HANDY GUIDE

TO

PATENT LAW AND PRACTICE

BY

GEORGE FREDERICK EMERY, LL.M.

OF THE INNER TEMPLE AND SOUTH-EASTERN CIRCUIT, ESQ., BARRISTER AT LAW,
FORMERLY ABBOTT SCHOLAR IN THE UNIVERSITY OF CAMBRIDGE AND
LATE SCHOLAR OF TRINITY COLLEGE,
OFFICIAL OF THE ARCHDEACONRY OF ELY
AUTHOR OF "A TREATISE ON COMPANY LAW UNDER THE ACTS 1862 TO 1900"

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PREFACE.

SINCE the first edition of this book was placed before the public, experience of the working of the then existing law relating to compulsory licences has stirred up the Legislature to make fresh provision for coping with the dog-in-the-manger policy adopted by many foreign patentees. It certainly seems strange that the British patent laws, intended solely to benefit the British community by encouraging the introduction of new manufactures, should have been wrested from their original purpose and used as a means for preventing the establishment of such manufactures in this country. But so it has been, and there does not appear to have been any case in which the question of a patentee's duty to work his patent, or to allow others to work it, in this country has been raised. The new statutory provisions deal with this matter, and it is to be hoped that its provisions may prove useful; but the author has in the body of the book suggested that there may be a simpler remedy at common law, capable of dealing with the case of a patent either obtained with the sole object of preventing manufacture in this country or obtained without any such express intention, but afterwards used with that object.

The author ventures to think that it could be fairly held that a person asking for the grant of a monopoly in a certain manufacture within this realm impliedly

declares his intention of carrying on such manufacture, and that if he has not any such intention, but merely desires to prevent any British subject from competing with a foreign manufacturer, that his application for the grant is a fraud on the Crown. The other case seems to come exactly within the express condition of the grant, providing that if at any time during its term it be made to appear to the Crown, or to any six or more of the Privy Council, that the grant is prejudicial or inconvenient to the subjects in general, all privileges and advantages whatever thereby granted shall determine and become void.

There have been during the last few years few important decisions relating to patents, but among these may be especially mentioned that of the House of Lords in *Moser* v. *Marsden*, determining that after the amendment of a specification the original cannot be referred to, even though the amendment ought not to have been allowed, thereby throwing on the Patent Office the full responsibility for any amendment.

The decision of a patent action generally depends entirely upon particular facts, and rarely involves any disputed question of law; and, as in the first edition, the author has been careful to resist the temptation to enlarge the book by introducing cases in which courts have decided questions of fact of the highest importance to the parties engaged, and, it may be, also interesting from a scientific standpoint, but entirely without bearing on the decision of any case in which a different patent is involved.

The author believes that he has included all the cases that have any bearing on the law of patents, and that the work, though not so bulky as some other dissertations on the same subject, will be found sufficient to

meet all the requirements both of the profession and of the public.

The circumstances under which patents are dealt with vary so much that anything approaching an exhaustive treatment of the subject of patent conveyancing would fill a large volume; but in the second Appendix will be found a few precedents relating to patents, which the author hopes will be found useful. The author believes that Form X which, with modifications, he has used to a considerable extent in practice, has not been previously published.

The book has been practically rewritten and brought up to date.

I have again to thank J. H. Taylor, Esquire, of Queen's College, Oxford, and Trinity College, Cambridge, for going through the proofs and verifying the Index, and the Comptroller for information on one or two matters of practice not dealt with by the Rules.

G. F. EMERY.

5 KING'S BENCH WALK, TEMPLE,
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CONTENTS.

	PAGE
Preface	iii
Table of Cases	ix
Table of Statutes	xxxi
Index of Rules	xxxv

CHAP.		
I.	Introductory	1
II.	Subject Matter of Letters Patent	14
III.	Who may Apply for a Patent	30
IV.	How to Obtain a Patent	39
V.	Specifications	58
VI.	Opposition to the Grant of a Patent	77
VII.	Keeping Up a Patent	87
VIII.	Rights and Obligations of Patentee	90
IX.	Licences	100
X.	Amendment of Specifications	109
XI.	Proceedings before Law Officers	118
XII.	Professional Assistance in Patent Matters	123
XIII.	Infringement	127
XIV.	Actions for Infringement	137
XV.	Revocation of Letters Patent	158
XVI.	Threats	166
XVII.	Particulars of Objections	177
XVIII.	Trial of a Patent Action	184
XIX.	Judgment in Infringement Action	196
XX.	Certificate of Validity	203
XXI.	Costs	207
XXII.	Extension of Term of Letters Patent	212
XXIII.	Offences	227
XXIV.	Register of Patents	229
XXV.	Compulsory Licences	234
XXVI.	International and Colonial Arrangements	246

CHAP.		PAGE
XXVII.	Miscellaneous	251
	Appendix A. Patent Office Forms	257
	Appendix B. Conveyancing Forms:—	
	I. Agreement for Joint Application	290
	II. Agreement for Joint Application (Short Form)	295
	III. Assignment of Letters Patent	296
	IV. Assignment of Letters Patent for a District	298
	V. Mortgage of Letters Patent	299
	VI. Licence at a Royalty	302
	VII. Exclusive Licence	304
	VIII. Agreement for the Use of a Machine at a Royalty with Right to Purchase	308
	IX. Agreement to Grant a Licence to a Company to be Formed	312
	X. Agreement to Promote a Company to Acquire an Invention	313
	Appendix C. Lists of Places receiving Donations of Patent Office Works	317
	Index	329

TABLE OF CASES.

(The figures in parentheses refer to the page numbers.)

A & B's Application	1902	S.G. 19 R.P.C. 556 (56, 86)
A & B's Application	1896	S.G. 13 R.P.C. 63 (54, 55)
A & B's Application	1902	S.G. 19 R.P.C. 403 (86)
Acetylene Illuminating Co. *v.* Midland Acetylene (Parent) Syndicate	1900	17 R.P.C. 534 (205)
Acetylene Illuminating Co. *v.* United Alkali Co.	1902	19 R.P.C. 213; C.A. 20 R.P.C. 161 (182, 204, 249)
Actien Gesellschaft für Cartonnagen Industrie *v.* Rennes	1895	12 R.P.C. 94 (151)
Actien Gesellschaft für Cartonnagen Industrie *v.* Temler	1900	18 R.P.C. 6 (90)
Adam's Patent	1899	16 R.P.C. 1 (213, 217)
Adie *v.* Clark	1877	2 App. Cas. 426; Clark *v.* Adie (No. 2) (149)
African Gold Recovery Co. *v.* Sheba Gold Mining Co.	1897	14 R.P.C. 660 (103, 105)
Re Ainsworth	1885	Gr. 269 (120)
Alcock *v.* Cooke	1820	5 Bing. 340 (70)
Allan's Patent	1867	L.R. 1 P.C. 507 (223)
Allen *v.* Rawson	1845	1 C. B. 566 (36)
Alliance Pure White Lead Syndicate *v.* MacIvor's Patents	1891	8 R.P.C. 321 (155, 182)
In re Allison's Patent	1898	S.G. 13 R.P.C. 208 (115)
Allison's Patent *in re*	1900	C.A. 17 R.P.C. 513 (112, 162)
Alton Woods' Case	1600	Coke 1 Rep. 40*b* (97)
Re Ambrose Hudd Smith	1896	A.G. 13 R.P.C. 200 (81)
American Braided Wire Co. *v.* Thompson & Co.	1888	C.A. 5 R.P.C. 120, 696; [1890] 7 R.P.C. 152 (35, 198, 199)
American Steel and Wire Co. *v.* Glover	1902	19 R.P.C. 102 (209)
Amos *v.* Chadwick	1877	4 Ch. D. 869 (156, 157)
Anderson *v.* Patent Oxonite Co.	1886	3 R.P.C. 279 (138)

Re Anderson & McKinnell	1887	Gr. A.P.C. 23 (118, 119)
Andrew & Co. *v.* Crossley Brothers	1891	C.A. [1892] 1 Ch 492; 9 R.P.C. 165 (117)
Anglo-American Brush Corporation *v.* Crompton	1887	C.A. 4 R.P.C. 27 (179)
Anonymous		Griff. 20 (40)
Anon.	1899	A.G. 1; R.P.C. 123 (73)
Anon.		1 Griff. 320 (161)
Apostoloff & Frendenberg's Application	1896	A.G. 13 R.P.C. 275 (53)
Appleby, etc. *v.* Albert Eadie Chain	1899	16 R.P.C. 318 (149, 175, 188, 191)
In re Armstrong's Patent	1897	C.A. 14 R.P.C. 747 (164)
Re Arnold	1887	Gr. A.P.C. 5 (116)
Arnold *v.* Bradbury	1871	6 Ch. 706 (186)
Ashworth *v.* English Card Clothing Co.	1902	C.A. 19 R.P.C. 463 (15, 17)
Ashworth *v.* Roberts	1890	7 R.P.C. 451 (155)
Atkins & Applegarth *v.* Castner-Kellner Alkali Co.	1901	18 R.P.C. 281; C.A. 19 R.P.C. 93 (70, 91)
Automatic Coal Gas Retort *v.* Mayor, etc., of Salford	1897	14 R.P.C. 150 (202)
Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co.	1889	6 R.P.C. 120 (205)
Automatic Weighing Machine Co. *v.* Knight	1889	C.A. 6 R.P.C. 304 (132)
Automatic Weighing Machine Co. *v.* International Hygienic Society	1889	6 R.P.C. 480 (205)
Avery's Patent	1887	4 R.P.C. 152; C.A. 322; 36 Ch. D. 307 (159, 160, 161)
Badham *v.* Bird	1888	5 R.P.C. 238 (193)
Badische Anilin und Soda Fabrik *v.* Levinstein	1885	24 Ch. D. 156; 2 R.P.C. 77; C.A. 143; 29 Ch. D. 366 (68, 190, 207)
Badische Anilin *v.* Levinstein	1887	H.L. 4 R.P.C. 449; 12 App. Cas. 710 (29, 70)
Badische Anilin *v.* Johnson	1897	H.L. 14 R.P.C. 405, 919 (135, 141)
Badische Anilin *v.* Thompson	1902	19 R.P.C. 502 (143)
Badische Anilin *v.* La Société Chimique	1897	14 R.P.C. 875 (204)
Badische Anilin *v.* La Société Chimique	1898	15 R.P.C. 359 (152)
Bagot Pneumatic Tyre Co. *v.* Clipper	1901	C.A. 19 R.P.C. 69 (106)
Bailey *v.* Roberton	1878	3 App. Cas. 1075 (63, 64)
Bainbridge *v.* Wigley	1810	Parl. Rep. 197; 1 Goodeve P.C. 30 (59)

Re Bairstow	1888	5 R.P.C. 289 (78, 119)
Bakewell's Patent	1852	15 Moo. P.C.C. 385 (223)
Barber *v.* Nathan & Somers	1902	19 R.P.C. 331 (174)
Barcroft *v.* Smith	1897	C.A. 14 R.P.C. 172 (191)
Barff's & Bowen's Patent	1895	[1895] A.C. 675; 12 R.P.C. 383 (221)
Barlow *v.* Baylis	1870	Griff. 45 (24)
Barrett *v.* Day	1890	7 R.P.C. 54 (171)
Bartlett's Petition, Gormully Petition	1899	16 R.P.C. 641 (239)
Bassett *v.* Graydon	1897	14 R.P.C. 701 (101)
Beanland's Patent	1887	4 R.P.C. 489 (223)
Beard *v.* Egerton	1849	19 L.J. 39; 3 C.B. 97, 123; 8 C.B. 206 (34, 60, 69, 70)
Beavis *v.* Rylands Glass & Engineering Co.	1899	17 R.P.C. 93 (14, 16)
Re Beck and Justice	1886	Gr. A.P.C. 10 (110)
Bennett *v.* Lord Bury	1880	5 C.P.D. 339 (157)
Benno Jaffé Fabrik *v.* Richardson	1893	10 R.P.C. 136 (155)
Benno Jaffé Fabrik *v.* Richardson	1894	11 R.P.C. 102 (183)
Bergmann *v.* Macmillan	1881	17 Ch. D. 423; 29 W.R. 890 (93, 103)
Berliner *v.* Edison-Bell Consol. Phonograph Co.	1899	16 R.P.C. 336 (174)
Bethell *v.* Gage	1897	14 R.P.C. 699 (209)
Betts' Patent		1 Moo. P.C.C. (N.S.) 49 (220)
Betts *v.* De Vitre	1864	3 Ch. 149; 11 Jur. N.S. 9 (136-140)
Betts *v.* Menzies	1865	10 H.L.C. (26)
Betts *v.* Wilmot	1871	6 Ch. 239 (135)
Bevan *v.* Welsbach Incandescent Gas Light Co.	1903	20 R.P.C. 69 (176)
Birmingham Pneumatic Tyre Syndicate *v.* Reliance Tyre Co.	1900	17 R.P.C. 277 (181)
Bishop *v.* Inman & others	1900	17 R.P.C. 749 (172)
Blakey & Co. *v.* Latham & Co.	1889	C.A. 6 R.P.C. 190 (170, 207)
Bloxam *v.* Elsee	1827	6 B. & C. 178; 3 L.J. (O.S.) Q.B. 93 (59)
Bodmer's Patent	1849	6 Moo. P.C.C. 468 (225)
Bodmer's Patent	1853	8 Moo. P.C.C. 282 (213)
In re Borrowman's Patent	1902	19 R.P.C. 159 (162)
Boulton *v.* Bull	1795	Dav. P.C. 196; 2 H.Bl. 463 (15)
Bovill *v.* Ainscough	1867	Lawson, *Pat. Pract.*, 2nd Edit., 495 (158)
Bovill *v.* Moore	1815	Dav. P.C. 361; Carpmael Rep. 348 (60)

Boxwell *v.* Cochran	1895	12 R.P.C. 169 (182)
Boyd *v.* Horrocks	1889	C.A. 6 R.P.C. 159 (130)
Boyd *v.* Tootal Broadhurst Lee Co.	1894	11 R.P.C. 175 (Lanc. Court Case) (199, 205)
Boyle & Co. *v.* Kane & Pattison	1901	18 R P.C. 325 (117)
Re Brand	1895	S.G. 12 R.P.C. 102 (81, 114)
Brandon's Patent	1884	1 R.P.C. 154
Bray *v.* Gardner	1887	C.A. 4 R.P.C. 40 (111)
Bridge's Application	1901	S.G. 18 R.P.C. 257 (18, 84)
British Dynamite *v.* Krebs	1879	H.L. 13 R.P.C. 190 (74)
British Insulated Wire Co. *v.* Dublin United Tramways Co.	1900	C.D. (Ir.) 17 R.P.C. 14 (196, 200, 202)
British Motor Syndicate *v.* Andrews	1899	16 R.P.C. 594 (191, 204)
British Motor Syndicate *v.* John Taylor & Sons, Ltd.	1900	17 R.P.C. 189; C.A. 723 (135)
British Motor Syndicate *v.* Universal Motor Carriage, etc.	1899	16 R.P.C. 113 (204)
British Mutoscope *v.* Homer	1901	18 R.P.C. 177 (134)
British Tanning Co. *v.* Groth	1891	8 R.P.C. 171 (249)
Briton, etc. Life Assurance *v.* Jones	1889	60 L.T. 637 (157)
Brook *v.* Aston	1857	8 E. & B. 485 (17)
Brooks *v.* Hall	1903	21 R.P.C. 29 (211)
Brooks *v.* Lamplugh	1898	C.A. 15 R.P.C. 33 (142, 210)
Brooks *v.* Lycett	1902	C.A. 19 R.P.C. 364 (209)
Brooks *v.* Lycett	1904	[1904] 1 Ch. 512 (111, 117)
Brooks *v.* Steel	1897	C.A. 14 R.P.C. 46 (133, 186)
Brown *v.* Jackson	1895	P.C. [1895] A.C. 446; 12 R.P.C. 311 (72, 130)
Brunton *v.* Hawkes	1821	4 B. & A. 550 (70, 74)
Burlingham, Innes & Lee's Patent	1898	15 R.P.C. 195 (223)
Campion *v.* Benyon	1821	3 B. & B. 10 (71)
Cannington *v.* Nuttall	1871	L.R. 5 H.L. 216 (19, 133)
Carpenter *v.* Smith	1841	1 W.P.C. 534 (22)
Carr's Patent	1873	L.R. 4 P.C. 539 (222)
Case *v.* Cressy	1901	C.A. 18 R.P.C. 419 (18)
Castner-Kellner Alkali Co. *v.* Commercial Development Co.	1899	C.A. 16 R.P.C. 251 (195, 209, 210)
In re Cercel's Patent	1898	15 R.P.C. 500 (162)
Chadburn *v.* Michan	1895	12 R.P.C. 120 (152)
Challender *v.* Royle	1887	C.A. 4 R.P.C. 363; 36 Ch. D. 425 (169, 170, 173)
Chamberlain & Hookham *v.* Mayor of Bradford	1901	19 R.P.C. 78 (211)
Chamberlain & Hookham *v.* Mayor of Huddersfield	1901	18 R.P.C. 454 (209)

Chambers *v.* Crichley	1864	33 Beav. 374 (149)
Re Chandler	1886	Gr. 270 (118)
Chanter *v.* Dewhurst & anr.	1844	12 M. & W. 823 (100)
Chanter *v.* Johnson	1845	14 M. & W. 411 (101)
Chanter *v.* Leese	1839	5 M. & W. 701 (107)
Chartered Institute of Patent Agents *v.* Lockwood	1894	H.L. 11 R.P.C. 374 (228)
Chatwood's Patent Safe *v.* Mercantile Bank of Lancashire	1900	17 R.P.C. 23 (111, 164)
Chatwood's Patent Safe *v.* Ratner Safe Co.	1899	16 R.P.C. 449 (111)
In re Chatwood's Patent	1899	16 R.P.C. 370 (113, 163)
Cheavin *v.* Walker	1876	5 Ch. D. 850 (227)
Cheetham *v.* Nuthall	1893	10 R.P.C. 321 (103, 105, 150)
Cheetham *v.* Oldham	1888	5 R.P.C. 617 (153, 154)
Cheetham *v.* Oldham	1891	8 R.P.C. 168 (12)
Chollet *v.* Hoffman	1857	7 E. & B. 686 (138)
Church's Patents	1886	3 R.P.C. 95 (225)
Claridge's Patent	1851	7 Moo. P.C.C. 394 (33, 225)
Clark *v.* Adie	1875	L.R. 10 Ch. 675 (130)
Clark *v.* Adie	1877	2 App. Cas. 315 (18, 19)
Clark *v.* Adie (No. 2)	1877	2 App. Cas. 426 (149)
Clark *v.* Nichols	1895	12 R.P.C. 310 (143)
Clark's Patent	1870	L.R. 3 P.C. 421 (218)
Clark's Patent	1899	16 R.P.C. 433 (221)
Claughton *v.* Foster	1903	21 R.P.C. 17 (204)
Cochrane *v.* Smethurst	1816	1 Stark. 205 (59)
Cockling's Patent	1885	2 R.P.C. 151 (224)
Re Codd	1884	Griff. 305 (78)
Cole *v.* Saqui	1889	C.A. 6 R.P.C., 41; 40 Ch. D. 132 (210)
Colley *v.* Hart	1890	7 R.P.C. 111 (172)
Colley *v.* Hart	1890	7 R.P.C. 101 (170, 171, 189)
Combined Weighing Machine Co. *v.* Automatic Weighing Machine Co.	1889	6 R.P.C. 502 (171)
Commercial Development Co. *v.* Atkins & Applegarth	1902	C.A. 19 R.P.C. 93 (91)
La Compagnie Generale d'Eaux, etc.	1891	[1891] 3 Ch. 451; 8 R.P.C. 446 (162)
Consolidated Car Heating Co. *v.* Caine	1903	P.C. 20 R.P.C. 745 (130)
Cook *v.* Pearce	1843	8 Q.B. 1063 (59)
Cooper's Application	1901	19 R.P.C. 53 (40)
Coppin *v.* Lloyd	1898	15 R.P.C. 373 (100, 104)
Cornish & Sieven *v.* Keene	1835	1 W.P.C. 508 (23, 37)

Crampton *v.* Patents Investment Co.	1888	5 R.P.C. 404 (175, 203)
Crane *v.* Price	1842	1 W.P.C. 409 (20)
Crompton *v.* Anglo-American Brush Corporation	1887	C.A. 4 R.P.C. 197; 35 Ch. D. 283 (179)
Crompton *v.* Ibbotson	1828	Dan. & Ll. 33; 1 W.P.C. 83; C.P.C. 460 (69)
Cropper *v.* Smith	1884	28 Ch. D. 151 (111, 164)
Cropper *v.* Smith	1885	H.L. 2 R.P.C. 17 (152)
Crossley *v.* Beverley	1829	1 R. & M. 166 *n.*; 1 W.P.C. 106 (133, 196)
Crossley *v.* Dixon	1863	10 H.L.C. 293 (105, 148, 150)
Crossley *v.* The Derby Gas Co.	1834	1 Webs. R. 119 (202)
Crosthwaite *v.* Moorwood	1894	11 R.P.C. 558 (152)
Crosthwaite *v.* Steel	1889	6 R.P.C. 190 (149)
Currie & Timmis' Patent	1898	15 R.P.C. 63 (223)
Curtis *v.* Platt	1863	3 Ch. D. 135 *n* (72)
Cutlan *v.* Dawson	1897	C.A. 14 R.P.C. 249 (105)
Cutler *v.* Bower	1847	11 Q.B. 973; 17 L J.Q.B. 217 (91)
Dangerfield *v.* Jones	1865	13 L.T. N.S. 142 (17)
Darby's Patent	1891	8 R.P.C. 380 (221, 224)
Re Dart		Gr. P.C. 307 (48)
Day *v.* Foster	1890	7 R.P.C. 54 (171)
Deacon's Patents	1887	4 R.P.C. 119 (220)
Deeley *v.* Perkes	1896	H.L. [1896] A.C. 496; 13 R.P.C. 581 (111, 112, 164)
Deeley's Patent	1894	11 R.P.C. 72 (163, 165)
Deeley's Patent	1895	C.A. 12 R.P.C. 199 (161)
Delta Metal *v.* Maxim-Nordenfelt Co.	1891	8 R.P.C. 247; 8 R.P.C. 169 (154, 204)
In re Delwick's Patent	1896	[1896] 2 Ch. 705 (113, 163)
Derosne's Patent	1844	2 W.P.C. 1 (223)
Re Dietz	1889	6 R.P.C. 297 (120)
Dollond's Case	1758	2 H. Bl. 470; 1 W.P.C. 42 (38)
Dover *v.* New Townend Cycle	1903	21 R.P.C. 135 (195)
Dowson Taylor & Co. Ltd. *v.* The Drosophore Co. Ltd.	1894	11 R.P.C. 536 (Lanc. Court Case) (173)
Dowson Taylor & Co. Ltd. *v.* The Drosophore Co. Ltd.	1895	C.A. 12 R.P.C. 95 (174)
Drake *v.* Muntz's Metal Co.	1886	3 R.P.C. 43 (147, 153)
Drummond's Patent	1889	43 Ch. D. 80; 6 R.P.C. 576; 59 L.J. Ch. 576 (162)
Duckett *v.* Sankey & Son	1899	16 R.P.C. 357 (208)
Dudgeon *v.* Thompson	1877	3 App. Cas. 44 (132)
Duncan & Wilson's Patents	1884	1 R.P.C. 257 (221)
Duncan Stewart's Patent	1885	3 R.P.C. 7 (222)

Dunlop Pneumatic Tyre Co. *v.* Actien Gesellschaft für Motor, etc.	1902	C.A. [1902] 1 K.B. 342 (140)
Dunlop Pneumatic Tyre Co. *v.* British & Colonial Motor Car Co.	1901	18 R.P.C. 313 (135)
Dunlop Pneumatic Tyre Co. *v.* Cresswell	1901	18 R.P.C. 473 (101)
Dunlop Pneumatic Tyre Co. *v.* Excelsior Tyre Co.	1901	18 R.P.C. 209 (133)
Dunlop Pneumatic Tyre Co. *v.* Green	1900	17 R P.C. 234 (200)
Dunlop Pneumatic Tyre Co. *v.* Moseley	1904	C.A. 1 Ch. 612; 73 L.J. Ch. 227 (133, 136)
Dunlop Pneumatic Tyre Co. *v.* Neal	1899	16 R.P.C. 247 (133)
Dunlop Pneumatic Tyre Co. *v.* Nev Ixion Tyre Co.	1899	C.A. 16 R.P.C. 16 (196)
Dunlop Pneumatic Tyre Co. *v.* North British Rubber Co.	1904	C.A. 21 R.P.C. 161 (108)
Dunlop Pneumatic Tyre Co. *v.* Rimington Bros. & Co.	1900	C.A. 17 R.P.C. 665 (141)
Dunlop Pneumatic Tyre Co. *v.* Wapshare Tube Co.	1900	17 R P.C. 433 (205)
Re Eadie	1885	Griff. 279 (79)
Edge *v.* Harrison	1891	8 R.P.C. 74 (163)
Edgeberry *v.* Stephens	1691	2 Salk. 447; 1 W.P.C. 35 (4, 33)
Edison-Bell Consolidated Phonograph Co. *v.* Columbia Phonograph Co.	1900	18 R.P C. 4 (181)
Edison-Bell Consolidated Phonograph Co. *v.* Waterfield, Clifford & Co.	1902	19 R.P.C. 329 (205)
Edison-Bell Phonograph Co. *v.* Edison Phonograph	1894	11 R.P.C. 33 (205)
Edison-Bell Phonograph Co. *v.* Smith & Young	1894	C.A. 11 R.P.C. 389 (178, 186, 188, 202)
Edison United Phonograph Co. and Edison-Bell Phonograph Co. *v.* T. Lewis Young	1894	11 R.P.C. 489 (157)
Edison & Swan Electric Light Co. *v.* Holland	1889	3 R.P.C. 395; C.A. 6 R.P.C. 243 (69, 141, 186, 189, 204)
Edison & Swan United Electric Light Co. *v.* Woodhouse & Rawson	1887	C.A. 4 R.P.C. 93 (20, 24, 186)
Edlin *v.* Pneumatic Tyre, etc.	1893	10 R.P.C. 311 (172)

Re Edmunds	1888	Griff. 281 (78)
Ehrlich *v.* Ihlee	1887	4 R.P.C. 115; 5 R.P.C. 457 (26, 152)
Electric Construction Co. *v.* Imperial Tramways Co.	1900	C.A. 17 R.P.C. 536 (75)
Electrolytic Plating Apparatus Co. *v.* Holland	1901	18 R.P.C. 521 (183)
Ellams *v.* Martyn & Co.	1899	C.A. 16 R.P.C. 28 (175)
Elmslie *v.* Boursier	1869	L.R. 9 Eq. 217 (33)
English & American *v.* Gare Machine	1894	11 R.P.C. 627 (172)
English & American Machinery Co. *v.* Union Boot & Shoe Machine Co.	1896	13 R.P.C. 64 (199, 200)
English & American Machinery Co. *v.* Union Boot & Shoe Machine Co.	1894	C.A. 11 R.P.C. 367 (183, 200)
Fabriques de Produits, etc. *v.* Lafitte & Co.	1899	16 R.P.C. 68 (204)
Fairburn *v.* Household	1884	1 R.P.C. 109 (174)
Fairburn *v.* Household	1885	C.A. 2 R.P.C. 195 (184)
Fawcett *v.* Homan	1896	C.A. 13 R.P.C. 398 (203)
Fenner *v.* Wilson	1893	C.A. 10 R.P.C. 283 (172)
Ferranti's Petition	1901	P.C. 18 R.P.C. 518 (218)
Finch's Patent	1898	15 R.P.C. 674 (212, 213, 221, 225)
Fletcher's Patent	1893	10 R.P.C. 252 (229)
Foxwell *v.* Bostock	1861	4 De G. J. & S. 313 (72)
Franklin Hocking & Co., Ltd. *v.* Franklin Hocking	1887	C.A. 4 R.P.C. 442 (132)
Frearson *v.* Loe	1878	9 Ch. D. 58, 65 (24, 94, 127, 139)
Fusee Vesta Co. *v.* Bryant & May	1887	34 Ch.D. 458; 4 R.P.C. 71 (112)
Gadd & Mason *v.* Mayor of Manchester	1892	9 R.P.C. 516; C.A. 67 L.T. 569 (22, 24, 26, 210)
Galloway's Patent	1843	1 W.P.C. 725 (213, 220)
Garrard *v.* Edge	1889	C.A. 6 R.P.C. 372 (182)
Garnett's Application	1899	S.G. 16 R.P.C. 154 (54)
In re Gaulard & Gibbs' Patent	1887	57 L.J. Ch. 209 (113, 163)
Gaulard & Gibbs' Patent	1888	5 R.P.C. 526; C.A. 6 R.P.C. 215 (161)
Gaulard *v.* Lindsay	1888	38 Ch. D. 38 (112)
Gavioli *v* Shepherd	1899	17 R.P.C. 157 (200)
Geipel's Patent	1904	C.A. [1904], 1 Ch. 239 (165)
Germ. Milling Co. *v.* Robinson	1885	3 R.P.C. 11 (153, 154)
Gibson & Campbell *v.* Brand	1841	1 W.P.C. 628 (35)
Gibson *v.* Brand	1841	Scott N.R. 844, 890; 4 M. & G. 179; 1 W.P.C. 631 (71)
Gillett *v.* Wilby	1839	1 W.P.C. 270 (74)
Re Glossop	1884	Griff. 285 (79, 80)

Görz & Högh's Patent	1895	W.N. 105 (162)
Goucher's Patent	1865	2 Moo. P.C.C. (N.S.) 532 (213)
Goucher *v.* Clayton	1864	11 Jur. N.S. 107 (150)
Graham *v.* Eli	1898	Div. Ct. 15 R.P.C. 259 (228)
Graham *v.* Fanta	1892	Div. Ct. 9 R.P.C. 164 (124, 228)
Re Grenfell & McEvoy's Patent	1890	7 R.P.C. 151 (53)
Guilbert-Martin *v.* Kerr	1887	4 R.P.C. 18 (207)
Guyot *v.* Thomson	1894	11 R.P.C. 541 (104, 107, 139)
Haddan's Patent	1885	Griff. 108; 54 L.J. Ch. 126 (163)
Hall *v.* Condor	1857	2 C.B. N.S. 22 (91)
Hall's Patent	1888	5 R.P.C. 283 (119)
Re Hall	1888	21 Q.B.D. 137 (110)
Hancock *v.* Somervell	1851	39 *Newton's Lond. Journ.*, 158 (23)
Hardy's Patent	1849	6 Moo. P.C.C. 441 (225)
Harrild & Parkin's Application	1900	S.G. 17 R.P.C. 617 (84)
Harris *v.* Rothwell	1887	C.A. 4 R.P.C. 225 (26)
Harrison *v.* The Anderston Foundry Co.	1876	1 App. Cas. 577 (18, 72, 73)
Harwood *v.* Great Northern Railway Co.	1865	11 H.L.C. 682 (17)
Haslam *v.* Hall	1887	4 R.P.C. 203 (146)
Haslam *v.* Hall	1888	5 R.P.C. 27 C.A. 144 (204)
Haslam Foundry & Engineering Co. *v.* Goodfellow	1887	37 Ch. D. 118; 5 R.P.C. 28 (112, 153)
Hassall *v.* Wright & others	1870	L.R. 10 Eq. 509 (138)
Hastings *v.* Brown	1853	1 E. & B. 454 (69)
Hattersley *v.* Hodgson	1903	20 R.P.C. 591 (66)
Haworth *v.* Hardcastle	1834	1 Webs. R. 484; 1 Bing. N.C. 182 (75, 188)
Haycock *v.* Bradbury	1887	4 R.P.C. 74 (205)
Hazeland's Patent	1894	11 R.P.C. 467 (222)
Heald's Application	1891	8 R.P.C. 429 (36)
Heap *v.* Hartley	1889	C.A. 6 R.P.C. 495; 42 Ch. D. 461 (107, 139)
Heath's Patent	1853	2 W.P.C. 247 (222)
Re Heath & Frost	1886	Griff. 311 (80)
Heath *v.* Unwin	1855	H.L. 2 W.P.C. 314 (130)
Heathfield *v.* Greenway	1894	11 R.P.C. 17 (179)
Henderson *v.* Eason	1852	17 Q.B. 701; 21 L.J.Q.B. 82 (102, 103)
Henderson's Patent	1901	P.C. 18 R.P.C. 449 (219)
Henser *v.* Hardie	1894	11 R.P.C. 421 (147)
Herbert's Patent	1867	L.R. 1 P C. 399 (225)
Herrburger *v.* Squire	1888	5 R.P.C. 581 (171)
Hesse *v.* Stevenson	1803	3 Bos. & P. 565 (230)
Heugh *v.* Chamberlain	1877	25 W.R. 742 (150)
Hexter *v.* Pearce	1900	[1900] 1 Ch. 341 (103)

Higgs *v.* Godwin	1858	E.B. & E. 529; 27 L.J.Q.B. 421 (29)
Hill *v.* Thomson & Forman	1817	1 W.P.C. 237 (18, 70)
Re Hill	1888	5 R.P.C. 599 (80, 119)
Hill's Patent	1863	1 Moo. P.C.C. (N.S.) 258 (222)
Hills *v.* Evans	1861	31 L.J. Ch. 460; 4 De G. F. & J. 288 (25, 185)
Hills *v.* Laming	1853	9 Ex. R. 256 (105, 150)
Hills *v.* London Gas Light Co.	1860	5 H. & N. 336 (23)
Hinks & Son *v.* The Safety Lighting Co.	1876	4 Ch. D. 607 (20)
In re Hirschfeld's Patent	1894	11 R.P C. 515 (162)
Hocking *v.* Hocking	1887	C.A. 4 R.P.C. 442 (132)
Hoe & Co. *v.* Foster & Sons	1899	C.A. 16 R.P.C. 33 (22)
Holliday *v.* Heppenstall	1889	C.A. 6 R.P.C. 320 (181, 183)
Holmes *v.* L. & N. W. R. Co.	1852	12 C.B. 831 (72)
Hopkinson's Patent	1896	13 R.P.C. 114 (218)
Horsey's Patent	1884	1 R.P.C. 225 (218)
Horton *v.* Mabon	1862	16 C.B. N.S. 141; 31 L.J.C.P. 255 (17)
Houghton's Patent	1871	L.R. 3 P.C. 461 (213, 222)
Household Co. *v.* Neilson	1843	H.L. 1 W.P.C. 673 (15)
Household *v.* Fairburn	1884	1 R.P.C. 109 (174)
Howes *v.* Webber	1894	11 R.P.C. 586; [1895] 12 R.P.C. 470 (144, 202)
Hubbuck *v.* Brown	1900	17 R.P.C. 638 (227)
Hughes' Patent	1898	15 R.P.C. 372 (220)
Hutton & Bleakley's Petition	1898	15 R.P.C. 749 (238, 239)
Incandescent Gas Light Co. *v.* Brogden	1899	16 R.P.C. 179 (92, 101, 134, 136)
Incandescent Gas Light Co. *v.* Cantelo	1895	12 R.P.C. 262 (92, 101, 134)
Incandescent Gas Light Co. *v.* Daylight Co.	1899	16 R.P.C. (136)
Incandescent Gas Light Co. *v.* De Mare	1896	C.A. 13 R.P.C. 301 (127, 136, 139, 195, 204, 210)
Incandescent Gas Light Co. *v.* Riemer	1900	C.A. 17 R.P.C. 378 (197)
Incandescent Gas Light Co. *v.* Sluce	1900	C.A. 17 R.P.C. 173 (197)
Incandescent Gas Light Co. *v.* Sunlight Incandescent	1896	13 R.P.C. 333 (195)
Inland Revenue Commissioners *v.* Müller	1901	H.L. [1901] A.C. 217 (106)
Innes *v.* Short	1898	15 R.P.C. 449 (136)
Jandus Arc Lamp *v.* Arc Lamp	1903	21 R.P.C. 115 (112)
Jandus Arc Lamp *v.* Johnson	1900	17 R.P.C. 361 (105, 149, 188, 189)
Jardine *v.* King, Mendham & Co.	1896	13 R.P.C. 411 (205)

Jenkins *v.* Hope	1896	13 R.P.C. 57 (144)
Job *v.* Potton	1875	L.R. 20 Eq. 84; 44 L.J. Ch. 262 (103)
Johnasson *v.* Palgrave	1880	Lawson, *Pat. Pract.*, 2nd Edit. 495 (156)
Re Johnson	1896	13 R.P.C. 659 (110)
Johnson *v.* Edge	1892	C.A. 9 R.P.C. 142 (169)
Johnson's Application	1901	19 R.P.C. 56 (40)
Johnson's Patent	1871	L.R. 4 P.C. 75 (221)
J. & G.'s Application	1902	S.G. 19 R.P.C. 555 (81)
Re Jones		Griff. 313 (113)
Jones' Patent	1840	1 W.P.C. 579 (212)
Joy's Patent	1893	10 R.P.C. 89 (222)
Jupe *v.* Pratt	1837	1 W.P.C. 146 (132)
Kane *v.* Guest	1899	16 R.P.C. 433 (208)
Kane & Pattison *v.* Boyle & Co.	1901	18 R.P.C. 325 (117)
In re Kay's Patent	1894	11 R.P.C. 279 (162)
Kelly *v.* Batchelar	1893	10 R.P.C. 289 (136)
Kelly *v.* Heathman	1890	7 R.P.C. 343 (152)
Kenny's Buttonholing Co. *v.* Somerville		26 W.R. 787; 38 L.T. 878 (93)
Kensington Electric &c. *v.* Lane Fox Electrical	1891	8 R.P.C. 277 (170)
Kerr & Haegger *v.* Crompton	1901	Pat. Ct. Lan. 19 R.P.C. 9 (209)
King, Brown & Co. *v.* Anglo-American Brush Co.	1889	6 R.P.C. 424 (21, 23)
Re Knight	1887	Gr. A.P.C. 35 (120)
Kurtz *v.* Spence	1887	C.A. 4 R.P.C. 427 (174)
Kynoch & Co. Ltd. *v.* Webb	1900	H.L. 17 R.P.C. 100 (19, 66, 72, 73, 75)
Re Lake	1887	Gr. A.P.C. 16 (49, 110, 116)
Re Lake	1889	6 R.P.C. 550 (85)
Lake's Patent	1891	8 R.P.C. 227 (221)
Re Lancaster	1884	Griff. 293 (79)
Lane Fox's Patent	1892	9 R.P.C. 411 (222)
Lang *v.* Whitecross Co.	1889	62 L.T. 119; 89 L.T.J. 351; 6 R.P.C. 570 (112)
Law *v.* Ashworth	1890	7 R.P.C. 86 (Lanc. Court Case) (173)
Lawson *v.* Donald Macpherson & Co.	1897	14 R.P.C. 696 (106)
Leake *v.* Cordeaux	1856	4 W.R. 806 (102)
Leather Cloth Co. *v.* American Cloth Co.	1865	11 H.L.C. 523 (227)
Leeds Forge Co. *v.* Deighton's Patent Flue Co.	1903	20 R.P.C. 185 (211)
Lee's Patent	1856	10 Moo. P.C.C. 226 (213)
Leonhardt *v.* Kallé	1895	12 R.P.C. 103 (70)
Levinstein's Petition	1898	15 R.P.C. 742 (238, 239)

Lewis *v.* Marling	1829	4 C. & P. 52; 1 W.P.C. 490; 10 B. & C. 22; 5 R. & M. 66 (70)
Lindon's Patent	1897	14 R.P.C. 643 (218)
Lines *v.* Usher	1897	C.A. 14 R.P.C. 206 (104)
Lister *v.* Norton	1885	2 R.P.C. 68 (155)
Livet's Patent	1892	9 R.P.C. 332 (222)
Lovell *v.* Hicks	1837	5 L.J. (N.S.) Ex. Eq. 101 (104)
Lowe's Patent	1852	8 Moo. P.C.C. 1 (218)
Lucas *v.* Miller	1900	17 R.P.C. 165 (21, 128)
Ludington Cigarette Machine Co. *v.* Baron Cigarette Machine Co.	1899	17 R.P.C. 25; C.A. 214; H.L. 745 (112)
Re Luke	1886	Griff. 294 (75)
Lyon's Patent	1894	11 R.P.C. 537 (224, 225)
Lyon *v.* Goddard	1893	C.A. 10 R.P.C. 344 (20, 21)
Lyon *v.* Mayor &c. of Newcastle-upon-Tyne	1894	11 R.P.C. 218 (145)
Re Macevoy	1888	5 R.P.C. 285 (80)
Re Main's Patent	1890	7 R.P.C. 13 (247, 249)
Mallet's Patent	1866	L.R. 1 P.C. 308 (225)
Mandleberg *v.* Morley	1895	12 R.P.C. 35 (209)
In re Manning's Patent	1903	20 R.P.C. 74 (233)
Marsden *v.* Saville Street Foundry & Engineering Co.	1878	L.R. 3 Ex. D. 203 (32, 34, 35)
In re Marshall & Naylor's Patent	1900	17 R.P.C. 553 (37)
Mathers *v.* Green	1865	L.R. 1 Ch. 29; 35 L.J. Ch. 1; 34 Beav. 170 (93, 103)
Matthews *v.* Parmenter	1896	13 R.P.C. 514 (22)
Maxim-Nordenfelt Co. *v.* Anderson	1897	14 R.P.C. 371 (95)
McDougall Bros. *v.* Partington	1890	7 R.P.C. 357 (153)
Re Meyer	1899	A.G. 16 R.P.C. 526 (80)
Mica Insulator Co. *v.* Electrical Co.	1898	15 R.P.C. 489 (75, 181)
Middleton *v.* Bradley	1895	12 R.P.C. 390, W.N. 123[7] (208)
Miller's Patent	1894	11 R.P.C. 55 (162)
Milligan *v.* Marsh	1856	2 Jur. N.S. 1083 (34)
Mill's Application	1901	S.G. 18 R.P.C. 322 (84)
Mills *v.* Carson	1892	9 R.P.C. 338; C.A. 10 R.P.C. 9 (104)
Monforts *v.* Marsden	1895	C.A. 12 R.P.C. 266 (91, 104)
Montgomerie *v.* Paterson	1894	Ct. Sess. 11 R.P.C. 221 (135)
Montgomery *v.* Wallace Jones	1903	H.L. 90 L.T. 1 (194)
Moore *v.* Thomson	1890	H.L. 7 R.P.C. 325 (149)
Morgan Brown's Patent	1886	3 R.P.C. 212 (226)
Morgan *v.* Seaward	1836	1 W.P.C. 174; 2 M. & W. 561 (23, 29, 68, 70, 180)

Morris *v.* Young	1895	H.L. 12 R.P.C. 455 (149, 188, 204)
Moseley *v.* Victoria Rubber Co.	1887	3 R.P.C. 351; 4 R.P.C. 252 (25, 154)
Moser *v.* Marsden	1892	C.A. 9 R.P.C. 214 (141)
Moser *v.* Marsden	1893	C.A. 10 R.P.C. 350 (34)
Moser *v.* Marsden	1896	H.L. 13 R.P.C. 24 (117)
Muirhead *v.* Commercial Cable Co.	1895	C.A. 12 R.P.C. 39 (105, 148)
Muntz's Patents	1846	2 W.P.C. 121 (221)
Murray *v.* Clayton	1872	L.R. 15 Eq. 115 (201)
Myers *v.* Baker	1858	3 H. & N. 802 (227)
Nadel *v.* Martin	1903	C.A. 20 R.P.C. 721 (195)
Re Nahnsen	1900	A.G. 17 R.P.C. 203 (80, 84, 85)
Napier's Patent	1861	13 Moo. P.C.C. 543 (223)
Napier's Patent	1881	L.R. 6 App. Cas. 174 (213)
National Company for the Distribution of Electricity *v.* Gibbs	[1899]	2 Ch. 289; 16 R.P.C. 339; 17 R.P.C. 303 (31, 102)
Neilson *v.* Harford	1841	1 W.P.C. 355 (75)
Newall *v.* Elliott	1858	4 C.B.N.S. 269 (61)
Newby *v.* Harrison	1861	1 J. & H. 393 (104)
New Conveyor Co. *v.* Edinburgh Gas Commissioners	1903	(Scotch) 21 R.P.C. 1, 147 (112)
New Ixion Tyre *v.* Spilsbury	1898	[1898] 2 Ch. 484; 15 R.P.C. 380; 79 L.T. 229 (230)
Newsum *v.* Mann	1890	7 R.P.C. 310 (208)
Re Newton	1900	A.G. 17 R.P.C. 123 (85)
Newton's Patents	1884	9 App. Cas. 592; 1 R.P.C. 177 (221)
Nickels *v.* Ross	1850	8 C.B. 679 (33)
Nobel's Explosives Co. *v.* Anderson	1894 1895	11 R.P.C. 115 (95) H.L. 12 R.P.C. 164 (194)
Nobel's Explosives Co. *v.* Jones	1882	8 App. Cas. 1 L.T. Ch. 339 (135, 140)
Normandy's Patent	1885	9 Moo. P.C.C. 452 (225)
North British Rubber Co. Ltd. *v.* Macintosh	1894	11 R.P.C. 484 (191)
North British Rubber Co. *v.* Gormully & Jeffry Mfg. Co.	1895	12 R.P.C. 17 (145, 157)
Norton's Patent	1863	1 Moo. P.C.C. (N.S.) 339 (221)
Nuttall *v.* Hargreaves	1891	C.A. 8 R.P.C. 450 (63)
Oldham *v.* Langmead	1789	3 T.R. 441 (145)
Otto *v.* Linford	1881	C.A. 46 L.T.N.S. 35 (15, 26, 187)
Otto *v.* Singer	1890	7 R.P.C. 7 (102)
Otto *v.* Steel	1886	3 R.P.C. 120 (204)
Otto *v.* Steel	1886	C.A. 3 R.P.C. 109 (26)
Overton *v.* Burn, Lowe & Sons	1896	13 R.P.C. 455 (174)
In re Owen's Patent	1898	[1899] 1 Ch. 157; 15 R.P.C. 755 (111, 163)

Owen's Patent	1900	17 R.P.C. 68, 637 (70, 164, 180)
Palmer Tyre Co. *v.* Pneumatic Tyre Co.	1899	16 R.P.C. 451 (195)
Parker *v.* Wells	1881	C.A. 18 Ch. D. 477 (155)
Parkinson *v.* Simon	1894	C.A. 11 R.P.C. 493; [1895] H.L. 12 R.P.C. 403 (194)
Re Parkinson	1896	S.G. 13 R.P.C. 509 (110)
Parnell's Patent	1888	5 R.P.C. 126 (229)
Parson's Patent	1898	P.C. 15 R.P.C. 349 (222)
Peach's Patent	1901	P.C. 19 R.P.C. 65 (219)
Peck *v.* Hindes	1898	15 R.P.C. 113 (176)
Peckover *v.* Rowland	1893	10 R.P.C. 118, C.A. 234 (131, 182)
Pegamoid *v.* British Leather Cloth Manufacturing Co.	1901	18 R.P.C. 317 (208)
Penn *v.* Bibby	1866	L.R. 1 Eq. 548 (182)
Penn *v.* Bibby	1866	L.R. 2 Ch. 132 (61)
Penn *v.* Bibby	1866	L.R. 3 Eq. 308 (199)
Penn *v.* Jack	1867	L.R. 5 Eq. 81 (199)
Perkin's Patent	1845	2 W.P.C. 17 (222)
Perry *v.* Société des Lunetiers	1896	13 R.P.C. 664 (72, 152)
Peters *v.* Owen	1888	5 R.P.C. 622 (154)
Peters *v.* Owen	1898	15 R.P.C. 663 (208)
Pettit Smith's Patent	1850	7 Moo. P.C.C. 133; 1 Goodeve P.C. 533 (224)
Pickard & Co. *v.* Prescott	1892	H.L., 9 R.P.C. 195 (26)
Pinto *v.* Badman	1891	8 R.P.C. 181 (233)
Pirrie *v.* York Street Flax Spinning Co.	1894	11 R.P.C. 431 (152)
Pitt's Patent	1898	H.L. 17 R.P.C. 745 (112)
Pitt's Patent	1901	18 R.P.C. 478 (115)
Plating Co. *v.* Farquharson	1883	Griff. 187; 17 Ch. D. 49 (154)
Plimpton *v.* Malcolmson	1876	3 Ch. D. 531, 568 (33, 68)
Plimpton *v.* Spiller	1876	Lawson, *Pat. Pract.*, 497 (74, 156)
Pneumatic Tyre Co. *v.* Casswell	1896	13 R.P.C. 164 (74, 142)
Pneumatic Tyre Co. *v.* Dunlop	1896	13 R.P.C. 553 (91)
Pneumatic Tyre Co. *v.* East London Rubber Co.	1897	14 R.P.C. 77, 103 (133, 204)
Pneumatic Tyre Co. *v.* English Cycle & Tyre Co.	1897	14 R.P.C. 851 (51)
Pneumatic Tyre Co. *v* Friswell	1896	13 R.P.C. 15 (145)
Pneumatic Tyre Co. *v.* Goodman & Son	1896	13 R.P.C. 723 (145)
Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre Co.	1899	H.L. 16 R.P.C. 50, 531 (26, 61, 64, 180, 189)
Pneumatic Tyre Co. *v.* Puncture Proof Pneumatic Co.	1899	C.A. 16 R.P.C. 209 (200)

Pneumatic Tyre Co. *v.* Tubeless Pneumatic Tyre Co.	1899	H.L. 16 R.P.C. 77 (15, 133)
Pneumatic Tyre Co. *v.* West London Rubber Co.	1898	15 R.P.C. 129 (184)
Pooley *v.* Pointon	1885	2 R.P.C. 167 (179)
Postcard Automatic Supply Co. *v.* Samuel	1889	6 R.P.C. 560 (101, 150)
Presto Gear Case *v.* Simplex Gear Case	1898	15 R.P.C. 835 (205)
Printing &c. Co. *v.* Sampson		L.R. 19 Eq. 467 (91)
Proctor *v.* Bailey	1889	C.A. 6 R.P.C. 538 (139)
Proctor *v.* Bennis	1887	36 Ch. D. 740; 4 R.P.C. 333 (72, 73, 141)
Railway Electrical Appliances *in re*	1876	3 Ch. D. 597 (107)
Ralston *v.* Smith	1865	11 H.L.C. 223 (14, 18)
Reason Manufacturing Co. *v.* Moy	1902	19 R.P.C. 409 (186)
Redges *v.* Mulliner	1893	10 R.P.C. 21 (105, 150)
Registrar *v.* Comptroller-General, &c., *ex p.* Tomlinson	1899	C.A. [1899] 1 Q.B. 909; 16 R.P.C. 233 (80)
Registrar *v.* Judge of Cty. Ct. of Halifax	1891	C.A. 8 R.P.C. 338 (137)
Registrar *v.* Townsend	1896	Pal. Ct. 13 R.P.C. 265 (54, 227)
Renard *v.* Levinstein	1865	2 H. & M. 629 (107)
Rendell's Patent	1894	11 R.P.C. 277 (Lanc. Ct. Case) (161)
Rex *v.* Arkwright	1785	1 W.P.C. 66 (67)
Richardson *v.* Castrey	1887	4 R.P.C. 265 (193)
Rickmann *v.* Thierry	1897	H.L. 14 R.P.C. 105 (17, 21, 194)
Rolls *v.* Isaacs	1881	19 Ch. D. 268 (16)
Roper's Patent	1887	4 R.P.C. 201 (223)
Rothwell *v.* King	1887	4 R.P.C. 397 (Lanc. Ct. Case) (208)
Russell *v.* Cowley	1834	1 W.P.C. 459 (18)
Re Rylands	1888	5 R.P.C. 665 (110)
Rylands *v.* Ashley's Patent Bottle Co.	1890	C.A. 7 R.P.C. 175 (154, 155)
Saccharine Corporation *v.* Anglo-Continental Chemical Works	1900	17 R.P.C. 307 (135, 205)
Saccharine Corporation *v.* Annand	1900	17 R.P.C. 1 (142)
Saccharine Corporation *v.* Chemical & Drugs Co.	1898	15 R.P.C. 33; [1900], 17 R.P.C. 743 (143, 198, 201)
Saccharine Corporation *v.* Dawson	1902	19 R.P.C. 173 (142, 197, 205)
Saccharine Corporation *v.* Haines, Ward & Co.	1898	15 R.P.C. 344 (155)

Saccharine Corporation Jackson	*v.*	1903	20 R.P.C. 611 (142)
Saccharine Corporation Reit, Meyer & Co.	*v.*	1900	17 R.P.C. 606 (135)
Saccharine Corporation Quincey	*v.*	1900	17 R.P.C. 337 (142)
Saccharine Corporation Skidmore	*v.*	1903	21 R.P.C. 31 (211)
Saccharine Corporation Wild	*v.*	1903	C.A. 20 R.P.C. 243 (142)
Savage *v.* Brindle		1896	13 R.P.C. 266 (133)
Savage *v.* Brindle		1900	17 R.P.C. 228 (151)
Savory *v.* Price		1823	1 R. & M. 1; 1 W.P.C. 83 (68)
Saxby's Patent		1870	L.R. 3 P.C. 292 (219, 221, 224)
Schermuly *v.* Pain		1901	18 R.P.C. 529 (198)
Scott's Patent		1902	19 R.P.C. 273; [1903] 20 R.P.C. 264 (163, 164)
Scott's Patent		1903	20 R.P.C. 604 (162)
Seaward *v.* Paterson		1897	[1897] 1 Ch. 545 (197)
Semet & Solway's Patent		1895	[1895] A.C. 78; 12 R.P.C. 10 (223, 225)
Re Serrell		1889	6 R.P.C. 101 (110)
Shallenberger's Application		1889	6 R.P.C. 550 (250)
Shaw *v.* Jones		1889	6 R.P.C. 328 (201)
Sheehan *v.* G.E.Raily. Co.		1880	16 Ch. D. 59 (138)
Shoe Machinery Co. *v.* Cutlan		1895	12 R.P.C. 342; 13 R.P.C 141 (147, 149, 152, 210)
Shone's Patent		1892	9 R.P.C. 438 (224)
Shrewsbury & Talbot Cab Co. *v.* Sterck		1896	C.A. 13 R.P.C. 53 (26)
Siddell *v.* Vickers		1888	5 R.P.C. 436 (118)
Siddell *v.* Vickers		1889	6 R.P.C. 464 (201)
Siddell *v.* Vickers		1892	C.A. 9 R.P.C. 152 (198, 201)
Sidebottom *v.* Fielden		1891	Pal. Ct. Lanc.; 8 R.P.C. 266 (153 182)
Sielaff's Application		1888	5 R.P.C. 487 (121)
Siemens *v.* Taylor		1892	9 R.P.C. 393 (106)
Simister's Patent		1842	1 W.P.C. 723 (223)
Simpson *v.* Holliday		1866	5 N.R. 340; L.R. 1 H.L. 315 (71)
Skinner *v.* Perry		1894	11 R.P.C. 406 (175)
Skinner *v.* Perry		1893	C.A. 10 R.P.C. 1 (170)
Sleight's Patent		1893	10 R.P.C. 447 (162)
Smelting Co. of Australia *v.* Commissioners of Inland Revenue		1896	2 Q.B. 179; [1897], 1 Q.B. 175 (106
Smith *v.* Cropper		1885	10 App. Cas. 249 (150)
Smith *v.* Lang		1890	CA. 7 R.P.C. 148 (182)

Smith *v.* Scott	1859	6 C.B. N.S. 771; 28 L.J. C.P. 325 (91)
Re Ambrose Hudd Smith	1896	A.G. 13 R.P.C. 200 (81)
Société Anonyme &c. *v.* Midland Lighting Co.	1897	14 R.P.C. 419 (101)
Société Anonyme du Générateur du Temple	1896	A.G. 13 R.P.C. 54 (31, 33, 41)
Société Anonyme de Glaces *v.* Tiljhman's Sand Blast Co.	1883	C.A. 25 Ch. D. 1 (92, 102, 135)
Southby's Patent	1891	8 R.P.C. 433 (223)
Re Southwell & Head	1899	A.G. 16 R.P.C. 361 (81, 86)
Speckhart *v.* Campbell	1884	C.A. *Times*, 13th March (138)
Spokes *v.* Banbury Board of Health	1865	2 Eq. 42 (197)
Standfield's Patent	1898	15 R.P.C. 17 (219)
Starey *v.* Graham	1899	16 R.P.C. 106 (228)
Steedman *v.* Marsh	1856	2 Jur. N.S. 391 (34)
Steers *v.* Rogers	1893	H.L. 10 R.P.C. 245 (92)
Re Stewart	1896	A.G. 13 R.P.C. 629 (80)
Stewart *v.* Casey	1892	C.A. 9 R.P.C. 9 (230)
Stoney's Patent	1888	5 R.P.C. 518 (223)
Re Stuart	1892	9 R.P.C. 452 (85)
Sturtz *v.* De la Rue	1828	1 W.P.C. 83; 5 Russ. 322 (69)
Sunlight Incandescent Gas *v.* Incandescent Gas Light Co.	1897	14 R.P.C. 757 (204
Sutcliffe *v.* Abbott	1903	20 R.P.C. 50 (183)
Taylor *v.* Hare	1805	1 W.P.C. 292 (104)
Thomas *v.* Hunt	1864	17 C.B.N.S. 183 (102)
Re Thomas & Prevost	1898	S.G. 15 R.P.C. 257 (86)
Re Thomas & Prevost	1899	S.G. 16 R.P.C. 69 (54)
Thomas's Patents	1892	9 R.P.C. 367 (221)
Thompson & Co. *v.* American Braided Wire Co.	1889	H.L. 6 R.P.C. 528 (20)
Thompson *v.* Macdonald & Co.	1891	8 R.P.C. 9 (178)
Thompson's Patent	1902	P.C. 19 R.P.C. 565 (224)
Thomson *v.* Moore	1889	6 R.P.C. 445 (197)
Re Thornborough & Wilks	1896	S.G. 13 R.P.C. 115 (79)
Ticket Punch Register Co. *v.* Colley's Patents	1895	C.A. 12 R.P.C. 171 (72, 189)
Tomlinson, *e. p.*	1899	C.A. [1899] 1 Q.B. 902; 16 R.P.C. 233 (80)
Townsend *v.* Haworth	1875	12 Ch. D. 830 (136)
Travell *v.* Carteret	1683	3 Lev. 134 (70)
Tubes *v.* Perfecta Seamless Steel Tube Co.	1901	C.A. 18 R.P.C. 339; [1903] H.L. 20 R.P.C. 77 (67, 75, 188)
Turner *v.* Winter	1787	1 W.P.C. 80 (69)
Tweedale *v.* Ashworth	1892	H.L. 9 R.P.C. 121 (208)

Tweedale *v.* Ashworth	1896	13 R.P.C. 522 (101)
Ungar *v.* Sugg	1891	8 R.P.C. 385; C.A. 9 R.P.C. 114 (169, 175)
Union Electrical Power Co. *v.* Electrical Power Storage	1888	C.A. 5 R.P.C. 329; 38 Ch. D. 325 (173)
United Horse Nail Co. *v.* Stewart & Co.	1887	4 R.P.C. 130; 13 App. Cas. 401 (199)
United Telephone Co. *v.* Dale	1884	25 Ch. D. 778 (133)
United Telephone Co. *v.* Donohoe	1886	31 Ch. D. 399 (148)
United Telephone Co. *v.* Mottishead	1886	3 R.P.C. 213 (193)
United Telephone Co. *v.* Patterson	1889	6 R.P.C. 140 (205)
United Telephone Co. *v.* Tasker	1888	6 R.P.C. 38 (146)
United Telephone Co. *v.* Walker	1887	4 R.P.C. 63 (199, 202)
Vaisey's Patent	1894	11 R.P.C. 592 (159)
Van Gelder's Patent	1889	6 R.P.C. 28 (118)
Van Gelder *v.* Sowerby Bridge Flour Co.	1890	C.A. 44 Ch. D. 374; 7 R.P.C. 41, 208 (138)
Vickers *v.* Siddell	1890	H.L. 7 R.P.C. 303; 15 App. Cas. 496 (20, 63, 72)
De Vitre *v.* Betts	1873	L.R. 6 H.L. 319; 21 W.R. 705 (198)
Von Heyden *v.* Neustadt	1880	50 L.J. Ch. 128; 14 Ch. D. 230 (27, 36, 135)
Vorwerk & Sons *v.* Evans & Co.	1890	7 R.P.C. 174 (192)
In re Wallace's Patent	1895	12 R.P.C. 444 (162)
Walton *v.* Lavater	1860	8 C.B. N.S. 162 (135, 149)
Walton *v.* Potter	1841	1 W.P.C. 586 (132)
Wapshare Tube Co. *v.* Hyde Imperial Rubber Co.	1901	C.A. 18 R.P.C. 374 (144)
Ward Bros. *v.* J. Hill & Son	1901	18 R.P.C. 481 (178, 180)
Washburn & Moen Mfg. Co. *v.* Q.	1889	6 R.P.C. 398 (139)
Watling *v.* Stevens	1886	C.A. 3 R.P.C. 147 (63)
Watson *v.* Holliday	1882	20 Ch. D. 780 (202)
Webb Lamp Co. *v.* Atkinson	1902	19 R.P.C. 599 (198, 205)
Wegmann *v.* Corcoran	1879	13 Ch. D. 65 (70)
Welsbach Incandescent Gas Light Co. *v.* Daylight Co.	1899	16 R.P.C. 353 (205)
Welsbach Incandescent Gas Light Co. *v.* Dowle	1899	16 R.P.C. 391 (147)
Welsbach Incandescent Gas Light Co. *v.* Gen. Incan. Gas Co.	1901	C.A. 18 R.P.C. 533 (143)

Welsbach Incandescent Gas Light Co. *v.* Krumm	1901	18 R.P.C. 211 (205)
Welsbach Incandescent Gas Light Co. *v.* New Incandescent (Sunlight Patent) Gas	1900	17 R.P.C. 237 (140, 197)
Welsbach Incandescent Gas Light Co. *v.* New Sunlight Incandescent Gas	1900	C.A. 17 R.P.C. 401 (156)
Welsbach Incandescent Gas Light Co. *v.* Vulcan Incandescent Light Synd.	1901	18 R.P.C. 279 (143)
Wenham Co. *v.* Champion Co.	1891	8 R.P.C. 22 (147)
Werdeman *v.* Soc. Gen. d'Électricité	1881	19 Ch. D. 247 (230)
Werner *v.* Gamage	1903	21 R.P.C. 137 (99)
Westinghouse *v.* Lancashire Rail. Co.	1884	1 R.P.C. 253 (202)
White *v.* Hartley	1903	Pal. Ct. Lanc. 20 R.P.C. 265 (207)
Willoughby *v.* Taylor	1894	11 R.P.C. 45 (209)
Wilson Bros. *v.* Wilson	1899	CA. 16 R.P.C. 315; 1903 H.L. 20 R.P.C. 1 (29, 152, 153)
Wirth's Patent	1879	12 Ch. D. 303 (33)
Wood *v.* Leadbitter	1845	13 M. & W. 845 (104)
Wood *v.* Zimmer	1815	1 W.P.C. 82 *n*; Holt N.P. 60 (23)
Woodcroft's Patent	1846	2 W.P.C. 31 (223)
Woodward *v.* Sansum & Co.	1887	C.A. 4 R.P.C. 166 (62, 63)
Wool, Hide & Skin Syndicate *v.* Riches	1902	19 R.P.C. 127 (32)
Woolfe *v.* Automatic Picture Gallery Co.	1902	19 R.P.C. 425; C.A. 20 R.P.C. 177 (111, 165)
Woolley *v.* Broad	1892	9 R.P.C. 429 (152)
Worthington Pump Co. *v.* Moore	1903	20 R.P.C. 41 (37)
Wright's Patent	1839	1 W.P.C. 576 (223)
Wright *v.* Hitchcock	1870	L.R. 5 Ex. 37 (135)
Yates *v.* Armstrong	1898	C.A. 77 L.T. 267 (112)
Yates & Kellett's Patent	1887	4 R.P.C. 150 (221)
Young *v.* White	1853	23 L. J. Ch. 190 (178)

ABBREVIATIONS USED IN TABLE OF CASES.

A.C. & App. Cas.	Law Reports, Appeal Cases.
B. & A.	Barnewall and Alderson's Reports.
B. & B.	Broderip and Bingham's Reports.
B. & C.	Barnewall and Cresswell's Reports.
Beav.	Beavan's Reports.
Bing.	Bingham's Reports of Common Pleas.
Bos. & P.	Bosanquet and Puller's New Reports.
Carpmael Rep.	Carpmael's Patent Cases.
C.B.	Common Bench Reports.
C.B. N.S.	Common Bench Reports, New Series.
Ch. or L.R. Ch.	Law Reports, Chancery Appeal Cases.
Ch. D.	Law Reports, Chancery Division.
C.P.D.	Law Reports, Common Pleas Division.
C. & P.	Carrington and Payne's Reports.
Coke Rep.	Coke's Reports.
Dan. & Ll.	Danson and Lloyd's Mercantile Cases.
Dav. P.C.	Davis's Reports.
De G. F. & J.	De Gex, Fisher and Jones's Reports.
De G. J. & S.	De Gex, Jones and Smith's Reports.
E. & B.	Ellis and Blackburn's Reports.
E.B. & E.	Ellis, Blackburn, and Ellis's Reports.
Ex. R.	Welsby, Hurlstone and Gordon's Reports.
Goodeve P.C.	Goodeve's Patent Cases.
Gr. or Griff.	Griffin's Patent Cases.
Gr. A.P.C.	Griffin's Additional Patent Cases.
H. Bl.	Henry Blackstone's Reports.
H.L.C.	Clark's House of Lords Reports.
H. & M.	Hemming and Miller's Reports.
H. & N.	Hurlstone and Norman's Reports.
Holt N.P.	Holt's Nisi Prius Reports.
J. & H.	Johnson and Hemming's Reports.
Jur. N.S.	Jurist, New Series.
K.B.	King's Bench Reports.
Lev.	Levinz's Reports
L.J.	Law Journal.
L.J. C.P.	Law Journal, Common Pleas.
L.R. Ch.	Law Reports, Chancery Appeals.
L.R. C.P.	Law Reports, Common Pleas.
L.R. H.L.	Law Reports, House of Lords, English.
L.R. P.C.	Law Reports, Privy Council.
L.R. Ex.D.	Law Reports, Exchequer Division.
L.R. Eq.	Law Reports, Equity Cases.
L.T.	Law Times Reports.
L.T.J.	Law Times Journal.
L.T. N.S.	Law Times Reports, New Series.
M. & G.	Manning and Granger's Reports.
Moo. P.C.C.	Moore's Privy Council Cases.
M. & W.	Meeson and Welsby's Reports.
N.R.	New Reports, Bosanquet and Puller.
Parl. Rep.	Parliamentary Reports.
Q.B.	Queen's Bench Reports.
Q.B.D.	Law Reports, Queen's Bench Division.
R. & M.	Russell and Mylne's Reports.
R.P.C.	Reports of Patent Cases or Patent Office Reports.
Russ.	Russell's Reports.
Salk.	Salkeld's Reports.
Scott N.R.	Scott's New Reports.
Stark.	Starkie's Reports.
T.R.	Term Reports
W.N.	Weekly Notes.
W.P.C.	Webster's Patent Cases.
W.R.	Weekly Reporter.

TABLE OF STATUTES.

21 Jac. 1., c. 3	Statute of Monopolies	Sec. 1 (1) Sec. 2 (2, 96) Sec. 4 (176) Sec. 6 (2)
4 Anne, c. 16		Sec. 27 (103)
3 & 4 Will. 4., c. 41	Judicial Committee Act, 1833	Sec. 17 (245)
44 & 45 Vict., c. 41	Conveyancing Act, 1881	Sec. 7 (107, 139)
46 & 47 Vict., c. 57	Patents, Designs, and Trade Marks Act, 1883	Sec. 3 (137) Sec. 4 (30) Sec. 5 (42, 58, 60, 62, 65, 71) Sec. 6 (10, 46) Sec. 7 (46, 50) Sec. 8 (50, 52) Sec. 9 (53, 54, 120) Sec. 10 (54) Sec. 11 (11, 77, 120) Sec. 12 (10, 55, 56) Sec. 13 (48, 50, 56, 138) Sec. 14 (50) Sec. 15 (56, 90) Sec. 17 (87) Sec. 18 (110, 113, 115, 116, 117, 120) Sec. 19 (111, 163) Sec. 20 (117) Sec. 22 (98, 235) Sec. 23 (229) Sec. 24 (88) Sec. 25 (213, 214, 218, 225, 226) Sec. 26 (158, 159, 160, 161, 163) Sec. 27 (94) Sec. 28 (190, 226) Sec. 29 (146, 151, 152, 208) Sec. 30 (153)

46 & 47 Vict., c. 57	Patents, Designs, and Trade Marks Act, 1883	Sec. 31 (203)
		Sec. 32 (168)
		Sec. 33 (73)
		Sec. 34 (32, 57)
		Sec. 35 (253)
		Sec. 36 (90)
		Sec. 37 (56)
		Sec. 38 (121, 122)
		Sec. 39 (27)
		Sec. 40 (6)
		Sec. 42 (254)
		Sec. 43 (96)
		Sec. 44 (158, 251)
		Sec. 46 (2)
		Sec. 82 (4, 5)
		Sec. 83 (190)
		Sec. 84 (5)
		Sec. 85 (230)
		Sec. 86 (10, 40)
		Sec. 90 (230)
		Sec. 91 (233)
		Sec. 93 (227, 233)
		Sec. 94 (253)
		Sec. 95 (254)
		Sec. 96 (232)
		Sec. 97 (46, 88, 252)
		Sec. 98 (52, 88, 252)
		Sec. 99 (253)
		Sec. 100 (255)
		Sec. 101 (5)
		Sec. 102 (254)
		Sec. 103 (246, 247, 248)
		Sec. 104 (246)
		Sec. 105 (227)
		Sec. 107 (190)
		Sec. 108 (228)
		Sec. 109 (158)
		Sec. 110 (254)
		Sec. 111 (231)
		Sec. 112 (228, 254)
		Sec. 116 (10)
		Sec. 117 (246)
48 & 49 Vict., c. 63	Patents, Designs, and Trade Marks (Amendment) Act, 1885	Sec. 3 (30, 50, 54, 56)

48 & 49 Vict., c. 63	Patents, Designs, and Trade Marks (Amendment) Act, 1885	Sec. 4 (51) Sec. 5 (110) Sec. 11 (77)
49 & 50 Vict., c. 37	Patents Act, 1886	Sec. 2 (42) Sec. 3 (28)
51 & 52 Vict., c. 50	Patents Act, 1888	Sec. 1 (227, 228, 124) Sec. 2 (49, 50) Sec. 4 (77) Sec. 26 (137)
54 & 55 Vict., c. 39	Stamp Act, 1891	Sec. 59 (106)
62 & 63 Vict., c. 20	Bodies Corporate Joint Tenancy Act, 1899	(32)
1 Edw. 7., c. 18	Patents Act, 1901	Sec. 1 (246)
2 Edw. 7., c. 34	Patents Act, 1902	Sec. 1 (39, 46, 51, 52, 54, 55, 87, 181) Sec. 2 (27) Sec. 3 (5, 234, 241) Sec. 4 (98)

INDEX OF RULES.

	PAGE
Rule 3	248
Rules 4, 5	255
Rule 6	33
Rule 7	41
Rule 8	45
Rule 9	48
Rule 10	52, 54
Rule 11	49, 54
Rule 12	54
Rules 13, 14	248
Rules 15, 16	249
Rule 17	42
Rules 18-24	43-45
Rule 24	42
Rule 25	81
Rule 26	82
Rule 27	28
Rules 28, 29	48, 49, 115
Rules 30, 31	49, 116
Rule 32	77
Rules 33, 34	78
Rule 35	79
Rules 36, 37	82
Rules 38-41	83
Rule 39	83, 121
Rule 40	83, 122
Rules 42, 43	113
Rules 44-47	114
Rule 48	115
Rules 49, 50	116
Rule 51	229
Rule 52	229, 249
Rule 53	230
Rule 54	230
Rules 55-60	231
Rule 61	229
Rule 62	230
Rule 63	107, 231
Rule 64	232
Rule 65	255
Rule 66	88
Rules 67, 68	89
Rule 69	239
Rules 70-73	240
Rules 74, 75	241
Rules 76, 77	254
Rule 78	253
Rule 79	6, 232
Rule 81	40, 42, 43, 52, 125
Patent Rules, Form W.	7

CHAPTER I.

INTRODUCTORY.

FROM an early period in history the Courts of Common Law recognised the right of the Crown by virtue of its prerogative to grant to the inventor or introducer of a new industry the sole right or monopoly of carrying on that industry for a limited time. Such a grant enabled the inventor to obtain the due reward of his labour and ingenuity by preventing for a time the competition of those who had merely to copy his processes, and in this way was a direct incentive to industry; at the same time the monopoly might not be for an unlimited time, for then those who had learned the new trade could have been restrained from earning a livelihood by its practice. Monopolies in ancient times.

Under several monarchs, especially Queen Elizabeth, the right of granting monopolies was terribly abused, monopolies being granted in respect of existing trades and causing a great deal of annoyance and loss to the people at large. Finally, in the reign of James I., the matter was made a subject of legislation by Parliament, and the Statute of Monopolies thenceforth prevented any further abuse of the royal prerogative. The first section of this statute contains a declaration of the common law with regard to monopolies in the following language:— Statute of Monopolies, 21 Jac. I., c. 3.

"Be it declared and enacted that all monopolies and all commissions, grants, licences, charters and letters patent, heretofore made or granted or hereafter to be made or granted to any person or persons bodies politic or corporate whatsoever of or for the sole buying, selling, making, working or using of anything within this realm or the dominion of Wales or of any other Monopolies illegal.

monopolies . . . are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution."

