in drawing not necessarily fatal.

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. The Rules require that different views and sections may be given on the drawing, and by Rule 19 the applicant may of his own volition, or at the request of the Comptroller, endorse, on his application and drawing, a brief statement of the point of novelty he claims.

CHAPTER V.

NOVELTY.

ACCORDING to Section 49 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): "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): "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.

Design must be new or original.

Must be new with reference to the goods to which it is applied.

Distinction between "new" and "original."

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.

Novelty considered with reference to state of prior knowledge.

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,

Not generally new if registered in other class.

Design old in furniture may be new in a kitchen range.

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 or gas lamp cannot be new simply because it is applied to an electric lamp (*Clarke's Design, supra*).

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. *Basteudorff* (1893, 10 R. P. C. 160) the defendant pleaded that a sample of the writing-table which embodied the design had, before registration, been submitted by the plaintiff to a customer, who had altered and returned it. It was held by Day, J., that this did not constitute publication. But where, as in *Blank* v. *Footman* (1888, 5 R. P. C. 653), the inventor of a new lace design had shown and handed a sample of the lace to his agent, and the agent had in turn shown the sample in an alleged confidential manner to two selected customers, who gave orders and kept cuttings from the lace, it was held that publication had taken place. It would seem that the mere confidential exhibition of the lace to the three indicated persons would not of itself have constituted publication; but the concluding of an order, and the leaving of the cuttings or samples in the customers' hands went beyond mere confidential disclosure. Almost the same circumstances caused the registered design to be upset in the older case of *Hunt* v. *Stevens* (1878, W. N. 79). An examination of the report of the more recent and very similar case

Disclosure for the purpose of doing business may destroy novelty.

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. To protect the owner or author of an unregistered design from the consequences of premature confidential disclosure, or the premature confidential acceptance of an order, as in *Blank* v. *Footman*, the present Act contains a special Section (55) which provides that:—

Effect of disclosure on copyright.

55. The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person, other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof, if registration thereof is obtained subsequently to the disclosure or acceptance.

The Section, it will be noticed, deals only with confidential disclosure, otherwise it hardly affects established precedents on the question of prior publication. The sole question to be decided is: Was the premature disclosure in fact a violation of good faith, either positively or by inference?

Premature sale of articles in accordance with design destroys novelty.

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.

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 had taken place (*Werner Motors, Limited* v. *Gamage*, 1904, 21 R. P. C. 621).

Co-existing patent and design.

Prior to the coming into force of the present Act, it had been held in *Hothersall* v. *Moore* (*supra*), that where a design had been registered in one class, and had been put on the market and made public, the proprietor could not validly register it in another class on account of this prior publication.

Now, by Section 50, it is provided that:—

Registration of designs in new classes.

50. Where a design has been registered in one or more classes of goods, the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated—

(*a*) On the ground of the design not being a new and original design, by reason only that it was so previously registered; or

(*b*) On the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods of any class in which it was so previously registered.

CHAPTER VI.

MARKING THE GOODS.

SECTION 54 of the Act provides that :—

54. (1) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall- — Requirements before delivery on sale.

(*a*) (If exact representations or specimens were not furnished on the application for registration), furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so the Comptroller may erase his name from the Register, and thereupon the copyright in the design shall cease; and Filing of representations.

(*b*) Cause each such article to be marked with the prescribed mark, or with the prescribed words or figures denoting that the design is registered; and if he fails to do so the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design, unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design. Marking.

(2) Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act, dispense with or modify such requirements as regards any such class or description of articles to such extent, and subject to such conditions, as they think fit. Relief from marking by Board of Trade.

In pursuance of Clause (*b*), Sub-section 1, of this section, Designs Rule 68 provides that—

Registration mark.

Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall cause each such article to be marked with the word REGISTERED, or with the abbreviation REG^{D}., or with the abbreviation R^{D}., as he may choose, and also (except in the case of articles to which have been applied designs registered in Classes 9, 13, 14, and 15) with the number appearing on the certificate of registration.

Cancellation on failure to supply drawings.

Clause (*a*) of Sub-section 1 refers to failure to supply the requisite drawings or specimens of the design on application, as provided for by Rules 20 and 21, and in *that case any delivery on sale of articles to which the* design has been applied leaves it in the discretion of the Comptroller to delete the applicant's name from the Register and bring the copyright to an end. Presumably, if a good excuse or explanation is forthcoming, the Comptroller may forgive the oversight, for Clause (*a*) only says that he may erase the name.

Penalty on failure to mark.

Clause (*b*) refers to delivery on sale after registration has been duly effected, but the penalty for failing to mark is not so severe as that in the former Act of 1883, which provided that upon failure to mark properly, the copyright was to cease, unless the proprietor could show that he had done all in his power to ensure the marking.

Default in marking bars right to damages or penalty.

The present Sub-section (*b*) only says that on failure to mark before delivery on sale the proprietor forfeits his right to recover any penalty or damages from an infringer, but does not imperil his copyright. Even the non-capacity to recover penalties and damages may be got over if the *proprietor shows that he took all proper steps to ensure* the marking; or if he can show that at the time the infringement took place the defendant knew or had received notice of the existence of the copyright. The section does not expressly preserve the plaintiff's right to an injunction, as in the case of patents under Section 33, but most probably it is not intended to deprive a plaintiff of this relief.

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.

Technical error in marking.

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. *Footman* (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 total failure to mark the goods will undoubtedly subject the proprietor to the disability set forth in Subsection 1, Clause (*b*), unless he can show very strong reasons why he should be excused. 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 registration mark 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 *Hollersall* v. *Moore* (1891, 9 R. P. C. 27).

Relief in case of inadvertence.

But, as has already been noted, the disabilities attached to non-marking are always subject to the 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.

Surplusage in marking.

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 later 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)

Proprietor must take all proper steps to ensure marking.

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."

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., (now Lord Justice Farwell) 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

Marking one part of combination.

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 of the design, 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. When any real difficulty in applying or preserving the mark on goods is encountered, the proprietor

should apply to the Board of Trade for a dispensation, as provided in Sub-section 2 of Section 54.

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, sent out as such but not sold, need not be marked.

Penalty for describing an article as "registered."

It is an offence under the Act (Section 89) to describe an article as "registered" where no registration has been effected, or where the period of registration has expired. This latter offence has been created by Sub-section 4 of Section 89. A person is deemed to represent a design as registered if he sells the article bearing any word or words implying that there is a subsisting copyright in the design. 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 in the United Kingdom must be marked (*Sarazin* v. *Hamell*, 1863, 7 L. T. N. S. 660), otherwise Clause (*b*) of Sub-section 1 (Section 54) will apply.

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 60 and 61 of the Act.

Section 60.

Section 60 of the Act provides that:—

60. (1) During the existence of copyright in any design it shall not be lawful for any person:—

Unlawful to apply design without licence.

(*a*) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

Unlawful knowingly to sell articles having design wrongfully applied.

(*b*) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

Penalties.

(2) If any person acts in contravention of this section he shall be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt, or if the proprietor elects to bring an action for the recovery of damages for

such contravention, and for an injunction against the repetition thereof, he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly:

Damages.

Provided that the total sum recoverable as a simple contract debt 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, and of Section 58 of the Act of 1883, except that in Clause (*a*) of Sub-section 1, anyone doing anything with a view to enable the design to be unlawfully applied is included as a wrong doer; and the like in Clause (*b*) with reference to anyone causing a fraudulent or obvious imitation to be published or exposed for sale.

Differences between Clauses (*a*) and (*b*).

Clause (*a*) is aimed at the manufacturer or producer of the goods, while Clause (*b*) deals with the seller and more particularly the retail seller. It is not under Clause (*a*) necessary to bring home to the manufacturer knowledge of the existence of registration of the design, except when he denies knowledge of the copyright under Section 54, Sub-section 1, Clause (*b*)—*i.e.* where the proprietor has failed to mark the goods properly. It is enough that he applies it or causes it to be applied (*Boustead* v. *Dempster*, 1907, 25 R. P. C. 121). 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.

Liability of manufacturer.

Liability of vendor.

Clause (*b*) of Sub-section 1 does not and cannot mean that a vendor of infringing goods is allowed under any circumstances to go scatheless simply because he has not, before the act complained of, received express notice that the goods he is selling are infringements of a registered design. If it can be shown that by any other means he had acquired the knowledge, or has obtained such information as would have put a reasonable man on his guard, he will be held liable, and in any case the plaintiff is entitled to an injunction.

Express notice to vendor not essential.

Aiders and Abettors.

It should also be noted that both in Clause (*a*) and Clause (*b*) the net to catch infringers is made somewhat wider than in the Act of 1883. Under Clause (*a*) not

only the person who applies or causes to be applied the infringing design, but also he who does anything to bring this about, is equally liable. So in Clause (*b*) not only the publisher or exposer for sale of the infringing article is liable, but also anyone who causes this to be done. Thus it may be possible to go behind an innocent manufacturer or vendor and hit the real culprit, or in addition to the manufacturer or vendor, if they are culpable, some aider or abettor may also be penalised.

What constitutes infringement.

A vast deal of misplaced learning has been lavished by writers on Copyright in Designs upon the discussion of how much or how little resemblance will constitute infringement. But every case must of necessity stand by itself, and when once the general principle has been stated the most careful consideration of all of the reported cases leaves the reader scarcely one whit the wiser. The only question is: Are the two designs sufficiently alike to constitute one the same or substantially the same as the other? The sum and substance of the whole matter is contained in Lord Fitzgerald's observation in the *Hecla Foundry Case* (1889, 6 R. P. C., p. 560, *supra*).

The test of the eye.

Holdsworth v. McCrea.

Hecla Foundry v. Walker.

Precisely in the same strain 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* (*supra*), that the eye is the test, and that the question should be determined by placing the designs side by side and asking whether they were the same, or the one an obvious imitation of the other, *taking into account the state of knowledge at the time, and in what respects the registered design was new and original, when considering whether variations from the registered design were substantial or not.* The same test was proposed to be applied in *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.

Prior knowledge to be considered.

Consideration of prior knowledge.

Of course, before comparing the registered design with the alleged infringement, the Court will apply Lord Herschell's rule above stated to the registered design itself. The proprietor alleges his copyright to be for "a new or original design not previously published in the United Kingdom."

Evidence of anticipatory knowledge admitted.

It is therefore the duty of the Court to see how far this allegation is true. For this purpose evidence will be admitted either to show (*a*) that the design is in fact old, or not new or original; or (*b*) that only certain features are new, and if the defendant has not taken these features then there is no infringement. Lord Herschell laid down that the function or purpose of the design must be disregarded, that is, that no one can register a design for a particular purpose and then say "Although you may vary my design, so long as you apply a similar thing to the same purpose you infringe." This will not do, and if the variation from the registered design is material, then there is no infringement. Thus no one can, by registering a design of a cabinet to hold a gramophone, claim a monopoly for any similar cabinet that will hold a gramophone regardless of variations from the registered design (*Gramophone Co.* v. *Magazine Co.*, 1909, 26 R. P. C. 785; 27 R. P. C. 152). To reduce the claim of the owner of the design to its proper limits, evidence of the prior state of knowledge will always be admitted, and the result of this is often to place the plaintiff in the usual dilemma, viz. - that if he insists upon a wide interpretation of his copyright, it is bad from anticipation, or if he accepts a more limited ambit the defendant does not infringe (*Leatheries, Ltd.* v. *Lycett Saddle Co. Ltd.*, 1909, 26 R. P. C. 166).

Need not be an exact copy.

Nevertheless, 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, 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."

General resemblance may constitute infringement.

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 ogee top, and also flanked by black porcelain pillars. The minor details also differed.

"Totality" of the design.

"The substance of a design lies in the totality" (*Per* Moulton, L. J., in *Gramophone Co.* v. *Magazine Holder Co.*, 1909, 27 R. P. C., p. 155). Imitations of parts of a registered design will not spell infringement if the general appearance is different (*Per* Neville, J., in *Sackett* v. *Clozenberg*, 1909, 27 R. P. C., p. 108).

Obvious and fraudulent imitation.

Grafton v. *Watson*.

Harper v. *Wright*.

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, 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.

Manisty, J., on "obvious" and "fraudulent" imitations.

Sherwood v. *Decorative Tile Co.*

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."

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 is liable.

As has already been pointed out, the mere fact of applying or causing to be applied the registered design without the consent of the proprietor renders the manufacturer of the goods liable to an action (*Boustead* v. *Dempster*, 1907, 25 R. P. C. 121).

But Section 60 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 L. 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., said: "I think that the intention of the Act (1883), 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

Intention of the section is to protect innocent retailer.

Smith v. *Roberts*.

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, and Section 60, Sub-section 2, of the present Act preserves this restriction.

Act of 1907.

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. A reasonable offer by the defendant to settle an action is always refused at the plaintiff's peril as to costs, if he insists on an enquiry and the damages assessed are less than the amount offered in settlement (*Fellis* v. *Williams*, 1908, 25 R. P. C. 511).

Reasonable submission by defendant.

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).

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 60, Sub-section 2, 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

Penalty recoverable as simple contract debt.

