LAW AND PRACTICE

OF

PATENTS FOR INVENTIONS

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THE PATENTEE'S MANUAL

A TREATISE

ON THE

LAW AND PRACTICE OF PATENTS

FOR INVENTIONS

WITH AN APPENDIX OF

Statutes, Rules, and Foreign and Colonial Patent Laws

International Conbention and Protocol

BY

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PREFACE

TO

THE SIXTH EDITION

In preparing the Sixth Edition of this Work for the press, considerable changes have been made both by way of enlargement and in the arrangement of the matter. The provisions of three supplementary Acts of Parliament and of four new sets of official Rules, now consolidated with the previous Rules, have been noticed, whilst numerous decisions of the Courts during the last six years, many of which have an important bearing on the Law of Patents, have been cited. Several chapters have been divided with a view to a fuller and more convenient treatment of the subjects, and additional chapters on other branches of the law have been introduced. Every page has undergone careful revision, and no pains have been spared to render the treatise one that patentees and inventors may consult with confidence as a trustworthy exposition of that branch of law with which their interests are most closely concerned. It may be added, that although the treatise was originally written especially for their use, the authors venture to think that in its enlarged form it may deserve the notice of the legal profession, since the large experience of one of them in obtaining Patents, and in the conduct of litigation arising out of Patents for forty years, has been turned to account in the production of the volume.

Reprints are given of all the Acts of Parliament which have any direct bearing on the subject of this work; as well as of the Rules and Forms issued by the Board of Trade under the authority of the Acts, of the Rules framed by the Law Officers in regard to proceedings before them, and of the Rules of the Privy Council with respect to applications for the extensions of Patents.

Great additions to and alterations in the Patent Laws of Foreign States and British Colonies have been made of recent years. The Appendix contains summaries of the whole of these laws to date, revised by professional correspondents.

The Appendix also contains a reprint of the International Convention and Protocol relating to arrangements for the mutual protection of industrial property including Patents. To this Convention Great Britain gave her adhesion, and a chapter has therefore been devoted to the subject in the body of the treatise.

A copy of the Rules lately issued by the Board of Trade in relation to applications for Patents under this Convention will also be found in the Appendix.

The copious Index will be found of material assistance by those readers who are in search of any particular topic.

The following summary of the alterations effected by the recent Acts of Parliament may be given here, *memoriæ causâ*:—

The Act of 1883 abolished the Commissioners of Patents, who were replaced by the Board of Trade as the governing body of the Patent Office. The Comptroller-General is the chief officer of the Board, and upon him devolves the charge of managing the business and superintending the work of the office. The Board was authorised to make rules, having the same effect as if forming part of the Act, for regulating

the conduct of Patent business; and it has accordingly promulgated a long series of rules for that purpose accompanied by forms.

The chief alterations in the procedure were:—1. Non-inventors may join with inventors in applying for a Patent. 2. The applications and specifications are referred to official examiners, who report whether the documents are in proper form; if they are not in proper form, the Comptroller may reject them or require them to be amended before acceptance, subject to appeal to a Law Officer. 3. Oppositions to the grant of Patents are decided by the Comptroller, subject to appeal to a Law Officer. 4. The steps necessary to be taken for obtaining a Patent are fewer. 5. Applications and other documents may be sent to the Patent Office through the post-office. 6. Patents are sealed by the Comptroller with the seal of the Patent Office. 7. The Government fees are reduced from 25*l.* for a three years' Patent to 4*l.* for a four years' Patent, and the remaining fees of 50*l.* and 100*l.* are payable in small annual sums. 8. Applications for leave to amend specifications are decided in the first instance by the Comptroller and on appeal by a Law Officer. 9. A new mode of obtaining the repeal of invalid Patents is substituted for the old proceeding of *scire facias*.