Trial of monopolies.

Section 2 provided for the trial of all such grants, etc., by and according to the common law and not otherwise. And section 6 made the exception on which our present patent law is based, and is as follows:—

Exception for inventions.

Statute of Monopolies, sect. 6.

"Provided also and be it declared and enacted that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under hereafter to be made for the sole working or making of any manner of new manufactures within this realm to the true and first inventor or inventors of such manufactures which others at the time of making such letters patent and grants shall not use so as they shall not be contrary to law nor mischievous to the state by raising prices of commodities at home or hurt of trade or generally inconvenient the said fourteen years to be accompted from the date of the first letters patent or grant of such privilege hereafter to be made but that the same shall be of such force as they should be if this Act had never been made, and of none other."

Statute does not enlarge exception.

It will be seen that the statute does not authorise any monopoly which would be void at common law, so that if it can be shown that any monopoly would have been bad at common law it will still be bad.

Procedure for granting patents.

The method of granting letters patent for inventions is now regulated by the Patents, Designs and Trade Marks Acts, 1883-1902, and the Patent Rules, 1903: but the test of validity is still (with one exception to be presently noticed) section 6 of the Statute of Monopolies.

Definition of invention Act, 1883, sect. 46.

The Act of 1883 defines an invention, for which alone a patent can be granted under the Act, as meaning any manner of new manufacture, the subject of letters patent and grant of privilege within section 6 of the Statute of Monopolies, and as including an alleged invention.

The question "What is an invention?" is considered in the next chapter.

The Statute of Monopolies provided for the grant of letters patent to the first and true inventor only; and, until 1883, if he died without applying for a patent, his

successors could not obtain a valid patent for his invention. It is now provided that the legal representatives, that is the executors or administrators, of a deceased inventor may, within six months of his death, apply for letters patent for any invention of which he died possessed; and if he should die after applying, but before the patent is sealed, it may be granted to his legal representatives, and so not be lost to his estate.

When inventor dies before taking out patent, patent granted to legal representatives. Act, 1883, sect. 34.

The meaning of "First and true inventor" is con-

That part of the section which excludes from its protection any grants, even for new manufactures, that may be "contrary to law or mischievous to the State, by raising prices of commodities at home or hurt of trade or generally inconvenient," has hitherto been a dead letter. In view, however, of the well-known fact that foreign manufacturers have largely made use of British patent rights for the sole purpose of preventing the making and working of new inventions within the realm, and of the fact that the latest statute dealing with patents makes provision for the revocation of patents, "where, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent or to grant licences on reasonable terms, any existing industry or the establishment of any new industry is unfairly prejudiced," it becomes worth considering whether a grant of monopoly to be used to prevent competition between British and foreign producers for the sole benefit of the latter is not voidable at common law as mischievous to the State. Suppose it found as a fact that a patentee, when he applied for a grant of monopoly, had no intention of making or working his invention within the United Kingdom, and only wanted a patent to prevent others for fourteen years from establishing there the new manufacture he had invented, so as to enable him to sell his foreign product at his own price. Could any jury fail

Mischievous to the State.

to find that such a grant was mischievous to the State by preventing the creation of a new home industry, and so prejudicing the trade of the country by preventing competition with foreign labour, and generally inconvenient by making this country dependent upon foreign sources for the supply of an article which might be equally well manufactured at home?

Is there any obligation to work a patent?

It seems hitherto to have been assumed that the grant of a monopoly imposed no obligation on the grantee to work or use his invention within the realm; but is this assumption well founded? The whole object of allowing monopolies at common law was to foster new industries. And it was laid down as long ago as 1691 that the Statute of Monopolies intended to encourage new devices useful to the kingdom.[1] Grants for a limited time of a monopoly in a new industry were for the public good, and therefore were held to be a proper exercise of the royal prerogative: but could any Court have held that it was for the public good to prohibit the creation of a new industry at home for the sole benefit of a foreign manufacturer? Again, it may well be that an application for the sole working or making of a new manufacture within the realm implies an intention to so work and make by the applicant or his assigns, and that where no such intention exists, the Crown, in making the grant, acts on a false suggestion and the grant is consequently bad *ab initio*. This question does not appear to have ever been considered in Court; but the use of patent rights to hinder instead of to promote new industries is of comparatively recent origin, and its propriety at common law might well be impeached.

Patent Office.

Act, 1883, sect. 82.

The Act of 1883 provided for the establishment of a Patent Office; this is situated in Southampton Buildings,

[1] Edgeberry v. Stephens, 1691, 2 Salk. 447: 1 W.P.C. 35.

Chancery Lane, W.C., and is under the immediate control of an officer, called the Comptroller-General of Patents, Designs and Trade Marks, who acts under the superintendence and direction of the Board of Trade This official will be frequently referred to hereafter as the Comptroller. The Act [1] also provides that any act or thing directed to be done by or to the Comptroller may be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

The Comptroller.

When Comptroller is absent.

The Act also provides for a seal for the Patent Office, with which letters patent are sealed, and this takes the place of the Great Seal formerly used for that purpose.

Seal of Patent Office, sect. 84.

The Act of 1883 also provides that—

Sect. 101. Power for Board of Trade to make general rules for regulating business of Patent Office.

"(1) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act:—

"(c) For making or requiring duplicates of specifications, amendments, 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, amendments, and other documents:

"(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

"(f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

"(g) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the Comptroller, or of the Board of Trade.

Altering forms.

"(2) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

Effect of rules.

"(3) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

Rules to be laid before Parliament.

"(4) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or if not, then as soon as practicable after the beginning of the then

[1] Sect. 82 (4) as amended by Patents Act, 1902, sect. 3.

next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

Rules may be annulled by Parliament.

"(5) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule, or to the making of any new rules or rule."

The Board of Trade have issued several sets of rules under this section, and the rules at present in force are the Patent Rules, 1903.

When Patent Office is open. Rule 79.

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

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

Patent Office Library.

There is at the Patent Office an excellent Public Free Library, which is open daily from 10 a.m. to 10 p.m., except on Sundays, Christmas Day, Good Friday and Bank Holidays. On Christmas Eve, Easter Eve, Whitsun Eve and the day observed as His Majesty's birthday, the library closes at 4 p.m.

The library contains all the printed specifications, indexes and other publications of the Patent Office, and also a collection of the leading British and foreign scientific journals, transactions of the learned societies and text-books of science and art.

The Act also provides that—

Act, 1883, sect. 40. Official journal.

"(1) The Comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the Comptroller may deem generally useful or important.

Sale branch.

"(2) Provisions shall be made by the Comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings (if any).

Publications.

"(3) The Comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit."

Several volumes of these have been published, and, with current specifications, may be obtained at the sale office of the Patent Office.

Applicant for patent must make full disclosure of his invention in a complete specification.

Before a patent can be granted the inventor or applicant for the patent must disclose to the public full information as to the mode of carrying out his invention, so that at the expiration of the term for which the patent is granted the trade may be open to all alike. This disclosure is made by filing at the Patent Office a complete specification, which is open to public inspection, before the patent is granted, and thenceforth becomes public property. The question of specifications is dealt with in chapter v.

Form of Grant of Letters Patent.

The following form of a grant of letters patent to a single inventor will hereinafter be the subject of frequent reference.

Form of Patent.

Patent Rules, 1903. Form W.

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

Recitals.

Whereas

hath declared that he is in possession of an invention for

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

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

And whereas the said inventor (herein-after 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:

Grant.

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 licencees,

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:

Prohibition against infringement.

Provisoes as to revocation.

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

Payment of fees.

Public services.

Licences.

Construction.

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

*

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

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

Seal of Patent Office.

Discussion of Grant of Letters Patent.

In this form of grant of letters patent to a single inventor they are expressed to be granted on the request or application of the inventor made in the prescribed form, in which he represents to the Crown that he is possessed of an invention, of which he gives the title, that he is the true and first inventor thereof, and that the same is not in use by any other person or persons to the best of his knowledge and belief; and that being the case, he humbly prays that a patent may be granted to him for the said invention.

Representations of applicant to the Crown

It will be noticed that in the grant all these representations are recited. This recital has the effect of making the applicant warrant the truth of all his representations; the grant is made simply on the strength of these representations being supposed to be true, and is bad at law if any one of them be not true, because the Crown was deceived thereby. The Crown on its part takes no responsibility for the truth or otherwise of any of the representations, and it is further expressly provided, though such provision is really unnecessary, that if the invention is not new, or if the patentee is not the first and true inventor, the letters patent shall determine and be entirely void.

are recited in the grant.

Effect of recital.

Crown takes no responsibility for truth of recitals.

Grant is voluntary on part of the Crown.

The grant is stated to be made "of our especial grace, certain knowledge and mere motion," and it is recited that "We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request". This affirms the principle that there is no right on the part of the inventor to demand the grant of the letters patent, but that the grant is a voluntary act of favour on the part of the Crown.

Crown cannot be compelled to grant a patent.

There are no means for compelling the Crown to grant letters patent for any invention; the Acts and Rules only govern the forms which must be complied with in making the grant; and the Act of 1883 specially provides that—

Sect. 116.

"nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent, or to the withholding of a grant thereof".

But is unlikely to interfere.

There is, therefore, no doubt that the Crown might refuse the grant of a patent on any application, but this power is mainly a matter of historic interest, and in the ordinary course if an application for a patent be made in proper form, and the examiner to whom it is referred should report that—

Act, 1883, sect. 6.

"the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and that the title sufficiently indicates the subject-matter of the invention,"

the Act provides that—

Act, 1883, sect. 12. As a rule patent will be granted.

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

Act, 1883. sect. 86. Except for illegal or immoral purpose, Comptroller has no discretion as to grant in ordinary cases.

The Comptroller has the power of refusing to grant a patent for any invention of which the use would, in his opinion, be contrary to law or morality; but with this exception he does not appear to have any power of refusing the grant if the examiner gives a favourable report on the formal points referred to him, unless an opposition be decided in favour of the opponent.

Now the grant of a patent can be opposed only on one of three grounds, namely :—

"(i) That the applicant had obtained the invention within the United Kingdom from the opponent, or from a person of whom he is the legal representative ; or

"(ii) That the invention has been patented in this country on an application of prior date; or

"(iii) 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."

Act, 1883, sect. 11. Grounds on which patent can be opposed.

Act, 1888, sect. 4.

Unless, therefore, the patent applied for can be brought within the range of one of these objections there is nothing to prevent any person from obtaining a patent for anything *primâ facie* patentable, even though the patent when obtained will be almost certainly bad.

Unless opposed, patent is granted.

As soon as a person has obtained a patent he is, as we shall see later, in a position to bring actions against any persons who may infringe his patent, and also to threaten to bring such actions against infringers; and even though he utterly fail to establish the validity of his patent, he may still be enabled by such means to injure the business of his rivals in trade, and possibly to reap considerable profits.

Patentee can bring actions and threaten.

If a patent is of doubtful validity, but not clearly bad, it may, nevertheless, be a very valuable property, since those desiring to use the invention will often prefer to accept a licence and pay moderate royalties under such a patent rather than incur the cost and risk of a patent action.

Bad patent often valuable.

The value of such a patent will be greatly enhanced if it be made the subject of an action for infringement, and a certificate be obtained that its validity has been called in question, since in that case any subsequent infringer may be compelled, if unsuccessful in an action for infringement, to pay the patentee's costs as between solicitor and client.

An action enhances value of patent.

Certificate of validity.

The certificate is only that the validity was called in question, and it may be given even when the action is settled upon terms arranged between the parties, so that it may be obtained without there being any actual decision on the question of validity.

Judgment against patent may be reversed on appeal, even by arrangement.

Even if at the trial the patent is held bad, the patentee need not always lose hope, for he may be successful on an appeal; or, if he can arrange matters with his opponents, he can in the Court of Appeal get the judgment against his patent reversed, and an injunction granted upon the terms which he has arranged without his being obliged to disclose those terms.[1]

Skilful management required to work bad patent.

It need hardly be said that in order to make a bad patent valuable it is necessary to have very skilful management; and, to avoid running risks, an intimate knowledge of the law of threats is also needful; but with these conditions a bad patent, backed up by sufficient capital, may sometimes be worked so as to give the patentee, at least for a time, a monopoly nearly as perfect as if the patent were good.

Slight invention often valuable.

It must always be remembered that the profit arising from an invention is not proportionate to the difficulty of making it; many patents of great value protect only very slight improvements on existing machines or processes. Provided an invention be useful and show some ingenuity, the amount of ingenuity is of little consequence, and, as a general rule, it may be said that the smaller the scope of a patent the less is the chance of its being upset.

Cost of patent is small.

The cost of obtaining a patent is now so low that if the inventor be in a position to get the invention worked at all, a very small royalty will soon repay his outlay and yield him a profit which may be out of all proportion to the amount of time and thought which he has bestowed on the invention.

On the other hand, it very often happens that a use-

[1] Cheetham *v.* Oldham, 1891, 8 R.P.C. 168.

ful invention of great ingenuity, which the inventor is not in a position to get taken up, never repays him the fees expended in applying for a patent. There can be no doubt that it is far easier to make an invention than to make it a commercial success; and an inventor who cannot work his own patent will, as a rule, be wise if he be content to accept a small profit for himself and leave the rest to those who undertake the more difficult and risky task of introducing it to the public.

Difficulty of getting an invention taken up.

CHAPTER II.

SUBJECT-MATTER OF LETTERS PATENT.

VALID letters patent can be granted only in respect of an invention, that is of "a new manufacture within this realm which others, at the time of making such letters patent and grant, shall not use". The word manufacture has received a liberal interpretation; in the words of Lord Westbury "it not only comprehends productions, but it also comprehends the means of producing them. Therefore, in addition to the thing produced, it will comprehend a new machine or a new combination of machinery; it will comprehend a new process or an improvement of an old process".[1]

Adaptive skill.

The result merely of adaptive skill and judgment in manufacture is not invention, even though the result may be an improved article,[2] nor are special forms produced by the exercise of known arts such as books, pictures, carvings and designs, though these are proper subjects for copyright. Thus, a new design of lace, made by a novel arrangement of well-known machinery, is not patentable, while a new form of machine for making an old design of lace might be proper subject-matter.

Discovery not always invention.

Discovery is not necessarily invention in the patent sense. A man may discover a new law of nature or a new element, but this will not entitle him to a patent to prevent others from taking advantage of the law or making use of the element. If, however, he at the same time

[1] Ralston v. Smith, 1865, 11 H.L.C. 223.

[2] Beavis v. Rylands Glass and Engineering Co., 1899, 17 R. P. C. 93.

should make some practical application of the law, or discover some process for producing the element, he could prevent others from copying his application or following his process.

A patent cannot be granted for a principle,[1] the very statement of what a principle is proves it not to be ground for a patent. It is a first ground and rule for arts and sciences, or, in other words, the elements and rudiments of them. A patent must be for some new production from those elements and not for the elements themselves.[2] Principle not patentable

Although, however, a law of nature, or a principle, cannot be patented, "a patent will be good though the subject of the patent consists in the discovery of a just, general and most comprehensive principle in evidence or law of nature if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained ".[3] except as applied.

"If you have a new principle or a new idea as regards any art or manufacture, and then show a mode of carrying that into practice, you may patent that, though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new."[4]

In such a case what is patented is the particular application of the principle or law or idea, so that its application for a different purpose will not be an infringement.[5]

[1] Pneumatic Tyre *v.* Tubeless Pneumatic Tyre, 1899, H.L. 16 R.P.C. 77.

[2] Boulton *v.* Bull, 1795, Dav. P.C. 196.

[3] Household Co. *v.* Neilson, 1843, 1 W.P.C. 673.

[4] Otto *v.* Linford, 1881, C.A. 46 L.T.N.S. 35; Ashworth *v.* English Card Clothing Co., 1902, C.A. 19 R.P.C. 463.

[5] Pneumatic Tyre *v.* Tubeless Pneumatic Tyre, 1899, H.L. 16 R.P.C. 77.

What is a "New Manufacture"?

To entitle it to the protection of a patent a manufacture must be new within this realm—that is, within the United Kingdom and the Isle of Man. It is no objection to the novelty of an invention that it has been previously used in a foreign country, or even within a British colony.[1]

Master inventions.

Some inventions may be described as master or pioneer inventions, that is, inventions which break fresh ground and open up new industries. In regard to these no question of novelty can arise, and their inventors have always been held entitled to special protection, though, as will be seen subsequently, even a pioneer inventor may very much weaken his position by a badly drawn specification. As instances of master inventions we may take those of the Welsbach Incandescent Mantle, which has revolutionised the whole system of gas lighting, and of the Pneumatic Tyre, which brought about a similar revolution in the cycle industry. As another instance in which the inventor derived little, if any, benefit from his ingenuity, owing to the absence of a patent may be mentioned the invention of the ordinary cycle wheel with light spokes in a state of tension, which almost instantly displaced the original cycle wheel made on the principle of a cart wheel with rigid spokes in a state of compression.

Improvement inventions.

The number of master or pioneer inventions is necessarily somewhat limited, and by far the greater number of inventions may be described as improvement inventions. In the case of an improvement invention the question of its novelty is closely bound up with the question of whether it is an invention at all or merely the result of adaptive skill and judgment in manufacture, which, as we have seen, is not sufficient to support a patent.[2]

[1] Rolls *v.* Isaacs, 1881, 19 Ch. D. 268.

[2] Beavis *v.* Rylands Glass and Engineering Co., 1899, 17 R.P.C. 93.

There is, of course, novelty in doing anything which has never been done before, but the means of doing it, though novel, may be so obvious to any one skilled in the subject that the discovery of it cannot be said to require any such exercise of inventive genius as could rightly entitle the man who first hit upon it to a patent for preventing others from pursuing a like course.

There may be novelty without invention.

Before deciding whether anything is really an invention or not, regard must be had to what is called the state of public knowledge at the time. The question is not what the inventor himself actually knew about the subject, but what an ordinary skilled person might have been expected to know. Thus, if one thing is known to be the mechanical or chemical equivalent of another, the mere substitution of one for the other, even though it may give the same result in a cheaper way, or even a better result, is not an invention for which a patent can be granted; but the discovery that two things are equivalents, and the substitution of one for the other in a manufacture, provided such substitution be useful, may well be the subject of a patent.[1]

Public knowledge must be considered.

Substitution of equivalent not invention,

but discovery of equivalent may be.

"*If*, with a particular purpose in view, you take the general principles of mechanics and apply one or other of them to a manufacture to which it has never before been applied, that is sufficient ground for taking out a patent."[2] There must, however, be some novelty in the application;[3] "you cannot have a patent for a well-known mechanical contrivance merely when it is applied in a manner or to a purpose which is not quite the same, but is analogous to the manner or purpose in or to which it has been hitherto notoriously applied,"[4] or, to put it

New application of a general principle may be invention.

But application must not be analogous to old,

[1] Horton *v.* Mabon, 1862, 16 C.B.N.S. 141; 31 L.J.C.P. 255.

[2] Dangerfield *v.* Jones, 1865, 13 L.T.N.S. 142; *cf.* Ashworth *v.* English Card Clothing Co., 1902, C.A. 19 R.P.C. 463.

[3] Brook *v.* Aston, 1857, 8 E. & B. 485.

[4] Harwood *v.* Great Northern Railway Co., 1865, 11 H.L.C. 682; Rickmann *v.* Thierry, 1897, H.L. 14 R.P.C. 105.

nor new use of old machine.

shortly, "a patent cannot be granted merely for a new use of an old machine."[1]

New process for old result.

The invention may consist in a new process for obtaining a known result, as for the manufacture of a well-known substance; and it may none the less be a good

Omission of step in process.

invention because it consists only in the omission of a step in the old process of manufacture, since this may effect a considerable saving in the cost of the process.[2]

Combination of old parts may be invention.

Again, an invention may consist in a new combination of old materials previously in use for the same purpose, or in a new method of applying such materials;[3] or in a new combination of old parts to produce a new result, or to produce a known result in a more useful and beneficial way,[4] though a patent has been refused for putting together a combination of old parts in which each part is applied only to its old purpose.[5]

Combination of old and new parts. Subordinate integers may be protected.

A new combination may not consist entirely of old parts, but may contain some parts which are themselves entirely novel; in such a case the patent may be made to protect not only the whole combination, but also these novel parts, or subordinate integers, as they are called.[6]

Subordinate integers.

"Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now again, that subordinate integer may be a step or a number of steps in the whole, which is or are perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a new combination within the meaning which is attached by the Patent Law to the term 'combination'. Suppose that in a patent you have

[1] Ralston *v.* Smith, 1865, 11 H.L.C. 223; Case *v.* Cressy, 1901, C.A. 18 R.P.C. 419.

[2] Russell *v.* Cowley, 1834, 1 W.P.C. 459.

[3] Hill *v.* Thomson & Forman, 1817, 1 W.P.C. 237.

[4] Harrison *v.* The Anderston Foundry Co., 1876, 1 App. Cas. 577.

[5] Bridge's application. Sir E. Carson, S.-G., 1901, 18 R.P.C. 257.

[6] Clark *v.* Adie, 1877. H.L. 2 App. Cas. 315.

a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C and D; he may at the same time claim that, as to one of those parts, D, it is in itself a new thing, and that as to another of those parts, C, it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts them together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would, or might be, held to be granted not only for the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind and has intended to claim protection for those subordinate integers." [1]

When invention is only combination of old parts.

In the case of a combination consisting entirely of old parts, so that the whole invention consists in combining well-known things, the following is the proper test of novelty: Is the product which is the result of the apparatus for which an inventor claims letters patent effectively obtained by means of the new apparatus, whereas it had never been effectively obtained by any of the separate portions of the apparatus which have now been combined into one valuable whole for the purpose of effecting the object in view? [2]

Small addition may be invention.

In order to be good subject-matter for a patent a new combination need differ only to a very small extent from an old one; it may be merely a slight addition or modification in one part of a machine, which, when once made, looks as if it ought to have been obvious, but, as was said by Jessel, Master of the Rolls, "Where a slight

[1] Clark *v.* Adie, 1877, 2 App. Cas. 320; *cf.* Kynoch & Co., Ltd., *v.* Webb, 1900, H.L., 17 R.P.C. 100.

[2] Cannington *v.* Nuttall, 1871, L.R. 5 H.L. 216.

alteration in a combination turns that which was practically useless before into that which is very useful and very important, judges have considered that, though the invention was small, yet the result was so great as fairly to be a subject of a patent; and, as far as a rough test goes, I know of no better ".[1]

New shape of element of old combination.

Even "the introduction into an old combination of a new shape of one of the old elements of that combination, which involves a law of nature otherwise left on one side, may be good subject-matter for a patent ".[2]

New or better article.

In dealing with the case of a combination patent, Chief Justice Tindal, in 1840, said: "We are of opinion that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent ".[3]

Complete article.

This judgment has been frequently followed,[4] and in a well-known case on wire bustles where the fact of invention was hotly disputed, bustles being well known articles, and the materials used by the patentee being also well known, the House of Lords held that the patent was good on the ground that the result was a complete article, light, effective, not likely to get out of order and capable of being manufactured, and therefore sold, cheaply, and that it could not be said that to produce a new thing combining those qualities required no invention.[5]

On the other hand, the same tribunal held invalid a patent for an eyelet with a celluloid face, although no

[1] Hinks & Son v. The Safety Lighting Co., 1876, 4 Ch. D. 607.

[2] Edison & Swan United Electric Light Co. v. Woodhouse and Rawson, 1887, C.A. 4 R.P.C. 93.

[3] Crane v. Price, 1842, 1 W.P.C. 409.

[4] Vickers v. Siddell, 1890, H.L., 7 R.P.C. 306; Lyon v. Goddard, 1893, C.A. 10 R.P.C. 338.

[5] Thompson v. American Braided Wire Co., 1889, H.L. 6 R.P.C. 528.

one had ever before made such an eyelet, and it was an enormous improvement on any existing eyelet.[1]

Decided cases may sometimes be of value in helping one to deal with the questions of novelty and invention, but it must always be remembered that the question of invention is one of fact in each case depending on the circumstances, and a decision in another case is no authority.[2] Where there is a jury the question of invention is for them.[3]

One case no authority in another.

Anticipation.

Hitherto the question of novelty has been treated from the point of view of general public knowledge, and it has been assumed that the thing claimed by the patent was in the widest sense of the word novel, that is, that the actual thing patented had never before been made, or, if made, that it had been made only in some way different from that pointed out in the specification of the patent. The next question is also often one of difficulty. A patent may be bad because what is claimed in it has been anticipated by something done, or publicly proposed to be done, before the date of the patent. Letters patent must be for a manufacture which others at the time of making such letters patent and grant do not use, and this has been extended to mean not only that the invention must not be in use at the date of the patent, but that it must not have been in use at any time before the date of the patent,[4] unless such use was merely experimental and was not public. Further than this, the invention must not have been published within the realm, since the knowledge of how to use the invention is equivalent to the actual user; and people must not be pre-

Patent may be anticipated

by prior user.

By prior publication.

[1] Rickmann *v.* Thierry, 1897, H.L. 14 R.P.C. 105.
[2] Lyon *v.* Goddard, 1893, C.A. 10 R.P.C. 344; H.L. 11 R.P.C. 353.
[3] Lucas *v.* Miller, 1900, 17 R.P.C. 165.
[4] King, Brown & Co. *v.* Anglo-American Brush Co., 1889, 6 R.P.C. 424.

vented from doing that which they are assumed to have known how to do before the grant of the patent.

Thus the invention may have been anticipated either by prior user or by prior publication; and it now remains to consider what ought to be reckoned as sufficient prior user or publication to invalidate a patent.

Perhaps the simplest kind of anticipation is by prior public user of the invention.

What is prior user.

The user must be public, that is, known to others besides the inventor, and known to them without their being bound to secrecy,[1] so that they might be at liberty to use it themselves. Again, it is not enough that the invention has been put in use by some person other than the inventor who applies for a patent, if such use was only by way of trial or experiment,[2] and was not of a commercial character or openly practised.

Prior user must be commercial.

"The meaning of 'public use' is this: that a man shall not, by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right that another man has to a patent for the same invention."[3]

Public use means use in public, not by the public.

"Public use means a use in public so as to come to the knowledge of others than the inventor, as contradistinguished from the use of it by himself in his chamber."[4]

Such use, however, need not be a use by the public, but may be a use by the inventor in public.[5] User, merely to see whether a particular machine is in working order, is not an experimental user of the machine, but is sufficient to anticipate a patent therefor.[6]

In a case in which the defendants to an action for

[1] Gadd *v.* Mayor of Manchester, 1892, C.A. 9 R.P.C. 514.
[2] Matthews *v.* Parmenter, 1896, 13 R.P.C. 514.
[3] Carpenter *v.* Smith, 1841, 1 W.P.C. 534.
[4] *Ibid.*, 542.
[5] *Ibid.*
[6] Hoe & Co. *v.* Foster & Sons, 1899, C.A. 16 R.P.C. 33.

infringement pleaded that they had used the invention before the date of the patent, Chief Justice Tindal gave the following instruction to the jury :—

"If it was generally known and practised, and not merely as a matter of experiment, and that kept secret by the party, and thrown away as the result of that which was of no use to the public, the patent is gone; or if the defendants have shown that they practised it and produced the same result in their factory before the time the patent was obtained, they cannot be prevented by the subsequent patent from going on with that which they have done."[1]

Sale of finished article may anticipate process.

It is probable that a patent may be anticipated by the sale or exposure for sale of a finished article produced by the use of the patented invention, even though a mere examination of such product would not disclose the details of the invention, or enable others to use the invention. It has, indeed, been laid down that the public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void,[2] but the cases on this question are not quite consistent.

User need not extend to date of patent.

Prior public user, in order to avoid a patent, need not extend to the date of the patent. "If it is proved distinctly that a machine of the same kind was in existence and was in public use, that is, if use or if trials had been made of it in the eye and in the presence of the public, it is not necessary that it should come down to the time when the patent was granted."[3]

The actual invention must have been used.

In a case of prior user it is necessary that the user should have been a user of the actual invention which is the subject of the patent: it is not enough that a machine

[1] Cornish & Sieven *v.* Keene, 1835, 1 W.P.C. 510.

[2] Wood *v.* Zimmer, 1815, 1 W.P.C. 82 *n*; Holt N.P. 60; *cf.* Hancock *v.* Somervell, 1851, 39 *Newton's Lond. Journ.*, 158; Morgan *v.* Seaward, 1837, 1 W.P.C. 195; Hills *v.* London Gas Light Co., 1860, 5 H. & N. 336.

[3] King, Brown & Co. *v.* Anglo-American Brush Co., 1889, 6 R.P.C. 424.

somewhat resembling the patented machine, but inferior to it, should have been used, even though it produced a similar result; for it has been clearly laid down that "a machine which would do the work of the patent machine more or less badly is not an anticipation of the patent".[1]

The user must have been for a similar purpose to that covered by the patent, and a claim for a particular substance arranged in a particular way for a particular purpose is not anticipated, even by a similar arrangement of the same substance for an entirely different purpose.[2]

Even if the prior machine contained some of the parts which the inventor believed to be new, his patent may still be good for an improvement; for "it does not follow that because an inventor thinks he has invented more than he has in fact, and describes the advantages of his invention, and some of these advantages arise from an old portion of the invention, it may not still be a good patent, provided that the invention as claimed is so limited as to fail to cover the actual thing in use, while it covers some of the advantages mentioned; in such a case it may still, no doubt, be a good patent".[3]

What is prior publication.

Lastly, an invention may be anticipated by prior publication. This means publication without any reservation, for the communication of an invention to a person who is aware that it is not intended to be published does not amount to a publication.[4]

Judges do not view anticipations by mere publication, or, as they are termed, "paper anticipations," with much favour, and scrutinise them very narrowly to see whether they are really anticipations. Probably not one in a hundred of the prior publications put forward as such in the pleadings in patent actions are, in fact, anticipations.

[1] Barlow *v.* Baylis, 1870, Griff 45.

[2] Edison *v.* Woodhouse, 1887, 4 R.P.C. 93.

[3] Frearson *v.* Loe, 1878, 9 Ch. D. 58.

[4] Gadd *v.* Mayor of Manchester, 1892, C.A. 9 R.P.C. 516; 67 L.T. 569.

The antecedent statement must be such that a person of ordinary knowledge on the subject would be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent.[1]

Anticipation must be complete.

The law on the question of prior public user and prior public knowledge was, in 1861, summed up by Lord Westbury in these words:—

> "The invention must be shown to have been before made known. Whatever is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application. The reason is manifest, because much further information, and therefore much further discovery, are required before the full truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore and the refined and pure metal which is extracted from it. . . . Upon principle, therefore, I conclude that the prior knowledge of an invention to avoid a patent must be a knowledge equal to that required to be given by a patent, viz., such a knowledge as will enable the public to perceive the very discovery and to carry the invention into practical use."[2]

Thus the description in an anticipation must be of

[1] Moseley v. Victoria Rubber Co., 1887, 4 R.P.C. 252; see 4 De G. F. & J. 299.

[2] Hills v. Evans, 1861, 31 L.J. Ch. 463; 4 De G. F. & J. 299.

such a character as to enable any competent person to make the machine for which protection is claimed.[1]

Publication may be by book or periodical, whether published in England or abroad.

In the case of a prior publication in a book or periodical published in England it is not necessary to prove anything beyond the date of publication, but an invention may be published in any well-known foreign language, such as French or German, and in the case of a foreign publication it is necessary to show that at least one copy was published in England.

It is not necessary to prove that any one in this country read the account of the invention; it is enough to show that they were in the position of being able to do so.

Book in public library.

Thus the deposition of a German specification in the library at the Patent Office,[2] or presumably the deposition of the anticipation at any public library, where it would be notified in the catalogue and open to inspection without any record being kept of such inspection, or the sale in this country of a foreign periodical containing a description of the patented article,[3] before the date of the patent, is a prior publication of the invention.

But, on the other hand, the mere fact that a foreign book containing a description of the invention is in an inner room of the British Museum is not of itself evidence of publication: it would be necessary to show that some one had looked into it.[4]

The prior publication must be complete in itself; it is not enough for an anticipation to be contained in several independent documents. This may be evidence of public knowledge, and may then be used to show that

[1] Ehrlich *v.* Ihlee, C.A. 5 R.P.C. 457; Otto *v.* Linford, C.A. 46 L.T. 39; Betts *v.* Menzies, 10 H.L.C.; Gadd *v.* Mayor of Manchester, C.A. 9 R.P.C. 532; Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre Co., 1899, C.A. 16 R.P.C. 50, 57; Shrewsbury & Talbot Cab Co. *v.* Sterck, 1896, C.A. 13 R.P.C. 53.

[2] Harris *v.* Rothwell, 1887, C.A. 4 R.P.C. 225.

[3] Pickard & Co. *v.* Prescott, 1892, H.L. 9 R.P.C. 195.

[4] Otto *v.* Steel, 1886, C.A. 3 R.P.C. 109.

there is no sufficient subject-matter for invention; but the fact that by comparing a number of documents it is possible to get sufficient information to enable one to do that which is described in the specification, is not an anticipation of the patent.[1]

Publication must be complete in itself, and it must not be collected from different places.

An invention forming the subject-matter of an application, made after a date to be fixed by the Board of Trade for the coming into force of section 1 of the Patent Law Amendment Act, 1902, comes under the following provision:—

"An invention covered by any patent granted on an application to which section 1 of this Act applies, shall not be deemed to have been anticipated by reason only of its publication in a specification deposited pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for a patent therefor, or of its publication in a provisional specification of any date not followed by a complete specification."

Patent Law Amendment Act, 1902, sect. 2.

This exception does not affect anticipation by the deposit of any other publication or by past user consequent on, or in carrying out, a specification more than fifty years old, and it, of course, relates only to British specifications, so that a search through those of other countries before the commencement of the fifty year period will still be necessary in some cases.

Publication at an Exhibition before Application for Patent.

Before leaving the consideration of what prior user or publication will defeat a patent, one case must be mentioned in which the exhibition of the invention before application for a patent is made will not affect the subsequent application, provided all the necessary formalities are complied with.

It is provided that—

"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,

[1] Von Heyden v. Neustadt, 1880, 50 L.J. Ch. 128.

Act, 1883, sect. 39, protection of patents exhibited at industrial exhibitions.

or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:

"(*a*) The exhibitor must, before exhibiting the invention, give the Comptroller the prescribed notice of his intention to do so; and

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

Act, 1886, sect. 3.

"Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

Protection of patents exhibited at international exhibitions.

"It shall be lawful for His Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibitions mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in such sections, of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely, or upon such terms and conditions as to His Majesty in Council may seem fit."

Rule 27. Notice to Comptroller of intended exhibition.

"Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition or of using the invention for the purpose of the exhibition in the place where the exhibition is held, may, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Form O of his intention to exhibit, publish, or use the invention, as the case may be. For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require."

See App. A.

This notice to the Comptroller must bear a stamp for 10s.

Utility.

It is necessary that the subject of a patent should be useful, since, if it be not, no public good will result and there will be no consideration for the grant. A very small degree of utility is, however, sufficient, as is shown by the following direction given to a jury by Baron Alderson in 1835:— *Invention must be useful.* *How much utility must there be.*

"A question in this case will be whether you think the steam engine was a useful invention; if it was of any use. I think if it was of different construction from any other steam engine, and of any use to the public, then that is sufficient." [1]

"The intention to produce a profitable matter is of the essence of a patent." [2] Utility, in a commercial sense, that is, having a commercial existence as a process of manufacture, being the utility required to support a patent; [3] but the question whether the patent proved profitable or not has no relation to the question of utility in patent law generally, being confined to cases of improvement by reason of cheaper production, where the thing claimed has not really been invented unless that condition is fulfilled.[4] *Commercial expectation essential.* *Commercial success has no relation to utility.*

The question of utility is one purely of fact in each case, and must, like other questions of fact, be treated without reference to other cases. *Utility is question of fact.*

[1] Morgan *v.* Seaward, 1836, 1 W.P.C. 186.
[2] Higgs *v.* Godwin, 1858, E.B. & E. 529; 27 L.J.Q.B. 421.
[3] Wilson Bros. *v.* Wilson, 1903, H.L. 20 R.P.C. 1.
[4] The Badische Anilin *v.* Levinstein, 1887, 4 R.P.C. 462.

CHAPTER III.

WHO MAY APPLY FOR A PATENT.

UNDER the Statute of Monopolies a patent could be granted to the true and first inventor or inventors of a manufacture; and this has been but slightly modified by later statutes. It is still true that a valid patent can be granted *only* to the true and first inventor or inventors (if living), either alone or in conjunction with others who are not inventors, but the words have been frequently subject to judicial consideration, and their scope has been materially widened from what they at first sight might seem to include.

Later statutes have also affected the class to whom patents may be granted by making provision for cases in which, by the untimely death of an inventor, his estate would have formerly been deprived of the benefit of his invention.

It is now provided that—

Who may apply for a patent. Act, 1883, sect. 4.

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

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

The Act of 1885 declares that—

Sect. 5.

"Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful, under the principal Act, to grant such a patent."

Thus a patent may be applied for by any person or group of persons, whether British subjects or aliens.

Since person includes corporation, there is nothing to prevent a patent being applied for by a joint-stock company, either alone or in conjunction with other corporations or persons; but, as it is obvious that a corporation cannot invent anything, it cannot apply for a patent on Form A1 as the first and true inventor, even though it be a foreign corporation.[1] The inventor, however, may be only an importer; and a corporation can, as the importer of an invention, apply for a patent on the Form A2 provided for that purpose.[2]

Corporation may apply.

Corporation may be true and first inventor.

In the absence of any agreement between joint applicants for a patent there is some doubt as to their actual rights in respect of the patent when granted. It will be seen that the Act says the patent will be granted to them jointly, and in form the grant is a joint grant. This would naturally give rise to a right of survivorship, as in the case of any other joint holding, and it has been held in a Court of first instance that this result follows from the form of the grant.[3] The Court of Appeal in that case came to the conclusion that there was a partnership in the patent, and that a covenant by the joint patentees as to the validity of the patent was joint and several, and not only a joint covenant;[4] but did not decide whether a partnership is to be presumed in the case of every joint grant, and it seems that this must be determined according to the circumstances of each case.

Joint applications.

Joint patent.

Until 9th August, 1899, a company could not hold property as a joint tenant, so that any grant made prior to that date to a company and an individual must necessarily have been a grant to them as tenants in common;

Joint tenant a corporation.

[1] Société Anonyme du Générateur du Temple, 1896, Webster, A.-G., 13 R.P.C 54.

[2] *Ibid.*

[3] National Company for the Distribution of Electricity *v.* Gibbs, 1899, 16 R.P.C. 339.

[4] National Company for the Distribution of Electricity *v.* Gibbs, 1900, C.A. 17 R.P.C. 303.

but the Bodies Corporate (Joint Tenancy) Act, 1899,[1] puts a company in the same position as an individual in respect of the joint holding of property. In the case of a joint tenancy between a corporation and another person, it would seem to follow that, on the dissolution of the former, the whole would pass by survivorship to the other joint tenant.

Advantage of joint application.

The advantage of a joint application is that while each of the applicants has the right of using the invention for which the letters patent are granted, yet, by a simple agreement, requiring only a sixpenny stamp, between the inventor and a co-applicant who is financing his invention, the latter can obtain entire control of the patent without the expense of any deed of assignment or licence.[2]

Joint application.

An inventor who has sold his invention and, with the purchaser, made a joint application for a patent, will be restrained from abandoning or withdrawing the application or doing any act or taking any steps to prevent the sealing or issue of the patent.[3]

Inventor dying before grant of patent.

A case having arisen which showed that there might be hardship when an inventor died without having applied for letters patent,[4] it was provided that—

Act, 1883, sect. 34.

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

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

"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 ad-

[1] 62 & 63 Vict., c. 20.

[2] For forms of agreement, see App. B.

[3] Wool, Hide and Skin Synd. v. Riches, 1902, 19 R.P.C. 127.

[4] Marsden v. Saville Street Foundry and Engineering Co., 1878, L.R. 3 Ex. D. 203.

ministration granted of his estate and effects, or an official copy of such probate or letters, shall be produced at the Patent Office in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require."

Application by representative of deceased inventor. Rule 6.

The general power of applying for letters patent is still limited by the rule that the grant must, unless he be no longer alive, be to the true and first inventor, so that it appears finally that the application must be made by the true and first inventor, or the personal representatives of a deceased true and first inventor, either alone or in conjunction with other persons or corporations.

Inventor includes importer.

The words true and first inventor soon came under judicial consideration, and were held to include an importer into this realm of a new manufacture, that is, of a manufacture new so far as this realm is concerned. Thus, in 1691, it was declared that—

"A grant of a monopoly may be to the first inventor by 21 Jac. I.; and, if the invention be new in England, a patent may be granted, though the thing was practised beyond the sea before: for the statute speaks of new manufactures within this realm; so that if they be new here, it is within the statute, for the Act intended to encourage new devices useful to the kingdom, and, whether learned by travel or by study, it is the same thing."[1]

Importer may be abroad.

It is not necessary that the importer should be in England, the importation may be by the application for letters patent; for it has been held that a patent can be granted to an alien resident abroad, including a foreign company,[2] for an invention communicated to him abroad by another alien.[3]

[1] Edgeberry *v.* Stephens, 1691, 2 Salk. 447; 1 W.P.C. 35; see also Elmslie *v.* Boursier, 1869, L.R. 9 Eq. 217; Nickels *v.* Ross, 1850, 8 C.B. 679; *In re* Claridge's patent, 1851, 7 Moo. P.C.C. 394; Plimpton *v.* Malcolmson, 1876, 3 Ch. D. 531.

[2] Société Anonyme du Générateur du Temple, 1896, A.-G. 13 R.P.C. 54.

[3] *Re* Wirth's patent, 1879, 12 Ch. D. 303.

Importer may be receiver only.

Again, "the first and true inventor" may merely be a receiver of the invention from abroad, and in this case we must distinguish two classes. First, there is the ordinary case in which a foreign inventor communicates his invention to an agent in this country, who applies for a patent for it as on a communication from abroad, and who, when the patent is granted, holds it in trust for his foreign correspondent; this trust existing even where the agent has improved upon the invention as communicated to him.[1]

Importer an agent.

Agent may improve on invention.

Importer not an agent.

The second case is where an invention is communicated to a person in this country without any intention of his applying for a patent on behalf of his correspondent. In this case he is entitled to apply for a patent in his own name and on his own account, for it has been held that "Any person not being in a confidential position towards the first inventor, receiving from a person abroad an invention, is entitled, perhaps not in a strictly moral view, but at all events according to law, to take out a patent on his own account for the invention so communicated".[2]

May apply for patent on his own account.

Communication must be from abroad.

It is, however, absolutely necessary that the communication (except in the case of an application by the personal representatives of a deceased inventor) should be received from some person not in the United Kingdom, since "the communication made in England by one British subject to another does not make the latter a first and true inventor to whom a valid patent can be granted".[3]

Applicant must be real inventor.

Except in the case of an importer, the first and true inventor must be the actual inventor, that is, he must himself have exercised inventive genius in discovering the invention.

[1] Moser *v.* Marsden, 1893, C.A. 10 R.P.C. 350; but see Milligan *v.* Marsh, 1856, 2 Jur. N.S. 1083; Beard *v.* Egerton, 1846, 3 C.B. 97.

[2] Steedman *v.* Marsh, 1856, 2 Jur. N.S. 391.

[3] Marsden *v.* Saville Stree Foundry and Engineering Co., 1878, L.R. 3 Ex. D. 203.

"A man may publish to the world that which is perfectly new in all its uses, and has not before been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learned it from a specification, and then the Legislature never intended that a person who had taken all his knowledge from the act of another, from the labours and assiduity and ingenuity of another, should be the man who was to receive the benefit of another's skill."[1]

It would not, however, be sufficient to destroy a patent to show that learned persons in their studies had foreseen or had found out the discovery that is afterwards made public, or that a man in his private warehouse had, by various experiments, endeavoured to discover it and failed, and had given it up.[2]

Invention may be suggested by another.

Inventive genius may be exercised in developing the suggestions of others, as appears from the following extract from a judgment in the Court of Appeal in the wire bustle case:—

"If a mere suggestion is made upon which the mind of the inventor has to work, and out of which the mind of the inventor produces something that is different from, an improvement upon, and a distinct variation from the suggestion, I apprehend the fact that it has been suggested by the reading of a specification, or by looking at the drawings of a specification, will not prevent his having a right to patent his invention."[3]

Invention may be application of others' work.

The invention itself may consist entirely in the application of knowledge gained from the works of others, since, "even if it could be shown that a patentee had made his discovery of a consecutive process by studying,

[1] Gibson & Campbell *v.* Brand, 1841, 1 W.P.C. 628.

[2] Marsden *v.* Saville Street Foundry and Engineering Co., 1878, L.R. 3 Ex. D. 203.

[3] American Braided Wire Co. *v.* Thompson & Co., 1888, C.A. 5 R.P.C. 120.

collating and applying a number of facts discriminated in the pages of such works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of nature would "[1]—a rule that often seems to be lost sight of in patent litigation.

Inventor may have assistants.

In the process of invention the inventor may receive assistance and even important suggestions from others, and yet he may be entitled to describe himself as the true and first inventor; he may employ servants to carry out experiments for him, and even to work on their own account on comparatively slight suggestions from him, and yet he may be entitled to a patent for the result of their labours. In an old case the law on this subject was stated with great clearness as follows:—

"I take the law to be that if a person has discovered an improved principle, and employs engineers, agents or other persons to assist him in carrying out that principle, and they, in the course of the experiments arising from that employment, make valuable discoveries accessory to the main principle, and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle, and may be embodied in his patent." [2]

Applicant must exercise some invention.

The employer, however, must have some claim to be described as the inventor; he must have exercised some inventive genius, even though it may not have been much: if the servant alone by his own ingenuity makes the invention, the fact that in working it out he was using his master's property and time is not enough to deprive him of the right to a patent, or to entitle the master to obtain a patent for the invention of his servant.[3]

A servant in confidential relation to his employer

[1] Von Heyden v. Neustadt, 1880, 50 L.J. Ch. 128, per James, C.J.
[2] Allen v. Rawson, 1845, 1 C.B. 566.
[3] Heald's application, 1891, 8 R.P.C. 429.

may, however, be trustee of an invention for that employer, and, if he should patent it, the employer may be entitled to a declaration that the patent is held in trust for him.[1]

In one case the directors of a company employed a workman to invent a tap for a stated purpose, and paid him for the time spent by him in working up the invention. They then took out a patent for the tap invented by the workman, and it was revoked on the ground that they were not the true and first inventors, and the Court declared that the workman was the true and first inventor and that the patent had been taken out in fraud of his rights.[2] Workman inventing to order.

There is, lastly, the very important question of rival inventors. If two persons, wholly unconnected with one another, at different times make the same invention, which of them is entitled to call himself the true and first inventor? Rival inventors.

The law on this subject is quite clear: the person entitled to a patent for an invention is the person who first goes to the Crown and applies for a patent. This law was declared in the following terms:— First to apply is entitled to patent.

"There may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first who comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and to enjoy its benefits." [3]

Since patents are dated as of the date and in the order of application, this now may be taken as equivalent to stating that the man whose application for a patent first reaches the Patent Office is the true and first inventor, and is entitled to the patent.

[1] Worthington Pump Co. *v.* Moore, 1903, 20 R.P.C. 41.
[2] Marshall & Naylor's patent, *In re*, 1900, 17 R.P.C. 553.
[3] Cornish *v.* Keene, 1835, 1 W.P.C. 508, per Tindal, C.J.

Re-discovery may be invention.

Provided an earlier inventor has not published his invention, the fact that the applicant for a patent has only re-discovered what had been first discovered by another, does not in any way affect his right to a patent. This question arose in a very early case which was afterwards referred to in the House of Lords in the following terms:—

"Dollond was patentee of a new method of making object-glasses, but it was objected that one Dr. Hall had made the same discovery before him. Dr. Hall, however, had confined it to his closet, and the public were not acquainted with it. Dollond was held to be the true and first inventor." [1]

[1] Dollond's case, 1758, 2 H. Bl. 470.

CHAPTER IV.

HOW TO OBTAIN A PATENT.

THE next matter for consideration is, what must a duly qualified party in possession of a patentable invention do in order to obtain a patent?

Grant a formal matter.

The grant of a patent in this country is very much a formal matter; every application is referred to an examiner, whose duty it is to report to the Comptroller whether the application is in proper form and the invention fairly described by the applicant. And in the case of applications made after a date to be fixed by the Board of Trade,[1] 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 deposited in the Patent Office, pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application. The discovery of such a claim or description does not, however, entitle the Comptroller to refuse the application, but only enables him to order an amendment to be made, or a reference to the earlier specification to be inserted. And it may be taken to be the rule that a patent will be granted upon an application which passes the prescribed stages and is unopposed, whether the invention be novel or not.

The Comptroller has power to refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or morality; and this power

[1] Patent Law Amendment Act, 1902, section 1 (11).

Act, 1883, sect. 86. Immoral patent may be refused.

has been exercised in the case of an application for a patent for a lottery machine.[1] A patent may also be refused on the ground that what is sought to be patented is not an invention within the meaning of section 46 of the Act of 1883.[2]

Grant may be opposed.

In some cases the grant may be opposed by persons whose rights would be affected by the grant of the patent as applied for; and, if their opposition be upheld, the grant may be refused, or certain conditions may be imposed on the applicant.

Comptroller must hear applicant.

In any case, before exercising any discretionary power adversely to the applicant, the Comptroller must, if required so to do, hear the applicant, and his decision is subject to appeal to the law officer.

Usual course.

With these exceptions the rule is that an application made in due form is accepted, and when a complete specification has been filed a patent is sealed in due course.

No examination as to validity.

Except as above stated, no examination as to whether the invention is novel, or as to whether it is proper subject-matter for a patent, is made by the Patent Office, the whole responsibility of this being thrown on the applicant.

Who makes the application.

An application for a patent may be made by the applicant or applicants to the Patent Office direct, or through an agent; in the latter case the agent is entitled to sign all the necessary papers, with the exception of the application form, which must in every case be signed by the applicant or applicants.

Patent agents.

Any person, except as provided by rule 81 (see p. 124), may act as agent for obtaining a patent, but only registered Patent Agents are allowed to describe themselves as Patent Agents. A list of Patent Agents is published by Messrs. Eyre & Spottiswoode, price (including postage) 1s. 1d.

[1] Griff. 20.

[2] Johnson's application, 1901, 19 R.P.C. 56; Cooper's application, 1901, 19 R.P.C. 53.

Forms of application.

Three forms are provided, on one of which an application for a patent must be made.

See App. A.

Patent Form A is for an application by the true and first inventor or inventors, or their personal representatives, either alone or in conjunction with others.

A corporation cannot apply on Form A as sole applicant.[1]

See App. A.

Patent Form A1 is for an application made in respect of an invention communicated from abroad by an agent on behalf of his foreign correspondent.

See App. A.

Patent Form A2 is to be used in making an application under the foreign and colonial arrangements, and must be accompanied by two copies of a complete specification.

[For method of obtaining these forms, see App. A.]

How to fill up application form.

Whichever form is used, the application must bear an impressed stamp for £1, must be filled in with the names and addresses of the applicants and the title of the invention, and must be signed by the applicant, or, if there be more than one, by each of the applicants. An application on behalf of a firm must be signed by every member of the firm; that on behalf of a corporation or company should be under its corporate seal.[2]

Address for service. Rule 7.

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

On the backs of Forms A and A1 will be found two forms of statement as to the address to which notices are

[1] Société Anonyme du Générateur du Temple, 1896, A.-G. 13 R.P.C. 54.
[2] Patent Office Circular.

Address to which notices may be sent.

to be forwarded: the first is for use when application is made through an agent, and contains an authority to the agent to act in the matter; the second is for use when the application is made direct. In every case one of these forms must be filled in and signed by the applicant or each of the applicants as the case may be.[1]

Change of address.

Any change of the address to which notices are to be sent must be notified to the Comptroller on Patent Form R, which must bear a stamp for 5s.

See App. A.

How the form of application is to be dealt with.

The form of application, when duly filled up, may be left by hand at the Patent Office or sent by a prepaid letter through the post,[2] addressed to the Comptroller, Patent Office, Southampton Buildings, Chancery Lane, London, W.C.

For full details, see chap. v.

It must be accompanied by two copies of either a provisional specification or a complete specification, and in the latter case one copy must bear an impressed stamp for £3.

Act, 1883, sect. 5 (3).

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

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

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

Drawings with provisional specification. Act, 1886, sect. 2.

It is not usual for drawings to accompany a provisional specification, but, if any are sent, others like them need not be sent a second time with the complete specification, and in it they may be referred to as the

Rule 24. drawings left with the provisional specification.

Preparing Specifications for Filing.

Rule 17. "A provisional specification must be commenced on

See App. A. Patent Form B, and a complete specification must be

[1] Rule 81, and *vide* Forms.

[2] Rule 80, and *vide* p. 252.

commenced on Patent Form C; the rest of the specification in each case must be on strong paper, of size. 13 inches by 8 inches, with a margin of 2 inches on the left-hand side. All specifications must be in the English language, and must be written or printed in large and legible characters on one side only, and the signatures must be in a large and legible hand."

See App. A.

Patent Forms B and C are issued in duplicate with Application Forms A, A1 and A2.

Form B does not require any stamp, but one copy of Form C must bear an impressed stamp for £3.

Each copy of the specification must be signed by the agent through whom the application is made,[1] or, if made without an agent, by the applicant or applicants.

Each copy must be signed.

Sizes and Methods of preparing Drawings accompanying Provisional or Complete Specifications. (Rules, 1890, 18 to 24.)

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

General. Rule 18.

"Drawings must be made on pure white, hot-pressed, rolled or calendered drawing paper of smooth surface, good quality and medium thickness. Mounted drawings, and drawings on toned paper or Bristol or other board, must not be used.

Requirements as to paper. Rule 19.

"Drawings must be on sheets which measure 13 inches from top to bottom, and are either 8 inches or 16 inches wide, the narrower sheets being preferable. Each sheet should be provided with a border line half an inch from

Size of drawings and arrangement of figures.

[1] Rule 81.

the edge of the paper, and the figures should be placed in an upright position.

" If there are more figures than can be shown in one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary, and the figures should be numbered consecutively throughout.

Drawings to be suitable for reproduction. Rule 20.

" Drawings must be of such a character as to be suitable for reproduction on a reduced scale. To meet this requirement—

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

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

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

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

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

" (*f*) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, etc., 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, 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 must bear the name of the applicant (and, in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the left-hand top corner; the number of sheets of drawings sent, and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter should appear on the drawings. Drawings to bear name of applicant, etc., but no descriptive matter. Rule 21.

"A facsimile or "true copy" of the original drawings must be filed at the same time as the original drawings, prepared strictly in accordance with the above rules (except with regard to the reference letters and figures, which should be in blacklead pencil). Copies of drawings. Rule 22.

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

"Drawings must be delivered at the Patent Office free from folds, breaks or creases. Delivery of drawings. Rule 23.

"If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them in the complete specification as those left with the provisional specification." Provisional drawings used for complete specifications. Rule 24.

Procedure after Application is sent.

"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." Order of recording applications. Rule 8.

"Applications left at the Patent Office, otherwise than through the post, shall be in like manner numbered in the order of their receipt at the Patent Office."

It is provided that an application by prepaid letter sent through the post shall be deemed to have been left

Act, 1883, sect. 97. Postal applications, when deemed received.

at the Patent Office at the time when the letter containing the same would be delivered in the ordinary course of post. Thus, if for any reason the delivery be delayed beyond the time when it would have taken place in the ordinary course of post, the applicant can claim to have his application dated and treated as having been received at the time at which, but for the delay in transmission, it would have reached the Patent Office.

Application lost in post.

Even if an application should never reach the Patent Office at all, the loss may be made good by leaving fresh copies of the application and specifications, and it is submitted that the applicant ought not to be allowed to suffer in any way except inconvenience by the default of the post office.

No discrimination is made between inland and foreign post.

It is provided that—

Application to be referred to an examiner. Act, 1883, sect. 6.

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

When report of examiner is unsatisfactory. Sect. 7.

"(1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or may require that the application or 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."

Act, 1902, sect. 1. Examination of previous specifications in United Kingdom on applications for patents. 46 & 47 Vict., c. 57.

"(1) Where an application for a patent has been made and a complete specification has been deposited by the applicant, the examiner shall forthwith, in addition to the inquiries which he is directed to make by the Patents, Designs and Trade Marks Act, 1883 (in this Act referred to as the principal Act), make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

"(2) If on investigation it appears that the invention has been wholly

or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

"(3) The examiner shall report to the Comptroller the result of his investigations in such manner as the Board of Trade may direct.

"(4) The provisions of sub-section 5 of section 9 of the principal Act, as amended by any subsequent enactment, shall apply to reports under this section.[1]

"(5) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

Comptroller may order reference.

"(6) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection be removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what prior specifications ought to be made in the specification by way of notice to the public.

"(7) An appeal shall lie from the decision of the Comptroller under this section to the law officer.

48 & 49 Vict., c. 63.

"(8) Section 8 of the principal Act and section 3 of the Patents, Designs and Trade Marks (Amendment) Act, 1885 (which regulate the time for depositing a complete specification), shall have effect as if references therein to the period of nine months were references to the period of six months.

No guarantee of validity.

"(9) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon.

Fee on sealing.

"(10) The Board of Trade, with the sanction of the Treasury, may prescribe an additional fee not exceeding one pound in respect of the investigation mentioned in this section, which shall be payable on the sealing of the patent.

"(11) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.

Act, 1902, sect. 2. Limitation as to anticipation.

"An invention covered by any patent granted on an application to which section 1 of this Act applies, shall not be deemed to have been anticipated by reason only of its publication in a specification deposited in the Patent Office pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for a patent therefor, or of its publication in a provisional specification of any date not followed by a complete specification."

[1] See p. 54.

No fee for amendment before acceptance.

When the Comptroller exercises his power to require an amendment before acceptance, no fee can be charged for making the amendment.[1] The provisional specification and application may be amended in this way; and it is doubtful whether the title can be amended in any other way.

Sect. 13. Patent to be for one invention only.

The Act of 1883 provides that a patent shall be granted for one invention only, though it may contain more than one claim; but that if a patent has been granted which comprises more than one invention, that fact shall not affect its validity.

Where application comprises more than one invention.

The fact that an application comprises more than one invention is a ground on which the Comptroller may refuse to accept the application; and this case is provided for by the following rule:—

Application for separate patents by way of amendment. Rule 9.

"Where a person making application for a patent includes in his specification by mistake, inadvertence or otherwise, more than one invention, he may, with the consent of the Comptroller, at any time before the date allowed for the acceptance of his complete specification, amend the same so as to apply to one invention only, and may make application for a separate patent for each such invention accordingly."

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

Exercise of Discretionary Power by Comptroller. Rule 28.

"Before exercising any discretionary power given to the Comptroller by the said Acts or these rules adversely to the applicant for a patent or for amendment, 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."

[1] *Re* Dart, Gr. P.C. 307.

"Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter."

Notice of hearing. Rule 29.

This notification to the Comptroller need not be in any particular form, and no fee is payable for the hearing.

"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."

Rule 30. Explanations by applicant.

"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."

Rule 31. Decision to be notified.

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

Act, 1888, sect. 2 (2). Appeal to law officer.

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

Act, 1888, sect. 2 (3).

The Comptroller neither gives nor receives costs of an appeal to the law officer.[1]

Costs of appeal.

"The Comptroller shall, when an application has been accepted, give notice thereof to the applicant."

Notice of acceptance, sect. 2 (4).

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

Advertisement. Rule 11.

It may happen that more than one application is made in respect of the same invention, and for some reason a patent on a later application may be sealed before the

More than one application for the same invention.

[1] *Re* Lake, 1887, Gr. A.P.C. 16.

first application is complete, so that when a patent would naturally be sealed on the first application the invention is already patented on a later one. To meet such a case it is provided that—

Act, 1883, sect. 13.

"in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application".

But in order to allow the later applicant to avoid the expense of litigation with the earlier applicant, it is also provided that—

Later applicant may withdraw. Act, 1883, sect. 7 (5), as amended. Act, 1888, sect. 2 (5).

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

This last provision enables the second applicant to avoid the expense either of opposition, when his patent has not been sealed, or of a Petition of Revocation when his patent has been sealed.

Provisional Protection.

Act, 1883, sect. 14.

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

Effect of provisional protection.

The effect of such provisional protection varies somewhat according as a provisional or complete specification has accompanied the application. It is only where a

Protection by acceptance of provisional specification.

provisional specification is filed that the protection is what is generally spoken of as provisional protection; this enables the applicant (or his legal representatives), at any time within nine months[1] (or on payment of a fine of £2 within ten months),[2] or in the case of applica-

[1] Act, 1883, sect. 8.
[2] Act, 1885, sect. 3.

tions made after the date to be fixed by the Board of Trade, under section 1 of the Patent Law Amendment Act, 1902, within six or seven months respectively[1] of the date on which his application was received at the Patent Office, to leave a complete specification and obtain a patent for his invention, and the patent so granted will bear the date of his first application.

Complete specification may embody improvements made in interval.

In this complete specification he can embody any improvement of his original invention which can be brought within the terms of the provisional specification, and during the interval he can use his invention in public and make any experiments and trials which may be deemed advisable, without thereby affecting his patent. At the same time he cannot describe his invention as patented, and cannot prevent others from using it until a complete specification has been accepted, so that if the patent is for an article which is in immediate demand, he is not in such an advantageous position as if he had filed his complete specification at first and obtained full protection for his invention.

Invention may be used in public.

Article may not be called patent.

Protection by acceptance of complete specification.

When an application, accompanied by a complete specification, has been accepted, the protection is precisely similar to that which is afforded by the acceptance of a complete specification filed after a provisional, and is practically equal to the protection of an actual patent for every purpose except the taking of legal proceedings; it is as though both the specifications had been accepted on the same day, and does not here require any separate consideration.

Abandonment of application. Act, 1885, sect. 4.

Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application, shall not at any time be open to public inspection or be published by the Comptroller.

Provisional specification.

The Court can order the production of the provisional specification of an abandoned application for a patent.[2]

[1] Act, 1902, sect. 1 (8).

[2] Pneumatic Tyre Co. v. English Cycle and Tyre Co., 1897, Wills, J., 14 R.P.C. 851.

Completion of Application by Complete Specification.

Act, 1883, sect. 8. A complete specification may be left after the application.

After the application, accompanied by a provisional specification, has been accepted, the applicant can complete his application by handing in at the Patent Office, or by sending by post to the Comptroller, at any time within nine calendar months of the date of his application (or, in proper cases, on payment of a fine of £2, for which Patent Form U must be used, within ten months of his application), or in the case of applications made after a date to be fixed by the Board of Trade, under section 1 of the Patent Law Amendment Act, 1902, within six or seven months respectively of his application, two copies of a complete specification.

Rule 10, see App. A.

How and where complete specification must be left. Sect. 98.

These must be handed in, or posted in due time to be received in the ordinary course of post, at the Patent Office before midnight on the same day of the ninth or tenth, or sixth or seventh months, as the case may be, from the date of application. If this day should fall on Christmas Day or Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, which are called excluded days, the complete specification need not reach the Patent Office until the day next following such excluded day, or days, if two or more of them occur consecutively.

If the office is closed, the policeman in charge will take documents up till midnight.

Preparation of complete specification for filing, see App. A.

The complete specification must be prepared in the manner above described for preparing specifications, using Form C for the first sheet, and must be sent to the Patent Office in duplicate, one copy bearing an impressed stamp for £3; each copy must be dated and signed by the applicant or applicants, or, where application is made through an agent, by the agent.[1]

[1] Rule 81.

A patent is not invalid because the complete specification is signed by some only of the applicants; but the patent in that case will be granted only to those who sign, and the others will be taken to have retired from the application.[1]

Patent not invalid if all applicants do not sign the complete specification.

If joint applicants disagree as to the form of the complete specification, the Comptroller will not decide the question between them, but they must settle it themselves.[2] When two complete specifications are lodged neither will be accepted.

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

Act, 1883, sect. 9. Specifications, etc., referred to an examiner.

[N.B.—The fact of an examiner not having found any difference in the inventions described in the two specifications is no evidence that no such difference exists.]

"(2) If the examiner reports that the conditions hereinbefore contained have not been complied with, the Comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

Appeal to law officer.

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

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

Time for acceptance is limited.

It is the duty of the applicant to frame his specification in such a way that a patent may be properly granted, and it is not a matter of course, if a specification be presented in such a form, that a patent cannot be granted without amendment, that the necessary amendment will

[1] *Re* Grenfell & McEvoy's patent, 1890, 7 R.P.C. 151.

[2] Apostoloff & Frendenberg's Application, 1896, Webster, A.-G., 13 R.P.C. 275.

be allowed.[1] Amendments may be made in the discretion of the Comptroller or law officer, but they are made somewhat sparingly.[2]

Where the Comptroller requires an amendment to be made, a reasonable time will be allowed for complying with his requisition; but delay in so doing, caused by inadvertence, is no ground for extending the period within which a patent must be sealed.[3]

In the case of applications made after a date to be fixed by the Board of Trade, the provisions of section 1 of the Patent Law Amendment Act, 1902, apply. For these, see p. 46.

Act, 1885, sect. 3. Enlargement of time for acceptance. Rule 10, see App. A.

The applicant may, in proper cases, get the time for acceptance enlarged for three months by making application to the Comptroller on Patent Form V, properly stamped. The stamp required is £2, £4 or £6, respectively, according as the extension sought does not exceed one, two or three months.

Act, 1883, sect. 9 (5). Reports of examiners not published.

"Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding other than an appeal to the law officer under this Act, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed."

Advertisement of acceptance of complete specification. Sect. 10. Rule 12.

On the acceptance of the complete specification, the Comptroller advertises the acceptance in the official journal; and, upon the publication of such acceptance, the application and specification, or specifications with the drawings (if any), may be inspected at the Patent Office upon payment of a fee of one shilling.

Specification may be inspected after acceptance.

Use of word patent.

Only after a complete specification has been accepted may articles made in accordance with the invention be marked patent.[4]

[1] Thomas & Prevost's application, 1899, Finlay, S.-G., 16 R.P.C. 69.
[2] Garnett's application, 1899, Finlay, S.-G., 16 R.P.C. 154.
[3] A. & B.'s application, 1896, Finlay, S.-G., 13 R.P.C. 63.
[4] Registrar v. Townsend, 1896, Pal. Ct. 13 R.P.C. 265.

Printing and sale of specifications.

The specifications and drawings are printed three weeks after the complete specification has been accepted,[1] and may be purchased at the sale branch of the Patent Office at the uniform price of 8d. This includes the price of inland postage, and, in case of an application by post, the cost of the postage stamp required on the application.

How to obtain a specification by post. See App. A.

A postal application for a specification should be made on Patent Form C1, which may be obtained at any money order office, but is kept in stock only at certain principal offices.

Grant of patent may be opposed within two months of acceptance.

Within two months from the date of the advertisement of the acceptance of a complete specification, the grant of the patent may be opposed upon certain grounds (full particulars of opposition are given in chapter vii.).

How patent is sealed. Act, 1883, sect. 12.

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

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

Sealing must be within fixed time from application.

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

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

In the case of applications made after the date fixed by the Board of Trade, under section 1 of the Act of 1902, a further fee not exceeding £1 is payable on the sealing of the patent.[2]

Where the Comptroller requires an amendment to be made, a reasonable time will be allowed for complying with his requisition, but delay in so doing, caused by inadvertence, is no ground for extending the period within which a patent must be sealed.[3]

[1] Patent Office Circular.
[2] Act, 1902, sect. 1 (11).
[3] A. & B.'s application, 1896, S.-G., 13 R.P.C. 63.

Where an opposition has been entered and persisted in merely for the purpose of delay, the law officer has no jurisdiction under this section, and will not direct the patent to be sealed out of time.[1]

Act, 1885, sect. 3.

Extension of time for sealing.

If the time for leaving the complete specification, or for the acceptance of the complete specification, has been extended, a further extension of four months after the expiration of the fifteen months is allowed for the sealing of the patent.

If there is no opposition, the patent is usually sealed about ten weeks after the date of the acceptance of the complete specification.[2]

Date of patent. Act, 1883, sect. 13.

"Every patent shall be dated and sealed as of the day of application provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification."

No legal proceedings can be commenced before sealing. Act, 1883, sect. 15.

Proceedings for infringement can be commenced only after the patent is sealed, but may refer back to the date of publication of the complete specification.

Lost patent may be replaced. Act, 1883, sect. 37.

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

See App. A.

Application for a duplicate to be sealed must be made on Patent Form N, and the application must bear an impressed stamp for £2.

Where applicant dies before sealing. Act, 1883, sect. 12 (3, *b*).

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

In the case of the applicant dying before the complete specification has been left at the Patent Office, the legal representatives should produce the Probate or Letters of Administration to the Comptroller, who will allow the subsequent stages of the application to be carried out in their names.

The personal representatives are entitled to send the

[1] A. & B.'s application, 1902, S.-G., 19 R.P.C. 556.
[2] Patent Office Circula..

complete specification in due course, but there is no special provision as to the time within which this must be done, and according to the practice of the Patent Office they have no further time than the applicant would have had. If the death should take place near the expiration of the time the personal representatives may be unable to comply with the requirements of the Office, but if the invention has not been published they would probably be able to abandon the application and make a fresh one within six months after the death under the provisions of section 34 of the Act of 1883,[1] though these apply strictly only where the deceased inventor has not made any application. An incomplete application rendered abortive by death might well be treated as no application in order to prevent the loss of the invention to the inventor's estate. The safest course is to file the complete specification within the time, and, if necessary, obtain a month's extension in the usual way.

Where the application has been made through an agent, a further authorisation is needed before he can proceed with the application.

If the complete specification has been filed and nothing is done, the patent will be sealed in the name of the deceased applicant; but if the legal representatives produce the Probate or Letters of Administration to the Comptroller, the patent will be granted to them instead.

[1] See p. 32.

CHAPTER V.

SPECIFICATIONS.

Two kinds of specification, provisional and complete.

In the preceding chapter the form was considered in which specifications must be prepared for accompanying or following an application for a patent to the Patent Office, and it was noticed that there are two kinds of specification, either of which may accompany the application. It was also seen that if only a provisional specification accompanies the application, it is necessary, in order to obtain a patent, to supplement it by sending to the Patent Office, within a limited time after the date of the application, a complete specification of the invention for which the protection of a patent is sought.

The present chapter is concerned with the substance of the specifications, and only in very small degree with their form; it deals with the draft only.

The Title of a Specification.

Specification must commence with the title. Sect. 5 (5).

The Act of 1883 provides that a specification, whether provisional or complete, must commence with the title; so that the first thing to be decided upon in drafting a specification is the title.

See p. 7.

Title must be suitably chosen,

It will be seen that in the form of grant it is recited that the inventor has represented that he is in possession of an invention for . . . (*here follows the title of the invention*). Now, if this title is not one which ought to be applied to the invention for which protection is sought, the applicant has made a misrepresentation,

or, as it is sometimes called, "a false suggestion"; and the effect of this will be that the patent, when granted, will be of no effect. Therefore it is very important that the specification should commence with a suitable title.

Or patent will be void.

There have been cases in which the title has been considered to be more general than the invention warranted, and it has been made clear that if the title embraces more than the actual invention, so as to make the invention seem greater than it really is, then the patent will be invalid.

Title may too general

Thus, in one case where the title conveyed the intelligence that by the invention an instrument gave "new notes" which had never before been produced, while, as a matter of fact, the instrument only produced "one new note," the patent was held bad for a false suggestion in the title.[1]

In another case, the accuracy of the judgment in which was afterwards questioned by a higher court, a patent for "an improved mode of lighting cities, towns and villages," which contained only a description of an improved street lamp, was held to be invalid on the same ground.[2]

It is sometimes rather difficult to know what ought to be made the title of an invention; for instance, in the case of a machine it is dangerous to call it a "machine," since that may make the invention appear wider than it really is. "In an old case the following directions were given to a jury as to the effect of describing an invention as "a machine for the manufacture of bobbin lace or twist lace": "If you think that he has invented an engine which consists of a perfectly new conformation of parts, though all the parts were used before, yet he will be entitled to support his patent for a new machine. If a

What may be called a machine.

[1] Bainbridge *v.* Wigley, 1810, Parl. Rep. 197; *cf.* also Bloxam *v.* Elsee, 1827, 6 B. & C. 178; 3 L. J. (O.S.) Q.B. 93.

[2] Cochrane *v.* Smethurst, 1816, 1 Stark. 205; questioned in Cook *v.* Pearce, 1843, 8 Q.B. 1063.

combination of a certain number of parts up to a given point existed before, and Mr. Brown's invention sprung from that point, and added other combinations to it, then I think his specification stating the whole machine as his invention is bad."[1]

"Machine" generally too broad.

Thus the title "machine" by itself is only applicable to what is an entirely new machine, and in most cases the title should be in somewhat narrower terms; for instance, as "an improved machine," or "improvements in machines".

New or improved method or machine is a safe description.

The judgment of Justice Cresswell, in a case where an invention had been described as "a new or improved method," seems to apply as well to a machine as to a method, and gives a very safe title for use where any doubt exists as to how an invention ought to be described. He said: "If a part of the method be new, so as to produce a result that, as a whole, is new, surely it may be called a new or improved method. If the method be altogether new, surely it may be called an improved method. They seem to be convertible terms."[2]

It is thus a safe rule to use the words "new or improved" when in doubt as to which an invention really is, and this should always be borne in mind in deciding upon the title for a patent.

Provisional Specification.

Act, 1883, sect. 5 (3).

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

Drawings are unusual.

It is, as has been already pointed out, unusual for drawings to accompany a provisional specification.

Object of provisional specification.