Injunction. £100, in the County Court. Where an injunction is sought, or where there is a question of applying to rectify the Register by expunging a design, the Chancery Division

Jury. of the High Court would be the most convenient. If trial by jury is desired, or the action is for damages, as under Section 60, 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 Sections 71 and 93—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 (see Section 93) 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 71, and can, therefore, alone or together with his co-proprietors, sue for infringement. But the

Licence to apply design must be in writing. 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).

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, without the licence of the proprietor, applied or caused to be

Manufacturer. applied the design to goods in the class for which the design was registered for purposes of sale, or the person who has done anything to enable the design to be so

Vendor. applied; or (*b*) the person who publishes or exposes such goods for sale or his aider and abetter, knowing that the design has been applied without the proprietor's consent.

The preceding portion of this chapter deals with the notice to be given to anyone who is or may be an innocent infringer.

The writ alleging infringement should be endorsed with a claim for— Endorsement of writ.

(*a*) The penalties against the defendant for infringement of the plaintiff's registered design; Penalty.

(*b*) An injunction to restrain the defendant, his servants and agents, from infringing the design; and Injunction.

(*c*) Delivery up or destruction of all infringing articles in the possession or under the control of the defendant. Delivery up.

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 60. 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. Even when a claim for an injunction is included, the presence of a claim for penalties prevents the administration of interrogatories (*Saunders* v. *Wiel* (*supra*); *Mexborough* v. *Whitwood Urban District Council*, 1897, L. R. 2 Q. B. 111; *Titus Astle* v. *Mansfield*, 1905, 22 R. P. C. 356). Damages in lieu of penalties (Section 60). Interrogatories in penalty action.

The statement of claim should recite— Statement of claim.

(*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*]: Title of plaintiff.

(*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. Infringement by manufacturer.

The statement of claim should then conclude with substantially a repetition of the claims endorsed on the writ (*supra*).

Infringement by vendor.

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 published or exposed for sale, without the consent of the registered proprietor, 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 registered proprietor. If any person is known to have been aiding and abetting the defendant he may be joined in the action, or he may be proceeded against separately, the wording of the writ and statement of claim being modified accordingly.

Procedure similar to that in Patent actions.

Mr. Justice North having given it as his opinion in *Morris Wilson* v. *Coventry Machinists' Co.* (1891, 8 R.P.C. 353), that proceedings in Patent actions should be regarded as the model upon which to regulate Designs actions, it is advisable that the statement of claim should be accompanied by particulars of breaches giving, if possible, all known or ascertained instances of infringement, with names, places, and dates. There is no specific obligation under the Statute, nor in the new Order 53A of the Rules of the Supreme Court 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.

Particulars of breaches.

Defence.

In his defence the defendant should state every plea founded on fact that will assist him to rebut the plaintiff's claim, as for example:—

Plaintiff not proprietor.

(*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.

Design not fit subject-matter.

(*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. Prior publication.

(*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 54 of The Patents and Designs Act, 1907) with the prescribed mark, words, or figures, denoting that the design was registered, or wrongly or insufficiently so marked. Goods not properly marked or improperly marked.

(*e*) That since the date of the alleged registration the said alleged design has been used for manufacture exclusively or mainly outside the United Kingdom. (This defence is expressly provided for in Section 58.) Manufacture abroad.

(*f*) If the plaintiff possesses any copyright in the said design (which is denied) the defendant has not infringed. No infringement.

If the defendant is a retailer, a further paragraph should be to the effect that the defendant has not wrongfully sold or published or 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, that he did it not knowing that the design had been so applied without the consent of the plaintiff. Defence by retailer.

If the defendant is a person whose conduct has been called in question as an aider and abettor, the wording of his defence should be modified accordingly.

The defence is preferably to be accompanied by the defendant's particulars of objection. 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— Defendant's particulars of objections.

(*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 the Statute. (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; as to the practice in Patents, see Order 53a, Rule 18, of the Rules of the Supreme Court.*) 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.

(*e*) If the defendant relies on manufacture abroad particulars of this should be given.

Particulars of prior publication.

Pages or sheets of drawings in books or publications should be given, and full circumstances of prior user, with dates, names, and addresses. It is possible that the stringent regulations set forth in Order 53A, as applicable to particulars in Patent actions, may be ordered in Designs actions also, but so far no reported case can be referred to.

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.

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.

Anticipations to be relied on must be pleaded.

But this rule might be relaxed.

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.,

Order for inspection.

Mere suspicion not enough to justify inspection order.

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.

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 60 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 60 are distinct, and the plaintiff must elect under which he is going. In an action for damages interrogatories may be administered.

Where penalties are claimed interrogatories not allowed.

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 in 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.

Practice in administering 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

Limits of interrogatories.

function (*Welsbach Incandescent Gas Light Co.* v. *New Sunlight Incandescent Lamp Co.*, 1900, 17 R. P. C. 401).

Answers to interrogatories.

When interrogatories are allowed, they must be answered by affidavit filed within ten days, or such other time as the Judge may allow.

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 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.

Judge's discretion as to costs.

Costs usually allocated to the different issues.

Certificate of validity.

If the plaintiff succeeds in his action, and the defendant has challenged the validity of the copyright, the plaintiff is now entitled to apply, under Section 61 of the new Act, for a certificate that the validity has been called in question. With this certificate in his possession, the plaintiff may

in any subsequent action, where the validity is again questioned, ask for costs as between solicitor and client.

Costs in the case of an innocent retailer.

The innocent retailer pushed into an action against his will, and after he had done all that 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. (See also *Jenkins* v. *Hope*, 1895, 13 R. P. C. 57; and *Clarke* v. *Hudson's Executors*, 1901, 18 R. P. C. 310.)

Smith v. *Lewis Roberts & Co.*

Jan v. *Grossman.*

Statutory provision as to threats.

Under the repealed Acts there was no provision in the Designs portion giving any statutory remedy in the case of threats by the proprietor of a registered design. Now by Section 61 an action for restraint of such threats may be taken by any person aggrieved, as provided by Section 36 in the case of Patents. For particulars of such an action the reader is referred to Chapter XX. in Part I. (Patents) on the "Action to Restrain Threats."

Appeal.

Either party may appeal to the Court of Appeal and thence to the House of Lords.

Further evidence in Court of Appeal.

Application might be made to the Court of Appeal to adduce fresh evidence, and if good grounds are shown leave may be granted (*Bayer's Design*, 1906, 23 R. P. C. 553).

CHAPTER VIII.

RECTIFICATION OF THE REGISTER.

SUB-SECTIONS 1, 2, and 3 of Section 52 of The Patents and Designs Act, 1907, provide as follows:—

The Register of Designs.

52. (1) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may be prescribed.

(2) The Register of Designs existing at the commencement of this Act shall be incorporated with and form part of the Register of Designs under this Act.

(3) The Register of Designs shall be *primâ facie* evidence of any matters by this Act directed or authorised to be entered therein.

Section 72. Provisions for rectifying the Register.

Again, by Section 72 (Sub-sections 1, 2, 3, and 4) it is provided that—

72. (1) The Court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of Patents or Designs of any entry, or by any entry made in either such Register without sufficient cause, or by any entry wrongly remaining on either such Register, or by an error or defect in any entry in either such Register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide in connection with the rectification of a Register.

(3) The prescribed notice of any application under this section shall be given to the Comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4) Any order of the Court rectifying a Register shall direct that notice of the rectification be served on the Comptroller in the prescribed manner, who shall, upon the receipt of such notice, rectify the Register accordingly.

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.

Scotland. In Scotland "the Court" means any Lord Ordinary of the Court of Session; and "Court of Appeal" means either Division of that Court (Section 94, Sub-sections 4 and 5).

Ireland. In Ireland "the Court" means the High Court in Ireland (Section 95, Sub-section 2).

Jurisdiction of Scottish and Irish Courts. There seems to be no reason for doubting that the Courts both in Ireland and in Scotland have jurisdiction to rectify the Register. Under the repealed Acts the Court of Session in Scotland held in *Courie* v. *Herbert* (1897, 14 R. P. C. 436) that it had such jurisdiction. The Irish Court, on the contrary, held in *Bayer* v. *Connell* (1897, 14 R. P. C. 436) that it had no jurisdiction; but it would be difficult to reconcile this latter decision at the present day with the provisions for notifying the Comptroller of an order for rectification by a Scottish Court (Section 94, Sub-section 7) or by an Irish Court (Section 95, Sub-section 3).

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 aggrieved." "Any person aggrieved," is a person who is, in some way or other, substantially interested in having the design removed from the register, or who would be substantially damaged if the design remained. In general terms when a person is improperly 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. This cannot be done by way of counterclaim as in a Patent action. The defendant must take out a summons in the action, or move to rectify. 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 the design is used for manufacture exclusively or mainly outside the United Kingdom.

Prior registered proprietor.

No counterclaim for rectification.

Defendant in an action.

Grounds of rectification.

No home manufacture of design.

Under the practice relating to the rectification of the Register of Trade Marks, an applicant to expunge, 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

Substitution of rightful for wrongful owner on the Register.

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 15, Sub-section 2), so as to preserve the validity in the hands of the new owner. 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.

Grocott's Design.

Fraudulent as compared with inadvertent registration.

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 of the Act of 1883, 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, but that the alteration in the Register could be made under Section 71 of the new Act.

Application to rectify Register

Following the practice in Trade Marks, an application to rectify the Register of Designs cannot be made h

subject-matter of a counter-claim in an action for infringement. It must be separately made by motion or summons. Four clear days' notice of every application to the Court, under Section 72 of the Act for rectification of the Register of Designs, should be given to the Comptroller (Rule 95). 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.

cannot be made by counter-claim in action.

Service of respondent without the jurisdiction.

If rectification is ordered, the person in whose favour it is made should serve an office copy of the order on the Comptroller, who will make the necessary alteration in the Register. Designs Form 26 should accompany the service of the order on the Comptroller.

An appeal lies from any decision of the Court of First Instance to the Court of Appeal and to the House of Lords.

Appeal.

A new feature of the present Act appears in Section 58, which provides that at any time after registration "any person" (which term it appears might cover and include a common informer) may apply to the Comptroller for the cancellation of the copyright on the ground that the design is used for manufacture mainly or exclusively outside the United Kingdom. The section says that in the case of such an application for cancellation the provisions of the Act with respect to the revocation of patents for the same cause will apply with the necessary modifications. The reader is therefore directed to the corresponding portion of the Chapter in Part I. which deals with the revocation of patents.

Cancellation on the ground of manufacture abroad.

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STATUTORY RULES AND ORDERS, 1907.

No. 949.

DESIGNS.

THE DESIGNS RULES, 1908. DATED DECEMBER 17, 1907.

BY VIRTUE of the provisions of The Patents and Designs Act, 1907, hereinafter referred to as "the Act," the Board of Trade do hereby make the following Rules:—

PRELIMINARY.

1. These Rules may be cited as "The Designs Rules, 1908," and shall come into operation from and immediately after the 31st day of December, 1907.

INTERPRETATION.

Interpretation.

2. In the construction of these Rules any words herein used, the meaning of which is defined by the Act, shall have the meanings thereby assigned to them respectively—

"Agent" means an agent resident or having a place of business in the United Kingdom or the Isle of Man, duly authorised to the satisfaction of the Comptroller.

"Office" means the Patent Office (Designs Branch), 25 Southampton Buildings, London, W.C.

"*Journal*" means the *Illustrated Official Journal (Patents)*.

"Specimen" means an article of manufacture or a substance with the design applied to it.

"Lodged" means left at the Office, or sent through the post by a prepaid letter addressed to the Comptroller at the Office.

Fees.

3. The fees to be paid in pursuance of the Act, so far as it relates to designs, shall be the fees specified in the First Schedule hereto. Fees.

Forms.

4. The forms herein referred to are the forms contained in the Second Schedule hereto, and such forms shall be used in all cases to which they are applicable, and shall be modified as directed by the Comptroller to meet other cases. Forms.

Sets of Articles.

5. "Set" means a number of articles of the same general character ordinarily on sale together, or intended to be used together, all bearing the same design, with or without modifications not sufficient to alter the character or not substantially affecting the identity thereof. Sets of articles.

Where there is any doubt whether given articles do or do not constitute a set, the doubt shall be determined by the Comptroller.

Classification of Goods.

6. For the purposes of the registration of designs and of these Rules, goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

If any doubt arises as to the class to which any particular description of goods belongs, it shall be determined by the Comptroller.

Documents.

7. Subject to any other directions that may be given by the Comptroller, all applications, notices, papers having representations affixed, and other documents required by the Act or by these Rules to be lodged shall be upon strong paper, and, except where otherwise required, on one side only, of a size of approximately 13 inches by 8 inches, and having on the left-hand part thereof a margin of approximately two inches. Size, &c., of documents.

8. A document lodged by a firm or partnership may be signed in the firm's name, or for and on behalf of the firm Signature of documents.

or partnership, by any one or more members thereof. A document lodged by a body corporate may be signed by a director or by the secretary or other principal officer of such body corporate.

Service of documents.

9. Any application, statement, notice, or other document authorised or required to be lodged, or to be left, made, or given, with or to any person under the Act or these Rules may be sent through the post by a prepaid or official paid letter; any document so sent shall be deemed to have been delivered at the time when the letter containing the same would be delivered in the ordinary course of post, and in proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

ADDRESS.