Whilst the procedure underwent great alterations, the substantive law was but little touched. The old decisions of the Courts regarding the subject-matter of patentable inventions; the incidents of utility and novelty which every patentable invention must possess; the contents of specifications and the infringement of Patents still remain applicable to Patents issued under the late Act. The duration of a Patent is the same as before the Act, and its extent is practically the same, being only smaller by the omission of the Channel Islands. The principal changes to be noticed are:—1. The Board of Trade was empowered to order

patentees to grant licences if they make default in granting them on reasonable terms. 2. The right of the Crown to use patented inventions without making compensation was abolished. 3. A Patent may be assigned for any place in or part of the United Kingdom. 4. A British Patent no longer comes to an end at the expiration of any earlier foreign Patent for the same invention.

The three supplementary Acts have made a few alterations in the details of procedure, and cleared away some doubts as to the meaning of certain provisions in the master act. And by the latest of those Acts a Register of Patent Agents has been established, which has been committed to the charge of the Institute of Patent Agents.

To recapitulate in brief the changes effected by recent legislation: The provisions of many earlier statutes were consolidated and amended; several features hitherto unknown in our system were introduced; the procedure was simplified; the fees payable to Government on applications for Patents were reduced, and greater facilities for the payment of the subsequent fees were afforded.

It was hoped that by these changes the inventive talent of the nation would be stimulated into more vigorous action, and that hope has not been disappointed, as a glance at the statistics furnished by the Comptroller in his reports will clearly prove. The average annual number of Patents sealed in the four years prior and in the four years subsequent to the coming into operation of the Act of 1883 were 3,928 and 9,314 respectively. The annual number of applications for Patents during the first four years of the new system was on the average 17,108, but no fewer than 7,792 of them, that is, about 45 per cent., were annually abandoned or otherwise came to naught. The number of applications increases at the rate of about a thousand a year.

47 Lincoln's Inn Fields, London:
May 1890.

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C. B.	Common Bench Reports
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C. & K.	Carrington & Kirwan's Reports
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THE LAW

OF

PATENTS FOR INVENTIONS.

CHAPTER I.

PRELIMINARY.

That the Crown has the power in certain cases of granting to inventors the privilege of a monopoly in working their inventions for a certain number of years is probably known to every reader before he opens this volume. During that period the entire community is precluded from making use of the invention, except by the permission of the inventor or the person who has duly succeeded to his rights; the law declaring that the privileged person shall derive the exclusive benefit, whatever that may be, of the invention for the specified time.

This privilege was formerly secured to the inventor by letters patent passed under the Great Seal. It is now secured to him by a patent obtained at the Patent Office, and the person to whom the privilege is granted is termed in common parlance the patentee.

For the purposes of the present treatise, there is no need that we should enter upon any historical disquisition as to the common-law right of the Crown in matters of patent privileges. It will be sufficient to state that the right of the Crown to grant privileges by letters patent to subjects obtaining its favour was exercised in very early times, and it was only disputed when exclusive rights to sell various

commodities, such as salt, iron, and coal, had been granted to certain persons, to the great grievance of their fellow-subjects, and to the oppression of trade. The Statute of Monopolies, passed in the twenty-first year of James I., was levelled at the abuses which an undue exercise of prerogative had produced, and being, says Sir Edward Coke, forcibly and vehemently penned for their suppression, cut off all claim on the part of the Crown to the right of granting monopolies and exclusive privileges, whereby the subjects of the realm could be aggrieved and inconvenienced.[1]

That statute (*see the Appendix*) declared that all monopolies, grants, and letters patent, for the sole buying, selling, making, working, or using of anything within the realm, were contrary to the laws, and void. But it excepted from the operation of this enactment all letters patent and grants of privilege of the *sole working or making of any manner of new manufactures to the true and first inventor of such manufacture, which others at the time of making such letters patent*