"The office of the provisional specification is only to describe generally and fairly the nature of the invention and not to enter into all the minute details as to the manner in which the invention is to be carried out; other-

[1] Bovill *v.* Moore, 1815, Dav. P.C. 361.
[2] Beard *v.* Egerton, 1846, 3 C.B. 123.

wise the provisional specification must be as full as the complete specification, and drawn with as much care and deliberation. Indeed, the statute itself indicates this distinction between the provisional and the final specification; for it calls the latter the complete specification, implying that the former is, or may legally be, in some respects, executory and incomplete. Moreover, it enacts that the provisional specification is to describe the nature of the invention and no more; but, when the statute comes to speak of the complete specification, its language is altogether different. It enacts that the complete specification shall describe not only the nature of the invention, but also the manner in which it shall be performed, and not only describe but particularly ascertain it."[1]

If a patentee gives, in his provisional specification, a wide enough description of the nature of his invention, he is entitled to fill that up and even to take advantage of knowledge which may come to him between the dates of the provisional specification and the final specification, in order to cover by his final specification matters of detail which he may not have known at the time when he drew up his provisional specification, but which are covered by the description he has given of the nature of his invention.[2]

Provisional may describe a mode of carrying out the invention.

It is not, however, any objection to a patent if the provisional specification does describe a mode of carrying out the invention, even though the mode shown in the complete specification should be a different and a better one.

"A patentee, putting in a provisional specification showing the nature of his invention, is not bound to describe a way in which that can be carried into effect

[1] Newall *v.* Elliott, 1858, 4 C.B. (N.S.) 269, adopted by H.L. in Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre Co., 1899, 16 R.P.C. 531, see p. 541; *cf.* Penn *v.* Bibby, 1866, L.R. 2 Ch. 132.

[2] Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre Co., 1899, H.L. (per Lord Shand) 16 R.P.C. 543.

Complete may describe different method from that in provisional.

and operation; but, if he does describe a way of doing it, and, before he files his complete specification, he either finds out improvements in that way, or a different way of carrying into effect that which is described as his invention in the provisional specification, he is bound to give the public the benefit of what he has discovered as regards the mode of carrying the invention, the nature of which must be described in the provisional specification, into effect, even although there may be improvement, and even invention, which was not known to him at the time."[1]

Details should be avoided in provisional,

and general language used instead.

Thus the inventor may please himself about giving details in his provisional specification; as, however, details are not required, it would seem better not to give them, but in the provisional specification to use general terms sufficiently wide to cover any improvements which are likely to occur during the time of provisional protection, and just sufficiently definite to enable the inventor to point out what part of the provisional specification describes the invention detailed in the complete specification. If this rule be followed there will not be much fear of the patent being upset upon the ground of disconformity, and this is all that really needs to be guarded against in framing a provisional specification.

The Complete Specification.

Should be as perfect as possible.

Although it is very important to have the provisional specification well drawn, it is of supreme importance to have the complete specification as perfect as possible, since it is to the complete specification that reference must be made to see in what the invention really consists and what the patentee claims as his monopoly.

Act, 1883, sect. 5 (4).

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

[1] Woodward *v.* Sansum, 1887, C.A. 4 R.P.C. 175.

If a provisional specification has been left with the application, it is necessary that the complete specification should describe the same invention as is described in the provisional specification.[1]

Must describe same invention as provisional.

The patent is granted on the application, and is for the invention which is described in the provisional specification, although the patent is not sealed until the complete specification, giving a more perfect description of the invention, has been filed; and if anything is not within the provisional specification the patent cannot protect it. This was clearly laid down by Lord Blackburn in the House of Lords, as follows:—

Nothing outside provisional specification can be protected.

"Look at the nature of the invention described in the provisional specification and say whether this which you have been doing, and which you say was a part of the patent, is fairly within the nature of the invention you have described. In that case you are protected; but, if it is a new and separate invention, and a different one, then you are not protected."[2]

"The provisional and complete specifications may describe different modes of carrying out an invention; but if both are really within the same invention described not minutely, but in general terms in the provisional specification, this will not render the patent bad, even though the complete may contain an improvement on what is described in the provisional."[3]

Mode of carrying out invention may differ in specifications.

But, although the complete specification may contain an improvement on what is described in the provisional specification, the improvement must not be anything in the nature of an independent invention.[4]

Improvements in complete specification.

The law on this point was also very clearly stated in the House of Lords, in the same case, as follows:—

[1] Vickers *v.* Siddell, 1890, H.L. 7 R.P.C. 303; Nuttall *v.* Hargreaves, 1891, C.A. 8 R.P.C. 450.

[2] Bailey *v.* Roberton, 1878, 3 App. Cas. 1075.

[3] Woodward *v.* Sansum, 1887, C.A. 4 R.P.C. 166.

[4] Watling *v.* Stevens, 1886, C.A. 3 R.P.C. 147.

"I cannot but think that . . . when the nature of an invention has been described in the provisional specification in the way which has been mentioned, if something were found out during the six months to make the invention work better, or with respect to the mode in which the operation is to be performed—a thing which is very likely to happen—still the nature of the invention remains the same, and it is no objection that, in the complete specification which comes afterwards, the invention or application is described more particularly and in more detail, or even if it be shown that there has been more discovery made, and so as to make the invention which is described in the provisional specification really workable.

"If nothing more is done than that, I think it is good; but, as soon as it comes to be more than that, and the patentee says in the provisional specification I describe my invention as A, and in the complete specification he says, I describe A and also B, then, as far as regards B, it is void, because the letters patent were granted for the invention that was described in the provisional specific tion, and do not cover the invention that is described in the other."[1]

Definition of disconformity.

If the complete specification contains something not foreshadowed in the provisional, the patent is bad, and the defect is known as disconformity. The question whether there is disconformity or not is one of law, since it arises out of the construction of the specifications.[2]

Complete specification may describe what it could not claim so as to publish it.

It is no objection to a patent if the complete specification describes something not in the provisional, simply for the sake of publishing it, and does not attempt to claim it as part of the invention protected by the patent; indeed, it is sometimes advisable to take this course in order to prevent any one from taking out a

[1] Bailey v. Roberton, 1878, 3 App. Cas. 1075.

[2] Pneumatic Tyre Co. v. Leicester Pneumatic Tyre Co., 1899, C.A. 16 R.P.C. 50.

patent for some minor detail which the original applicant does not wish to make the subject of a separate application.

This is often advisable.

Since the complete specification must contain details of the invention described in the provisional specification, it acts as a definer of what the provisional specification had stated to be the subject-matter of the application; and it is no objection to a complete specification that the invention described in it is smaller than what appeared from the provisional specification to be in prospect, provided the invention be not so narrowed as to make the title too general, and so render the patent void for a false suggestion in the title.

Complete defines provisional, and may narrow its scope.

Thus far the complete specification has been considered with reference to the provisional specification, which may not have any existence; what follows applies to any complete specification, whether it accompanies the application or follows it.

A complete specification—

(*a*) Must commence with the title;

(*b*) Must particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed;

(*c*) Must be accompanied by drawings (or must refer to drawings already sent with the provisional specification) if required; and—

(*d*) Must end with a distinct statement of the invention claimed.

Act, 1883, sect. 5. Requirements of complete specification.

Nothing further need be said about (*a*), since what has been already said applies equally to all specifications, whether provisional or complete.

(*b*) and (*c*) may be considered together; the drawings and the letterpress together form the specification, any deficiency in the one being supplemented by the other; and their relative importance varies according to the class of invention which it is sought to protect. In some cases drawings may be not only unnecessary, but quite out

Drawings supplement letterpress.

of the question, and in such cases the wording of the specification is all-important; while in others the drawings by themselves may be sufficient to show what the invention is, though the letterpress should always contain some descriptive reference to them.[1]

No rule can be given as to how far the applicant should rely on the letterpress, and how far on drawings; but, as a rule, where drawings are of any use, the more they are used the better.

Only what is described is protected.

The letters patent contain a recital that "the inventor hath, by his complete specification, particularly described the nature of his invention," and the letters patent are granted only for the invention so described.

Consideration for grant.

This is a recital of very great importance, since it is a recital of what the applicant has done in order to entitle himself to the grant of a patent; it is a recital of the consideration for the grant, and, if it be not true, there is a failure of the consideration and the patent is of no effect.

Especially in a combination of old parts must the specification describe and ascertain the invention with such certainty as not to deter the public from using what is old by including it in the claim for monopoly.[2]

Applicant must not keep back any useful information for working the invention.

The applicant must give the public the full benefit of his invention; he must not attempt to keep back anything which he knows to be of value in working the invention, in the hope of combining the advantages of a patent with those of a trade secret.

To whom a specification is addressed.

"It is clearly settled as law, that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted; for the end and meaning of the specification is to teach the public, after the term for

[1] Hattersley *v.* Hodgson, 1903, 20 R.P.C. 591.
[2] Kynoch *v.* Webb, 1900, H.L. 17 R.P.C. 100, 108.

which the patent is granted, what the art is, and it must put the public in possession of the secret in as ample and beneficial a way as the patentee uses it."[1]

It is thus very important to know how much it is necessary for the applicant to go into details of his invention, and to ascertain this one must consider the class of persons to whom a specification is supposed to be addressed.

A concise statement of this has been recently given in the House of Lords in the following words:—

"The object and purpose of a specification is that it is to enable not anybody, but a reasonably well-informed artisan, dealing with a subject-matter with which he is familiar, to make the thing, so as to make it available for the public at the end of the protected period."[2]

More lengthy explanations have been given in other cases, of which the following are useful examples:—

Specification must be such as ordinary skilled workman can understand.

"It is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. If it is a mechanical invention you have, first of all, scientific mechanicians of the first class, eminent engineers; then you have scientific mechanicians of the second class, managers of great manufactories, great employers of labour, persons who have studied mechanics; . . . and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even from slight hints and still more imperfect descriptions, and would be able to supplement, so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the first two classes, which I will call the scientific classes. The other class

[1] Rex *v.* Arkwright, 1785, 1 W.P.C. 66, per Buller, J.

[2] Per Halsbury, L.C., Tubes *v.* Perfecta Seamless Steel Tube Co., 1903, H.L. 20 R.P.C. 77.

consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected of him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description or correct an erroneous description. . . .

"It will be a bad specification if the first two classes only understand it and if the third class do not."[1]

Specification may assume matters of common knowledge.

"The specification ought to be framed so as not to call upon a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. You may call upon him to exercise all the existing knowledge common to the trade, but you cannot call upon him to exercise anything more. You have no right to call upon him to tax his ingenuity or invention.

Specification must not leave room for experiments.

"The specification of a patent must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect, so as to save a party the trouble of making experiments and trials."[2]

The sufficiency of a specification must be tested by the state of public knowledge at the time it is filed.[3]

Must not be ambiguous or misleading.

The specification must not be misleading or ambiguous; it must not describe an elaborate method of making materials, forming part of a new mixture, when such materials can be readily purchased;[4] it must not direct the use of a substance under an ordinary description when the ordinary commercial article answering to the description will not answer, but a special prepara-

[1] Plimpton *v.* Malcolmson, 1876, 3 Ch. D. 568, per Jessel, M.R.
[2] Morgan *v.* Seaward, 1836, 1 W.P.C. 174, per Alderson, B.
[3] Badische Anilin *v.* Levinstein, 1885, 24 Ch. D. 156.
[4] Savory *v.* Price, 1823, 1 R. & M. 1.

tion, sold only by the patentee, is required;[1] it must not lead a person, attempting to put the invention in practice, into a course of futile experiments by suggesting the use of alternatives, which, to the knowledge of the patentee, will not answer.[2]

"It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. . . . If the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void. It is certainly of consequence that the terms of a specification should express the invention in the clearest and most specific manner, so that a man of science may be able to produce the thing intended without the necessity of trying experiments."[3]

Process described must produce right result.

The rule that *no experiments* may be required does not, however, apply to every case.

"The specification must be sufficiently clear to enable a person, conversant in the subject, without invention to carry out the invention; but not necessarily to enable him to do the work without any trial or experiment, which, when it is new or especially delicate, may frequently be necessary, however clear the description may be."[4]

In some cases trial may be needed to carry out specification,

But, although experiment may be still needed in order to put the invention in practice, [illegible] be nothing to put the public on a wrong [illegible] the specification, upon a fair interpretation, [illegible] al it is insufficient.[5]

but it must not be equivocal.

[1] Sturtz *v.* De la Rue, 1828, 1 W.P.C. 83.

[2] Crompton *v.* Ibbotson, 1828, Dan. & Ll. 33.

[3] Turner *v.* Winter, 1787, 1 W.P.C. 80, 81.

[4] Edison & Swan Electric Light Co. *v.* Holland, 1889, C.A. 6 R.P.C. 243; see also Beard *v.* Egerton, 1849, 8 C.B. 206.

[5] Hastings *v.* Brown, 1853, 1 E. & B. 454.

False statement.

A false suggestion as to the utility of parts of a process described in the specification will invalidate the patent;[1] but the fact that a patentee misconceives and mistakes the theory of his invention does not invalidate his patent.[2]

Specification need show only one method,

The applicant is not bound to describe every way known to him of carrying out his invention; it is sufficient if he shows one useful way, even though it may turn out not to be the most beneficial way.

but may give more provided they will all work.

He may give several ways, but must be careful only to give ways that will give the required result; for, "If you describe in a specification two ways of doing a thing, and by one way it cannot be done, the specification is bad".[3]

Generic term not always sufficient.

"It is not sufficient to describe a material by a generic term comprising many species, the majority of which would be unsuitable";[4] but if a patent be for a process which may be applied to a large class of substances, it is no objection to prove that it is only some of these substances which will give a useful result.[5]

Nature of chemical product need not be given.

In a chemical patent it is not necessary to state what is the exact chemical nature of the product produced by a process; it is the commercial, not the chemical, value of the product that is the subject of the patent.[6]

Mistakes should be avoided.

What mistakes will render patent bad.

The applicant should be careful to avoid mistakes in his directions or drawings; but a mistake will not necessarily render the patent bad unless it be likely to mislead the public, or should amount to a false suggestion.

[1] Owen's patent, 1900, 17 R.P.C. 68; *cf.* Morgan *v.* Seaward, 1836, 2 M. & W. 561; Travell *v.* Carteret, 1683, 3 Lev. 134; Alcock *v.* Cooke, 1829, 5 Bing. 340; Hill *v.* Thomson, 1817, 1 W.P.C. 237; Brunton *v.* Hawkes, 1821, 4 B. & A. 550; Lewis *v.* Marling, 1829, 4 C. & P. 52.

[2] Atkins & Applegarth *v.* The Castner-Kellner Alkali Coy., Ltd., 1901, 18 R.P.C. 281.

[3] Beard *v.* Egerton, 1846, 19 L.J. 39.

[4] Wegmann *v.* Corcoran, 1879, 13 Ch. D. 65.

[5] Badische Anilin *v.* Levinstein, 1887, H.L. 4 R.P.C. 449.

[6] Leonhardt *v.* Kallé, 1895, 12 R.P.C. 103.

"The statement that an error in a specification, which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, is true only of such errors as appear on the face of the specification or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture. The reason is because such errors cannot possibly mislead; but it is not true of errors which are discoverable only by experiment and further inquiry, nor of an erroneous statement amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject."[1]

Claims.

A complete specification must end with a distinct statement of the invention claimed. Act, 1883, sect. 5.

After the invention has been described at length in the specification, and by means of references to the drawings accompanying it, the applicant must state shortly what it is that he claims to have invented. This is done by means of a claiming clause, containing one or more claims, which must define clearly what it is that the patent is meant to protect. These claims are means for warning the public what they must avoid doing if they do not wish to incur the risk of an action for infringement.[2] Claiming clause. Warning the public.

A usual form of preface to the claims is—

"Having now particularly described the nature of my invention, and in what manner the same is to be performed, I declare that what I claim is . . ." Form of clause.

Although the Act of 1883 requires a complete specification to end with a distinct statement of the invention

[1] Simpson *v.* Holliday, 1866, 15 N.R. 340; L.R. 1 H.L. 315, per Ld. Westbury.

[2] Campian *v.* Benyon, 1821, 3 B. & B. 10; Gibson *v.* Brand & Scott, 1841, N.R. 890.

claimed, and it would be the duty of the Comptroller to refuse to accept, or, at any rate, to require the amendment of a specification that did not comply with this requirement, it has happened that a complete specification without any distinct claiming clause has been accepted; and, a patent having been granted, it was held that the omission of a claiming clause did not of itself render the patent invalid.[1]

Absence of claims does not make patent bad.

Where there is a claim for a combination, and the combination is the novelty, the patentee need not point out how far he claims novelty for particular portions;[2] but, where there is only an improvement in some part, the patentee must claim the improvement only and not the whole combination as improved.[3]

Claim for combination.

A claim for new means of bringing about an old result is confined to the actual means described, and does not prevent the same result being attained by other means.[4]

In a patent for an improvement on an existing machine or process the specification must distinguish what is new from what is old;[5] and the claim for an improvement must be strictly confined to the actual improvement described, and must not cover anything known or in use before the date of the patent.[6]

New and old distinguished in claims.

If the claims themselves are not sufficient to distinguish what is new from what is old, this may often be conveniently done by means of what is called a dis-

Disclaiming clauses.

[1] Vickers *v.* Siddell, 1890, H.L. 7 R.P.C. 306.

[2] Harrison *v.* Anderston Foundry Co., 1876, 1 A.C. 574; Proctor *v.* Bennis, 1887, 36 Ch. D. 740, 4 R.P.C. 333.

[3] Perry *v.* Société des Lunetiers, 1896, 13 R.P.C. 664.

[4] Ticket Punch Register Co. *v.* Colley's Patents, Ltd., 1895, C.A. 12 R.P.C. 171; Curtis *v.* Platt, 1863, 3 Ch. D. 135 *n*; Proctor *v.* Bennis, 1887, 36 Ch. D. 740; 4 R.P.C. 333.

[5] Foxwell *v.* Bostock, 1861, 4 De G. J. & S. 313, approved in Kynoch *v.* Webb, 1900, H.L. 17 R.P.C. 100; Holmes *v.* L. & N.W.R. Co., 1852, 12 C.B. 831.

[6] Brown *v.* Jackson, 1895, P.C. [1895], A.C. 446, 12 R.P.C. 311.

claiming clause, which either precedes the claiming clause or is made to form a part of it.

A disclaiming clause usually commences by stating that the applicant knows that certain things have been either done, or proposed to be done, and that he does not claim them, and then he proceeds to state what he does claim.

Often advisable to avoid an anticipation.

If the applicant knows of any machine or process which might be put forward as an anticipation, or if his invention differs but slightly from what is described in some earlier specification or book, he should always insert a disclaimer in his specification; he will thus avoid, or at least considerably lessen, any chance of opposition, and also the danger of getting his patent upset on the ground of its being anticipated.

A disclaimer of something claimed in an earlier patent should follow the words of the claim of the earlier specification, even though it may not specifically refer to it.[1] In many cases there seems no objection to inserting a specific reference to the prior patent, and thus obviating all risk of opposition.

New and old must be distinguished in an improvement, but not in a new combination.

It is necessary to distinguish what is new from what is old only when the invention consists in an improvement on an old machine or process; where the invention consists of a combination, and where the claim is clearly only for a combination, it is not necessary to distinguish what part of the combination (if any) is new from what is old;[2] so that where the claim is for a combination, even though every part be old, there will be no need for a disclaimer.

Act, 1883, sect. 33. Multiple claims.

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

[1] Webster, A.-G., 1899, 17 R.P.C. 123.

[2] Harrison *v.* The Anderston Foundry Co., 1876, 1 App. Cas. 574; see also Proctor *v.* Bennis, 1887, 36 Ch. D. 740; but *cf.* Kynoch *v.* Webb, 1900, H.L. 17 R.P.C. 100.

Redundant claims.

Specifications are frequently loaded with a number of claims, often for exactly the same thing, but expressed in slightly different language. Such repetition should be avoided as much as possible, since it is always a source of danger. Any one claim, if bad, invalidates the patent, and in construing a specification, as in construing any other document, the Court tries to avoid treating any part as mere surplusage, and may attach some distinct meaning to a duplicate claim which will endanger an otherwise good patent.

Frequently one finds claims for mere applications of the invention following the claim for the invention itself. Such claims do not invalidate the patent,[1] but they are unnecessary and useless, always a possible source of danger, and should therefore be avoided.

Claims for subordinate integers in combination.

Since a patent for a new combination may also be made to cover any new parts, or subordinate integers, which form part of the whole combination claimed, a single patent may be made to cover several distinct improvements in a machine, as well as the whole machine, each of these improvements being made the subject of a separate claim. The inventor should be very careful to claim only those parts which are really novel, for, if it should turn out that one or more of these supposed improvements were not new, the whole patent would be invalidated.[2]

Application claims.

In some cases it might be unreasonable to sever claims for parts of a combination from the rest of the invention, and treat them as definite claims for such parts, even if used for an altogether different purpose.[3] If, however, upon a fair construction of a specification,

[1] Pneumatic Tyre Co. *v.* Casswell, 1896, 13 R.P.C. 164; British Dynamite *v.* Krebs, 1879, H.L. 13 R.P.C. 190.

[2] Brunton *v.* Hawkes, 1821, 4 B. & A. 550; Gillett *v.* Wilby, 1839, 1 W.P.C. 270.

[3] Plimpton *v.* Spiller, 1876, Lawson *Pat. Pract.*, 497; British Dynamite *v.* Krebs, 1879, H.L. 13 R.P.C. 190.

it claims matters that are not new, effect must be given to it, and it must not receive a forced construction on the ground that it was foolish or suicidal of the patentee to claim something that was old.[1]

Claims for the use of parts of a combination which, though new so far as the application is concerned, are not new in themselves, are thus useless and dangerous, since, if they should be held to be claims for subordinate integers, they would invalidate the patent,[2] while at the best they do not give the patentee anything which he has not already obtained in his principal claim.

A subordinate claim is usually taken to apply to the subject-matter of the main invention, and the Court will not make any forced construction of the specification so as to extend the claim of the patentee to a wider range than the facts would warrant by including things in such general use that the patentee must have known that they were old.[3]

Importance of wording of claims.

The proper framing of claims and of any necessary disclaimer is a matter of the utmost importance, as upon them the value, and it may be the very existence, of the patent depends.

Especially in the case of a master or pioneer invention must the greatest care be exercised; if the claim be too wide the patent may be bad as claiming a principle, and a claim for every method of carrying out an invention would bring it into this category;[4] if, on the other hand, the claim be too narrow, the patent may be utterly worthless, because its evasion is thereby rendered easy. The real invention may be the result, and, if this be the case, care must be taken not to lay too much stress on

[1] Kynoch *v.* Webb, 1900, H.L. 17 R.P.C. 100, per Ld. Davey.

[2] The Electric Construction Co *v.* Imperial Tramways Co., 1900, C.A. 17 R.P.C. 536; Tubes *v.* Perfecta Seamless Steel Tube Co., 1901, C.A. 18 R.P.C. 339, rev. by H.L.

[3] Haworth *v.* Hardcastle, 1834, 1 Webs. 484, quoted by Halsbury, L.C., in Tubes *v.* Perfecta Seamless Steel Tube Co., 1903, H.L. 20 R.P.C. 77, 97.

[4] Neilson *v.* Harford, 1841, 1 W.P.C. 355.

the means for attaining it, or the use of what are really equivalent means may be rendered possible. In other cases the exclusion of all that is old and the inclusion of all that is new is the object, and a knowledge of what has been already done and of the existing state of public knowledge on the subject is essential.

It may, perhaps, be better to claim too much than too little, as a wide claim can always be made narrower by amendment, while a narrow claim cannot possibly be enlarged. Amendment is, however, a somewhat tedious process, besides being a matter of additional expense; and, further, wherever it is necessary, all damages from infringements committed prior to amendment must be regarded as irrecoverable.

CHAPTER VI.

OPPOSITION TO THE GRANT OF A PATENT.

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

Act, 1883, sect. 11. Notice of grounds for opposition.

Act, 1888, sect. 4.

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

Act, 1883, sect. 11. Notice to applicant.

"(3) The law officer shall, if required, hear the applicant, and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

Appeal to law officer.

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

Law officer may employ expert.

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

Rule 32.

See App. A.

First ground of opposition.

The Comptroller may allow an unsigned notice to be signed subsequently.[1]

Under the first ground of opposition the obtaining must have been within the United Kingdom. There need not be any fraud in the obtaining of the invention from the opponent, but, of course, in some cases there may have been fraud, and in such cases evidence of the fraud should be given before the Comptroller, since, if no evidence of fraud is given before the Comptroller, it will not be possible to introduce the subject before the law officer.[2]

Who may oppose.

The opponent on this ground must be the actual person from whom the applicant obtained the invention, or his legal representative.[3] This latter term appears to apply only to the legal personal representative of a deceased person, who, as we have seen, has much the same rights, so far as the inventions of such person are concerned, as the inventor himself would have had if he had lived.

Thus, this ground is practically confined to persons who could themselves have properly applied for the patent which they are opposing.

Rule 33. Evidence as to the obtaining must be given.

"Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within fourteen days after the expiration of the two months from the date of the advertisement of the acceptance of the applicant's complete specification, the opposition shall be deemed to be abandoned."

See p. 49.

Rule 34. Attendance of declarant on Comptroller.

"Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, the Comptroller may request or allow any

[1] *Re* Codd, 1884, Griff. 305.
[2] *Re* Bairstow, 1888, 5 R.P.C. 286.
[3] *Re* Edmunds, 1888, Griff. 281.

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

Where the opponent proves that the applicant obtained a substantial part of his invention from him, but the applicant has also made improvements of merit, the patent may be sealed, subject to an agreement being filed at the Patent Office for securing to the opponent the full rights of a joint patentee;[1] or the patent may be sealed to the applicant and opponent as joint inventors.[2]

Second ground of opposition.

The second ground of opposition is "that the invention has been patented in this country on an application of prior date".

Rule 35. Number and date of prior patent required.

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

Prior patent need not be actually sealed.

The prior patent need not have been actually sealed, but the complete specification must have been accepted; and it does not matter whether the prior patent is an existing or an expired patent.[3]

It was at one time thought that it was not material whether the prior patent relied on in an opposition was valid or invalid,[4] but this is not a correct view of the law, since an invalid grant does not necessarily defeat a grant made on a subsequent application.[5]

Who may oppose.

Notwithstanding the somewhat general words of the Act that "any person may give notice of opposition,"

[1] *Re* Luke, 1886, Griff. 294.
[2] *Re* Eadie, 1885, Griff. 279.
[3] *Re* Lancaster, 1884, Griff. 293; *re* Glossop, 1884, Griff. 285.
[4] *Re* Thornborough & Wilks, 1896, S.-G. 13 R.P.C. 115.
[5] Mica Insulator Co. *v.* Electrical Co., 1898, 15 R.P.C. 489.

the class of persons who are able to oppose on the second ground has been restricted by the law officers, through the exercise of their discretionary power of determining whether any person is entitled to be heard in opposition. The Comptroller is bound to hear only such persons as would be entitled to be heard by the law officer,[1] so that it is useless for any one to give notice of opposition unless he can bring himself within the prescribed limits.

Opponent must be interested in prior patent.

"The only class of persons who are entitled to be heard in opposition before the law officer are persons who are interested with a legitimate and real interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it."[2]

A person who had owned an expired patent and has worked under it is entitled to oppose,[3] and though it was formerly held that the mere fact of manufacturing under an expired patent gave no *locus standi*,[4] this is no longer the rule. It is now the rule that a *bona fide* attempt to carry out the invention sought to be protected by a person who desires to oppose the grant, and proof that he may be damnified by the application which he desires to oppose, entitles such person to oppose the grant.[5]

A licencee under a prior patent may be heard in opposition.[6]

An opponent with a *locus standi* under the second head may oppose on the ground of the existence of other patents in which he is not interested,[7] but a person

[1] Registrar *v.* Comptroller-General, *e. p.* Tomlinson, C.A. [1899], 1 Q.B. 909; 16 R.P.C. 233.

[2] *Re* Heath & Frost, 1886, Griff. 311.

[3] *Re* Glossop, 1884, Griff. 285, approved *re* Nahnsen, 1900, A.-G. 17 R.P C. 203.

[4] *Re* Macevoy, 1880, 5 R.P.C. 285.

[5] *Re* Meyer, 1899, A.-G. 16 R.P.C. 526.

[6] *Re* Hill, 1888, 5 R.P.C. 599.

[7] *Re* Stewart, 1896, A.-G. 13 R.P.C. 629.

opposing on the first ground may not also allege a prior patent in which he is not interested.[1]

An opponent who desires his prior patent to be construed as a master patent for a pioneer invention, must give evidence before the Comptroller as to the state of public knowledge concerning the subject-matter of his invention at the date of his application.[2]

Questions of mechanical equivalents may be considered in deciding an opposition on the ground of a prior grant for the same invention.[3]

Third ground of opposition.

The last ground of opposition was introduced in 1888 to meet the danger of an earlier applicant stealing his invention from a later applicant, who had either filed a complete specification or otherwise published his invention during the term of the earlier applicant's provisional protection.

Evidence before Comptroller.

The evidence used before the Comptroller must be given by statutory declaration or affidavit.

Care should be taken that statutory declarations filed in the Patent Office are confined to matter relevant to the issue.[4]

Statutory Declarations and Affidavits.

Form, etc., of statutory declaration and affidavit. Rule 25.

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

[1] J. & G.'s application, 1902, S.-G. 19 R.P.C. 555.

[2] *Re* Southwell & Head, 1899, A.-G. 16 R.P.C. 361.

[3] *Re* Ambrose Hudd Smith, 1896, A.-G. 13 R.P.C. 200.

[4] Official notice by Comptroller, 19th Jan., 1895, *re* Brand, 1895, S.-G., 12 R.P.C. 102; see P.R. 11, 17 and 17A.

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. Rule 26.

"The statutory declarations and affidavits required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

"(*a*) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

"(*b*) In any other part of His Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

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

Opponent's evidence. Rule 36.

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

Applicant's evidence. Rule 37.

"Within fourteen days from the delivery of such copies, the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent copies thereof, and within fourteen days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and

Evidence in reply.

on so leaving shall deliver to the applicant copies thereof. Such last-mentioned declarations shall be confined to matters strictly in reply."

Applicant's evidence if opponent does not leave statutory declarations. Rule 38.

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

Opponent's evidence. Rule 39.

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

Evidence in reply.

Closing of evidence. Rule 40.

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

Hearing. Rule 41.

"On completion of the evidence (if any), or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If either party does not desire to be heard, he shall, as soon as possible, notify the Comptroller to that effect. If either party desires to be heard he must leave Form E at the Patent Office. The Comptroller may refuse to hear either party who has not left Form E prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory declaration already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he

See App. A.

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."

A patent, the grant of which is opposed, may be sealed with a claim entirely different from that originally made;[1] but an applicant whose claim, as originally drawn, is anticipated by the patent relied on by the opponent, will not be allowed to amend his claim by substituting claims for other distinctive matter contained in the specification.[2]

Appeals to law officer.

From the decision of the Comptroller an appeal lies to the law officer; the procedure on appeal in an opposition, either to a grant or to an amendment, is the same, and is dealt with in a separate chapter (chapter xi.).

The hearing before the law officer is by way of rehearing, and *viva voce* evidence may be given, so that the witnesses may be cross-examined.

When opposition is likely to succeed.

In order to actually prevent a patent being sealed, it is necessary for the opponent to have an extremely strong case. If the grant is refused, the applicant is left entirely without remedy; while, if the patent is sealed, it is always open to impeachment in the Courts, and if proved to have been wrongly sealed it can always be revoked; it is, therefore, comparatively seldom that the grant is wholly refused.

A patent has been refused for putting together a combination of old parts in which each is applied only to its old purpose.[3]

A patent for a particular mixture will not be stopped because such mixture may be covered by a general claim in a prior patent.[4]

[1] Per Sir E. Carson, S.-G., Harrild & Parkin's application, 1900, 17 R.P.C. 617.

[2] Mill's application, Sir E. Carson, S.-G., 1901, 18 R.P.C. 322.

[3] Bridge's application, Sir E. Carson, S.-G., 1901, 18 R.P.C. 257.

[4] *Re* Nahnsen, 1900, A.-G. 17 R.P.C. 203.

A patent will not be stopped on general grounds of want of novelty, and where there is a strongly controverted question of scientific anticipation the patent will be granted.[1] General grounds of anticipation insufficient.

The following rule has been laid down as a general guide on the question of refusing a grant, viz., that the issue of a patent should be refused by the officer only if, having examined the evidence, he is so clearly of opinion that the opponent has made out his case, that he would, if a jury were to find in favour of the applicant, refuse to accept it, and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence.[2] Rule for refusing a grant.

As a general rule an opposition is entered, not so much for the purpose of stopping the patent as for forcing the applicant to make an amendment, by way of disclaimer, of something in which the opponent is interested. Disclaimer may be ordered.

Disclaimers are of two kinds, specific and general.

In a specific disclaimer the applicant mentions some prior patent, and states that he does not claim anything described therein, or something to that effect. Varieties of disclaimer.

A specific disclaimer will be required only in very special cases where the prior patent is a master patent, or the later invention is simply a modification of the earlier one. If the applicant can prove that there was any public knowledge on the subject of the application at the date of the prior application, he will, as a rule, be compelled to insert only a general disclaimer, not mentioning the prior patent, but only disclaiming what had been before claimed. Such disclaimer may be ordered to be made in the terms of the claim of a prior patent without a specific reference thereto.[3]

To obtain a specific disclaimer the opponent must

[1] *Re* Nahnsen, 1900, A.-G. 17 R.P.C. 203; *re* Lake, 1889, 6 R.P.C. 550.
[2] *Re* Stuart, 1892, 9 R.P.C. 452.
[3] *Re* Newton, 1900, A.-G. 17 R.P.C. 123.

give evidence of the state of public knowledge in order to get his patent construed as a master patent.[1]

Re-opening an opposition.

When an opposition has been disposed of, it can only be reopened under very special circumstances. The mere fact that the opponent wishes to withdraw his opposition is not sufficient.[2]

Collusive Opposition.

It has sometimes happened that an opposition has been entered simply to delay the sealing of a patent, in *view of obtaining priority of time in the sealing of* foreign patents. The sealing of a patent must be completed within fifteen months from the date of the application; except where the sealing is delayed by an appeal to the law officer, or by opposition to the grant, in which case the law officer may extend the time for sealing. Proceedings in opposition, especially if followed by an appeal to the law officer, may take a considerable time, and if the Comptroller or the law officer has any suspicion that the opposition is not *bona fide*, but is for the purpose of delay, the time for sealing will not be extended unless the applicant can clearly prove the absence of any collusion in the opposition. Such a collusive opposition is an abuse of the process of the Patent Office, and any patent agent who assists in such an abuse will be reported to the Board of Trade,[3] while the law officer will not give directions for sealing the patent out of time, and consequently the patent will be lost.[4]

[1] *Re* Southwell & Head, 1899, A.-G. 16 R.P.C. 361.
[2] *Re* Thomas & Prevost, 1898, S.-G. 15 R.P.C. 257.
[3] A. & B.'s application, 1902, S.-G. 19 R.P.C. 403.
[4] A. & B.'s application, 1902, S.-G. 19 R.P.C. 556

CHAPTER VII.

KEEPING UP A PATENT.

When a patent has been sealed the applicant becomes the patentee, and in all matters connected with the patent the patentee is the person concerned.

Patentee defined. Sect. 46.

The Act of 1883 defines the "patentee" as the person, for the time being, entitled to the benefit of the patent. Thus, if a patentee assigns his patent to any person or persons (including corporations), he ceases at once to be patentee, and the assignee or assignees become patentee or patentees in their turn. Now, as any act or thing which may be required to be done in connection with a patent is always left to the patentee, it must be remembered that in all that follows relating to patents the patentee for the time being, and not the original patentee, is referred to under the term "patentee".

Term of patent. Act, 1883, sect. 17.

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

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

Fees must be paid to keep patent in force.

The fees of £1 and £3, paid with the application and complete specification, and the further fee, if any, paid on sealing under section 1 of the Act of 1902, keep the patent in force until the expiration of the fourth year from the date of the application.

The fees payable in respect of a patent, and the manner of payment of such fees, are regulated by the

Fees, how fixed. Act, 1883, sect. 24.

Board of Trade, and they have been altered from time to time by that authority. The present scale of fees, with the times of payment, will be found at pp. 257, 258.

Payment of fees for continuance of patent. Rule 66.

"If a patentee intends, at the expiration of the fourth year from the date of his patent, to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance."

See App. A.

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

Date for payment of renewal fees.

The latest day for payment of a renewal fee in any year is the date for which the patent was sealed, that is, in ordinary cases the date on which the application for the patent was made.

Act, 1883, sect. 98.

This must be sent to the Patent Office so as to be received before midnight on the day on which the payment falls due, unless that day should fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving. These are called excluded days, and a payment due on an excluded day may be made up to midnight on the day next following such excluded day, or days, if two or more of them occur consecutively.

Payment by post. Act, 1883, sect. 97.

Payment may be made by prepaid letter through the post, and if so made will be deemed to have been made at the time when the letter containing the same would be delivered in the ordinary course of post. It is thus sufficient to prove that the letter was properly addressed, prepaid and put into the post, even though it should never reach the Patent Office. It will be seen that there is no distinction between inland and foreign post.

Enlargement of time for payment.

If payment be not made in time, the time may be extended for not more than three months on payment of a fine. The Act of 1883 provides as follows:—

"If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the Comptroller for an enlargement of the time for making that payment. Sect. 17 (3).

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

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

"(*b*) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement." No damage for infringements during enlargement of time.

"An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement." Patentee must show why fee was not paid in time. Rule 67.

"On due compliance with the terms of rule 66, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively, duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made." Certificate of payment. Rule 68.

Application for enlargement of the time for payment of a renewal fee must be made on Patent Form K, duly stamped. The fees are £3, £7 and £10 for enlargements of one, two or three months respectively. See App. A.

CHAPTER VIII.

RIGHTS AND OBLIGATIONS OF PATENTEE.

SUBJECT to the due payment of the fees as they become due, the patent gives protection for fourteen years from the date of application, and the legal position of a patentee that is the owner of a patent, whether a grantee or an assignee, will now be briefly considered.

Range of patent. Act, 1883, sect. 16.

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

An English patent does not extend to the Channel Islands, nor to any colony or foreign possession; for these separate patents must be obtained as for foreign countries.

Assignment of patent. Act, 1883, sect. 36.

"A patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man as effectually as if the patent were originally granted to extend to that place or part only."

Thus a patent may be assigned for any limited area.[1] And, of course, it may be assigned for the whole of the United Kingdom and Isle of Man.

Assignment must be by deed.

A patent is personal property, but an assignment must be by deed; in order to be effectual it must be duly stamped and registered at the Patent Office; and from the date of such registration the assignee, whether of part or of the whole of the patent, takes, so far as what is assigned to him is concerned, the place of the assignor. If the patent is assigned for any part of the

[1] Actien Gesellschaft v. Temler, 1900, 18 R.P.C. 6.

kingdom the assignee becomes the patentee for that part, with all the rights of a patentee, so far as his district is concerned.

Assignee becomes patentee.

When a person sells a patent, he must, of course, warrant that he has a good title to sell it; but he sells it for what it is, and does not by so selling it in any way warrant its validity.[1] The same is true in the case of a contract to sell, so that the vendor can maintain an action for the purchase money, even though the patent turn out to be invalid.[2] A sale may, of course, be subject to a covenant on the part of the vendor to hold himself responsible if the patent should be declared bad, but this is exceptional, and usually *caveat emptor* is the rule.[3]

Assignor does not warrant validity.

It is sometimes made a term of a contract for sale that the vendor or assignee should litigate the patent usually to a final judgment or settlement, and in such case the condition is not fulfilled so long as an appeal is pending.

On the sale of a patent the vendor often agrees to assign any improvements and any patents granted to him therefor, and such an agreement is perfectly valid.[4] For forms of assignment, see Appendix B.

Future patent rights.

On referring to the form of grant it will be seen that the Crown doth by the letters patent—

What is granted to the patentee.

See p. 7.

"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 licencees, and no others, may at all times hereafter during the terms 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".

[1] Monforts *v.* Marsden, 1895, 12 R.P.C. 266.

[2] Hall *v.* Condor, 1857, 2 C.B.N.S. 22; Smith *v.* Scott, 1859, 6 C.B.N.S. 771: *cf.* Cutler *v.* Bower, 1847, 11 Q.B. 973.

[3] Commercial Development Corporation *v.* Atkins & Applegarth; Atkins *v.* Castner-Kellner Alkali Co., 1902, C.A. 19 R.P.C. 93.

[4] Printing, etc., Co. *v.* Sampson, L.R. 19 Eq. 462; Pneumatic Tyre Co. *v.* Dunlop, 1896, 13 R.P.C. 553.

Patentee has a monopoly.

This gives to the patentee a monopoly of the invention for the term of the patent, that is, he may, during that time, make and sell the patented article at his own price without any risk of lawful competition, and he may also sell or supply the article subject to any conditions as to the manner or locality in which it may be used.[1]

May sell subject to conditions as to user,

but must give notice of restrictions before sale.

If the patentee wishes to restrict the manner in which the patented article may be used, clear notice of the restriction must be given to the purchaser before the article is sold;[2] for, when an article is sold without any restriction on the buyer, the sale gives an absolute right as against the seller to use the article in any way the buyer may think fit. This will include using or selling the article in any country where the vendor owns a patent for the article at the time of sale.[3]

Co-owners of a patent.

We have seen that a patent may be granted to several persons jointly; and even if originally granted to a single person the grantee may assign it to more than one person, and thus several persons may become co-owners, or, as they may then be called, co-patentees, and this either as joint owners or as owners in common.

A co-owner can work invention alone.

When there are several co-owners of a patent, each of them is at liberty, unless he is bound by some agreement to the contrary, to work the patent on his own account; he can manufacture and sell articles made under it without the consent of his co-owners, and, in the absence of any agreement to the contrary, he need not account to them for any profits which he may so make.[4]

Where a patent is partnership property, though granted to one of the partners, neither partner can assign it without the consent of the other; but, on a dissolution,

[1] Incandescent Gas Light Co. v. Brogden, 1899, 16 R.P.C. 179.

[2] Incandescent Gas Light Co. v. Cantelo, 1895, 12 R.P.C. 262.

[3] Société Anonyme de Glaces v. Tilghman's Sand Blast Co., 1883, 25 Ch. D. 1.

[4] Steers v. Rogers, 1893, H.L. 10 R.P.C. 245.

each will, in the absence of any agreement thereon, be entitled to work under the patent for his own benefit.[1]

Whether joint owner can grant licences on his own account.

Whether the part-owner of a patent can grant licences and receive royalties without accounting to his co-owners for the sums so received, does not appear to have ever been decided.[2] A co-owner can, however, sell a part of his share, and the purchaser will then be entitled to work the patent on his own account. As the price of such a share might be paid in the form of an annuity, and thus might practically amount to a royalty, there really seems no reason why the vendor should not also have power to grant a licence.

Joint owner may sell part of his share.

Persons not owners entitled to benefit.

Besides joint owners, there may be persons who, though they are not owners, are entitled to share in the profits of the patent; thus, an owner may assign a share of the profits while remaining sole proprietor. In such a case the assignee of profits can claim an account from a licencee; but the account must be taken in the presence of the assignor and of all persons interested, so as to bind them.[3]

Accounts of licencees where joint owners.

Licencees.

The use in the grant of the word "licencees" implies that not only may the patentee by himself and his agents work his invention, but that he may license others to do so, and this is often the most valuable right attaching to the possession of a patent. The subject of licences is considered further in chapter ix.

The grant continues:—

See p. 8.

Infringement forbidden.

"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 any wise 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,

[1] Kenny's Buttonholing Co. *v.* Somerville, 26 W.R. 787.
[2] Mathers *v.* Green, 1865, L.R. 1 Ch. 29.
[3] Bergmann *v.* Macmillan, 1881, 17 Ch. D. 423.

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."

Liability of infringers.

If any person breaks this royal command he is said to have infringed the patentee's monopoly, and the patentee is entitled to bring against such person an action for infringement to restrain future breaches and to recover damages in respect of past offences. The subject of actions for infringement is dealt with later. If any

Threatened infringements.

person threatens to infringe the patentee's monopoly without actually doing so, the patentee may bring an action against such person to prevent him from carrying his threat into execution.[1] For the consideration of what amounts to infringement, see chapter xiii.

Threats.

Besides bringing actions against infringers a patentee may endeavour to prevent infringements taking place by frightening intending infringers with threats of actions, and this right of threatening is often extremely effective, as the costs of a patent action are almost invariably very great for both parties, whichever side may ultimately be successful.

This question is dealt with in chapter xvi.

The Act of 1883 provides that—

Patent binds the Crown. Act, 1883, sect. 27 (1).

"A patent shall have to all intents the like effect as against His Majesty the King, his heirs and successors, as it has against a subject."

But in cases where the Crown is concerned the patentee has not the same freedom as to the terms on which his invention shall be used as he has generally. It will be seen that, by the terms of the grant,—

Patentee must supply articles for public service.

"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."

[1] Frearson v. Loe, 1878, 9 Ch. D. 65.

And the Act of 1883 provides that—

"The officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee; or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested." Sect. 27 (2). Terms on which Crown may use invention.

By the grant of letters patent for an invention the Crown is not in any way bound to admit their validity. If any department should make use of the invention, such use will very probably be without any agreement with the patentee, and the patentee must take some action to obtain any compensation to which he may consider himself entitled. Crown need not admit validity.

If he believes that any department is using, or intends to use, his invention, he should write to that department pointing out what his patent is for, and inquiring whether they wish to use his invention. He should also ask, in the event of their admitting user of his invention, that they should come to an agreement with him as to the terms upon which they are to use it. Procedure if Crown infringes.

If they admit the fact of user, and do not dispute the validity of his patent, but fail to come to terms with him, he should apply to the Treasury to settle the terms.

If they deny user, or deny the validity of his patent, he should apply to the Treasury to nominate some person against whom he may bring any action he may be advised to bring, and who shall defend on behalf of the Crown.[1] Where Crown disputes validity.

This course has been adopted more than once, and has proved very satisfactory, as it enables all matters in dispute to be determined in an ordinary action for infringement; if it were not adopted, the patentee would have to proceed by way of a petition of right.

[1] Maxim-Nordenfelt *v.* Anderson, 1897, 14 R.P.C. 371; Nobel's Explosives Co. *v.* Anderson, 1894, 11 R.P.C. 115.

Patentee has full inspection.

The patentee will be allowed full inspection of what the department is actually doing, so as to be able to establish the fact of infringement, if such should really exist.

Procedure when validity is established.

When the validity of the patent and the fact of infringement have been established in any action that may be taken by the patentee against the nominee of the Treasury, he should again apply to the department to agree upon the terms on which the invention shall be used, and, in default of their coming to an agreement with him, he must apply to the Treasury to fix the terms.

The Act of 1883 provides that--

Use of invention on foreign vessels. Sect. 43.

"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.

Provision must be mutual.

"But this section shall not extend to vessels of any foreign state of which the laws authorise subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state."

Reasonable requirements of the public.

There is another condition attached to the grant of a patent, which, though never formulated, probably existed at common law, and which now attaches under the provisions of the Patent Act, 1902. The grant of a patent for a monopoly, being an exercise of the royal prerogative, could not be made to the detriment of any of the subjects of the Crown. The grant itself recites that it is made because the Crown is willing to encourage all inventions which may be for the public good, and this recital seems to imply that there has been a representation to the Crown that it will be for the public good to grant the particular patent containing the recital. Now, if the result of granting the monopoly is that the

reasonable requirements of the public, whatever they may be, are not satisfied, it seems clear that the grant is not for the public good, and that, therefore, in making it the Crown has not done what it intended to do, with the result that the grant is bad in law.[1] Reasonable requirements of the public.

In order to render the grant bad in law on this ground, it would, perhaps, be necessary to prove that the applicant, when he applied for the grant, intended to use it in a manner contrary to the public good, and the mere user itself might not be sufficient to enable a court of law to find that the Crown had been deceived. Thus, in an action for infringement it might be very difficult for the defendant to succeed on the above ground, and the defence does not appear to have ever been put forward.

The Statute of Monopolies does not allow validity to any monopoly, even one granted to a true and first inventor, which is contrary to law or mischievous to the State by raising prices of commodities at home, or hurt of trade, or which is generally inconvenient; but as this statute is merely declaratory of the common law, it does not carry the matter any further. It will be seen, however, that one of the conditions of the grant itself is that it shall determine and be void, to all intents and purposes, if at any time it shall be made to appear to six or more members of the Privy Council that the grant is prejudicial or inconvenient to the subjects in general.

This condition appears to cover the case of a grant becoming prejudicial or inconvenient by reason of the way in which it is used, as well as that of a grant which was void *ab initio*. By section 2 of the Statute of Monopolies the force and validity of every patent is to be tried by a court of law, and the words in the grant giving power to the Privy Council to determine a patent may have been regarded, perhaps wrongly, as having no effect.

[1] Alton Woods' case, 1600, Coke, 1 Rep. 40*b* *vide* 46*a*.

Reasonable requirements of the public.

The words themselves are a relic of times previous to the Statute of Monopolies, and it does not appear that since the passing of the statute any application has been made to the Privy Council to terminate a grant; but the evil of user for the sole benefit of the foreign producer is one of comparatively modern growth, and there seems no reason why, to remedy this evil in any case, a petition at common law should not lie to the Privy Council to enforce the condition of the grant that it should not be prejudicial or inconvenient to the subjects in general.

There is now a statutory right to apply to the Privy Council, under certain circumstances, to revoke a patent on the ground of misuser, which may be regarded as giving effect to the ancient condition.

Revocation for non-user.

The Act of 1883 made provision, by section 22, for the granting, under certain conditions, of a compulsory licence, the Board of Trade being the body charged with carrying this part of the Act into effect. During recent years there have been several applications under that section, some of which have succeeded and some of which have failed. There was, however, no statutory power to revoke a patent where the grant of a licence was an insufficient remedy, though, as the terms on which licences might be granted were not restricted, and only a nominal royalty need have been reserved, the absence of the more summary method of relief was probably not of very great consequence. There was one great objection, however, to the old procedure, namely, that the successful party had to bear its own costs, the Board having no power over costs. Section 22 of the old Act has now been repealed by the Patents Act, 1902, and by the same Act fresh provision has been made for the granting of compulsory licences, the Judicial Committee of the Privy Council being substituted for the Board of Trade as the tribunal, and full power being given to it to deal with the costs of the proceedings.

An applicant for a compulsory licence may now, in

the alternative, ask for the revocation of the patent; but an order for revocation cannot be made within three years from the date of the patent, nor unless the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences.

This question is dealt with further in chapter xxv.

Design of Patent Article.

The fact that an article is the subject-matter of an application for a patent does not affect the registrability of its design.[1]

[1] Werner *v.* Gamage, 1903, 21 R.P.C. 137.

CHAPTER IX.

LICENCES.

See p. 8.

THE letters patent provide that the patentee by himself, his agents or licencees, and no others, may, etc., and go on to forbid any person using the invention without the consent, licence or agreement of the patentee in writing under his hand and seal. Later on it is provided that nothing in the grant shall prevent the granting of licences in such manner and for such considerations as they may by law be granted.

Patentee may grant licences.

This shows that the patentee may grant licences to others to use his invention. From the earlier part it would appear that a licence, to be effective, must be in writing under the hand and seal of the patentee; but,

A licence should be by deed,

on the other hand, the last proviso makes the power of granting licences very considerably wider. When the patentee sells a patented article to any one unconditionally, he thereby impliedly licenses the use of that article, so that it seems clear that in some circumstances even a parol licence can be good. If a licence be granted not under seal, the Courts will enforce it against the licencee, since "to grant a licence not under seal may be a contempt of the Crown, but does not exempt the man to whom it is granted, and who derives a benefit from it, from paying the price of it".[1]

but one not under seal will be enforceable.

A parol licence is *prima facie* revocable,[2] but the

[1] Per Baron Alderson, Chanter v. Dewhurst and another, 1844, 12 M. & W. 823.

[2] Coppin v. Lloyd, 1898, Channel, J., 15 R.P.C. 373.

presumption of revocability may be easily rebutted. For instance, the unconditional purchase of a patented machine from the patentee confers on the purchaser the right to use the machine for his own advantage, in any way he may think fit, and the patentee has no power to put an end to this right, which, as has been already said, is tantamount to a parol licence.[1]

Licence by correspondence.

Correspondence containing the main terms of a licence, forming part of negotiations for a formal licence which was never granted, followed by the payment of royalties, constitutes a binding licence.[2]

Licences under seal.

A licence under seal may either be delivered, in which case it becomes a deed, or it may be under seal without delivery, in which case it is not a deed,[3] and does not appear to be subject to any stamp duty. An agreement to grant a licence is enforceable in equity, and for many purposes as good as a licence.[4]

Rights of licencees.

There may be a valid licence to construct a machine without any right of using it when made;[5] and if a patented article be sold with an express limitation as to the manner in which it may be used, any user beyond that so limited will subject the purchaser to the penalties of an infringer.[6] So also a person licensed only to make articles of a particular description becomes an infringer if he goes beyond his licence.[7]

Unless specially required by his licence, a licencee is not bound to complete the article made under the licence before selling it; he may leave the purchaser to complete it ready for use.[8]

Unless there be an express provision to the contrary.

[1] Incandescent Gas Light Co. *v.* Cantelo, 1895, 12 R.P.C. 262.
[2] Tweedale *v.* Ashworth, 1896, 13 R.P.C. 522.
[3] Chanter *v.* Johnson, 1845, 14 M. & W. 411.
[4] Postcard Automatic Supply Co. *v.* Samuel, 1889, 6 R.P.C. 562.
[5] Basset *v.* Graydon, 1897, H.L. 14 R.P.C. 701.
[6] Incandescent Gas Light Co. *v.* Brogden, 1899, 16 R.P.C. 179.
[7] Société Anonyme, etc., *v.* Midland Lighting Co., 1897, 14 R.P.C. 419
[8] Dunlop Pneumatic Tyre Co. *v.* Cresswell, 1901, 18 R.P.C. 473.

a licence to manufacture implies a licence to use or sell, and the purchaser from a licencee has all the privileges of a purchaser, including that of being entitled to resell.[1]

The rights of a licencee under his licence, like those of the patentee under his patent, are local, and where patents for more than one country are owned by the same patentee, the fact that an article is made in one country, under licence from him, does not authorise its sale in any other country for which he may have patent rights. Thus, an English patent is infringed by the sale in England of an article made abroad by a licencee under a foreign patent.[2]

Time for granting.

A licence may be granted even before the complete specification is filed.[3]

Licences by co-owners.

In the absence of agreement to the contrary, each of two or more co-owners of a patent has power to make use of the invention, for his own advantage, without accounting to the others for any profits he may make thereby.[4] This applies equally in the case of original patentees, who are at law joint owners of the patent,[5] and in that of persons who are owners in common.

Now, if a part-owner of a patent can sell an article made under it, he can impliedly license the purchaser to use the article he has purchased; and if a part-owner of a patent can thus grant an implied licence under it, there seems no reason why he should not be able to grant any other kind of licence without the consent of his co-owners. The grant of a licence by a part-owner of a patent seems, indeed, somewhat analogous to the grant of a lease of mining rights by a part-owner of

[1] Thomas *v.* Hunt, 1864, 17 C.B.N.S. 183.

[2] Société Anonyme, etc., *v.* Tiljhman, 1883, C.A. 25 C.D. 1; 53 L.J. Ch. 1.

[3] Otto *v.* Singer, 1890, 7 R.P.C. 7.

[4] Henderson *v.* Eason, 1852, 17 Q.B. 701; 21 L.J. Q.B. 82; but see Leake *v.* Cordeaux, 1856, 4 W.R. 806.

[5] National Company for the Distribution of Electricity *v.* Gibbs [1899], 2 Ch. 289.

mineral property, and such a lease is undoubtedly valid.[1] It is not, however, clear what is the position of the part-owner of a patent who has granted a licence, and of his licences, with regard to any royalties that may have been reserved. It has been suggested, but not decided, that the part-owner would have to account to his co-owners for their shares in such royalties,[2] and, by analogy with the position of co-owners of other property, this would be the case.[3] It may be, however, that the licencee of a part-owner would be liable to account to the co-owners for the profits made by him on the share attributable to such co-owners, of any articles made or sold by him under the patent,[4] paying royalty to his licensor only on the share attributable to him.

A licencee is entitled to have an account of royalties due from him taken in the presence of all parties interested.[5]

Licence usually reserves royalty.

A licence may be granted wholly or partly in consideration of a lump sum, but it is more usual to reserve a royalty, either fixed or varying.

Effect of declaration of invalidity on royalty.

When royalties are reserved, it is generally stipulated that, if at any time the patent shall be declared invalid, the payment of royalties shall cease; but in such a case a declaration of invalidity, that is reversed on appeal, even by consent, does not affect the licence.[6] If this be not stipulated for by the licencee, a declaration of invalidity will not affect the payment of royalty, at least until the patent be revoked; and, in case of the licence being for a fixed term, the licencee may be bound to pay the royalties during that term, notwithstanding the revocation of the patent.[7] A sum paid as royalty under

[1] Hexter *v.* Pearce [1900], 1 Ch. 341.

[2] Mathers *v.* Green, 1865, 1 Ch. 29.

[3] Henderson *v.* Eason, 1852, 17 Q.B. 701; see also 4 Anne, c. 16 s. 27.

[4] Job *v.* Potton, 1875, L.R. 20 Eq. 84; 44 L.J. Ch. 262.

[5] Bergmann *v.* Macmillan, 1881, 17 Ch. D. 423.

[6] Cheetham *v.* Nuthall, 1893, 10 R.P.C. 321.

[7] African Gold Recovery Co. *v.* Sheba Gold Mining Co., 1897, 14 R.P.C. 660.

an invalid patent, which has not been revoked, cannot be recovered from the patentee[1] unless there has been fraud.[2]

Term of licence. Licence by deed, when irrevocable.

A licence is very usually granted for the remainder of the term of the patent and any extension thereof; and in such a case, if it be under seal, it cannot be revoked by the licensor.[3] It may, however, be for a shorter definite period, or it may be for an indefinite time; in the last case, unless the licence required some definite notice to be given, it would, like a mere parol licence,[4] be revocable at any time by the licensor.[5]

Licence for indefinite term is revocable.

Licence does not warrant validity.

The grant of a licence does not impliedly warrant that the patent is valid, nor that in working under such licence the licencee does not infringe an earlier patent.[6]

Licensor's duty to keep up patent.

There is no implied warranty, on the part of the patentee, in granting a licence, even though it be an exclusive licence, that he will keep up the patent by paying the necessary fees; and if the licencee covenant to pay royalties for a fixed term they will be payable, even though the patent be allowed to lapse.[7] If, however, the licensor has agreed to protect and defend the patent from infringements, and the licence provides for the cessation of royalties in default thereof, the licensor is bound to keep up the patent, and any royalty paid after lapse of the patent, and in ignorance thereof, is recoverable by the licencee as money paid under a mistake of fact.[8]

Licencee may not dispute validity.

A licencee under a patent is, during the continuance of the licence, estopped from disputing the validity of the patent, and, while he is paying royalties, is not at

[1] Taylor *v.* Hare, 1805, 1 W.P.C. 292.

[2] Lovell *v.* Hicks, 5 L.J. (N.S.), Ex. Eq. 101.

[3] Guyot *v.* Thomson, 1894, 11 R.P.C. 541.

[4] Coppin *v.* Lloyd, 1898, 15 R.P.C. 373.

[5] Wood *v.* Leadbitter, 1845, 13 M. & W. 845; *vide* also Newby *v.* Harrison, 1861, 1 J. & H. 393.

[6] Monforts *v.* Marsden, 1895, 12 R.P.C. 266.

[7] Mills *v.* Carson, 1892, 9 R.P.C. 338, C.A. 10 R.P.C. 9.

[8] Lines *v.* Usher, 1897, C.A. 14 R.P.C. 206.

liberty to deny the title of his licensors;[1] but he may, if sued for royalties, show that the licensor's right has expired. Thus, though the licencee could not say that the patent had been declared invalid, he could show that it had been revoked or had lapsed through non-payment of fees.[2]

Licencee may show that licensor's right has ceased.

A licencee can also show that what he has been doing is outside his licence and outside the patent, but unless there be an ambiguity in the specification he cannot refer to other specifications in order to limit the scope of the patent.[3]

A licencee can, in the absence of provision to the contrary, at any time repudiate his licence, and from the date of such repudiation the licence terminates;[4] the repudiation dates from the time when the licencee gives notice to the licensor.[5]

Licencee may repudiate licence.

Sometimes a licence is really a lease, with or without an option of purchase, of machinery at a royalty rent or a fixed rent, and the fact that such a lease is called a licence does not entitle the lessee or licencee to escape his liability for the rent by repudiation.[6]

To prevent the licencee repudiating his licence, and thereby becoming able to dispute the validity of the patent, it is usual for the licence to contain a covenant on the part of the licencee not at any time, either directly or indirectly, to dispute the validity of the patent.

Licencee usually covenants not to dispute validity.

[1] Hills *v.* Laming, 1853, 9 Ex. R. 256; Crossley *v.* Dixon, 1863, 10 H.L.C. 304.

[2] Muirhead *v.* The Commercial Cable Company, 1895, C.A. 12 R.P.C. 39; but see African Gold Recovery Co. *v.* Sheba Gold Mining Co., 1897, 14 R.P.C. 660, where the revocation of a patent was held to be no defence to an action for royalties.

[3] Jandus Arc Lamp *v.* Johnson, 1900, 17 R.P.C. 361.

[4] Redges *v.* Mulliner, 1893, 10 R.P.C. 21; Crossley *v.* Dixon, 1863, 10 H.L.C. 293.

[5] Redges *v.* Mulliner, 1893, 10 R.P.C. 21; Crossley *v.* Dixon, 1863, 10 H.L.C. 293; Cheetham *v.* Nuthall, 1893, 10 R.P.C. 321.

[6] Cutlan *v.* Dawson, 1897, C.A. 14 R.P.C. 249.

Licence is property.

A licence to work under a patent is property within the meaning of the Stamp Act, 1891, section 59; so that a contract for the sale of a licence requires an *ad valorem* stamp.[1] It seems clear that such a licence is property locally situate in the district to which it extends.[2]

Licence is not necessarily assignable.

A licence is not assignable unless it is made so in distinct terms, and it is usual to make a licence to work under a patent assignable only with the business of the licencee, and to bind the licencee not to part with his business without compelling the purchaser to accept a transfer of the licence.

Licence to company promoter.

Sometimes a licence is granted for the purpose of being transferred to a company to be promoted by the licencee; but such a grant does not give rise to any privity of contract between the licensor and the company when the licence has not been actually transferred to the latter, even though the company has worked under the licence,[3] and a better method of procedure is one which the author believes he originated, by which the patentee agrees with the promoter to grant a licence to the company when formed, and appoints him his attorney to execute such licence. (*Vide* Form X, App. B.)

If a patentee accepts royalties from the assignee of a licencee, he cannot afterwards dispute the validity of the assignment.[4]

Licence to use several patents.

A licence is often made to extend to more than one patent, and in such a case the royalties are usually made payable until the expiration of the term of the latest patent; in such a case the royalty must be paid without deduction during the whole period, even though the principal patents have expired.[5]

[1] Smelting Co. of Australia *v.* Commissioners of Inland Revenue, C.A. [1897], 1 Q.B. 175.

[2] Inland Revenue Commissioners *v.* Müller, H.L. [1901], A.C. 217, but see 2 above.

[3] Bagot Pneumatic *v.* Clipper, 1901, C.A. 19 R.P.C. 69.

[4] Lawson *v.* Donald Macpherson & Co., 1897, 14 R.P.C. 696.

[5] Siemens *v.* Taylor, 1892, 9 R.P.C. 393.

In an old case, where there was a licence granted to use six patents on payment of an annuity of £400, it was held that the consideration was entire, and if it failed partially, by reason of one of the patents being invalid, it failed entirely, and no action could be maintained for the money;[1] so that it is well to be careful in framing a licence to use more than one patent to avoid the risk of this occurring.

Where one patent held bad.

If a patentee grants an exclusive licence for the remainder of the term of the patent, without reserving any royalty, he has parted with his entire interest, and the licencee can probably claim to be registered as owner and to sue in his own name; but, where an exclusive licence has been granted for a limited area and a limited time, the licencee cannot sue without joining the licensor.[2]

Licence may be equal to assignment.

Licencee cannot sue alone.

In granting an exclusive licence it is usual to give the licencee the right to bring actions in the patentee's name, upon indemnifying him against the costs; it is possible that an exclusive licencee could bring an action in his own name, though the point does not appear to have ever been decided.[3] It has, however, been held that an exclusive licence is not a conveyance within the meaning of section 7 of the Conveyancing Act, 1881.[4]

Exclusive licencee may have power to sue in name of patentee.

An assignee of a patent, in consideration of a royalty, is not impliedly bound to manufacture or to renew the patent.[5]

A full licence to use and exercise an invention enables the licencee to do anything he likes under the patent. Thus, he may employ an independent agent to manufacture for him articles that he wishes to sell under the licence.[6]

Full licence.

[1] Chanter *v.* Leese, 1839, 5 M. & W. 701.
[2] Heap *v.* Hartley, 1889, C.A. 6 R.P.C. 495, 42 Ch. D. 461.
[3] Renard *v.* Levinstein, 1865, 2 H. & M. 629.
[4] Guyot *v.* Thomson, 1894, 11 R.P.C. 554.
[5] Railway Electrical Appliances, *in re*, 1876, 3 Ch. D. 597.
[6] Dunlop Pneumatic Tyre Co. *v.* North British Rubber Co., 1904, C.A. 21 R.P.C. 161.

For forms of licences, see Appendix B.

Registration of licence. Rule 63.

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

CHAPTER X.

AMENDMENT OF SPECIFICATIONS.

Correction of clerical errors.

It may happen that, after filing his complete specification, the applicant discovers that some clerical error has been made which it would be advisable to correct.

In such a case he should apply to the Comptroller, upon Patent Form P (bearing a stamp of £1 or 5s., according to whether the patent has or has not been sealed). See App. A.

The application must be accompanied by a certified copy of the specification with the correction made in red ink.

Invalidity of patent may be cured by amendment.

It may be, however, that after the complete specification is filed, the applicant, or, if the patent has been sealed, the patentee, may discover that there is something in the specification which renders the patent invalid, or, at any rate, which it would be safer to alter.

When claim covers something old.

For instance, he may find that his claims cover something which, without his knowledge, existed before the date of his patent, and it may be possible to alter the specification and so narrow the claim as to exclude that which would, unless the specification were amended, be an anticipation of the invention. Although the applicant for a patent is expected to examine into what has gone before, so as not to claim anything that is old, there is provision made for enabling a patentee, at any time, to so amend the specification as to make the patent, if possible, a valid one.

The original specification may be capable of two con-

Ambiguity may be cleared up.

structions, and in such a case the patentee may limit it by amendment to one of these;[1] but he may not amend solely to turn an insufficient description into a sufficient description, nor may he introduce knowledge subsequent in date to the patent.[2]

Act, 1883, sect. 18 (1).

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

Amendment must not enlarge claim. Act, 1883, sect. 18 (8).

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

It used to be the custom to allow an amendment when there was any doubt as to its effect,[3] but now an amendment will be closely examined to see that it does not infringe the above rule, and, if it would make the claim wider than in the original specification, the amendment will be refused.[4]

The amendment must not make the patent extend to anything which was not discovered at the date of the original specification.[5] Nor must the patentee strike out an original claim for a complete combination and insert a new claim for a subordinate part only.[6]

Amendment during Patent Action.

Act, 1883, sect. 18 (10), as amended Act, 1888, sect. 5.

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

A pending action for threats does not interfere with the amendment of a specification.[7]

[1] *Re* Rylands, 1888, 5 R.P.C. 665.
[2] *Re* Johnson, 1896, 13 R.P.C. 659.
[3] *Re* Lake, 1887, Cr. A.P.C. 16.
[4] *Re* Parkinson, 1896, S.-C. 13 R.P.C. 509.
[5] *Re* Beck & Justice, 1886, Cr. A.P.C. 10.
[6] *Re* Serrell, 1889, 6 R.P.C. 101.
[7] *Re* Hall, 1888, 21 Q.B.D. 137.

The action or petition must be pending at the time when the application for leave to amend is made;[1] but an action withdrawn from the list and standing over generally is pending. A pending appeal is not a pending action.[2] What is a pending action.

In the case of a patent being held bad in a petition for revocation, the Court will delay the registration of the order for a limited time, in order that the patentee may amend his specification, if this would save the patent; and, in the case of such amendment being made, the order will not be registered.[3] Registration of revocation delayed.

"In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed." Act, 1883, sect. 19. Court may allow amendment and impose terms.

Leave to apply to amend may be given more than once in the same action.[4]

Amendment, when an action is pending, is limited to disclaimer.[5] Only by disclaimer.

Leave to apply to amend in an action for infringement may be made conditional, on abstaining from the use of threats, until the question of amendment is disposed of,[6] or it may be made a condition that the amended specification should not be used at the trial,[7] though the latter condition would generally necessitate the discontinuance of the action, and is unusual. Leave is usually granted on the terms that the plaintiff should, Leave may be conditional.

[1] Woolfe *v.* Automatic Picture Gallery Co., 1902, 19 R.P.C. 425; C.A. 20 R.P.C. 177; Brooks *v.* Lycett, 1904, 1 Ch. 512.

[2] Cropper *v.* Smith, 1884, 28 Ch. D. 151.

[3] Deeley *v.* Perkes, 1896, H.L. [1896], A.C. 496, 13 R.P.C. 581.

[4] Chatwood's Patent Safe *v.* Mercantile Bank of Lancashire, 1900, 17 R.P.C. 43.

[5] *In re* Owen's patent, 1898 [1899], 1 Ch. 157; 15 R.P.C. 755.

[6] Chatwood's Patent Safe *v.* Ratner Safe Co., 1899, 16 R.P.C. 449.

[7] Bray *v.* Gardner, 1887, C.A. 4 R.P.C. 40.

in any event, pay the costs of the application and the costs of the action up to, and occasioned by, the disclaimer, except only so far as the proceedings might be utilised for the purposes of the amended action; the plaintiff undertaking to amend his pleadings, so as to confine the action to the specification as amended, or to consent to the action being dismissed with costs.[1]

The plaintiff may be required to waive all claim to damages for infringement prior to the amendment,[2] and in special circumstances, this may be extended to the user after amendment of machines previously made though this is unusual.[3]

The terms on which application for leave to amend should be allowed,[4] and whether it should be allowed at all,[5] are in the discretion of the judge, and will not be interfered with by the Court of Appeal, unless that Court is of opinion that such discretion has been exercised on a wrong principle.[6]

Terms of amendment pending petition.

In a petition for revocation, leave to apply to amend by disclaimer will be granted on the terms that the respondent should pay the costs of the application for leave to apply, and the costs of the petition down to the date of such application, except so far as what has been already done may be utilised in subsequent proceedings; and should the petitioner, after amendment, not con-

[1] Haslam Foundry and Engineering Co. *v.* Goodfellow, 1888, 37 Ch. D. 118; see also Fusee Vesta Co. *v.* Bryant & May, 1887, 34 Ch. D. 458, 4 R.P.C. 71.

[2] Gaulard *v.* Lindsay, 1888, 38 Ch. D. 38; Lang *v.* Whitecross Co., 1889, 62 L.T. 119, affirmed H.L. 89 L.T.J. 351.

[3] Ludington Cigarette Machine Co. *v.* Baron Cigarette Machine Co., 1899, 17 R.P.C. 25, C.A. 214; *cf.* Deeley *v.* Perkes, 1896, H.L. [1896], A.C. 496; 13 R.P.C. 581; Jandus Arc Lamp *v.* Arc Lamp, 1903, 21 R.P.C. 115.

[4] New Conveyor Co. *v.* Edinburgh Gas Commrs., 1903 (Scotch), 21 R.P.C. 1, 147.

[5] Lang *v.* Whitecross Co., 62 L.T. 112, App. H.L. 89, L.T.J. 351.

[6] Yates *v.* Armstrong, 1898, C.A. 77, L.T. 267; Allison's patent *in re* 1900, C.A. 17 R.P.C. 513; Ludington Cigarette Machine Co. *v.* Baron Cigarette Machine Co., *In re* Pitt's patent, 1898, H.L. 17 R.P.C. 745.

tinue, that the respondent should pay all the petitioner's costs.[1]

An application for leave to apply to amend is usually made by summons, but, in the Chancery Division, may be by motion.[2]

"A request for leave to amend a specification must be signed by the applicant, and shall contain an address for service in the United Kingdom. When not made in pursuance of an order of the Court, or a judge, the request must, where a patent has been sealed, also contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. The request must be accompanied by a duly certified copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct." Request to amend, how made. Rule 42.

The application for leave to amend must be made on Patent Form F, which must bear a stamp for £1 10s. or £3, according as the application be made before or after the sealing of the patent. See App. A.

An application for leave to amend a complete specification, before acceptance, must be made in this way.[3]

"Where a request for leave to amend is made in pursuance of an order of the Court or a judge, an office copy of the order shall be left with the request at the Patent Office." Request during action. Rule 43.

"At any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment. Where such notice is given, the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer." Opposition to amendment. Act, 1883, sect. 18 (2). Notice to patentee.

[1] *In re* Chatwood's patent, 1899, 16 R.P.C. 370; *In re* Gaulard & Gibbs' patent, 1887, 57 L.J. Ch. 209; see also *In re* Delwick's patent [1896], 2 Ch. 705.

[2] *In re* Delwick's patent [1896], 2 Ch. 705.

[3] *Re* Jones, Gr. P.C. 313.