Address.

10. Where any person is by the Act or these Rules bound to furnish the Comptroller with an address, the following provisions shall apply:—

The address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of business of the person whose address is given.

When a person does not reside in a town with streets, the Comptroller may require the address to include all indications which he thinks necessary for such purpose as far as it can be attained.

When an applicant resides in a town where there are streets, the address given shall include the name of the street, and the number in the street or name of premises, if any.

Address for service.

11. Where a registered proprietor of a design lives out of the United Kingdom or the Isle of Man, he may furnish the Comptroller, on Form Designs No. 6, with an address for service within the United Kingdom, which shall be entered in the Register.

All notices and documents, which under these Rules are required to be sent to the registered proprietor, shall be deemed duly sent if sent to him at his registered address, if that address be within the United Kingdom or the Isle of Man, or where the registered proprietor lives outside

the United Kingdom or the Isle of Man, to his address for service, if any, on the Register.

Where a registered proprietor lives out of the United Kingdom or the Isle of Man, and has not furnished such address for service, the Comptroller need not send to him any notice which under these Rules the Comptroller is required to send.

Where an applicant lives out of the United Kingdom or the Isle of Man, he shall furnish the Comptroller with an address for service within the United Kingdom, and until he does so the Comptroller need not proceed with the examination of his application.

When such address for service is furnished it shall, on the registration of the design, be entered in the Register as the address for service of the proprietor.

Agents.

Agency.

12. An application for registration, and all other communications between an applicant and the Comptroller, or the Board of Trade, and between the registered proprietor of a design and the Comptroller, or the Board of Trade, or any other person, may be made by or through an agent.

Any such applicant or proprietor may appoint an agent to represent him in the matter of the design by signing and sending to the Comptroller an authority in writing to that effect in the Form Designs No. 1, or in such other form as the Comptroller may deem sufficient. In case any registered proprietor of a design shall appoint such an agent, service upon such agent of any document relating to such design shall be deemed to be service upon the person so appointing him, and all communications directed to be made to such person in respect of such design may be addressed to such agent.

The Comptroller shall not be bound to recognise as an agent, or to receive further communications in respect of any business under the Act relating to designs from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of the Act, and not since restored,

or any person who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence, or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the Register of Patent Agents, to have his name erased therefrom, or any company, which if it had been an individual, the Comptroller could refuse to recognise as an agent, or any company or firm, if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm. In any particular case the Comptroller may, if he think fit, require the personal signature or presence of an applicant or other person.

Application for Registration.

Signature of application.

13. An application for registration of a design shall be signed by the applicant for registration or by his agent.

Form of application.

14. Except as regards applications in Classes 13, 14, and 15, an application for registration of a design shall be lodged at the Office, and (except as regards applications for lace designs in Class 9) shall be on Form Designs No. 2, or in the case of a set on Form Designs No. 3.

Lace designs.

15. An application for registration of a lace design in Class 9 shall be on Form Designs No. 4, or in the case of a set on Form Designs No. 5.

Acknowledgment of application.

16. On or after receipt of an application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Class.

17. An application shall state the class in which the design is to be registered, and where it is desired to register the same design in more than one class, a separate application shall be made in each class. In that case each application shall be numbered separately, and shall be treated as a separate and distinct application.

Application of design.

18. Every application shall state the article or articles to which the design is to be applied, and, where the Comptroller so requires, the applicant shall further state for what

purpose the article to which the design is to be applied is used, and the material, or the predominating material, of which the article is made.

Statement of novelty.

19. The applicant may and shall, if required by the Comptroller in any case so to do, endorse on the application a brief statement of the novelty he claims for his design, and where representations are furnished shall endorse each with such statement, if any.

Representations.

20. Except as regards applications in Classes 13, 14, and 15, there shall be furnished in connection with an application for the registration of a design to be applied to a single article, three exactly similar drawings, photographs, tracings, or other representations of the design, or three specimens.

Representations for set, and in Classes 13, 14, and 15.

21. There shall be furnished in connection with an application for the registration of a design to be applied to a set, four exactly similar drawings, photographs, tracings, or other representations of the design, or four specimens; in connection with an application in any one of the Classes 13, 14, and 15, there shall be furnished six such representations, or six specimens.

Nature of representations.

22. Each representation of the design, or set of designs, must be upon paper of the prescribed size and not on cardboard, and must appear on one side only of the paper. The figure or figures must be placed in an upright position on the sheet. When more figures than one are shown, these should, where possible, be on one and the same sheet, and each should be designated on the sheet (*e.g.*, front view, side view).

Drawings, &c., must be in ink.

23. When drawings or tracings are furnished, they must be in ink, and if on tracing cloth or tracing paper must be mounted on paper of the prescribed size.

Representations for set.

24. When the design is to be applied to a set, each of the representations accompanying the application should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

Special representations.

25. When the specimens are not, in the Comptroller's opinion, of a kind which can be conveniently pasted into

books, representations shall be furnished for insertion in the Register and for official purposes.

Words, &c., on designs.

26. Where words, letters, or numerals are not of the essence of the design, they shall be removed from the representations or specimens.

Repeat of pattern.

27. Each representation of a design which consists of a repeating surface pattern must show the complete pattern and a sufficient portion of the repeat in length and width, and ought not to be of less size than 7 inches by 5 inches.

Specimens of designs.

28. Where representations are supplied, the Comptroller shall also be supplied, if in any case he so requires, with a specimen.

Additional representations or specimens.

29. The Comptroller shall be furnished with more representations or more specimens of any design if he requires them.

Representations of living persons or persons recently dead.

30. Where the names or representations of living persons appear on a design, the Comptroller shall, if he so require, be furnished with consents from such persons before proceeding to register the design. In the case of persons recently dead, the Comptroller may call for consents from their legal representatives before proceeding with registration of a design on which their names or representations appear.

Procedure on Receipt of Application.

Acceptance.

31. Upon receipt of an application for registration, the Comptroller shall consider it, and if he thinks there is no objection to the design being registered, he may accept it.

Objections.

32. If after consideration of the application any objections appear, a statement of these objections shall be sent to the applicant in writing, and unless within one month the applicant applies for a hearing, he shall be deemed to have withdrawn his application.

Decision of Comptroller.

33. The decision of the Comptroller at such hearing as aforesaid shall be communicated to the applicant in

writing, and if he objects to such decision, he may within one month, should he consider it necessary for the purpose of appeal, apply upon Form Designs No. 7 requiring the Comptroller to state in writing the grounds of his decision and the materials used by him in arriving at the same.

Date for appeal.

34. Upon receipt of such form the Comptroller shall send to the applicant such statement as aforesaid in writing, and the date when such statement is sent shall be deemed to be the date of the Comptroller's decision for the purpose of appeal; but if the applicant does not apply for the grounds of the Comptroller's decision, appeal shall be lodged within one month from the date of the decision.

Non-Completion.

Non-completion within twelve months.

35. Where an application for registration of a design is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Comptroller shall give notice to the applicant in writing of such non-completion, and if the applicant has an agent, shall send a duplicate of such notice to such agent. If after fourteen days from the date when such notice was sent, the application is not completed, the application shall be deemed to be abandoned, but the Comptroller may with such notice, where the applicant lives at such distance from the Office that he cannot reasonably be expected to do what is necessary within such fourteen days, give a further time after such fourteen days for the completion of such application.

Death of Applicant.

Death of applicant before registration.

36. In case of the death of any applicant for the registration of a design after the date of his application, and before the design applied for has been entered in the Register, the Comptroller may, on being satisfied of the applicant's death, enter in the Register, in place of the name of such deceased applicant, the name, address and description of the person owning the design, on such ownership being proved to the satisfaction of the Comptroller.

Extension of Period of Copyright.

Extension of period of copyright.

37. At any time after the registration of a design, the period of copyright therein may be extended for a second period of five years if Form Designs No. 8 be lodged; but no period of copyright shall be extended unless an application for extension be lodged at least one week before the expiration of the original period of five years. When a proprietor has more than one design, copyright in which ceases at the same date, he may, in place of using a separate Form Designs No. 8 for each design, include all the designs in one form, stamped with the total amount of the prescribed fees for such designs and so modified as to meet the circumstances of the case. Form Designs No. 8 shall be endorsed with the name and address of the person lodging the same.

Notice of extension.

38. On receipt of Form Designs No. 8 an entry of the extension of the period of copyright shall be made in the Register, and the Comptroller shall send to the registered proprietor at his registered address or his address for service, a notice that the period of copyright has been extended for a further period of five years.

Second extension.

39. At any time not less than six months and not more than twelve months before the expiration of the second period of five years mentioned in Sub-section 3 of Section 53 of the Act, application may be made to the Comptroller for a further extension of the period of copyright by lodging Form Designs No. 9.

Payment of extension fee.

40. If the Comptroller grants the application, he shall send notice to the registered proprietor, who shall, at least one week before the expiration of the second period of five years, pay the prescribed fee by lodging Form Designs No. 10.

Notice of second extension.

41. Form Designs No. 10 shall be endorsed with the name and address of the person lodging the same, and on receipt thereof an entry of the further extension of the period of copyright shall be made in the Register, and a notice of such extension, as prescribed by Rule 38, shall be sent.

Advertisement of extension.

42. Upon an extension of the period of copyright, the extension shall be advertised in the *Journal*.

Assignment, &c.

Joint request for entry of assignment &c.

43. Where a person becomes entitled as assignee, mortgagee, licensee, or otherwise to any interest in the copyright of a design, he may, conjointly with the registered proprietor, apply on Form Designs No. 11 to have an entry of the fact made in the Register, and on receipt of such form the Comptroller may make a note in the Register of such interest.

Application for entry of assignment by subsequent proprietor.

44. Where no such joint application is made, any person who has become entitled to an interest in the copyright of a design by assignment, mortgage, licence, or otherwise, may apply for the entry of his name in the Register as proprietor of such interest in such copyright. The application shall be on Form Designs No. 13, and such application shall contain the name, address, and description of the person claiming to be entitled (hereinafter called "the claimant").

Case accompanying application.

45. Together with such application the claimant shall leave a case stating full particulars of the assignment, mortgage, licence, instrument, or other mode of transfer by virtue of which he claims to be entitled to be entered in the Register, so as to show the manner in which, and the person or persons through whom, such interest has been acquired.

Statutory declaration in support of such request.

46. Where the Comptroller shall determine that the case sets out particulars such as entitle the claimant to be entered in the Register, he may call upon the claimant to furnish a statutory declaration on Form Designs No. 14, verifying the several statements in the case and declaring that the particulars given comprise every material fact and document affecting the matter.

Proof of title.

47. In any case, the Comptroller may call on any person who desires his name to be entered in the Register for such proof or additional proof of title as the Comptroller may require for his satisfaction.

Entry in the Register.

48. When the Comptroller is satisfied that the claimant is entitled to the entry of his name, he shall make a note in the Register of such interest.

Removal of name.

49. Where the name of a person is entered on the Register as mortgagee or licensee, such person may on lodging Form Designs No. 15 have a note entered in the Register that he no longer claims to be mortgagee or licensee, as the case may be.

Alteration of Address.

Alteration of address in Register.

50. Every registered proprietor of a design who alters his address, or his address for service, shall forthwith apply to the Comptroller on Form Designs No. 16, and the Comptroller shall alter the Register accordingly.

Correction of Clerical Errors.

Correction by applicant.

51. Where an applicant desires to correct a clerical error in his application, he shall lodge a Form Designs No. 17.

Correction by proprietor.

52. Where the registered proprietor of a design desires to correct a clerical error under Section 70 of the Act, he shall lodge a Form Designs No. 17.

Cancellations.

Cancellation of design.

53. Where the registered proprietor of a design desires to cancel his registration, either wholly or in respect of any particular goods in connection with which the design is registered, he shall lodge a Form Designs No. 18.

Cancellation by trustee in bankruptcy, &c.

54. Cancellation may also be effected by the trustee in bankruptcy of the registered proprietor, or where the registered proprietor is a company in liquidation by the liquidator, or in any other case where the request is made by a person whom the Comptroller may decide to be entitled to act in the name of the registered proprietor. In such cases Form Designs No. 18 shall be lodged, modified as the Comptroller directs.

Discretionary Power.

Hearing.

55. Before exercising any discretionary power given to the Comptroller by the Act adversely to any person, the Comptroller shall, if so required, hear the person who will be affected by the exercise of such power.

Application for hearing.

56. An application for a hearing shall be made within one month from the date when the matter on which the Comptroller is called on to exercise discretionary power has arisen.

Notice of hearing.

57. Upon receiving such application, the Comptroller shall give the person applying ten days' notice of a time when he may be heard by himself or his agent.

Within five days from the date when such notice would be delivered in the ordinary course of post, the person applying shall notify the Comptroller whether or not he intends to be heard on the matter.

Notification of decision

58. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the person affected.

Searches.

Search under Section 57.

59. Where any person desires to obtain the information which he is entitled to obtain under Section 57 of the Act, and can furnish the registration number of the design, he shall lodge Form Designs No. 19, and the Comptroller will thereafter furnish him with the information aforesaid.