[1] 'The King had undoubtedly, by the ancient laws of the realm, large powers for the regulation of trade; but the ablest judges would have found it difficult to say what was the precise extent of those powers. . . . In addition to his undoubted right to grant special commercial privileges to particular places, he long claimed a right to grant special commercial privileges to particular societies and to particular individuals; and our ancestors, as usual, did not think it worth their while to dispute this claim till it produced serious inconvenience. At length, in the reign of Queen Elizabeth, the power of creating monopolies began to be grossly abused; and as soon as it began to be grossly abused, it began to be questioned. The Queen wisely declined a conflict with the House of Commons backed by the whole nation. She frankly acknowledged that there was reason for complaint; she cancelled the patents which had excited the public clamours; and her people, delighted by this concession, and by the gracious manner in which it had been made, did not require from her an express renunciation of the disputed prerogative. The discontents which her wisdom had appeased were revived by the dishonest and pusillanimous policy of her successor, called Kingcraft. He readily granted oppressive patents of monopoly. When he needed the help of his Parliament, he as readily annulled them; and as soon as the Parliament had ceased to sit, his Great Seal was put to instruments more odious than those he had recently cancelled. At length that excellent House of Commons which met in 1623 determined to apply a strong remedy to the evil. The King was forced to give his assent to a law which declared monopolies established by royal authority to be null and void.' (Macaulay's 'History of England,' iv. 127.)

and grants should not use, so they be not contrary to law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient. It was afterwards declared that these excepted grants of privilege should have the same validity that they had previous to the passing of the statute, but no other. 'It is to be observed' (said *Lord Justice James* in the case of *Von Heyden* v. *Neustadt*, 50 L. J. N. S. Ch. 126) 'that the statute of James gives no right to the inventor. The statute is a statute for the abolishing and forbidding monopolies, and the sixth section, under which the Crown acts in these matters, is a mere proviso excepting from the operation of that Act certain patents or grants of privileges, which are to be "of such force as they should be if that Act had never been made, and of none other." And it is from the ancient power and prerogative of the Crown so saved and preserved that every patentee derives his monopoly. What the Crown could lawfully do, and has lawfully done, after that statute, is shown by the uniform tenor of the letters patent which have been since issued, by the advice and authority of every law officer and every holder of the Great Seal for upwards of two centuries and a half. The power of the Crown to grant letters patent of such tenor has never been brought in question.'

When the validity of a monopoly comes into question, the first point to consider is, whether it is rendered void by the statute; and secondly, if it should not be thereby avoided, whether it is a privilege permitted by the common law.

In this treatise, however, we restrict ourselves to a consideration of Patents for inventions. It is not every kind of discovery that can be protected by a patent. The statute of James I. requires a patentable invention to be referable to some *manner of manufacture*, as these words have been interpreted by the courts of law.

Nor is it every one who may succeed in obtaining the grant of a patent for an invention that is able to sustain it

under strict legal scrutiny. In order that a patent should be held valid in a court of law :

1. *The Invention* must possess a certain amount of utility; must display some degree of novelty; and must have been attained by the exercise of some measure of ingenuity.

2. *The Patentee* must be the true and first inventor, that is, he must not have obtained the invention from another person (unless he has imported it from abroad); nor must he have derived it from a printed book; nor from a patent specification published in this country or introduced from abroad.

3. *The Specification*, that is the patentee's formal description of his invention, must be accurate, intelligible, and sufficient; it must point out distinctly what the patentee claims as his own; and must not claim anything that is not his own.

Besides treating of these subjects, the procedure in applications for patents will be explained in this volume. The Patent itself, its form, intent, and duration, and the dealings with it by way of Assignment and Licence, will be expounded. Various contentious matters, such as oppositions to grants, the infringement of patent rights, the revocation of patents, and the proceedings taken to restrain a patentee's threats will be dealt with. Certain collateral topics, such as the amendment of specifications, the registration of patents and of documents relating thereto, and the international and colonial arrangements for the reciprocal issue of patents, will be handled. A brief account of the Patent Office establishment, where the business of obtaining patents is transacted, will be given; and lastly, a short chapter on the Institute of Patent Agents will be found at the end of the treatise.

CHAPTER II.

THE SUBJECT-MATTER OR NATURE OF A PATENTABLE INVENTION—A BARE PRINCIPLE NOT PATENTABLE—PROCESSES—CHIEF CLASSES OF PATENTABLE INVENTIONS.

In proceeding to consider the subject-matter or nature of the inventions which may be legally protected by patents, it is proper to premise that no general definition can be given which shall exactly mark out what can and what cannot be included in a valid patent. Where the invention is not one of a well-known class, it will be much better for the inventor to consult some one conversant with such matters —some one whose practical experience comes in aid of general principles, and who is bound by his profession and standing in society to the utmost secrecy—than to rely altogether upon what is stated in books, or upon a narrow range of precedent. It is the more important that the inventor's attention should be drawn to this point previous to his incurring expense, since a patent is taken out entirely at the risk of the inventor, the Crown in no degree guaranteeing the validity of its grant, which, if contested, will be judged by the abstract rules of law applicable to the case.