Notice of opposition. Rule 44. See App. A.

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

Copy for the applicant.

A notice of opposition to an amendment must bear an impressed stamp for 10s.

If the notice of opposition be not signed by the opponent, the Comptroller may allow him to sign it subsequently.

Opponent's evidence. Rule 45.

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

Further proceedings. Rule 46.

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

For these, see pp. 82, 83.

Applicant's evidence if opponent does not leave statutory declarations. Rule 47.

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

Care should be taken to confine the declarations to relevant matter.[1]

The filing of declarations is optional, and the oppon-

[1] Official notice by Comptroller, 19th Jan., 1895, *re* Brand, 1895, S.-G. 12 R.P.C. 102.

ent may be able to rely on the reasons which he has given in his notice of opposition.

The rules regarding the forms of such declarations are given on pp. 81 *et seq.*

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

For these, see p. 83.

The decision of the Comptroller is subject to an appeal to the law officer, which must be made according to the law officers' rules (see next chapter).

It is provided that—

"The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions (if any) the amendment ought to be allowed." Act, 1883, sect. 18 (4). Law officer to hear parties.

There does not appear to have been any case in which the law officer has refused to hear the opponent. The decision of the law officer is final on any question coming before him in proceedings for amendment of a specification. Law officer's decision final.

Special terms as to actions for infringement are imposed only in very special cases.[1]

"Where no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether and subject to what conditions (if any) the amendment ought to be allowed." Act, 1883, sect. 18 (5). When opponent does not appear.

"Before exercising any discretionary power given to the Comptroller adversely to the applicant 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." Act, 1883, sect. 94. Exercise of discretionary power by Comptroller. Rule 28.

"Within five days from the date when such notice would be delivered in the ordinary course of post, or such Notice by applicant. Rule 29.

[1] Allison's patent, Finlay, S.-G., 1898, 13 R.P.C. 408; Pitt's patent, Carson, S.-G., 1901, 18 R.P.C. 478.

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 statements, etc. Rule 30.

"Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require."

Decision to be notified to parties. Rule 31.

"The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and to any other person who appears to him to be affected thereby."

Act, 1883, sect. 18 (6). Refusal of leave to amend. Sect. 18 (7).

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

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

In case of an appeal against the Comptroller, the Comptroller neither gives nor receives costs, whatever the result, except in very special circumstances.[1]

If an application to amend be refused by the Comptroller, and not appealed against, no appeal will be allowed from a similar refusal, made on a second application, for substantially the same amendment.[2]

Requirements when leave is given to amend. Rule 49.

"Where leave to amend is given, the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings, as amended, to be prepared in accordance with Rules 17 to 23."[3]

Advertisement of amendment. Rule 50.

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

[1] *Re* Lake, 1887, Gr. A.P.C. 16.
[2] *Re* Arnold, 1887, Gr. A.P.C. 5.
[3] See pp. 42 *et seq.*

"Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification." Act, 1883, sect. 18 (9). Leave to amend conclusive of right to amend.

When a patent has been amended, the specification, as amended, takes the place for all purposes of the original specification; the latter can only be looked at (if at all) to assist in construing the amended specification, and the validity of the patent is not affected by the fact that the amendment makes the claim wider than it was originally, except in case of fraud.[1]

So far as the bringing of actions is concerned, amendment is complete as soon as conditional leave to amend has been obtained, and the condition has been assented to by the patentee.[2]

If no conditions are imposed, it would appear that the amendment is complete, for this purpose, as soon as leave to amend is given.

An amendment made without leave of the Court while an action or petition is pending is null and void.[3] Irregularity.

"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." Act, 1883, sect. 20. Effect of amendment on damages.

When a patentee, suing on an amended specification, desires to claim damages for infringement prior to the date of amendment, he should do so in his pleadings and give evidence that he is entitled to such damages.[4]

[1] Moser *v.* Marsden, 1896, H.L. 13 R.P.C. 24.

[2] Andrew & Co. *v.* Crossley Brothers, 1891, C.A. [1892], 1 Ch. 492; 9 R.P.C. 165.

[3] Brooks *v.* Lycett, 1904, 1 Ch. 513.

[4] Boyle & Co. *v.* Kane & Pattison, 1901, 18 R.P.C. 325.

CHAPTER XI.

PROCEEDINGS BEFORE LAW OFFICERS.

It has been seen that the decision of the Comptroller is always subject to an appeal to the law officer, that is, to the Attorney- or Solicitor-General.

Decision of law officer is final.

The decision of the law officer, whether he be Attorney-General or Solicitor-General, is final on every matter before him; and he is not a Court to which a prohibition can go, and there is no means of testing the correctness of his decision,[1] which, however, cannot be referred to in Court as an authority on any question decided by him.[2]

Notice of appeal. L.O.R. 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."

See App. A.

The notice of intention to appeal must be on Patent Form T, which must bear a stamp for £3, and must be sent to the Comptroller at the Patent Office.

The notice of appeal need not be signed by the appellant himself; signature by his authorised agent is sufficient.[3]

The fourteen days run, in case of leave being given to amend, from the day of forwarding to the opponent a copy of the amendment as approved by the Comptroller.[4]

[1] *Re* Van Gelder, 1889, 6 R.P.C. 28.
[2] Siddell v. Vickers, 1888, 5 R.P.C. 436.
[3] *Re* Anderson & McKinnell, 1887, Gr. A.P.C. 23.
[4] *Re* Chandler, 1886, Gr. 270.

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

When notice has been given, just before the fourteen days expire, and the party receiving it desires to give a counter notice, the time for giving it will be extended.[1]

"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." Form of notice. L.O.R. 2.

When notice of appeal is given as to part only of the Comptroller's decision, and the party receiving such notice desires to question other parts, he must give a counter notice.[2] Law officer will only hear arguments on points mentioned in notice.

The law officer will hear the parties only on the points raised by the notice or counter notice,[3] and, except on such points, no alteration will be made in the Comptroller's decision on the application of one party without the consent of the other.[4]

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

When the appeal is by an opponent, he need not give notice to the applicant,[5] but the law officer provides for giving such notice.[6]

"Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officer's clerk all the papers relating to the matter of the application in respect of which such appeal is made." L.O.R. 4.

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

[1] *Re* Bairstow, 1888, 5 R.P.C. 289.
[2] *Ibid.*
[3] *Ibid.*
[4] Hall's patent, 1888, 5 R.P.C. 283.
[5] *Re* Anderson & McKinnell, 1887, Gr. A.P.C. 23.
[6] *Re* Hill, 1888, 5 R.P.C. 601.

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

Whom law officer must hear.

Act, 1883, sects. 11 (3) and 18 (4).

Sects. 9 (3) and 18 (7).

In case of opposition to either the grant of a patent or the amendment of a specification, the law officer is only required to hear the opponent if he is, in the opinion of the law officer, a person entitled to be heard in opposition; but he must, in any case, hear the applicant, and, when the Comptroller is respondent, he also is entitled to be heard.

Appellant not appearing or withdrawing.

If the appellant does not appear at the hearing, the appeal will be dismissed with costs.[1]

If the appeal be withdrawn, without sufficient reason being assigned for the withdrawal, the appellant will have to pay the costs.[2]

Respondent not appearing.

If the respondent does not appear, but explains his non-appearance to the satisfaction of the law officer, another day will be appointed for hearing the appeal, and the respondent will be ordered to pay the costs of the day.[3]

In case of opposition to the grant of a patent—

Law officer may employ expert. Act, 1883, sect. 11 (4).

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

Evidence on appeal. L.O.R. 8.

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

Evidence before Comptroller is documentary.

The evidence before the Comptroller is entirely documentary, and, therefore, in a complicated case, the proceedings before him are somewhat unsatisfactory; the

[1] *Re* Dietz, 1889, 6 R.P.C. 297.
[2] *Re* Knight, 1887, Gr. A.P.C. 35.
[3] *Re* Ainsworth, 1885, Gr. 269.

real contest being an appeal to the law officer, who may examine witnesses on oath and administer oaths for that purpose.

Law officers may take *viva voce* evidence. Act, 1883, sect. 38.

"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."

Attendance of witnesses may be ordered. L.O.R. 9.

"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."

L.O.R. 10.

The Comptroller has no power to award any costs to either party, directly or indirectly; but the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court (*i.e.*, of the High Court of Justice).

No costs before Comptroller.

Law officer may give costs. Act, 1883, sect. 38.

"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."

Law officer may fix amount of costs. L.O.R. 11.

As a rule the law officer fixes the costs; the amount awarded is quite an arbitrary one, often five guineas, but sometimes double that sum, or even more, will be awarded when the evidence is of an expensive kind.

A note of the fees paid on an appeal should be handed in by the appellant.[1]

Recovery of costs. L.O.R. 12. Act, 1883, sect. 38.

"If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act (*i.e.*, to make the order a rule of the Court)."

Form of documentary evidence. L.O.R. 13.

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

Fresh evidence. Rule 39.

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

[1] Sielaff's application, 1888, 5 R.P.C. 487.

Notice to leave fresh evidence. Rule 40.

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

Notices to law officer's clerk. L.O.R. 14.

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

The Act of 1883 provides that—

Sect. 38.

"The law officers may from time to time make, alter and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act."

The rules referred to above were made under this provision.

CHAPTER XII.

PROFESSIONAL ASSISTANCE IN PATENT MATTERS.

To aid intending applicants for patents, and to enable them to make their applications in proper form, the Patent Office publishes a circular of information which will be found very useful. This circular is supplied gratis at the Patent Office.

Patent Office Circular.

A careful examination of this, and of a few specifications, will often be sufficient to enable an intelligent person to make an application for a patent, on a provisional specification, without professional aid, without making any serious mistakes, though, even at this stage, skilled assistance should not lightly be dispensed with.

Professional assistance advisable but not indispensable.

The choice of a suitable title and the drafting of a provisional specification do not generally present any great difficulty, and, provided the title is applicable to the invention and not too wide, and the provisional specification gives a fair outline of the invention, sufficiently general to cover all probable improvements, the applicant is not likely to go far wrong. When, however, it becomes a question of the complete specification and its claims, the greatest care and skill are required, and, as a rule, it is advisable for the applicant to obtain professional assistance.

Title must be applicable to invention.

Complete specification requires great care.

Before settling the claims it is very important to know what has been done before in the same connection, so as to be able to make the claims cover all that is really new and nothing that is old. For this purpose it is often advisable to supplement the applicant's know-

Knowledge of what has gone before is essential.

Searches.

ledge by making a search through the specifications of previous patents. Such a search involves considerable expenditure of time, and the applicant may not feel prepared to spend several days at the Patent Office, or elsewhere, on work of this description; besides which, one who is accustomed to the work is more likely to carry it out effectively than one who has had little or no experience in such matters.

Patent agents.

Such work should, therefore, be entrusted to a patent agent, of whom there are many in London and other places; their business consists in conducting all kinds of work, other than that which appertains to solicitors, in connection with patents. Formerly any person, however ignorant of patent business, could style himself a patent agent; but the Act of 1888 provided that—

Who may call themselves patent agents. Sect. 1 (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."

Penalty for using the name patent agent improperly. Sub-sect. 4.

"If any person describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds."

Any one may act as agent in patent matters, but employment of patent agent is advisable.

Providing he does not describe himself as being a patent agent, any person can act as agent for another in patent business; and the signing of a specification as agent for the applicant is not sufficient to render him liable to the fine;[1] but it would be certainly unwise, in ordinary circumstances, for an applicant to employ as his agent any person whose name was not on the register.

A list of registered patent agents is published by Messrs. Eyre & Spottiswoode, East Harding Street, Fleet Street, E.C., and may be obtained through any bookseller, or from them direct, for 1s. 1d., post free.

"With the exception of the signing of the following

[1] Graham v. Fanta, 1892, Div. Ct. 9 R.P.C. 164.

documents, namely, applications for patents, requests for leave to amend applications, specifications or letters patent, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, notices of abandonment of or of intention not to proceed with applications, surrenders of letters patent, and petitions for compulsory licence and revocation of patent, all communications to the Comptroller under the said Acts and these Rules may be signed by, and all attendances upon the Comptroller may be made by or through an agent, duly authorised, to the satisfaction of the Comptroller, and, if he so require it, resident in the United Kingdom. The Comptroller shall not be bound to recognise as such agent, or to receive further communications from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the register of patent agents, kept under the provisions of the Patents, Designs and Trade Marks Act, 1888, relating to the registration of patent agents, and not since restored. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent or other person."

Agency. Rule 81.

A patent agent cannot undertake the conduct of an action for infringement, or for restraining threats, or of a petition for revocation or prolongation, which must be conducted by the party in person, or through a solicitor, like any other legal proceeding; but, in all proceedings before the Comptroller and the law officers, it is unusual to employ a solicitor as such, and his place is generally taken by a patent agent, though, as has been said, the Acts and Rules do not require that the person who acts as agent for an applicant, patentee or opponent should be a patent agent.

Patent agent cannot do solicitor's work.

At a hearing before the Comptroller, or a law officer, the parties may be represented by an agent or by counsel,

Counsel may be employed.

and, in such proceedings, counsel take their instructions from the agent without the intervention of a solicitor.

Non-contentious business.

Besides the contentious proceedings in which professional assistance is generally absolutely necessary, there are many matters in which it is inadvisable for a patentee to trust to his own unaided powers. For settling the complete specification, amendments or licences, professional aid is generally essential. Many a patent, which might have been of great value, has been ruined by bad drafting, and the complete specification should, if possible, have the finishing touches given by a good patent agent or experienced counsel.

Proceedings on sale of a patent.

When a patent is sold, the vendor does not usually in any way warrant its validity, and the intending purchaser usually requires some search to be made by a qualified patent agent to see if the patent has been anticipated, and frequently requires the result of any such search to be laid before counsel, and makes the purchase conditional on obtaining a favourable opinion thereon.

Counsel's opinion usually required by purchaser.

Value of official searches.

The provisions for an official search, in the case of applications made after the prescribed date, may somewhat affect the necessity for a search through British specifications, in the case of patents granted thereon; but the need for a search through foreign specifications will still remain, and purchasers may, for a time at least, be inclined to doubt the value of the official search, and to require a further search to be made, even through British specifications.

CHAPTER XIII.

INFRINGEMENT.

LETTERS patent confer upon the patentee, his agents and licencees, the sole right to make, use, exercise and vend the invention in the United Kingdom and the Isle of Man in such manner as to him or them may seem meet.

If any person, without the licence of the patentee, makes, uses, exercises or vends the invention within the prescribed limits, such person is said to have infringed the letters patent; and the patentee is entitled to bring an action for infringement against him. In such an action, unless the patent is held bad, if he prove that the infringement has taken place, the patentee will be entitled to judgment against the infringer for an injunction to restrain any future infringements, for an account of the profits which the infringer has made by his wrongful acts, or, in the alternative, for an inquiry into the damages which the patentee has suffered by the infringements, and, lastly, for an order requiring the delivery up upon oath to the patentee or the destruction of all the infringing articles which may be at the time in the possession of the infringer.

Patentee may bring action for infringement.

Penalties of infringers.

The patentee is not obliged to wait until his patent has been actually infringed; if any person threatens to do what the patentee considers will be an infringement of his patent, he can bring an action to restrain the threatened infringement;[1] of course, in such a case there

Patentee may sue before infringement.

[1] Frearson *v.* Loe, 1878, 9 Ch. D. 65; Incandescent Gas Light *v.* De Mare, 1896, C.A. 13 R.P.C. 301.

is no question of damages, and the only relief possible is an injunction. In order to succeed, the patentee must show that his patent is valid, and that the defendant has threatened, and continues to threaten, to do something which would actually infringe the patent.

Generally better to wait for infringement to take place.

Except when it is very clear that what is threatened will be an infringement, it is safer to wait until the infringement takes place, and, in the meantime, to threaten to proceed against infringers (see Threats, p. 166).

What constitutes infringement.

The question of what constitutes an infringement is one of great importance, not only to the patentee, but also to the public; since the latter are entitled to know what they may do without infringing and so becoming liable to the severe penalties inflicted on infringers.

The first question that arises in respect of any alleged infringement is, "Does the article or process, alleged to be an infringement, come within the scope of the invention described and claimed in the complete specification?" since this alone is protected by the patent. This depends on the meaning of the specification, and this is a matter of law for the consideration of the Court. When, however, the meaning of the specification is ascertained, the question of infringement becomes one of fact, and, if the case be tried by jury, will be left to them to answer.[1]

Construction of specification.

Is the user complained of an infringement.

A second question which may arise is, whether, granted that the article or process would otherwise be an infringement, the facts of the case are such that what the defendant did was done under an implied licence from the patentee, and, therefore, did not amount to an infringement. In such a case there may, of course, be questions of what actually happened, but, when these are answered, the question of infringement becomes a matter of law for the Court to decide.

The question as to whether the alleged infringement does or does not come within the scope of the invention

[1] Lucas v. Miller, 1900, 17 R.P.C. 165.

protected by a patent is sometimes one of considerable difficulty, even after the meaning of the complete specification is ascertained. Where the infringer has simply taken the invention as described no difficulty arises, but this is not by any means usual. More often, at least in what may be termed wilful cases, the infringer, starting with the invention described in the specification, disguises it by making slight alterations here and there, by using something which is different from what is described in the specification, but which will produce the same effect, or by adding or subtracting something, perhaps in itself of considerable importance, so that at first sight what he does may appear to be quite different from what is described in the specification, and only after careful examination, and with full knowledge of all the particulars, does the fact of infringement become clear.

Does alleged infringement come within scope of patent.

Effect of alterations from invention described in specification.

Perhaps the simplest alteration that an infringer can make in an invention, described by a specification, is to substitute for the method described an equivalent method which will produce the same result. This, according as the invention is mechanical or chemical, is called using a mechanical or chemical equivalent. In his specification an applicant is not bound to describe every method of carrying out his invention, and if he describes one practical method, this will be sufficient to prevent others from using anything which, at the date of his specification, was known to be an equivalent. A patent will not, however, protect the patentee against the use of any method which, though really equivalent to that described in the specification, was not, at the date of the specification, known to be an equivalent.

Substitution of an equivalent.

What is an equivalent.

"The specification must be read as persons acquainted with the subject would read it at the time it was made; and, if it could be construed as containing any chemical equivalents, it must be such as are known to such persons at that time; but those which are not known at the time as equivalents, and afterwards are

Equivalent must be known at date of patent.

found to answer the same purpose, are not included in the specification. They are new inventions."[1]

Substitution of equivalent in combination may not be an infringement.

It is not, however, in every case that the introduction of an equivalent fails to secure immunity from infringement. In the case of a patent for a combination, all depends on whether the substitution takes place in an important or unimportant part. As a general rule, a patent for a combination protects only the actual thing described, and is not infringed by the use of a different combination, even though the same results are produced in similar ways by each. Thus, "where there is a well-known machine, and there is an improvement in a part of that machinery for effecting the old object, though in a better way, you must confine the patentee to the improvement which he claims in effecting that particular object. It does not come to the question whether this is or is not a mechanical equivalent; it is, 'Have you really taken in substance that which was the invention of the plaintiff, protected by his patent?'"[2]

But this is not always true.

Even in the case of a patent for a combination the question of equivalents may be of importance. "A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact, every patent, or almost every patent, is a patent for a new combination. The patent is for the entire combination; but there is, or may be, an essence or substance of the invention underlying the mere accident of form, and that invention, like every other invention, may be appropriated by a theft in a disguised or mutilated form; and it will be in every case a question of fact whether the alleged piracy is the same in substance and in fact, or is a substantially new or different combination."[3] From this it

[1] Heath *v.* Unwin, 1855, H.L. 2 W.P.C. 314.

[2] *Boyd v. Horrocks*, 1889, C.A. 6 R.P.C. 159; see also *Brown v.* Jackson [1895], A.C. 446. Consol. Car. Heating Co. *v.* Caine, 1903, P.C., 20 R.P.C. 745.

[3] Clark *v.* Adie, 1875, L.R. 10 Ch. 675.

follows that a patent for a combination may be infringed by taking the essential part with mechanical equivalents for some of the parts.[1]

When essential part of combination is taken.

Besides the use of mechanical or chemical equivalents, there are many ways in which an infringer may endeavour to conceal the fact of infringement. As a general statement of the law on this subject we may take the following words of Chief Justice Tindal in a case decided in 1841 :—

Test of infringement.

"Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, either to obtain a patent for it himself, or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right; and, therefore, what you have to look at upon the present occasion is not simply whether in form or in circumstances, that may be more or less immaterial, that which has been done by the defendants varies from the specification of the plaintiff's patent, but to see whether in reality, in substance and in effect the defendants have availed themselves of the plaintiff's invention in order to make that fabric.

"There can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object. There may be many roads leading to one place, and if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent

[1] Peckover v. Rowland, 1893, 2 A. 10 R.P.C. 234.

for that purpose. But he has no right whatever to take, if I may so say, a leaf out of his neighbour's book, for he must be contented to rest upon his own skill and labour for the discovery, and he must not avail himself of that which had before been granted exclusively to another."[1]

This statement of the law has been repeated by numerous judges in different words. Thus, Lord Chancellor Cairns puts it as follows: "That which is protected by a patent is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified. But I agree that it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected may be taken notwithstanding."[2]

Infringement must be of what is described, but may be altered so as to conceal fact of infringement.

Infringement is matter of fact depending on evidence.

In every case the question of fact whether a machine or process is an infringement, is one to be decided on the evidence, and other cases afford little guide to the right answer; but the above statements of law show to what points attention must be devoted in order to arrive at the correct result on the evidence. As has been said: "You must ask yourself whether the substance and pith of the invention is taken substantially. A mere addition to the original machine will not prevent the new machine from being an infringement; nor will diminishing or subtracting this or that part of the original machine necessarily prevent an infringement of it from taking place. You must recall yourself, after making allowance for the subtraction, to the question whether in substance the invention has been borrowed."[3]

To this rule nothing need be added, except that the

[1] Walton *v.* Potter, 1841, 1 W.P.C. 586.

[2] Dudgeon *v.* Thompson, 1877, 3 App. Cas. 44; *cf.* Jupe *v.* Pratt, 1837, 1 W.P.C. 146; Automatic Weighing Machine *v.* Knight, 1889, C.A. 6 R.P.C. 304.

[3] Franklin Hocking & Co., Ltd., *v.* Franklin Hocking, 1887, C.A. 4 R.P.C. 442.

substance and pith of the invention must be determined from the specification and its claims, and not from the opinions of expert or other witnesses.[1]

By use for new purpose.

The adoption for a new purpose of machinery patented for another purpose is an infringement.[2]

The mere making of parts, which are subsequently fitted by another person in an infringing machine, is no infringement;[3] but it is an infringement for a person to make all the parts of a patented machine, and to supply these parts to others in a form in which they can be easily put together, and thus enable the patented invention to be used.[4]

Infringement by selling parts of invention.

By repairing.

The repair of a patented article may be an infringement if it is substantially the making of a new article.[5]

There may be infringement by making without either selling or using, for the patentee has a monopoly in manufacture. Thus, where a patent was about to expire, and defendant had made a large number of the patented articles, so as to throw them on the market as soon as the monopoly had expired, an injunction was granted to restrain the sale of such articles, both before and after the time limited by the patent.[6]

Others may not prepare to flood market on expiration of patent.

Infringement by user of infringing article.

Apart from making or selling, there may be infringement by user, and this may be in one of two ways. There is infringement by user every time that an infringing article is used, and this is a necessary provision for enabling the patentee to stop the manufacture and sale of infringing articles by persons from whom he would be unable to obtain compensation in damages.

[1] Brooks *v.* Steel, 1897, C.A. 14 R.P.C. 46; Pneumatic Tyre Co. *v.* Tubeless Pneumatic Tyre Co., 1899, H.L. 16 R.P.C. 77.

[2] Pneumatic Tyre Co. *v.* East London Rubber Co., 1897, 14 R.P.C. 103, quoting Cannington *v.* Nuttall, L.R. 5 H.L. 230.

[3] Savage *v.* Brindle, 1896, 13 R.P.C. 266; Dunlop Pneumatic Tyre Co. *v.* Moseley, C.A. (1904), 1 Ch. 612.

[4] United Telephone Co. *v.* Dale, 1884, 25 Ch. D. 778.

[5] Dunlop Pneumatic Tyre Co. *v.* Excelsior Tyre Co., 1901, 18 R.P.C. 209: Dunlop Pneumatic Tyre Co. *v.* Neal, 1899, 16 R.P.C. 247.

[6] Crossley *v.* Beverley, 1829, 1 R. & M. 166*n*.

By breach of limited right to use.

There may, however, be infringement by an improper user of an article, which is not itself an infringement, but which may have been actually made and sold by the patentee himself. When a patentee sells an article, made under his patent, he can do so subject to restrictions either as to the locality or the manner in which it may be used, provided such restriction be brought to the notice of the purchaser before the sale.[1] In these cases the patentees upheld their right to prevent the use of their patent incandescent mantle for gas lighting, except on burners supplied by themselves, though they had no monopoly in the manufacture and sale of such burners.

Machines are frequently supplied, either by way of sale or on hire, upon condition of a royalty being paid for user. A machine let out on hire may be taken under distress for rent due from the hirer, but the landlord cannot give to a purchaser in such a case any rights in respect to the user of the machine, and any such user by the purchaser will be an infringement from which he will be restrained by injunction.[2]

Purchaser may be an infringer.

It will be readily understood that a patentee, who had a patent only in this country, would be prepared to supply articles made under his patent for export at a cheaper rate than for home use, since the exported articles would have to face the competition of makers abroad, and the use at home of such an article, sold for export only, would affect the profits of his monopoly in the same way as the importation of similar articles made abroad, and will be restrained. Where a person has patent rights in two countries, and manufactures in both, the sale of an article in one country, in the absence of a clear indication to the contrary, implies a licence to use it in the other; but if a patentee has sold his foreign patent he cannot any

[1] Incandescent Gas Light Co. *v.* Cantelo, 1895, 12 R.P.C. 262; Incandescent Gas Light Co. *v.* Brogden, 1899, 16 R.P.C. 179.

[2] British Mutoscope *v.* Homer, 1901, 18 R.P.C. 177.

longer sell the invention for use in such foreign country so as to defeat the rights of his assignee.[1]

By importation.

The importation of an infringing article is an infringement,[2] even though such importation be immediately followed by exportation without any use in this country.[3] But custom house agents for the importers are not liable as infringers, since they take no active part in the infringement.[4]

The importation of an article made abroad, in the production of which a patented process has been used, is an infringement of the patent for such process.[5]

Act of infringement must be local.

In order to constitute an infringement of an English patent there must be some act done within the prescribed territorial limits; the mere posting of a parcel of an infringing substance at a foreign post office, addressed to a person in England, is not an infringement.[6]

Contract of sale for delivery abroad.

The making, in this country, of a contract for the sale of a patented article, to be delivered abroad, is not an infringement of the patent.[7]

By exhibition.

The exhibition, as part of an article offered for sale, of an infringing article, which is excluded from the sale, is an infringement by user.[8]

By aiding and abetting.

A person who merely licenses another to infringe a patent is not an infringer;[9] but a person who causes or

[1] Betts *v.* Wilmot, 1871, 6 Ch. 239; *cf.* Société Anonyme de Glaces *v.* Tilghman's Sand Blast Co., 1883, C.A. 25 Ch. D. 1.

[2] Von Heyden *v.* Neustadt, 1880, 14 Ch. D. 230; Walton *v.* Lavater, 1860, 8 C.B.N.S. 162; Wright *v.* Hitchcock, 1870, L.R. 5 Ex. 37.

[3] British Motor Syndicate *v.* John Taylor & Sons, Ltd., 1900, 17 R.P.C. 189, C.A. 723.

[4] Nobel's Explosives Co. *v.* Jones, 1882, H.L. 8 App. Cas. 1.

[5] Saccharine Corporation, Ltd., *v.* Anglo-Continental Chemical Works, Ltd., 1900, 17 R.P.C. 307.

[6] Badische Anilin, etc., *v.* Johnson & Co., 1897, C.A. 14 R.P.C. 405, H.L. 919.

[7] Saccharine Corporation, Ltd. *v.* Reit, Meyer & Co., 1900, 17 R.P.C. 606.

[8] Dunlop Pneumatic Tyre Co. *v.* British and Colonial Motor Car Co., 1901, 18 R.P.C. 313.

[9] Montgomerie *v.* Paterson, 1894, Ct. Sess. 11 R.P.C. 221.

assists another to do so is in a different position. Thus, the directors of a company are liable as infringers in respect of infringements by the company, and are frequently made defendants in infringement actions against the company of which they are directors.[1]

So also the receiving of a commission from an infringer, on orders for infringing articles forwarded to, and executed by, the infringer, is itself an infringement.[2]

The sale, in a suitable form, of a substance not itself capable of being patented expressly for use in a patented process, has been held to be an infringement,[3] though the correctness of this decision, which was not appealed from, may well be doubted.[4]

Patentee must not cause infringement.

The patentee must not in any way be instrumental in causing the infringement to be committed; thus, the making of an infringing article, under the instructions of the patentee's agent, is not an infringement; for the patentee must not lay a trap for any one so as to entangle an innocent party in litigation.[5] The sale of an infringing article to the patentee's agent is, however, constantly relied on as the specific act of infringement alleged in the particulars of breaches.

[1] Betts *v.* De Vitre, 1864, 11 Jur. N.S. 9; 3 Ch. 129; Incandescent Gas Light Co. *v.* De Mare, 1896, 13 R.P.C. 301; Incandescent Gas Light Co. *v.* Daylight Co., 1899, 16 R.P.C.

[2] Incandescent Gas Light Co. *v.* Brogden, 1899, 16 R.P.C. 179.

[3] Innes *v.* Short, 1898, 15 R.P.C. 449; *cf.* Townsend *v.* Haworth, 1875, 12 Ch. D. 830; Dunlop Pneumatic Tyre Co. *v.* Moseley, C.A. (1904), 1 Ch. 612.

[4] *Ibid.*

[5] Kelly *v.* Batchelar, 1893, 10 R.P.C. 289.

CHAPTER XIV.

ACTIONS FOR INFRINGEMENT.

If a patentee believes that any person has made use of his invention without licence from him—that is, that any person has infringed his monopoly—he may bring against such person an action for infringement of his patent.

Court in which action must be brought. Act, 1888, sect. 26.

An action for infringement in England must be brought in the High Court of Justice or in the County Palatine Court of Lancaster. In the High Court the action may be commenced in either the Chancery or Queen's Bench Division, and the choice of plaintiffs is divided nearly equally between the two.

Cannot be tried in county court.

An action for infringement of a patent, however small the amount of damage may be, cannot be tried in a county court.[1]

The Act of 1883 provides that—

Actions in Scotland and Ireland. Sect. 3 (1).

"The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents, or to designs, or to trade marks; and with reference to any such proceedings in Scotland the term 'the Court' shall mean any Lord Ordinary of the Court of Session, and the term 'Court of Appeal' shall mean either division of the said Court; and with reference to any such proceedings in Ireland, the terms 'the Court' and 'the Court of Appeal' respectively mean the High Court of Justice in Ireland and His Majesty's Court of Appeal in Ireland."

[1] Registrar *v.* Judge of County Court of Halifax, 1891, C.A. 8 R.P.C. 338.

No action till patent is sealed, relates back to acceptance. Act, 1883, sect. 13.

An action for infringement cannot be commenced until the patent is actually sealed; but it may relate back to all infringements committed after the date of publication of the complete specification.

Parties.

Registered owner can sue.

The registered owner of the patent is usually a plaintiff, even though he may only be in the position of a trustee; but it appears that a *cestui que trust* may sue in his own name.[1] This would enable an equitable assignee to sue; but the assignment ought to be by deed, and it is better to have the assignment registered before commencing the action.

Registration not necessary, but advisable.

If the plaintiff is a registered owner, he usually describes himself in the statement of claim simply as registered proprietor.

A joint owner may sue alone.

When there are co-owners of a patent, any one of them can sue for infringement without the rest;[2] if the defendant wishes to avoid the possibility of having several actions against him in respect of the same infringement, he should at once apply to join the other owners as parties.[3]

Formerly registration necessary before action.

Formerly an assignee of a patent could not sue for infringement until the assignment had been registered;[4] but, when the assignment was registered, the registration had relation back, and gave a right to sue as from the date of the assignment.[5]

Mortgagor may sue alone.

A mortgagor in possession of a patent can sue for infringement without joining the mortgagee; but if it appear to the judge desirable that the mortgagee should be a party he ought to join him.[6]

[1] Speckhart *v.* Campbell, C.A., *Times*, 13th March, 1884.

[2] Anderson *v.* Patent Oxonite Co., 1886, 3 R.P.C. 279.

[3] Sheehan *v.* G. E. Rail. Co., 1880, 16 Ch. D. 59.

[4] Chollet *v.* Hoffman, 1857, 7 E. & B. 686.
Hassall *v.* Wright and others, 1870, L.R. 10 Eq. 509.

[5] Van Gelder *v.* Sowerby Bridge Flour Co., 1890, C.A. 7 R.P.C. 41 208, 44 Ch. D. 374.

A licencee, even when his licence is an exclusive one, cannot sue in his own name without joining the patentee.[1] An exclusive licence to work a patent is not a conveyance within the meaning of section 7 of the Conveyancing Act, 1881.[2]

Licencee cannot sue alone.

The writ usually claims—

Form of writ.

(1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's letters patent (usually adding the title, date and number of the patent).

(2) Damages, or, at the option of the plaintiff, an account of profits.

(3) Delivery up to the plaintiff, or destruction, of all articles in the defendant's possession made in infringement of the said letters patent.

(4) When a certificate of validity has been obtained in a previous trial, costs between solicitor and client. (This is not necessary, but may induce settlement.)

An action for an injunction may be commenced before the defendant has actually infringed if he has threatened to do so,[3] and in this case only (1) and possibly (4) will be required.

An injunction may be granted to restrain infringement where there is an intention to infringe, and no actual infringement; but an injunction will not be granted where there is no intention to infringe, even though there may have been a past infringement.[4]

Who may be defendants.

Any party who is alleged to have infringed, directly or indirectly, may be made a defendant. Thus, it has been held right to commence an action against carriers who have in their possession infringing articles, and on discovery to add the owners as defendants;[5] but custom-

[1] Heap *v.* Hartley, 1889, C.A. 42 Ch. D. 461; 6 R.P.C. 495.

[2] Guyot *v.* Thomson, 1894, 11 R.P.C. 554.

[3] Frearson *v.* Loe, 1878, 9 Ch. D. 65; Incandescent Gas Light Co. *v.* De Mare, 1896, 13 R.P.C. 301.

[4] Proctor *v.* Bailey, 1889, C.A. 6 R.P.C. 538.

[5] The Washburn and Moen Manufacturing Co. *v.* Q., 1889, 6 R.P.C. 398.

house agents for foreign importers are not liable to be thus attacked.[1]

Directors of a company may be joined.

Directors of a company may be liable for infringements by the company, and, since the infringement of letters patent is a tort, they will, if made defendants, be liable jointly and severally for both damages and costs.[2] It is very usual to thus join the directors as defendants in an action against an infringing company.

Where, before the trial of an action for infringement, brought against a company and its directors, the company has transferred its business to a new company with the same directors, an injunction will not be granted so as to affect the directors in their management of the new company. The new company ought to be added as a party to the action.[3]

A foreign company exhibiting an infringing article in this country, on a stand in charge of a representative employed by them, are liable as infringers, and may be served with a writ at such stand as persons carrying on business there.[4]

When defendant is out of the jurisdiction.

If the defendant be an importer, resident out of the jurisdiction, the plaintiff must not delay the commencement of his action until the term of his patent has nearly expired, as he will then have no ground for claiming an injunction, and will be unable to obtain leave to serve the defendant out of the jurisdiction; or, if he obtains leave to serve, the service will be liable to be set aside. In such a case his only remedy is to sue the persons who, in this country, have purchased infringing articles, since he has no right of action abroad against an infringer in this country only.

[1] Nobel's Explosives Co. *v.* Jones, 1882, 8 App. Cas. 1.

[2] Betts *v.* De Vitre, 3 Ch. 149, 11 Jur. 9.

[3] Welsbach Incandescent Gas *v.* New Incandescent (Sunlight Patent) Gas, 1900, 17 R.P.C. 237.

[4] Dunlop Pneumatic Tyre Co. *v.* Actien Gesellschaft für Motor, etc., 1902, C.A. (1902), 1 K.B. 342.

To make a person liable as an infringer, there must be some act on his part taking effect within the United Kingdom, since nothing done abroad can be an infringement of a British patent. A person selling infringing articles abroad, for importation into this country, even though he assist in despatching the same to the purchaser here, is not liable as an infringer. Thus, where a manufacturer abroad transmits infringing articles by post to purchasers in England, the patentee has no remedy against the manufacturer, but must sue the purchaser.[1]

The manufacturer and purchaser of an infringing machine may be sued together,[2] but the manufacturer cannot claim to be added as a defendant in an action against the purchaser;[3] if, however, he has given the purchaser an indemnity, he may be allowed to defend as a third party, and, in such a case, if unsuccessful, he will be liable for the plaintiff's costs.[4]

Manufacturer when third party.

A patentee who has failed to prove infringement in one action, is not debarred from bringing an action against another party for an exactly similar alleged infringement, and such second action will not be stayed pending an appeal in the first, unless it be clearly proved that the second defendant would be bound by the result of the first action.[5]

Action Under Several Patents.

Actions are frequently brought for infringement of several letters patent, and there is no reason why the infringements of several should not be, in some cases, included in the same action, even though the acts com-

[1] Badische Anilin *v.* Johnson, 1897, H.L. 14 R.P.C. 405, 919.

[2] Proctor *v.* Bennis, 1887, 36 Ch. D. 740.

[3] Moser *v.* Marsden, 1892, C.A. 9 R.P.C. 214; Edison *v.* Holland, 1886, 3 R.P.C. 395.

[4] Edison & Swan Electric Light Co. *v.* Holland, 1889, C.A. 6 R.P.C. 287.

[5] Dunlop Pneumatic Tyre Co. *v.* Rimington Bros. & Co., Ltd., 1900, C.A. 17 R.P.C. 665.

plained of in respect of one patent may be quite distinct from those in respect of the other or others; but in such cases the action may be tried as though it were two or more distinct actions, in order to prevent the confusion of trying two distinct matters at the same time.[1] If the cases under several patents are distinguishable, and are tried together, the costs will be taxed as if a separate action had been brought on each patent.[2]

Group of patents.

In some cases the owner of a group of patents might be able to succeed in an action brought under all the patents of the group, where he would fail if he brought a separate action under each patent. Such an action has been tried, and has been successful where the plaintiff proved that its patents covered every known commercial method of manufacturing the substance, the sale or use of which was the cause of complaint.[3] But a similar action by the same plaintiff was held to be oppressive, and the plaintiff was limited to alleging infringement of three selected patents,[4] so that in future, unless a plaintiff can prove which patent has been infringed, he is not likely to be successful, and in any such action the grant of an injunction is doubtful, even though damages may be recovered.[5]

If, in such a case, an injunction be granted, it will be limited to the time when the earliest of the patents under which the goods can be made expires.[6]

Interim Injunctions.

When to be applied for.

If the plaintiff intends to apply for an interim injunction, he should do so as soon as possible after the defendant has entered an appearance; or he may, with special leave in an urgent case, do so before appearance.

[1] Pneumatic Tyre v. Casswell, 1896, 13 R.P.C. 164.
[2] Brooks v. Lamplugh, 1898, C.A. 15 R.P.C. 33.
[3] Saccharine Corporation, Ltd., v. Annand, 1900, 17 R.P.C. 1.
[4] Saccharine Corporation, Ltd., v. Wild, 1903, C.A. 20 R.P.C. 243.
[5] Saccharine Corporation, Ltd., v. Quincey, 1900, 17 R.P.C. 337.
[6] Saccharine Corporation, Ltd., v. Dawson, 1902, 19 R.P.C. 169; followed in Saccharine Corporation, Ltd. v. Jackson, 1903, 20 R.P.C. 611.

Application, how made.

The application is made by motion or summons, according to the division in which the action is commenced, and asks for an injunction to restrain the defendant, his servants and agents from making, using, exercising or vending the invention for which the letters patent were granted.

Evidence on application for interim injunction.

Upon the hearing the plaintiff must be prepared with evidence of the infringement, of the intention to continue the infringement, of the validity of the patent and also of his title.

Affidavits on a motion for an interim injunction, made on information and belief, ought to show what are the sources of the information;[1] but an affidavit which showed on its face that it was founded on information obtained as the result of inquiries made by the deponent, on behalf of the plaintiff, has recently been admitted, though it would appear on its face to be merely hearsay.[2]

The fact that a certificate of validity has been granted is, as a rule, a *primâ facie* ground for granting an interlocutory injunction where the infringement is clear;[3] but is not sufficient where validity is attacked on the ground of a prior user not set up in the action in which the certificate of validity was granted.[4]

Defendant not appearing.

If the defendant does not appear on a motion for an interim injunction, an injunction will be granted upon the plaintiff filing an affidavit stating that the defendant is infringing, and that the patent is good and valid, and has not been anticipated.[5]

If the defendant appears and does not dispute the

[1] Saccharine Corporation, Ltd., *v.* Chemical & Drugs Co., 1898, 15 R.P.C. 33.

[2] Badische Anilin Fabrik *v.* Thompson, 1902, 19 R.P.C. 502.

[3] Welsbach Incandescent Gas Light Co., Ltd., *v.* Vulcan Incandescent Light Synd., 1901, 18 R.P.C. 279.

[4] Welsbach Incandescent Gas Light Co., Ltd., *v.* General Incandescent Gas Co., 1901, C.A. 18 R.P.C. 533.

[5] Clarke *v.* Nichols, 1895, 12 R.P.C. 310.

Validity not disputed.

validity of the patent, and there is good evidence of intention to infringe on his part, an injunction will be granted.[1]

Defendant a licencee.

An interlocutory injunction will be granted, even under a new patent, against a licencee who goes outside his licence, since he cannot dispute the validity of the patent; but if the plaintiff denies his right to work under the patent at all, an injunction will not be granted, since, in that case, the fact that he claims to be a licencee will not put him in a worse position than that occupied by a stranger.[2]

An interlocutory injunction will not be granted against a defendant who can show a *primâ facie* title to work under the patent as owner of a share, or as licencee of a part-owner.[3]

When injunction is resisted.

Plaintiff must have *primâ facie* evidence of validity.

Plaintiff must show account insufficient.

If the defendant appears and resists the injunction, the plaintiff will not obtain an interim injunction unless he can show that for many years the validity of the patent has been unquestioned, and his monopoly has been complete and free from infringement, or that the validity of the patent has been upheld in a previous trial; and also that he will not be sufficiently protected if the defendant keeps an account of all the profits made by the alleged infringements.

Inadvertent infringement.

Where the defendant alleged that he had infringed in ignorance of the plaintiffs rights, and that the amount of his infringement was small, and undertook not to repeat the infringement, an injunction was refused.[4]

Purchaser undertaking not to use.

Where a patentee had obtained judgment against a manufacturer, and in consequence a purchaser had offered to undertake not to use the machine he had pur-

[1] Howes v. Webber, 1894, 11 R.P.C. 586.

[2] Wapshare Tube Co. v. Hyde Imperial Rubber Co., 1901, C.A. 18 R.P.C. 374.

[3] Wapshare Tube Co. v. Hyde Imperial Rubber Co., 1901, C.A. 18 R.P.C. 374.

[4] Jenkins v. Hope, 1896, 13 R.P.C. 57.

chased during the existence of the patent, but the patentee commenced an action and moved for an interim injunction, on the defendant undertaking not to use the machine till trial or further order, the motion was dismissed with costs.[1]

Where an injunction has been refused upon terms against a vendor of alleged infringing articles, a motion for an interim injunction against a customer will be dismissed with costs.[2]

When infringement doubtful no injunction granted.

If there is any reasonable doubt as to whether what the defendant is doing amounts to infringement, or if the defendant seriously disputes the validity of the patent, an injunction will not be granted; but, as a rule, the defendant will be ordered to keep an account of his profits, and the motion or summons will be ordered to stand over until the trial of the action or further order.

Account may be ordered to be kept.

Where the defendant resisted an order to keep an account in an action on a comparatively new and unfought patent, the order for an account to be kept was prefaced by the words: "The defendant not admitting the validity, but, on the other hand, contending that the patent is invalid".[3]

Defendant undertaking not to infringe.

If the defendant undertakes not to infringe until the trial of the action or further order, the motion will stand over with liberty to apply.[4]

Previous action on validity is useful.

Where there is good evidence of infringement, the strongest ground for an injunction is that the validity of the patent has been established in a previous trial; but where the defendants offered to pay a reasonable sum into Court, and to keep an account, an interim injunction was refused, though the patent had been so upheld.[5]

Defendant giving security and keeping an account.

[1] Lyon *v.* Mayor of Newcastle, 1894, 11 R.P.C. 218.

[2] Pneumatic Tyre Co. *v.* Goodman & Son. 1896, 13 R.P.C. 723.

[3] Pneumatic Tyre Co. *v.* Friswell, 1896, 13 R.P.C. 15.

[4] Lyon *v.* Mayor of Newcastle, 1894, 11 R.P.C. 218.

[5] The North British Rubber Co., Ltd., *v.* The Gormully and Jeffry Manufacturing Co., 1895, 12 R.P.C. 17.

Plaintiff must give undertaking in damages.

When an interim injunction is granted, the plaintiff must give the defendant an undertaking in damages in case he should not succeed in the action.

Statement of Claim.

The Act of 1883 provides that—

Sect. 29 (1).

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

Form of statement of claim.

The statement of claim is usually a formal document which states the title of the plaintiffs to the letters patent, alleges that the said letters patent are good and valid, and that the defendant has infringed in the manner shown in the particulars of breaches delivered with it; and if it be the case "that a certificate that the validity of the letters patent had been in question was granted by Mr. Justice (——), on the day of , in an action entitled ".

It is irregular, on a writ claiming the usual relief for infringement, to include in the statement of claim a new and wholly different cause of action such as a claim for damages for misrepresentation.[1]

Particulars of Breaches.

The particulars of breaches must be the best that the plaintiff is able to give, but it is obvious that without full discovery the plaintiff cannot give very full particulars. He should give any instances of which he is aware, and may add a general statement as to other infringements. Where the patent has more than one claim the plaintiff should state which claims are alleged to have been infringed.[2]

The particulars should say in what way the de-

[1] United Telephone Co. v. Tasker, 1888, 6 R.P.C. 38.
[2] Haslam v. Hall, 1887, 4 R.P.C. 203.

fendant has infringed, or threatened to infringe, *i.e.*, by manufacture, sale or user, and the plaintiff is bound by these particulars, so that if he has not alleged infringement by manufacture in the particulars, he cannot complain of manufacture at the trial.[1] In cases where the plaintiff is unable to give particulars as to what part of his patent has been infringed, he may apply for an order for liberty to inspect the defendant's alleged infringement before delivery of the statement of claim.[2]

Should state kind of infringement complained of.

Inspection before statement of claim.

Where the alleged infringement is at all complicated, the particulars should specify which part of the article complained of is alleged to infringe.

Complicated machine.

No general rule can be given as to how explicit the particulars need be, except that they must be such as to leave no reasonable doubt in the mind of the defendant as to what is the case he has to meet.

Particulars must show what plaintiff complains of.

It is not necessary for the plaintiff, when alleging that a certain claim has been infringed, to tell the defendant what he considers to be the meaning of that claim.[3]

Particulars need not interpret claim.

In an action for infringement, and not to restrain threatened infringement, evidence of acts by the defendants after the date of the writ is inadmissible.[4]

Infringement after writ.

The particulars of breaches usually state that the plaintiff will claim full compensation in respect of all infringements committed by the defendant up till the date of the judgment.

Compensation claimed for all infringements.

The particulars of breaches form part of the pleadings in the action, and are usually settled by counsel.

If the defendant admits some infringements, but denies all others, the plaintiff can move for judgment on the pleadings; but the inquiry into damages must,

Defendant admitting infringement.

[1] Henser *v.* Hardie, 1894, 11 R.P.C. 421.
[2] Drake *v.* Muntz's Metal Co., 1886, 3 R.P.C. 43.
Wenham Co. *v.* Champion Co., 1891, 8 R.P.C. 22.
[3] Welsbach Incandescent Gas Light Co., Ltd., *v.* Dowle, 1899, 16 R.P.C.
[4] Shoe Machinery Co. *v.* Cutlan, 1895, 12 R.P.C. 342.

in such a case, be confined to the admitted cases of infringement.[1]

Defence.

Three courses are open to the defendant in an action for infringement, success in any one of which will entitle him to judgment in the action. He may show—

Forms of defence.

(1) That the plaintiff is not entitled to sue under the patent;

(2) That he has not infringed, or threatened to infringe, the patent; and

(3) That the patent is bad.

Licencee may not dispute validity,

but may show that plaintiff has no title.

The first course is open to him except when he is a licencee under the plaintiff, and continues to pay royalties to him; for, as long as he is paying royalties, he may not dispute his licensor's title;[2] but, provided he does not continue to pay royalties, it is open to a licencee to show that his licensor's title has expired.[3]

No infringement is a complete defence.

It is, of course, a complete answer to the plaintiff's claim if the defendant can show that he has not done, or threatened to do, anything in infringement of the patent.

Defendant a Licencee.

Licencee need not admit interpretation of patentee.

The fact that a man has taken a licence under the patent does not involve any assumption that the interpretation put on the specification by the patentee is to be accepted by him as the true one.

"A licencee is entitled to have it ascertained what is the ambit, what is the field which is covered by the specification as properly construed; and he is entitled to say, 'Inside of that field I have not come; so far as I have worked, I have worked outside the limit which is

[1] United Telephone Co. *v.* Donohoe, 1886, 31 Ch. D. 399.
[2] Crossley *v.* Dixon, 1863, 10 H.L.C. 304.
[3] Muirhead *v.* The Commercial Cable Co., 1895, 12 R.P.C. 39.

covered by it as properly construed, and therefore I am not bound to make any of those payments which are stipulated in my licence as payments to be made for working the patent '."[1]

Licencee may have ambiguous specification construed by Court.

Thus a licencee, although he may not dispute the validity of the patent, is entitled to have the specification construed by the Court; and if it is ambiguous, or requires explanation, but not unless,[2] he may give evidence of the state of public knowledge at the date of the patent to show that the patentee could not be taken to have intended to include what he is doing.[3]

Special Cases.

Defendant may not always dispute validity.

There are several cases in which the defendant is not allowed to dispute the validity of the plaintiff's patent.

Estoppel by record.

If the question of validity has been determined in a previous action to which he was a party, or if in such an action he has submitted to an injunction, he may not afterwards dispute the validity of the patent.[4]

By being an assignor.

If the defendant has formerly been an owner of the patent, and has assigned his share to the plaintiff, or his predecessor in title, he cannot dispute the validity of the patent, for that would be to derogate from his own grant.[5]

Actual party only is estopped by assignment or by record.

The assignment must have been by the defendant in order to thus bind him; for if the assignment was only by his trustee in the bankruptcy, he is at liberty to dispute the validity of the patent on the ground of want of

[1] Clark *v.* Adie (No. 2), 1877, 2 App. Cas. 426.

[2] Jandus Arc Lamp *v.* Johnson, 1900, 17 R.P.C. 361.

[3] Crosthwaite *v.* Steel, 1889, 6 R.P.C. 190; *cf.* Appleby *v.* Albert Eadie Chain, 1899, 16 R.P.C. 318; Morris *v.* Young, 1895, H.L. 12 R.P.C. 455.

[4] Moore *v.* Thomson, 1890, H.L. 7 R.P.C. 325; Shoe Machinery Co. *v.* Cutlan, 1896, 13 R.P.C. 141.

[5] Chambers *v.* Crichley, 1864, 33 Beav. 374; Walton *v.* Lavater, 1860, 8 C.B.N.S. 162; Oldham *v.* Langmead, 1789, 3 T.R. 441.

novelty, or insufficiency of the specification,[1] or presumably on any other ground.

An assignment by the defendant only binds him, it does not bind his partner;[2] and a like rule applies where the defendant has been the defendant in a previous action.[3]

Licencee is estopped from disputing validity, but may repudiate licence.

If the defendant be a licencee under the patent he cannot dispute its validity;[4] he can, however, at any time repudiate the licence, and from the time of such repudiation the licence terminates;[5] so that a licencee, even by deed, may give notice to the plaintiff that he repudiates the licence, and then, unless he is under covenant not to dispute the validity of the patent, he may raise the question in his defence. It is not, however, sufficient for him simply to plead in his defence that the licence has been abandoned,[6] since this is not notice that such is the case, and until the notice be given he may not dispute the validity of the patent.

Repudiation must precede defence.

Equitable licencee may be estopped.

The rule that a licencee may not dispute validity may in some cases apply also to persons who are only equitable licencees; thus it has been held that the defendant in an infringement action cannot both claim to be an equitable licencee and also question the validity; he must choose one or the other alternative.[7]

Licencee only is estopped.

It is only the actual licencee who is unable to dispute the validity; the fact of a person having been a licencee does not prevent his partner raising the question.[8]

Subject to these limitations, the defendant in his

[1] Smith v. Cropper, 1885, 10 App. Cas. 249.

[2] Heugh v. Chamberlain, 1877, 25 W.R. 742.

[3] Goucher v. Clayton, 1864, 11 Jur. N.S. 107.

[4] Hills v. Laming, 1853, 9 Ex. R. 256.

[5] Redges v. Mulliner, 1893, 10 R.P.C. 21; Crossley v. Dixon, 1863, 10 H.L.C. 293.

[6] Cheetham v. Nuttall, 1893, 10 R.P.C. 321.

[7] Postcard Automatic Supply Co. v. Samuel, 1889, 6 R.P.C. 560; and see Crossley v. Dixon, 1863, 10 H.L.C. 293.

[8] Goucher v. Clayton, 1864, 11 Jur. N.S. 107.

defence usually raises as many of these issues as can be raised with any hope of success. He does not admit the plaintiff's title, he denies that he has infringed, and he alleges that the patent is invalid. Usual defence.

The Act of 1883 provides that—

"The defendant must deliver with his statement of defence, or, by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof. Particulars of objections to validity must be given. Sect. 29, (2), (3).

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

The defence is usually a formal document, and all objections to the validity of the patent are left to be dealt with in the particulars, which are usually settled by counsel. Form of defence.

The particulars of objections in an action for infringement are similar to those in a petition for revocation, and to those required in an action for threats where the validity of the patent is put in issue; and the subject is dealt with in a separate chapter. Form of particulars of objection.

In an action against two defendants an injunction will be granted against one who submits to an injunction, although the other may obtain judgment on the ground of invalidity of the patent;[1] but if one of two joint-defendants defends and the other does not, judgment in default of pleading will not be given against the latter pending the decision of the action.[2] Thus in an action for infringement where there is more than one defendant, one of them may have no defence because he cannot either deny infringement or dispute the patent, since another defendant disputes the validity of his More than one defendant.

[1] Savage *v.* Brindle, 1900, 17 R.P.C. 228.

[2] Actien Gesellschaft für Cartonnagen Industrie *v.* Rennes, 1895, 12 R.P.C. 94.

patent; while, if this defence succeeds, it will enable the other defendant to escape judgment.[1]

No evidence of matter not in particulars. Sect. 29 (4).

Both plaintiff and defendant must be careful to give particulars of all that they intend to put in evidence at the trial, for the Act of 1883 provides that—

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

This rule is strictly enforced,[2] unless leave to amend is asked for, and, as will be seen, this may prove a costly remedy for a defendant.

Particulars may be amended. Act, 1883, sect. 29 (5).

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

Conditions for amendment.

Leave to amend will be given at practically any stage of the action upon terms as to costs.

As a rule the conditions for amending the particulars of objections are, that the defendant shall pay any costs incurred between the delivery of the original and the amended particulars, in case the plaintiff should discontinue within a given time after the delivery of the amended particulars,[3] and that he should pay the costs of the amendment in any event.

Amendment during the trial of the action has been allowed on similar terms.[4]

An application to amend particulars should not be adjourned to the trial.[5]

After trial particulars may be amended pending an appeal, by leave of the Court of Appeal.[6]

[1] Cropper *v.* Smith, 1885, H.L. 2 R.P.C. 17.

[2] Perry *v.* Société des Lunetiers, 1896, 13 R.P.C. 670.

[3] Ehrlich *v.* Ihlee, 1887, 4 R.P.C. 115; Wilson *v.* Wilson, 1899, C.A. 16 R.P.C. 315; Woolley *v.* Broad, 1892, 9 R.P.C. 429.

[4] Chadburn *v.* Michan, 1895, 12 R.P.C. 120, 131; Crosthwaite *v.* Moorwood, 1894, 11 R.P.C. 558; Badische Anilin *v.* La Société Chimique, 1898, 15 R.P.C. 359.

[5] Kelly *v.* Heathman, 1890, 7 R.P.C. 343.

[6] Shoe Manufacturing Company *v.* Cutlan, 1895, C.A. 12 R.P.C. 330 (R.S.C., O. 58, r. 4); Pirrie *v.* York Street Flax Spinning Co., 1894, 11 R.P.C. 431.

An order as to amendment of particulars is not appealable as to costs.[1]

Interlocutory Proceedings.

Inspection.

The Act of 1883 provides that—

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

The plaintiff can, in general, obtain an order entitling him to inspect the defendant's works, if such inspection would assist him in proving his case,[2] even before delivery of his statement of claim.[3] But there is no absolute right to such an order, the granting of it being a matter of judicial discretion to be exercised with due regard to the interests of the parties.[4] Plaintiff can obtain inspection.

Mere suspicion of infringement does not entitle a plaintiff to an order for inspection,[5] a *primâ facie* case must be made out, and the order will be confined to those of the defendant's processes as to which such *primâ facie* case is made out.[6]

Where the plaintiff has been supplied with specimens of the infringing articles, inspection of the defendant's premises will be refused.[7]

The defendant may answer the plaintiff's application for inspection by alleging that it would disclose trade secrets, and in such a case the Court will appoint an independent expert to make a secret report to it on the Defendant may allege trade secret.

[1] Wilson *v.* Wilson, 16 R.P.C. 315.
[2] For Form of Order see Haslam *v.* Goodfellow, 1887, 5 R.P.C. 28.
[3] Drake *v.* Muntz's Metal Co., 1885, 3 R.P.C. 43.
[4] McDougall Bros. *v.* Partington, 1890, 7 R.P.C. 357.
[5] Germ. Milling Co. *v.* Robinson, 1884, 1 R.P.C. 217.
[6] Cheetham *v.* Oldham, 1888, 5 R.P.C. 617.
[7] Sidebottom *v.* Fielden, 1891, 8 R.P.C. 267.

question. An expert appointed for this purpose may not be called as a witness by either side, or at least if called must only be asked such questions as are approved by the judge.[1]

Inspection by defendant.

The plaintiff may also be ordered to give inspection to the defendants of what is being done by him, or under him, under his patent, to put machinery to regular work before them, and to supply samples of what is being made under the patent.[2] If the defendant gives evidence that the plaintiff could procure inspection at the works of a specified third party, the plaintiff will be ordered to apply for such inspection, and, in case of being unsuccessful, to embody the result of his application in an affidavit.[3]

Samples may be ordered.

Inspection is generally required by the defendant when utility is in issue to show that the plaintiff himself does not work according to his patent.

Inspection may also be given in case a prior user be alleged.

Discovery.

Discovery of documents, and by means of interrogatories, is open to both parties as in any other action.

Communications between patentee and patent agent are not privileged, and, where the patent agent is also the plaintiff's solicitor, the plaintiff must, in giving discovery of documents, distinguish between communications between himself and his solicitor as such, and those between himself and his solicitor when acting as his patent agent.[4]

Interrogatories.

Interrogatories must not depend for their relevancy on the construction of the specification.[5]

[1] Plating Co. *v.* Farquharson, 1883, Griff. 187, 17 Ch. D. 49.

[2] Germ. Milling Co. *v.* Robinson, 1885, 3 R.P.C. 11 (where a form of order will be found); Cheetham *v.* Oldham, 1888, 5 R.P.C. 617; Peters *v.* Owen, 1888, 5 R.P.C. 622.

[3] Rylands *v.* Ashley's Patent Bottle Co., 1890, C.A. 7 R.P.C. 175.

[4] Moseley *v.* Victoria Rubber Co., 1886, 3 R.P.C. 351.

[5] Delta Metal *v.* Maxim-Nordenfelt Co., 1891, 8 R.P.C. 169.

The plaintiff is entitled to ask the defendant whether he uses the specific processes described in the specification, taking them one by one, though he may not ask him generally what process he uses.[1]

A defendant must answer an interrogatory asking from whom he obtained goods alleged to infringe.[2]

In an action against a licencee for an account, the plaintiff is entitled on interrogatories to the names of some customers to whom the defendant has sold goods alleged to be made under the licence, although the defendant claims that they were made by a secret process.[3] Licencee. Secret process.

Where general prior user is alleged, the defendant must give the names and addresses of the users, and the places and dates of user, on interrogation.[4] Prior user.

A defendant who denies infringement may be asked if he sold certain specified articles to specified persons, but he cannot, until after judgment, be made to disclose the names of customers in a general way,[5] since if he admits the sale of certain goods, but denies that they are infringements, the question of who purchased them may be irrelevant. Names of customers cannot be asked.

The defendant may interrogate the plaintiff as to whether he has succeeded in using his patented invention without any alterations or additions; but not as to what those alterations or additions are, since this is not necessarily relevant to the matter in dispute.[6] Interrogation of plaintiff as to utility.

In an action with a limited company the opposite party is not entitled to interrogate particular officers or agents of the company, because they have knowledge of the subject-matter of the action acquired otherwise than through, or on behalf of, the company; nor can the Interrogating a company.

[1] Benno Jaffé *v.* Richardson, 1893, 10 R.P.C. 136.

[2] Saccharine Corporation, Ltd., *v.* Haines, Ward & Co., 1898, 15 R.P.C. 344.

[3] Ashworth *v.* Roberts, 1890, 7 R.P.C. 451.

[4] Alliance Pure White Lead Synd. *v.* MacIvor's patents, 1891. 8 R.P.C. 321.

[5] Lister *v.* Norton, 1885, 2 R.P.C. 68; Parker *v.* Wells, 1881, C.A. 18 Ch. D. 477.

[6] Rylands *v.* Ashley's Patent Bottle Co., 1890, C.A. 7 R.P.C. 175.

secretary be compelled to ask for information from the officers and agents of the company, except as to knowledge which they had acquired in the course of their employment by the company.[1] Thus, a reconstruction may be used to obliterate evidence against a patent in the knowledge of a company, since the reconstructed company is, in law, a different person, and has none of the knowledge of the old company.

Consolidation of Actions.

Under the rules of the Supreme Court—

"Causes or matters pending in the same division of the High Court may be consolidated by an order of the Court or a judge in the manner formerly in use in the courts of Common Law."[2]

Consolidation must be on application of defendants.

In these courts actions could be consolidated only at the instance of the defendants;[3] and, if the defendants applied for and obtained an order for consolidating the actions, the plaintiff had to choose which he would proceed with first, and proceedings in the others were stayed until the first had been disposed of.

Defendants only bound by order.

If, in the one tried, the plaintiff was successful, the other defendants were bound by the result; but, if the plaintiff was unsuccessful, he could, unless he had consented to be bound by the result of the first, proceed with the others.

Where first defendant fails to defend.

The orders made in various cases are so worded as only to bind the defendants; but there might be a great hardship inflicted on the other defendants if the one selected for attack did not appear and defend the action, and provision is usually made for such a case.[4]

Appeals.

When several actions have been consolidated, and

[1] Welsbach Incandescent Gas Light Co. *v.* New Sunlight Incandescent Gas Co., 1900, C.A. 17 R.P.C. 401.

[2] R.S.C., O. 49, r. 8.

[3] Amos *v.* Chadwick, 1877, 4 Ch. D. 869; Lush's *Practice*, 3rd ed., p. 965.

[4] See Bovill *v.* Ainscough, 1867, Plimpton *v.* Spiller, 1876, Johnasson *v.* Palgrave, 1880, Lawson, *Pat. Pract.*, 2nd edit., pp. 495 *et seq.*

the defendant in the representative case refuses to appeal against an adverse judgment, the Court may substitute one of the other defendants who are bound by the decision to prosecute an appeal.[1]

Several actions against one defendant.

Although true consolidation applies only when there are several defendants sued by one plaintiff, when several plaintiffs have brought actions against the same defendant the Court may, under its general jurisdiction, extend the time for taking the next step in the rest of the actions until a test action has been tried; and where the first action fails to be a real trial of the issue, a second may be substituted as a test action.[2]

Defendant in test case not defending.

Where an order has been made in one action that another should be treated as a test case, and at the trial the defendant does not appear, this does not affect the binding nature of the test case.[3]

Actions against purchasers.

It often happens that there are a large number of infringements by purchasers, and, in such a case, it is oppressive to commence actions against them all if such a course can be reasonably avoided. If an action on the patent is being fought, it has been laid down that the proper course for the patentee to pursue is to write to each infringer and inform him that he is infringing, but that if he will agree not to raise any objection on the ground of delay proceedings will not be commenced till the pending action has been tried; while, if this be not done, a writ will be issued forthwith asking for the usual relief.[4]

[1] Briton, etc., Life Assurance v. Jones, 1889, 60 L.T. 637.

[2] Amos v. Chadwick, 1877, 4 Ch. D. 869; Bennet v. Lord Bury, 1880, 5 C.P.D. 339.

[3] The Edison United Phonograph Company and The Edison Bell Phonograph Company, Limited, v. T. Lewis Young, 1894, 11 R.P.C. 489.

[4] N. B. Rubber Co. v. Gormully & Jeffry Mantg. Co., 1895, 12 R.P.C. 21.

CHAPTER XV.

REVOCATION OF LETTERS PATENT.

It will be seen that the letters patent are granted subject to the condition—

See p 8.

"that if at any time during the said term it be made to appear to us, our heirs or successors, or our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes".

The Act of 1883 provides that—

Form of proceedings for revocation.
Sect. 26 (1).
Sect. 44 (9).
See p. 251.

"Revocation of a patent may be obtained on petition to the Court."

This does not apply to a patent which has been assigned to the Secretary of State for War, and in relation to which he has certified that it is his opinion that in the interest of the public service the particulars of the invention, and of the manner in which it is to be performed, should be kept secret.

In Scotland.
Sect. 109.

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

"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."

The Act of 1883 provides that—

"Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement, and shall also be a ground of revocation." Grounds for revocation. Sect. 26 (3).

These grounds will be fully discussed in the chapter on Particulars of Objections, and need not be here further mentioned.

In one case it was suggested that a patent for a medicinal preparation which contained poison was bad (presumably as prejudicial or inconvenient to subjects in general), because it was taken out to defeat the provisions of the Pharmacy Acts; but this was declared not to be a ground upon which it could be revoked.[1]

"A petition for revocation of a patent may be presented by— Who may present petitions for revocation. Sect. 26 (4).

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

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

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

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

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

When a person petitions under (*c*), (*d*) or (*e*), he must state in his petition under which head or heads he is petitioning; and, until he has proved that he has a *locus standi* under one of the heads mentioned in the petition, the Court will not entertain any evidence as to the invalidity of the patent.[2] Petitioner must prove his *locus standi*, or petition will not be heard.

Under (*c*) the person who presents the petition must show that the patent was obtained in fraud of his rights, that is, that the patentee has been guilty of dishonest and culpable acts in obtaining it; the petition must be in the

[1] Vaisey's patent, 1894, 11 R.P.C. 592.

[2] Avery's patent, 1887, C.A. 4 R.P.C. 322, 36 Ch. D. 307.

name of the person so defrauded, it cannot be presented by his attorney in his own name.[1] It is more advantageous to present a petition under the head (*c*) than any of the others, since—

Where there is fraud patent may be granted to person defrauded. Act, 1883, sect. 26 (8).

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

When Attorney-General's fiat must be obtained.

Unless the person petitioning can bring himself under (*c*), (*d*) or (*e*), he must obtain the fiat of the Attorney-General authorising him to present the petition.

How to obtain fiat.

A person who desires to obtain the Attorney-General's fiat, must send to the law officer's clerk, at room 549, Royal Courts of Justice, the following documents:—

(1) Memorial to the Attorney-General asking for his authority, and stating all the circumstances. (On judicature paper.)

(2) Statutory declaration verifying the statements in the memorial. (On judicature paper.)

(3) Two copies of the proposed petition, and of the particulars of objections proposed to be delivered.

(4) Certificate by a barrister that the petition is proper to be authorised by the Attorney-General. (On foolscap.)

(5) Certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

(6) Declaration by the applicant that the validity of the patent cannot be disputed in any legal proceedings then pending. (On foolscap.)

[1] Avery's patent, 1887, C.A. 4 R.P.C. 322, 36 Ch. D. 307.

Usually the Attorney-General grants or refuses his fiat *ex parte*, but sometimes he directs notice to be given to the patentee, or persons interested, that they may appear before him and oppose the granting of his fiat.

Fiat may be granted *ex parte*.

The Attorney-General has no power to award costs to any person on an application for his fiat,[1] and, unless by consent they be made costs in the cause, they will not be allowed to a successful petitioner at the trial of the petition.[2]

No costs for proceedings to obtain fiat.

A petition for revocation is a proceeding on behalf of the public, and it is so far not a proceeding *inter partes* that neither party is estopped from raising anew points which have been already decided in a previous action for infringement by the respondent against the petitioner.[3]

Petition is not *inter partes*.

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

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

Particulars of objection must be delivered. Petitioner bound by particulars. Act, 1883, sect. 26 (5), (6).

The particulars of objections in a petition for revocation are similar to those in an action for infringement.

No certificate as to the reasonableness of the particulars is required in a petition for revocation in order to obtain the costs thereof.[4]

The petitioner may obtain directions from the Court as to what persons are to be served with the petition; all parties beneficially interested in the patent should be made respondents to the petition.[5]

There is no power to serve a petition of revocation out of the jurisdiction; but if ample notice be given to the respondent the Court will make an order *nisi* for the

Respondent out of jurisdiction.

[1] Griff. 320.
[2] Rendell's patent, 1894, Lanc. Ct., 11 R.P.C. 277.
[3] Deeley's patent, 1895, C.A. 12 R.P.C. 199.
[4] Gaulard & Gibbs' patent, 1888, 5 R.P.C. 526; C.A. 6 R.P.C. 215.
[5] Avery's patent, 1887, 4 R.P.C. 152, C.A. 322.

petition to be set down for trial in the list of witness actions.[1]

First hearing of petition.

The petition is usually filed in the Chancery Division, and comes into the ordinary petition list, when directions should be applied for as to the mode of trial, a summons for such directions being unnecessary.[2]

A patentee abroad must have notice of the petition before the patent can be revoked,[3] and notice by registered letter will be ordered, and is sufficient.[4]

An unopposed petition will be granted with costs,[5] except in the case of a foreign respondent who has not appeared, when no order will be made as to costs.[6]

When revocation is unopposed.

When the respondent appears and consents to the revocation, an order for revocation will be made with costs without evidence being taken.[7] And the respondent may save costs by going to Chambers to consent to an order with costs, and so avoid having the petition set down.[8]

When opposed usually tried as witness action.

As a general rule, when the respondent appears and opposes the revocation, he applies for the petition to be tried on *viva voce* evidence, and in that event the Court will make an order that either party shall be at liberty to set it down in the witness list after a certain day.[9]

No security for costs by respondent.

If a foreign respondent applies to have a petition for revocation tried on *viva voce* evidence, he will not have to give security for costs.[10]

[1] Drummond's patent, 1889, 43 Ch. D. 80, 6 R.P.C. 576, 50 L.J. Ch. 576; *cf.* Görz & Högh's patent [1895], W.N. 105; Allison's patent, 1900, 17 R.P.C. 297.

[2] Miller's patent, 1894, 11 R.P.C. 55.

[3] *In re* Kay's patent, Stirling, J., 1894, 11 R.P.C. 279; La Compagnie Generale d'Eaux, etc., 1891, 8 R.P.C. 446; [1891] 3 Ch. 451; Drummond's patent, 1889, 43 Ch. D. 80, 6 R.P.C. 576.

[4] *In re* Hirschfeld's patent, 1894, 11 R.P.C. 515; *In re* Allison's patent, 1900, 17 R.P.C. 297.

[5] Wallace's patent, 1895, 12 R.P.C. 444.

[6] *In re* Cercel's patent, 1898, 15 R.P.C. 500.

[7] Sleight's patent, 1893, 10 R.P.C. 447.

[8] Scott's patent, 1903, 20 R.P.C. 604.

[9] *In re* Borrowman's patent, 1902, 19 R.P.C. 159.

[10] Miller's patent, 1894, 11 R.P.C. 55.

A petition for revocation almost exactly resembles an action in the manner in which it is conducted; interrogatories may be administered, and discovery and inspection ordered, as in an action for infringement.[1] These should be asked for when the petition comes on in the ordinary petition list.[2]

Conduct of petition before trial.

The petition may be sent for trial to the assizes, and when fraud is alleged the trial may be ordered to be by jury.[3] See chapter xviii. on Trial.

Trial may be at assizes.

Jury.

At the trial—

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

Respondent commences. Act, 1883, sect. 26 (7).

The costs of a petition of revocation usually follow the event. While the petition is pending, the patentee may apply to the Court for leave to apply to amend his specification by disclaimer, but not in any other way,[4] and the petition will be stayed pending the amendment being made.

Costs.

Amendment pending petition. Act, 1883, sect. 19.

The usual terms on which leave to apply to amend is granted are, that the respondent should pay the costs of the application for leave to apply, and the costs of the petition down to the date of such application, except so far as what has been already done may be utilised in subsequent proceedings; and, should the petitioners after amendment decide not to continue the petition, that the respondent should pay all the petitioner's costs of the petition.[5]

An application for leave to apply to amend is usually made by summons, but may be made by motion.[6]

[1] Haddan's patent, 1885, Griff. 108; 54 L.J. Ch. 126.