Where the applicant is unable to furnish the registration number of the design he shall lodge Form Design No. 20, together with such information as he is in possession of, and the Comptroller will thereupon make such search in the class indicated as may be possible on the information supplied, and will furnish such information as can be afforded. Where Form Designs No. 20 is accompanied by a representation or specimen of the design, such representation or specimen shall be furnished in duplicate.

Search among registered designs.

60. The Comptroller may, if Form Designs No. 21 be lodged, cause a search to be made among the registered designs, and state whether, in his opinion, any design accompanying such form, and to be applied to goods in any particular class, is or is not identical with, or an obvious imitation of, any registered design applied to such goods of which the copyright is still existing. The design accompanying Form Designs No. 21 shall be furnished in duplicate.

Hours of Inspection.

Hours of inspection.

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

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

Power to Dispense with Evidence.

Dispensing with evidence.

62. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Amendments.

Amendment of documents.

63. Any document or drawing or other representation of a design may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if the Comptroller think fit, and on such terms as he may direct.

Enlargement of Time.

Enlargement of time.

64. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such

terms, as he may direct, and such enlargement may be granted though the time has expired for doing such act or taking such proceeding.

Excluded days.

65. Whenever the last day fixed by the Act or by these Rules for doing any thing shall fall on a day when the Office is not open, or on a Saturday, which days shall be excluded days for the purposes of the Act and these Rules, it shall be lawful to do any such act or thing on the day next following such excluded day or days, if two or more of them occur consecutively.

Fees paid late by persons living at distance from Office.

66. Where a time for paying a fee is limited by these Rules, and the person who is bound to pay such fee resides at such distance from the Office that he cannot reasonably be expected to pay the fee on the date limited by the Rule, the Comptroller, if satisfied that the omission to pay the fee has not been from any want of diligence on the part of the person whose business it is to pay it, may accept the fee even though the date for paying the fee has passed, and treat it as if received on the correct date, provided always that the fee is actually paid with such promptitude as can be expected in the circumstances.

Certificate by Comptroller.

Certificate for use in legal proceedings or other purpose.

67. Where a certificate is required for the purpose of any legal proceeding, or other special purpose, as to any entry, matter, or thing which the Comptroller is authorised by the Act or these Rules to make or do, the Comptroller may, on the lodging of a Form Designs No. 22, give such certificate, which shall also specify on the face of it the purpose for which it has been issued as aforesaid.

Marking of Articles.

Registration mark.

68. Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall cause each such article to be marked with the word **REGISTERED**, or with the abbreviation **REG$^{D.}$** or with the abbreviation **R$^{D.}$** as he may choose, and also (except in the case of articles to which have been applied designs registered in Classes 9, 13, 14, and 15) with the number appearing on the certificate of registration.

Register of Designs and Inspection of Registered Designs.

Registering design.

69. When a design is accepted there shall be entered in the Register a representation or specimen of the design, the calling or description of the proprietor, the date of the application, and such other particulars as the Comptroller may deem necessary.

Inspection of registered designs.

The period under Section 56 of the Act during which a design shall not be open to inspection, except as provided in that section, shall be, as regards designs in Classes 13, 14, and 15, five years, and, as regards designs in other classes, two years from the date of the original registration thereof.

Cancellation of Designs used for Manufacture Outside the United Kingdom.

Cancellation of designs used for manufacture outside the United Kingdom.

70. An application for the cancellation of the registration of a design under Section 58 of the Act shall be made on Form Designs No. 23, which shall, if so required by the Comptroller, contain an address for service in the United Kingdom. The applicant shall simultaneously with, or as soon as may be after, the leaving of such application at the Office deliver or cause to be delivered to the registered proprietor of the design (hereinafter called "the proprietor") or his agent a copy of such application, and furnish the Comptroller with evidence of such delivery.

Procedure.

71. The proprietor shall, within fourteen days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what place the design is used for manufacture in the United Kingdom; and setting out in the event of the design not being used for manufacture in the United Kingdom to an adequate extent the reasons why it is not so used for manufacture.

Copies of evidence.

72. The proprietor shall deliver or cause to be delivered copies of such evidence to the applicant, and furnish the Comptroller with evidence of such delivery.

Evidence in answer.

73. Within fourteen days from the delivery of such copies, or within such further time as the Comptroller may allow, the applicant shall, if he decides to proceed with his application, leave at the Office statutory declarations in answer, and on so leaving shall deliver to the proprietor or his agent copies thereof, and furnish the Comptroller with evidence of such delivery.

Closing of evidence.

74. No further evidence shall be left at the Office on either side except by leave, or on the requisition of the Comptroller, and upon such terms, if any, as the Comptroller may think fit.

Hearing.

75. On completion of the evidence, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and give the parties ten days' notice at least of such appointment, and in the event of his deciding to take evidence *viva voce* in lieu of, or in addition to, the evidence by declaration, or to allow any declarant to be cross-examined on his declaration, he may require the attendance of any declarant or other person whose evidence he may consider desirable.

Industrial and International Exhibitions.

Notice of exhibition.

76. Any person desirous of exhibiting a design or any article to which a design has been applied at an industrial or international exhibition, which has been duly certified as such by the Board of Trade, or of publishing a description of a design during the period of the holding of such an exhibition, shall give the Comptroller notice, on Form Designs No. 24, of his intention to exhibit the design or article, or to publish a description of the design, as the case may be. For the purpose of identifying the design in the event of an application to register the same being subsequently made, the person lodging Form Designs No. 24 shall supply a brief description of the nature thereof, accompanied by a sketch, drawing, or specimen, and shall supply such other information as the Comptroller may in each case require.

Statutory Declarations.

Form, &c., of statutory declaration.

77. The statutory declarations required by these Rules, or used in any proceedings thereunder, shall be headed in

the matter or matters to which they relate, and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall, so far as possible, be confined to one subject. Every statutory declaration shall state the description and true place of abode of the person making the same, and shall bear the name and address of the person leaving it, and shall state on whose behalf it is left.

Manner in which, and person before whom, declaration is to be taken.

78. Statutory declarations shall be made and subscribed as follows:—

(*a*) In the United Kingdom, before any Justice of the Peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(*b*) In any other part of His Majesty's dominions, before any Court, Judge, Justice of the Peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of His Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a Notary Public, or before a Judge or Magistrate.

Notice of seal of officer taking declaration to prove itself.

79. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration, in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Designs in Classes 13, 14, and 15.

Application at Manchester.

80. All applications for registration of designs in Classes 13, 14, and 15 shall be lodged at the Office, or left at or sent to the Manchester Branch Office, at the option of the applicant.

Manchester Office.

81. Until the Board of Trade shall otherwise direct, the Manchester Branch Office (hereinafter called "the Manchester Office") shall be the Manchester Branch of the Trade Marks Registry of the Patent Office, 48 Royal Exchange, Manchester, and applications for registration of designs in Classes 13, 14, and 15, and all communications intended to be made at or sent to the Manchester Office shall be addressed to the Keeper of Cotton Marks (hereinafter called "the Keeper") at 48 Royal Exchange, Manchester.

Applications in duplicate.

82. All applications for registration of designs in Classes 13, 14, and 15 shall be in duplicate, and if the application be lodged at the Office, one copy shall forthwith be sent by the Comptroller to the Keeper; if the application be addressed to the Keeper, he shall forthwith send one copy to the Comptroller. One of the forms of application shall be stamped and the other unstamped.

Form of application for checks or stripes.

83. Applications in Class 15 for registration of designs consisting substantially of checks or stripes only shall be made on Form Designs (Manchester) No. 2. If any doubt arises as to whether a design presented for registration on Form Designs (Manchester) No. 2 is a design consisting substantially of checks or stripes only, that doubt shall be determined by the Comptroller.

Form of application for designs other than checks or stripes.

84. Applications in Classes 13 and 14 for registration of designs shall be made on Form Designs (Manchester) No. 1.

Manchester Register.

85. There shall be kept at the Manchester Office a Register, to be called the Manchester Register, wherein the entries made shall be duplicates of the entries in the Register at the Office relating to designs registered in Classes 13 and 14 in the Third Schedule to the Designs Rules, 1890, of which the copyright shall be existing on the 1st January, 1908, and of those which shall be made on that date and thereafter relating to designs registered in Classes 13, 14, and 15.

Alteration of Register.

86. When any alteration or addition is made at the Office of or to an entry in the Register relating to a design included in those mentioned in Rule 85, the Comptroller shall forthwith give notice thereof to the Keeper, who shall alter the Manchester Register accordingly.

Notice of dispute.

87. Where a dispute arises with reference to a design entered in the Manchester Register, the parties thereto may give notice (in duplicate) to the Keeper on the Form Designs (Manchester) No. 3, and he shall make a note in the Manchester Register of such request, and shall send a copy of the note to the Comptroller, together with one copy of the notice. One copy of the Form Designs (Manchester) No. 3 shall be stamped and the other unstamped.

Procedure at Manchester.

88. All documents under these Rules shall, when they relate to designs in Classes 13, 14, and 15, be in duplicate, and may be lodged at the Office, or left at or sent to the Manchester Office, at the option of the applicant or other person lodging or leaving or sending the same. All documents which the Comptroller is directed to send may be sent from the Manchester Office by the Keeper when they relate to designs in Classes 13, 14, and 15. When any document bears a fee-stamp, the duplicate may be unstamped.

Appeals to the Board of Trade.

Appeal to Board of Trade.

89. When any person intends to appeal to the Board of Trade he shall, before doing so, apply to the Comptroller for a hearing, and may, if he considers it necessary, obtain the grounds of the Comptroller's decision. Within one month from the date of such decision, or from the date of the issue of the grounds thereof, if such have been issued, he shall, if he is advised to appeal to the Board of Trade, lodge a notice of such his intention on Form Designs No. 25, accompanied by a copy of the form of application and six representations of the design applied for, and a copy of the grounds of the Comptroller's decision, if any grounds have been issued.

Grounds of appeal to be stated.

90. Such notice shall also be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

Transmission of notice.

91. A copy of the notice and all the accompanying documents shall also be forthwith sent by the appellant to the Secretary of the Board of Trade, No. 7 Whitehall Gardens, London.

Directions by Board.

92. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to

parties and evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade.

Hearing of appeal.

93. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given by the Board of Trade to the Comptroller and to the appellant.

No appeal unless notice duly given.

94. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

Applications to and Orders of the Court.

Notice to Comptroller of application to rectify Register.

95. Four clear days' notice of every application to the Court under Section 72 of the Act for rectification of the Register of Designs shall be given to the Comptroller.

Order of Court.

96. Where an order has been made by the Court in any case under the Act, the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith serve on the Comptroller an Office copy of such order, together with Form Designs No. 26, if required. The Register may, if necessary, thereupon be rectified or altered by the Comptroller.

Publication of order of Court.

97. Whenever an order is made by the Court under the Act, the Comptroller may, if he thinks that the effect of such order should be made public, advertise a notice thereof in the *Journal*.

Repeal.

Repeal.

98. All general Rules relative to designs heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1902, and in force on the 31st day of December, 1907, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application or other matter then pending.

D. LLOYD GEORGE,
President of the Board of Trade.

Dated this 17th day of December, 1907.

SCHEDULES.

FIRST SCHEDULE.

FEES.

The following Fees shall be paid under the Act, so far as it relates to Designs. Such Fees must in all cases be paid before or at the time of the doing of the matter in respect of which they are to be paid :--

Subject or Proceeding.	Amount.	Corresponding Form.
	£ s. d.	
1. On application to register one design to be applied to a single article in a class, not being lace, and except articles in Classes 13 to 15.*	0 5 0	Designs No. 2
2. On application to register one design to be applied to a set of articles in a class, not being lace.	0 10 0	Designs No. 3
3. On application to register one design to be applied to lace, or to register one design in Class 15.	0 1 0	Designs No. 4, or Designs (Manchester) No. 2
4. On application to register one design to be applied to a set of lace articles.	0 2 0	Designs No. 5
5. On application to register one design in Class 13 or Class 14.	0 2 6	Designs (Manchester) No. 1
6. On application to Comptroller to state grounds of decision and materials used under Rule 33.	0 5 0	Designs No. 7
7. On extension of period of copyright under Section 53 (2).	1 0 0	Designs No. 8
8. On application for extension of period of copyright under Section 53 (3).	0 10 0	Designs No. 9
9. On extension of period of copyright under Section 53 (3).	1 10 0	Designs No. 10
10. On joint application to enter name of subsequent proprietor, &c.	Same as registration fee.	Designs No. 11 or 12
11. On application to enter name of subsequent proprietor, &c., under Rule 44, for each design.	0 10 0	Designs No. 13
12. On application of mortgagee, licensee, or other person having registered interest, for removal of his name.	0 1 0	Designs No. 15
13. On application for entry of address for service or of new address.	0 1 0	Designs No. 6 or 16
14. On application to correct clerical error	0 1 0	Designs No. 17
15. On application by proprietor or his representative for cancellation.	0 1 0	Designs No. 18
16. On application for search under Section 57 when registration number is supplied.	0 1 0	Designs No. 19

* NOTE.—By additional Designs Rules, dated 14th November, 1906, the Fee relative to carpets, rugs, floorcloths, and oilcloths, is reduced to 2s. 6d.