As we have already remarked, it is not every kind of discovery which can be protected by a patent. No invention is patentable which does not fall within the language of the Act of King James, and is not referable to some 'manner of new manufactures.' It is true, as we shall see further on, that these words have received a very wide interpretation; still they have never been held to include such inventions and discoveries as that of an abstract principle without reference to any of its practical applications; or that of a game of skill or chance irrespective of the

appliances for playing it; or that of a method of calculation unconnected with apparatus for working it; or that of a vegetable suitable for food; or that of a natural substance applicable to a useful purpose, such as guano or mineral phosphate of lime; or that of an elementary body such as a metal. Patents which relate to inventions and discoveries such as these can only be maintained when they are taken out for the manufacture of the apparatus required for the given purpose, or for methods of preparing the natural substance for some useful end.

Before giving examples of the chief classes into which those inventions which have received the sanction of judicial decision are divisible, it may be well first to clear the ground a little by making some remarks on the cases relating to Principles and Processes.

It has been repeatedly laid down by the Courts that

BARE PRINCIPLES ARE NOT PATENTABLE.

A principle may be of the utmost value in the eyes of philosophers; its discovery may lead to highly important consequences, and form the germ of a striking advance in civilisation; yet unless its discoverer can show at least one application of it to a useful purpose—unless he can point out the means of gaining therefrom some immediate material advantage—he is not permitted to exclude his fellow-subjects from turning it to any account they like. 'I rather think it would be difficult' (said *Lord Kenyon*, in *Hornblower* v. *Boulton*, 8 T. R. 95; Dav. Pat. Ca. 221) 'to form a specification of a philosophical principle; it would be something like an idea without a substratum.'

Neither are principles in a more restricted sense patentable, unless they are embodied in a concrete form and their application to some purpose of utility indicated. 'You cannot' (said *Alderson, B.*, in *Jupe* v. *Pratt*, 1 W. P. C. 145) 'take out a patent for a principle. You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying

it into effect. But then you must start with having invented some mode of carrying the principle into effect.' 'Undoubtedly' (said *Eyre, C. J.*, in *Boulton* v. *Bull*, 2 H. Bl. 463) 'there can be no patent for a mere principle; but for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent. . . . It is not' (referring to the case before him) 'that the patentee has conceived an *abstract* notion that the consumption of steam in fire-engines may be lessened, but he has discovered a practical manner of doing it, and for that practical manner of doing it he has taken his patent. Surely this is a very different thing from taking a patent for a principle; it is not for a principle, but for a process. Again, the substance of the invention is a discovery that the condensing the steam out of the cylinder, and protecting the cylinder from the external air, and keeping it hot to the degree of steam-heat, will lessen the consumption of steam. This is no abstract principle; it is in its very statement clothed with practical application.'

In the much-debated case of *Neilson* v. *Harford* (1 W. P. C. 295) a great deal was said as to the point now before us. Neilson took out his patent in 1828 for the improved application of air to produce heat in furnaces, and in his specification declared that his invention consisted in passing a blast of air from the blowing-apparatus into an air-vessel kept heated to a red-heat, or nearly so, and from that vessel, by means of a pipe, into the furnace; that the size of the vessel must depend on the blast, and on the heat necessary to be produced, but that the form of the vessel was immaterial to the effect, and might be adapted to the local circumstances or situation. The defendants, who were alleged to have infringed this patent, contended that it was void, as being for a principle. The Court of Exchequer, after full consideration, thought that the plaintiff did not merely claim a principle, but a machine embodying a principle. The case must be considered as if the principle being well

known, the plaintiff had first invented a mode of applying it by a mechanical apparatus to furnaces; and the invention then consisted in this—the application of air heated up to red-heat, or nearly so, and the interposition of a receptacle for heating air between the blowing-apparatus and the furnace. And *Mr. Baron Alderson*, in reply to the argument of the plaintiff's counsel that he claimed every vessel and every shape of closed vessel in which air could be heated between the blowing-apparatus and the furnace, said, 'Then I think that is a principle, if you claim every shape. If you claim a specific shape, and go to the jury and say that which the other people have adopted is a colourable imitation, then I can understand it. If you claim every shape, you claim a principle. There is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself. You must detail some specific mode of doing it.' (See L. J. Lindley's approving remarks on this dictum. *Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 308.)