[2] Scott's patent, 1902, 19 R.P.C. 273 (per Buckley, J.).

[3] Edge *v.* Harrison, 1891, 8 R.P.C. 74.

[4] *In re* Owen's patent, 1898 [1899], 1 Ch. 157, 15 R.P.C. 755.

[5] *In re* Chatwood's patent, 1899, 16 R.P.C. 370; *In re* Gaulard & Gibb's patent, 1888, 57 L.J. Ch. 209; *In re* Deeley's patent, 1894, 11 R.P.C. 72; see also *In re* Delwick's patent [1896], 2 Ch. 705.

[6] *In re* Delwick's patent [1896], 2 Ch. 705.

Successive amendments possible.

Leave to apply to amend may be given more than once in the course of an action,[1] and, no doubt, the same would apply to a petition.

If the petitioner succeeds at the trial, the Court will declare the patent invalid and order its revocation. This is carried out by registration of the order at the Patent Office.

The Court can and will stay registration of the order for revocation pending an appeal.[2]

Where a patent has been revoked in the Court of first instance, and the Court of Appeal has ordered security to be given for the costs of the appeal, the Court can order the appeal to be dismissed, unless the security be given before a fixed date.[3]

Where invalidity might be cured by amendment.

If the invalidity of the patent is curable by amendment, the Court will, on the application of the respondent, suspend for a time the registration of the order for revocation, in order that the patentee may apply for leave to amend his specification, and, if such leave be obtained, suspend registration altogether, or it may make the order conditional[4] on leave to amend not being obtained on an application to be made within a limited time. A conditional order of this nature has hitherto been made where amendment by disclaimer only was necessary; but, since a pending appeal is not a pending action,[5] there seems no reason why the amendment in such a case should be restricted to disclaimer.

[1] Chatwood's Patent Safe *v.* Mercantile Bank of Lancashire, 1900, 17 R.P.C. 23.

[2] *In re* Armstrong's patent, 1897, C.A. 14 R.P.C. 747.

[3] *In re* Owen's patent, 1900, C.A. 17 R.P.C. 637.

[4] Deeley *v.* Perkes, 1896, H.L. 13 R.P.C. 581; Scott's patent, 1903, 20 R.P.C. 264.

[5] Cropper *v.* Smith, 1884, 28 Ch. D. 151.

Petition Pending Amendment.

A petition for revocation commenced after an application has been made to amend the specification will be adjourned till after the proceedings for amendment,[1] the latter not being in any way affected by the petition.[2]

In making such a conditional order the Court has a discretion as to the terms which it will impose as a condition for the indulgence; and an exercise of this discretion will not be reviewed by the Court of Appeal except in an exceptional case.[3]

[1] Deeley's patent, 1894, 11 R.P.C. 72.
[2] Woolfe *v.* Automatic Picture Gallery, 1903, C.A. 20 R.P.C. 177.
[3] *Re* Geipel's patent, C.A. (1904), 1 Ch. 239.

CHAPTER XVI.

THREATS.

To bring actions.

A PATENTEE not only has the right of bringing actions and recovering damages against those who infringe his

Patentee may threaten to bring actions.

patent, but he may, by threats, endeavour to prevent others from infringing. It is open to him to say, "I have a patent for this invention, and I give warning that I may bring an action against any one whom I find infringing my patent".

Purchaser of infringement is liable.

Now, the purchaser of an infringing article, if he uses that article, is liable for infringement of the patent; and, in most cases, the advantage he would obtain by purchasing an infringing article instead of one made by, or under licence from, the patentee, would be very small compared with the loss he would inevitably suffer were he made the defendant in an action for infringement. It is, therefore, very probable that if an intending purchaser be aware that an article is the subject of a patent,

Purchaser would probably prefer not to infringe.

he will take care not to run the risk of infringing, and will consequently purchase the licenced rather than the infringing article. It seems, then, that threats against the purchasers of infringing articles are very likely to be

Warning to purchasers may stop infringement.

of use to the patentee, and, if he has any reason to suspect that his patent is being infringed, he should take every opportunity of warning the public of the possible consequences of infringement.

Patentee not obliged to sue for an infringement.

A patentee is not obliged to bring an action against every person he may find infringing his patent, even though he may have threatened in a general way to bring

actions. The expense of even a successful patent action is usually considerable, and a patentee could hardly be expected to take proceedings against any infringer unless he could feel certain of actually obtaining any damages and costs that might be awarded to him if successful. Even if he fully believes that his patent is valid, a patentee may well find that by means of threats he can keep the amount of infringement within such narrow limits that his loss of profits by them is not so great as to justify him in incurring the cost of an action.

Threats might avoid necessity for action.

In any case the patentee will probably consider prevention better than cure, and deem an advertisement containing a threat at least not inferior to one of a more peaceful nature; and, as there is always great risk in a patent action, if a patentee can prevent infringement by means of threats, it will, in almost all cases, be to his advantage to do so.

Prevention better than cure.

An action is always risky.

If the threats are intended only to prevent possible infringements of a valid patent, they cannot injure anybody, since the most they can do is to prevent wrongful competition with the patentee's monopoly.

Injury by threats to others.

It may happen, however, that there are infringements going on, and the effect of the patentee's threats may be very serious for those who have actually commenced competing with him; for threats, if effectively used, may entirely ruin the trade of such rivals.

Threats may do serious injury,

If the patent be valid, the ruin of their trade will not be any injustice to the rivals of the patentee, since their competition is an illegal one; but if the patent be invalid, there is no reason why its possessor should be placed in a more favourable position than his rivals.

but no damage. if patent be good.

Now, we have seen that the grant of a patent is of itself no guarantee whatever of the novelty of the invention, and thus it may happen that the possessor of a patent can ruin his rivals in trade by threatening to bring actions which could not be carried to a successful termination, because the patent itself was invalid; and yet,

Patent no guarantee of novelty.

Threats might prevent validity being contested.

as the patentee might prefer to threaten only, and not to run the risk of an action, the validity of the patent might never come in dispute unless some one took proceedings to get the patent revoked.

Patent might be ambiguous.

Again, the wording of the patent may be such that without judicial interpretation there is a doubt as to whether what is being done in competition with the patentee is really an infringement at all, and this cannot be well determined in proceedings for revocation of the patent.

In order to prevent a patentee continuing to threaten indefinitely without putting his patent into court, the Act of 1883 provided that--

Limitation of threats. Act, 1883, sect. 32.

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

Person threatening must bring action.

What constitutes a threat.

The first question which arises on this section is what is meant by "threatening any other person". How far can it be taken to apply to a general threat to bring actions against infringers?

General warnings may be threats.

In 1887 it was laid down by the Court of Appeal that "Everybody has still a right to issue a general warning to pirates not to pirate, and to infringers not to infringe, and to warn the public that the patent to which the patentee is entitled, and under which he claims, is one which he intends to enforce; but it does not follow that because a threat is so worded as in mere language apparently and grammatically to apply only to the future, that therefore it may not be in any particular case in substance and in fact applicable to what has been done.

It might be really directed against the sale and manufacture of some machines which the patentee considered infringements, and would none the less be a threat because it was worded in a general way as a warning to all persons not to infringe." [1]

In 1891 it was suggested that this section of the act, being limited to threats, did not subject a patentee to an action for publishing a general statement that he claimed to be the owner of a valid patent, which covered all articles of a particular description.[2] But, in the succeeding year, the Court of Appeal again affirmed the doctrine that a general warning may be a threat; and that the threat may, in fact, be directed against a particular infringement, and render the patentee liable to an action.[3]

And in the year following, in the Court of Appeal, the following was held to be the effect of the section :—

"The object of the section was to give an action for damages where there was not one before, and to enable an action to be brought against a man who uses threats, unless he will or does follow up his threats by commencing an action himself.

"You are not to threaten, even in a general kind of way, which might not be regarded as a threat to any particular person; you are not to do it even by a circular or advertisement; but, if you do threaten, no action is to lie against you if you will prosecute the person who is aimed at by your threats.

Not even general threats are allowed unless the threatener is qualified under the Act.

"The Legislature desires that threats of patent actions shall not hang over a man's head, that the sword of Damocles, in such a case, should either not be suspended, or should fall at once; and it is with that view that the section seems to be framed.

"You shall not threaten legal proceedings unless the

[1] Challender *v.* Royle, 1887, C.A. 4 R.P.C. 375, 36 Ch. D. 425.
[2] Ungar *v.* Sugg, 1891, 8 R.P.C. 385; C.A. 9 R.P.C. 114.
[3] Johnson *v.* Edge, 1892, C.A. 9 R.P.C. 142.

manufacture to which the threat applies infringes the legal right of the threatener, or unless the threatener is about to forthwith bring an action to show the validity of his threats. If he cannot bring himself within these two saving clauses at the end of the section, then the section absolutely forbids a man threatening legal proceedings with regard to a patent at all."[1]

Conditions under which threats may be issued.

It thus appears that there are only two conditions under which a person can use even the most general kind of threat without being liable for any damage which his threats may cause. It will be well to examine these two conditions carefully, and to see exactly what each amounts to.

Must prove infringement of legal right,

The first is that he shall be able to show that the manufacture, to which the threat applies, infringes a legal right belonging to him. In order to do this he must have a legal, as distinguished from an equitable, title to the patent,[2] and must also be able to show that his patent is a valid one, for if not he has no legal rights; you cannot infringe a bad patent.[3] He must also prove that his threats were directed only against manufactures which came within the scope of his patent.

or must commence an action.

The other alternative is for him to commence an action for infringement, and to prosecute it with due diligence. The action must be brought by the person who threatens,[4] and must be a *bonâ fide* action for infringement, and not a collusive action;[5] it need not be brought against the person who is the plaintiff in the action for threats, but it will require a great deal to prove that an action brought against the plaintiff in an action for threats is not *bonâ fide*.[6]

Action may be against any infringer.

An advantage to sue plaintiff for threats.

[1] Skinner *v.* Perry, 1893, C.A. 10 R.P.C. 1.

[2] Kensington Electric, etc., *v.* Lane Fox Electrical, 1891, 8 R.P.C. 277; [1891] 2 Ch. 573.

[3] Blakey *v.* Latham, 1889, C.A. 6 R.P.C. 190.

[4] Kensington Electric, etc., *v.* Lane Fox Electrical, 1891, 8 R.P.C. 277.

[5] Challender *v.* Royle, 1887, C.A. 36 Ch. D. 425, 4 R.P.C. 363.

[6] Colley *v.* Hart, 1890, 7 R.P.C. 101.

The action need not be such as to test the validity of the patent; an action for royalties against a licencee who cannot dispute the vaiidity of the patent is sufficient to bring the patentee within the proviso.[1]

Action need not test validity.

If the action for infringement be commenced before the commencement of the action for threats, the latter action will be vexatious;[2] but the bringing of an action for infringement does not form a defence to an action for threats when what is done by the plaintiff in the action for threats is not similar to that for which the action for infringement is brought.[3]

Action for threats after *an infringement* action is vexatious. Both actions must be on same kind of infringement.

The action, then, must be for an infringement of the same class as that which is threatened; and it must also be commenced and prosecuted with due diligence.

The question as to what constitutes due diligence in commencing an action for infringement depends entirely on the circumstances of the case, and no rule can be laid down.[4]

What is due diligence?

When a patentee has had an action for threats commenced against him, he is justified in waiting a reasonable time to have a statement of claim delivered, and see whether he can combine the action for infringement with the action for threats by a counter-claim.[5] In one case, when the threats had been continued for over a year, and then the patentee, on being sued to restrain the threats, waited to counter-claim for infringement, and the counter-claim was unsuccessful, it was held that he had not brought an action with due diligence.[6] But in a more recent case, in which the threats had been continued over a long period, no action being taken, and the person aggrieved brought an action to restrain the threats, the

Action may be by counter-claim.

An unsuccessful counter-claim may not be a good defence.

[1] Day *v.* Foster, 1890, 7 R.P.C. 54.

[2] Barrett *v.* Day, 1890, 7 R.P.C. 54.

[3] Combined Weighing Machine Co. *v.* Automatic Weighing Machine Co., 1889, 6 R.P.C. 502.

[4] Colley *v.* Hart, 1890, 7 R.P.C. 101.

[5] *Ibid.*

[6] Herrburger *v.* Squire, 1888, 5 R.P.C. 581.

Patentee not certain of infringement.

defendants, on a motion for interim injunction to restrain the threats, stated that they could not be sure as to whether the plaintiff did actually infringe, and got an order for inspection of the plaintiff's works. After this they commenced an action for infringement, and the application for an injunction to restrain the threats was refused.[1]

Action need not be successful.

Provided that it is commenced and prosecuted with due diligence, the action for infringement need not be successful in order to protect the patentee from liability

Patentee may threaten while action pending.

for the damage caused by his threats. He may, as long as he is duly prosecuting his action for infringement, continue to threaten, and it is not contempt of court to go so far as to say that users of infringing articles are liable to damages and injunction in respect of such user.[2]

Action may be discontinued.

If, at any time during the prosecution of his action, the patentee finds that it is hopeless to continue the action, he may discontinue it without losing his defence to any action for threats already issued. The action for infringement in order to be a good defence need not be successful, and whether it be dismissed at the trial or discontinued when its further prosecution is hopeless makes no difference.[3] It is right to discontinue and not to go on with a hopeless action, and discontinuance is no evidence of *mala fides* in having commenced the action.[4]

Due diligence a question of fact.

If an action for infringement be commenced *bonâ fide*, but be not prosecuted with due diligence, it is no defence to an action for threats. These matters are questions of fact for the jury. If two actions have been commenced against the plaintiff, and not duly prosecuted, independent damages may be given in respect of each.[5]

[1] Edlin *v.* Pneumatic Tyre, etc., 1893, 10 R.P.C. 311.
[2] Fenner *v.* Wilson, 1893, C.A. 10 R.P.C. 283.
[3] Colley *v.* Hart, 1890, 7 R.P.C. 111.
[4] English and American *v.* Gare Machine, 1894, 11 R.P.C. 627.
[5] Bishop *v.* Inman and others, 1900, 17 R.P.C. 749.

As the law stands at present it seems as if the owner of even a hopelessly bad patent may safely use threats, provided he brings an action for infringement against some one within a reasonable time; and if, before a reasonable time has expired, any one commences an action to restrain his threats, he may wait until the time comes for delivering a defence, and then raise the question of infringement by way of counter-claim. Summary of law of threats.

Action for Threats.

In an action for threats, the plaintiff is entitled to particulars of the patents under which the threats are issued.[1] Particulars of patents.

The defendant is entitled to particulars of the threats complained of before putting in a defence, but not to the names of customers whom the plaintiff has, in consequence of the threats, promised to indemnify.[2] Particulars of threats.

Where the plaintiff alleges threats by the defendant's agents, particulars of the agents as well as of the threats must be given.[3] Particulars of agents.

The plaintiff in his statement of claim usually alleges that the patent is bad for the reasons given in the particulars of objections, and claims a declaration that the patent is invalid.[4] Plaintiff for threats may allege invalidity;

The particulars of objections are similar to those required in other patent actions, and should be delivered with the pleading which denies the validity.

Where, however, the statement of claim does not allege invalidity, and the defence alleges validity, the but if not, invalidity may be raised by reply.

[1] Union Electrical Power Co. *v.* Electrical Power Storage, 1888, C.A. 5 R.P.C. 329, 38 Ch. D. 325.

[2] Law *v.* Ashworth, 1890, 7 R.P.C. 86 (Lancaster Court Case).

[3] Dowson Taylor & Co. Ltd. *v.* The Drosophore Co. Ltd., 1894, 11 R.P.C. 536 (Lancaster Court Case).

[4] Challender *v.* Royle, 1887, C.A. 4 R.P.C. 363; Union Electrical Power Co. *v.* Electrical Power Storage, 1888, C.A. 5 R.P.C. 329, 38 Ch. D. 325.

invalidity may be set up in the reply, but in that case leave for a special rejoinder will be given.[1]

Claims in action for threats.

The plaintiff claims damages for past injuries, and an injunction to restrain threats. If he commences his action without great delay he will, as a rule, apply for

Interim injunction.

an interim injunction; but where an action for infringement is being prosecuted with due diligence no interim injunction will be granted.[2]

Where an action for infringement is pending, an interlocutory injunction will not be granted in a threats action for restraining threats, commenced subsequently to the infringement action, on the ground that the latter is not *bonâ fide*.[3]

An interlocutory injunction will not be granted where there is a dispute as to the *mala fides* of threats, and also a denial of having threatened at all, no patents being alleged.[4]

Patentee abroad.

An injunction will be granted *ex parte* against foreign patentees to restrain threats by their solicitors in England, the latter being made parties to the proceedings.[5]

Staying of threats action.

If an action for infringement be commenced by the defendant in a threats action against the plaintiff, the latter action will be stayed, and the costs made costs in the infringement action;[6] but this rule does not apply unless the infringement action involves all the patents upon which the threats are based.[7]

Damages for threats.

The damage must be really due to the threats, and not to general rumours in the trade, and the natural dis-

[1] Dowson Taylor & Co., Ltd., *v.* The Drosophore Co., Ltd., 1895, C.A. 12 R.P.C. 95.

[2] Kurtz *v.* Spence, 1887, C.A. 4 R.P.C. 427.

[3] Berliner *v.* Edison-Bell Consolidated Phonograph, 1899, 16 R.P.C. 336.

[4] Barber *v.* Nathan & Somers, 1902, 19 R.P.C. 331.

[5] Overton *v.* Burn, Lowe & Sons, 1896, 13 R.P.C. 455.

[6] Household *v.* Fairburn, 1884, 1 R.P.C. 109.

[7] Dowson Taylor *v.* The Drosophore Co., 1895, C.A. 12 R.P.C. 95.

inclination of people to run any risk of an action. The question of the amount of damages should be dealt with at the trial, and not referred.[1]

Where a contract is stopped by reason of threats, the loss of profits is a proper measure of damages.[2]

Although the question of the validity of a patent can be tried in an action for threats, it is doubtful whether a valid certificate of validity can be given.[3]

When the validity of the patent is in issue the defendant commences, and the procedure is similar to that in an action for infringement.

Where there is a counter-claim for infringement in an action to restrain threats, which is down for trial with a jury, the question of infringement will not be withdrawn from the jury.[4]

Circulating threats by other people.

An injunction restraining the defendants, their servants and agents, "from threatening the plaintiffs, or any of the plaintiff's customers, with any legal proceedings or liability in respect of the manufacture, sale or purchase of a machine," does not prevent them circulating threats made by the manufacturer of the machine, even though the defendants are his regular agents for its sale.[5]

Undertaking not to threaten.

Notice of pending action not a threat.

An undertaking in a threats action not to threaten any person by letters, circulars, advertisements or otherwise, with legal proceedings on liability in respect of the manufacture, sale, use or purchase of an invention, and not to allege that such manufacture, use, sale or purchase is an infringement of letters patent belonging to the person giving such undertaking, has been held to be no bar to an action for infringement by such person against the person to whom the undertaking was given, or to his

[1] Ungar v. Sugg, 1891, 8 R.P.C. 385; C.A. 9 R.P.C. 114.
[2] Skinnner v. Perry, 1894, 11 R.P.C. 406.
[3] Crampton v. Patent Investments Co., Ltd., 1888, 5 R.P.C. 404.
[4] Appleby v. Albert Eadie Chain, 1899, 16 R.P.C. 318.
[5] Ellams v. Martyn & Co. [1899], C.A. 16 R.P.C. 28.

informing a customer that such action had been commenced.[1]

Statute of Monopolies, Section 4.

A threat under a patent, the specification of which requires amendment in order to validate the patent, does not render the patentee liable for treble damages under Statute of Monopolies, section 4, since the section does not apply to letters patent for alleged new inventions.[2]

[1] Bevan *v.* Welsbach Incandescent, 1903, 20 R.P.C. 69.
[2] Peck *v.* Hinder, 1898, 15 R.P.C. 113.

CHAPTER XVII.

PARTICULARS OF OBJECTIONS.

Particulars of objections required whenever validity is challenged.

WHENEVER the validity of a patent is challenged in any proceeding at law, whether in an action for infringement or for threats, or in a petition for revocation, the party who challenges validity must deliver to the party upon whom the task of defending the patent will fall particulars of his objections to the validity of the patent which is challenged.

At the trial the challenger is confined to the particulars he has delivered, so that it is most important for them to embrace every objection that can be fairly taken to the patent; at the same time, various judges have commented severely on the very loose way in which particulars are often framed, and on the inclusion in them of objections for sustaining which no evidence is given, and which are really wholly inapplicable.

Claims must be specified.

The particulars should, where necessary, specify the claims against which they are directed, and should in every case be made as precise as possible.

Feeble objections should be avoided.

In making out particulars of objections, quality is of far greater importance than quantity. A single good objection is sufficient to invalidate a patent; and, although it is, of course, better to find more than one point against which an attack may be directed, it should always be remembered that one strong objection is better than a dozen weak ones, and that if an objection cannot be sustained its inclusion is a sign of weakness.

It is not, as a rule, advisable to raise objections on

trivial matters in the specification, as a number of trivial objections may incline the Court to favour the patent. In one case, where the only real issue was that of validity, which was decided in favour of the patent, Lord Esher, M.R., in dismissing an appeal, used the following words :—

"The defendants have used the exact thing that has been patented; they have used it to a considerable extent, but they say, 'Your patent is a bad one, you cannot sue upon it'; and they have taken, by way of objection, every one of the ordinary objections which are taken under such circumstances—that is to say, they spell every paragraph and every line in the patent, and try to persuade the Court that some one line or some one sentence in it is so bad that it makes the whole of the patent bad, and prevents the inventor from having the benefit of his invention, however useful or however great it may be. I do not hesitate to say myself that when that is the sort of defence in such a case, the Court ought to look carefully to see whether any one of these objections can be sustained. The Court certainly, under those circumstances, ought not to favour the objection. Those who take such objections as that must prove them strictly."[1]

Some of the following objections will usually be found applicable when the validity of the patent is open to attack.

True and first inventor. *Cf.* p. 33.

(*a*) "That the plaintiff (*or the person to whom the patent was granted where there has been an assignment*) was not the true and first inventor of the alleged invention in respect of which the said letters patent were granted."

This objection is often used very loosely, but it is really applicable only when it is intended to show that the plaintiff obtained the invention from some other person. It is not a correct way of alleging want of novelty.[2]

The burden of proving that the patentee was not the first and true inventor lies on the defendant.[3]

Invention not proper subject-matter.

(*b*) "That the alleged invention is not proper subject-matter for letters patent."

[1] Edison-Bell Phonograph Corporation Ltd. *v.* Smith & Young, 1894, C.A. 11 R.P.C. 395.

[2] Thomson *v.* Macdonald & Co., 1891, 8 R.P.C. 9.

[3] Ward Bros. *v.* J. Hill & Son, 1901, 18 R.P.C. 481; *cf.* Young *v.* White, 1853, 23 L.J. Ch. 190.

This is applicable only when the alleged invention is *primâ facie* not proper subject-matter; *e.g.*, if it is for a principle, or for an illegal or immoral purpose, the ground on which subject-matter is impeached ought to be stated. *Cf.* p. 14.

(*c*) "That the alleged invention is not useful." Invention not useful.

This is frequently introduced, though but rarely is it of any avail to the defendant. If, however, it can be sustained, it is a good objection. *Cf.* p. 29.

It sometimes happens that the patentee himself has never used the invention as described, though doing something of a similar kind, and in such case this is strong evidence of inutility, since what must be useful is what is described and claimed in the specification and not what the inventor is actually doing.

(*d*) "The complete specification does not sufficiently describe and ascertain the nature of the alleged invention comprised therein, and in what manner the same is to be performed. In that, etc. (adding wherein the insufficiency lies)." Specification insufficient. *Cf.* p. 65.

This particular must contain particulars of the parts of the invention which are alleged to be insufficiently described if the defendant is able to point them out.[1]

(*e*) "The specification is ambiguous in that . . ." Specification ambiguous.

Instructions issued by the patentee for working the invention are material on a question of sufficiency.[2] *Cf.* p. 68.

This particular should point out in what way the specification is ambiguous.[3]

(*f*) "That the alleged invention described in the complete specification is different from that described in the provisional specification and title (or one of them) in that . . ." Disconformity. *Cf.* p. 64.

This particular must state in what way the inventions described in the specifications differ from one another.[4]

[1] Crompton *v.* Anglo-American Brush Corporation, 1887, C.A. 4 R.P.C. 197 : 35 Ch. D. 283.

[2] Pooley *v.* Pointon, 1885, 2 R.P.C. 167, 172.

[3] Heathfield *v.* Greenway, 1894, 11 R.P.C. 17.

[4] Anglo-American Brush Corporation *v.* Crompton, 1887, C.A. 4 R.P.C. 27.

The proof of disconformity lies on the defendant.[1]

The question of disconformity is one of law, and unless new facts bearing upon the question of construction can be brought before the Court, the Court is bound by a former decision thereon.[2]

Enlargement by amendment. *Cf.* p. 110.

(*g*) "That the amendment of the complete specification enlarged the scope of the alleged invention, and was obtained by fraud in that . . ."

Particulars of the enlargement and of the fraud must be given. This objection will very rarely be available. It is not easy to see what fraud, other than the bribery of some official at the Patent Office, would be sufficient.

Concealment by patentee. *Cf.* p. 66.

(*h*) "That the complete specification did not describe the most beneficial method of carrying out his alleged invention with which the plaintiff was then acquainted."

This should be used only when the defendant is able to point out something which he can show was within the knowledge of the plaintiff at the date of filing the complete specification, and which was omitted therefrom; the particular should mention what is complained of.

False suggestion. See p. 9.

(*i*) "That the letters patent were granted on a false suggestion that . . ."

Particulars of the false suggestion should be given, such as of any words in the complete specification which might tend to mislead. This objection in its most general form, and the similar one "that the Crown was deceived," are often used in a very loose manner.

Crown deceived.

A false suggestion as to the utility of parts of a process described in a specification may invalidate the patent.[3]

This objection might possibly be available in the case of a patent obtained by a foreign manufacturer to prevent manufacture in this country. (See p. 96.)

[1] Ward Bros. *v.* J. Hill & Son, 1901, 18 R.P.C. 481.

[2] Pneumatic Tyre Co. *v.* Leicester Pneumatic Tyre Co., 1899, C.A. 16 R.P.C. 50.

[3] *In re* Owen's patent, 1899 (No. 12, 368 of 1896), 17 R.P.C. 68, following Morgan *v.* Seaward. 2 M. & W., 561.

(*j*) "That the subject matter of claim of the plaintiff's patent was the subject of a prior grant of monopoly by letters patent, No. , dated ." Prior grant.

Particulars of objection on the ground of prior grant must specify the claims alleged to be covered by the prior grant.[1]

An invalid grant cannot be set up as a prior grant for defeating a patent subsequently applied for.[2]

(*k*) "That the alleged invention was anticipated in the following prior publications." Invention anticipated by prior publication. *Cf.* p. 24.

If the prior publications be specifications of English patents, the publication need not be proved; but, in any other case, the time and place of publication must be given in the particulars. In specification; in other publications.

The parts relied on as anticipations should be specified, not necessarily pages and lines, though this is generally advisable, but where the anticipation is to be found, and what it is;[3] but if defendants allege that they rely on the whole of a specification, further and better particulars will not be ordered, and this is very often done to save trouble.[4] Particulars should be very definite.

In the case of a patent granted on an application made after the date prescribed by the Board of Trade for the coming into effect of section 1 of the Patents Act, 1902, the specification of a British patent, granted more than fifty years before the date of the application, is not available as an anticipation.[5]

It is improper to refer in the particulars of objection to publications which are to be merely used in evidence, and which are not put forward as objections to the

[1] Birmingham Pneumatic Tyre Syndicate *v.* Reliance Tyre Co., 1900, 17 R.P.C. 277.

[2] The Mica Insulator Co. *v.* The Electrical Co., 1898, 15 R.P.C. 489.

[3] Holliday *v.* Heppenstall, 1889, C.A. 6 R.P.C. 320.

[4] Edison-Bell Consolidated Phonograph Co. *v.* Columbia Phonograph Co., 1900, 18 R.P.C. 4.

[5] Patents Act, 1902, sect. 1 (10).

validity of the patent in dispute, and the costs of such improper particulars will not be allowed.[1]

Anticipation by prior public user must be definite. *Cf.* p. 22.

(*l*) "That the alleged invention was anticipated by prior public user by at on ."

This particular must give the details of the prior user; it should specify the persons by whom, the places where, the dates at and the manner in which the prior user took place.[2]

It is not sufficient to allege prior user over a space of several years many years ago.[3] If general user in a locality is alleged, the plaintiff may interrogate as to the names and addresses of those who so used the invention.[4]

No order for inspection of anticipating machines not in the possession, or under the control, of the defendant will be made unless by consent.[5]

Considering public knowledge no subject-matter. *Cf.* p. 17.

(*m*) "Considering the state of public knowledge at the date of the patent, the alleged invention was not proper subject-matter for the grant of letters patent."

Public knowledge is a matter for evidence.

No particulars of the public knowledge need be given,[6] though it is not unusual to state that the specifications and publications put forward as prior publications will be relied on as evidence of the state of public knowledge.

A specification is no proof of public knowledge,

The specification of a prior patent is not evidence of much value as to prior public knowledge,[7] which must be proved by ordinary evidence, as by that of persons

[1] Acetylene Illuminating Co. *v.* United Alkali Co., 1902, 19 R.P.C. 213, 234.

[2] Penn *v.* Bibby, 1866, L.R. 1 Eq. 548.

[3] Smith *v.* Lang, 1890, C.A. 7 R.P.C. 148.

[4] Alliance Pure White Lead Syndicate *v.* MacIvor's patents, Ltd., 1891, 8 R.P.C. 321.

[5] Garrard *v.* Edge, 1889, C.A. 6 R.P.C. 372; Sidebottom *v.* Fielden Pal. Ct., Lancashire, 1891, 8 R.P.C. 266.

[6] Boxwell *v.* Cochran, 1895, 12 R.P.C. 169.

[7] Peckover *v.* Rowland, 1893, 10 R.P.C. 118.

engaged in the trade, though well-known books may also be referred to.[1]

but books are evidence.

The knowledge of a particular man is not public knowledge, though it may be an anticipation,[2] since even a single person must not be restrained by a patent from doing that which he was able to do before the date of the grant.

Knowledge of one person not public knowledge.

As evidence of common knowledge a defendant may, if he has given notice in his particulars of objections of his intention so to do, but not unless, refer to a single specification, though where several publications are relied on no reference is necessary.[3]

Single specification may not be referred to without notice.

No notice if several publications are referred to.

On an objection on the ground of want of novelty evidence of want of subject-matter may be given.[4]

Sometimes objections (*b*), (*e*), (*f*), (*l*) and (*m*) are put in a hypothetical form, "If the complete specification be construed so as to include the alleged infringement, then," etc.

Hypothetical form of objections.

(*n*) "That the said letters patent are contrary to law, mischievous to the state by raising the prices of commodities at home, and hurt of trade and generally inconvenient."

(*o*) "That the said letters patent are prejudicial and inconvenient to the subjects of the Crown in general by preventing the growth of industries within the realm."

These may be applicable where a grant of monopoly has been abused. (See p. 96.)

Amendment of Particulars of Objection. (See p. 125.)

[1] Holliday *v.* Heppenstall, 1889, C.A. 6 R.P.C. 320.

[2] Benno Jaffé Fabrik *v.* Richardson, 1894, 11 R.P.C. 102.

[3] English and American Machinery Co., Ltd., *v.* Union Boot and Shoe Machine Co., Ltd., 1894, C.A. 11 R.P.C. 367; Sutcliffe *v.* Abbott, 1903, 20 R.P.C. 50.

[4] Electrolytic Plating Apparatus Co. *v.* Holland, 1901, 18 R.P.C. 521.

CHAPTER XVIII.

TRIAL OF A PATENT ACTION.

What is a patent action?

In the term patent action are included the three kinds of action which have been already considered, *viz.*, actions for infringement, actions for threats where validity and infringement are in issue, and petitions for revocation.

One procedure in all patent actions.

Although in these three kinds of action the relations of the parties are different, the procedure at trial is practically the same in all, and the three varieties can be conveniently considered together.

Patent action may be tried at assizes.

Any action for infringement or threats may be put down for trial at assizes, and a petition for revocation may be ordered to be tried at assizes when that mode of trial appears to the Court to be convenient.

and must not be sent back to be tried in London for want of time.

If set down for trial at assizes, a patent action will be tried like any other action so standing for trial, and if in the Chancery Division it must not be sent back to the judge of the Chancery Division, because there is no time to try it; it must be treated as a remanet, or transferred to a neighbouring assize.[1]

A corporation cannot appear in person, and must appear in court by counsel.[2]

Issues in a Patent Action.

Revocation.

The simplest kind of patent action is a petition for revocation in which only two points can arise, *viz.*, What

[1] Fairburn *v.* Household, 1885, C.A. 2 R.P.C. 195.
[2] Pneumatic Tyre Co. *v.* West London Rubber, 1898, 15 R.P.C. 129.

is the invention claimed in the complete specification? and, Is the patent for this invention a valid one?

In an action for infringement the same two points arise, and there is the further question, Has the defendant infringed? Infringement.

In an action for threats there are the further questions, Has the defendant threatened? and, if so, Has he with due diligence commenced and prosecuted an action for infringement? Threats.

Construction of the Specification.

The first question for the Court at the trial of any patent action is, What is the invention for which the patent is granted? that is, What does the patentee claim in his complete specification?

The construction of the specification is a matter of law for the Court, but it differs somewhat from that of most documents, since the Court will generally hear the evidence of experts as to its meaning. Upon this subject Lord Westbury in 1861 made the following statement: "It is undoubtedly true as a proposition of law that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes, and requires generally the aid of the light derived from what are called surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words or technical terms of art, the phrases used in commerce and the proofs and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents)—that all these are matters of fact upon which evidence may be given, contradictory testimony may be deduced, and upon which undoubtedly it is the province and the right of a jury to decide."[1] Construction is matter of law. Evidence on meaning of specification.

[1] Hills *v.* Evans, 1862, 31 L.J.N.S. Ch. 460.

Although expert evidence may be given to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in a specification, the nature of the invention for which a patent is granted must be ascertained from the specification itself, and has to be determined by the judge and not by a jury, nor by any expert or other witness.[1]

Both parties usually call expert evidence in favour of the construction they desire to be put on the specification.

Construction forms a precedent.

The construction of a specification is so far a matter of law that it forms a precedent, which is binding in any later action brought on the same patent.[2]

In ascertaining what is the invention patented, the claims must be looked at and construed as forming part of the specification, and must not be dealt with independently of what precedes them.[3]

Rules for the Construction of a specification.

Upon this subject Lord Esher, M.R., said: "As to the rule of construction of a patent, when the question is what is the true construction, I cannot doubt myself that the same rules of construction, or the same canons of construction, are to be applied to the construction of a patent or to any part of it as are used with regard to any other instrument. You must look at the whole of the specification, and then, having looked at the whole, if it is an objection to the claim, see what the claim on the true construction of it is, having regard to the whole of the instrument."[4]

Ambiguity.

A specification is sometimes capable of bearing more than one construction, and then it becomes a question for the Court which construction is to be preferred.

[1] Brooks v. Steel, 1897, C.A. 14 R.P.C. 46.

[2] Edison & Swan v. Holland, 1889, C.A. 6 R.P.C. 243.

[3] Reason Manufacturing Co. v. Moy, 1902, 19 R.P.C. 409; Arnold v. Bradbury, 1871, 6 Ch. 706; Edison v. Woodhouse, 1887, 4 R.P.C. 99.

[4] Edison-Bell Phonograph Corporation Ltd., v. Smith & Young, 1894, C.A. 11 R.P.C. 395.

The grant provides that the letters patent shall be construed in the most beneficial sense for the advantage of the patentee, and it has been sometimes supposed that this means that the Court is to try and make out a meaning which will make the patent of the greatest benefit to the patentee.

See p. 8.
Benevolent construction of specification.

On this subject, which is called the beneficial construction of a patent, Jessel, M.R., in 1882, used the following language:—

"I have heard judges say, and I have read that other judges have said, that there should be a benevolent interpretation of specifications. What does this mean? I think, as I have explained elsewhere, it means this: when the judges are convinced that there is a genuine, great and important invention, which, as in some cases, one might almost say, produces a revolution in a given art or manufacture, the judges are not to be astute to find defects in the specification, but on the contrary, if it is possible, consistently with the ordinary rules of construction, to put such a construction on the patent as will support it. They are to prefer that construction to another which might possibly commend itself to their minds if the patent was of little worth and of very little importance. That has been carried out over and over again, not only by the Lord Chancellor on appeal, but by the House of Lords. There is, if I may say so, and I think there ought to be, a bias, as between two different constructions, in favour of the real improvement and genuine invention, to adopt that construction which supports an invention. Beyond that I think the rule ought not to go."[1]

Rule for construction.

Limit of rule of benevolent construction.

In a recent case in the Court of Appeal, Lord Justice Kay went somewhat further than this when he laid down the rule that—

"The Court will construe the specification so as to support the patent if it can fairly be done, and will not

[1] Otto v. Linford, 1881, C.A. 46 L.T. N.S. 39.

be astute to find flaws in small matters in a specification with a view to overthrow it. Where any expression is ambiguous the Court will endeavour to give effect to the intentions of the patentee."[1]

Evidence which does not attack the validity of a patent may be given with a view to narrowing its scope without delivering particulars of objections,[2] and the Court will consider alleged anticipations for the purpose of arriving at the true construction of a specification,[3] since it will not, unless obliged, extend the claim to matters which the patentee must have known were old when he drew up his specification.[4]

Even if the defendant be a licencee, who cannot dispute validity, he can attempt to show that he is outside the patent, though a licencee cannot, except in case of an ambiguity, refer to other specifications in order to limit the scope of the patent under which he is a licencee.[5]

Validity.

A patent bad *in one point* is bad altogether.

When the meaning of the specification has been arrived at, the next question is whether the patent is a valid one. Now, we have seen that if a patent be bad in one particular, it is altogether invalid; so that the question of validity resolves itself into the question—Has any one of the objections specified in the particulars been sustained?

These objections may involve the construction of the specification, or may be simple questions of fact, as of the sufficiency of the specification, or the utility or

[1] Edison-Bell Phonograph Corporation, Ltd., *v.* Smith & Young, 1894, C.A. 11 R.P.C. 400.

[2] Appleby *v.* Albert Eadie Chain, 1899, 16 R.P.C. 318.

[3] Morris *v.* Young, 1895, H.L. 12 R.P.C. 455.

[4] Haworth *v.* Hardcastle, 1834, 1 Webs. 484, quoted by Halsbury, L.C., in Tubes *v.* Perfecta Seamless Steel Tube Co., 1903, H.L. 20 R.P.C. 77, 97.

[5] Jandus Arc Lamp *v.* Johnson, 1900, 17 R.P.C. 361.

novelty of the invention; but since a jury is now rarely employed in the trial of a patent action, these distinctions are not of very great importance.

The question of conformity of the specifications is a matter of law, which, when determined, forms a precedent binding in subsequent trials;[1] but all the other objections seem to be matters of fact, which must be decided *de novo* at each trial.[2]

Most objections are matters of fact.

Expert evidence must be given upon the question whether or no two things are mechanical equivalents.[3]

Mechanical equivalents.

Documents that have been registered at the Patent Office can be put in evidence without being strictly proved.[4]

Infringement.

The question whether the defendant has infringed is one entirely of fact, which will, in a trial by jury, be left to the jury.

Infringement is a question of fact.

Where the infringement is not clear expert evidence will be required to show that it exists, and, on the part of the defendant, to prove its absence.

Threats.

The question as to whether what was done by the defendant in an action for threats amounted to a threat, seems to be one partly of law and partly of fact, and is dealt with in the chapter on Threats.

Whether a threat has been used.

Due Diligence.

Whether the defendant in an action for threats brought an action with due diligence depends entirely on the circumstances of the case.[5]

[1] Pneumatic Tyre Co. v. Leicester Pneumatic Tyre, 1899, C.A. 16 R.P.C. 50.

[2] Edison & Swan v. Holland, 1889, C.A. 6 R.P.C. 243.

[3] Ticket Punch Register v. Colley's patents, Ltd. (per Smith, L.J.), 1895, 12 R.P.C. 171.

[4] Jandus Arc Lamp v. Johnson, 1900, 17 R.P.C. 361.

[5] Colley v. Hart, 1890, 7 R.P.C. 101.

The Hearing of a Patent Action.

The Act of 1883 provides that—

Sect. 28 (1). Assessor may be applied for by either party.

"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 and hear the case wholly or partially with his assistance. The action shall be tried without a jury unless the Court shall otherwise direct."

How assessor is paid. Sect. 28 (3).

"The remuneration (if any) to be paid to an assessor under this section shall be determined by the Court, and be paid in the same manner as the other expenses of the execution of this Act."

Act, 1883, sect. 83 (2).

"The other expenses of the execution of this Act shall be paid out of money provided by Parliament."

Act, 1883, sect. 107. Trial in Scotland.

"In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct; but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action, or in any action or proceeding respecting a patent hitherto competent to those courts.

"For the purposes of this section 'court of appeal' shall mean any court to which such action is appealed."

Employment of an assessor would reduce cost of action.

It would certainly appear that this provision might more often be taken advantage of by suitors, and it would certainly often reduce the cost of a patent action; the assessor appointed by the Court does not entail any expense on the parties, and if an action be tried in this way the expense of expert witnesses might be almost, if not entirely, avoided. It would be a great boon to a poor plaintiff, to whom the proverbial cost of a patent action must often be a cause of great injustice. It is equally available as of right for a defendant.

Notwithstanding its apparent beneficence the right to demand an assessor has but seldom been exercised by the parties. The Court has, however, on numerous occasions, when the evidence of the experts called by the parties has been more than usually divergent, appointed an independent expert to report to it.[1] Sometimes such

[1] For a form of reference see Badische Anilin Fabrik v. Levinstein, 1885, 2 R.P.C. 77.

report is taken in writing and sometimes the referee is called to give verbal explanations or to answer questions, and in that case the report cannot be entered in the order of the Court as having been read.[1] If the referee be called, only such questions as the court may permit may be asked by the parties.[2]

It will be seen that the statutory provision as to trial without a jury does not apply to an action for threats, and if such an action be tried with a jury questions arising on the patent will be left to them.[3]

Patentee commences.

When the validity of a patent is in issue the party defending the patent commences; a somewhat curious provision, since, apart from the issue of infringement, practically the whole burden of proof rests on the party attacking the patent. If the attacking party adduces any evidence against the patent, the patentee may call evidence in reply. The usual result of this arrangement is that the cross-examination of the patentee's witnesses is prolonged to enormous length, often with very little benefit to either side, in order to avoid the necessity of having evidence in reply.

In spite of the particulars required to be given, the parties are often unaware of the case which their opponent intends to make, and their gradual enlightenment on this question during the course of the trial does not tend to rapidity.

Surprises during trial.

If a novel point arises in the course of the trial, necessitating the calling of further evidence, application should be made for an adjournment to enable such evidence to be given; since, if this be not done, the Court of Appeal will not allow such evidence to be given on the hearing of an appeal.[4]

Title usually admitted,

The title of the plaintiff in an action for infringement

[1] British Motor Syndicate *v.* Andrews, 1899, 16 R.P.C. 594.

[2] North British Rubber Co. *v.* Macintosh, 1894, 11 R.P.C. 484.

[3] Appleby *v.* Albert Eadie Chain, 1899, 16 R.P.C. 318.

[4] Barcroft *v.* Smith, 1897, C.A. 14 R.P.C. 172.

is usually admitted by consent, as are the specifications and patents; and in one case the defendants, who refused to admit the plaintiff's title, had to pay the costs of proving it, although successful in the action.[1]

or defendants may have to pay costs of proving it.

If not admitted the patent must be proved by proof of the grant and subsequent title, and the specification by certified copies.

Act, 1883, sect. 89. See p. 232.

Each party must, of course, carefully consider which points his evidence is to be directed towards, and upon this his choice of witnesses will depend. It is very usual for both sides to call scientific experts, who are frequently really expert advocates of the cause they are called to support rather than witnesses.

Expert witnesses are usually called.

The scientific witnesses generally have to prepare themselves specially for giving evidence, and come prepared with accounts of experiments which they have made in the course of this preparation. A witness is not compelled to make a general disclosure of all his experiments, though, if asked about any particular experiment, he must be prepared to give full particulars, for which purpose he should always have his original notes with him in court.

Witnesses may make experiments for use as evidence.

When the subject of the patent is mechanical, each party usually produces models and drawings of what they consider that the specification describes, and also of the alleged infringement; models of any articles alleged to anticipate the patent are usually produced, but it is advisable, where practicable, to have the actual articles produced in Court, since this will avoid not only the expense of making models and drawings, but also the expense of proving their correctness, and the possibility of a conflict of evidence as to what the articles really are. The expert witnesses should be well acquainted with all the models, drawings and specifications which it is intended to use in evidence.

Models and drawings.

Proof of anticipations by models.

Experts should examine models, drawings and publications.

Besides scientific experts it is often necessary or

[1] Norwerk & Son v. Evans & Co., 1890, 7 R.P.C. 174.

advisable to call trade witnesses to speak to the knowledge possessed by the trade at the date of the patent, and as to the utility of the invention.

Trade witnesses to general knowledge.

When the sufficiency of the specification is in issue, workmen may be given the specification, and, without any further assistance, instructed to make what is described; and then they may be called and asked to produce the result of their work. Evidence may also be given of instructions issued by the patentee as to the user of his invention.

Sufficiency proved by workmen.

As a general rule all the issues in a patent action are tried together; the question of infringement will be tried separately only if the validity of the patent be admitted,[1] but where several instances of prior user are alleged, all the evidence on one will sometimes be taken before going into another.[2] Where it is admitted that an alleged prior user, if proved, would be fatal to the patent, the defendant will be allowed to call witnesses to prove such user before the rest of the case is gone into.[3]

When issues are taken separately.

In order to be successful in an action for infringement the plaintiff must be successful on every point, so that the defendant need succeed on only a single point to be entitled to judgment.

Plaintiff for infringement must succeed on every point.

Now it may happen that a plaintiff, who is entitled to succeed on every other point, is unable to prove infringement; and the Court can then say that, since the defendant has succeeded on that ground, the other issues do not affect the result of the action, and need not be considered. This result may, however, be very hard on a patentee, who may have devoted his chief attention to the issue of validity in order to get this established; but it seems that if the action can be determined on one issue

Defendant in infringement must succeed on one point.

[1] United Telephone Co. *v.* Mottishead, 1886, 3 R.P.C. 213.
[2] Richardson *v.* Castrey, 1887, 4 R.P.C. 265.
[3] Badham *v.* Bird, 1888, 5 R.P.C. 238.

the patentee has no right to have any decision on the others. Formerly the Court of Appeal would decide every issue that had been fully argued and decided in the Court below,[1] but the House of Lords has laid down that this is not a proper thing to do, that if done after the first decisive issue the judgments are mere dicta, and that a Court ought not to go into matters not relevant to the issue.[2] It is possible that this may, to some extent, affect the obtaining of any decision on validity where infringement is not proved; and, in any event, if the Court finds no infringement its subsequent finding on validity would appear to be only a dictum.

An appeal a rehearing.

An appeal from the decision of a judge is by way of rehearing, and there is no presumption that the judgment appealed against is right.[3]

Questions of fact in House of Lords.

In the absence of exceptional circumstances the House of Lords will not reconsider concurrent findings of the Courts below on questions of fact.[4]

Shorthand Notes.

If the trial is likely to last more than one day, or if an appeal is at all probable, it is advisable to have a shorthand note of the evidence taken. The cost of this is very usually shared by the parties, but more usually they are, by agreement, made costs in the cause; unless this latter course be adopted they will not be allowed on taxation as between party and party, unless the Court makes a special order to that effect.

The necessity of shorthand notes is, however, so fully recognised that it is becoming more and more usual to allow their cost between party and party as part of the

[1] Parkinson *v.* Simon, 1894, C.A. 11 R.P.C. 493.
[2] Parkinson *v.* Simon, 1895, H.L. 12 R.P.C. 403.
[3] Rickmann *v.* Thierry, 1897, H.L. 14 R.P.C. 105.
[4] Nobel's Explosives Co. *v.* Anderson, 1895, H.L. 12 R.P.C. 164; but see Montgomery *v.* Wallace Jones, 1903, H.L. 90 L.T. 1.

costs of the trial;[1] and even where not so allowed, if used at the trial, and also in the Court of Appeal, the cost will be allowed as costs of an appeal.[2]

As in every other matter the parties must be careful to have all their evidence ready at the trial, as the Court of Appeal is not at all disposed to permit additional evidence on the hearing of an appeal.[3]

Judgment by Consent.

Where an action is compromised, an undertaking not to infringe is preferable to an injunction, since the latter may be used in a misleading way in advertisements.[4]

[1] Palmer Tyre Co. *v.* Pneumatic Tyre Co., 1899, 16 R.P.C. 451; Incandescent Gas Light Co. *v.* De Mare. 1896, 13 R.P.C. 301; Incandescent Gas Light Co. *v.* Sunlight Incandescent, 1896, 13 R.P.C. 333.

[2] The Castner Kellner Alkali Co. *v.* The Commercial Development Corporation, 1899, C.A. 16 R.P.C. 251.

[3] Nadel *v.* Martin, 1903, C.A. 20 R.P.C. 721.

[4] Dover *v.* New Townend Cycle, 1903, 21 R.P.C. 135.

CHAPTER XIX.

JUDGMENT IN INFRINGEMENT ACTION.

If the plaintiff succeeds in an action for infringement he is entitled to judgment for—

Injunction.

(1) "An injunction to restrain the defendant, his servants and agents, from infringing the letters patent during the remainder of the term."

This may extend to restraining the sale after the patent has expired of articles made during the term of the patent.[1] If the patent has expired, an injunction will be required only when the defendant has made a number of articles before the expiration of the patent for sale afterwards, and in this case, if the infringement be commenced shortly before the expiration of the patent, an injunction will not always be granted.[2]

Where two kinds of infringement are alleged, and one only—and that one that has been used only to a limited extent—is established, while the other is held not to be an infringement, an injunction will be granted in a limited form only, directed specifically against the kind of infringement proved.[3]

In an action against a company and its directors, where the company has transferred its business to a new company with the same directors, an injunction will not

[1] Crossley *v.* Beverley, 1829, 1 R. & M. 166 *n*; 1 W.P.C. 106.

[2] British Insulated Wire *v.* Dublin United Tramways, 1900, C.D. (Ir.), 17 R.P.C. 14.

[3] Dunlop Pneumatic, etc., *v.* New Ixion Tyre, etc., 1899, C.A. 16 R.P.C. 16.

be granted against the directors so as to affect them in their management of the new company, which ought to be made a party to the action.[1]

If an action be brought on several patents, and the plaintiff proves that they cover every known process of manufacture, but cannot identify the patent that has been infringed, an injunction, if granted, will be made to determine on the termination of the first patent under which the manufacture can be effected.[2]

The method of enforcing an injunction is, in the case of an individual, by committal, and, in the case of a corporation, by sequestration of the property of the corporation,[3] or by committal of its directors or other agents. Committal. Sequestration.

To commit a person who has not been enjoined, it is necessary to prove that he is the servant or agent of a party who has been enjoined, or that with knowledge of the injunction he has been aiding and abetting its infringement.

An injunction can be enforced by committal for an infringement of a different character from that on which the injunction was made, and where the defendant endeavours to escape by changing the character of his infringement committal is the proper remedy.[4] Different infringement

A person against whom an injunction has been made can be committed for contempt, if with knowledge of the injunction he persists in his infringement, although an order has not been drawn up and formally served on him.[5] before order drawn up.

The liquidator of a company appointed before the

[1] Welsbach Incandescent Gas *v.* New Incandescent (Sunlight Patent) Gas, 1900, 17 R.P.C. 237.

[2] Saccharine Corporation *v.* Dawson, 1902, 19 R.P.C. 169.

[3] Spokes *v.* Banbury Board of Health, 1865, 2 Eq. 42; *vide* Seaward *v.* Paterson (1897), 1 Ch. 545, approved in C.A.; Incandescent Gas Light Co. *v.* Sluce, 1900, C.A. 17 R.P.C. 173.

[4] Thomson *v.* Moore, 1889, 6 R.P.C. 445.

[5] Incandescent Gas Light Co. *v.* Riemer, 1900, C.A. 17 R.P.C. 378.

Liquidator of Company.

trial of an action cannot be committed for breach of an injunction against the company in which he is not named.[1]

Evidence of public knowledge.

On a motion to commit for breach of an undertaking not to infringe, evidence of public knowledge may be given with a view to narrowing the construction of the specification.[2]

The plaintiff also claims—

Damages or an account of profits.

(2) "Damages or an account of the profits made by the defendant through his infringements."

The plaintiff must choose one or the other alternative, he cannot have both,[3] and it is often very difficult to see which is likely to bring him the largest amount, since the damage suffered by the plaintiff is an entirely different matter from the profits made by the defendant. The choice need not be made till after verdict.

Assessment of damages.

If the plaintiff chooses to have damages, they may be assessed by the Court, or possibly the plaintiff may be entitled to apply at the trial to have them assessed by a jury;[4] but, as a rule, the Court orders an inquiry to be taken of the amount of the damage suffered by the plaintiff, and the judgment will be for the amount so found.

An inquiry as to damages may be refused where only a single instance of infringement is proved, and the defendant, after putting in a defence, has not appeared at the trial.[5]

Measure of damages.

When the plaintiff is a manufacturer, the usual measure of damages is the total profit the plaintiff would have made if he had supplied the infringing articles

[1] Saccharine Corporation, Ltd., *v.* Chemical and Drugs Co., 1900, 17 R.P.C. 743.

[2] Schermuly *v.* Pain, 1901, 18 R.P.C. 529.

[3] De Vitre *v.* Betts, 1873, L.R. 6 H.L. 319; 21 W.R. 705; Siddell *v.* Vickers, 1892, 9 R.P.C 162.

[4] American Braided Wire *v.* Thompson, 1888, C.A. 5 R.P.C. 696.

[5] Webb Lamp Co. *v.* Atkinson, 1902, 19 R.P.C. 599.

himself;[1] but where an article is made partly by infringing and partly by other machinery, the damages may be less than if the whole of the machinery was made in infringement of the plaintiff's patent rights.[2] When a complete article consists partly of a patented and partly of an unpatented part, and the parts are separate and obtainable separately, allowance should be made in respect of the unpatented part.[3]

Where patentee does not grant licences.

Where the plaintiffs would, but for the defendant's competition, have had a practical monopoly of manufacture of the patented article, loss to the plaintiffs caused by their having to lower their prices owing to competition by the defendant may be taken into account.[4]

Lowering of prices may be considered.

Litigation may increase amount claimed, except when licences are granted to all on fixed terms.

As a general rule, a patentee can rightly claim from an infringer who litigates more than he would be prepared to accept from a licencee,[5] but when a patentee both manufactures himself and licences others on fixed terms, he can recover in damages only the amount which he would have received for royalties;[6] and, if he has accepted this amount as royalty from the users of infringing machines, he cannot recover anything as damages from the manufacturers.[7]

Damages from purchaser and from manufacturer.

The fact that damages have been recovered against the manufacturer of infringing goods does not affect the amount of damages recoverable against a purchaser from him.[8]

Inferior articles.

Damages ought not to be reduced on the ground that infringements were for a cheaper class of machine than

[1] Boyd *v.* Tootal Broadhurst Lee Co., Ltd., 1894, 11 R.P.C. 175.

[2] United Horse Nail *v.* Stewart, 1887, 4 R.P.C. 130; 13 App. Cas. 401.

[3] United Telephone *v.* Walker, 1887, 4 R.P.C. 63.

[4] American Braided Wire *v.* Thompson, 1890, C.A. 7 R.P.C. 152.

[5] Penn *v.* Bibby, 1866, L.R. 3 Eq. 308.

[6] English & American Machinery Co. *v.* Union Boot & Shoe Machine Co., 1896, 13 R.P.C. 64.

[7] Penn *v.* Jack, 1867, L.R. 5 Eq. 81.

[8] United Telephone *v.* Walker, 1887, 4 R.P.C. 63.

the patentee's own make of goods;[1] but where a patentee manufactures himself and also grants licences for the manufacture of articles of a somewhat inferior quality, it need not be assumed, in estimating damages, that every infringing tyre sold means loss of the sale of a tyre to the patentee, though, on the other hand, the ordinary royalty is not necessarily the true measure of damage to the patentee.[2]

Actual damage must be proved.

A patentee is not entitled to substantial damages for an infringement unless he can prove that he has actually sustained pecuniary loss thereby. If the difference between the price of an infringing article and that charged by the patentee would have prevented the sale of the article by the patentee, in place of that of the infringement, the patentee cannot recover substantial damages from the purchaser of such infringement.[3]

Where patentees regularly licence machines, but do not sell, the damages caused by infringements are the profits that would have been derived from licences for the infringing machines had they been duly licenced.[4]

Where, under a single contract with a foreign firm, infringing articles are imported both before and after the patent has expired, an inquiry as to damages will be confined to the articles actually received prior to the expiration of the patent.[5]

Account of profits in lieu of damages.

Instead of claiming damages the plaintiff may adopt the acts of the defendant as those of his agent, and make the defendant account to him for all the profits which he has made by his infringements. In this case the Court will order an account of such profits to be taken, and,

[1] Dunlop Pneumatic Tyre Co. *v.* Green, 1900, 17 R.P.C. 234.

[2] Pneumatic Tyre Co. *v.* Puncture Proof Pneumatic, etc., 1899, C.A. 16 R.P.C. 209.

[3] Gavioli *v.* Shepherd, 1899, 17 R.P.C. 157.

[4] English & American Machinery Co. *v.* Union Boot & Shoe Machine Co., 1896, 13 R.P.C. 64.

[5] British Insulated Wire *v.* Dublin United Tramways, 1900, C.D (Ir.), 17 R.P.C. 14.

as a general rule, there will be judgment for the amount of profit so found, together with the costs of taking the account; but if it seems probable that the amount found due on taking an account will be trifling, the costs may be left to the discretion of the referee to whom the taking of the account is entrusted.[1]

Costs of account.

It is often to the patentee's advantage to adopt this course, since the profit, direct and indirect, made by the defendant may be much in excess of any damage which the plaintiff has suffered; indeed, the profits may be considerable when the damage is practically *nil*.

Account of profits often advisable.

When the infringement is by user of an infringing machine only, the proper course is to compare the profits arising when the infringing machine is used with those which would have resulted had the infringement not taken place.[2] Of course, where no other machine would do the work of the patented machine, the plaintiff is entitled to the whole profit made by its use; but when the work could be done in other ways the plaintiff is entitled only to the increased profit arising from the use of his invention over what the defendants would have made without it.

Profits by user.

When the infringing machine has been introduced into an existing manufacture, the defendants must disclose their profits before and after its introduction.[3]

Whether damages or profits be chosen, the defendant must make a full disclosure of all the articles made or sold, and of the prices obtained; he must also disclose the names and addresses of purchasers of infringing machines.[4]

Defendant must make full disclosure.

It is inconvenient to order an account of profits against a public body, and some other arrangement

Defendant a public body.

[1] Shaw *v.* Jones, 1889, 6 R.P.C. 328.

[2] Siddell *v.* Vickers, 1892, C.A. 9 R.P.C. 152.

[3] Siddell *v.* Vickers, 1889, 6 R.P.C. 464.

[4] Murray *v.* Clayton, 1872, L.R. 15 Eq. 115; Saccharine Corporation *v.* Chemical & Drugs Co., 1900, C.A. 17 R.P.C. 612.

should be made for settling the amount of their liability for past infringements.[1]

Profits from bankrupt defendant

When an account of profits is taken, the amount found due is not due by way of damages, but rather as money had and received for the use of the plaintiff; and when an infringer is bankrupt, a patentee may prove in the bankruptcy for profits which he is entitled to recover from the infringer.[2]

The Court may also order—

Delivery up.

(3) "The delivery up on oath by the defendant to the plaintiff, or the destruction of all infringing machines in the defendant's possession."

The value of infringing machines so ordered to be given up must not be considered in assessing the damages, or set off against the amount awarded for damages.[3]

When part only of a machine infringes, the infringing parts only need be delivered up.[4]

Instead of being delivered up, the infringing articles are sometimes ordered to be marked so as to prevent their being sold by the defendant,[5] or to be destroyed.[6]

Where an infringement takes place a few days before the expiration of a patent, delivery up of the infringing articles will not always be ordered.[7]

[1] Automatic Coal Gas Retort *v.* Mayor, etc., of Salford, Romer, J., 1897, 14 R.P.C. 450; *cf.* Crossley *v.* The Derby Gas Co., 1834, 1 Webs. R. 119.

[2] Watson *v.* Holliday, 1882, 20 Ch. D. 780.

[3] United Telephone *v.* Walker, 1887, 4 R.P.C. 63.

[4] Edison-Bell Phonograph Corporation Ltd. *v.* Smith & Young, 1894 C.A. 11 R.P.C. 389.

[5] Westinghouse *v.* Lancashire Railway Co., 1884, 1 R.P.C. 253.

[6] Howes *v.* Webber, 1895, 12 R.P.C. 470.

[7] British Insulated Wire *v.* Dublin United Tramways, C.D. (Ir.), 1900, 17 R.P.C. 14.

CHAPTER XX.

CERTIFICATE OF VALIDITY.

THE Act of 1883 provides that—

"In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or judge so certifies, then, in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same."

Sect. 31. Effect of certificate of validity on costs.

If a patent be held invalid at the trial, and be held good on appeal, the Court of Appeal will grant a certificate under this section.[1]

A certificate obtained under this section is popularly known as a certificate of validity, though, as we shall see, the title is not an altogether accurate one. It will be readily understood that the possession of such a certificate is of immense advantage to the patentee, since not only does it entitle him to costs as between solicitor and client in any subsequent action, but it usually also enables him to obtain an interim injunction against any subsequent infringer.

Advantage of having a certificate.

It will be noticed that the section applies only to an action for infringement, and it is doubtful whether a valid certificate can be given in an action for threats.[2]

No certificate in action for threats.

As a general rule, where a certificate of validity has been given, a second one will not be given in a subse-

[1] Fawcett v. Homan, 1896, C.A. 13 R.P.C. 398.

[2] Crampton v. The Patents Investment Co., Limited, 1888, 5 R.P.C. 404.

Only one certificate of validity granted.

quent action;[1] but if the grounds on which validity is disputed in the second action are substantially different from those which failed in the first action, a second certificate may be granted.[2]

A certificate of validity may be given even though the patent has expired before the date of the judgment.[3]

Grant of certificate not appealable.

The granting or withholding of a certificate of validity is in the discretion of the Court or judge, and from it there is no appeal.[4]

A certificate of validity should not be given unless the judge is satisfied that the validity has been in contest.[5] The Court will not consider the circumstances under which a certificate has been given,[6] so that a patentee who has obtained a certificate without a real contest has an unfair advantage over any future *bonâ fide* antagonist.

Validity need not be upheld.

A certificate may be given when the patent is held invalid,[7] and it seems reasonable that this should be done whenever the invalidity can be cured by amendment, and only in such cases is it likely to be granted.[8]

When validity not decided.

A certificate has been granted when, after a contest, the parties have come to a settlement, of which it was a term that a certificate should be applied for;[9] but, on

[1] Edison & Swan Electric Light Co. *v.* Holland, 1889, C.A. 6 R.P.C. 287; Pneumatic Tyre Co. *v.* East London Rubber, 1897, 14 R.P.C. 77.

[2] Otto *v.* Steel, 1886, 3 R.P.C. 120.

[3] Sunlight Incandescent Gas *v.* Incandescent Gas Light Co., 1897, 14 R.P.C. 757; British Motor Syndicate *v.* Universal Motor Carriage, etc., 1899, 16 R.P.C. 113.

[4] Haslam *v.* Hall, 1888, C.A. 5 R.P.C. 144.

[5] Per Byrne, J., Fabriques de Produits Chimiques, etc., *v.* Lafitte & Co., 1899, 16 R.P.C. 68; per Romer, L.J. C.A., British Motor Syndicate *v.* Andrews, 1899, 16 R.P.C. 594.

[6] Incandescent Gas Light *v.* De Mare, 1896, 13 R.P.C. 301.

[7] Haslam *v.* Hall, 1888, 5 R.P.C. 27; but see Morris *v.* Young, 1895, H.L. 12 R.P.C. 455.

[8] Acetylene Illuminating Co. *v.* United Alkali Co., 1902, 19 R.P.C. 213; *cf.* Badische Anilin *v.* Société Chimique, 1897, 14 R.P.C. 875.

[9] Delta Metal *v.* Maxim-Nordenfelt Co., 1891, 8 R.P.C. 247; but *cf.* Claughton *v.* Foster, 1903, 21 R.P.C. 17.

the other hand, a certificate has since been refused when the question of validity was raised, but not decided, at the trial.[1]

A certificate has been refused when validity was disputed in the pleadings and admitted at the trial,[2] and also where defendant put in a defence and provisional order, but did not appear at the trial;[3] but the practice in this respect has not been uniform.[4]

What actions are affected by certificate of validity.

The rule as to costs applies only to a subsequent action—that is, to an action commenced after the certificate is given;[5] but it applies even where, in the subsequent action, the validity is not put in question.[6]

Plaintiff unsuccessful in action.

The rule has been held to apply to an action in which the plaintiff fails to prove infringement, so as to entitle him to costs as between solicitor and client, of the issue of validity.[7]

When only issue is as to amount of damage.

When the defendant admits infringement, and does not dispute validity, but has offered the plaintiff less than the amount for which he obtains judgment, and even if infringement be the only issue,[8] the plaintiff may be deprived of his full costs.[9]

[1] Jardine *v.* King, Mendham & Co., 1896, 13 R.P.C. 411.

[2] Presto Gear Case *v.* Simplex Gear Case, 1898, 15 R.P.C. 835.

[3] Webb Lamp Co. *v.* Atkinson, 1902, 19 R.P.C. 593.

[4] Haycock *v.* Bradbury, 1887, 4 R.P.C. 74; Edison-Bell Phonograph *v.* Edison Phonograph, 1894, 11 R.P.C. 33; Acetylene Illuminating Co. *v.* Midland Acetylene (Parent) Syndicate, 1900, 17 R.P.C. 534; Welsbach Incandescent Gas *v.* Krumm, 1901, 18 R.P.C. 211.

[5] Saccharine Corporation *v.* Anglo-Continental Chemical Works, 1900, 17 R.P.C. 307; Automatic Weighing *v.* Combined Weighing Machine, 1889, 6 R.P.C. 120; Automatic Weighing *v.* International Hygienic Soc., 1889, 6 R.P.C. 480.

[6] United Telephone *v.* Patterson, 1889, 6 R.P.C. 140.

[7] Dunlop Pneumatic Tyre Co. *v.* Wapshare Tube Co., 1900, 17 R.P.C. 433.

[8] Edison-Bell Corporation *v.* Waterfield, 1902, 19 R.P.C. 329; Saccharine Corporation *v.* Dawson, 1902, 19 R.P.C. 173; but *cf.* Welsbach *v.* Daylight, 1899, 16 R.P.C. 353.

[9] Boyd *v.* Tootal Broadhurst Lee Co., Limited, 1894, 11 R.P.C. 185 (Lanc. Ct. case).

Rule as to costs applies unless it is ordered otherwise.

The rule as to costs applies, unless the Court or the judge trying the action certifies that it ought not to apply; so that whenever a plaintiff, having a certificate of validity, is successful, application should be made to the judge on behalf of the defendant for a certificate to deprive the plaintiff of solicitor and client costs.

Notice of certificate of validity should be given.

When he has obtained a certificate of validity, the plaintiff should, in any subsequent action, give the defendant notice of the fact, as it is likely to have considerable weight in inducing a submission. It should also be mentioned in the statement of claim, and costs as between solicitor and client should be claimed.

CHAPTER XXI.

COSTS.

Costs of action follow event.

In an action for infringement or threats, and in a petition for revocation, the successful party is in the usual course, unless deprived thereof by the judge, entitled to the general costs of the action or petition.

Costs of issues may be set off.

Where several issues are decided, the costs of each separate issue may, if separable from the general costs of the action, be made to follow the event of the issue, and be set off against the costs awarded to the other party.

When costs of issue of infringement may be set off.

Thus, a plaintiff unsuccessful in the action, by reason of the invalidity of his patent, but proving infringement, may be allowed the costs of that issue;[1] but this is only true when that issue can be distinguished from the rest of the case.[2]

There can be no infringement of a bad patent; but a plaintiff on a bad patent may, in some cases, be allowed costs of the issues which are unnecessary without infringement, because those costs have been improperly and unnecessarily incurred.[3]

When costs of other issues set off.

Where the defendants were successful on infringement, but had pleaded that if they had infringed, the patent was bad, and the question of validity not fought

[1] Badische Anilin Fabrik *v.* Levinstein, 1885, C.A. 2 R.P.C. 143; 29 Ch. D. 420.

[2] Guilbert-Martin *v.* Kerr, 1887, 4 R.P.C. 18; White *v.* Hartley, 1903, Pal. Ct. Lanc., 20 R.P.C. 265.

[3] Blakey & Co. *v.* Latham & Co., 1889, C.A. 6 R.P.C. 190.

out, the plaintiffs were given the costs of all issues but that of infringement.[1]

Costs of particulars. Act, 1883, sect. 29 (6).

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

Certificate as to particulars should always be applied for.

In consequence of this it is necessary that both the plaintiff[2] and defendant should ask the judge at the trial to certify that their particulars are reasonable and proper, or, if proved, that they have been proved; but where the defendant is not called on to prove any particulars of objections, as where the defendant succeeds on the issue of infringement, and the question of validity is not gone into,[3] the judge will probably refuse a certificate as to their being reasonable and proper.[4]

Where, however, an action breaks down on the cross-examination of the plaintiff's first witness, leave may be given to further cross-examine, with a view to obtaining a certificate that the particulars of objection were reasonable and proper.[5]

Subsequent application.

Costs of the particulars of objections may be allowed on an application made subsequently to the trial, but the costs of such an application will not be given to either party.[6]

Action withdrawn.

If the plaintiff withdraws his action before trial, it seems that the successful defendant will have to bear the costs of his particulars of objections.[7] Where, at the trial, the defendant in a threats action withdraws his

[1] Tweedale *v.* Ashworth, 1892, H.L. 9 R.P.C. 121.

[2] Kane *v.* Guest, 1899, 16 R.P.C. 433.

[3] Peters *v.* Owen, 1898, 15 R.P.C. 663.

[4] Newsum *v.* Mann, 1890, 7 R.P.C. 310.

[5] Pegamoid, Ltd., *v.* British Leather Cloth Manufacturing Co., Ltd., 1901, 18 R.P.C. 317.

[6] Duckett *v.* Sankey & Son, 1899, 16 R.P.C. 337.

[7] Middleton *v.* Bradley, 1895, 12 R.P.C. 390; but see Rothwell *v.* King, 1887, 4 R.P.C. 397 (Lanc. Ct. case).

counter-claim, the plaintiff may be allowed the costs of his particulars of objections.[1]

Leave to discontinue.

Where a plaintiff can discontinue his action without leave, it appears that he can, by so doing, deprive the defendant of the costs of his particulars; but where leave to discontinue is necessary, the Court has a discretion as to costs,[2] and the plaintiff will probably be required to pay the costs of the particulars of objections as if certified, or as the master shall certify,[3] not to bring a fresh action against the defendants on the same grounds, or in respect of infringements prior to the date of the writ, and, in case the defendant be a public authority, to pay the defendant's costs as between solicitor and client.[4]

It may also be made a condition that no action shall be brought against any purchaser from the defendant before the date of the writ.[5]

If a plaintiff at the trial offer no evidence, and the action is dismissed, no certificate can be given by the judge at the trial, and, consequently, no costs of the particulars of objections can be allowed.[6]

Certificate as to some particulars only may be given.

The judge sometimes gives a certificate as to some only of the particulars of objections; and judges have frequently complained of the insertion of particulars which are really not applicable to the case, but are put in as general forms. As a general rule, however, certificates of reasonableness of particulars are granted so as to secure to the party delivering them the costs of everything reasonably and properly inserted in them, although he may fail to prove the specific objections under which the detailed particulars may be ranged.[7]

[1] Willoughby *v.* Taylor, 1894, 11 R.P.C. 45.

[2] Brooks *v.* Lycett, 1902, C.A. 19 R.P.C. 366.

[3] Kerr *v.* Crompton, 1901, Pal. Ct. Lanc., 19 R.P.C. 9.

[4] Chamberlain & Hookham *v.* Mayor of Huddersfield, 1901, 18 R.P.C. 454.

[5] Bethell *v.* Gage, 1897, 14 R.P.C. 699.

[6] Mandleberg *v.* Morley, 1895, 12 R.P.C. 35; American Steel and Wire Co. *v.* Glover, 1902, 19 R.P.C. 102.

[7] Castner Kellner Alkali Co. *v.* Commercial Development Corporation, 1899, C.A. 16 R.P.C. 251.

Costs will not be allowed of particulars going only to the construction of a patent that is held valid.[1]

Court of Appeal can give certificate.

If the defendant should fail at the trial, he will not require any certificate as to his particulars, since he must have failed on every issue; but if he should appeal against the judgment, and the Court of Appeal should reverse the decision of the Court below, it can give a certificate that the particulars of objections are reasonable and proper.[2]

Action on several patents.

In an action on four patents, one being abandoned at the trial, while the plaintiffs succeeded on one and failed on the other two, the costs were ordered to be taxed as on separate actions.[3]

Appeal to House of Lords.