Subject or Proceeding.	Amount.	Corresponding Form.
17. On application for search under Section 57 when registration number is not supplied.	0 2 6	Designs No. 20
18. On application for search under Rule 60	0 2 6	Designs No. 21
19. On application for certificate of Comptroller for legal proceedings or other special purpose.	0 5 0	Designs No. 22
20. On application for cancellation under Section 58	1 0 0	Designs No. 23
21. On notice to Comptroller of intended exhibition of an unregistered design.	0 5 0	Designs No. 24
22. On notice to Keeper under Rule 87	0 2 6	Designs (Manchester) No. 3
23. On appeal from Comptroller to Board of Trade in respect of each decision appealed against.	0 5 0	Designs No. 25
24. For each entry in the Register of an alteration in pursuance of an Order of Court.	0 5 0	Designs No. 26
25. Copy of Certificate of Registration, each copy ..	0 1 0	Designs No. 27
26. Inspection of Register or design where inspection is permitted, except inspection under the second paragraph of Section 56 (1) of the Act, for each quarter of an hour.	0 1 0	—
27. Office copy of design	Cost according to agreement	
28. For Office copy of documents, every 100 words .	0 0 4 but never less than 1s.	
29. For certifying Office copies, MSS. or printed ...	0 1 0	

The Fees to be paid on any proceeding at the Manchester Office shall be the same as for the similar proceeding at the London Office.

Dated this 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

Approved—

JOSEPH A. PEASE,
J. H. WHITLEY,
Lords Commissioners of His Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

SUBJECT.	No. in Schedule I.
Authorisation	–
Application for registration of design, not being lace, and except articles in Classes 13 to 15.	1
Application for registration of set of designs, not being lace	2
Application for registration of a design to be applied to lace	3
Application for registration of design to be applied to a set of lace articles.	4
Application for entry of address for service in Register	13
Request for statement of grounds of decision under Rule 33	6
Certificate of registration	–
Extension of copyright for second period	7
Application for extension of copyright for third period	8
Extension of copyright for third period	9
Joint request by registered proprietor and assignee, &c., to enter the name of assignee, &c., in the Register.	10
Joint request by registered proprietor and assignee of design in Class 9 to enter the name of assignee in the Register.	10
Request to enter name of subsequent proprietor, &c., in the Register under Rule 44.	11
Form of declaration in support of statement of case accompanying Form Designs No. 13.	–
Form of application under Rule 49 to vacate entry of name of mortgagee or licensee in Register.	12
Form of application for alteration of address or address for service in Register.	13
Form of request for correction of clerical error in application to Register, or for correction of clerical error under Section 70.	14
Form of application by registered proprietor to cancel entry in Register.	15
Request for search under Section 57 when registration number is supplied.	16
Request for search under Section 57 when registration number is not supplied.	17
Request for search under Rule 60	18
Request for certificate for use in legal proceedings or other special purpose.	19
Request for cancellation of registration under Section 58	20
Notice of intended exhibition of an unregistered design	21
Application for registration of design in Class 13 or Class 14	5
Application for registration of a design in Class 15	3
Notice to Keeper under Rule 87	22
Appeal from Comptroller to the Board of Trade	23
Request for the Register to be altered in pursuance of an Order of the Court.	24
Application for copy of Certificate of Registration	25

THIRD SCHEDULE.

Classification of Goods.

Class 1.—Articles composed wholly of metal or in which metal predominates, not included in Class 2.

Class 2.—Jewellery.

Class 3.—Articles composed wholly of wood, bone, ivory, papier maché, or other solid substances not included in other Classes, or of materials in which such substances predominate.

Class 4.—Articles composed wholly of glass, earthenware, or porcelain, bricks, tiles, or cement, or in which such materials predominate.

Class 5.—Articles composed wholly of paper (except paper hangings), cardboard, millboard, or strawboard, or in which such materials predominate.

Class 6.—Articles composed wholly of leather or in which leather predominates, and bookbinding of all materials.

Class 7.—Paper hangings.

Class 8.—Carpets and rugs in all materials, floorcloths, and oilcloths.

Class 9.—Lace.

Class 10.—Hosiery.

Class 11.—Millinery and wearing apparel, including boots and shoes.

Class 12.—Ornamental needlework on muslin or other textile fabrics.

Class 13.—Printed or woven designs on textile piece goods (other than checks or stripes).

Class 14.—Printed or woven designs on handkerchiefs and shawls (other than checks or stripes).

Class 15.—Printed or woven designs (on textile piece goods or on handkerchiefs or shawls), being checks or stripes.

Class 16.—Goods not included in other classes.

D. LLOYD GEORGE,
President of the Board of Trade.

Dated this 17th day of December, 1907

STATUTORY RULES AND ORDERS, 1908.

No. 967.

DESIGNS.

The Designs Rules, 1908 (Second Set). Dated November 14, 1908.

BY VIRTUE of the provisions of The Patents and Designs Act, 1907, the Board of Trade do hereby make the following Rules :—

Preliminary.

1. These Rules may be cited as "The Designs Rules, 1908 (Second Set)," and shall come into operation from and immediately after the 1st day of December, 1908.

Fees.

2. The fee payable on an application to register one design to be applied to carpets, rugs, floorcloths, and oilcloths shall be two shillings and sixpence instead of five shillings as heretofore.

Dated this 14th day of November, 1908.

WINSTON S. CHURCHILL,
President of the Board of Trade.

Approved—

J. HERBERT LEWIS,
CECIL NORTON,
Lords Commissioners of His Majesty's Treasury.

APPENDIX A.

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 and when the 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 Denby 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 licence 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 are contained in the Schedule attached hereto, and in respect to 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 5.

AGREEMENT for Sale of Patent to Company, made between Patentee and Trustee for Syndicate about to form a Company; agreed consideration, partly cash, partly shares in Company; Patentee to be a Director in Company; Agreement to become void in the event of capital not being subscribed.

Memorandum of Agreement made this day of . 19 , BETWEEN WILLIAM SCOTT, of Brierfield Hall, Northwich, in the County of Chester (hereinafter called "the Vendor"), of the one part, and GEORGE SCATTERGOOD, of No. 3 Capstan Street, in the City of Liverpool, Solicitor (hereinafter called "the Trustee"), of the other part.

WHEREAS the said Vendor claims to be the true and first inventor of certain "Improvements in Pneumatic Wheel Tyres," for which he has obtained His Majesty's Letters Patent No. 14,036, under date the 12th February, 1902, and also certain foreign and colonial patents as set forth in the Schedule A hereto: AND WHEREAS the parties whose names appear in the Schedule B hereto, together with the amounts of their respective holdings or interests, and who are hereinafter referred to as "the Syndicate," have duly empowered and appointed the said Trustee to agree to purchase the said invention and Letters Patent (home, foreign, and colonial) from the Vendor, in trust for and on their behalf, for the consideration of £10,000 in cash, together with certain fully paid-up shares, but subject to the conditions hereinafter expressed:

NOW THESE PRESENTS WITNESS that, in pursuance of the said Agreement and authorisation, and for the considerations

and subject to the conditions herein expressed, IT IS HEREBY AGREED between the said Vendor and the said Trustee as follows:—

1. The Trustee shall upon the signing of these presents pay to the Vendor the sum of £250, being part payment of the aforesaid sum of £10,000, receipt of which sum of £250 is hereby acknowledged by the Vendor, and the Trustee shall thereupon inform the Syndicate of the execution of this Agreement.

2. The Syndicate or their agents shall then take the necessary steps to promote and form a limited company, to be entitled "The Scott Patent Tyre Company, Limited," and shall register the said company in terms of The Companies (Consolidation) Act, 1908, 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 88 of The Companies (Consolidation) Act, 1908.*

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.

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 Patents 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 as 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 centum 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 centum 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 centum 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 B.

THE

PATENTS AND DESIGNS ACT, 1907.

(7 EDW. VII., CHAPTER 29.)

ARRANGEMENT OF SECTIONS.

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THE PATENTS AND DESIGNS ACT, 1907.[1]

(7 EDW. VII., CHAPTER 29.)

An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks.

[28th August, 1907.

BE IT ENACTED by the King's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

PART I.—PATENTS.

Application for and Grant of Patent.

Application.

1. (1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner. (P. R. 5 to 8, 10 to 26, and 97.)

(3) The 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 at least of the applicants, claims to be the true and first inventor, for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.

[1] In this copy of the Act references have been inserted to the Patents Rules (P.R.), Designs Rules (D. R.), and Law Officer's Rules (L. O. R.), 1907, made pursuant to the Act.

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed. (P. R. 10.)

Specifications.

2. (1) A provisional specification must describe the nature of the invention.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

(3) In the case of any provisional or complete specification where the comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification. (P. R. 19 to 26.)

(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed. (P. R. 14.)

(5) Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification. (P. R. 36.)

Proceedings upon application.

3. (1) The Comptroller General of Patents, Designs, and Trade Marks (hereinafter referred to as the comptroller) shall refer every application to an examiner.

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings 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.

(3) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.

(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant. (P. R. 38.)

Provisional protection.

4. 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 invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

Time for leaving complete specification.

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

Provided that where an application is made for an extension of the time for leaving a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month. (P. R. 4 and 27, Sch. I. 6.)

(2) Unless a complete specification is so left the application shall be deemed to be abandoned.

Comparison of provisional and complete specification.

6. (1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner.

(2) If the examiner reports that the complete specification has not been prepared in the prescribed manner, the comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the comptroller may—

(*a*) refuse to accept the complete specification until it has been amended to his satisfaction; or

(*b*) (with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date:

Provided that where the complete specification includes an invention not included in the provisional specification, the comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left.

(4) A refusal of the comptroller to accept a complete specification shall be subject to appeal to the law officer, who 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.

(5) Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void:

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months. (P. R. 4 and 37, Sch. I. 7.)

Investigation of previous specifications in

7. (1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries

which he is directed to make by this 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 complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application. (P. R. 28, 29, and 30.)

United Kingdom on applications for patents.

(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. (P. R. 30.)

(3) 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.

(4) If the comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection is 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 (P. R. 31 and 32):

Provided that the comptroller, if satisfied that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent.

(5) An appeal shall lie from the decision of the comptroller under this section to the law officer.

(6) 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 connexion with, any such investigation or report, or any proceeding consequent thereon.

Investigation of specification published subsequently to application.

8. (1) An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior applications; and that section shall, subject to rules under this Act, have effect accordingly.

(2) Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public. (P. R. 33, 34, and 35.)

(3) For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.

(4) 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.

Advertisement on acceptance of complete specification.

9. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection. (P. R. 38 and 39.)

Effect of acceptance of complete specification.

10. 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 until a patent for the invention has been granted to him.

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 any of the following grounds:—

(*a*) That the applicant obtained the invention from him, or from a person of whom he is the legal representative; or

(*b*) That the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent; or

(*c*) That the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or

(*d*) 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. (P. R. 40 to 47.)

(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 opponent, if desirous of being heard, decide on the case.

(3) The decision of the comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and 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 may determine.

Grant and sealing of patent.

12. (1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application to the applicants jointly, and the comptroller shall cause the patent to be sealed with the seal of the Patent Office. (P. R. 48, Sch. I. 10.)

(2) *A patent shall be sealed as soon as may be,* and not after the expiration of fifteen months from the date of application: Provided that—

(*a*) Where the comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent:

(*b*) 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:

(*c*) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death:

(*d*) Where in consequence of the neglect or failure of the applicant to pay any fee

a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall, in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act. (P. R. 48.)

Date of patent.

13. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.

Effect, extent, and form of patent.

14. (1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man:

Provided that 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.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim; and 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 has been granted for more than one invention. (P. R. 49 to 51, Sch. III. A.)

Fraudulent applications for patents.

15. (1) 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.

(2) 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 patent so revoked:

Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.

Single patent for cognate inventions.

16. (1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the court or the comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein.

Term of Patent.

Term of patent.

17. (1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be fourteen years from its date.

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times: Provided that the comptroller, upon the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months. (P. R. 52 to 54, Sch. I. 23.)

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure

to pay any fee within the prescribed time, and before any enlargement thereof, the court before which the proceeding is proposed to be taken may, if it think fit, refuse to award any damages in respect of such infringement.

Extension of term of patent.

18. (1) A patentee may, after advertising in manner provided by Rules of the Supreme Court his intention to do so, present a petition to the court 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 give notice to the court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the comptroller shall be entitled to appear and be heard, and shall appear if so directed by the court.

(4) The court, in considering its decision, shall 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 it appears to the court that the patentee has been inadequately remunerated by his patent, the court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the court may think fit.

Patents of addition.

19. (1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired. (P. R. 50, Sch. III. B.)

(2) Where an application containing such a request is made, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.

(3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal.

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

Restoration of Lapsed Patents.

Restoration of lapsed patents.

20. (1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the comptroller in the prescribed manner for an order for the restoration of the patent. (P. R. 55, Sch. I. 24.)

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office. (P. R. 55 to 58.)

(4) Where such notice is given the comptroller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the comptroller shall hear the case and, subject to an appeal to the court, issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such provisions as may be prescribed shall

be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal. (P. R. 58 and 59.)