In the same case (1 W. P. C. 342) *Alderson, B.*, said, 'I take it that the distinction between a patent for a principle and a patent which can be supported is, that you must have an embodiment of the principle in some practical mode, described in the specification, of carrying the principle into actual effect; and then you take out your patent, not for the principle, but for the mode of carrying the principle into effect. In Watt's patent, which comes the nearest to the present of any you can suggest, the real invention of Watt was, that he discovered that by condensing steam in a separate vessel, a great saving of fuel would be effected by keeping the steam-cylinder as hot as possible, and applying the cooling process to the separate vessel, and keeping it as cool as possible; whereas before, the steam was condensed in the same vessel; but then Mr. Watt carried that practically into effect by describing a mode which would effect the object.'

The words of *Lord Justice Clerk Hope*, in the case of the *Houschill Company* v. *Neilson* (1 W. P. C. 683), may be cited in reference to the same point. 'A patent cannot be

taken out solely for an abstract philosophical principle—for instance, for any law of nature or any property of matter, apart from any mode of turning it to account in the practical operations of manufacture, or the business, and arts, and utilities of life. The mere discovery of such a principle is not an invention in the patent-law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object and end, and without the application of it to human industry or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself. But a patent will be good, though the subject of the patent consists in the discovery of a great general and most comprehensive principle in science 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. . . . It is no longer an abstract principle. It comes to be a principle turned to account to a practical object, and applied to a special result. It becomes then not an abstract principle, which means a principle considered apart from any special purpose or practical observation, but the discovery and statement of a principle for a special purpose, that is, a practical invention, a mode of carrying a principle into effect. . . . The instant that the principle, although discovered for the first time, is stated in actual application to, and as the agent of, producing a certain specified effect, it is no longer an abstract principle; it is then clothed with the language of practical application, and receives the impress of tangible direction to the actual business of life.'

Minter's patent was for an improvement in the construction of chairs, which consisted in the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acted as a counter-balance to the pressure against the back. The patentee having obtained a verdict at the trial of an action for the infringe-

ment of the patent, it was contended, on a motion for a nonsuit, that the patentee had claimed a *principle*, and not any particular means of carrying the principle into effect. Now, to a principle *per se* he was not entitled; and as to the particular means adopted, the defendant had not borrowed it. The plaintiff, it was further argued, had attempted to appropriate by his specification one of the first principles in mechanics, viz. the lever. 'But,' said *Lord Lyndhurst, C. B.*, 'it is not a leverage only, but it is a self-adjusting leverage; and it is not a self-adjusting leverage only, but it is a self-adjusting leverage producing a particular effect, by means of which the weight on the seat counterbalances the pressure on the back of a chair.' And *Parke, B.*, said, 'For the application of a self-adjusting leverage to a chair, cannot he patent that? He claims the combination of the two, no matter in what shape or way you combine them; but if you combine the self-adjusting leverage, which he thus applies to the subject of a chair, that is an infringement of the patent.' *Lord Lyndhurst* went on to say that the application of a self-adjusting leverage producing the effect constituted the machine, and the patentee claimed that machine, and the right to make it, by the application of a self-adjusting leverage producing a particular effect. (*Minter* v. *Wells*, 1 W. P. C. 134.)

Again, *Sir W. P. Wood, V. C.*, said in *Dangerfield* v. *Jones* (13 L. T. N. S. 142), 'If, having 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 been before applied, that is a sufficient ground for taking out a patent, provided that the Court sees that which has been invented is new, desirable, and for the public benefit.'