The Court of Appeal will not order the solicitor of the successful party to give a personal undertaking to repay costs paid by the other side in the event of a successful appeal to the House of Lords.[4]

Shorthand notes.

As has been already said, there is an increasing tendency to allow the cost of a shorthand note of the evidence, and where such note is used by the Court such costs will probably be allowed.[5]

Costs on higher scale.

Although a patent action probably involves more work and expense than almost any other kind of action, it is not often that costs are given on the higher scale; the rule being that only ordinary costs shall be given, except in a case of unusual difficulty and skill—antiquarian research and things of that kind,[6] not usually experienced in a patent action.

Where costs are given on the higher scale in the

[1] Shoe Machinery Co. *v.* Cutlan, Romer J., 1895, 12 R.P.C. 342.

[2] Cole *v.* Saqui, 1889, C.A. 6 R.P.C. 41; 40 Ch. D. 132.

[3] Brooks *v.* Lamplugh, 1898, C.A. 15 R.P.C. 33.

[4] Castner Kellner Alkali Co. *v.* Commercial Development Corporation, 1899, C.A. 16 R.P.C. 251.

[5] See p. 195.

[6] Gadd *v.* Mayor, etc., of Manchester, 1892, C.A. 9 R.P.C. 516; *cf.* Incandescent Gas *v.* De Mare, 1896, 13 R.P.C. 301.

Court of first instance, it does not follow that they will be given in the Court of Appeal.[1] Costs on appeal.

The costs of a witness present in the Court of Appeal, but not called, cannot be allowed on taxation.

A view by counsel between judgment and appeal may be allowed.[2]

Judgment by Default.

Where the plaintiff obtains judgment in default of defence, he will be allowed the costs of his particulars of breaches.[3]

[1] Chamberlain & Hookham *v.* Mayor, etc., of Bradford, 1901, 19 R.P.C. 78.

[2] Leeds Forge Co. *v.* Deighton's Patent Flue, 1903, 20 R.P.C. 185.

[3] Brooks *v.* Hall, 1903, 21 R.P.C. 29; Saccharine Corpn. Ltd. *v.* Skidmore, 1903, 21 R.P.C. 31.

CHAPTER XXII.

EXTENSION OF TERM OF LETTERS PATENT.

The fourteen years' limit is sometimes found too short.

THE Statute of Monopolies limited the time for which letters patent for an invention could be granted to fourteen years; and this is so far still the limit that every patent is now granted for that term. It was found, however, that in some cases the term of fourteen years was not long enough to enable an inventor to get his invention introduced and to obtain a proper reward for his labour, and so, in special cases, Parliament extended the limit of time beyond the fourteen years. To attain this object a special Act of Parliament was formerly required, but it was thought better to simplify the process, and to allow the Crown to extend the term of a patent upon a report of the Judicial Committee of the Privy Council that the patentee had been inadequately remunerated by his patent.

Extension was by special Act.

Extension now by Privy Council when remuneration is inadequate.

Grounds for extension of term.

This is the only ground upon which a patent may be extended; and, in order to obtain an extension, the patentee will have to show that his invention was one of unusual merit, and that, through no fault of his own, he has failed to secure proper remuneration, but not necessarily that if the term be extended he will be able to do so,[1] though, where the original inventor will not benefit, an extension will not be granted.[2]

A petition may be presented, and an extension of the

[1] Jones' patent, 1840, 1 W.P.C. 579.
[2] Finch's patent, 1898, 15 R.P.C. 676.

patent may be granted, for part only of the invention originally protected.[1]

Extension as to part of patent.

Procedure for obtaining Extension.

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

Patentee may petition for extension. Act, 1883, sect. 25 (1).

A patentee here means a person for the time being entitled to the benefit of the patent; and it is only such a person who may present a petition for extension. If the petitioner be an assignee, he must prove his title strictly;[2] but there is no objection to an extension being granted in a suitable case to an assignee, whether a private person or a public company,[3] provided such extension will benefit the first inventor.[4]

Meaning of patentee.

There does not appear to have been any case in which one of several joint patentees has presented a petition for extension without joining his co-patentees, but there seems no reason, provided he can show what profits they have made, why such a petition would not be properly presented, and an extension granted to such joint patentee with due provision for preserving the rights of his co-patentees.

A joint patentee can probably petition alone.

When a patent has been once extended, no further extension can be granted.[5]

Only one extension.

The Privy Council have no power to extend the time for petitioning for the extension of a patent beyond the limit of six months before its expiration.[6]

Time for petitioning.

[1] Bodmer's patent, 1853, 8 Moo. P.C.C. 282; Lee's patent, 1856, 10 Moo. P.C.C. 226; Napier's patent, 1881, L.R. 6 App. Cas. 174.

[2] Galloway's patent, 1843, 1 W.P.C. 725.

[3] Houghton's patent, 1871, L.R. 3 P.C. 461.

[4] Finch's patent, 1898, 15 R.P.C. 676.

[5] Goucher's patent, 1865, 2 Moo. P.C.C. (N.S.) 532.

[6] Adam's patent, 1899, 16 R.P.C. 1.

Rules for Procedure on Petitions.

Act, 1883, sect. 25 (6).

"It shall be lawful for His Majesty in Council to make from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee."

The following are the Rules to be observed in Proceedings before the Judicial Committee of the Privy Council under the Patents, Designs, and Trade Marks Act, 1883, Section 25.

I.

Advertisement of petition

A party intending to apply by Petition, under section 25 of the Act, shall give public notice by advertising three times in the *London Gazette* and once at least in each of three London newspapers.

If the applicant's principal place of business is situated in the United Kingdom, at a distance of fifteen miles or more from Charing Cross, he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business, and carries on no such manufacture, then, if he resides at a distance of fifty miles or more from Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

The applicant shall in his advertisements state the object of his Petition, and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day shall not be less

than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He shall also give notice that caveats must be entered at the Council Office on or before such day so named in the said advertisements.

II.

Time for presenting

A Petition under section 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.

The Petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the first of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

The Petitioner shall apply to the Lords of the Committee to fix a time for hearing the Petition, and when such time is fixed the Petitioner shall forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers.

III.

Documents to be lodged.

A party presenting a Petition under section 25 of the Act must lodge at the Council Office eight printed copies of the specification; but if the specification has not been printed, and if the expense of making eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only shall be deemed sufficient.

The Petitioner shall also lodge at the Council Office eight copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. He shall also furnish three copies of the said balance sheet for the use of the Solicitor

to the Treasury, and shall, upon receiving two days' notice, give the Solicitor to the Treasury, or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance sheet at the hearing, or from which the materials for making up the said balance sheet have been derived.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for the hearing.

IV.

Opposition

A party intending to oppose a Petition under section 25 of the Act must enter a caveat at the Council Office before the day on which the Petitioner applies for a time to be fixed for hearing the matter thereof, and, having entered such Caveat, shall be entitled to have from the Petitioner four weeks' notice of the time appointed for the hearing.

The Petitioner shall serve copies of his Petition on all parties entering caveats in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service.

All parties intending to oppose a petition shall, within three weeks after such copies are served on them respectively, lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the Petition.

V.

Copies of deposited documents.

Parties shall be entitled to have copies of all papers lodged in respect of any Petition under section 25 of the Act at their own expense.

All such Petitions and all statements of grounds of objection shall be printed in the form prescribed by the Rules which apply to proceedings before the Judicial

Committee of the Privy Council. Balance sheets of expenditure and receipts shall be printed in a form convenient for binding along with such Petitions.

VI.

Costs incurred in the matter of any Petition under section 25 of the Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any Petition, and the Registrar, or such other officer, shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses. Costs.

VII.

The Lords of the Committee may excuse Petitioners and Opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under section 25 of the Act as they shall consider to be just and expedient. Waiver of compliance with rules.

VIII.

The Lords of the Committee will hear the Attorney-General or other Counsel on behalf of the Crown on the question of granting the prayer of any Petition under section 25 of the Act. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take, or of any evidence which he may think fit to place before the Lords of the Committee. Crown to be heard on petition.

The Privy Council cannot, under Rule VII., extend the time for lodging a petition for extension beyond six months prior to the termination of the term of the patent, that time being fixed by statute.[1]

[1] Adam's patent, 1899, 16 R.P.C. 1.

Time for advertising.

Where, however, by an oversight, the necessary advertisements have not been published, the Privy Council will, in order to enable the petition to be presented before six months from the date of expiration of the patent, allow a petition to be received subject to an undertaking to insert the proper advertisements.[1]

It will be seen that, by Rule I., the advertisement must give notice that any person may lodge a caveat against the petition within a certain time, and the Act itself provides that—

Caveats Act, 1883, sect. 25 (2).

"Any person may enter a caveat addressed to the Regist ar of the Council at the Council Office, against the extension."

A caveat must be lodged in the name of the actual objector, not in that of a patent agent for him.[2]

Time for lodging caveat.

The time for entering a caveat will not be extended merely because the party desirous of opposing was not aware of the proceedings for prolongation.[3]

Who will be heard on petition. Act, 1883, sect. 25 (3).

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

As a rule, not more than two counsel will be heard on behalf of any party entitled to be heard.

Grounds for decision. Sect. 25 (4).

"The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case."

In a petition for extension the petitioner must not withhold anything which is material; the committee require that *uberrima fides* shall be shown by him, since the grant of an extension is entirely a matter of grace; and if the committee find that any material fact has been suppressed, they will dismiss the petition.[4]

[1] Lindon's patent, 1897, 14 R.P.C. 643.

[2] Lowe's patent, 1852, 8 Moo. P.C.C. 1.

[3] Hopkinson's patent, 1896, 13 R.P.C. 114.

[4] Horsey's patent, 1884, 1 R.P.C. 225; Clark's patent, 1870, L.R. 3 P.C. 421; Ferranti's petition, 1901, 18 R.P.C. 518.

Any earlier patents dealing with the same subject-matter should be disclosed, and generally everything bearing on the matter should be stated on the face of the petition.[1]

The committee will not grant an adjournment to supplement an obvious defect in the petition.[2]

Accounts must be perfect.

The first thing which the Judicial Committee look at is the profit made by the patentee, and it is most essential that the accounts filed should be as perfect as possible.

"It is the duty of every patentee who comes for the prolongation of his patent to take upon himself the onus of satisfying this committee, in a manner which admits of no controversy, what has been the amount of remuneration which in every point of view the invention has brought to him, in order that their lordships may be able to come to a conclusion whether that remuneration may fairly be considered as a sufficient reward for his invention or not. It is not for the committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what might be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the committee in a shape which will leave no doubt as to what the remuneration has been which he has received."[3]

Duty of patentee to keep accounts.

A patentee should always keep accurate accounts of matters connected with his patent, in view of a possible petition for extending its term, since accounts made up from memory or conjecture are very objectionable and likely to defeat the petition. This was clearly stated in the Privy Council in the following language: "Their Lordships have to complain of the very unsatisafctory manner in which the accounts have been presented to them, which has compelled them in many particulars to

[1] *In re* Standfield's patent, per Lord Hobhouse, 1898, 15 R.P.C. 17.

[2] Peach's patent, 1901, 19 R.P.C. 65.

[3] Henderson's patent, 1901, P.C., 18 R.P.C. 449, quoting Saxby's patent, L.R. 3 P.C. 294.

resort to conjecture where certainty ought to have been afforded. There can be no difficulty in a patentee beginning from the first to keep a patent account distinct and separate from any other business in which he may happen to be engaged. He knows perfectly well that if his invention is of public utility, and he has not been adequately remunerated, he will have a claim for an extension of the original term of his patent. It is not, therefore, too much to expect that he should be prepared when the necessity arises to give the clearest evidence of everything that has been paid and received on account of the patent. In the present case it is said that the capsule business, the subject of the patent, was blended with the other business of the petitioner, and that it is impossible to distinguish them. This may be perfectly true at the present time, but it need not have been so if the petitioner had proceeded from the first upon a separate system of account keeping. For want of this he has to resort to speculation as to how much of the entire business ought to be ascribed to the patent, and to arrive at the conclusion by assuming as the basis of calculation the royalty which a licencee would be disposed to give." [1]

Form of accounts.

The accounts should, on the one side, show all receipts in connection with the patent, and, on the other, all the expenditure, and in the latter may be included the cost of legal proceedings, the cost of the patent and of experiments, and the expense of bringing the invention into use.[2]

Profits of company working patent.

The accounts of the original patentee must, of course, be filed, and, if he has sold his patent to a company for cash and shares, the accounts must show the profits made by the company.[3] And also what sales of the patentee's shares, if any, have taken place, since it is necessary to

[1] Betts' patent, 1 Moo. P.C.C. (N.S.) 49, cited in Hughes' patent, 1898, 15 R.P.C. 372.

[2] Galloway's patent, 1843, 1 W.P.C. 725.

[3] Deacon's patents, 1887, 4 R.P.C. 119.

show that the origiral inventor, as well as the assignee, has been inadequately remunerated.[1]

The fact that the patentee has no interest in the prolongation is very strong against prolongation being granted.[2]

The accounts must, of course, show all royalties received from licencees under the patent, and, if there be a free licencee, the profits made by him, compared with those made by royalty-paying licencees, should be shown in the account.[3] Manufacturer's profit cannot be distinguished from patentee's profit.[4]

Profits of free licence.

The ground for granting an extension being want of proper remuneration for the invention, the patentee must show what remuneration he has received for the invention independently of the English patent. For this purpose, if there be any foreign patents, accounts of the profits in respect of them should be submitted to the Judicial Committee.[5]

Profits of foreign patents must be stated.

If proper accounts are not filed in time, an adjournment will not be granted;[6] and, if the accounts are not clear, evidence to explain them will not be allowed, but the petition will be dismissed with costs.[7]

When there is any profit, the utmost accuracy is necessary; but, when the accounts show a heavy loss, extreme accuracy is not required.[8]

A meritorious patent will be prolonged despite some

[1] Barff's and Bowen's patent, 1895, [1895]; A.C. 675, 12 R.P.C. 383.

[2] Clark's patent, 1899, 16 R.P.C. 433; Norton's patent, 1863, 1 Moore P.C.C. (N.S.) 339; Barff's and Bowen's patent [1895], A.C. 675; 12 R.P.C. 383; Finch's patent, 1898, 15 R.P.C. 674.

[3] Thomas's patents, 1892, 9 R.P.C. 367.

[4] Muntz's patents, 1846, 2 W.P.C. 121; Duncan and Wilson's patents, 1884, 1 R.P.C. 257; Saxby's patent, 1870, L.R. 3 P.C. 292.

[5] Newton's patents, 1884, 9 App. Cas. 592, 1 R.P.C. 177; Johnson's patent, 1871, L.R. 4 P.C. 75.

[6] Yates and Kellett's patent, 1887, 4 R.P.C. 150.

[7] Lake's patent, 1891, 8 R.P.C. 227.

[8] Darby's patent, 1891, 8 R.P.C. 380.

difficulty in ascertaining the exact amount of the patentee's remuneration.[1]

Remuneration for patentee's time.

In estimating the patentee's profits the Judicial Committee will, where he has been personally engaged in developing his invention, and in superintending the manufacture of goods under it, make an allowance out of the net amount received by him for remuneration for the time so expended by him.[2] Thus, even when the patentee has received considerably more than a fair return for capital expended by him, he may be able to show that most of the balance would be absorbed in paying him at a fair rate for work done after the patent was granted.[3]

In order to have a *primâ facie* case for extension, the remuneration must appear to be decidedly inadequate; and where large profits are shown the Judicial Committee will not go into the question of merit.[4]

When merits are considered

When the accounts show that the patentee has not made very large profits, the Judicial Committee will proceed to examine into the merits of the invention and into the other circumstances of the case. For this purpose the Judicial Committee assume that the patent is a valid one,[5] even though it may have been declared invalid in a Court of first instance, against the judgment of which an appeal is pending.[6] Although, however, the general question of validity will not be considered, evidence of anticipation by patents and by actual user is admissible.[7]

validity assumed.

[1] *In re* Parson's patent, 1898, 15 R.P.C. 349.

[2] Joy's patent, 1893, 10 R.P.C. 89; Carr's patent, 1873, L.R. 4 P.C. 539; Perkin's patent, 1845, 2 W.P.C. 17.

[3] Livet's patent, 1892, 9 R.P.C. 332; Hazeland's patent, 1894, 11 R.P.C. 467.

[4] Houghton's patent, 1871, L.R. 3 P.C. 461.

[5] Heath's patent, 1853, 2 W.P.C. 247; Hill's patent, 1863, 1 Moo. P.C.C. (N.S.) 258.

[6] Lane Fox's patent, 1892, 9 R.P.C. 411.

[7] Duncan Stewart's patent, 1885, 3 R.P.C. 7.

It has not been decided whether a patent which requires amendment can be extended.[1]

In order to obtain prolongation the petitioner must show that there is exceptional merit in the invention,[2] and, when a reasonable profit has resulted, the committee will consider whether the benefit to the patentee is commensurate with that to the public.[3] Exceptional merit must be shown.

If the patentee has not made any profit from the patent, the only questions for the Judicial Committee to consider are those of the merit of the invention and the conduct of the patentee.

The patentee will have to show that there is some considerable usefulness to the public[4] in the invention, and on the question of utility the fact that the invention has not been brought into extensive public use might lead the Judicial Committee to infer that it was not useful;[5] to remove this inference the patentee should be prepared to show that the invention is not from its nature easily brought into public use.[6] Utility must be shown.

As a rule, if the invention has not been brought into public use at all, this fact will go very strongly against any extension being granted, since the inference is that, if not used for fourteen years, the invention cannot be of any value.[7] If, however, the patentee can show that the invention is of such limited applicability that it has hardly had a fair chance of being used,[8] or that the experiments necessary to perfect it were difficult to carry Invention not brought into use. Extension of patent not brought into use.

[1] *In re* Burlingham Innes & Lee's patent, 1898, 15 R.P.C. 195.

[2] Beanland's patent, 1887, 4 R.P.C. 489.

[3] Derosne's patent, 1844, 2 W.P.C. 1.

[4] Woodcroft's patent, 1846, 2 W.P.C. 31.

[5] Simister's patent, 1842, 1 W.P.C. 723; Napier's patent, 1861, 13 Moo. P.C.C. 543.

[6] Semet and Solway's patent, 1895, A.C. 78, 12 R.P.C. 10.

[7] Wright's patent, 1839, 1 W.P.C. 576; Roper's patent, 1887, 4 R.P.C. 201; Allan's patent, 1867, L.R. 1 P.C. 507.

[8] Roper's patent, 1887, 4 R.P.C. 201; Stoney's patent, 1888, 5 R.P.C. 518; Southby's patent, 1891, 8 R.P.C. 433; Bakewell's patent, 1852, 15 Moo. P.C.C. 385; Currie and Timmis' patent, 1898, 15 R.P.C. 63.

out, and that due diligence has been used in carrying them out,[1] and that there is every prospect that if the term be extended it will get into use, the Judicial Committee may grant the extension.

Utility considered in relation to merit.

The consideration of utility by the Judicial Committee is not at all connected with validity, as the following quotation clearly shows:—

"Their Lordships do not propose in this case to go into any question with reference to the novelty or utility of this invention. In point of fact, it is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would, of course, abstain in any case from prolonging a patent which was manifestly bad, yet, in one point of view, they are in the habit, in taking into account that which may be termed the question of utility, to consider not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit."[2]

Effect of unchecked infringement.

The Judicial Committee will also consider all the circumstances of the case, and in this connection they will look at what the patentee has done in endeavouring to get the patent worked. It will go against him if he has slept on his rights for a long time, either by allowing infringements to go unchecked, or by not endeavouring to get the invention worked till a large part of his time had expired.[3]

Effect of exclusive licence.

An agreement giving one party an exclusive right to use the invention will be treated with disfavour;[4] and, if an extension be granted, an exclusive licencee may be required to renounce all claim under his licence before the extension is registered.[5]

[1] Thompson's patent, 1902, 19 R.P.C. 565.

[2] Saxby's patent, 1870, L.R. 3 P.C. 294; Cockling's patent, 1885, 2 R.P.C. 151.

[3] Pettit Smith's patent, 1850, 7 Moo. P.C.C. 133.

[4] Darby's patent, 1891, 8 R.P.C. 384.

[5] Shone's patent, 1892, 9 R.P.C. 438; Lyon's patent, 1894, 11 R.P.C. 537.

Where the patentee will not derive any benefit from a prolongation, a prolongation will not be granted.[1]

When there are foreign patents, whether granted before or after the English Patent, the fact that they have lapsed does not affect the discretion of the Judicial Committee in recommending an extension;[2] but if, at the date of the application for a patent in this country, the invention was well known abroad, the importer is unlikely to obtain any extension.[3]

Lapsed foreign patents do not affect extension.

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

Act, 1883, sect. 25 (5). How patent is extended.

When the extension is granted to some party other than the original patentee, the Judicial Committee sometimes make it a condition that some benefit should be reserved to him,[4] or to his family,[5] unless he has been already remunerated.[6]

It is not unusual to impose terms as to the granting of licences to any persons who may care to apply for them,[7] and to make other conditions for the working of the patent, so as to protect the public and parties other than the patentee from hardship or injustice.[8]

Where a patent is mortgaged the patentee will be required to extend the mortgage so as to cover the extended patent.[9]

[1] *In re* Finch's patent, 1898, 15 R.P.C. 674.
[2] Semet and Solway's patent [1895], A.C. 78.
[3] Claridge's patent, 1851, 7 Moo. P.C.C. 394.
[4] Hard's patent, 1849, 6 Moo. P.C.C. 141.
[5] Herbert's patent, 1867, L.R. 1 P.C. 399.
[6] Bodmer's patent, 1849, 6 Moo. P.C.C. 468.
[7] Lyon's patent, 1894, 11 R.P.C. 537; Mallet's patent, 1866, L.R. 1 P.C. 308.
[8] Normandy's patent, 1855, 9 Moo. P.C.C. 452.
[9] Church's patents, 1886, 3 R.P.C. 95.

Assessor may be called in. Act, 1883, sect. 28 (2) (3).

"The Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them, call in the aid of an assessor."

"The remuneration, if any, to be paid to an assessor under this section shall be determined by the Judicial Committee, and be paid in the same manner as the other expenses of the execution of this Act."

Costs. Act, 1883, sect. 25 (7).

"The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice."

No rule can be laid down as to costs in petitions for extension; in each case the Judicial Committee will consider all the circumstances of the case, and one case is no guide to what will be done in another. If the petition is abandoned, the petitioner will have to pay the opponent's costs.[1]

Council Office Fees.

On Petitions to the King in Council.

	£	s.	d.
Entering	1	1	0
Setting down petition	0	10	0
Summons	0	10	0
Committee Report	1	10	0
Order of His Majesty in Council	3	2	6
Committee Order	1	12	6
Lodging affidavit	1	1	0
Lodging petition	1	1	0
Searching books for information for parties	0	10	0
Committee references	2	2	0
Lodging caveat	1	1	0
Subpœna to witness.	0	10	0
Fee for taxation petitions	1	1	0

[1] Morgan Brown's patent, 1886, 3 R.P.C. 212.

CHAPTER XXIII.

OFFENCES.

"(1) ANY person who represents that any article sold by him is a patented article, when no patent has been granted for the same, shall be liable for every offence on summary conviction to a fine not exceeding five pounds. Act, 1883, sect. 105. Penalty on falsely representing articles to be patented.

"(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented if he sells the article with the word 'patent,' 'patented,' or any word or words expressing or implying that a patent has been obtained for the article stamped, engraved or impressed on, or otherwise applied to the article."

If a patent has been granted, but has lapsed before the time at which the representation is made, this will be sufficient to avoid the penalty.[1] If patent has lapsed.

When a complete specification has been accepted, articles made under it may be safely marked "Patent".

Section 15 gives all privileges on acceptance.[2]

An improper use of the word patent in a trade mark is sufficient to disable the owner thereof from suing for infringement.[3]

"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." Act, 1883, sect. 93. Falsification of register.

"After the 1st day of July, 1889, 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." Using the title of patent agent.

[1] Myers *v.* Baker, 1858, 3 H. & N. 802; Cheavin *v.* Walker, 1876, 5 Ch. D. 850; The Leather Cloth Co. *v.* The American Cloth Co., 1865, 11 H.L.C. 523.

[2] R. *v.* Townsend, 1896, Pat. Ct., 13 R.P.C. 265.

[3] Per Rigby, L.J., Hubbuck *v.* Brown, 1900, 17 R.P.C. 638, 647.

Act, 1888, sect. 1 (1). Sect. 1 (4). Sect. 1 (5).

"If any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable on summary conviction to a fine not exceeding £20."

In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

The fact that a person is qualified to be on the register does not entitle him to describe himself as a patent agent; he must pay the fees and do all that is necessary to procure himself to be registered.[1]

It is not an offence against this section for any person to describe himself as a patent expert, or to use any other similar title, provided he does not make use of the actual designation "Patent Agent".[2] Nor is it an offence for any person to sign a specification or do any other act as agent for an applicant for letters patent.[3]

An action will not lie to restrain an unqualified person from describing himself as a patent agent.[4]

Summary proceedings in Scotland. Act, 1883, section 108.

"In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court."

In Ireland. Act, 1883, sect. 117.

"In the application of this Act to Ireland, 'summary conviction' means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it."

In Isle of Man. Act, 1883, sect. 112 (c).

"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."

Misdemeanour in Isle of Man. Act, 1883, sect. 112 (b).

"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."

[1] Starey v. Graham, 1899, Div. Ct., 16 R.P.C. 106.

[2] Graham v. Eli, 1898, Div. Ct., 15 R.P.C. 259.

[3] Graham v. Fanta, 1892, Div. Ct., 9 R.P.C. 263; Graham v. Eli, *supra*.

[4] Chartered Institute of Patent Agents v. Lockwood, 1894, H.L. 11 R.P.C. 374.

CHAPTER XXIV.

REGISTER OF PATENTS.

"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 transmission of patents, of licences under patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed. Act, 1883, sect. 23.

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

"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."

The actual proprietorship must, in general, be affected by a document that is entered on the register; a letter agreeing to give an exclusive licence on terms of royalties to be agreed on is not a document that can be entered on the register;[1] nor can an old agreement, in a general form, relating to future patents.[2]

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

"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." Entry in respect of Convention application. Rule 52.

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

[1] Fletcher's patent, 1893, 10 R.P.C. 252.
[2] Parnell's patent, 1888, 5 R.P.C. 126.

Entry of failure to pay fees. Rule 62.

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

Alteration of address. Rule 53.

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

This application must bear a stamp for 5s.

Registration of assignments, etc. Act, 1883, sect. 87.

"Where a person becomes entitled by assignment, transmission or other operation of law to a patent, the Comptroller shall, on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent in the Register of Patents. The person for the time being entered in the Register of Patents as proprietor of a patent shall, subject to the provisions of this Act and any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, licence or dealing. Provided that any equities in respect of such patent may be enforced in like manner as in respect of any other personal property."

But although it is provided that—

No notice of trust on register. Act, 1883, sect. 85.

"There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied or constructive,"

Equitable assignment.

it has been decided that an equitable assignment of a patent can be entered in the register.[1]

A patent belonging to a bankrupt, or granted to an undischarged bankrupt, passes to the trustee as part of his estate.[2]

Notice of an equity will defeat priority of registration,[3] and the assignee of an assignee takes subject to the terms of the first assignment.[4]

Request for entry of subsequent proprietorship. Rule 54.

"Where a person becomes entitled to a patent, or to any share or interest therein, by assignment, or by transmission, or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller and left at the Patent Office."

[1] Stewart v. Casey, 1892, C.A. 9 R.P.C. 9.
[2] Hesse v. Stevenson, 1803, 3 Bos. & P. 565.
[3] New Ixion Tyre v. Spilsbury, 1898, 15 R.P.C. 380; [1898] 2 Ch. 484.
[4] Werdeman v. Société Generale d'Électricité, 1881, 19 Ch.D. 247.

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

Such request must bear a stamp for 10s.

"Every such request shall state the name, address and calling of the person claiming to be entitled to the patent or to any share or interest therein, as the case may be, and the particulars of the assignment, transmission or other operation of law, by virtue of which he claims to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted. Particulars to be stated in request. Rule 56.

"Every assignment and every other document containing, giving effect to, or being evidence of the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall, unless the Comptroller in his discretion otherwise directs, be produced to him, together with the request and such other proof of title as he may require for his satisfaction. Production of documents of title and other proof. Rule 57.

"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.

"There shall also be left with the request an attested copy of the assignment or other document or copy above required to be produced. Copies for Patent Office. Rule 58.

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

"Where an order has been made by His Majesty in Council for the extension of a patent for a further term, or for the grant of a new patent, or where an order has been made for the revocation of a patent or the rectification of the register under section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the register, as the case may be." Entry of orders of the Privy Council or of the Court. Rule 60.

An application for the entry of an order of the Privy Council in the register must be made on Patent Form S, and must bear a stamp for 10s.

See App. A.

"If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree or other authority for the rectification shall be served on the Comptroller, and he shall rectify the register accordingly." Scotch or Irish Order, how registered. Act, 1883, sect. 111 (2).

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

See App. A.

A request to enter a notification of a licence or other document must bear a stamp for 10s.

Register to be open to public. Act, 1883, sect. 88.

"Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and 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."

The fee for each inspection is 1s.

Hours of inspection of register. Rule 64.

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

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

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

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

Sealed copies are evidence. Act, 1883, sect. 89.

"Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals."

Certified copies of documents. Rule 79.

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

The fee for office copies is 4d. per 100 words, but never less than 1s., and for drawings according to agreement. The cost of a printed specification is 8d. There is a fee of 1s. for certifying an office copy or specification, etc.

Certificate of Comptroller to be evidence. Act. 1883, sect. 96.

"A certificate purporting to be under the hand of the Comptroller as to any entry, matter or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made and of the contents thereof, and of the matter or thing having been done or left undone."

See App. A.

The fee for a certificate from the Comptroller is 5s.; it is given on Patent Form Q.

"The Comptroller may, on request in writing, accompanied by the prescribed fee,— Clerical errors may be corrected. Act, 1883, sect. 91.

(*a*) Correct any clerical error in or in connection with an application for a patent; or

(*b*) Correct any clerical error in the name, style or address of the registered proprietor of a patent."

An application to the Comptroller to correct a clerical error must be made on Patent Form P, which must bear a stamp for 5s. or £1, according as the application is made before or after the patent is sealed. See App. A.

"The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit. Correction of register by the Court. Act, 1883, sect. 90.

"The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

"Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the Comptroller."

A person who has agreed to purchase a share of a patent is aggrieved by the registration of a transfer of another share, executed by a bankrupt, but if the invalidity of the transfer has been cured by a transfer from the Official Receiver, a motion for rectification will be refused with costs.[1]

Rectification of the register cannot be obtained by means of a counter-claim in an action, but must be made the subject of an original motion.[2]

The Court here means the High Court, or other Court having jurisdiction in patent matters.

"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." Falsification of register a misdemeanour. Act, 1883, sect. 93.

[1] *In re* Manning's patent, 1903, 20 R.P.C. 74.

[2] Pinto *v.* Badman, 1891, 8 R.P.C. 181.

CHAPTER XXV

COMPULSORY LICENCES.

Act, 1902, sect. 3.

(1) ANY person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent;

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves, the Board of Trade, if satisfied that a *primâ facie* case has been made out, shall refer the petition to the Judicial Committee of the Privy Council, and if the Board are not so satisfied, they may dismiss the petition;

(3) Where any such petition is referred by the Board of Trade to the Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licences on such terms as the said Committee may think just, or if the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by Order in Council;

Provided that no order of revocation shall be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default;

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licencee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard;

(5) If it is proved to the satisfaction of the Judicial Committee that the patent is worked or that the patented article is manufactured exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public have been satisfied, the petitioner shall be entitled either to an order for a compulsory licence or, subject to the above proviso, to an order for the revocation of the patent;

(6) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, (*a*) any existing industry or the establishment of any new industry is unfairly prejudiced, or (*b*) the demand for the patented article is not reasonably met;

(7) An Order in Council directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding;

(8) His Majesty in Council may make rules of procedure and practice for regulating proceedings under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council or any order made by the Judicial Committee under this Act may be enforced by the High Court as if it were an order of the High Court; See p. 241.

(9) The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but in awarding costs on any application for the grant of a licence the Judicial Committee may have regard to any previous request for, or offer of, a licence made either before or after the application to the Committee;

(10) For the purposes of this section three members of the Judicial Committee shall constitute a quorum;

(11) This section shall apply to patents granted before as well as after the commencement of this Act.

Comparison with repealed provisions.

The provisions of this section are far stronger than those of the section 22 of the Act of 1883 which it replaces, and may be found to be of even wider application than was expected when the Act was passed. It will be noticed that two cases are provided for in sub-sections 3 and 5 respectively. Sub-section 3 provides for any case in which the reasonable requirements of the public have not been satisfied, without any question as to the reason for such being the case, and in such cases the Judicial Committee has a discretionary power to make an order for a compulsory licence or for revocation, in case the grant of a licence would not meet the case; but if the patentee can show any good ground for not making such an order, as, for example, that he is about to commence working the patent himself, or has arranged

for its working by some one else, in such a way as to secure the satisfaction of public requirements in the future, the petitioner cannot absolutely claim an order in his favour.

In the special case dealt with by sub-section 5 the Committee is not left to exercise any such discretion, and if the petitioner can show that the patent is worked, and the patented article is manufactured exclusively or mainly outside the United Kingdom, then the burden is thrown on the patentee of showing that, in spite of the facts proved by the petitioner as to the working of the patent being done abroad, still the reasonable requirements of the public have been satisfied.

Reason for provision.

Now, there is little doubt that the main reason for the enactment was to prevent a British patent from being used simply to prevent the growth of a new industry in this country, by what may be termed the dog-in-the-manger policy adopted by many foreign patentees, and the words of the section, if followed to their logical conclusion, seem very apt for effectuating that object. It will be seen that by sub-section 6 the reasonable demands of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms: (*a*) Any existing industry or the establishment of any new industry is unfairly prejudiced; or (*b*) the demand for the patented article is not reasonably met. It is to the former of these conditions that most consideration must be given, since any demand for a patented article would appear to be capable of being met by importation as fully as by home manufacture.

Effect of condition as to foreign working.

The first condition is very general in its application, and, indeed, seems to apply to practically every case in which manufacture is carried on entirely or mainly abroad. The expression "establishment of any new

industry" includes, of course, the establishment of the industry of manufacturing the patented article, or of carrying into effect the patented process, while the section, of course, alludes to the establishment of an industry in the United Kingdom. This being the case, it is not easy to see how the establishment of such an industry can be otherwise than unfairly prejudiced by being delayed for fourteen years until the foreign producer has trained his men to the work, obtained the benefit of long experience, and, at the same time, secured the markets of the world for himself, so that when his monopoly shall at last expire he will have practically nothing to fear from competition in this country, and will have practically obtained a perpetual monopoly. Precisely the same reasoning applies to any working of the patent in the United Kingdom, merely with a view to formally satisfying the requirements of the Act while carrying on the bulk of the work abroad; indeed, it would seem as though working to an adequate extent in the United Kingdom must necessitate sufficient working to train those engaged in the work in sufficient numbers, and to a sufficient extent, to enable the home producer to compete on fair terms with the foreign producer, both at home and abroad, when the term of the patent shall have expired. If the patent relates to an article in large demand for export to countries in which it is not protected by a patent, and the patentee works his patent in the United Kingdom, even to a sufficient extent to supply the home demand, but so that there is no export trade from this country established in the subject-matter of the patent during its existence, it must surely be held that the establishment of the industry here is unfairly prejudiced by its exclusion from foreign markets.

Reasonable requirements of public.

It is to be hoped that the Judicial Committee will put a liberal interpretation on sub-section 6, and regard the reasonable requirements of the public as satisfie[illegible]

only by such working in the United Kingdom as will put the home producer on an equality with his foreign rivals, both in the home markets and in the markets of the world.

Sub-sect. 6. Licence or revocation.

It will be noticed that, if the case comes under sub-section 6, the Judicial Committee have no choice, except between ordering the grant of a licence or revoking the patent; but this is merely a special case under sub-section 3, and the licence is to be on such terms as appear just, and, in the case of the article being unprotected in any foreign country, it might be made a term of the licence that goods for export should be free from royalty, but be marked not to be used in the United Kingdom, while a proper royalty would be reserved for articles intended for home use. Unless such a provision be made for exported articles it is not easy to see how the grant of a licence would be a sufficient remedy, and the alternative would therefore appear to be revocation, which would be even more unsatisfactory to the patentee.

Terms of licences.

As to the terms upon which the Judicial Committee will order licences to be granted, it is, of course, impossible to make any accurate forecast. In the case of an applicant asking only for a licence to manufacture for export to countries in which the patentee has no protection, there seems to be no reason why a licence for such manufacture should not be granted at a nominal royalty, with the condition of proper marking of all articles made by the licencee, as the rights of the patentee under his patent are not materially affected by the establishment of an export trade.

Under the old procedure the royalty fixed by a compulsory licence might be higher than the usual royalty required by the patentee,[1] while a minimum royalty depending on the subject-matter was usual.[2]

[1] Hutton & Bleakley's petition (Bousfield, Q.C., referee), 1898, 15 R.P.C. 749.
[2] Levinstein's petition, 1898, 15 R.P.C. 74; where a form of licence is given.

Whether, in any case outside sub-section 5, a licence be granted or not depends entirely upon the special facts, and it is impossible to formulate any general rules to guide intending petitioners. Discretionary grants.

The following are instances of petitions, of which there were very few, under the old provisions. A petitioner who had an invention that was an improved variety of a species covered by the respondent's patent, was refused a licence on the respondent's making a reasonable offer to manufacture such improved variety for the petitioners.[1]

The proprietor of a newspaper was granted a licence for an invention for rapidly inserting late news, although the proprietor of a rival paper was in possession of an exclusive licence for its use in the district.[2]

A licence was granted to work under a chemical patent owned by a foreign manufacturer.[3]

Procedure.

A petition to the Board of Trade for a compulsory licence or revocation must be made on Form H, bearing an impressed stamp for £1. See App. A.

"A petition to the Board of Trade for an order under section 3 of the Patents Act, 1902, shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order, and the name and address of the patentee and any other person who is alleged in the petition to have made default." Petition for grant of compulsory licence or revocation of Patent. Rule 69.

"The petition and an examined copy thereof shall be left at the Patent Office, accompanied by affidavits or

[1] Bartlett's patent, Gormully petition, 1899, 16 R.P.C. 641.
[2] Hutton & Bleakley's petition, 1898, 15 R.P.C. 749.
[3] Levinstein's petition, 1898, 15 R.P.C. 742.

To be left with evidence at Patent Office. Rule 70.

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. Rule 71.

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

Evidence in reply.

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

Closing of evidence. Rule 72.

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

For form of declarations, etc., see p. 81.

Power of Board of Trade to dismiss petition. Rule 73.

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

"If they are so satisfied, they shall consider whether

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

Arrangements between parties. Rule 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 Judicial Committee, with copies of any affidavits, statutory declarations, or other documentary evidence which may have been furnished under the foregoing Rules, and with certified copies of all entries in the Register of Patents relating to the patent in question, and any other information in the possession of the Board which it appears to them may be of service to the Judicial Committee in ascertaining what persons should be made parties to the proceedings before the Committee, and the Board shall give written notice to the parties that the petition has been referred to the Judicial Committee."

Reference of petition to Judicial Committee. Rule 75.

Rules to be observed in Proceedings before the Judicial Committee of the Privy Council, under the Patents Act, 1902, Section 3.[1]

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

II. (*a*) No application to fix a time for hearing the Petition shall be made unless the Petitioner shall have

[1] Dated 16th February, 1903.

previously given notice to the Patentee, to the opponents and to any other person claiming an interest in the patent as exclusive licencee or otherwise, that the Petition has been referred to the Judicial Committee, that it is his intention to apply to the Judicial Committee on a specified day, which day shall be not less than four weeks from the date when the notice is served or sent, to fix a time for hearing the Petition, and that any person desiring to be heard before the Judicial Committee at the time so fixed must enter a caveat at the Council Office on or before the day so specified.

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

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

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

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

V. The time for hearing a Petition shall be fixed

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

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

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

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

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

IX. No solicitor or agent shall be entitled to conduct proceedings under this Act before the Judicial Committee, unless he is a solicitor or agent admitted to practise before the Privy Council, in accordance with Her late Majesty's Order in Council of the 6th March,

1896. Such solicitor or agent shall be allowed the same fees, and the same Council Office fees shall be chargeable in respect of proceedings under this Act as are prescribed by the general Rules applicable to proceedings before the Judicial Committee.

X. Applications to the Judicial Committee to fix a time for hearing the Petition, and on other matters of procedure, shall be addressed in the first instance to the Registrar of the Privy Council, who shall take their Lordships' instructions thereon and communicate the same to the parties. In cases of doubt the Registrar may, or, if so requested by any of the parties, he shall, enter the application for hearing before their Lordships' Board.

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

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

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

XIII. The Judicial Committee may refer any matters in connection with proceedings under this Act to be examined and reported on in the same manner as matters may be referred by them under Section 17 of

the Act 3 & 4 Will. IV. c. 41 (Judicial Committee Act, 1833).

This section is as follows:—

It shall be lawful for the said committee to refer any matters to be examined and reported on to the aforesaid Registrar, or to such other person or persons as shall be appointed by His Majesty in Council, or by the said Judicial Committee, in the same manner and for the like purposes as matters are referred by the Court of Chancery to a master of the said Court; and for the purposes of this Act the said Registrar and the said person or persons so to be appointed shall have the same powers and authorities as are now possessed by a Master in Chancery. Judicial Committee Act, 1833, sect. 17.

XIV. The Judicial Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition. Counsel on behalf of the Crown is not required to give notice of the grounds of any objection he may think fit to take, or of any evidence which he may think fit to place before the Committee.

XV. Costs incurred in the matter of any Petition under this Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Judicial Committee to tax the same, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

CHAPTER XXVI.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International arrangements for protection of inventions. Act, 1883, sect. 103 (1), as amended by Act, 1901, sect. 1 (1).

"If His Majesty is pleased to make any arrangements with the Government or Governments of any foreign state or states for mutual protection of inventions . . . then any person who has applied for protection for any invention . . . in any such state shall be entitled to a patent for his invention . . under this Act in priority to other applicants; and such patent . . . shall have the same date as the date of the application in such foreign state.

"Provided that his application is made . . . within twelve months from his applying for protection in the foreign state with which the arrangement is in force.

"Provided that nothing in this section contained shall entitle the patentee . . . to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification."

Act, 1901, sect. 1 (2). 1 Ed. 7, c. 18.

An application under this section shall be accompanied by a complete specification, which, if not accepted within the period of twelve months, shall, with the drawings (if any), be open to public inspection at the expiration of that period.

Provision for Colonies and India. Act, 1883, sect. 104.

"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 . . . patented . . . in this country, it shall be lawful for His Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions (if any) as to His Majesty in Council may seem fit, to such British possession.

"An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for His Majesty in Council to revoke any Order in Council made under this Act.

Definition of British possession. Act, 1883, sect. 117.

"'British possession' means any territory or place situate within His Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one Legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"'Legislature' includes any person or persons who exercise legislative authority in the British possession; and where there are local Legislatures as well as a central Legislature, means the central Legislature only."

An International Convention for the protection of industrial property exists between the following states:— Patent Office Circular.

Belgium.
Brazil.
Denmark with the Faroe Islands.
France with Algeria and Colonies.
Great Britain with New Zealand and Queensland.
Italy.
Japan.
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.

"Similar arrangements, for the mutual protection of inventions, have been made between Great Britain on the one side, and each of the following States and Colonies on the other:—

Ecuador (Designs and Trade Marks only).
Greece (Designs and Trade Marks only).
Honduras.
Mexico.
Paraguay.
Roumania (Designs and Trade Marks only).
Tasmania.
Uruguay.
Western Australia.

"The publication in the United Kingdom or the Isle of Man during the . . . periods aforesaid of any description of the invention, or the use therein during such periods of the invention . . . shall not invalidate the patent which may be granted for the invention. . . . Act, 1883, sect. 103 (2).

"The application for the grant of a patent . . . under this section must be made in the same manner as an ordinary application under this Act. . . ." Act, 1883, sect. 103 (3).

Where the foreign state in which the first patent was taken out becomes a member subsequently to the date of that patent, but before that of the application here, the International Convention applies.[1] State joining Convention after date of first patent.

An appeal lies to the law officer with regard to an application under the International Convention.

[1] *Re* Main's patent, 1890, 7 R.P.C. 13.

Limitation of international arrangements. Act, 1883, sect. 103 (4).

"The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state."

Definition of convention application. Rule 3.

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

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

Applications under the International Convention.

Convention applications. Rule 13.

"Every Convention application shall contain a declaration that foreign application has been made for protection of the invention to which such Convention application relates, and shall specify all the Foreign States or British possessions in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a complete specification, and signed by the person or persons, by whom such first foreign 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, etc., to accompany application. Rule 14.

"Every Convention application, in addition to the specification left therewith, must be accompanied by a copy or copies of the specification, and drawings or documents filed or deposited by the applicant in the Patent Office of the Foreign State or British possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such

Foreign State or British possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto, and verified by statutory declaration or otherwise to the satisfaction of the Comptroller."

Public inspection. Rule 15.

"If the complete specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall, with the drawings, if any, be open to public inspection at the expiration of that period."

Proceedings. Rule 16.

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

Rule 52.

"The patent granted on any Convention application shall be entered in the register as dated of the date on which the first foreign application was made, and the payment of renewal fees and the expiration of the patent shall be reckoned as from the date of the first foreign application."

Such further proceedings include any act within the discretion or jurisdiction of the Comptroller, and consequent appeals to the law officer.[1]

A foreign patentee must elect whether he will apply under the International Convention, or risk having his patent invalidated by a prior publication in England of his prior foreign patent[2] or other anticipation. The election must be made when the application is lodged on which the patent is granted, and the date of the patent is conclusive as to the patentee's right to priority.[3]

[1] *Re* Main's patent, 1890, 7 R.P.C. 13.

[2] The British Tanning Co., Limited, *v.* Groth, 1891, 8 R.P.C. 121.

[3] Acetylene Illuminating Co. *v.* United Alkali Co., 1902, 19 R.P.C. 213; C.A. 20 R.P.C. 161.

Only the foreign patentee himself, or his legal personal representative, can take advantage of the International Convention; a patent to an agent for him can only be granted as of the date of application as on "an application for a communication from abroad".[1]

The chief points in the International Convention[2] are:—

Art. IV. (1) The right of priority obtained by a person who first applies for a patent in this country is seven months.

Importation. Art. V. (2) The importation by the patentee into the country where the patent has been granted of objects manufactured in any other state, belonging to the Union, does not entail forfeiture; but the patentee must work his patent in conformity with the laws of the country into which he so imports articles, when any working in such country is required in order to keep a patent in force.

Art. XI. (3) Temporary protection is given to patentable inventions for articles exhibited at official or officially recognised International Exhibitions.

International Office and periodical. "An International Office, in connection with the Convention, has been established at Berne, Switzerland, which publishes a monthly periodical, entitled *La Propriété Industrielle*. The yearly subscription (including postage) for all countries within the Postal Union is 5 francs 60 centimes, and should be forwarded by money order to L'Imprimerie Co-opérative, Berne."

[1] Shallenberger's application, 1889, 6 R.P.C. 550.

[2] The text of the Convention with a translation is published by Messrs. Eyre & Spottiswoode at 2d.

CHAPTER XXVII.

MISCELLANEOUS.

Warlike Inventions.

Assignment to Secretary for War of certain inventions. Act, 1883, sect. 44.

"(1) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor), may (either for or without valuable consideration) assign to His Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of His Majesty, all the benefit of the invention, and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

"(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of 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 for the time being.

Secretary for War may prevent publication of specifications.

"(3) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the Comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

Specifications, etc., kept in sealed packet.

"(4) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State.

"(5) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

"(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand

of the Secretary of State to receive the same, and shall, if returned to the Comptroller, be again kept sealed by him.

"(7) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the Secretary of State to receive it.

"(8) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

No revocation of patent not published.

"(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

No copies allowed.

"(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

May be published at any subsequent time.

"(11) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

Communication of invention to Secretary for War is not a publication.

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

Postal Communications.

Act, 1883, sect. 97. Rule 80.

"(1) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

"(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post."

Excluded Days.

Act, 1883, sect. 98.

"Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday,

or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days. Excluded days.

days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively."

Person Incapacitated from doing Anything.

"If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted." Act, 1883, sect. 99.

Fraudulent Applications.

"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." Act, 1883, sect. 35.

Power to Dispense with Evidence, etc.

"Where, under these rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence." Rule 78.

"Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for an amendment of a specification, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent. Discretionary power of Comptroller. Act, 1883, sect. 94.

Difficulties in administration. Act, 1883, sect. 95.

"The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter."

Power of amendment, etc. Rule 76.

Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

General power to enlarge time. Rule 77.

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 Rule 33 or in the procedure in these Rules relating to compulsory licences and revocation of patents, 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.

Annual reports of Comptroller. Act, 1883, sect. 102.

"The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries and allowances and other money received and paid under this Act."

Ireland and the Isle of Man.

Reservation of remedies in Ireland. Act, 1883, sect. 110.

"All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under, or in respect of, a patent as if the same had been granted to extend to Ireland only."

Act, 1883, sect. 112 (1).

"This Act shall extend to the Isle of Man, and—

"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, competent to those Courts."

Patent Museum, South Kensington.

Patent Office Circular, p. 8.

"This Museum was in 1883 placed under the management of the Department of Science and Art. It no longer forms a separate section, but has been incorporated with the general Science Collections of the South Kensington Museum. All communications relating thereto should be addressed to the Secretary, Science and Art Department, South Kensington, London, S.W. The Science Collections are open to the public *free* daily, from 10 A.M. to 10 P.M. on Mondays, Tuesdays and Saturdays, and from 10 A.M. to 4, 5 or 6 P.M. on other days of the week, according to the season. A number of the models may be seen in motion from 11 A.M. to the hour of closing. Entrance—Exhibition Road."

Models for Patent Museum. Act, 1883, sect. 42.

"The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled in case of dispute by the Board of Trade."

"Copies of all specifications, drawings and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals." Documents sent to British capitals. Act, 1883, sect. 100.

Certified copies of any entry in the Register, or certified copies of or extracts from patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee (see p. 258). Certified copies of documents. Rule 65.

Fees Payable at the Patent Office.

The fees to be paid under the said Acts shall be those specified in the list of fees in the first schedule to these Rules. Rule 4.

Forms to be used at the Patent Office.

The forms contained in the second schedule to these Rules may, as far as they may be applicable, be used in any proceedings under the said Acts or under these Rules, and so far as they relate to the same subject-matter, shall be substituted for the forms in the first schedule to the Act of 1883. Rule 5.

The above list of fees and the forms are given in Appendix A.

Patent Office Publications.

These may be consulted daily at the Free Public Library of the Patent Office; at the Science and Art Department, South Kensington; and at the Free Lib- Patent Office Circular.

raries, etc., named in Appendix C. They are also on sale at the Patent Office, 25 Southampton Buildings, Chancery Lane, W.C., and will be forwarded by post on receipt of the price and of the postage (if any is charged). *Sums amounting to* 1s. *or more must be remitted by Postal or Post Office Order, payable to the Comptroller-General.* Postage stamps sent in payment of any amount exceeding 11d. will be returned. Deposit accounts may be opened, the minimum deposit being £2.

In ordering specifications, the price of which is 8d. each, the name of the patentee and the number and year of the patent must be given. In searching for the invention of any particular person, the Name Indexes, published as part of the Illustrated Official Journal of Patents, should be consulted. In searching as to the novelty of any particular invention, the Abridgment Class and Index Key should first be consulted to ascertain where the subject-matter is classified in the Patent Office publications. The corresponding volumes of Abridgments of Specifications, each of which is furnished with Name and Subject-Matter Indexes, should then be examined. In the case of recent specifications, for which abridgment volumes have not yet been published, the annual and monthly Subject-Matter Indexes and Illustrated Official Journal must be consulted. Such searches cannot be undertaken by the Patent Office. See Par. 11.

"Specifications or other publications cannot be returned by the purchasers unless a wrong number has been supplied through an error on the part of the Patent Office."

APPENDIX A.

PATENT OFFICE FORMS.

FIRST SCHEDULE TO RULES.

List of Fees Payable on and in Connection with Letters Patent.

	£ s. d.	£ s. d.
1. On application for provisional protection ...	1 0 0	
2. On filing complete specification	3 0 0	
		4 0 0
or		
3. On filing complete specification with first application ...		4 0 0
4. On appeal from Comptroller to Law Officer. By appellant		3 0 0
5. On notice of opposition to grant of patent. By opponent		0 10 0
6. On hearing by Comptroller. By applicant and by opponent respectively		1 0 0
On application to amend specification :—		
7. Up to sealing. By applicant		1 10 0
8. After sealing. By patentee		0
9. On notice of opposition to amendment. By oppon...		0
10. On hearing by Comptroller. By applicant and by opp... respectively		0 0
11. On application to amend specification during action on proceeding. By patentee		3 0 0
12. On application to the Board of Trade for a compulsory licence. By person applying		1 0 0
13. On opposition to grant of compulsory licence. By opponent		1 0 0
On certificate of renewal :—		
14. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year		5 0 0
15. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year		6 0 0
16. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year		7 0 0
17. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year		8 0 0

18.	Before the expiration of the 8th year from the date of the patent and in respect of the 9th year	9	0	0
19.	Before the expiration of the 9th year from the date of the patent and in respect of the 10th year	10	0	0
20.	Before the expiration of the 10th year from the date of the patent and in respect of the 11th year	11	0	0
21.	Before the expiration of the 11th year from the date of the patent and in respect of the 12th year	12	0	0
22.	Before the expiration of the 12th year from the date of the patent and in respect of the 13th year	13	0	0
23.	Before the expiration of the 13th year from the date of the patent and in respect of the 14th year	14	0	0
	On enlargement of time for payment of renewal fees:—			
24.	Not exceeding one month	1	0	0
25.	„ two months	3	0	0
26.	„ three months	5	0	0
27.	For every entry of an assignment, transmission, agreement, licence, or extension of patent	0	10	0
28.	For duplicate of letters patent ... ... each	2	0	0
29.	On notice to Comptroller of intended exhibition of a patent under Section 39	0	10	0
30.	Search or inspection fee ... ... each	0	1	0
31.	For office copies ... ... every 100 words (but never less than one shilling)	0	0	4
32.	For office copies of drawings, cost according to agreement			
33.	For certifying office copies, MSS. or printed ... each	0	1	0
34.	On postal request for printed specification	0	0	8
	On request to Comptroller to correct a clerical error:—			
35.	Up to sealing	0	5	0
36.	After sealing	1	0	0
37.	For certificate of Comptroller under Section 96	0	5	0
38.	For altering address in register	0	5	0
39.	For enlargement of time for filing complete specification, not exceeding one month	2	0	0
	For enlargement of time for acceptance of complete specification:—			
40.	Not exceeding one month	2	0	0
41.	„ two months	4	0	0
42.	„ three months	6	0	0

SECOND SCHEDULE TO RULES.

FORMS.[1]

			PAGE
A.—	Form of Application for Patent		260
A1.—	„ „ „ *communicated from Abroad*		262
A2.—	„ Application for Patent under International and Colonial Arrangements		264
B.—	„ Provisional Specification		265
C.—	„ Complete Specification		266
C1.—	„ Postal Request for Printed Specification		267
D.—	„ Opposition to Grant of Patent		268
E.—	„ Notice that Hearing will be Attended		269
F.—	„ Application for Amendment of Specification		270
G.—	„ Opposition to Amendment of Specification		271
H.—	„ Application for Grant of Compulsory Licence or Revocation of Patent		272
H1.—	„ Petition for Grant of Compulsory Licence or Revocation of Patent		273
I.—	„ Opposition to Petition for Grant of Compulsory Licence or Revocation of Patent		274
J.—	„ Application for Certificate of Payment or Renewal ...		275
K.—	„ Application for Enlargement of Time for Payment of Renewal Fee		276
L.—	„ Request to Enter Name upon the Register of Patents ...		277
M.—	„ „ „ Notification of Licence or other Document in the Register of Patents		278
N.—	„ Application for Duplicate of Patent		279
O.—	„ Notice of Intended Exhibition of an Unpatented Invention		280
P.—	„ Request for Correction of Clerical Error		281
Q.—	„ Certificate of Comptroller-General		282
R.—	„ Notice for Alteration of an Address in Register		283
S.—	„ Application for Entry of Order of Privy Council in Register		284
T.—	„ Appeal to Law Officer		285
U.—	„ Application for Extension of Time for Leaving a Complete Specification		286
V.—	„ Application for Extension of Time for Acceptance of a Complete Specification		287
W.—	„ Patent		7

[1] As to obtaining forms, see p. 288.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form A.

(To be accompanied by two copies of Form B or of Form C.)

APPLICATION FOR PATENT.

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

(*a* _____

_____

_____

_____

_____

_____do hereby

declare that_____in possession of an invention the title of which

(*b*) Here insert title of invention.

is (*b*)_____

_____

_____

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

that (*c*)_____

claim to be the true and first inventor_____thereof; and that the same is not in use by any other person or persons to the best

of_____knowledge and belief; and _____humbly pray that a Patent may be granted to_____for the said invention.

Dated_____day of_____19____

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

(*d*)_____

_____

_____

NOTE.—One of the two forms on the opposite page or a separate authorisation of agent should be signed by the applicant or applicants.

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

(1) *Where application is made through an Agent* (*Rule* 81).

_____

_____hereby appoint_____

of_____

to act as_____Agent in respect of the within application for a Patent, and request that all notices, requisitions and communications relating thereto may be sent to such Agent at the above address.

_____day of_____19____

* _____ * To be signed by applicant or applicants.

_____

_____

_____

---

(2) *Where application is made without an Agent* (*Rule* 7).

_____

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

_____day of_____19____

† _____ † To be signed by applicant or applicants.

_____

_____

_____

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form A1.

(To be accompanied by two copies of Form B or of Form C.)

APPLICATION FOR PATENT FOR INVENTION COMMUNICATED FROM ABROAD.

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

I (a)_____

of_____in the

county of_____do hereby declare that I

(b) Here insert title of invention.

am in possession of an invention the title of which is (b)_____

_____

_____

_____

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

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

_____

_____

_____

_____

that I claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my knowledge and belief; and I humbly pray that a Patent may be granted to me for the said invention.

Dated _____day of_____19___

(d) To be signed by applicant or applicants.

(d)_____

_____

_____

_____

NOTE.—One of the two forms on the opposite page or a separate authorisation of agent should be signed by the applicant or applicants.

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

(1) *Where application is made through an Agent (Rule 81).*

_____hereby appoint_____

of_____

to act as_____Agent in respect of the within appplication for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

_____day of_____19____

* _____

*To be signed by applicant or applicants.

---

(2) *Where application is made without an Agent (Rule 7).*

_____

_____hereby request that all notices, requisitions, and communications in respect of the within application may be sent to_____

_____

_____at_____

_____

_____day of_____19____

† _____

† To be signed by applicant or applicants.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form A2.

(To be accompanied by two copies of Form C.)

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

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

(a)

(*b*) Here insert title of invention.

do hereby declare that I (or we) have made applications for protection of my (or our) invention of (*b*)

(*c*) Here insert the name of each *Foreign* State, followed by the official date of the application in each respectively.

in the following Foreign States and on the following official dates, *viz.*: (*c*)

(*d*) Here insert the name of each British possession, followed by the official date of application in each respectively.

and in the following British Possessions and on the following official dates, *viz.*: (*d*)

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (*e*)

(*e*) Here insert the official date of the earliest foreign application.

(*f*) Here insert the official date of the earliest *foreign* application.

to the best of knowledge, information, and belief, and humbly pray that a patent may be granted to for the said invention in priority to other applicants, and that such patent shall have the date (*f*)

(*g*) Signature of applicant or of each of applicants.

(*g*)

NOTE.—If the application be made through an agent a proper authorisation should be supplied: if not, an address for service to which communications may be sent should be furnished.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.

To be issued with Form A or A1.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form B.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

(a) _____

_____

_____

_____

(a) Here insert title verbally agreeing with that in the application form.

(b) _____

_____

_____

_____

_____

_____

(b) Here insert (*in full*) name, address and calling of applicant or applicants as in application form.

do hereby declare the nature of this invention to be as follows: (c)

_____

_____

_____

_____

_____

_____

_____

_____

_____

(c) Here begin description of the nature of the invention. The continuation of the specification should be upon wide-ruled paper of the same size, on one side only, with a margin of two inches on the left hand of the paper. The specification and the duplicate thereof must be dated (thus): "Dated this day of , 19 ," and signed at the end

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Where provisional specification has been left, quote No and date.
No._____
Date_____

PATENT.

Form C.

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

(a) Here insert title verbally agreeing with that in the application form.

(a)_____

(b) Here insert (*in full*) name, address and calling of applicant or applicants as in application form.

(b)_____

do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement :—

(c) Here begin full description of invention. The continuation of the specification should be upon wide-ruled paper of the same size, on one side only, with a margin of two inches on the left hand of the paper. The completion of the description should be followed by the words :—

(c)_____

"Having now particularly described and ascertained the nature of my said Invention, and in what manner the same is to be performed, I declare that what I claim is:" After which should be written the claim or claims numbered consecutively. The specification and the duplicate thereof must be dated (thus): "Dated this day of , 19 ," and signed at the end.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,

1883 TO 1902.

Form C1.

POSTAL REQUEST FOR PRINTED SPECIFICATION.

To the Comptroller-General.

Please send one copy of Specification, No. _____ Year _____

to

(*Name in full*) _____.

(*Address*) _____

PATENTS,
$7\frac{1}{2}d.$

$\frac{1}{2}d.$

The Comptroller-General,

The Patent Office,

25 Southampton Buildings,

London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form D.

PATENT.

FORM OF OPPOSITION TO GRANT OF PATENT.

(To be accompanied by an unstamped copy.)

* Here state (*in full*), name and address.

* I, _____

_____

_____

_____

hereby give notice of my intention to oppose the grant of Letters Patent upon application No. _____ of _____, applied for by _____

_____

_____

upon the ground †. _____

† Here state upon which of the grounds of opposition permitted by section 11 of the Act of 1883, as amended by section 4 of the Act of 1888, the grant is opposed.

_____

_____

_____

_____

_____

_____

_____

_____

_____

_____

‡ To be signed by opponent.

(Signed) ‡ _____

My address for service in the United Kingdom is :—

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form E.

PATENT.

FORM OF NOTICE THAT HEARING BEFORE THE COMPTROLLER WILL BE ATTENDED.

OPPOSITIONS TO THE GRANT OF PATENTS OR TO AMENDMENTS.

SIR,

_____ of (*a*) _____ (*a*) Here insert address.

_____

hereby give notice that the hearing in reference to _____

_____ will be attended by myself or by some person on my behalf.

_____

Sir,

Your obedient Servant,

(Signed) _____

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form F.

PATENT.

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION.

* Here state (*in full*) name and address of applicant or patentee.

* _____

_____

_____

_____

_____

seek leave to amend the specification of Letters Patent No. _____ of 1 , as shown in red ink in the certified copy of the original specification hereunto annexed.

† These words are to be struck out when Letters Patent have not been sealed, or when, if Letters Patent have been sealed, the application is made in pursuance of an order of the Court or a judge.

† I declare that no action for infringement or proceeding for revocation of the Letters Patent in question is pending.

‡ Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the Letters Patent.

My reasons for making this amendment are as follows ‡: _____

_____

_____

_____

_____

§ To be signed by applicant.

(Signed) § _____

My address for service in the United Kingdom is:—

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

N.B.—No amendment is permissible that would make the invention substantially larger or substantially different (section 18 of the Act of 1883): nor, so long as any action for infringement or proceeding for revocation of a patent is pending, may the application be made except by leave of the Court or a judge under section 19 of the Act of 1883. If the application is made by such leave, this should be stated, and an office copy of the order of the Court or judge should accompany the application.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form G.

PATENT.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION.

(To be accompanied by an unstamped copy.)

* _____ * Here state (*in full*) name and address of opponent.

_____

_____

_____

_____

_____

hereby give notice of objection to the proposed amendment of the specification of Letters Patent No. _____ of 1 _____ for the following reason : † _____ † Here state reason of opposition.

_____

_____

_____

_____

_____

_____

_____

_____

_____

_____

(Signed) _____

My address for service in the United Kingdom is:—

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

PATENTS ACT, 1902.

Form H.

FORM OF APPLICATION FOR GRANT OF COMPULSORY LICENCE OR REVOCATION OF PATENT.

PATENT.

(To be accompanied by an unstamped copy.)

* Here state (*in full*) name and address of applicant.

* _____

_____

_____

hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a licence to me by †_____

† Here state name and address of patentee, and number and date of his Patent.

_____

_____

_____

_____

_____

(Signed)_____

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. See Form H1.

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

PATENTS ACT, 1902.

Form H1.

FORM OF PETITION FOR GRANT OF COMPULSORY LICENCE OR REVOCATION OF PATENT.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

THE PETITION of (*a*) of in the county of , being a person interested in the matter of this petition as herein-after described:—

SHOWETH as follows:—

1. A patent dated No. was duly granted to for an invention of (*b*)

2. The nature of my interest in the matter of this petition is as follows: (*c*)

3. (*d*)

The evidence which I propose to leave at the Patent Office accompanying this petition is as follows: (*e*)

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default the reasonable requirements of the public with respect to the invention patented as above stated have not been satisfied.

Your petitioner therefore prays that an order may be made granting to him a compulsory licence on the terms following, *viz.*: (*f*)

or that the said patent may be revoked.

(Signed) _____

NOTE.—In pursuance of the requirements of Rule 70, the petitioner must deliver to the patentee, and to any other person alleged to have made default, copies of the petition and of the affidavits or statutory declarations and other documentary evidence in support.

(*a*) Here insert (*in full*) name, address, and calling.

(*b*) Here insert *title of* invention.

(*c*) Here state fully the nature of petitioner's interest.

(*d*) Here state in detail the circumstances of the case under section 3 of the said Act, and show that it arises by reason of the default of the patentee, or as the case may be, of any other person claiming an interest in the Patent as exclusive licencee or otherwise to work his Patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms. The statement of the case should give the names and addresses of any persons who are alleged in the petition to have made default. The paragraphs should be numbered consecutively.

(*e*) Here state what affidavits or statutory declarations together with any other documentary evidence will be left at the Patent Office with the petition, as required by Rule 70.

(*f*) Here state the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

PATENTS ACT, 1902.

Form I.

PATENT.

FORM OF OPPOSITION TO PETITION FOR GRANT OF COMPULSORY LICENCE OR REVOCATION OF PATENT

(a) Here state (in *full*) name and address.

(*a*) _____

_____

_____

hereby give notice of opposition to the petition of _____

_____

_____

_____

for the grant of a compulsory Licence under Patent No. _____ of 1

or the revocation of the said patent. The grounds upon which I oppose the

(*b*) Here state fully the grounds of opposition.

said application are as follows, *viz.*: (*b*)

(Signed) _____

NOTE.—In pursuance of the requirements of Rule 71, copies of the affidavits or statutory declarations in reply to the evidence left with the petition must be delivered to the petitioner.

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.

[When stamped this Form must be sent at once to the Patent Office.]

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form J.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

_____hereby transmit the fee prescribed for the continuation in force of *_____Patent No._____, of I_____for a further period of_____.

* Here insert name of patentee.

Name †_____

† Here insert name and full address.

Address_____

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

[This part of the Form to be filled in at the Patent Office.]

CERTIFICATE OF PAYMENT OR RENEWAL.

PATENT.

Letters Patent No._____of I_____.

_____I_____

This is to certify that _____did this_____day of_____I_____, make the prescribed payment of £_____ in respect of a period of_____from_____and that by virtue of such payment the rights of the patentee remain in force.*

* See section 17 of the Patents, Designs, and Trade Marks Act, 1883.

Seal.

The Patent Office, London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form K.

PATENT.

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

SIR,

I HEREBY apply for an enlargement of time for_____month in which to make the_____payment of_____ upon my Patent, No._____of 1

(*a*) The circumstances must be stated in detail; see Rule 67.

The circumstances in which the payment was omitted are as follows (*a*):

I am,

Sir,

Your obedient Servant,

(*b*) Here insert full address to which receipt is to be sent.

(*b*) _____

To the Comptroller,

The Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form L.

PATENT.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS.

I (*a*)_____

_____

_____

(*a*) *Or* We. Here insert (*in full*) name, address, and description.

hereby request that you will enter (*b*)_____name (*c*) in the Register of Patents:—

(*b*) *My or our*
(*c*) *Or names.*

(*d*)_____claim to be entitled (*e*)_____

_____

of the Patent No._____of 1 , granted to (*f*)_____

_____

_____

(*d*) I *or* We.
(*e*) Here insert the nature of the claim, *e.g.*, *as Assignee*.
(*f*) Here give name and address of person to whom Patent was granted.

the title of which is (*g*)_____

_____

_____

(*g*) Here insert title of the invention.

by virtue of (*h*) _____

_____

_____

_____

_____

_____

_____

_____

(*h*) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.

And in proof whereof I transmit the accompanying (*i*)_____

_____with an attested copy thereof.

(*i*) Here insert the nature of the document.

I am,

Sir,

Your obedient Servant,

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form M.

PATENT.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENCE OR OTHER DOCUMENT IN THE REGISTER OF PATENTS.

SIR,

I HEREBY transmit an attested copy of (*a*)_____

_____.

_____

under Patent No._____of 1 , as well as the original document for verification, and I have to request that a notification thereof may be entered in the Register.

(*a*) Here insert a description of the nature of the document.

I am,

Sir,

Your obedient Servant,

(Signed)_____

(*b*)_____

(*b*) Here insert full address.

_____

_____

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form N.

PATENT.

APPLICATION FOR DUPLICATE OF PATENT.

Date

SIR,

I REGRET to have to inform you that the Patent dated *

* Here insert date, number, full name and address of grantee.

No. granted to

for an invention the title of which is †

† Here insert title of invention.

has been ‡

‡ Here insert the word "destroyed" or "lost" as the case may be, and state, in full, the circumstances of the case, which must be verified by statutory declaration.

I beg therefore to apply for the issue of a duplicate of such Patent.§

§ Here state interest possessed by applicant in the Patent.

(Signature of Patentee.)

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form O.

PATENT.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

* Here state (*in full*) name and address of applicant.

* _____

_____

_____

hereby give notice of my intention to exhibit a _____

of _____ at the _____

_____

_____

† State "opened" or "is to open".

Exhibition, which † _____ of _____ ,

under the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1902.

‡ This description of invention should be accompanied by drawings if necessary.

‡ _____ herewith enclose a brief description of my invention

_____

_____

(Signed) _____

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form P.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

PATENT.

SIR,

I HEREBY request that the following clerical error (*a*)_____ (*a*) or errors.

_____

in the (*b*)_____ (*b*) Here state whether in application, specification or register.

No. _____ of 1 , may be corrected in the manner shown in red ink

in the certified copy of the original (*b*)_____

_____

hereunto annexed.

Signature_____

Full Address_____

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form Q.

PATENT.

CERTIFICATE OF COMPTROLLER-GENERAL.

The Patent Office,

London,

19

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

To * _____

_____

_____

* Here insert (*in full*) name and address of person requiring the certificate.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form R.

PATENT.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

SIR,

(a) _____ (a) Here state *(in full)* name or names and address of applicant or applicants.

_____

_____

_____

_____

hereby request that ____ ____address now upon the Register may be altered as follows:—

(b) _____ (b) Here insert full address.

_____

_____

_____

Sir,

Your obedient Servant,

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form S.

PATENT.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

(a) Here state (*in full*) name and address of applicant.

(a) _____

_____

_____

_____

(b) Here state the purport of the order.

hereby transmit an office copy of an Order in Council with reference to (b)

_____

Sir,

Your obedient Servant,

_____

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form T.

PATENT.

FORM OF APPEAL TO LAW OFFICER.

I, (*a*)_____ (*a*) Here insert (*in full*) name and address of appellant.

hereby give notice of my intention to appeal to the Law Officer from (*b*) (*b*) Here insert "the decision" or "that part of the decision," as the case may be.

of the Comptroller of the_____day of_____

19 , whereby he (*c*)_____ (*c*) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.

No. (*d*)_____of the year 1 (*d*) (*d*) Insert number and year.

Signature_____

Date_____

N.B.—This notice must be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of the same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form U.

PATENT.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR LEAVING A COMPLETE SPECIFICATION.

SIR,

_____ hereby, in respect of application No._____ dated_____, apply for one month's extension of time in which to leave a Complete Specification.

The circumstances in and grounds upon which this extension is applied for are as follows (*a*) :—

(*a*) The circumstances and grounds must be stated in detail; see *Rule* 10.

Sir,

Your obedient Servant,

(*b*)_____

(*b*) To be signed by applicant or applicants, or his or their agent.

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

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1902.

Form V.

PATENT.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR ACCEPTANCE OF A COMPLETE SPECIFICATION.

SIR,

_____ hereby apply for _____ months' extension of time for the acceptance of the Complete Specification upon application No. _____ dated _____.

The circumstances in and grounds upon which this extension is applied for are as follows (*a*):— _____

(*a*) The circumstances and grounds must be stated in detail; see Rule 10.

Sir,

Your obedient Servant

(*b*) _____

(*b*) To be signed by applicant or applicants, or his or their agent.

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

Patent Forms and Fees.—(i.) Forms are not supplied by the Patent Office, but can be purchased on personal application at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), Strand, London, W.C., or, at a few days' notice and upon pre-payment of the value of the stamp, at any Money Order Office in the United Kingdom.