Amendment of Specification.

Amendment of specification by comptroller.

21. (1) An applicant or a patentee may at any 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, and the reasons for, the proposed amendment. (P. R. 60, 66, and 67.)

(2) The request and the nature of the 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. (P. R. 60 to 65.)

(3) Where such a notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

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

(5) The decision of the comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and where there is no opposition, the comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) 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.

(7) 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 be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification. (P. R. 67.)

(8) This section shall not apply when and so long as any action for infringement or proceeding before the court for the revocation of a patent is pending.

Amendment of specification by the court.

22. In any action for infringement of a patent or proceedings before a court for the revocation of a patent the court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs, advertisement or otherwise, as the court may think fit:

Provided that no amendment shall be so 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 the amendment, and where an application for such an order is made to the court notice of the application shall be given to the comptroller, and the comptroller shall have the right to appear and be heard, and shall appear if so directed by the court.

Restriction on recovery of damages.

23. Where an amendment of a specification 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.

Compulsory Licences and Revocation.

Compulsory licences and revocation.

24. (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. (P. R. 68 to 74.)

(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 court, 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 court, and it is proved to the satisfaction of the court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the court to grant licences on such terms as the court may think just, or, if the court is 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 of the court:

Provided that an order of revocation shall not 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) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(*a*) If by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent, or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or

industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or

(*b*) If any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the court 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.

Revocation of patent.

25. (1) Revocation of a patent may be obtained on petition to the court.

(2) Every ground on which—

(*a*) A patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by scire facias; or

(*b*) A patent may be revoked under this Act either by the comptroller or as an alternative to the grant of a compulsory licence:

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

(3) A petition for revocation of a patent may be presented—

(*a*) By the Attorney-General or any person authorised by him; or

(*b*) By any person alleging—

(i) That the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) 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; or

(iii) 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.

Power of comptroller to revoke patents on certain grounds.

26. (1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed (P. R. 75 and 76):

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court.

(2) The comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

(3) A patentee may at any time by giving notice in the prescribed manner to the comptroller offer to surrender his patent, and the comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent. (P. R. 77.)

(4) Any decision of the comptroller under this section shall be subject to appeal to the court.

Revocation of patents worked outside the United Kingdom.

27. (1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom. (P. R. 78 to 81.)

(2) The comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

(*a*) Forthwith; or

(*b*) After such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent:

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to a adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

Register of Patents.

Register of patents.

28. (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 be prescribed. (P. R. 82 to 93.)

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

(3) The register of patents shall be prima facie evidence of any matters by this Act directed or authorised to be inserted therein.

(4) 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. (P. R. 88 to 91.)

Crown.

Patent to bind Crown.

29. A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject:

Provided that any Government department may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.

Assignment to Secretary for War or the Admiralty of certain inventions.

30. (1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any

patent obtained or to be obtained for the invention; and the Secretary of State or the Admiralty 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 or the Admiralty on behalf of His 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 or the Admiralty.

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the comptroller 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 or the Admiralty so certify the application and specifications, with the drawings (if any), and any amendment of the complete specification, 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 or the Admiralty.

(5) The packet shall, until the expiration of the 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 the Admiralty or of the law officer.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

(8) Where the Secretary of State or the Admiralty certify as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the complete specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State or the Admiralty.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State or the Admiralty 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 Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State or the Admiralty may at any time 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 the Admiralty, or to any person or persons authorised by the Secretary of State or the Admiralty 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.

(13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid. (P. R. 97 to 99.)

Legal Proceedings.

Hearing with assessor.

31. (1) In an action or proceeding for infringement or revocation of a patent, the court may, if it think 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 the case wholly or partially with his assistance; the action shall be tried without a jury unless the court otherwise directs.

(2) The Court of Appeal may, if they think fit, in any proceeding before them 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, as the case may be, and be paid as part of the expenses of the execution of this Act.

Power to counter-claim for revocation in an action for infringement.

32. A defendant in an action for infringement of a patent, if entitled to present a petition to the court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the Rules of the Supreme Court by way of counter-claim in the action for the revocation of the patent.

Exemption of innocent infringer from liability for damages.

33. A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an 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 on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:

Provided that nothing in this section shall affect any proceedings for an injunction.

Order for inspection, &c., in action.

34. In an action for infringement of a patent, the court 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 may see fit.

Certificate of validity questioned and costs thereon.

35. In an action for infringement of a patent, the court may certify that the validity of the patent came in question; and, if the court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

Remedy in case of groundless threats of legal proceedings.

36. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats:

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Miscellaneous.

Grant of patent to two or more persons.

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent,

and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate. (P. R. 51.)

Avoidance of certain conditions attached to the sale, &c., of patented articles.

38. (*1*) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

(*a*) To prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(*b*) To require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent:

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy:

Provided that this sub-section shall not apply if—

(i) The seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) The contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding sub-section, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

(*a*) Affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(*b*) Be construed as validating any contract which would, apart from this section, be invalid; or

(*c*) Affect any right of determining a contract or condition in a contract exercisenble independently of this section; or

(*d*) Affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

Costs and security for costs.

39. (1) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the court.

(2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man the comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

Procedure on appeal to law officer.

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of the Act; and in any proceeding before the law officer 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.[1]

[1] See the L. O. R. for procedure on appeal to the Law Officer.

Provisions as to anticipation.

41. (1) An invention covered by any patent applied for on or after the first day of January, one thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.

Disconformity

42. A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.

Patent on application of representative of deceased inventor.

43. (1) If the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative. (P. R. 11.)

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

Loss or destruction of patent.

44. 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 seal a duplicate thereof. (P. R. 100.)

Provisions as to exhibitions.

45. (1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application: Provided that—

(*a*) The exhibitor, before exhibiting the invention, gives the comptroller the prescribed notice of his intention to do so; and

(*b*) The application for a patent is made before or within six months from the date of the opening of the exhibition. (P. R. 101.)

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

Publication of illustrated journal, indexes, &c.

46. (1) The comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he 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 in force, with any accompanying drawings.

(3) The comptroller shall continue, in such form as he deems expedient, the indexes and abridgments of specifications hitherto published, and shall prepare and

publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he thinks fit.

Patent Museum.

47. (1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

(2) The Board of Education 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.

48. (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 His 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) This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.

PART II.—DESIGNS.

Registration of Designs.

Application for registration of design

49. (1) The comptroller may, on the application made in the prescribed form and manner of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this Part of this Act. (D. R. 13 to 36 and 80 to 88.)

(2) The same design may be registered in more than one class, and, in case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question. (D. R. 6, Sch. III.)

(3) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal to the Board of Trade, and the Board shall, after hearing the applicant and the comptroller, if so required, make an order determining whether, and subject to what conditions, if any, registration is to be permitted. (D. R. 89 to 94.)

(4) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned. (D. R. 35.)

(5) A design when registered shall be registered as of the date of the application for registration.

Registration of designs in new classes.

50. Where a design has been registered in one or more classes of goods the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated—

(*a*) On the ground of the design not being a new and original design, by reason only that it was so previously registered; or

(*b*) On the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods of any class in which it was so previously registered.

Certificate of registration.

51. (1) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate. (D. R. 67.)

Register of designs.

52. (1) There shall be kept at the Patent Office a book called the Register of Designs wherein shall be entered the names and addresses of proprietors of

registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may be prescribed. (D. R. 69.)

(2) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

(3) The register of designs shall be primâ facie evidence of any matters by this Act directed or authorised to be entered therein.

Copyright in registered Designs.

Copyright on registration.

53. (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2) If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller shall on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period of five years. (D. R. 37 and 38.)

(3) If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller may, subject to any rules under this Act, on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years. (D. R. 39 to 42.)

Requirements before delivery on sale.

54. (1) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall—

(*a*) (If exact representations or specimens were not furnished on the application for registration) furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon the copyright in the design shall cease; and

(*b*) Cause each such article to be marked with the prescribed mark, or with the prescribed words or figures, denoting that the design is registered; and if he fails to do so the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design. (D. R. 20 to 30, and 68.)

(2) Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as they think fit. (D. R. 68.)

Effect of disclosure on copyright.

55. The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.

Inspection of registered designs.

56. (1) During the existence of copyright in a design, or such shorter period not being less than two years from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorised in

writing by him, or a person authorised by the comptroller or by the court, and furnishing such information as may enable the comptroller to identify the design, and shall not be open to the inspection of any person except in the presence of the comptroller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2) After the expiration of the copyright in a design, or such shorter period as aforesaid, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

(3) Different periods may be prescribed under this section for different classes of goods. (D. R. 61 and 69.)

Information as to existence of copyright.

57. On the request of any person furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, the comptroller shall inform such person whether the registration still exists in respect of the design, and if so, in respect of what classes of goods, and shall state the date of registration, and the name and address of the registered proprietor. (D. R. 59 and 60.)

Cancellation of registration of designs used wholly or mainly abroad.

58. (1) At any time after the registration of a design any person may apply to the comptroller for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom, and where such an application is made the provisions of this Act with respect to the revocation of patents worked outside the United Kingdom (including those relating to costs) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the comptrolle.. (D. R. 70 to 75.)

(2) Such ground as aforesaid shall be available by way of a defence to an action for infringement of the copyright in the design.

Industrial and International Exhibitions.

Provisions as to exhibitions.

59. (1) The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof: Provided that—

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

(*b*) The application for registration is made before or within six months from the date of the opening of the exhibition. (D. R. 76.)

(2) His Majesty may, by Order in Council, apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

Legal Proceedings.

Piracy of registered design.

60. (1) During the existence of copyright in any design it shall not be lawful for any person—

(*a*) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enabling the design to be so applied; or

(*b*) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this section he shall be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt, or if the proprietor elects to bring an action for the recovery of damages for such contravention, and for an injunction against the repetition thereof, he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly :

Provided that the total sum recoverable as a simple contract debt in respect of any one design shall not exceed one hundred pounds.

Application of certain provisions of the Act as to patents to designs.

61. The provisions of this Act with regard to certificates of the validity of a patent, and to the remedy in case of groundless threats of legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design for references to the patentee, and of references to the design for references to the invention.

PART III.—GENERAL.

Patent Office and Proceedings thereat.

Patent Office.

5 Edw. VII. c. 15.

62. (1) The Treasury may continue to provide for the purposes of this Act and The Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established. (D. R. 80 to 88.)

Officers and clerks.

63. (1) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and The Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

Seal of Patent Office.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

Fees.

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule. (P. R. 4, Sch. 1. D. R. 3, Sch. 1.)

Provisions as to Registers and other Documents in Patent Office.

Trust not to be entered in registers.

66. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

Inspection of and extracts from registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee. (P. R. 94. D. R. 61.)

Privilege of reports of examiners.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Prohibition of publication of specification, drawings, &c., where application abandoned, &c.

69. (1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connexion with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the comptroller.

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection or be published by the comptroller.

Power for comptroller to correct clerical errors.

70. The comptroller may, on request in writing accompanied by the prescribed fee—

(*a*) Correct any clerical error in or in connexion with an application for a patent or in any patent or any specification (P. R. 95);

(*b*) Cancel the registration of a design either wholly or in respect of any particular goods in connexion with which the design is registered (D. R. 53 and 54);

(*c*) Correct any clerical error in the representation of a design or in the name or address

of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs. (P. R. 95, Sch. I. 43. D. R. 51, 52, Sch. I. 14.)

Entry of assignments and transmissions in registers.

71. (1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design. (P. R. 85 to 91. D. R. 43 to 49.)

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be. (P. R. 90 and 91. D. R. 43 to 49.)

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

Rectification of registers by court.

72. (1) The court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the court.

(4) Any order of the court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

Powers and Duties of Comptroller.

Exercise of discretionary power by comptroller.

73. Where any discretionary power is by or under this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard. (*P. R.* 102 to 105. D. R. 55 to 58.)

Power of comptroller to take directions of law officers.

74. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer for directions in the matter.

Refusal to grant patent, &c., in certain cases.

75. The comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality.

Annual reports of comptroller.

76. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that 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.

Evidence, &c.

Evidence before comptroller

77. (1) Subject to rules under this Act in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration in

the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence *viva voce* in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit. (P. R. 106 and 107. D. R. 77 and 78.)

(2) In case any part of the evidence is taken *viva voce*, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.

Certificate of comptroller to be evidence.

78. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone. (P. R. 96. D. R. 67.)

Evidence of documents in Patent Office.

79. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Transmission of certified printed copies of specifications, &c.

80. (1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in

pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Applications and notices by post.

81. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post. (P. R. 7. D. R. 9.)

Excluded days.

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day. (P. R. 110 and 111. D. R. 61, 65, and 66.)

Declaration by infant, lunatic, &c.

83. (1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

Register of Patent Agents.

Register of patent agents.

84. (1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by

any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, one thousand eight hundred and eighty-eight, he had been *bonâ fide* practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act. (P. A. R. 6, 7.)

(3) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Agents for patents.

85. (1) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent. (P. R. 9. D. R. 12.)

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Powers, &c., of Board of Trade.

Power for Board of Trade to make general rules.