In the case of the *Electric Telegraph Company* v. *Brett* (10 C. B. R. 838) it was argued that the giving of duplicate signals at intermediate stations was not the proper subject of a patent, being an idea or principle only, and not a new manufacture. But it was held by the Court, that as the patentees had not only communicated the idea or principle,

but showed how it might be carried into effect, viz. by appropriate apparatus at each station, the patent was valid.

See also the remarks upon this subject of *Sir G. Jessel, M.R.*, in the case of *Otto* v. *Linford* (46 L.T. N.S. 39, Goodeve Patent Cases, 343).

PROCESSES.

It will have been observed that what the statute of King James excepts from the operation of the invalidating first clause is the privilege of the *sole working or making of any manner of new manufactures.* Now it seems to have been at one time doubted whether a mere method or process was embraced by these words of the statute. *Perhaps*, said *Lord Tenterden, C. J.*, in the case of *Rex* v. *Wheeler* (2 B. & A. 350), the statute 'may extend to a new process to be carried on by known implements, or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind.' The current of decision since Lord Tenterden's time has converted what he put in a doubtful way into a certainty; for the books are full of cases which prove beyond a doubt that a process is patentable. The patent contested in *Gibson* v. *Brand* (1 W.P.C. 631) was for a new or improved process or manufacture of silk. *Tindal, C. J.*, said that there was strong reason to suppose that a patent for a process, in the strict or proper sense of the term, might be good in law. Such certainly was the opinion of *Chief Justice Eyre* in *Boulton* v. *Bull* (1 Carp. R. 146). 'It was admitted in the argument at the bar that the word "manufacture" in the statute was of extensive signification; that it applied not only to things made, but to the *practice of making*, to principles carried into practice in a new manner, to new results of principles carried into practice.'

It has been said that the doubt as to whether a process is patentable has been needlessly raised, and that it is a misuse of terms to speak of a patentable process at all. The subject-matter of the patent, it is urged, is in reality a *manufacture according to a new process*, and this is there-

fore a new manufacture. For example, in *Crane* v. *Price* (1 W. P. C. 377), the subject of the patent was, according to this view, the manufacture of iron by means of a new process, viz. the combination of a hot-air blast and anthracite in the furnace. In *Gibson* v. *Brand* it was the manufacture of silk by a new process.

We are told by *Sir F. Pollock, C. B.* (*Stevens* v. *Keating*, 2 W. P. C. 182), that 'the real invention may be, not so much the thing when produced, as the mode in which it is produced; and its novelty may consist, not so much in its existence as a new substance, as in its being an old substance, but produced by a different process. In one sense, an old substance produced by a new process is a new manufacture; of that there cannot be a doubt; and therefore, although the language of the Act has been said to apply only to manufactures and not to processes, when you come to examine, either literally, or even strictly, it appears to me the expression "manufacture" is free from objection, because, though an old thing, if made in a new way, the very making of it in a new way makes it a new manufacture. Therefore, although I think this is a patent for the process rather than the product, I think it may be a patent for the product.'

Allowing this explanation its full force, it will not extend to many cases wherein it has been decided that bare processes are patentable, or to cases where patents for mere applications have been supported. For example, in *Forsyth* v. *Riviere* (1 Carp. Rep. 401), the application of a known detonating powder to the discharge of known kinds of fire-arms was held to be a patentable invention. But how could this be a manufacture in the ordinary meaning of the word? Again, in the case of *Hartley's Patent* (1 W. P. C. 54), it was held that the application of metal plates, made in the ordinary way, to ships and buildings, with the view of protecting them against fire, by preventing the access of air, was a patentable invention. Again, in the case of the *Electric Telegraph Company* v. *Brett* (10 C. B. R. 838), a method of giving duplicate signals at

intermediate stations was held to be properly the subject of a patent. In none of these cases was any new substance produced, nor any new machinery employed. 'Most certainly the exposition of the statute, as far as usage will expound it, has gone very much beyond the letter' (*Eyre, C. J.*, in *Boulton* v. *Bull*, 1 Carp. R. 146); and *Lord Chief Justice Tindal's* remarks in *Cornish* v. *Keene* (1 W. P. C. 508) show the latitude of interpretation which is given to the word 'manufactures' in the Act of Parliament. 'It has a very wide and extended meaning. You may call it almost *invention*.' Again, *Coleridge, J.*, said, in *Bush* v. *Fox* (Macr. P. C. 176), manufacture includes both process and result. And in *Ralston* v. *Smith* (11 H. L. C. 223), *Lord Westbury* said, 'By the large interpretation given to the word "manufacture," 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.'