If it should not be convenient to apply in either of the ways above specified, the stamped forms can be ordered by post from the Controller of Stamps, Room 7, Inland Revenue Office, Somerset House, London, W.C. In this case a bankers' draft or a Money or Postal Order payable to the Commissioners of Inland Revenue and crossed Bank of England, to cover the value of the stamp and the cost of transmitting the Form in a registered envelope by post, must be forwarded to Somerset House with the application for the Form. Cheques will not be accepted.

(ii.) Forms A, B, C and C1 are *usually kept on sale* at the undermentioned places :—

London General Post Office, E.C.	Post Office, Lombard Street, E.C.
Post Office, 195 Whitechapel Road, E.	,, 28 Eversholt St., Camden Town, N.W.
,, 239 Borough High Street, S.E.	,, 12 Parliament St., S.W.,
,, Charing Cross, W.C.	

and the chief Post Offices in the towns named below :—

In England and Wales.

Accrington.
Altrincham.
Ashton-under-Lyne.
Barnsley.
Barrow-in-Furness.
Bath.
Bedford.
Beverley.
Birkenhead.
Birmingham.
Blackburn.
Bolton.
Bradford.
Brighton.
Bristol.
Bromsgrove.
Burnley.
Burslem.
Burton-on-Trent.
Bury.
Cambridge.
Cardiff.
Carlisle.
Chatham.
Chester.
Clitheroe.
Congleton.
Coventry.
Crewe.
Croydon.
Darlaston.
Derby.
Dewsbury.
Doncaster.
Dorchester.
Driffield.
Droitwich.
Dudley.
Durham.
Exeter.
Gateshead.
Goole.
Greenwich.
Guildford.
Halifax.
Hartlepool.
Huddersfield.
Hull.
Ipswich.
Keighley.
Kendal.
Kidderminster.
Knaresbro'.
Knutsford.
Lancaster.
Leamington.
Leeds.
Leicester.
Lichfield.
Lincoln.
Liverpool.
Macclesfield.
Manchester.
Middlesbrough.
Nantwich.
Newcastle.
Newport (Mon.)
Northallerton.
Northampton.
Nottingham.
Nuneaton.
Oldbury.
Oldham.
Patrington.
Plymouth.
Pontefract.
Portsmouth.
Prescot.
Preston.
Reading.
Redditch.
Richmond (Yorks).
Ripon.
Rochdale.
Rotherham.
Rugby.
Salford.
St. Helens.
Scarborough.
Sedgeley.
Sheffield.
Southampton.
Stafford.
Stalybridge.
Stockport.
Stoke-on-Trent.
Stourbridge.
Stourport.
Sunderland.
Swansea.
Tamworth.
Truro.
Tunstall.
Wakefield.
Walsall.
Warrington.
Wednesbury.
West Bromwich.
Whitby.
Widnes.
Wigan.
Wolverhampton.
Wolverton.
Woolwich.
Worcester.
York.

In Scotland.

Aberdeen.
Dumbarton.
Dundee.
Edinburgh.
Glasgow.
Greenock.
Inverness.
Lanark.
Leith.
Paisley.
Perth.
Renfrew.

In Ireland.

Belfast.
Cork.
Dublin.
Dundalk.
Galway.
Limerick.
Londonderry.
Waterford.
Wexford.

APPENDIX B.

CONVEYANCING FORMS.

FORM I.

AGREEMENT FOR JOINT APPLICATION.

MEMORANDUM OF AGREEMENT made the day of 19 between A. B. of the one part and C. D. of the other part WHEREAS the said A. B. claims to be in possession of an invention relating to and by him entitled of which the said A. B. claims to be the first and true inventor and which is hereinafter referred to as the said invention AND WHEREAS the said A. B. has requested the said C. D. to provide him with the funds requisite for perfecting and bringing out the said invention and the said C. D. has agreed to provide such funds subject to the conditions hereinafter contained NOW IT IS HEREBY MUTUALLY AGREED AS FOLLOWS that is to say—

1. The said A. B. shall in confidence explain the said invention to the said C. D. or some person named by him.

2. IF within one month after such explanation the said C. D. is satisfied or such other person reports favourably as to the value of the said invention the said A. B. and C. D. will forthwith apply for a joint grant of letters patent for the United Kingdom in respect of the said invention and will make similar applications in such colonies and foreign countries as to the said C. D. shall appear advisable Such applications shall be made through E. F. or some other registered patent agent named by the said C. D. and at the sole cost of the said C. D. and the said A. B. will supply the said E. F. or other patent agent aforesaid with full

information as to the said invention in order to enable him to apply for the said letters patent and will assist as and when required in the preparation of the necessary specifications and drawings.

3. The said A. B. will as and when reasonably required by the said C. D. and at the cost of the said C. D. make or assist in making or supervise the making of any working or other models to show the working of the said invention and the said A. B. will at any time after the said application for letters patent for the United Kingdom has been accepted explain and demonstrate the said invention and models and the working thereof to such person or persons and at such place or places and time or times as the said C. D. shall reasonably require.

4. The said C. D. will pay the cost of making the application or applications aforesaid and will advance to the said A. B. from time to time such sums subject as hereinafter provided as the said A. B. shall reasonably require for defraying the cost of travelling and hotel expenses in connection with the carrying out of these presents and the cost of models and demonstrations as aforesaid and the said C. D. will also pay the said A. B. at the rate of per day for all time reasonably occupied in the carrying out of these presents including time during which by reason of his obligations hereunder the said A. B. is prevented from engaging in or obtaining other work.

5. Any letters patent obtained under this agreement shall be under the control of the said C. D. who shall have full power without consulting the said A. B. to enter into any contracts for the sale thereof or for granting licences thereunder or otherwise in connection therewith including the mortgaging thereof PROVIDED ALWAYS that the said A. B. is not thereby rendered subject to any pecuniary liability or obligation and the said C. D. shall have full power to give a good and sufficient discharge to any purchaser licencee or mortgagee for any purchase money royalty or mortgage money payable in respect thereof and the said A. B. hereby agrees to concur in the execution of any deed licence or other document necessary for carrying any such

contract into execution AND the said A. B. hereby irrevocably appoints the said C. D. to be his attorney in his name and on his behalf to do all such acts and things and to execute all such deeds and other instruments as may in the opinion of the said C. D. be necessary or convenient for giving effect to these presents PROVIDED that the said A. B. shall not thereby be subjected to any pecuniary liability.

6. It shall be lawful for the said C. D. in lieu of applying for letters patent for any colony or foreign country to sell the right to make any such application on any terms that the said C. D. may approve and any money or other consideration received in respect thereof shall be applied as though it were purchase-money paid for such letters patent.

7. The said A. B. shall not without the consent in writing of the said C. D. previously obtained either himself work under the said letters patent or licence any other person so to do.

8. The said C. D. shall be at liberty to work under the said letters patent but in the event of his so doing he shall keep proper accounts in separate books showing all his dealings in respect of goods made in accordance with the said invention and will permit the said A. B. or his agent thereto appointed in writing at all reasonable times to inspect and take copies therefrom and will also permit the said A. B. or his agent appointed as aforesaid at all reasonable times to inspect any works whereon the said C. D. is carrying on any process of manufacture in accordance with the said invention and will render to the said A. B. half-yearly accounts showing the profits made by the said C. D. by working the said invention and will account for one-third of the profits so shown as though the same were royalties received by him in respect of the said letters patent and this clause shall apply so long as any letters patent obtained under these presents shall be in force.

9. ALL moneys and other considerations received by the said C. D. under or by virtue of these presents shall be applied by him in repaying all expenses incurred by him under or by virtue of these presents together with interest thereon at the rate of per cent. and the balance

thereof shall be equally divided between the said A. B. and C. D.

10. The said A. B. may at any time after the expiration of months after the date of the application for letters patent for the United Kingdom by written notice require the said C. D. to state in writing whether he proposes to apply for any particular foreign or colonial letters patent and unless the said C. D. within fourteen days after such notice states in writing that he intends so to apply such foreign country or colony shall be excluded from this agreement and the said A. B. shall be at liberty to apply for letters patent for such foreign country or colony himself or to dispose for his own sole benefit of the right to make such application as to him shall seem good.

11. If the said A. B. shall at any time during the continuance of this agreement make any improvement in respect of the said invention he shall forthwith communicate the same in confidence to the said C. D. or some person named by him as aforesaid and if the said C. D. shall within one month after such communication state in writing his desire to include such improvement in this agreement this agreement shall apply thereto as though the said improvement were part of the said invention otherwise the said A. B. shall be at liberty to apply for letters patent in respect of the said improvement on his own behalf or to otherwise deal with the same as to him shall appear right.

12. The said C. D. shall not be bound under these presents to pay any renewal fee necessary for keeping any letters patent *obtained under these presents in force nor to work* the said invention in any country where such working is required in order to support a patent but in the event of the said C. D. determining not to pay such renewal fee or to provide for such working the said C. D. shall give to the said A. B. in the case of a renewal fee one month's and in the case of working three months' notice of such his intention and from the date of such notice such letters patent shall cease to be subject to this agreement and the said C. D. shall at the request and cost of the said A. B. assign and convey or release the same to the said A. B. or his

assigns without prejudice to any right the said A. B. may have to recover from the said C. D. any moneys previously received by the said C. D. in respect of the said letters patent.

13. The said C. D. shall at any time during the continuance of this agreement be at liberty to apply for the amendment or to bring any action for the infringement of any letters patent for the time being subject hereto and to use the name of the said A. B. therein upon indemnifying him against any liability for the costs thereof and in the event of the said C. D. being unwilling to defend any petition for the revocation of any such letters patent or if any such letters patent shall be declared invalid in any legal proceedings to appeal from such decision or if such invalidity can be cured by amendment to apply for leave to amend the said A. B. shall be entitled at his own cost and risk to defend such petition or to prosecute an appeal from such decision or to make such application for leave to amend and in the event of his so doing such letters patent shall forthwith cease to be subject to this agreement and the said C. D. shall at the request and cost of the said A. B. assign and release such letters patent to the said A. B. or his assigns PROVIDED ALWAYS that the said A. B. shall not be entitled to use the name of the said C. D. in defending any such petition or in prosecuting any such appeal unless he shall before so doing reasonably secure the said C. D. against any liability for the costs thereof.

14. The said C. D. may at any time after making the application for letters patent give one month's notice in writing to the said A. B. revoking this agreement and from the expiration of such notice this agreement shall determine without prejudice to anything done in the meantime or to the right of the said A. B. to recover from the said C. D. any moneys due to him under these presents and the said C. D. shall at any time thereafter at the request and cost of the said A. B. assign and release any letters patent and other rights then subject to these presents to the said A. B. or his assigns.

15. If the said C. D. shall not be satisfied with the said invention or shall not as provided in Clause 2 hereof state

his desires to include any improvement under this agreement the said C. D. shall not without the previous consent in writing thereto of the said A. B. in any way use or publish the said invention or such improvement respectively.

16. The said A. B. will not unless the said C. D. has expressed himself as not satisfied with the said invention during the time mentioned in Clause 2 hereof without the consent of the said C. D. in writing disclose the said invention to any person other than the said C. D. or the person named by him as aforesaid.

In witness etc.

FORM II.

AGREEMENT FOR JOINT APPLICATION (SHORT FORM).

AN AGREEMENT made the day of 19 between A. B. of the one part and C. D. of the other part WHEREAS the said A. B. is in possession of an invention entitled of which he claims to be the true and first inventor AND WHEREAS the said C. D. has agreed to assist him in bringing out the said invention NOW IT IS HEREBY AGREED AS FOLLOWS that is to say—

1. The said A. B. shall join the said C. D. in making a joint application for letters patent in respect of the said invention for the United Kingdom at the cost of the said C. D. and through E. F. or any other registered patent agent named by the said C. D. and the said A. B. will give the said E. F. or such other patent agent as aforesaid full information to enable him to prepare the necessary specifications and drawings and to make the said application.

2. If the said letters patent be granted the said A. B. shall not be at liberty to make use exercise or vend the said invention or to grant licences under the said letters patent without the consent in writing of the said C. D. previously obtained.

3. The said C. D. shall be at liberty to make use exercise and vend the said invention provided that in the event

of his so doing he shall account to the said A. B. for per cent. of the profits made by him thereby and the said C. D. shall be at liberty to grant licences under the said letters patent and shall account to the said A. B. for per cent. of the royalties or other payments received by him in respect thereof.

4. The said C. D. shall not be bound to pay any renewal fee in respect of the said letters patent but in the event of his determining not to do so he shall at least one month before such renewal fee shall be due give to the said A. B. notice in writing of his intention not to pay such fee and he shall at any time thereafter at the request and cost of the said A. B. convey or release the said letters patent to the said A. B. or his assigns.

In witness etc.

FORM III.

ASSIGNMENT OF LETTERS PATENT.

THIS INDENTURE made the day of 19 between A. B. hereinafter called the patentee of the one part and C. D. hereinafter called the purchaser of the other part WITNESSETH that in consideration of the sum of £ now paid to the patentee the receipt whereof is hereby acknowledged the patentee as beneficial owner doth hereby assign unto the purchaser all those letters patent and grant of privilege dated the day of and numbered granted to E. F. for the sole making using exercising and vending within the United Kingdom of Great Britain and Ireland and the Isle of Man for the term of fourteen years from the date thereof of an invention entitled together with all rights benefits and privileges thereby conferred TO HAVE AND HOLD AND ENJOY the same unto the said C. D. for the residue of the term thereof and any extension thereof absolutely.

In witness etc.

One or both of the following covenants may also be added where the patentee is the original grantee.

And the patentee doth hereby covenant with the purchaser that he has not at any time prior to the date of the application for the said letters patent made any disclosure or publication of the said invention such as would render the said letters patent invalid.

If Improvements are included in the Sale.

And the patentee doth hereby covenant with the purchaser that he will from time to time after making any improvement in or addition to the said invention or discovery in connection therewith including any improvement addition or discovery aforesaid now (if so) in their knowledge and possession forthwith give notice thereof in writing to the purchaser or his assigns who shall be entitled to the sole and exclusive benefit thereof and as and when reasonably required by the purchaser or his assigns but at his or their expense as to actual costs (if any) out of pocket occasioned thereby communicate and explain to the purchaser or his assigns or his or their agents any such improvement addition or discovery and shall at the expense of the purchaser or his assigns if he or they shall require the same apply for and obtain or (if he or they shall so think fit) join with him or them in applying for and obtaining letters patent in respect of any such improvement addition or discovery and execute and do all such assurances and things as shall be necessary or convenient for vesting the same letters patent and the exclusive benefit thereof in the purchaser or his assigns as by the purchaser or his assigns shall be reasonably required And further the foregoing provisions in this clause shall as far as possible apply to the interest of the patentee in every such improvement addition or discovery aforesaid which he may in conjunction with any other person or persons now have in their knowledge and possession or hereafter make.

FORM IV.

ASSIGNMENT OF LETTERS PATENT FOR A DISTRICT.

THIS INDENTURE made the day of 19 between A. B. of the one part and C. D. of the other part witnesseth that in consideration of the sum of £ paid to the said A. B. the receipt whereof is hereby acknowledged the said A. B. as beneficial owner doth hereby convey and assign unto the said C. D. all those letters patent and grant of privilege dated the day of and numbered for the sole making using exercising and vending within the United Kingdom of Great Britain and Ireland and the Isle of Man for the term of fourteen years from the date thereof of an invention entitled together with all the rights benefits and privileges thereby conferred so far as the same relate to the administrative County of London and no further TO HAVE HOLD AND ENJOY the same within the said administrative County unto the said C. D. for the remainder of the term thereof and any extension thereof absolutely And the said A. B. doth hereby for *himself his executors administrators assigns and licencees* covenant with the said C. D. that he and they respectively will not during the remainder of the said term or any extension thereof unless and until the said letters patent be revoked sell give lend let on hire or otherwise supply to any person other than the said C. D. his executors administrators assigns or licencees any made in accordance with the said invention unless such be marked in a conspicuous and permanent manner with a notice that it may not be used or sold within the said administrative County of London so long as the said letters patent shall remain in force And the said C. D. for himself his executors administrators assigns and licencees doth hereby covenant with the said A. B. that he and they respectively will not during the said term or any extension thereof as aforesaid sell give away lend let on hire or otherwise supply to any person other than the said A. B. his executors administrators assigns or licencees any so made as aforesaid

unless such be marked as aforesaid with a notice that it may not be used or sold in any part of the United Kingdom outside the said administrative County of London or exported to or used in . And the said A. B. hereby covenants with the said C. D. that he will pay or cause to be paid all fees necessary to be paid to keep the said letters patent in force as and when the same shall become due and will defend the said letters patent in the event of any petition being presented for their revocation up to the Court of Final Appeal and in the event of any renewal fee in respect of the said letters patent not being paid on or before the date when the same ought to be paid it shall be lawful for the said C. D. to pay such fee together with the fee payable for an extension of the time for paying such fee and the said A. B. will on demand repay to the said C. D. the amount of such fee or fees together with any other expense properly incurred by the said C. D. in paying the same with interest thereon at the rate of 5 per cent. per annum but the said C. D. shall be under no obligation to make any such payment and his right in this respect shall be without prejudice to his right to recover damages in respect of breach of this covenant or otherwise and the said A. B. hereby acknowledges the right of the said C. D. to production of the said letters patent and undertakes for the safe custody thereof.

In witness etc.

FORM V.

MORTGAGE OF LETTERS PATENT.

THIS INDENTURE made the day of between A. B. hereinafter called the mortgagor of the one part and C. D. hereinafter called the mortgagee of the other part whereas the mortgagor is the registered proprietor of the letters patent and grant of privilege dated the day of for the sole making using and vending within the United Kingdom of Great Britain and Ireland and the Isle of Man for the term of fourteen years from the date

thereof of an invention entitled granted to E. F. And whereas the mortgagee has agreed to advance the present sum of £ and may advance further sums by monthly instalments upon having the same secured in manner hereinafter appearing NOW THIS INDENTURE WITNESSETH that in consideration of the sum of £ now paid to the mortgagor and of any further sums which may be advanced as aforesaid the mortgagor hereby covenants with the mortgagee that he will on the day of repay to the mortgagee the said sum of £ and any further sums that shall have then been actually advanced by the mortgagee and will six months after any further advance by the mortgagee repay the sums advanced with interest thereon from the date hereof or from the date or dates on which the same shall have been advanced respectively at the rate of per cent. per annum and that if the said sum or sums or any of them shall not be repaid as aforesaid that the mortgagor will pay interest on the same or such part thereof as shall be from time to time outstanding at the said rate by equal half-yearly payments on the day of and the day of respectively until the same shall be repaid AND THIS INDENTURE FURTHER WITNESSETH that for the same consideration the mortgagor as beneficial owner doth hereby convey and assign to the mortgagee all those letters patent and grant of privilege dated the day of and numbered granted to the said E. F. as aforesaid together with all rights and privileges thereby conferred TO HAVE AND TO HOLD the same to the mortgagee his executors administrators and assigns for the residue of the unexpired term thereof and any extension thereof subject nevertheless to the provisoes for redemption and for the granting of licences hereinafter contained AND the mortgagor doth hereby covenant with the mortgagee that he will during the remainder of the said term so long as any money shall remain owing under these presents pay each of the renewal fees necessary for keeping the said letters patent in force not less than one month before the same shall become due and that in the event of his not paying any such fee as aforesaid that it shall

be lawful for the mortgagee to pay the same together with any further fee that may be necessary for extending the time for paying the same and that the mortgagor will on demand repay to the mortgagee the amount of any such fee or fees so paid as aforesaid together with any expense properly incurred by the mortgagee in making such payment with interest thereon at the rate of 5 per cent. per annum and that until the repayment thereof the same shall be a charge on the said letters patent AND the mortgagor doth hereby covenant with the mortgagee that the said letters patent are good and valid AND it is hereby agreed and declared that the mortgagor shall until the registration of the declaration as hereinafter provided or until the exercise by the mortgagee of the statutory power of sale have full power without the concurrence of the mortgagee to work under the said letters patent for his own benefit and to grant licences to manufacture in accordance with the said invention in consideration of the payment of any royalty not less than for each made and sold under such licence and with or without a minimum royalty but not for any other consideration whatever PROVIDED ALWAYS that such licence shall not be binding on the mortgagee whether he shall have notice thereof or not unless the same shall have been registered at the Patent Office before the registration thereat by the mortgagee or his assigns of some document showing that the right of the mortgagor to grant licences has ceased AND that the royalties reserved by the said licences shall form part of the security for the money due from time to time under these presents as though the same had been expressly assigned to the mortgagee hereby AND it is hereby declared that in the event of any principal or interest payable under these presents remaining unpaid for the space of thirty days after the same shall have become due and payable it shall be lawful for the mortgagee to register at the Patent Office a declaration under his hand that the mortgagor shall no longer have the right to grant licences under the said letters patent as above provided and upon the registration thereof the right of the mortgagor to grant licences hereunder shall determine And it is further declared that

until the registration of such declaration as aforesaid or until the exercise by the mortgagee of the statutory power of sale it shall not be lawful for the mortgagee to grant licences under the said letters patent or to work under the same without the licence of the mortgagor and that from and after the registration of such declaration the mortgagee shall have power to grant licences under the said letters patent upon any terms that he shall think right provided always that if the principal sum or sums of money hereinbefore covenanted to be paid with interest thereon shall be duly paid as hereinbefore provided then and in such case the said letters patent shall at the request and cost of the mortgagor his executors administrators or assigns be reassigned to him or them.

In witness etc.

FORM VI.

LICENCE AT A ROYALTY.

THIS INDENTURE made the day of between A. B. hereinafter called the licensor of the one part and C. D. hereinafter called the licencee of the other part whereas the licensor is the registered proprietor of letters patent for the United Kingdom for an invention entitled numbered of AND WHEREAS the licencee is desirous of manufacturing in accordance with the invention described in the specification of the said letters patent similar to that which has been deposited with the licensor and marked for purposes of identification AND WHEREAS the licensor has agreed to grant to the licencee such licence as is hereinafter contained Now THIS INDENTURE WITNESSETH and it is hereby agreed and declared as follows that is to say—

1. The licensor hereby grants to the licencee full power authority and licence during the residue of the term of the said letters patent number of and any extension thereof to manufacture and sell or let on hire in the United Kingdom similar in all respects to the said deposited .

2. The licencee shall pay to the licensor by way of royalty in respect of every manufactured by him during the residue of the term of the said letters patent or any extension thereof the sum of Provided that in the event of the licensor granting any licence for the manufacture of of similar quality to the said deposited at a lower royalty than that above mentioned the licencee shall as from the date of such licence pay the same royalty as is thereby reserved in lieu of that above mentioned.

3. The licencee shall within ten days after the last days of June and December in each year deliver to the licensor an account in writing showing the number of manufactured by him during the preceding half-year and shall within one month after such last days respectively pay the royalty due in respect thereof and in the event of such royalty not being paid within the time aforesaid the licencee will pay interest thereon from the expiration thereof until payment at the rate of 5 per cent. per annum PROVIDED ALWAYS that if the royalty payable in respect of any half-year shall be less than £ the licencee shall pay in addition thereto such further sum as will therewith make up the sum of £ But in the event of his so doing he shall be entitled to deduct the sum or sums so paid over the said sum of £ from the excess if any of the royalty payable in respect of any succeeding half-year.

4. The licencee shall keep proper accounts in separate books showing the number of manufactured by him and shall permit the licensor or his agent authorised thereto in writing to examine the same at any reasonable time and to take copies thereof and extracts therefrom and shall permit the licensor or his agent as aforesaid at any time to inspect any premises on which are being manufactured under these presents.

5. The licencee shall mark every manufactured by him under these presents in the manner shown on the deposited and shall not in any way depart from the pattern of the said deposited without the consent in writing of the licensor previously obtained.

6. The licencee will not repudiate this licence nor will

he at any time directly or indirectly dispute the validity of the said letters patent.

7. In the event of the said letters patent being declared invalid by any competent Court and of the licensor not appealing therefrom or being unable so to appeal the said royalties shall not be payable in respect of any manufactured after the date of such declaration of invalidity unless such invalidity can be cured by amendment and the licensor shall within three months after such declaration apply for and on such application obtain leave to amend.

8. The licencee will at all times during the continuance of this licence give information to the licensor of any infringements of the said letters patent that may come under his notice and will do all in his power to prevent the infringement thereof.

Lastly if any royalty due under these presents shall remain unpaid for one month after the same ought to have been paid whether payment thereof shall have been demanded by the licensor or not or if the licencee shall make default in the performance of any obligation on his part herein contained it shall be lawful for the licensor at any time before such royalty shall have been paid or before such default shall have been remedied to his reasonable satisfaction or waived by notice in writing to the licencee to revoke this licence as from the date of such notice without prejudice to the right of the licensor to recover any moneys due to him hereunder.

In witness etc.

FORM VII.

EXCLUSIVE LICENCE.

THIS INDENTURE made the day of between A. B. hereinafter called the licensor of the one part and C. D. hereinafter called the licencee of the other part WHEREAS the licensor is the registered proprietor of letters patent for the United Kingdom number of and dated the day of granted to E. F. for the sole making using exercising and

vending of an invention entitled of which the said E. F. claims that he is the true first inventor AND WHEREAS the licencee is desirous of working under the said letters patent and the licensor has agreed to grant him an exclusive licence to work thereunder as hereinafter provided NOW THIS INDENTURE WITNESSETH as follows that is to say—

1. The licensor in consideration of the sum of £ paid to him by the licencee the receipt whereof is hereby acknowledged and in consideration of the royalties hereinafter reserved doth hereby grant to the licencee the sole power authority and licence during the residue of the term of the said letters patent and any extension thereof by himself his servants agents and sub-licencees as hereinafter provided to make use exercise and vend within the United Kingdom of Great Britain and Ireland and the Isle of Man the invention described and claimed in and by the specification of the said letters patent No. of .

2. The licencee will pay to the licensor by way of royalty a sum equal to per cent. of the net selling price of all the made and sold by him hereunder and will also pay to the licensor a sum equal to per cent. of any moneys received by him by way of royalty or payment for any licence granted by him hereunder or the net amount after payment of costs obtained by way of damages or on an account of profits or otherwise against any infringer of the said letters patent as hereinafter provided.

3. The licencee shall within ten days after the last days of and respectively in each year deliver to the licensor an account in writing showing the sales for the preceding half-year and the sums received by the licencee on account of royalties or by way of damages or profits or otherwise as aforesaid during the same period and shall within three months thereof pay to the licensor the sum or sums due to him hereunder in respect thereof and in the event of any such moneys not being paid within the time aforesaid the licencee will pay interest thereon from the expiration of such period of three months at the rate of 5 per cent. per annum provided always that the total sum payable to the licensor in respect of any half-year shall

not be less than £ but subject to such minimum payments being made the licencee shall be entitled to deduct from the moneys payable in respect of any succeeding half-year any sum paid in excess of the sum shown to be due on the account aforesaid.

4. The licencee shall keep proper accounts in separate books containing full particulars of everything made and sold by him under these presents of all licences granted by him and of all receipts of royalties and other payments under or in respect thereof and of all other things which may be material for the purpose of showing the amounts payable to the licensor hereunder and will at any time produce the same for the inspection of the licensor or of his agent thereto appointed in writing who shall be at liberty to make copies or extracts therefrom.

5. The licensor shall be at liberty at any reasonable time during the continuance of this licence by himself or his agent thereto appointed in writing to enter upon any factory or place of business of the licencee or his sub-licencees in which the manufacture of anything made under these presents is being carried on at any reasonable hour with the object of obtaining any information that may be material for the purpose of ascertaining the amount of any royalty or other sum payable hereunder and the licencee and his sub-licencees respectively shall afford every reasonable facility for obtaining such information.

6. The licencee will pay the fees due for renewal of the said letters patent as and when the same shall become due and will not at any time repudiate this licence nor will he at any time either directly or indirectly dispute the validity of the said letters patent.

7. The licencee shall take all reasonable steps to prevent infringement of the said letters patent and shall be at liberty to use the name of the licensor for the purpose of bringing any legal proceedings to enforce the said letters patent upon indemnifying the licensor against any pecuniary liability in respect thereof and shall subject as hereinbefore provided be entitled to retain for his own benefit any damages or other sums recovered therein In the event of a petition

being presented for the revocation of the said letters patent the licencee will defend the same and indemnify the licensor against any liability for the costs thereof In the event of the said letters patent being declared invalid in any legal proceeding the licencee will carry the same on appeal to the final Court of Appeal Provided that if such invalidity can be cured by amendment it shall be lawful for the licencee with the consent of the licensor (such consent not to be unreasonably withheld) to apply for leave to amend the specification of the said letters patent in lieu of appealing Any proceedings for amendment shall be at the cost of the licencee.

8. In the event of the said letters patent being declared invalid by the highest Court of Appeal the royalties hereby reserved shall cease to be payable as from the date of such declaration but the licencee shall be entitled to recover all royalties due in respect of sales made previous to the date of such declaration Provided always that if the invalidity of the said letters patent so declared shall be capable of being cured by amendment the licencee shall forthwith apply in the name of the licensor but at the cost of the licencee for leave to amend the same and in the event of such leave being obtained the provisions of this clause as to the cesser of royalty shall not take effect.

9. The licencee shall have the right to grant sub-licences at such royalties as he may consider reasonable and such sub-licences may be for the residue at the time of the granting thereof of the term of the said letters patent and any extension thereof or for any shorter term and may be limited to particular districts or to special forms of manufacture and may be subject to such conditions as to the licencee may appear right.

10. If the licencee shall dispose of his business during the continuance of this licence it shall be lawful for him to transfer the benefit of this licence to the purchaser but such transfer shall not release the licencee from any liability hereunder to indemnify the licensor against the costs of any legal proceedings or from any other obligation on his part hereunder.

11. If the licencee shall become bankrupt or insolvent

or shall compound with his creditors this licence shall *ipso facto* determine without prejudice to the right of the licensor to recover any moneys then accrued due to him hereunder.

Lastly if any moneys due to the licensor from the licencee under these presents shall remain unpaid for fourteen days after the same ought to have been paid or if the licencee shall make default in the performance of any obligation on his part herein contained it shall be lawful for the licensor at any time before such moneys shall have been paid or such default shall have been remedied to the reasonable satisfaction of the licensor or have been waived by notice in writing to the licencee to revoke this licence as from the date of such notice without prejudice to the right of the licensor to recover any moneys due to him hereunder at the date of such notice Provided always that such revocation or the determination of this licence under the last preceding clause shall not affect any sub-licences *bonâ fide* granted by the licencee previously to such revocation or determination but the royalties thereafter payable thereunder shall be payable to the licensor as if the same had been duly assigned to him.

In witness etc.

FORM VIII.

AGREEMENT FOR THE USE OF A MACHINE AT A ROYALTY WITH RIGHT TO PURCHASE.

MEMORANDUM OF AN AGREEMENT made the day of 19 between A. B. hereinafter called the company of the one part and C. D. hereinafter called the licencee of the other part WHEREAS the company is the registered proprietor of the letters patent of which particulars are contained in the schedule hereto AND WHEREAS the licencee has paid to the company the sum of £ and in consideration thereof and of the royalties hereinafter reserved the company has agreed to grant to the licencee the licence hereinafter expressed NOW IT IS HEREBY AGREED AS FOLLOWS that is to say—

1. The company will forthwith deliver to the licencee the machine numbered hereinafter referred to as the machine The licencee shall pay the cost of carriage of the machine from the company's depot and the cost of fixing the machine in position which shall be done by the company's workmen.

2. The licencee will pay to the company within ten days after the last days of March June September and December respectively for the use of the machine during the preceding three months the sum of for every thousand revolutions of the machine during such period and for the purpose of ascertaining the number of such revolutions the number indicated by the counter attached to the machine shall be conclusive evidence.

3. The licencee will at any reasonable time during the continuance of this licence permit the agent of the company duly authorised thereto in writing to inspect the machine.

4. The licencee will during the continuance of this licence keep the machine clean and in good repair and condition and in the event of any substantial repair becoming necessary will give notice thereof to the company and will not before or during days after giving such notice unless at the written request of the company attempt to do such repairs The company will endeavour to do any repairs of which notice is given as aforesaid within the time aforesaid but in the event of the company not commencing to do such repairs within such time the licencee shall be at liberty to have such repairs done at his own cost and risk by any person who is in the opinion of the licencee capable of doing the same If any repairs are done by the company the licencee will pay the company's reasonable charge therefor.

5. The licencee will not at any time during the continuance of this licence remove the name-plate from the machine nor remove the said counter or permit the same to be removed from the machine or to be in any way tampered or interfered with except for necessary cleaning and oiling and not for such purposes in any way that can affect the reading thereof.

6. The licencee will on the day of in every year so long as this licence shall continue pay to the company for insuring the machine against fire the sum of and in the event of the machine being destroyed or damaged by fire during such time the company will without cost to the licencee repair or replace the same as to the company may appear best and in the event of the company replacing the same the substituted machine shall be deemed to be the machine for all purposes of these presents and the licencee shall in the event of the said counter being so damaged that it cannot be read pay to the company in respect to the time between the last reading of the said counter and the date of the fire a sum proportionate to that paid in respect of the last preceding period of three months.

7. The machine shall remain the property of the company during the continuance of this licence but after the licencee shall have paid the sum of £ by way of royalty for the use thereof as aforesaid the licencee shall have the right of purchasing the same outright for the sum of one shilling.

8. Subject to the provisions of the last preceding clause the term of this licence shall be from the date when the machine shall be delivered to the licencee until the expiration of the terms of all the said letters patent Provided that if during the said term and the continuance of these presents the company shall make or acquire any improvement which can be applied to the machine the company will at the request and cost of the licencee apply such improvement thereto And if such improvement shall be the subject of letters patent belonging to the company the term of this licence shall be extended until the expiration of the term of such letters patent and the said sum of £ shall be increased to such sum as may be agreed or in default of agreement as may be determined by arbitration.

9. The licencee shall not at any time directly or indirectly dispute the validity of any of the letters patent specified in the said schedule or of any other letters patent referred to in the last preceding clause hereof nor shall the revocation or any declaration of the invalidity of any of such letters

patent affect this licence or the payment of the said royalties thereunder so long as any of the said letters patent shall be in force.

10. The licencee will not at any time during the continuance of this licence permit or suffer a distress to be levied on any premises where the machine shall be and will at all reasonable times upon the request of the company's agent produce to him the receipts for the last rent or rates that shall have become due in respect of such premises.

11. The licencee shall not except on an emergency remove the machine from the place where it shall be fixed by the company as aforesaid without giving the company at least one week's previous notice in writing and the company shall be entitled to superintend such removal and the subsequent fixing of the machine and the licencee shall pay the reasonable charges of the company for so doing.

12. If this licence shall continue until the expiration of the term thereof as defined in clause 8 hereof the licencee shall be entitled within one month from the expiration of the said term and in this respect time shall be of the essence of the contract to purchase the machine at a price equal to the difference between the total sum paid by him as royalty under this licence and the sum of £ or such increased sum as aforesaid.

13. If any royalty or other money payable to the company under these presents shall be in arrear for ten days or if the licencee shall make default in the performance of any obligation on his part herein contained or if the licencee shall become bankrupt or insolvent or shall compound with his creditors it shall be lawful for the company at any time before such money shall have been paid or such default shall have been remedied to the reasonable satisfaction of the company or waived without any notice to the licencee to enter on the premises where the machine shall be and retake possession thereof and upon the company so retaking possession this licence shall determine without prejudice to the right of the company to recover any moneys due to it from the licencee under these presents at the date of such retaking of possession.

14. This licence is assignable with the consent in writing of the company such consent not to be unreasonably withheld.

In witness etc.

FORM IX.

AGREEMENT TO GRANT A LICENCE TO A COMPANY TO BE FORMED.

THIS AGREEMENT made the day of between hereinafter called the patentee of the one part and hereinafter called the promoter of the other part WHEREAS the patentee is the owner of the letters patent mentioned in the schedule hereto. AND WHEREAS the promoter is desirous of promoting a company to work under the said letters patent in accordance with the terms of the licence contained in the said schedule NOW IT IS HEREBY MUTUALLY AGREED as follows that is to say—

If the promoter shall procure within months from the date hereof the registration of and the provision of working capital of at least £ for a company for the purpose of working under the said letters patent as aforesaid the patentee hereby agrees at the request and cost of such company to grant to it a licence in the form contained in the schedule hereto or in such other form as may be agreed between the patentee and such company to be formed and in the event of the patentee upon reasonable proof of such registration and of the provision of such working capital failing or refusing to grant such licence upon being thereto required by such company the patentee hereby appoints the promoter or any person appointed by him his agent and attorney in his name and on his behalf to execute a licence to such company in the form contained in the schedule hereto and the patentee hereby agrees to ratify and confirm such execution and licence and hereby declares that this appointment is irrevocable for the space of twelve months from the date hereof.

In witness etc.

FORM X.

AGREEMENT TO PROMOTE A COMPANY TO ACQUIRE AN INVENTION.

THIS AGREEMENT made the day of between hereinafter called the inventor of the one part and hereinafter called the promoter of the other part WHEREAS the inventor is in possession of an invention entitled which is the subject of an application for letters patent for the United Kingdom No. dated AND WHEREAS the inventor has requested the promoter to promote a company for the purpose of acquiring the said invention and patent and of obtaining letters patent for the said invention for foreign countries to which request the promoter has acceeded NOW IT IS HEREBY MUTUALLY AGREED as follows that is to say—

1. The promoter agrees to register a company under the name of or some other suitable name with a capital of £ divided into shares of each and having for its primary object to enter into an agreement with the inventor in the form contained in the schedule hereto and to pay or provide for the payment of the preliminary expenses in connection with the registration and formation thereof and to procure the subscription of shares therein.

2. Upon the registration of the said company the inventor agrees to enter into an agreement with the company in the form contained in the schedule hereto upon being required so to do by the said company or by the promoter or by any person appointed by them or either of them by notice in writing served upon the inventor in the manner described in the said form of agreement and in the event of the inventor upon being so required refusing or failing or omitting to enter into and duly execute such agreement the inventor hereby appoints the promoter or any person appointed by him his agent and attorney in his name and on his behalf to enter into and duly execute the said agreement and the inventor hereby agrees to ratify confirm and allow such

agreement and execution and to carry such agreement into effect And the inventor hereby declares that this appointment is irrevocable for the space of months from the date hereof.

3. If the said company shall enter into the said agreement with the inventor the inventor will pay to the promoter or his nominees by way of remuneration for his services the sum of £ in cash and the sum of in fully paid shares out of the said company and the inventor hereby authorises the directors of the said company to allot the same to the promoter or his nominees out of the fully paid shares to become due to the inventor under the said agreement as and when the same shall become due.

4. If the promoter should fail to register the said company within weeks after the date of these presents the inventor may give him notice in writing terminating this agreement and in the event of such notice being given this agreement shall determine and neither party shall be entitled to any compensation.

In witness etc.

THE SCHEDULE ABOVE REFERRED TO.

THIS AGREEMENT made the day of between hereinafter called the inventor of the one part and limited hereinafter called the company of the other part WHEREAS the inventor is in possession of an invention entitled which is the subject of an application by him for letters patent for the United Kingdom No. of AND WHEREAS the company has been formed with the object *inter alia* of entering into this agreement being the agreement referred to in paragraph of its Memorandum of Association NOW IT IS HEREBY AGREED as follows that is to say—

1. The inventor shall sell and the company shall purchase all that said invention and the benefit of the said application for letters patent and the right to make application for letters patent in any country or colony in respect of the said invention.

2. The price to be paid by the company for the said in-

vention and rights shall be the sum of £ to be paid as to £ part thereof immediately upon the execution hereof and as to the balance in fully paid-up shares of the company to be allotted to the inventor or his nominees upon the sealing of the said letters patent for the United Kingdom.

3. The inventor will forthwith at the request and cost of the company apply to amend his said application by joining the company as an applicant and will supply all requisite information to any patent agent appointed by the company to enable him to prepare the necessary specifications and applications and will at the request and cost of the company execute all deeds and documents that may be required for enabling the company to complete the said application and to make and complete any other applications for letters patent that the company may think right to make and for vesting any letters patent obtained in respect of the said invention in the company.

4. If the inventor shall at any time during the term of years from the date hereof make any improvement in respect of the said invention he shall forthwith inform the company thereof and shall at the request of the company communicate the same to some person appointed thereto in writing by it And if the company shall within one month after such communication express its desire to include such improvement in this agreement and shall agree to apply for letters patent for the United Kingdom in respect thereof this agreement shall apply to such improvement as though the same were part of the said invention otherwise the inventor shall be at liberty to deal with such improvement in such way as he shall think fit In the event of the company including any improvement in this agreement the company shall pay to the inventor in respect thereof upon the sealing of any patent therefor such remuneration as may be agreed or in default of agreement as may be settled by arbitration to be the fair value to the company thereof and the company shall have the option of paying the same in cash or fully paid ordinary shares or part thereof in cash and part in such shares.

5. In the event of the company not applying for letters

patent in any country or colony within months after the date of the application for the United Kingdom the inventor shall have the right to apply on his own behalf for letters patent in such country or colony and the right to apply therefor shall thenceforth cease to be subject to this agreement.

6. The company shall employ the inventor as its manager for a term of years from the date hereof at a salary of £ per annum and the inventor agrees to act as such manager for the said term and at the said salary and to devote his whole time to the service of the company and during such time as he may remain such manager as aforesaid to retain in his name not less than of the fully paid shares to be allotted as aforesaid.

7. Any notice to the inventor hereunder may be served by delivering or sending the same by prepaid letter addressed to him at and in the case of service by post, shall be deemed to have been received on the day following that on which it has been posted

8. If any difference shall arise between the parties hereto touching these presents or the construction hereof or any clause or thing herein contained or any matter in any way connected with these presents or the operation thereof or the rights duties or liabilities of either party hereto in connection with the premises then and in every such case the matter in difference shall be referred to the arbitration of whose decision shall be final.

In witness etc.

APPENDIX C.

LISTS OF PLACES RECEIVING DONATIONS OF PATENT OFFICE WORKS.

A.—Places in the United Kingdom receiving a complete set of the publications of the Patent Office including the Specifications, on condition that they shall be daily accessible to the public, for reference or for copying, free of all charge.

Belfast—Free Public Library.
*Birmingham—Reference Library, Patent Department, Eden Place.
Bolton—Little Bolton Library.
Bradford, Yorkshire—Free Library, Darley Street.
Bristol—Public Libraries, Hotwells Branch Library.
Cardiff—Central Free Library, Reference Department.
Carlisle—Public Library, Tullie House.
Derby—Public Library and Museum.
Dublin—National Library of Ireland, Kildare Street.
Dundee—Public Library, Albert Institute.
*Glasgow—Stirling's and Glasgow Public Library, Miller Street.
Halifax—Public Library, Akroyd Park.
*Horwich—Mechanics' Institute Library.
Huddersfield—Town Hall.
Hull—Public Libraries.
Ipswich—Museum Library, High Street.
*Keighley—Mechanics' Institute, North Street.
Kidderminster—Free Library.
*Leeds—Free Public Library.
Leicester—Free Public Library, Wellington Street.
Liverpool—Free Library, William Brown Street.
London—Free Library, London Street, Bethnal Green (from 1888).
*Manchester—Free Library, Deansgate.
Newcastle-upon-Tyne—Public Library, New Bridge Street.
Newport, Monmouth—Free Library.
Nottingham—Central Free Public Library.
*Oldham—Free Library, Union Street.

Preston—Harris Free Public Library and Museum.
Rochdale—Free Public Library, Esplanade.
Salford—Free Library, Peel Park.
*Sheffield—Free Public Library, Surrey Street.
Stockport—Central Free Library.
Swansea—Public Library.
Wolverhampton—Free Library.

* This Library also receives a set of Specifications of United States Patents (from 1898).

B.—Public Offices, etc., in the United Kingdom, and British Colonies and Foreign States receiving a complete set of the Publications of the Patent Office.

Public Offices, etc.

London—British Museum.
Science Library, South Kensington Museum.
*Edinburgh—Museum of Science and Art.
Dublin—Public Record Office.
Isle of Man—Castletown—Rolls Office.

British Colonies, etc.

Canada—Quebec—Montreal—Council of Arts and Manufactures of Quebec.
Ontario—Ottawa—Patent Office.
Toronto—Public Library.
India—Bombay—Patent Office, Secretariat.
Calcutta—Patent Office, Imperial Secretariat.
Madras—Patent Office, Secretariat.
New South Wales—Sydney—Patent Office.
New Zealand—Wellington—Patent Office.
Queensland—Brisbane—Patent Office.
South Australia—Adelaide—Colonial Institute.
Patent Office (from 1878).
Tasmania—Hobart—General Register Office.
Victoria—Melbourne—Patent Office.
Public Library.
Western Australia—Perth—Patent Office (from 1898).

Foreign States.

Austria—Vienna—Handelsministerium (from 1898).
Polytechnic University.
Belgium—Brussels—École Industrielle, Palais du Midi.
Ministère de l'Industrie.
Denmark—Copenhagen—Patent Office (from 1893).

France—Paris—Bibliothèque Nationale.
Office National des Brevets d'Invention et des Marques de Fabrique.
Germany—Berlin—Kaiserliches Patentamt.
Kaiserliches Statistischeamt.
Alsace—Mühlhausen—Société Industrielle.
Baden—Carlsruhe—Technische Hochschule (from 1876).
Bavaria—Munich—Polytechnische Verein.
Prussia—Aachen—Königliche Technische Hochschule.
Berlin—Königliche Bibliothek.
Hanover—Polytechnische Schule.
Saxony—Dresden—Polytechnische Schule.
Italy—Naples—Royal Institution for the Encouragement of Science (from 1852).
Rome—Ufficio delle Privative Industriali.
Japan—Tokio—Patent Office (from 1884).
Norway—Christiania—Patent Office (from 1884).
Russia—Riga—Polytechnic School.
St. Petersburg—Bibliothèque Impériale.
Spain—Madrid.
Sweden—Stockholm—Patent Office.
United States—Washington, D.C.—Patent Office.
California—San Francisco—Mechanics' Institute.
Illinois—Chicago—Free Public Library.
Maryland—Baltimore—Peabody Institute.
Massachusetts—Boston—Free Public Library.
Missouri—St. Louis—Mercantile Library.
New York—Albany—State Library.
Ithaca—Cornell University.
New York City—Astor Library.
Ohio—Cincinnati—Public Library.
Pennsylvania—Philadelphia—Franklin Institute.
Pittsburg—Carnegie Library.
Wisconsin—Madison—Historical Society.

C.—Places in the United Kingdom receiving the Abridgments of Specifications, and, if an asterisk is affixed, the Illustrated Official Journal of Patents also.

*Aberdeen—Public Library.
*Accrington—Public Library.
*Airdrie—Free Public Library.
*Alloa—Public Library.
Alnwick—Scientific and Mechanical Institution.
Armagh—Natural History and Philosophical Society.

*Ashton-under-Lyne—Heginbottom Free Library.
*Aston, near Birmingham—Aston Manor Public Library.
Ayr—Carnegie Public Library.
Bacup—Mechanics' Institution.
Banbury—Mechanics' Institute.
*Barnsley—Free Library.
Barnstaple—North Devon Athenæum.
*Barrow-in-Furness—Free Public Library and Museum.
*Basingstoke—Mechanics' Institute and Club.
*Birkenhead—Free Public Library.
*Blackburn—Free Library and Museum.
Blyth—Mechanics' Institution.
Bodmin—Literary Institution.
*Bootle—Free Public Library.
Braintree—Braintree and Bocking Mechanics' Institute.
*Brighton—Public Library, Royal Pavilion.
*Burnley—Mechanics' Institution.
Burslem—Wedgwood Institute.
Bury St. Edmund's—Athenæum Library.
*Canterbury—Free Library.
Cardiff—South Wales Institution of Engineers, Park Place.
Carmarthen—Literary and Scientific Institute.
*Carnarvon—Free Library.
Cheltenham—Public Library.
*Chester—Free Library, St. John Street.
Colchester—Public Library.
*Cork—Free Library, Nelson's Place.
Coventry—Free Library.
*Crewe—Mechanics' Institution.
*Darwen—Public Library.
*Devonport—Free Public Library.
*Dewsbury—Public Free Library.
*Doncaster—Free Library.
*Dumbarton—Free Public Library.
Ebbw Vale—Literary and Scientific Institute.
*Exeter—Albert Memorial Museum and Free Library.
Frome—Literary and Scientific Institution.
Glasgow—*Athenæum.
Mechanics' Institution.
Kelvingrove Museum.
West of Scotland Iron and Steel Institute.
*Institution of Engineers and Shipbuilders in Scotland, 207 Bath Street.
*Philosophical Society.
*Gloucester—Free Library, Guildhall.
Guernsey—Guille-Allés Library, Market Place.

Halesworth—Mechanics' Institute.
Halifax—Mechanics' Institute, Crossley Street
*Hanley—Public Free Library.
Hebden Bridge—Mechanics' Institution, Commercial Street.
*Heywood—Public Free Library.
Huddersfield—Technical School.
*Inverness—Public Library.
*Jersey—Public Library.
Kettering—Church Institute and Working Men's Club.
Kilmarnock—Public Library.
Lancaster—Public Library, Storey Institute.
*Leamington Spa—Free Library, Town Hall.
Leeds—*Association of Engineers.
Church Institute.
Philosophical and Literary Society.
Yorkshire College.
Leek, Staffordshire—Literary and Mechanics' Institution.
Liverpool—Polytechnic Society, Royal Institution.
London—*Brixton Oval, Tate Central Library.
*Camberwell Central Library, Peckham Road, S.E.
*Canning Town Free Public Library, Barking Road, E.
*Guildhall Library, E.C.
*Imperial Institute.
*Incorporated Law Society, Chancery Lane.
*Chartered Institute of Patent Agents, Southampton Buildings, Chancery Lane.
*Institution of Civil Engineers, Gt. George Street.
Institution of Mechanical Engineers, Storey's Gate, St. James's Park, S.W.
*Inner Temple Library.
*London Institution, Finsbury Circus.
*Newington Public Library, Walworth Road, S.E.
*People's Palace, Mile End Road, E.
*Society of Arts.
*Southwark, St. George's Public Library, Borough Road, S.E.
*Walthamstow Public Library.
*Wandsworth Public Library.
*War Office, Pall Mall.
*West Ham Public Library, Stratford.
*Westminster Free Public Library, Great Smith Street.
*Wi bledon Free Public Library.
*Loughborough—Public Library.
Lowestoft—Public Library.
Manchester—*Chemical Club.
*Moss Side Public Library.
*Owen's College.

*Mansfield—Free Public Library.
*Middlesborough—Public Free Library.
*Middleton, Manchester—Free Library.
*Newcastle-upon-Tyne—North of England Institute of Mining and Mechanical Engineers.
*North Shields—Free Library.
*Northwich—Brunner Free Public Library.
*Norwich—Free Library.
*Nottingham—Mechanics' Institution.
Oswestry—Free Public Library, Guildhall.
*Penzance—Free Library.
*Perth—Sandeman Public Library.
*Peterhead—Public Library.
*Plymouth—Free Public Library.
*Pontypridd—Free Library.
Portsmouth—*Dockyard.
*Public Free Library, Central Library, Town Hall.
*Reading—Free Public Library, Museum and Art Gallery.
Redditch—Literary and Scientific Institution.
*Redruth—Free Public Library.
*Richmond, Surrey—Free Public Library.
Rotherham—Free Public Library.
Ryde, Isle of Wight—Young Men's Christian Association and Literary Institute, Lind Street.
Saffron Walden—Literary and Scientific Institution.
*St. Helens—Free Public Library, the Gamble Institute.
Scarborough—Mechanics' and Literary Institute, Vernon Place.
Shipley—Salt Schools.
*Shrewsbury—Free Public Library.
Southend-on-Sea—Institute.
*South Shields—Public Free Library.
Spalding—Christian Young Men's Association.
*Stafford—Free Library.
Stockton-on-Tees—Free Library.
Stowmarket—The Institute.
Sudbury, Suffolk—Literary and Mechanics' Institute.
*Swansea—Royal Institution of South Wales.
Swindon, New—G.W.R. Mechanics' Institution.
Uttoxeter—Reading Room and Library.
*Walsall—Free Library.
*Warrington—Municipal Museum.
*Wednesbury—Free Library.
Wellington—Young Men's Christian Association.
*West Bromwich—Free Library.
*West Hartlepool—Public Library.
*Weston-super-Mare—Free Public Library.
Whitby—Museum.

*Whitehaven—Free Public Library.
*Woolwich—Ordnance Factories.
*Worcester—Public Library, Victoria Institute.
*Workington—Public Library and Reading Room.

D.—Places abroad receiving the Abridgments of Specifications, and, if an asterisk is affixed, the Illustrated Official Journal of Patents also.

BRITISH COLONIES, ETC.

Canada—Quebec—Montreal—Society of Civil Engineers.
Manitoba—*Winnipeg—Public Library.
*Cape Colony—Cape Town—Colonial Secretary's Office.
*Malta—Valetta—Chief Secretary's Office.
*Mauritius—Colonial Secretary's Office.
*New Zealand—Auckland Free Public Library.
Victoria—Ballarat—School of Mines.
Western Australia—Perth—Victoria Library.

FOREIGN STATES.

France—Paris—British Chamber of Commerce.
*Germany—Gotha—Ducal Friedenstein Collection.
Strasburg—Imperial and Provincial Library of the University.
Netherlands—Delft—Polytechnic School.
*Peru—Lima—Escuela de Ingenieros.
*Switzerland—Berne—Bureau International pour la Protection de la Propriété Industrielle.
Zurich—Federal Polytechnic School.
United States—Illinois—Urbana—University of Illinois.
Indiana—Crawfordsville—Wabash College.
Terre Haute—Rose Polytechnic Institute.
Massachusetts—Boston—American Academy of Arts and Sciences.
Springfield—City Library Association.
Michigan—*Detroit—Public Library.
*Lansing—State Library.
Minnesota—Saint Paul—Minnesota Historical Society.
*New Jersey—Newark—Free Public Library.
*New York—American Society of Civil Engineers.
Pennsylvania—Philadelphia—Engineers' Club, 1122 Girard Street.
Philadelphia—Law Association.
Pittsburg—Mercantile Library Association.
Scranton—Young Men's Christian Association.
*Wisconsin—Milwaukee Public Library.

E.—Places receiving some special portion of the publications of the Patent Office.

Belfast—The Linen Trade Board.
Birmingham—Mason College.
Leek—The Nicholson Institute.
Liverpool—Chemical Laboratory, University College.
London—British Horological Institute.
Federated Institutes of Brewing.
Home Office.
Institute of British Carriage Manufacturers.
Institute of Electrical Engineers.
Institution of Naval Architects.
Iron and Steel Institute.
Microscopical Society.
Photographic Society.
Society of Chemical Industry.
Surveyors' Institution.
Manchester—Municipal Technical School.
Society of Dyers and Colorists.
Waltham Abbey—Gunpowder Factory.
Woolwich—Ordnance Committee.

F.—Places in the United Kingdom receiving the Illustrated Official Journal of Patents.

Accrington—Mechanics' Institution.
Arbroath—Public Library.
Belfast—Queen's College.
Birmingham—Cycle Engineers' Institute.
Blackpool—Free Library.
Blackrock (Co. Dublin)—Public Library.
Brechin—Public Library.
Bristol—Literary and Philosophical Club.
School of Science, Merchants' Hall.
Burnley—Corporation Free Library.
Bury—Public Library.
Cambridge—Free Library.
University Library.
Chatham—Dockyard.
Chorley—Free Public Library.
Croydon—Central Free Public Library.
Darlington—Edward Pease Public Library.
Denbigh Free Reading Room.
Dublin—King's Inn Library.
Law Library—Four Courts.

Dudley—Free Library.
Dundalk—Free Library.
Edinburgh—Advocates' Library.
Public Library.
Elgin—Library.
Enfield—Small Arms Factory.
Falkirk—Public Library.
Falmouth—Free Public Library.
Galashiels—Public Library.
Glasgow—Library of the Faculty of Procurators.
Gravesend—Public Library.
Hawick—Public Library.
High Wycombe—Free Library.
Holyhead—Public Library.
Huddersfield—Lockwood Mechanics' Institution.
Lincoln—Public Library.
Llanelly—Mechanics' Institution.
London—Acton Public Library.
Admiralty.
Aeronautical Society.
Austrian Embassy.
Bar Library, Royal Courts of Justice.
Battersea Public Library, Lavender Hill.
Battersea Public Library, Lurline Gardens, Victoria Road.
Battersea Public Library, Lammas Hall, Bridge Road West.
Bishopsgate Institute.
Board of Trade.
Borough Road Polytechnic Institution.
Central Young Men's Christian Association, 186 Aldersgate Street.
Clerkenwell Public Library.
Coach Builders' and Wheelwrights' Art Journal.
Cold Storage and Ice Trades Review.
Ealing Free Public Library.
East Ham—Plashet Library.
Edmonton Public Library.
Electrician.
Feilden's Magazine.
Fulham Free Public Library.
Fulham Free Public Library, Wandsworth Bridge Road Branch.
German Embassy.
Goldsmiths' Company's Technical Institute, New Cross, S.E.
Hammersmith Free Public Library.
Hampstead Public Libraries, Kilburn Branch.
Harlesden Public Library.
Historical Society, Royal.
India Office.

Inland Revenue Department.
Kensington Free Public Library, Notting Hill.
Kilburn Public Library.
Lewisham Public Libraries.
London Chamber of Commerce.
Old Brompton Road Free Public Library.
Pharmaceutical Society of Great Britain.
Polytechnic, Regent Street.
Poplar Public Library.
Postal Stores, Mount Pleasant, Clerkenwell.
Privy Council.
Rotherhithe Public Library.
Royal Institution.
St. Bride Foundation Institute.
Society of Patent Agents.
Stoke Newington Public Library.
Tottenham Public Library.
Tottenham Public Library, St. Ann's Road Branch.
Toynbee Hall.
Treasury.
Whitechapel Free Public Library.
Willesden Green Public Library.
Ludlow—Young Men's Christian Association.
Macclesfield—Free Library, Town Hall.
Manchester—Association of Engineers.
Merthyr Tydvil—Free Library.
Nelson—Free Library.
Nenagh—Town Hall.
Newburgh, Fife—Laing Free Library.
Newcastle-on-Tyne—Institution of Engineers and Ship Builders.
Newport, Mon.—Chamber of Commerce.
Newport, Salop—Literary Institute.
Oldbury—Public Library.
Oxford—Bodleian Library.
Public Library.
Pembroke—Dockyard.
Sheerness—Dockyard.
Sheffield—Chamber of Commerce.
Southpo .—Atkinson Free Library.
Stony Stratford—Church Institute.
Stroud—Free Library.
Sunderland—Equitable Industrial Society, Limited.
Public Free Library.
Thetford—Mechanics' Institution.
Thornaby-on-Tees—Public Library.
Todmorden—Free Library.
Watford—Public Library.

Whitchurch—Mechanics' Institute.
Wigan—Corporation Library.
Wolverton—L. and N. W. R. Library.
Woolwich—Royal Artillery Institution.
Royal Gun Factory.
Wrexham—Free Public Library.
York—Institute of Art, Literature and Science.
Free Library.

G.—Places abroad receiving the Illustrated Official Journal of Patents.

(a) British Colonies, etc.

British Guiana—Georgetown; Demerara—Government Secretary's Office.
Canada—Ontario—Kingston—School of Mining.
Ottawa—Exchequer Court.
Toronto—Bureau of Agriculture.
Canadian Institute.
Manitoba—Winnipeg—Library of Parliament.
Cape Colony—Kimberley Public Library.
Ceylon—Government.
India—Calcutta—"Indian and Eastern Engineer."
Ishapore, Bengal—Gunpowder Factory.
New South Wales—Sydney—Engineering Association.
Trinidad—Government.
Victoria—Melbourne—Australian Institute of Patent Agents.
Department of Mines.

(b) Foreign States.

Argentine Republic—Buenos Ayres—Patent Office.
"Revista de Patentes y Marcas."
Austria-Hungary—Buda Pesth—Patent Office.
Prague—Deutsche Technische Hochschule.
Vienna—"Austrian Trade Journal."
"Der Electro Techniker."
Belgium—Brussels—Society of Electricians.
"L'Industrie."
France—Marseilles—Société Scientifique Industrielle.
Paris—Association des Chemister.
"L'Eclairage Electrique."
"L'Electricien."
"Le Mois Scientifique et Industriel."
France—Paris—"Les Brevets de Sucrerie."
"Revue Générale des Matières-Colorantes."
Société Anonyme de Publications Industrielles.
Société Nationale d'Agriculture.

Germany—Berlin—"Der Grossbetrieb."
Zeitschrift für Werkzeugmaschinen und Werkzeuge.
Stuttgart—Bibliothek der Musterlagers.
Italy—Turin—La Proprietà Industriale.
Switzerland—Berne—Bureau de la Propriété Intellectuelle.
United States—New York—American Institute of Electrical Engineers.
American Railway Association.
"India Rubber World."
Municipal Journal and Engineer.
"Scientific American."
Pennsylvania—Harrisburg—State Library of Pennsylvania
Pittsburg—Engineers' Society of Western Pennsylvania.
Washington—Smithsonian Institution.

H.—Places receiving the Trade Marks Journal only.

Edinburgh—Fishery Board for Scotland.
Jamaica—Spanish Town—Registrar-General.
London—Board of Agriculture.
Netherlands—The Hague—Office de la Propriété Industrielle.
Wolverhampton—Chamber of Commerce.

INDEX.

A.

ABANDONED application, specification not published, 51.
ABRIDGMENTS of specifications, provisions as to, 5.
ABROAD, contract for delivery, not an infringement, 135.
ABUSE of patent rights, how put in issue, 183.
ACCEPTANCE—
  how advertised, 49.
  notice of, how given, 49.
  amendment before, not allowed as of course, 53.
    required by Comptroller before, no fee for, 48.
  appeal from refusal of, 49.
    procedure in, 118.
  no fee for hearing before, 49.
  of complete specification, effect of, 51.
    ground for opposition, 79.
    term patent may be used after, 227.
    how published, 54.
  fee for, 54.
  time for extension of, 54.
  inspection of complete specification after, 54.
  of provisional specification, effect of, 50.
  time for, 54.
    extension of, 54.
      effect of, on sealing, 56.
      fee for, 54.
      form of application for, 287.
  title may be amended before, 48.
ACCOUNTS—
  duty of patentee to keep, 219.
  of licencees, how taken, 93, 103.
  when ordered in lieu of interim injunction, 145.
  on petition for extension, effect of imperfect, 221.
ACCOUNTS—
  on petition for extension, form for, 217.
  importance of, 219.
  rules as to, 215, 219.
  of profits alternative to damages, 198.
  not ordered against public body, 201.
ACTION(S)—
  amendment of specification when pending, 113.
  allowed more than once, 111.
  leave for, discretionary, 112.
  limited to disclaimer, 111.
  terms of, 111.
  on amended specification, form of claim in, 117.
  time for commencing, 117.
chancery, at assize, where no time, procedure, 184.
consolidation of, 156.
for infringement, assessor demandable on hearing of, 190.
  how paid, 190.
  amendment pending, 110.
  by an assignee, 138.
  certificate of validity grantable in, 203.
  claim in, 127.
  against company and directors, 140.
costs in, follow event, 207.
  when affected by certificate of validity, 205.
  on discontinuance, 209.
  reduced by employment of assessor, 190.
County Court cannot try, 137.
court for, 137.
defence in, 148.
  usual form of, 151.
defendant to, who may be, 139.
directors may be made defendants in, 136, 140.

ACTION(S)—
for infringement, discontinuance of, terms imposed for, 209.
discovery in, 154.
enhances the value of patent, 11.
against foreign company exhibiting here, 140.
importer abroad, 140.
inspection of defendant's works in, 153.
plaintiff's works in, 154, 172.
works of third party, 154.
interim injunction in, 142.
evidence for, 143.
defendant not appearing, 143.
against licencee, 144.
account in lieu of, 145.
undertaking in lieu of, 145.
granted undertaking where, 146.
interlocutory proceedings in, 153.
interrogatories in, 154
issues in, 185.
how tried, 193.
by joint owner of patent, 138.
judgment in, 196.
licence cannot be repudiated in defence, 150.
licencee cannot bring, 139.
exclusive, may have right to bring, 107.
defendant in, position of, 144, 150.
limit to threats of, 168.
more than one defendant in, 151.
may not be avoidable by threats, 167.
none before patent sealed, 138.
notice of pendency of, not a threat, 175.
particulars of breaches in, 146.
of objections in, 151.
amendment of, in, 152.
costs of, 208.
where action discontinued, 208.
parties in, position of, 193.
patent agent cannot conduct, 125.
pending, unaffected by certificate, 205.
plaintiff in, 138.
must prove his case, 142.
against purchasers, procedure as to, 157.
relates back to acceptance of specification, 138.
second for similar infringement, stay of, 141.

ACTION(S)—
for infringement, against several defendants, procedure in, 151.
under several patents, costs in, 210.
how tried, 141.
limit to, 142.
statement of claim in, 146.
to support threats, requirements of, 171.
discontinuance of, 172.
need not succeed, 172.
time for, 173.
threats, action stayed pending, 174.
commenced after, no injunction in, 174.
when a defence to threats action, 171.
time for commencing, 138.
trial of procedure at, 190.
undertaking not to threaten no bar to, 175.
writ in, form of, 139.
for injunction lies on threat of infringement, 127, 139.
patent, definition of, 184.
discontinued, costs of particulars, 208.
hearing of procedure in, 190.
issues in, 184.
assessor demandable on hearing of, 190.
procedure in, 184.
to prevent use of term "Patent Agent," bad, 228.
settled, certificate of validity may be given, 204.
several, against one defendant, 157.
test, procedure where defendant does not appear, 157.
appeal in case of, 157.
for threats, after infringement action, 174.
amendment not affected by, 110.
claim of plaintiff in, 173.
counter claim in, may be defence, 171.
certificate of validity not given in, 175.
damages recoverable in, 174.
defences to, 169.
defendant begins if patent challenged, 175.
due diligence as a defence to, 171.
given by statute, 168.
infringement action when a defence to, 171.

ACTION(S)—
for threats, inspection of works of plaintiff in, 172.
interim injunction in, 174.
invalidity may be raised in, 173.
issues in, 185.
may be tried with jury, 191.
particulars of objections must be given in, 173.
patents under which threats issued, 173.
reply in, may challenge patent, 173.
stayed pending infringement action, 174.
statement of claim in, 173.
ADDITION—
ineffective to prevent infringement, 131.
may be invention, 19.
ADDRESS—
to be given on application form, 41.
of caveator on licence to be given, 242.
change of, notice of, to be given, 42.
form of, 283.
registration of, 230.
ADVERTISEMENT(S)—
of acceptance, 49.
amendment, 116.
application for amendment, 113.
petition for extension, 214.
contents of, 218.
proof of, 215.
time for, extended, 218.
hearing of licence petition, 243.
proposed rules, 6.
AFFIDAVIT(S)—
as to advertisements of petition for extension, 215.
of advertisement of hearing of licence, petition required, 243.
for Patent Office, form of, 81.
how sworn, 82.
of service of notice of licence petition, 242.
AGENT—
may make application for patent, 40.
who may act as, for obtaining patent, 40.
patent. See "Patent Agent".
what papers may sign, 40.
appointment of, how made, 42.
may sign complete specification, 52.
where applicant dies, must be reappointed, 57.
cannot enter caveat in own name, 218.
AGENT—
assisting in collusive opposition, position of, 86.
may sign appeal to law officer, 118.
for patentee, sale to, an infringement, 136.
of patentee, article made for, not an infringement, 136.
for licence proceedings, who may act as, 243.
form of authorisation of, 261.
for foreign inventor, position of, as importer, 34.
improving on invention, 34.
using threats, particulars of must be given, 173.
may be committed for breach of injunction, 197.
AGREEMENT—
between joint applicants, 32.
form of, 290.
for hire of patent machine, 308.
licence, effect of, 101.
to grant licence to company to be formed, 312.
to promote company, 313.
AIDING and abetting infringement, 135.
ALTERATION of address, registration of, 230.
ALIEN abroad may apply for patent, 33.
AMBIGUITY in specification not allowable, 68.
may be removed by amendment, 110.
arguable by licencee, 149.
how raised and proved, 179.
how dealt with, 186, 187.
patentee has benefit of, 187.
licencee may discuss effect of, 188.
AMENDMENT—
before acceptance not allowed as of course, 53.
of complete specification required before acceptance, 53.
advertisement of, 116.
to remove ambiguity, 109, 110.
appeal in, 116.
no appeal from law officer in, 115.
application for, form of, 270.
for fee on, 113.
how made, 113.
second application for same, no appeal, 116.
when complete, 117.
pending petition, terms of, 112.

AMENDMENT—
required by comptroller, no fee for, 48.
time allowed for, 55.
of title, when permissible, 48.
of documents, 254.
must not enlarge claim, 110.
of claim on an opposition, 84.
enlarging patent, effect of, 117.
effect of, on damages, 117.
may not introduce subsequent knowledge, 110.
invalidity by, how put in issue, 180.
after judgment in petition, 111, 164.
leave for, conclusive of right, 117.
limit to right of, 110.
may be opposed, 113.
opposed evidence on, 114.
opposition to, form for, 271.
how given, notice of, 113.
of particulars pending appeal, 152.
of objections, 152.
costs of, 152.
no appeal as to, 153.
patent requiring, not under sec. 4, Stat. of Monop., 176.
while action or petition pending, 110.
pending, not affected by action or petition, 111.
action or petition limited to disclaimer, 111.
discretion of Court as to, 112.
how leave applied for, 113.
terms of, 111.
more than one, pending, one action, 164.
how affected by pending appeal, 111.
petition discontinued after, costs of, 163.
procedure in, 113.
on appeal, 118.
where leave to amend given, 116.
may be refused, 115.
registration of revocation stayed pending, 164.
before revocation, petition not affected, 165.
of specification pending petition for revocation, 165.
may be allowed on terms, 116.
not affected by threats action, 110.
widening scope of patent refused, 110.
ANTICIPATING machine, inspection of, 182.
ANTICIPATION, 21.
to defeat patent, must be complete, 25.
by prior specification, limit of, 47.
not made up from several documents, 26.
how raised, 181.
paper, requirement of, 25, 26.
particulars of, how given, 181.
by old specification, when ineffective, 181.
by prior user, how raised, 182.
knowledge of one person may be, 183.
may affect construction, 188.
proof of, by models, 192.
APPEAL(S)—
from comptroller, procedure in, 118.
discretion of comptroller, 40.
refusal of comptroller to accept application, 49.
comptroller in opposition, 84.
requiring amendment, 53.
none from refusal of certificate of validity, 204.
certificate of validity may be granted on, 203.
as to particulars given on, 210.
to House of Lords, costs pending, 210.
costs on higher scale not usual on, 210.
cost of witness present on, 211.
in cases of opposition, 77.
patent may be extended pending an, 222.
view pending, allowable, 211.
pending, effect of, on amendment, 111.
in proceedings for amendment, 115.
none from second application for same amendment, 116.
law officer in patent matters, 118.
to law officer, time for, 118.
fee on, 118.
cross, 119.
notice of, how given, 118.
served, 119.
respondent in, not appearing, 120.
withdrawal of, effect of, 120.
limit of argument in, 119.
costs in, 120, 121.
evidence on, 120.
form of, 285.
rules as to, how made, 122.
amendment of particulars pending, 152.

APPEAL(S)—
registration of revocation stayed pending, 164.
in case of test action, 157.
dismissed where security not given, 164.
decision of several issues on, 194.
nature of, 194.
cost of shorthand notes when allowed on, 195.
APPLICANT(S)—
first, entitled to patent, 37.
takes risk of validity, 40.
entitled to be heard before patent refused, 40.
must sign application form, 41.
joint, form of agreement between, 290.
must give address for service, 41.
to be informed of prior specifications, 46, 47.
entitled to be heard before refusal, 48.
may be required to attend or explain, 49.
to have notice of acceptance, 49.
second, for same invention may withdraw, 50.
position of, on acceptance of provisional specification, 50.
some only signing specification, 53.
joint, disagreeing on form of specification, 53.
must agree on specification, 53.
duty of, in framing complete specification, 53.
dying before complete specification filed, procedure, 56.
death of, effect on appointment of agent, 57.
must not keep back anything, 66.
duty of, to disclose invention, 66.
may disclaim what is old, 73.
should avoid redundant claims, 75.
entitled to notice of opposition, 77.
to be heard before opposition determined, 77.
evidence of, in an opposition, when to be filed, 82.
to be heard on an opposition, 83.
for amendment must appear when required, 116.
entitled to be heard on appeal to law officer, 120.
should not usually settle claims, 123.
foreign, must choose procedure, 249.
for patent, who may be, 30.
limit to class of, 33.
must be actual inventor, 34.
APPLICATION(S)—
abandoned, specification not published, 51.
referred to examiner, what for, 39.
for patent, by whom made, 40.
form for patent signed by applicants, 40.
in proper form, patent follows, 39.
on foreign invention, how made, 41.
forms, how to be filled in, 41.
by a firm, how made, 41.
how delivered at Patent Office, 42.
may be made by post, 42.
through post, how numbered, 45.
when deemed received, 45.
lost in transit, 46.
how numbered, 45.
reference of, to examiner, 46.
stamp on, 41.
covering two inventions may be refused, 48.
more than one for same invention, procedure, 49.
abandoned, no publication of specification in, 51.
how completed, 52.
for copies of specifications, how made, 55.
title of requirements for, 58.
for certificate as to particulars, costs of, 208.
duplicate claims should be avoided, 74.
for enlargement of time for renewal, how made, 89.
to correct clerical error, how made, 109.
to amend, how made, 113.
for leave to amend in action, how made, 113.
to adduce fresh evidence on appeal to law officer, 121.
for registration of proprietorship, how made, 230.
for time to hear licence petition procedure, 241.
to Privy Council, how addressed, 244.
under international arrangements, how made, 246.
convention, form for, 260.
who can make, 250.
definition of, 248.
under convention, how made, 248.
appeal to law officer in, 247.
foreign, definition of, 248.
fraudulent, effect of, 253.
form for patent, 260.