86. (1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(*a*) For regulating the practice of registration under this Act:

(*b*) For classifying goods for the purposes of designs:

(*c*) For making or requiring duplicates of specifications, drawings, and other documents:

(*d*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents:

(*e*) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(*f*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(*g*) For regulating the keeping of the register of patent agents under this Act:

(*h*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the comptroller, and shall be laid before

both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

Proceedings of the Board of Trade.

87. (1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Provision as to Order in Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

Offences.

Offences.

89. (1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

90. (1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article:

Unauthorised assumption of Royal Arms.

(2) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the

Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds:

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

International and Colonial Arrangements.

International and Colonial arrangements.

91. (1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or The Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign state:

Provided that—

(*a*) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign state; and

(*b*) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country. (P. R. 17, 18, and 83.)

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated -

(*a*) In the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(*b*) In the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design; or

(*c*) In the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or The Trade Marks Act, 1905: Provided that—

(*a*) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period; and (P. R. 15 to 18)

(*b*) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under The Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

Definitions.

Provisions as to "the court."

92. (1) In this Act, unless the context otherwise requires, "the court" means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2) Where by virtue of this Act a decision of the comptroller is subject to an appeal to the court, or a petition may be referred or presented to the court, the appeal shall, subject to and in accordance with Rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.

Definitions.

93. In this Act, unless the context otherwise requires—

"Law officer" means the Attorney-General or Solicitor-General for England:

"Prescribed" means prescribed by general rules under this Act:

"British possession" does not include the Isle of Man or the Channel Islands:

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention:

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant.

"Design" means any design (not being a design for a sculpture or other thing within the protection of The Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined: 54 Geo. III. c. 50.

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural:

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered:

"Proprietor of a new and original design,"—

(*a*) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and

(*b*) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(c) In any other case, means the author of the design;

and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

Application to Scotland, Ireland, and the Isle of Man.

Application to Scotland

94. In the application of this Act to Scotland—

(1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed:

(2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:

(3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act:

(4) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as

the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court:

(5) Notwithstanding anything in this Act, the expression "the court" shall, as respects petitions for compulsory licences on revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the time of a patent mean such Lord Ordinary:

(6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt:

(7) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly:

(8) The expression "injunction" means "interdict."

95. In the application of this Act to Ireland— Application to Ireland.

(1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only:

(2) The provisions of this Act conferring a special jurisdiction on the court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Ireland in any proceedings

relating to patents or to designs; and with reference to any such proceedings the term "the Court" means the High Court in Ireland:

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

96 This Act shall extend to the Isle of Man, subject to the following modifications:—

(1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those courts:

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court:

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Savings, and Short Title.

Saving for prerogative.

97. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

Repeal and savings.

98. (1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that Schedule—

(*a*) As respects the enactments mentioned in Part I. of that Schedule, as from the commencement of this Act;

(*b*) As respects the enactments mentioned in Part II. of that Schedule, as from the date when rules of the Supreme Court regulating the matters dealt with in those enactments come into operation;

(*c*) As respects the enactments mentioned in Part III. of that Schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation;

and the enactments mentioned in Part II. [illegible] Part III. of that Schedule shall, until so repealed, have effect as if they formed part of this Act:

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

Short title and commencement.

99. This Act may be cited as "The Patents and Designs Act, 1907," and shall, save as otherwise expressly provided, come into operation on the first day of January, one thousand nine hundred and eight.

SCHEDULES.

Section 65.

FIRST SCHEDULE.

Fees on Instruments for Obtaining Patents and Renewal.

Note.—This Schedule is not reprinted, the Statutory Fees having been replaced by another Schedule issued by the Board of Trade. See the First Schedule to The Patents Rules, 1908.

SECOND SCHEDULE.

Section 98.

Enactments Repealed.

PART I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except subsections (5), (6), and (7) of section twenty-six, section twenty-nine, subsections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886 ...	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. VII. c. 18.	The Patents Act, 1901 ...	The whole Act.
2 Edw. VII. c. 34.	The Patents Act, 1902 ...	The whole Act.
7 Edw. VII. c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

SECOND SCHEDULE—*continued*

PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (5), (6) and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (2) and (3) of section forty-seven and section forty-eight.

APPENDIX C.

THE

PATENTS AND DESIGNS ACT, 1908.

(8 EDW. VII., CHAPTER 4.)

An Act to explain Section Ninety-two of The Patents and Designs Act, 1907. **[1st August, 1908.**

BE IT ENACTED by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Explanation of 7 Edw. VII. c. 29 s. 92.

1. It is hereby declared that so much of Subsection (2) of Section Ninety-two of the Patents and Designs Act, 1907, as provides that the decision of a Judge of the High Court to whom a petition is presented by virtue of that Act is to be final does not apply in the case of a petition for the revocation of a patent under Section Twenty-five of that Act.

Short title.

2. This Act may be cited as "The Patents and Designs Act, 1908."

APPENDIX D.

RULES OF THE SUPREME COURT.

ORDER 53A.

DATED JUNE 3RD, 1908.

PROCEDURE IN ACTIONS FOR INFRINGEMENTS OF PATENTS AND UNDER THE PATENTS AND DESIGNS ACT, 1907.

1. In this Order:—

"The Act" means "The Patents and Designs Act, 1907."

"The Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks.

"The Court" includes the Judge of the High Court for the time being selected by the Lord Chancellor as the Court for the purpose of hearing appeals and petitions under the Act.

2. The Rules of the Supreme Court for the time being in force shall apply, so far as may be practicable (unless by the Act or by these Rules otherwise expressly provided), to all proceedings before the Court under the Act. In particular, if the Court is for the time being a Judge of the Chancery Division, the provisions of Order 5, Rule 9 (*a*) shall apply to all such proceedings, as being business assigned to the Court within the meaning of that Rule.

3. In the case of petitions for extension of the terms of a patent, under Section 18 of the Act, the following Rules shall apply:—

(*a*) A party intending to apply by petition, under Section 18 of the Act, shall give public notice by advertising three

times in the *London Gazette*, and once at least in a London daily newspaper the price of which is not less than one penny.

(*b*) 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 *such* place of business, then if he carries on the manufacture of anything made under his specification in the United Kingdom, at a distance of fifteen miles or more from Charing Cross, he shall advertise once at least in some local newspaper published or circulated in the town or district where he carries on such manufacture. If he has no *such* place of business, and carries on no such manufacture in the United Kingdom, then if he resides in the United Kingdom, 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.

(*c*) The applicant shall in his advertisements state the object of his petition, and shall give notice of the day (which, if the Court is for the time being a Judge of the Chancery Division, shall be an ordinary petition day) on which he intends to apply to the Court for a day to be fixed, before which the petition shall not be in the paper for hearing (hereinafter called "the appointed day"), which first-mentioned 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*. Every such advertisement shall state an address within the United Kingdom for service on the applicant of any document requiring service under this Rule. He shall also give notice that notices of objection must be lodged as hereinafter provided [*on or*] before such day so named in the said advertisements. A copy of such advertisement shall be forwarded by the applicant to the Solicitor for the Board of Trade at the same time as the first advertisement is sent to the *London Gazette*,

and the Board of Trade shall thereupon cause such advertisement to be inserted in the three following issues of the *Illustrated Official Journal (Patents)*.

(*d*) A petition, under Section 18 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*, and a copy of the petition must within the same time be furnished to the Solicitor of the Board of Trade. Such petition shall be made returnable for the day named in the advertisements.

(*e*) The petition must be accompanied by an affidavit, or affidavits, of advertisements having been published by the petitioner, according to the requirements of Rules (*a*), (*b*), and (*c*) hereof. The statements contained in such affidavit, or affidavits, may be disputed upon the hearing.

(*f*) Upon the day named in the advertisements the petition shall appear in the Court List, and the petitioner shall apply to the Court to fix the appointed day.

(*g*) The petitioner shall forthwith, after the appointed day has been fixed, give public notice of the same by advertising once at least in the *London Gazette*.

(*h*) A party presenting a petition, under Section 18 of the Act, must lodge as hereinafter provided a copy thereof, with two printed copies of the specification of his patent.

(*i*) The petitioner shall also lodge as hereinafter provided, not less than three weeks before the appointed day, two 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 Court at the hearing. He shall also at the same time furnish three copies of the specification and of the said balance sheet to the Solicitor to the Board of Trade, and shall upon receiving two days' notice give the Solicitor to the Board of Trade, 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, or from which the materials for making up the said balance sheet have been derived.

(*j*) Any person desirous of opposing the prayer of a petition, under Section 18 of the Act, shall lodge as hereinafter provided a notice that he intends so to oppose, and giving an address in the United Kingdom for service of any document requiring service under this Rule. Such person shall at the same time serve upon the petitioner a copy of such notice. Such notices shall be respectively lodged and served before the day named in the petitioner's advertisements as that on which he intends to apply to the Court for the appointed day to be fixed.

(*k*) The petitioner shall forthwith upon receipt of such notice serve a copy of his petition upon each person giving such notice.

(*l*) Every person giving such notice as aforesaid shall, within three weeks after service of the petition upon him, lodge as hereinafter provided, two copies, and serve upon the petitioner one copy, and lodge with the Solicitor of the Board of Trade three copies in writing of particulars of the objections upon which he intends to rely against the granting of the prayer of the petition.

(*m*) Any person who shall not, within the said three weeks, lodge and serve such particulars of objections as aforesaid, shall be deemed to have abandoned his opposition.

(*n*) No person who has delivered such particulars of objections shall be entitled to oppose the granting of the prayer of the petition on any grounds not stated in such particulars.

(*o*) Any person who has lodged notice that he intends to oppose the granting of the prayer of the petition shall be entitled to be heard on the application to fix the appointed day, and every person who has lodged and served particulars of objection shall be served by the petitioner with notice of the appointed day.

(*p*) The petition shall not be entered in the List for trial, until the expiration of the time limited for the lodging and

service of the particulars of objections, and shall only be entered for trial on the lodging of an affidavit on behalf of the petitioner that all persons who have served him with notice of intention to oppose the prayer of his petition have been served with copies of the petition. The petition shall, if and so long as the Court is a Judge of the Chancery Division, and subject to any direction of the Court to the contrary, be set down in the same manner as if it had been a witness action assigned to that Judge, and shall be marked in the Witness List not before the of 19 , being the appointed day.

(*q*) Any persons who have delivered particulars of objections shall be entitled, at their own expense, to obtain from the petitioner copies of the accounts which have been lodged by him.

(*r*) All petitions, documents, and copies by these rules required to be lodged shall, if and so long as the Court is a Judge of the Chancery Division, be lodged at the chambers of the Judge, and, subject as aforesaid, shall be lodged with such person and at such place as the Court may from time to time direct.

(*s*) The Court 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 18 of the Act as it shall consider to be just and expedient.

(*t*) The Comptroller, if he elects, or is directed to appear on the question of granting the prayer of any petition, under Section 18 of the Act, shall not be 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 Court.

(*u*) The Court may, in cases where opposition has been entered to the prayer of a petition, under Section 18 of the Act, give costs to or against such opponents.

(*v*) In the event of the Court refusing the prayer of the petition the Court shall not, except under special circumstances, give more than one set of costs amongst all the opponents.

(*c*) The Comptroller-General and the Board of Trade shall not be entitled to any costs on or in relation to their appearance on or opposition to the granting of the prayer of a petition.

(*x*) Service of any document requiring service under this Rule may be made by enclosing such document in a prepaid registered letter and posting such letter to the person required to be served at his address for service.

4. All appeals to the Court from any decision of the Comptroller, under Sections 20, 26, or 27 of the Act, shall be brought by petition presented to the Court within one calendar month of the decision of the Comptroller, or within such further time as the Court may under special circumstances allow. Each such petition 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. It shall also state concisely the grounds of the appeal, and no grounds, other than those so stated, shall, except with the leave of the Court, to be given on such terms and conditions as may seem just, be allowed to be taken by the appellant at the hearing.

5. Every appeal to the Court under Sections 20, 26, or 27 of the Act shall, if and so long as the Court is a Judge of the Chancery Division, and subject to any direction of the Court to the contrary, be set down in the same manner as if it were a witness action assigned to such Judge, and be heard and disposed of in due course.

6. In all proceedings before the Court under Sections 20, 26 and 27 of the Act, the evidence used shall be the same as that used at the hearing before the Comptroller, and no further evidence shall be given except by the leave of the Court on application to be made to the Court at or before the hearing.

7. In all petitions referred by the Board of Trade to the Court under Section 24 of the Act, the following Rules shall apply:—

(*a*) No evidence shall be given upon any issues, other than those raised upon the original petition before the Board of Trade.

(*b*) Every person who has given notice of opposition in accordance with the Patent Rules, 1908, shall be entitled to be heard on such petition, and the Court may direct the petition to be served or notice thereof to be given to such other person or persons as may be thought desirable.

(*c*) The petition shall, if and so long as the Court be a Judge of the Chancery Division, and subject to any direction of the Court to the contrary, be set down in the same manner as if it were a witness action assigned to such Judge.

(*d*) The petition shall be heard by the Court as a witness action, and shall come on in due course in the Witness List.