In *Newall* v. *Elliott* (13 W. R. 11) the patent was for 'improvements in apparatus employed in laying down submarine telegraph wires;' and the specification, after describing the apparatus, concluded with the following claim:—'First, coiling the wire or cable round a cone; secondly, the supports placed cylindrically outside the coil round the cone; thirdly, the use of the rings in combination with the cone as described.' It was objected that the invention thus claimed was merely a mode of coiling and paying out cables, and was not a new manufacture, and could not, therefore, be the subject-matter of a patent. The Court, however, over-ruled the objection, and held the patent valid.

Previous to the patent granted to Wallington, gelatine had been made by submitting large pieces of hide to the action of caustic alkali, and by employing blood to clarify the product. Wallington's process consisted in cutting the hides into thin slices, and the use of blood was unneces-

sary. This was held to be a patentable invention. (*Wallington* v. *Dale*, 7 Exch. Rep. 888.)

CLASSES OF PATENTABLE INVENTIONS.

The inventions for which valid patents have been granted may be roughly divided into the following classes :—

1. *New contrivances applied to new objects or purposes, and yielding new results.*

2. *New contrivances applied to old objects or purposes.*

3. *New combinations of old parts, or of old and new parts, the subject-matter consisting either of material objects or of mechanical processes.*

4. *New methods of applying an old thing.*

5. *Chemical processes, sometimes in combination with mechanical contrivances.*

The reader may like to have some illustrations of these classes of inventions, and we shall proceed to offer the following :—

1. *New contrivances applied to new objects or purposes.* Several modern inventions of great commercial or social importance would fall under this head. Amongst them are conspicuous—Apparatus to be worked by electricity for transmitting messages from place to place on land; wire cables for transmitting messages by the aid of electricity across the ocean; telephonic apparatus for transmitting words from the mouth of a speaker to the ear of a listener at a distance; the art of photography; the art of electro-plating. All these have been invented and made wonderful progress within the recollection of many persons now living.

2. *A new contrivance employed to effect a well-known object*—to make, for instance, an article previously made in a different way—is also patentable, provided that the new contrivance is attended with some degree of utility; for example, that it accomplishes the result more rapidly, efficiently, or cheaply than the old contrivance. 'There may be a valid patent' (said *Lord Eldon* in *Hill* v. *Thompson*, 1 W. P. C. 237) 'for a new combination of materials

previously in use for the same purpose, or for a new method of applying such materials.'

Again, where an invention effects a known purpose with new materials, it will be held a patentable process. Thus, Binney obtained a patent for the manufacture of packing for the joints of steam-engines. Feltmann afterwards obtained a patent for the same object, but he employed different materials for the packing stuff. The later patent was held to be good for a new process. (*Binney* v. *Feltmann*, 1 Griff, P. C. 50.)

A process by which a product is directly obtained when the old method of obtaining it was indirect may form the subject of a patent. Thus, it was held in *Booth* v. *Kennard* (1 H. & N. 527), that to obtain gas by the direct distillation of oleaginous seeds was a patentable invention, although gas had been previously obtained by the distillation of oil expressed from oleaginous seeds.

3. *A new combination of known parts or old processes* producing a new result, or producing an old result in a more economical manner or more perfect form, whereby articles cheaper or better than had ever before been produced are rendered accessible to the public, will be held a meritorious and patentable invention. It was held in *Crane* v. *Price* (1 W. P. C. 408) that the combination of the hot-air blast with stone coal in the smelting of iron (the hot-air blast and stone coal having been separately in use before, but the combination being previously unknown) was an invention intended by the statute, and such as might well become the subject of a patent. It was said by *Tindal, C. J.*, that there were numerous instances of patents where the invention consisted in no more than in the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public.

That the novel combination of old parts having a useful result may form the subject of a valid patent has been again and again decided. (*Lister* v. *Leather*, 8 E. and B.