APPLICATION(S)—
of principle, different, not infringement, 15.
new, of general principle may be invention, 17.
for compulsory licence, form of, 272.
analogous, of old principle not patentable, 17.
joint, advantages of, 32.
by personal representatives, 32.
for patent may be importation of invention, 33.
by agent for foreign inventor, 34.
by importer on own account, 34.
of work of others may be invention, 35.
of principle is patentable, 15.
for patent revoked for fraud, 160.
for amendment pending petition, procedure, 163.
APPOINTMENT of agent, how made, 42.
ARTICLE—
new or better, patentable, 20.
design of patent, registrable, 99.
ASSESSOR—
costs reduced by having, 190.
may be demanded on hearing of patent action, 190.
either party may demand, 190.
on extension petition, how paid, 226.
in patent action, how paid, 190.
may be called in by Privy Council, 226.
trial with provisions as to, 190.
ASSIGNEE—
accounts of, on petition for extension, 220, 221.
extension to, terms of, 225.
of licence, position of, 107.
of patent, position of, 90.
position of, as plaintiff, 138.
profits of, must be shown for extension, 220, 221.
for royalty, position of, 107.
of share of profits, position of, 93.
ASSIGNMENT—
documents required on registration of, 231.
equitable, may be registered, 230.
fee for registration of, 231.
of licence, registration of, 231.
of patents, 90.
must be by deed, 90.
form of, 298.
of patent for district, form of, 298.
does not estop partner, 150.
ASSIGNMENT—
must be registered to be effectual, 90.
registration of, 230.
ASSIGNOR—
of patent may not dispute validity, 149.
partner of, may dispute validity, 150.
ASSISTANTS of inventor, position of, 36.
ASSIZES—
patent action triable at, 184.
petition for revocation triable at, 184.
trial of petition at, 163.
ATTORNEY-GENERAL may appear on licence petition, 245.
fiat of, for revocation of petition for procedure, 160.

B.

BANK HOLIDAY is excluded day, 52, 252.
BANKRUPT—
assignment by, may be erased from register, 233.
patent of, how affected, 230.
undischarged, patent granted to, passes to trustee, 230.
BANKRUPTCY—
assignment by trustee in, does not estop bankrupt, 149.
effect of, on patent, 230.
profits may be proved for in, 202.
BARRISTER. See "Counsel".
BENEVOLENT construction, what is meant by, 187.
BENEFICIAL construction, 187.
BOARD OF TRADE—
may dismiss petition, when, 240.
duties of, as to licence petition, 240.
position of, as to compulsory licences, 234.
to make rules, 5.
BODIES Corporate (Joint Tenancy), Act, 1899, 32.
BOOKS are evidence of public knowledge. 183.
BREACHES—
particulars of, amendment of, 152.
plaintiff limited to, 152.
See "Particulars".
BRITISH possession, definition of, for patent purposes, 246.

C.

CARRIER may be defendant for infringement, 139.
CAVEAT—
against extension of patent, how lodged, 216.
by whom lodged, 218.
time for lodging, not extended, 218.
on extension, provisions as to, 218.
in licence proceedings, 242.
on licence, address for service of caveator, 242.
person lodging, against licence, must give particulars, 243.
CERTIFICATE(S)—
of Comptroller, form of, 282.
provisions as to, 232.
as to particulars of objections, 208.
as to particulars, how given, 209.
of payment of renewal fees, 89.
fee, application for, 275.
form of, 275.
of validity. See "Validity".
effect of, 11.
on appeal, 12.
Cestui que trust can sue in own name, 138.
CHANGE of address, notice of, to be given, 42.
CHANNEL Islands, not covered by British patent, 90.
CHEMICAL product, nature of, need not be stated, 70.
CHRISTMAS, an excluded day, 52, 252.
CIRCULAR of Patent Office, 255.
CLAIM(S)—
what are, 71.
absence of, effect of, 72.
requirements of, 72.
amendment must not enlarge, 110.
for master invention, importance of wording of, 75.
meaning of, how ascertained, 186.
multiple, 73, 74.
for subordinate integers, 74.
for applications of invention should be avoided, 74.
subordinate, how dealt with, 75.
need not be interpreted by particulars of breaches, 147.
objected to, must be specified in particulars, 177.
relied on, as prior grant, must be specified, 181.
should be settled by expert, 123.
may be varied in an opposition, 84.
COLLATION of results may be invention, 35, 36.
COLONIAL—
arrangements, 246.
convention, form for application under, 264.
invention, application in respect of, 41.
COLONIES, not covered by British patent, 90.
COMBINATION—
claim, requirements of, 73.
essential part of, used may be infringement, 130.
infringement of, by substitution, 130.
may be invention, 18.
patent, requirements of specification of, 65.
test of novelty of, 18.
COMMISSION, receipt of, may be infringement, 136.
COMMITTAL—
evidence on construction, admissible on motion for, 198.
as a means for enforcing injunction, 197.
before order drawn up, 197.
the right remedy for an altered infringement, 197.
COMPANY—
must appear in court by counsel, 184.
assignee of patent, accounts of, on petition, 220.
a defendant, transferring business, procedure, 197.
foreign, exhibiting here may be sued, 140.
infringement by, directors liable for, 140.
how injunction enforced against, 197.
interrogatories to officer, limitation of, 155.
liability of directors of, for infringement, 136.
new, how affected by judgment against old company, 196.
promotion of, agreement for, 312.
reconstruction of, effect of, on evidence, 156.
reconstructed, injunction against directors of, 14
pending infringement action, 140.
may be registered as proprietor of patent, 231.
unformed, licence to promoter of, 106.
agreement to grant, 312.

COMPLETE specification may embody improvements, 51.
COMPLETION after death of applicant, 56.
COMPTROLLER—
annual reports of, 254.
appeal from, in amendment, 115.
discretionary power of, 40.
in opposition, 84.
procedure on appeal from, 118.
may require amendment of complete specification, 53.
applicant to attend or explain, 49.
British address for service, 41.
attendance of applicant for amendment, 116.
of declarant in an opposition, 78, 79.
must hear applicant, 40.
before refusing application, 48.
not bound to hear on opposition without notice, 83.
certificate of, provisions as to, 232.
correction by, of clerical error, 233.
cannot give costs, 121.
decision of, on acceptance, to be notified, 49.
on amendment, how notified, 116.
discretion of, as to amendments before acceptance, 53.
discretionary power of, how exercised, 40, 253.
evidence before, how given, 81.
form of certificate of, 282.
notice of attendance before, 269.
will not decide between joint applicants, 53.
may appeal to law officer, 254.
may require personal signature, 125.
position of, 5.
refusal of acceptance by, appealable, 49.
may refuse application covering two inventions, 48.
grant, if immoral, 10, 39.
to recognise certain persons as agents, 125.
substitute for, 5.
may extend time for procedure, 254.
COMPULSORY licence. See "Licence".
CONCEALMENT by patentee, how put in issue, 180.
CONDITIONS, on which patent usually granted, 10.
CONSOLIDATION of actions, 156.
CONSTRUCTION—
affected by anticipations, 188.
benevolent, what is, 187.
CONSTRUCTION—
of claims, rules for, 186.
particulars in respect of, not allowed, 210.
of specification, how dealt with by court, 185.
forms a precedent, 185.
CONTRACT—
for sale abroad, not an infringement, 135.
stopped by threats, damages for, 175.
CONVENTION APPLICATION—
advantages of, 250.
how dated, 249.
definition of, 248.
documents required for, 248.
form for, 264.
how made, 248.
registration of, 229.
renewal fees on, 249.
who can make, 250.
COPY(IES)—
of assignment, to be left at Patent Office, 231.
of documents filed on extension proceedings, 216.
fees for, 232.
in licence proceedings, 243.
penalty for use of false, of register, 233,
of register, is evidence, 232.
of patents, how obtained, 232.
CORPORATE body, registration of, as proprietor, 231.
CORPORATION—
appearance by, in action, 184.
may apply for patent, 31.
position of, when joint applicant, 31.
can apply as importer, 33.
cannot apply alone on Form A, 41.
joint tenant, survivorship from, 32.
CORRECTION—
of clerical errors, 233.
of register by court, 233.
COST(S)—
of abandoned petition for extension, 226.
of account of profits, 200, 201.
of action under several patents, 142.
of amendment of particulars, 152.
where patent amended, pending action, 112.
petition, 112, 163.
on appeal from comptroller, 121.
in amendment, 116.
on appeal to law officer, 121.

COST(S)—
of withdrawn appeal to law officer, 120.
of assessor, how provided for, 190.
on extension, how provided, 226.
comptroller cannot award, 121.
effect of certificate of validity on, 205.
where certificate, follow as of course, 206.
of experts, on petition for extension, 217.
of extension proceedings, how enforced, 226.
of extension, how borne, 226.
of obtaining fiat not recoverable, 161.
on higher scale, rule as to allowing, 210.
of issues, may be set off, 207.
of legal proceedings, shown in accounts on extension, 220.
of licence petition, how taxed, 245.
of opposition to extension, 226.
of particulars of abandoned action, 208.
of undefended action, 211.
allowed on subsequent application, 208.
of objection not gone into, 208.
rules as to, 208.
pending appeal to Lords, 210.
of petition discontinued on amendment, 163.
plaintiff with certificate may not get full costs, 205.
of proceedings for compulsory licence, 235.
of proving patentee's title where not admitted, 192.
of rectification proceedings, 233.
reduced by having assessor, 190.
security for, on appeal, not given, effect, 164.
in petition of revocation, 162.
where several patents sued on, 210.
of shorthand notes, 194, 210.
in threats action where infringement action commenced, 174.
usually follow event, 207.
of witness present on appeal, 211.
COUNSEL—
corporation must appear in Court by, 184.
how instructed in patent matters, 125, 126.
number heard on petition for extension, 218.
COUNSEL—
opinion of, often required on sale, 126.
view by, pending appeal, allowable, 211.
COUNTER CLAIM—
as defence to threats action, 171.
none for rectification of register, 233.
COUNTY COURT, no jurisdiction in patent action, 137.
COURT—
may appoint expert to assist it, 190.
for infringement action, 137.
order of, affecting patent, how registered, 231.
can order production of specification of abandoned application, 51.
position of expert, appointed by, 191.
may rectify register. 233.
for rectification, 233.
CROSS appeal to law officer, 119.
CROWN—
how affected by patent, 94.
assumes truth of representations, 9.
deceived by applicant, grant bad, 9.
grant of patent, voluntary, by, 10.
deceived, issue of, how raised, 180.
entitled to be heard on petition for extension, 217.
entitled to appear on licence petition, 235, 245.
patentee's rights against, how determined, 95.
terms on which invention may be used by, 95.
CUSTOM-HOUSE agent for importer, not suable for infringement, 135, 139.
CUSTOMER(S)—
of defendant, disclosure of names of, 155.
of licencee, names of, must be divulged in action, 155.
of plaintiff in threats action need not be disclosed, 173.

D.

DAMAGE(S)—
actual must be proved, 200.
amount of, only issue effect of certificate of validity when, 205.
how affected by amendment, 117.
not affected by delivery up, 202.

DAMAGE(S)—
how affected by quality of infringement, 199.
before amendment, how claimed, 117.
assessment of, by jury, 198.
how usually assessed, 198.
disclosure where chosen, 201.
when patent fees in arrear, 89.
inquiry as to, where infringement admitted, 147.
refused in some cases, 198.
how affected by licences, 199.
against manufacturer, effect of, on purchaser, 199.
measure of, 198.
and profits, alternative forms of relief, 198.
recoverable in threats action, 174.
undertaking as to, by plaintiff on interim injunction, 146.
DATE—
of patent, 56.
for second invention in an application, 48.
DAYS excluded, what are, 52. 252.
DEATH of inventor before application, 52.
DECLARATIONS—
statutory, for Patent Office, form of, 81.
how made, 82.
DEFENCE—
to action on threats, 171.
in infringement action, form of, 148.
licence cannot be repudiated in, 150.
usual form of, 151.
DEFENDANT(S)—
may demand assessor, 190.
can apply for consolidation of actions, 136.
must apply for ordinary costs where certificate, 206.
how bound to disclose names of customers, 155.
must disclose fully after judgment, 201.
when estopped from disputing validity, 149.
in infringement, position of, 193.
must give inspection of works, 153.
may obtain inspection of plaintiff's works, 154.
of works of third party, 154.
out of jurisdiction, how servable, 140.
limited to his particulars, 152.
DEFENDANT(S)—
may not get costs of particulars in abandoned action, 208.
several, position of, 151.
need only succeed on one point, 193.
successful, may have to pay costs of infringement issue, 207.
sued by several plaintiffs, 157.
in test action, failing to defend, 157.
alleging trade secret, procedure on, 153.
who may be, 139.
DEFINITION—
of British possession, for patent purposes, 246.
of convention, application, 248.
of invention, 2.
of patentee, 87.
of reasonable requirements of public, 235.
DELIVERY—
abroad, contract for, not an infringement, 135.
up of articles does not affect damages, 202.
up of infringing articles, 202.
up not ordered on expiry of patent, 202.
up of part of machine may be ordered, 202.
DESIGN of patent article registrable, 99.
DESTRUCTION of infringing articles may be ordered, 202.
DILIGENCE—
due, is a question of fact, 172, 189.
due, what is, 171.
DIRECTIONS in revocation petition, 162.
DIRECTORS—
committal of, for breach of injunction by company, 197.
of company, how far bound to answer interrogatories, 155.
may be defendants on infringement, 136, 140.
liability of, for infringement by company, 136, 140.
injunction against, in case of reconstruction, 196.
of reconstructed company, how far restrained, 140.
DISCLAIMER(S)—
by way of amendment, 109.
amendment, pending action or petition, limited to, 111.
specific, when ordered, 85.

DISCLAIMER(S)—
varieties of, 85.
what is a, 72.
how framed, 73.
DISCLOSURE of invention in complete specification, nature of, 66.
DISCONFORMITY—
what is, 64.
a question of law, 64, 180.
onus of proof of, 180.
how put in issue, 179.
DISCONTINUANCE—
of action, effect of, on threats, 172.
terms imposed for, 209.
DISCOVERY—
of documents, in patent action, 154.
in petition for revocation, 163.
is not invention, 14.
DISCRETIONARY power of comptroller, how exercisable, 40, 48, 253.
DISTRICT—
assignment of patent for, 90.
form of, 228.
DOCUMENT(S)—
that an agent may not sign, 124, 125.
amendment of, 254.
application to enter in register, 278.
on application for time for hearing licence petition, 242.
certification of copies of, 232.
comparison of, to make up anticipation, 26.
required with convention application, 246.
on extension, parties entitled to copies of, 216.
fees for copies of, 232.
required to be lodged on petition for extension, 215.
in licence proceedings, copies of, 243.
to be lodged on petition for licence, 239.
required by Privy Council on licence petition, how prepared, 243.
required in opposition to extension, 216.
in Patent Office, how put in evidence, 232.
registered at Patent Office, how proved, 189.
required to be registered, 229.
of title, producible for registration, 231.
DRAWINGS—
accompanying specifications, how prepared, 43.
DRAWINGS—
copies of, to be filed, 45.
how to be delivered, 45.
adoption of, filed with provisional specification, 42, 45.
may be amended, 110.
with provisional specification, how used, 42.
in specifications, object of, 65.
for use in court, 192.
DUBLIN, documents sent to, 255.
DUTY of patentee to keep accounts, 219.

E.

EDINBURGH, documents sent to, 255.
EMPLOYER—
entitled to invention of confidential servant, 36.
when entitled to patent, 36.
EQUITY(IES)—
enforcements of, as to patents, 230.
notice of, effect on priority, 230.
EQUIVALENT(S)—
what is covered by patent, 129.
expert evidence required as to, 189.
infringement by substitution of, 129.
mechanical, may be considered in an opposition, 81.
substitution of, not invention, 17.
discovery of, is invention, 17.
unknown at date of patent, not covered, 129.
ERROR—
clerical, correction of, 109, 233.
form of request for correction of clerical, 281.
in specification, effect of, 70.
ESTOPPEL by licence, 104.
EVIDENCE—
on opposed amendment, 114.
on appeal to law officer, application to adduce fresh, 121.
expert, as to construction, 185.
expert, required on question of equivalents, 189.
further, on appeal by, 195.
infringement is a question depending on, 132.
for interim injunction in infringement, 144.
of general knowledge admissible on motion to commit, 198.
before law officer in appeals, 120.
to limit scope of patent, 188.
limited to particulars, 152.

EVIDENCE—
of meaning of specification, 185.
on opposition on master patent, 81.
in oppositions, when and how filed, 82.
in petition for licence, 240.
power to dispense with, 253.
of a prior user may be taken first, 193.
before Privy Council, in licence proceedings, 244.
EXAMINATION—
of complete specification, before acceptance, 53.
result of, not evidence, 53.
none as to validity by Patent Office, 40.
of past specifications, 46.
EXAMINER(S)—
of application, his duties, 39.
application to be referred to, 46.
reports of, not published, 54.
of specification, duty of, 53.
EXCLUDED DAYS, what are, 252.
EXERCISE, use and meaning of, 107.
EXHIBITION—
action against foreign company for, 140.
exhibitor at, may be an infringer, 140.
may be infringement, 135.
notice of intended, 280.
publication at, when privileged, 27.
EXPERIMENTS—
disclosure of result of, by expert, 192.
by expert witnesses, 192.
by servants of applicant, 36.
specification must not require, 69.
EXPERT—
court may appoint, to assist it, 190.
appointed by court, position of, 191.
when appointed to inspect works, 153.
employed by Crown in opposition, 120.
may be employed by law officer in opposition, 77.
evidence. See "Evidence".
evidence, as to construction, 186.
witnesses, cost of, reduced by employment of assessor, 190.
witnesses. See "Witnesses".
EXPORT, goods for sale at home, infringement, 134.
EXTENSION—
of term of patent. See "Patent," 212.
of time for payment of renewal fees, 88.
for sealing, 56.

F.

FAILURE, prior, patent not defeated by, 24.
FALSE SUGGESTION—
issue of, how raised, 180.
as to utility, effect of, 180.
FEE(S)—
none for amendment required by comptroller, 48.
on appeal to law officer, 118.
on application for amendment, 113.
for certificate of comptroller, 232.
for copies of documents, 232.
for correction of clerical error, 233.
on entry of order for extension, 231.
for enlargement of time for amendment, 54.
none on hearing by comptroller before acceptance, 49.
for inspection of specification after acceptance, 54.
for keeping patent in force, 88.
may be paid in advance, 88.
extension of time for payment of, 88.
damages when, in arrear, 89.
may be paid by post, 88.
in licence proceedings before Privy Council, 244.
Patent Office, list of, 257.
on petition for compulsory licence, 239.
on petitions for prolongation, 226.
for registration of assignment, 231.
on registration of document at Patent Office, 232.
on registration of licence, 232.
renewal, application for certificate of payment, 275.
renewal, application for enlargement of time for, 276.
renewal, certificate of payment of, 89.
for renewal of convention application, 249
renewal, failure to pay to be entered in register, 230.
renewal, form of certificate of payment, 275.

FEE(S)—
renewal, payment of, to be entered in register, 229.
on sealing patent, 55.
for sealing duplicate patent, 56.
FIAT—
of Attorney-General, procedure for obtaining, 160.
how granted, 161.
costs of obtaining, position of, 161.
FIGURES, accompanying specifications, how prepared, 43.
FOREIGN—
application, definition of, 248.
convention, form for application under, 264.
rights, how affected by sale at home, 134.
patents, profits from, relevant to extension, 221.
patent, use of, on British ships, 96.
working of patent, legality of, 4.
FORM(S)—
of agreement to grant licence to new company, 312.
between joint applicants, 290.
to promote company, 313.
application, how to be filled in, 41.
of appeal to law officer, 285.
of application for patents, 41, 260.
amendment, 270.
duplicate patent, 279.
compulsory licence, 272.
renewal certificate, 275.
enlargement of time for renewal, 276.
complete specification, 286.
acceptance, 287.
of appointment of agent, on application, 42.
of certificate of comptroller, 282.
of defence, in infringement action, 148.
of assignment of patent, 296.
for district, 298.
for documents to Privy Council, on licence proceedings, 243.
for evidence in Patent Office proceedings, 81.
of letters patent, 7.
discussion of, 9.
of licence at royalty, 302.
exclusive, 304.
to use machine, 308.
of mortgage of letters patent, 299.
of notice of intention to be heard by comptroller, 269.
FORM(S)—
of notice of intended exhibition of invention, 280.
for notification of change of address, 42, 283.
of opposition to grant of patent, 268.
amendment of patent, 271.
compulsory licence, 274.
for particulars of objections, 178.
Patent Office, list of, 259.
how obtainable, 288.
of petition for compulsory licence, 273.
of postal request for specification, 267.
provisions as to alteration of, 5.
of specification, 265.
of request to register title, 277.
document, 278.
correction of error, 281.
under order of Privy Council, 284.
of statement of claim in infringement action, 146.
in statute, how altered, 5.
of writ in action for infringement, 139.
FRAUD—
alleged in petition trial, when, 163.
revocation petition on ground of, 159.
FRIDAY, GOOD, an excluded day, 52, 252.

G.

GOOD FRIDAY, an excluded day, 52, 252.

H.

HOUSE OF LORDS—
and questions of fact, 194.
will not decide all issues, 194.

I.

IMMORAL application may be refused, 39.
IMPORTATION—
may be infringement, 135.
by post, effect of, 135.
how prevented, 141.
sale abroad for, not infringement, 135.

IMPORTER—
abroad, how suable, 140.
may be agent, 34.
when an, may apply on own account, 34.
applying, may be abroad, 33.
included in inventor, 33.
of infringement an infringer, 135.
position of, applying for patent, 34.
may be merely receiver of invention, 34.
when a trustee for inventor, 34.
IMPROVEMENT(S)—
how to be claimed, 72.
may be embodied in complete specification, 51.
inventions, 16.
INADVERTENCE, a defence to *interim* injunction, 144.
INCAPACITY, effect of, 253.
INCONVENIENCE, of patent, how put in issue, 183.
INDEXES of patents, provisions as to, 5.
INDUSTRY(IES)—
affected by patent worked abroad, remedy, 235.
must not be prejudiced by patent, 235.
prevented by patent, objection on ground of, 183.
INFRINGEMENT(S)—
action. See "Action".
action for, only after sealing, 56.
admitted, motion for judgment on, 147.
by aiding and abetting, 135.
altered to avoid injunction, procedure where, 197.
caused by patentee, 136.
cheap, may not cause damage, 200.
may be cheaper than action to patentee, 167.
claims in respect of, 127.
by receiving commission, 136.
by Crown, procedure in respect of, 95.
different application of principle is not, 15.
exhibition may be, 135.
about expiration of patent, no delivery up, 202.
general claim for unknown, 147.
inadvertent, no injunction for, 144.
inferior quality of, may affect damages, 200.
no interim injunction against doubtful, 145.
INFRINGEMENT(S)—
issue of, costs of, may be set off where patent bad, 207.
liability of directors for, by company, 136.
licensor of, not liable, 135.
limit of locality for, 135.
lowering price, damages from, recoverable, 199.
making of parts of machine may be, 133.
manufacturing alone is, 133.
marked in lieu of delivery up, 202.
none by act abroad, 135.
not found, position of action, 194.
now notified in particulars of breaches, 146.
ordered *to be given* up, 202.
of patent forbidden, 93.
penalties for, 94.
price of, where a defence, 200.
profits of, how ascertained, 201.
questions as to fact or law, 128.
a question of fact, 132, 189.
when renewal fees in arrear, 89.
repair may be, 133.
when restrained by injunction, 139.
by sale to agent of patentee, 136.
by sale at home of export goods, 134.
by substitution of equivalent, 129.
tested by specification, 133.
threatened, action lies to restrain, 94, 127, 139.
course as to, 127.
threats for preventing, 94.
tried by jury in threats action, 191.
two kinds of alleged, one proved, form of injunction, 196.
unchecked, effect of, on extension, 224.
may be by user alone, 133.
by user of machine sold under distress for rent, 134.
by user of patent machine for new purpose, 133.
by variation of invention as described, 129.
what is, 128.
action. See "Action for Infringement".
INFRINGER—
liability of an, 94, 127.
purchaser may be liable as, 134.
receiving commission from, an infringement, 136.

INJUNCTION—
action for, lies on threat of infringement, 139.
against agent of foreign patentee, for threats, 174.
infringement, term of, 196.
threats, 168.
threats, does not affect threats of third party, 175.
breach of, by different infringement, remedy, 197.
when continued, after expiration of patent, 196.
how enforced, 197.
undertaking preferable to consent, 195.
usual form of, 196.
when granted against infringement, 139.
interim, 142, 143.
account may be ordered in lieu of, 145.
application for, 142.
certificate of validity, best ground for, 145.
evidence on application for, 143.
when granted, 143.
granted, plaintiff undertakes for damages, 146.
none for inadvertence, 144.
none where infringement not clear, 145.
none to prevent use of term patent agent, 228.
where one infringement proved out of two alleged, 196.
on sale after expiration of patent of goods made before, 133.
under several patents, limitation of, 142.
INSPECTION—
of complete specification when first allowed, 54.
of register of patents, 232.
of defendant's works in infringement action, 153.
by defendant of plaintiff's works, 154.
of works of plaintiff for threats, 172.
procedure for, 153.
of third party by defendant, 154.
INSTRUCTIONS, issued by patentee, relevant as to sufficiency, 193.
INSUFFICIENCY, how put in issue, 179.
INTERNATIONAL—
arrangements, 246.
application under, 41.
INTERNATIONAL—
convention, advantages of, 250.
to what countries applied, 247.
effect of, 246.
form for application under, 264.
time for application under, 248.
exhibition, protection of inventions at, 250.
journal, on patents, 250.
office, for patents, 250.
INTERROGATORIES—
in action for infringement, 154.
to company, limitation of, 155, 156.
duty of secretary of company as to, 155, 156.
in petition for revocation, 163.
INTERROGATORY, as to user by plaintiff allowable on utility, 155.
INVENTION(S)—
adaptive skill is not, 14.
must be claimed in specification, 71.
combination may be, 18.
of old parts may be, 18.
communicated from abroad, form of application, 41, 262.
when patentable, 34.
definition of. 2.
description of, in provisional specification, 60.
difficulty of introducing, 13.
discovery is not, 14.
of equivalent may be, 17.
may be exhibited before application, when, 27.
immoral, unpatentable, 10.
improvement, 16.
international arrangements as to protection of, 246.
master, 16.
importance of claims in case of, 75.
merits of, when considered by Privy Council, 222.
one method of carrying out, must be shown, 70.
more than one, application in respect of, 49.
included in application procedure, 48.
nature of, by whom determined, 186.
new application of principle may be, 17.
new process is, 18.
not brought into use, effect on extension, 223.
notice of exhibition of, 280.
novelty without, 17.

INVENTION(S)—
obtained from opponent, result, 79.
part of new combination may be, 18.
patent for more than one, good, 48.
must be for one only, 48.
patentable, must be useful, 29.
patented, terms on which Crown may use, 95.
use of, on foreign ships, 96.
prior use or publication of, 21.
protected, how ascertained, 132.
when provisionally protected, 40.
a question of fact for jury, 21.
re-discovery may be, 38.
same must be described in both specifications, 63.
small, often valuable, 12.
by study of works of others, 35.
substitution of equivalent, is not, 17.
suggested by another, 35.
by servant, 36.
use of, for new purpose an infringement, 133.
may be used after acceptance of application, 51.
warlike, provisions as to, 251.
what is and what is not, 14.
INVENTOR(S)—
allowance for time of, in account of profits, 222.
applicant must be actual, 34.
may have assistants, 36.
cannot claim patent as of right, 10.
deceased, grant to representatives of, 3.
may defeat patent by disclosure, 23.
defrauded, may obtain patent by revocation, 159.
dying before application for patent, 32.
foreign, must elect procedure, 249.
includes importer, 33.
not interested in extension, effect of, 221.
must be benefited by extension of patent, 225.
not properly remunerated, position of, 212.
patent may be granted to, 2.
of invention, prior sale by, effect of, 23.
how far protected by patent, 132.
rival, position of, 37.
should not expect too much, 12.
selling invention, restrained from withdrawing application, 32.
INVENTOR(S)—
servant using master's time may be true and first, 36.
takes all responsibility for grant, 9.
true and first, form of raising objection, 178.
burden of proof of first and true, 178.
IRELAND—
copies of documents for use in, 255.
provisions as to, 254.
punishment of offences in, 228.
IRISH order, registration of, 231.
IRREGULARITY, amendment of, 254.
ISLE of MAN—
covered by patent, 90.
provisions as to, 254.
summary proceedings in, 228.
ISSUE(S)—
costs of, may be set off, 207.
decision of several, in patent action, 193.
decisive may be tried first, 193.
House of Lords will not decide all, 194.
in action for infringement, 185.
in patent action, trial of, 193.

J.

JOINT—
tenant, a corporation, survivorship from, 32.
owners, action for infringement by, 138.
applicants, agreement between, 32.
forms of agreement between, 290.
application, advantages of, 32.
allowable, 30.
effect of, 31.
by corporation, 31.
JOURNAL—
official, 6.
amendment to be advertised in, 116.
JUDGMENT—
appealed against, no presumption of its being right, 194.
in infringement, 196.
in petition, amendment after, 164.
JURY—
assessment of damages by, 198.
invention is question for, 21.
revocation petition may be tried with, 163.
threats action may be tried with, 191.
not usual in patent action, 190.

K.

KNOWLEDGE—
general, proof of, 192.
of one person, may be anticipation, 183.
not public knowledge, 183.
public, is not anticipation, 26.
particulars of, not required, 182.
may be proved on motion to commit, 198.
what is, 182.

L.

La Propriété Industrielle, how obtainable, 250.
LAW, issue of patent contrary to, how raised, 183.
LAW OFFICER(S)—
appeal to, in amendment, 116.
from discretion of comptroller, 40.
form of, 285.
in opposition, 77, 84.
from refusal to accept, 49.
withdrawal of, 120.
may appear on petition for licence, 234.
comptroller may apply to, 254.
costs in appeals to, 120, 121.
cross-appeal to, 119.
discretion as to parties entitled to be heard, 120.
may employ expert in oppositions, 77, 120.
fee on appeal to, 118.
no appeal from, in amendment, 115.
in patent matters, 118.
proceedings before, 118.
time for appeal to, 118.
may order attendance of witnesses, 121.
rules, 118 *et seq.*
LIBRARY—
anticipation by book in, 26.
of Patent Office, 6.
LICENCE(S)—
agreement to grant to unformed company, 312.
application to enter, on register, 278.
assignment of, registration of, 231.
compulsory, application for, form of, 273.
costs of proceedings for, 235.
grounds for grant of, 234.
LICENCE(S)—
compulsory, objection to grant of, how served, 243.
order for, effect of, 235.
address for service of caveator, 242.
advertisement of time for hearing, 243.
petition for, costs of, 245.
Crown may be heard on, 245.
copies of documents in relation to, 243.
documents on application for time for hearing, 242.
documents required in, form of, 243.
duties of Board of Trade as to, 240.
evidence in opposition to, 240.
petition, evidence before Privy Council, in, 244.
for, fee on, 239.
fees in, before Privy Council, 244.
for, form for, 239.
law officer may appear on, 235.
full, effect of, 107.
licencee may appear on petition for, 234.
notice of application for fixing time for, 241.
notice of time for hearing petition, 243.
opposition to petition for, form of, 274.
petition for, parties to, 234.
persons entitled to appear at hearing of, 242.
proof of allegations in, 239.
reference of questions for report, 241.
for, time for hearing, how fixed, 241.
waiver of, compliance with rules, 244.
when Board of Trade may dismiss, 240.
when heard, 242.
when referred to Privy Council, 234.
who may conduct, 243.
proceedings for, 234, 239.
reasons for provisions as to, 234.
or revocation alternative, 234.
revocation on petition for, 234.
scope of provisions for, 235.
settlement of proceedings for, 241.
terms of, 238.

LICENCE(S)—
compulsory, time for notice of objections to, 243.
extension of time for objecting, 242.
when demandable, 235.
when Privy Council, bound to make order, 238.
who may apply for, 234.
conduct proceedings for, 243.
lodge caveat on proceedings for, 242.
exclusive, not a conveyance, 107, 139.
effect of, on extension, 224.
fee on registration of, 232.
grant of, may affect damages, 199.
granted by part owner of patent, 102.
may be granted by patentee, 93.
how granted, 100.
to new company, 106.
does not imply validity, 104.
is locally situated, 106.
of machine at royalty, form of, 308
parole, good, 100.
with option of purchase, effect of, 105.
by part owner of patent, 93.
position of registered owner of patent as to grant of, 230.
is property, 106.
registration of, 107.
procedure on, 231.
may be repudiated by licencee, 105, 150.
revocation of, 104.
sale of, stamp on contract for, 106.
stamp on, 101.
under several patents, usual provisions of, 106.
effect of invalidity on, 106.
term of, 104.
terms as to, imposed on extension, 225.
where not granted, assessment of damages, 199.
usual consideration for, 103.
when assignable, 106.
to company promoter, effect of, 106.
when grantable, 102.
LICENCEE(S)—
accounts of, how taken, 93, 103.
action against may support threats, 171.
may appear on petition for licence, 234, 242.
LICENCEE(S)—
need not admit construction of patent, 188.
as defendant, position of, 104.
may not dispute validity, 104.
equitable, may be estopped on validity, 150.
exclusive, position of, 107.
on extension, 224.
right of, to bring action for infringement, 107.
may have right of action, 107.
under expired patent, may oppose, 80.
free profits of, relevant on extension, 221.
full, rights of, 107.
how affected by revocation, 103.
cannot bring infringement action, 139.
injunction against, 144.
under part owner, position of, 102.
position of, 101.
when a lessee, 105.
may prove himself outside patent, 188.
may repudiate licence, 105, 150.
procedure, 150.
sued, may have patent construed, 148.
must give names of customers, 155.
evidence of public knowledge when allowable, 149.
cannot repudiate by defence, 150.
may show expiry of plaintiff's title, 148.
may not dispute validity, 148.
usual covenants of, 105.
LICENSOR—
duty of, to keep up patent, 2, 104.
of infringement, not liable, 135.
LIMITATION, of anticipation by prior specification, 47.
London Gazette, time for hearing licence petition to be notified in, 243.
Loss on patent need not be accurately shown for extension, 221.

M.

MACHINE—
anticipating inspection of, 182.
licence to use, form of, 308.
manufacturer and purchaser of, joint defendants, 141.

MACHINE—
new use for old, not patentable, 18.
part of, infringing, delivery up ordered, 202.
particulars of infringement by parts of, 147.
patented, making of parts for, may be infringement, 133.
sold under distress, user of, may be infringement, 134.
what may be called, 59.
MACHINERY, may be ordered to be worked before defendant, 154.
MAN, ISLE OF—
provisions as to, 254.
summary proceedings in, 228.
MANUFACTURE—
adaptive skill in, is not invention, 14.
new, the only subject for patent, 2.
patentable, must be new, 16.
for patentee's agent, not an infringement, 136.
MANUFACTURER—
under expired patent may oppose, 80.
of infringing article, position of, 141.
damages against, do not exonerate purchaser, 199.
MANUFACTURING alone is infringement, 133.
MASTER—
when entitled to patent for work of servant, 36.
inventions, 16.
MEDICAL patent, position of, 159.
MERIT required for extension of patent, 223.
MISTAKE—
in documents supplied by Patent Office, 256.
in specification, effect of, 70.
MODELS—
for use in Court, 192.
experts should examine, 192.
for patent museum, 254.
MONOPOLIES—
at common law, 1.
statute of, 1.
limitation of, 2.
and foreign worked patents, 97.
sect. 4, not applicable to patent, 176.
how to be tried, 2.
MORTGAGE of patent, form of, 299.
MORTGAGEE—
may be joined in action of infringement, 138.
protection of, on extension, 225.
MORTGAGOR can bring action, 138.
MOTION for rectification, proper procedure, 233.
MUSEUM, patent, 254.

N.

NAMES—
of customers of licencee defendant must be given, 155.
of plaintiff's customers not required in threats action, 173.
NEW—
or better article patentable, 20.
shape, introduction of, may be invention, 20.
NOTICE—
of abandonment of licence, time for, 150.
of acceptance, how given, 49.
of appeal to law officer, form of, 285.
how given, 118.
how served, 119.
of application to fix time for hearing licence petition, 241.
to attend before comptroller, 269.
of change of address, 42, 283.
of equity affects priority of registration, 230.
of exhibition, 28.
of invention, 280.
of existence of an infringement action not a threat, 175.
to foreign respondent, of revocation petition, 162.
of hearing by comptroller, 48.
of opposition, 83.
to law officer's clerk, how sent, 122.
of objection to licence petition, Crown need not give, 245.
to objectors, of hearing of extension petition, 216.
of opposition to amendment, how given, 113.
how given, 77.
of intended reference to publication on opposition, 83.
of reference of licence petition to Privy Council, 241.
of restrictions as to user of patented article, 92.
of time fixed for hearing licence petition, 243.
NOVELTY—
does not imply invention, 17.
issue of, how raised, 182.

NOVELTY—
patent not refused for want of, when, 85.
proof of want of, 182.
and public knowledge similar, 182.
want of, will not stop sealing of patent, 39.
NUMBERING of applications, 45.

O.

OBJECTION(S)—
to extension, Crown need not give notice of, 217.
to be filed, 216.
to grant of compulsory licence, how made, 243.
hypothetical form of, 183.
particulars of. See "Particulars".
question whether law or fact, 189.
OFFENCE(S)—
none to sign specification as agent, 228.
use of term "patent expert" is not an, 228.
with respect to patents, 227.
OFFICE, patent, 4.
OFFICER of company, how far bound to answer interrogatory, 155.
OFFICIAL JOURNAL—
of Patent Office, 6.
acceptance to be advertised in, 49.
OPINION of counsel as to validity, 126.
OPPOSITION—
to amendment, evidence on, 114.
form for, 271.
how made, 113.
appeal in, evidence on, 84.
to extension, caveat by opponent, 216.
costs of, 226.
of patent, procedure for, 216.
collusive, effect of, 86.
position of agent assisting in, 86.
employment of expert in, by Crown, 120.
declarant in, may be required to attend, 78.
for delay, effect of, 56.
disclaimer may be ordered on, 85.
evidence in cases of, 78.
an, when and how filed, 82.
form of notice of, 268.
grounds for, 11, 77.
hearing of, 83.
how dealt with, 77.
OPPOSITION—
mechanical equivalents may be considered in an, 81.
notice of, how given, 77.
for prior patent, rules as to, 79.
procedure on appeal, 118.
seldom reopened, 86.
when patent will be stopped on, 85.
to grant of patent, time for, 55, 77.
usual reasons for, 85.
to compulsory licence, evidence in, 240.
to licence petition, form of, 274.
OPPONENT(S)—
when entitled to be heard by law officer, 120, 178.
not entitled to withdraw after opposition closed, 86.
evidence, when to be filed, 82
proving invention stolen, position of, 79.
opposing on several grounds, position of, 80.
who may be, 78.

P.

PAPER—
for specifications, 43.
for drawings, 43.
PARLIAMENT, rules to be laid before, 5.
PARTICULARS—
of agents using threats must be given, 173.
of breaches, form of, 146.
costs of, in undefended action, 211.
how prepared, 146.
need not interpret claims, 147.
plaintiff bound by allegations in, 147.
certificate as to, must be obtained, 208.
on construction only, not allowed, 210.
costs of, rules as to, 208.
of objections always required when patent disputed, 177.
amendment of, during action, 152.
pending appeal, 152.
not appealable as to costs, 153.
certified on appeal, 210.
challenger of patent bound by, 177.
costs of, allowed afterwards, 208.
amendment of, 152.
where plaintiff discontinues, 208.

PARTICULARS—
of objections, cross examination for costs of, 208.
forms for, 178.
must be delivered, 151.
no costs of, where plaintiff offers no evidence, 209.
not gone into, cost of, 208.
not required for narrowing scope of patent, 188.
not to specify publications merely used as evidence, 181.
partial certificate as to, 209.
required by statute, 177.
rules for framing, 177.
delivered by plaintiff in threats action, 173.
of patents under which threats issued, 173.
of prior publication, how given, 181.
user, form of, 182.
of public knowledge not required, 182.
of threats must be given, 173.
PARTIES to petition for licence, 234.
PARTNER not estopped by assignment, 150.
PARTNERSHIP—
application by, how made, 41.
in joint patent, when presumed, 31.
patent forming assets of, rights as to, 92.
PATENT(S)—
abuse of, how put in issue, 183.
action under more than one, 141.
on more than one, form of injunction, 197.
for an addition, 19.
agent, any one may act as, 124.
briefs counsel in Patent Office proceedings, 125.
definition of, 228.
what documents may not be signed by, 124.
erased from register, position of, 125.
improper use of term, 227.
no injunction to prevent use of term, 228.
limit of work of, 126.
list of, 124.
how obtainable, 40, 124.
penalty for using title, 124.
must be registered, 228.
register, position of persons entitled to be on, 228.
registration of, 124.
utility of employing, 124.
PATENT(S)—
agent, who may describe themselves as, 40.
act as, 40.
amendment of form of, application for, 270.
pending petition, 163.
after revocation order, 164.
anticipation of, 21.
not applicable to provisionally protected article, 51.
application for duplicate, 279.
form of, 260.
by whom made, 40.
by representatives, 32.
where applicant dies. procedure for, 56.
article, position of purchaser of, 92.
assessor, in action, payment of, 190.
assignable for limited area, 90.
assignee of, for district, position of, 90.
profits of, position of, 93.
for royalty, position of, 107.
assignment of, in whole or in part, 90.
must be by deed, 90.
registration of, 230.
when attacked, patentee commences at trial, 191.
held bad, extension of, pending appeal, 227.
clearly bad, not extended, 222.
challenged, particulars of objections required, 177.
challenger of, bound by particulars, 177.
chemical, need not state nature of product, 70.
for a combination, 18.
consideration for grant of, 65.
contrary to law, issue of, how raised, 183.
under convention, date of, 249.
co-owners of, position of, 92.
corporation may apply for, 31.
may be registered as proprietor of, 231.
costs of action on more than one, 210.
covers known equivalent, 129.
Crown not bound to grant, 10.
effect of, on the Crown, 94.
date of, 56.
conclusive, 249.
equivalent to infringe must be known at, 129.

PATENT(S)—
doubtful, management of, 12.
often valuable, 11.
duplicate of lost, may be sealed, 56.
duration of, 90.
enlarged by amendment, valid, 117.
evidence against, how affected by reconstruction, 156.
when invention may be exhibited prior to, 27.
expert, any one may describe himself as, 228.
expiration, goods for sale after, 133.
of, injunction continuing after, 196.
expired, certificate of validity may be given on, 204.
who may oppose on ground of, 80.
extension of, accounts required on, 219.
for, 213.
form of accounts for, 220.
accounts imperfect, result, 219.
advertisement of petition for, 214.
proof of advertisements, 215.
assessor on petition for, 226.
to assignee, terms of, 225.
caveat by intending opponent, 216.
costs of proceedings relevant on, 220.
documents to be lodged, 215.
disclosure on petition for, 218.
entry of order for, 284.
none where facts concealed, 218.
fee on registration of order for, 231.
fees on proceedings for, 226.
granted only once, 213.
grounds for, 212.
decision, 218.
affected by unchecked infringement, 224.
must benefit inventor, 225.
affected by exclusive licence, 224.
on terms as to licences, 225.
opposition to, 216.
costs of, 226.
order for, how registered, 231.
partial, 212, 213.
costs of abandoned, petition for, 226.
petition for, not adjourned for amendment, 219.
before advertisement, 218.
costs of proceedings for, 226.
how taxed, 217.
PATENT(S)—
extension of, petition for, number of counsel heard, 218.
Crown may be heard on, 217.
petition for, expert witness costs, 217.
parties entitled to documents on, 216.
petition for, how prepared, 216.
how served, 216.
time for lodging petition for, 217.
who will be heard on petition for, 217.
primâ facie case for, what is, 222.
procedure for, 213.
waiver of compliance with rules as to, 217.
term of, 212.
time for lodging objections to, 216
petitioning for, 213.
presenting petition for, 215.
extent of protection, 90.
not defeated by prior failure, 24.
fees for keeping, in force, 87.
fee on sealing, 55.
use of invention on foreign ships, 96.
foreign profits from, relevant for extension, 221.
use of, on British ships, 96.
form of, 7.
discussion of, 9.
forms of application for, 41.
value of, enhanced by action, 71.
future agreement as to, not registrable, 229.
goes to first applicant, 37.
grant of, a formal matter, 39.
to be entered in register, 229.
granted as of course on application in due form, 39.
where novelty doubtful, 85.
may be granted for rediscovery, 38.
when granted for communicated invention, 34.
grounds of opposition to grant, 11.
immoral, may be refused, 39.
importation of invention by application for, 33.
improper use of the word, penalty for, 227.
effect of improper use of, in trade marks, 227.
inconvenience of, how put in issue, 183.
must not prejudice any industry, 235.
how protected internationally, 246.
when invalid, 189.

PATENT(S)—
invalid, may be amended, 110.
certificate of validity where, 204.
is not ground for opposition, 79.
prior, no objection, 181.
may be invalidated by title, 59.
invalidated by false suggestion of utility, 70.
not invalidated by false theory, 70.
declaration of invalidity of, effect on royalties, 103.
one, of several in licence invalid, 107.
joint application for, 30.
extension of, 213.
presumption of partnership, 31.
knowledge, subsequent to date of, may not be introduced by amendment, 110.
lapse of, right to use word patent unaffected by, 227
Law Amendment Act, 1902, prior publication, 27.
liable to compulsory licence, provisions, 235.
licence under more than one, 107.
licencee under, cannot dispute validity, 150.
duty of licensor to keep up, 104.
limits of protection of, 132.
master, ground of opposition, evidence required, 81.
meaning of, licencee may dispute, 188.
me it required for extension of,
s, extended where ac-
ts imperfect, 221.
evous to state, invalid, 2, 3.
an one, available for manufacture, injunction, 197.
cence under, 106.
mortgage of, form of, 299.
mortgagor of, can sue alone, 138.
museum, 254.
nature of property in, 90.
obligation to work at common law, 4.
offences with regard to, 227.
office, 4.
seal of, 5.
regulation of business at, 5.
form of affidavits for, 81.
application, how left at, 42.
circular, 255.
circular, how obtained, 123.
closed, documents how filed when, 52.

PATENT(S)—
office, documents registered, how proved, 189.
fees, list of, 257.
forms, list of, 259.
how obtainable, 288.
when open, 6.
proceedings at, counsel how instructed for, 125.
publications how procurable, 255.
registration of documents at, 230.
when renewal fees must reach, 88.
searches, what are made, 46.
sale branch, 6.
publications of, 6.
library, when open, 6.
does not investigate validity, 40.
supplying wrong documents, 256.
old, undisputed, ground for interim injunction, 144.
must cover only one invention, 48.
for more than one invention good, 48.
opposed, variation of claim in, 84.
opposition to, form of, 268.
grant of, time for, 55.
may be lost by collusive opposition, 86.
not usually stopped on opposition, 84.
when stopped on opposition, 84, 85.
ownership of, how affected by bankruptcy, 230.
part owner, licences by, 93, 102.
forming partnership assets, rights as to, 92.
person interested in, may lodge caveat on licence petition, 242.
for preventing British industry, position of, 235.
petition for extension of, 212.
prior, form of objection on ground of, 181.
opposition on ground of, rules as to, 79.
procedure for grant of, how regulated, 2.
obtaining, 39.
for process, defeated by prior sale of result, 23.
infringed by importation of an article, 135.
professional assistance with regard to, 123.
how proved in Court, 192.
reference to, in subsequent specification, when ordered, 85.

PATENT(S)—
register of, application to enter document in, 278.
application to enter name in, 277.
copies of, how obtained, 232.
contents of, how proved, 232.
convention application, how entered in, 229.
correction of errors in, 233.
documents to be entered in, 229.
equitable assignment may be entered in, 230.
falsification of copy of, 233.
penalty for, 227, 233.
grant of patent to be entered in, 229.
inspection of, 232.
payment of renewal fees to be entered in, 229.
provisions for keeping, 229.
rectification of, 233.
costs of rectification of, 233.
cannot be rectified on counter claim, 233.
trust cannot be entered in, 230.
requiring amendment, not under sect. 4, Stat. of Monopolies, 176.
revocation of, 158.
foreign, worked by Privy Council, 97, 98.
on petition for licence, 234.
registration of, 231.
may be revoked in Scotland, 158.
rights, abuse of, how put in issue, 183.
future, sale of, lawful, 91.
rules for construction of, 187.
sale to company, effect of, on extension, 225.
of, usual terms of, 9..
sealing of, no action before, 13.
when usually sealed, 56.
scope of, amendment enlarging, refused, 110.
evidence to limit, 188.
infringement must be within, 130.
licencee may not limit, by prior publications, 188.
subject matter for, 14.
term of, 87.
may be used after complete specification, 54, 227.
test of, validity of, 2.
supporting threats, particulars of, 173.
choice of title for, 58.

PATENT(S)—
need not be tried by action to support threats, 171.
trivial objections to, inadvisable, 177.
unworked in country, position of, 3.
not used, effect on extension, 223.
must be useful, 29.
not affected by prior experimental user, 22.
affected by past user though discontinued, 23.
validity of, assumed for extension, 222.
triable in threats action, 175.
value of, enhanced by action, 11.
no implied warranty of validity on sale of, 91.
war, when not revocable, 158.
warning not to infringe, when actionable, 168.
what is granted under, 91.
who may apply for, 30.
worked abroad, objection to, 236.
only abroad, position of, 96, 234.
may be rendered worthless by ill-drawn claims, 75.

PATENTEE—
abroad, notice to, of revocation proceedings, 162.
need not give security for costs of petition, 162.
duty of, as to accounts, 219.
agent of, infringement by sale to, 136.
has benefit of ambiguity, 187.
may amend specification, 109.
commences at trial, when patent attacked, 191.
concealment by, how put in issue, 180.
conduct of, considered for extension, 223.
definition of, 87.
for district, position of, 90.
failing in action, may commence another, 141.
instructions issued by, evidence of insufficiency, 193.
insufficiently remunerated, right of, 212.
joint, position of, 31, 92.
position of, as to extension, 213.
may grant licences, 93.
may prove in bankruptcy for profits recoverable, 202.
limits of protection from equivalents, 129.

PATENTEE—
must prove actual damage to recover it, 200.
supply articles for public services, 94.
must not cause infringement, 136.
lay trap, 136.
not benefited by extension, fatal, 225.
bound to sue every infringer, 166.
interested in extension, effect of, 221.
working patent, position of, 235.
partial grant of licences by, 102.
position of, as to licences, 93.
person registered as, position of, 230.
power of, to grant licences, 100.
profits of, how ascertained, 220.
must be clearly shown for extension, 220.
rights granted to, 91.
of, against infringers, 127.
accepting royalty from assignee, 106.
may sell for export at special price, 134.
in several countries, effect of sale by, 134.
shares sold by, account of, for extension, 220.
time of, allowance for, on extension, 222.
title of, usually admitted at trial, 191.
PAYMENT of assessor in patent action, 190.
PENALTY(IES)—
for use of false copy of register, 233.
falsification of register, 227.
improper use of the word patent, 227.
term patent agent, 227.
of an infringer, 127.
for using title patent agent, 124.
PERSON under incapacity, provisions as to, 253.
PERSONAL representative, may apply for patent, 32.
PETITION—
for compulsory licence. See "Licence," 234.
for extension of patent. See "Patent".
for licence. See "Licence".
PETITIONER—
for revocation, must prove *locus standi*, 159.
who may be, 159.
PITH and marrow of invention, how ascertained, 132, 133.
PLAINTIFF—
in infringement action, 138.
in patent action may demand assessor, 190.
description of, in statement of claim, 138.
in infringement, may inspect defendant's works, 153.
may have to give inspection, 154.
interrogation of, as to utility, 155.
limited to his particulars of breaches, 152.
must elect between damages or profits, 198.
prove damage, 200.
succeed on every issue, 193.
offering no evidence, no costs of particulars, 209.
may be ordered to give samples, 154.
in infringement, position of, 193.
undertakes in damages, when interim injunction, 146.
unsuccessful, may have full costs of issue, 205.
withdrawing action, costs of particulars, 208.
POISON, patent medicine containing, position of, 159.
POST—
application may be made by, 42.
by, how numbered, 45.
when deemed received, 45.
lost in transit, 46.
importation by, how prevented, 141.
through, effect of, 135.
payment of renewal fees by, 88.
how to obtain specifications by, 55.
POSTAL—
communications to Patent Office, provisions as to, 252.
request for specification, form of, 267.
POSTING abroad, not an infringement, 135, 141.
PRINCIPLE—
application of, alone protected, 15.
analogous application of known, not invention, 17.
new, application of, may be invention, 17.
embodiment of, is patentable, 15.
is not patentable, 15.

PRIOR—
grant invalid, patent is not invalid, 181.
objection on ground of, 181.
knowledge, affects construction of specification, 188.
publication of invention, what is; 21, 24.
not constructed from various books, 26.
how proved, 26.
by specification fifty years old, 27.
user of invention, 21.
general interrogatories as to, 155.
must be the same as invention patented, 23.
what, will defeat patent, 22.
PRIVY COUNCIL—
applications to, how addressed, 244.
for entry of order of, in register, 284.
may call in assessor, 226.
when compelled to make order on licence petition, 238.
documents to be referred to on licence petition, 241.
evidence before, in licence proceedings, 244.
may extend term of patent, 212.
fees in proceedings before, 226.
on registering order of, 231.
orders of, as to costs how enforced, 226.
for licence, effect of, 235.
petition for licence may be referred to, 234.
quorum of, for compulsory licence, 235.
may refer questions for report, 244.
reference of licence petition to, 241.
petition to, deferred for settlement, 241.
registration of order of, for extension, 231.
may revoke patent on licence petition, 234.
no revocation by, for three years, 234.
right of, to revoke grant, 97.
rules for licence proceedings before, 241.
cannot extend time for lodging petition, 217.
PROCEDURE—
in action against indemnified purchaser, 141.
in amendment, 113
for amendment pending petition, 163.
PROCEDURE—
after leave to amend, 116.
on appeal from Comptroller, 118
against Crown to enforce patent rights, 95.
where defendant company transfers business, 196, 197.
for extension of patent, 213.
for fiat for revocation petition, 160.
in threats action, where validity in issue, 175.
for obtaining inspection of works, 153.
where two inventions in one application, 48.
for obtaining patent, 39.
in opposition to extension, 216.
directions as to, 216.
in patent actions, 184.
on petition for revocation, 162.
on discovery of prior specification, 46, 47.
for rectification of register, 233.
for registration of documents at Patent Office, 231.
for revocation of patent, 158.
rules for, on licence proceedings, 241.
in case of surprise at trial, 191.
for fixing time for hearing licence petition, 241.
at trial of patent action, 191.
PROCEEDINGS, before law officer, 118.
PROCESS—
described must produce result described, 69.
different, to produce same result not infringement, 131.
interrogatory as to, 155.
more than one, available to defendant, injunction, 197.
new, for old result patentable, 18.
omission of step in, patentable, 18.
patent, sale of substance suitable for use in, effect of, 136.
patented, used in production of article abroad, 135.
patents covering every known, injunction in, 197.
sale of result of, may defeat patent for, 23.
PRODUCTION, of specification of abandoned application in Court, 51.
PROFESSIONAL assistance, in patent matters, 123.
PROFITS—
account of, may be better than damages, 200, 201.

PROFITS—
how ascertained in various cases, 201.
costs of taking account of, 200, 201.
or damages are alternative forms of relief, 198.
disclosure where account of chosen, 201.
found due are not damages, 202.
recoverable, are provable in bankruptcy, 202.
PROHIBITION, does not lie against law officer, 118.
PROMOTER, licence to, effect of, 106.
PROMOTION of company, form of agreement for, 313.
PROOF of documents registered at the Patent Office, 189
PROTECTION, by acceptance of complete specification, effect of, 51.
PROVISIONAL—
protection, what is, 50.
specification. See "Specification".
of abandoned application not published, 51.
production of, in Court, 51.
requirements of, 60.
PROVISIONALLY protected article may not be termed patent, 51.
PUBLIC—
authority, action against, discontinued, terms imposed, 209.
body, account of profits not ordered against, 201.
entitled to full disclosure of invention, 66.
fast or thanksgiving day is excluded day, 253.
good, grant contrary to, position of, 97.
patent must be for, 96.
knowledge sometimes is not anticipation, 26.
what may be assumed, 67.
evidence of, required in opposition on patent, 81.
when evidence of, allowable by licencee, 149.
no particulars of, required, 182.
how proved, 182.
to be regarded, 17.
what is, 182.
protection of, on extension, 225.
reasonable requirements of, discussion of term, 237.
must be satisfied, 96, 234.
what are, 235.
register of patents open to, 232.
PUBLICATION(S)—
anticipating, should be examined by experts, 192.
used merely in evidence, not objections, 181.
of reports of examiners, none, 54.
at industrial exhibition, when privileged, 27.
notice of intended reference to, on opposition, 83.
of Patent Office, 6.
how obtainable, 255.
provisions as to, 5.
where to be seen, 255.
prior, of invention, effect of, 21.
how proved, 26, 181.
how put in issue, 181.
by specification fifty years old, 27.
what is, 24.
of specification of abandoned application, none, 51.
damages recoverable from, 138.
of time for hearing licence petition, 243.
PURCHASER(S)—
actions against, procedure in respect of, 157.
not relieved by damages against manufacturer, 199.
defendant must disclose names of, 201.
indemnified, action against, procedure in, 141.
of cheap infringement may not be liable, 200.
of infringing article, how liable, 141.
may be liable as infringer, 134.
of licensed machine, position of, 134.
motion against, when dismissed, 144, 145.
of patented article, position of, 92.
position of, where action against vendor discontinued, 209.
of patents, requirements of, 126.
of share of patent may apply to rectify register, 233.
warnings to, 166.

R.

RECITALS in patent and their effect, 9.
RECTIFICATION—
of register how obtained, 233.
how entered, 231.
not obtainable by counterclaim, 233.

RECTIFICATION—
powers of Court in proceedings for, 233.
proceedings, costs of, 233.
registration of order for, 233.
REDISCOVERY may be invention, 38.
REFEREE may be appointed by Court, 190.
REFUSAL—
of acceptance, appeal from, 49.
procedure in, 118.
REGISTER—
of patents. See "Patents".
falsification of, penalty for, 227.
agents, 124, 228.
penalties in connection with, 233.
rectification of, how registered, 231.
REGISTRAR, of Privy Council, position of, in licence proceedings, 244.
REGISTRATION—
of assignment necessary, 90.
of patents, 230.
of design of patent article, 99.
of licences, 107.
priority of, how affected by equity, 230.
of order for rectification, 231.
revocation, 231.
of revocation stayed pending amendment, 111, 164.
of transmission, how obtained, 230.
REMUNERATION of inventor inadequate, procedure, 212.
RENEWAL fee, application for certificate of payment, 275.
REPAIR may be infringement, 133.
REPORTS of comptroller, 254.
of examiners not published, 54.
REPRESENTATIONS of applicant for patent, 9.
REPUDIATION of licence, time for, 150.
RESPONDENT on appeal to law officer, not appearing, 120.
REVOCATION—
of licence, 104.
of patent, 158.
obtained by fraud, 159.
grounds for, 159.
how carried out, 164.
effect of, on licence, 103.
on petition for licence, 234.
form for petition for, as alternative to licence, 239.
in lieu of licence, form of application for, 273.
opposition to, form of, 274.
of patent by Privy Council, 97.
registration of, 231.
REVOCATION—
registration of, stayed pending amendment, 164.
petition for, amendment of patent during, 163.
amendment pending, limited to disclaimer, 111.
amendment after judgment in, 111, 164.
second amendment pending, 164.
amendment pending, terms of, 112.
amendment while pending, 110.
commenced after amendment proceedings, 165.
discontinued after amendment, costs of, 163.
assessor may be demanded on hearing of, 190.
asses or in, how paid, 190.
not *inter partes*, 161.
triable at assizes, 163, 184.
fiat for, how granted, 161.
directions in, 162.
foreign respondent, 161.
interlocutory proceedings in, 163.
interrogatories in, 163.
issues in, 184.
judgment on, 164.
may be tried with jury, 163.
order in, stayed pending amendment, 111, 163.
order in, registration stayed for appeal, 164.
particulars of objection in, 161.
patent agent cannot conduct, 125.
procedure on, 161.
cannot be served out of jurisdiction, 161.
service of, 161.
none for war patent, 251, 252.
who may present, 159.
unopposed, procedure on, 162.
RIVAL inventors, position of, 37.
ROYALTY(IES)—
effect of declaration of invalidity on, 103.
how affected by revocation, 103.
not reserved, effect of, 107.
from assignee, effect of receiving, 106.
RULES—
as to appeals to law officer, how made, 122.
for construction of specification, 186.
for procedure on extension petition, 214.

RULES—
for extension petition, waiver of compliance with, 217.
for licence proceedings before Privy Council, 241.
waiver of compliance with, 244.
of procedure at Patent Office, how made, 5.
to be laid before Parliament, 5.
at present in force, 6.

S.

SALE—
branch, of Patent Office, 6.
contract for, not an infringement, 135.
after expiration of patent, of infringing goods, restrained, 133.
at home of export goods may be infringement, 134.
of patent, usual requirements of purchaser on, 126.
under distress, of licensed machine, effect of, 134.
of patent for district, 90.
usual terms of, 91.
no implied warranty of validity on, 91.
article may be conditional, 92.
effect of, 92.
prior, by inventor defeats patent, 23.
for a royalty, effect of, 107.
of copies of specifications, 55.
of substance suitable for infringing process, possible effect of, 136.
SAMPLES, plaintiff may be ordered to give, 154.
SATURDAY is an excluded day, 52, 252.
SCOTCH order, registration of, 231.
SCOTLAND—
copies of documents for use in, 255.
procedure for hearing patent action in, 190.
revocation of patent in, 158.
summary proceedings in, 228.
SEAL of Patent Office, 5.
SEALING—
no action before, 56.
of duplicate patent, 56.
fee on, 55.
time for and extension thereof, 55.
not extended for collusive opposition, 86.
usual time for, 56.
SEARCHES—
advisability of, 124.
official value of, 126.
by Patent Office, what made, 46.
SECRET process alleged by defendant, procedure when, 153.
SECRETARY of company, duty of, as to interrogatories, 155.
SEQUESTRATION, for enforcing injunction against company, 197.
SERVANT—
assisting inventor, position of, 36.
confidential, may be trustee of invention, 38.
when committed for breach of injunction, 197.
when entitled to patent, 36.
SERVICE—
address for, must be given by applicant, 41.
of caveator on licence, 242.
of notice of licence petition, 241.
hearing of licence petition, 241.
of objections to compulsory licence, 243.
of petition for revocation, 161.
SHAPE, introduction of new, patentable, 20.
SHIPS, foreign, use of invention in, 96.
SHORTHAND NOTES—
costs of, 210.
the use of, 194.
SOLICITOR—
who may conduct licence proceedings as, 243.
not usually employed in Patent Office proceedings, 125.
SPECIFICATION—
complete, effect of acceptance of, 51.
use of word patent, acceptance of, 54, 227.
amendment of, before acceptance, 53.
acceptance of, how published, 54.
accepted is ground of opposition, 79.
must end with claim of invention, 71.
form for, 266.
settling draft of, 126.
applicant dying before filing, procedure, 56.
may embody improvements, 51.
when open for inspection by public, 54.
fee for inspection of, 54.
how and when filed, 52.
preparation of, for filing, 52.
stamp on, 52.
how signed, 52.

SPECIFICATION—
complete, licence may be granted before filing, 102.
more than one filed, 53.
requirements of, 62, 65.
may embody improvements, 63.
may show different means for carrying out, 63.
must describe same invention, 63.
may narrow invention, 65.
may not enlarge invention, 63.
object of, 67.
need of professional assistance for, 123.
extension of time for filing, 52.
referred to examiner, 53.
signed by some of applicants, 53.
stamp on, 42.
form of application for extension of time for acceptance of, 287.
for leaving, 286.
publication of, action relates back to, 138.
abridgments of, 5.
to whom addressed, 66.
ambiguous, how dealt with, 186.
issue of, how raised and proved, 179.
amended, how prepared and filed, 116.
replaces old completely, 117.
amendment of, 109.
how applied for, 113.
form of application for, 270.
opposition to, form for, 271.
pending petition, 163.
bad by amendment, how issue raised, 180.
anticipation must be equivalent to, 25, 26.
by, fifty years old, 27.
by, how raised and proved, 181.
what is benevolent construction of, 187.
clerical error in correction of, 109.
errors in, effect of, 70.
comparison with previous, 46.
descriptions of, 58.
convention application when open to inspection, 249.
concealing knowledge, issue of, how raised, 180.
conformity of, a matter of law, 189.
construction of, 128.
affected by anticipation, 188.
SPECIFICATION—
evidence on construction of, on motion to commit, 198.
construction of, how dealt with by Court, 185.
forms precedent, 185.
rules for construction of, 186.
copies of, how obtainable, 55.
to accompany licence petition, 242.
may disclaim what is old, 73.
disconformity of, how raised, 179.
a question of law, 180.
distribution of, 255.
drawings accompanying, how prepared, 43.
experts should study, 192.
foreign, to accompany convention application, 248.
the test for infringement, 132, 133.
how signed, 43.
insufficiency of, evidence on, 193.
how put in issue, 179.
sufficiency of, how tested, 67.
interpretation of, questionable by licencee, 149.
invention must be ascertained from, 132, 133.
what knowledge it may assume, 67.
not evidence of public knowledge, 182.
old, when not available as anticipation, 181.
must not be ambiguous or misleading, 68.
require experiments, 69.
be equivocal, 69.
should not have redundant claims, 74.
instructions for ordering, 255.
preparation of, for filing, 42.
must be in English, 43.
paper for, 43.
postal request for copy of, 267.
prior, licencee may not refer to, 188.
procedure on discovery of prior, 47.
when printed, 55.
how proved in Court, 192.
any one may sign, as agent, 228.
statutory requirements of, 42.
title of, 58.
for warlike inventions, provisions as to, 251.
what, must accompany application, 42.

SPECIFICATION—
provisional effect of acceptance of, 50.
drawings with, how used, 42.
form for, 265.
need of professional assistance for, 123.
requirements of, 60.
STAMP—
on complete specification, 42, 52.
on contract for sale of licence, 106.
on licence, 101.
STATEMENT(S)—
of claim on amended specification, form of, 117.
should allege certificate of validity, 205.
description of plaintiff in, 138.
must not claim fresh kind of relief, 146.
for infringement, form of, 146.
in threats action, 173.
STATUTORY—
declarations, form of, for Patent Office, 81.
requirements of specifications, 42.
STUDY of books, invention by, 35, 36.
SUBJECT MATTER—
for patents, 14.
adaptive skill is not, 14.
discovery is not, 14.
principle is not, 15.
what is and what is not, 14.
form of objection as to, 178.
issue of, how raised, 182.
SUBORDINATE INTEGERS—
claim for, 74.
what is, 18.
SUBSTITUTION—
of equivalent, in combination may not infringe, 130.
infringement by, 130.
SUFFICIENCY—
of specification, evidence on, 193.
instructions issued by patentee relevant on, 193.
of specification, how tested, 67.
SUGGESTION of invention by another, 35.
SUNDAY is an excluded day, 252.
SURPRISE, in course of trial, procedure in case of, 191.
SURVIVORSHIP—
from joint tenancy of a corporation, 32.
between joint patentees, 31.

T.

THIRD party procedure in action against purchaser, 141.
THREAT(S)—
notice of a pending infringement action is not a, 175.
what is a, 168.
action for. See "Action".
statutory, 168.
action to support, discontinuance of 172.
need not be successful, 172.
test patent, 171.
in lieu of action, 167.
on threatened infringement, 128.
damage recoverable for, 174.
general warning may be, 168.
by agents, particulars of agents required, 173.
effect of, on trade rivals, 167.
injunction may be granted against, 168.
for preventing infringements, 94.
limitation of, 168.
particulars of, must be given, 173.
pending action to support, allowable, 172.
qualification for issuing, 168.
may be restrained pending amendment, 111.
reason for not permitting unlimited, 167.
summary of law as to, 173.
supported by action against licencee, 171.
the use of, 166.
undertaking not to issue, no bar to infringement action, 175.
does not prevent notice of a pending infringement action, 175.
TIME—
for acceptance, enlargement of, 54.
limit of, 56.
effect of extension of, on sealing, 56.
form of application for extension of, 287.
for accounts on extension, not extended, 221.
for amendment before acceptance, 54.
for appeal to law officer, 118.
for application under international convention, 248.
for lodging extension petition, extension of, 217.
caveat against compulsory licence, 242.

TIME—
for caveat not extended, 218.
for completing application, 52.
for complete specification, enlargement of form, 286.
what days not to be reckoned, 252.
enlargement of, for any purpose, 254.
for evidence in oppositions, 82.
for hearing licence petition, how fixed, 241.
extension of, 242.
for hearing petition for extension, how fixed, 215.
for inspection of register of patents, 232.
for lodging documents in extension petition, 216.
objections to extension, 216.
notice of objections to licence petition, 243.
for opposition to compulsory licence, 240.
to grant of patent, 55.
for petitioning for extension of patent, 213, 215.
for payment of renewal fees, 88.
extension of, 88.
form of application for, 276.
usual, for sealing patent, 56.
The Times, time for hearing licence petition to be published in, 243.
TITLE—
of patent, how amended, 48.
choice of, 58.
importance of, 58.
improper, may make patent bad 59.
requirements of, 58.
of patentee, proof of, at trial, 191.
TRADE MARK, improper use of word patent in, effect of, 227.
TRANSMISSION of patent, registration of, 230.
TRAP, patentee must not lay, 136.
TRIAL—
with assessor, provisions as to, 190.
of issues in patent action, 193.
with jury in threats action, 191.
of patent action, procedure on, 184, 191.
of action, amendment of particulars during, 152.
costs of shorthand notes of, 194.
of petition for revocation, 162.
where fraud alleged, 163.
surprise in, course of procedure in case of, 191.
TRUST, notice of, not registrable, 230.

U.

UNDERTAKING—
as to costs, pending appeal to Lords, 210.
breach of, not to infringe evidence of public knowledge on, 198.
not to threaten does not bar infringement action, 175.
preferable to consent injunction, 195.
UNITED Kingdom, patent must be properly worked in, 235.
USE and exercise, licence to, 107.
USER—
by exhibition, an infringement, 135.
infringement may be by user alone, 133.
of invention for new purpose, an infringement, 133.
restrictions on, must be notified before sale, 92.
right of, how limited, 134.
experimental prior, does not defeat patent, 22.
general prior, interrogatories as to, 182.
particulars of, 182.
prior, of invention, effect of, 21.
what is, 22.
evidence of, may be taken first, 193.
how put in issue, 182.
UTILITY—
essential for patentability, 29.
meaning of, 29.
no relation to commercial success, 29.
a question of fact, 29.
how put in issue, 179.
in issue, inspection required, 154.
plaintiff may be interrogated as to user, 155.
necessary for extension, 223.
proof of, 193.
false suggestion as to effect of, 70, 180.

V.

VALIDITY—
certificate of, provisions as to, 203.
actions affected by, 205.
effect of, on costs, 205.
Court will not go behind, 204.
costs of issues where plaintiff fails, 205.

VALIDITY—
certificate of, best ground for interim injunction, 145.
no appeal from refusal of, 204.
where validity not determined, 204.
may be given after expiration of patent, 204.
does not affect pending action, 205.
when given on bad patent, 204.
where plaintiff deprived of full costs, 205.
should be set out in statement of claim, 206.
not granted in threats action, 175.
value of, 204.
when given, 204.
not disputable by assignor, 149.
counsel's opinion on, usually required on sale of patent, 126.
how determined as against Crown, 95.
when defendant stopped from disputing, 149.
assumed for extension, 222.
decision as to, where infringement not proved, 193.
disputed, when no interim injunction, 143.
of patent, for more than one invention, 48.
when considered on petition for extension, 222.
licencee covenants as to, 105.
sued cannot dispute, 104, 148.
may be disputed by partner of assignor, 150.
not investigated by Patent Office, 40.
may be *res judicata*, 149.
of patent, test of, 2.
no implied warranty of, on sale of patent, 91.
of patent worked only abroad questionable, 96, etc.
VARIATION from invention described may infringe, 130.
VIEW pending appeal allowable, 211.

W.

WAR—
invention relating to, provisions as to, 251.
invention, not published by communication to War Department, 252.
patent, not published, 252.
when irrevocable, 158, 252.
WARNING, general, may be threat, 168.
WARRANTY—
none implied on grant of licence, 104.
of validity, on sale of patent, 91.
WITNESS(ES)—
on appeal to Law Officer, costs of, 121.
attendance of, before Law Officer, how obtained, 121.
expert, cost of, reduced by having assessor, 190.
on petition for extension, 217.
on licence petition, 245.
experiments by, 192.
disclosure of result of experiments by, 192.
should examine models, etc., 192.
preparation of, for trial, 192.
usually necessary, 192.
patentee's, cross-examination of, 191.
present on appeal, costs of, 211.
as to sufficiency of specification, 193.
trade, for proof of general knowledge, 192.
as to utility, 193.
WORKMAN inventing to order, entitled to patent, 37.
WORKMEN—
may prove sufficiency of specification, 193.
what must understand specification, 66, 67.
WRIT in action for infringement, 139.

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