8. In all proceedings before the Court under the Act, the Court shall have all the powers by the Act vested in the Comptroller, and may make any order which might, or ought to, have been made by the Comptroller.

9. In all proceedings before the Court under the Act, the costs of and incident thereto, including the costs of hearings before the Comptroller or the Board of Trade, as the case may be, shall be in the discretion of the Court (except as hereinbefore expressly provided in the case of petitions under Section 18 of the Act).

10. If a defendant in an action for infringement of a patent intends to rely as a defence to such action on the insertion by the patentee in any contract or contracts of any condition which, by virtue of Section 38 of the Act, is null and void, he shall deliver with his defence full particulars of the dates of and parties to all contracts on which he intends to rely as containing any such condition, and of the particular conditions in any such contracts on which he intends to rely as being by virtue of that section null and void, and save as appears from such particulars, no defence shall be available to him in such action under Sub-section 4 of that section: Provided that particulars delivered under this Rule may be from time to time amended by leave of the Court.

11. Any person presenting a petition for the revocation of a patent, under Section 25 of the Act, must deliver with his petition

particulars of the objections to the validity of the patent on which he means to rely, and no evidence shall, except by leave of the Court, be admitted in proof of any objection of which particulars are not so delivered.

12. The respondent to a petition for the revocation of a patent, under Section 25 of the Act, shall be entitled to begin and give evidence in support of the patent, and if the petitioner gives evidence impeaching the validity of the patent, the respondent shall be entitled to reply.

13. In an action for infringement of a patent, the plaintiff must deliver with his statement of claim particulars of the breaches relied upon.

14. In an action for infringement of a patent the defendant, if he disputes the validity of the patent, must deliver with his defence particulars of the objections on which he relies in support of such invalidity.

15. A defendant in an action for infringement of a patent who, under Section 32 of the Act, counterclaims in the action for the revocation of the patent shall, with his counterclaim, deliver particulars of any objection to the validity of the patent on which he relies in support of his counterclaim.

16. Particulars of breaches shall specify which of the claims in the specification of the patent sued upon are alleged to be infringed, and shall give at least one instance of each type of infringement of which complaint is made.

17. Particulars of objections (whether delivered with the defence in an action for infringement of patent, or with a petition for revocation under Section 25 of the Act, or with a counter-claim for revocation under Section 32 of the Act), must state every ground upon which the validity of the patent is disputed and must give such particulars as will clearly define every issue which it is intended to raise.

18. If one of the objections taken in the particulars of objections be want of novelty, the particulars must state the time and place of the previous publication or user alleged, and if it be alleged that the invention has been used prior to the date of

the patent, must also specify the names of the person or persons who are alleged to have made such prior user, and whether such prior user is alleged to have continued down to the date of the patent, and if not, the earliest and latest dates on which such prior user is alleged to have taken place, and shall also contain a description (accompanied by drawings if necessary) sufficient to identify such alleged prior user, and if such user relates to any machinery or apparatus, shall specify whether the same is in existence and where the same can be inspected.

No evidence at variance with any statement contained in the particulars shall be given in support of any objection, and no evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent, and which is in existence at the date of the delivery of the particulars, shall be receivable, unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings.

19. Particulars of breaches and particulars of objection may from time to time be amended by leave of the Court upon such terms as may be just.

20. Further and better particulars of breaches or particulars of objections may at any time be ordered by the Court.

21. At the hearing of any action, petition, or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as the Court may seem just), be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.

22. On taxation of costs in any action, or counterclaim for infringement of patent, or in any petition for revocation of a patent under Section 25 of the Act, or in any counterclaim for revocation of a patent under Section 32 of the Act, the following provision shall apply: that is to say:—

If the action, petition, or counterclaim proceeds to trial on any patent, no costs shall be allowed in respect of any issues raised in the particulars of breaches or particulars of objections and relating to that patent, to the parties

delivering the same respectively, except in so far as such particulars are certified by the Court to have been proven, or to have been reasonable and proper without regard to the general costs of the case, but, subject as aforesaid, the costs of the issues raised by the particulars of breaches and the particulars of objections shall be in the discretion of the Taxing Master.

23. Where an application is made by a patentee for leave to amend his specification by way of disclaimer under Section 22 of the Act, the following Rules shall apply:—

(*a*) The application shall be made by motion in the proceedings pending before the Court, and notice of such motion, together with a King's Printers' copy of the specification, showing in red ink the amendment proposed to be made, shall be served on the parties to such proceedings, and in the first instance upon such parties only.

(*b*) On the hearing of such motion the Court shall decide whether, and on what terms as to costs or otherwise, the application shall be allowed to proceed, and if the application be allowed to proceed, shall give directions as to whether such application shall be heard on oral or affidavit evidence, and, if on affidavit evidence, shall fix the times within which affidavits shall be filed by the parties respectively, and by any other person entitled to be heard under the Act or these Rules.

(*c*) If the application be allowed to proceed, the applicant shall forthwith serve the Comptroller with a copy of the notice of motion, together with such copy of specification as aforesaid, and also a copy of the order allowing the application to proceed, and also with the name and address of the applicant's solicitor, and the proposed amendment shall be advertised in the *Illustrated Official Journal* (*Patents*), such advertisement stating that any person desiring to oppose the amendment must, within fourteen days of the issue of the advertisement, give notice in writing of such desire to the applicant's solicitor, whose name and address for that purpose shall be also stated in the advertisement. Any person giving such notice shall be entitled to be heard upon the hearing of the motion.

(*d*) Within seven days after the receipt of any such notice the applicant shall, if the person giving such notice shall have stated therein an address for service within the United Kingdom, serve on such a person a copy of the notice of motion, together with such copy of the specification as aforesaid, and also a copy of the order allowing the application to proceed. Such service may be made by prepaid registered letter sent to such person through the post at his address for service.

(*e*) In the case of an application directed to be heard on oral evidence the applicant shall, as soon as he shall have complied with the requirements of the preceding Rules, set the same down for hearing in the Witness List, and in the case of an application directed to be heard on affidavit evidence the applicant shall, after such compliance as aforesaid, and after the times fixed for filing evidence have expired, set the same down for hearing in the non-Witness List, and the application so set down shall be heard and disposed of in due course.

(*f*) Where the Court allows a specification to be amended, the applicant shall forthwith lodge with the Comptroller an office copy of the order allowing such amendment, and the Comptroller shall advertise the same once at least in the *Illustrated Official Journal* (*Patents*). He shall also, if required so to do by the Court or by the Comptroller, leave at the Patent Office a new specification and drawings as amended, the same being prepared as far as may be in accordance with the Rules of the Patent Office for the time being in force.

24. These Rules may be cited as the "Rules of the Supreme Court (Patents and Designs), 1908," and shall be read with the Rules of the Supreme Court, 1883.

The 3rd day of June, 1908.

APPENDIX E.

INTERNATIONAL CONVENTION.

THE International Convention for the Protection of Industrial Property is comprised in three documents. These are:—

1. The Original Convention, signed at Paris on the 20th March, 1883.

2. The Final Protocol, executed at the same time, by which various clauses of the Original Convention were explained, and to a certain extent modified.

3. The Additional Act, signed at Brussels on the 14th December, 1900, by which several modifications were introduced into the terms of the Original Convention.

In the following reprint the three documents have been incorporated, formal parts being omitted. The original text, where repealed by the Additional Act, has been left out and replaced by the new provisions. Where the later documents serve only to explain the first, they are printed below the text in smaller type.

Great Britain acceded to the International Convention on the 17th March, 1884. The States adhering to it at the present time are set out on pages 311, 312.

ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the protection of Industrial Property.

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.).

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.

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.

The Final Protocol annexed to the International Convention of the 20th March, 1883, shall be completed by the addition of No. 3 bis in the following terms:—

"3 bis. The patent, in each country, shall not be liable to forfeiture on account of failure to utilize it until after the expiration of at least three years from the date of the deposit of the application in the country concerned, and only provided the patentee cannot show reasonable cause for his inaction."

ARTICLE III.

1. Article III. of the Convention shall run as follows:—

Article III. The subjects or citizens of States which are not Parties to the Union shall be assimilated to the subjects or citizens of the Contracting States, provided that they are domiciled in or have industrial or commercial establishments, real and effective, in the territory of one of the States of the Union.

ARTICLE IV.

2. Article IV. shall run as follows:—

Article IV. Any person who shall have duly applied for a patent, industrial design, or model or trade-mark in one of the Contracting States, shall enjoy, in order to admit of such request being lodged in the other States, during the periods of time mentioned below, a right of priority, the rights of third parties being reserved.

Consequently, subsequent registration in one of the other States of the Union, before the expiration of such periods of time, shall not be invalidated by any acts accomplished in the interval—either, for instance, by another registration, by the publication of the invention, or by the working of it, by the sale of patterns of the design or model, or by the use of the trade-mark.

The above-mentioned periods of time during which priority is guaranteed shall be twelve months for patents with respect to inventions, and four months for patents for industrial designs or models, as well as for trade or merchandise marks.

3. There shall be inserted in the Convention an Article IV. bis, in the following terms:—

Article IV. bis. Patents applied for in the various Contracting States by persons admitted to the benefits of the Convention in the terms of Articles II. and III. shall be independent of the patents obtained for the same invention in the other States, whether such States be or be not parties to the Union.

This stipulation shall apply to patents already existing at the time when it shall come into effect.

The same stipulation shall apply, in the case of the accession of new States, with regard to patents in existence, either on one side or the other, at the time of accession.

ARTICLE V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ARTICLE VI.

Every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

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.

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.

4. The two following paragraphs shall be added to Article IX.:—

In States the laws of which do not admit of seizure upon importation, prohibition of importation may take the place of such seizure.

The authorities shall not be compelled to effect the seizure in the case of goods in transit.

ARTICLE X.

5. Article X. shall run as follows:—

Article X. The stipulations of the preceding Article shall be applicable to every production which may falsely bear as indication

of origin the name of a specified locality, when such indication shall be joined to a trading name of a fictitious character or used with intent to defraud.

Any producer, manufacturer, or trader engaged in the production, manufacture, or trade of such goods, and established either in the locality falsely designated as the place of origin, or in the district where the locality is situated, is to be deemed a party concerned.

6. There shall be inserted in the Convention an Article X. bis, in the terms following:—

Article X. bis. Persons resorting to the countries referred to in the Convention (Articles II. and III.) shall enjoy in all the States of the Union the protection accorded to nationals against dishonest competition.[1]

ARTICLE XI.

7. Article XI. shall run as follows:—

Article XI. The High Contracting Parties shall, in conformity with the legislation of each country, accord temporary protection to inventions susceptible of being patented, and to industrial designs or models, as well as to trade-marks or merchandize marks, in respect of products which shall be exhibited at official or officially recognised International Exhibitions held 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.

5. The organization of the special Department for Industrial Property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

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[1] *The passage in the text is the official translation as it appears in* Command Paper [Cd. 1084] of the Treaty Series, No. 15, 1902, but it is not authoritative, the French text being the authoritative text. This text reads as follows: "Article X. bis. Les ressortissants de la Convention (Articles II. et III.) jouiront, dans tous les États de l'Union, de la protection accordée aux nationaux contre la concurrence déloyale," and would, perhaps, be better translated thus—"Persons whose rights are founded in the Convention shall enjoy in all the States of the Union the protection accorded to nationals against unlawful competition."

ARTICLE XIII.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely:—

1st class	... ...	25 units.
2nd class	... ...	20 „
3rd class	... ...	15 „
4th class	... ...	10 „
5th class	... ...	5 „
6th class	... ...	3 „

These co-efficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense:—

1st class	...	France, Italy.
2nd class	...	Spain.
3rd class	...	Belgium, Brazil, Portugal, Switzerland.
4th class	...	Holland.
5th class	...	Servia.
6th class	...	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account, which will be communicated to all the other Administrations.

The International Office will centralise information of every kind relating to the protection of Industrial Property, and will bring it together in the form of a general statistical statement which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said Administrations or by societies or private persons will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of Industrial Property.

The Administration of the country in which the next conference is to be held will make preparations for the transactions of that conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual Report upon his administration of the Office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

ARTICLE XIV.

8. Article XIV. shall run as follows:—

Article XIV. The present Convention shall be submitted to periodical revisions with a view to the introduction of amendments calculated to improve the system of the Union.

For this purpose, Conferences shall be held successively, in one of the Contracting States, between the 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.

9. Article XVI. shall run as follows:—

Article XVI. States which are not parties to the present Convention shall be allowed to accede to it upon their request.

The accession shall be notified through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the other States.

It shall entail, as a matter of right, accession to all the clauses, as well as admission to all the advantages stipulated in the present Convention, and shall take effect one month after the dispatch of the notification by the Swiss Government to the other States of the Union, unless a subsequent date has been indicated by the acceding 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.

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.

The present Additional Act shall have the same value and duration as the Convention of the 20th March, 1883.

It shall be ratified, and the ratifications shall be deposited at the Ministry for Foreign Affairs, Brussels, as soon as possible, and at the last within a period of eighteen months from the date of signature.

It shall come into force three months after the Protocol of deposit shall have been closed.

In witness whereof the respective Plenipotentiaries have signed the Present Additional Act.

Done at Brussels, in a single copy, the 14th December, 1900.

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