1004; *Newall* v. *Elliott*, 10 Jur. N. S. 954; *S. C.* 13 W. R. 11; *Murray* v. *Clayton*, L. R. 7 C. 570; *Cannington* v. *Nuttall*, L. R. 5 H. L. 205; *Hayward* v. *Hamilton*, 1 Griffin P. C. 115.) 'If there be' (said *Lord Westbury* in *Spencer* v. *Jack*, 3 De G. J. & S. 346) 'a combination of several things previously well known, which combination is attended with such results of utility and advantage to the public that the combination itself is rightly denominated a substantial improvement, it is impossible to deny that that is the subject of a patent.' See further as to combinations in the chapter on the Complete Specification.

A new combination of processes may even consist of an old combination with the omission of one of the old processes, provided that some degree of invention has been manifested in arriving at the new combination or process. Thus in the case of *Russell* v. *Cowley* (1 W. P. C. 459) a patent had been obtained for an invention for manufacturing iron tubes, by welding them without the use of a mandrel, or internal support; and its validity being contested, it was held good. *Lord Lyndhurst* read the specification as claiming only the manufacture of tubes without a mandrel. By the new process, tubes could be made of greater length, of greater uniformity, and considerably cheaper, than before.

But the combinations for which patents are obtained frequently consist not only of old parts, but to some extent of new parts, which are themselves minor inventions and may be protected as such. If any one of the parts is new, it follows that the entire combination is new too.

The introduction into an old combination of a new shape of one of the old elements of that combination, which new shape invokes a physical law otherwise left on one side (*e.g.* employing a filament of carbon instead of a thick rod in an incandescent electrical lamp), is a good subject for a patent. (*Edison & Swan United Electric Light Co.* v. *Woodhouse* (first action), 4 R. P. C. 93.)

4. *A new mode of applying a known thing may be the subject of a patent, provided that some ingenuity, some novelty, is exhibited in the mode of making that application*, and that

the application is attended by some useful result. (See the section on Applications in Chapter V.) In Watt's patent for a new method of lessening the consumption of steam and fuel in steam-engines, the enclosing of the cylinder in a case of wood, or any other material that transmits heat slowly, was claimed, and allowed to be a patentable invention. (*Boulton* v. *Bull*, 2 H. Bl. 463, 1 Carp. 117.) In Forsyth's patent for a method of discharging fire-arms, the patentee claimed the use and application of certain known fulminating compounds for this purpose. It was contended that, since the properties of detonating powder were well known for other purposes, the using of such materials to discharge fire-arms was not a new manufacture for which a patent could be supported. But *Abbott, C. J.*, stated that if the invention (*i.e.* this particular application of detonating powder) were new, it was such a one as might be secured by patent. The jury having found the invention to be a new one, the patentee had a verdict. (*Forsyth* v. *Riviere*, 1 Carp. 404.)

Charcoal had been used in refining sugar previously to Derosne's patent; but the old method was to mix charcoal powder with the syrup, and the new was to pass the syrup through beds of charcoal constructed in a particular manner. By the old process a considerable quantity of charcoal was taken up by the syrup, and this was an injury to the sugar. In Derosne's process this objection did not arise; and, moreover, it was applicable not only to the refinement of coarse sugar, but to the original manufacture of sugar out of cane-juice. In an action brought for infringing the patent, the originality of the invention was held not to be impeached by showing that there had been an earlier use of charcoal in the refinement of sugar. No evidence was given that any other person, before the date of the plaintiff's patent, ever applied in use the particular mode of filtering syrup which the patent was intended to introduce: and in the absence of such evidence, *Lord Abinger* directed the jury to find for the plaintiff. (*Derosne* v. *Fairie*, 1 W. P. C. 154.)

In the case of *Cornish* v. *Keene* (1 W. P. C. 517) a patent for improvements in the manufacture of elastic fabrics was

contested. The patentee's mode of effecting his object was by introducing into the fabric threads of india-rubber, coated with filamentous material and applied as warp or weft, or as both, according to the direction of the elasticity required —the india-rubber threads having been stretched to their utmost tension and rendered non-elastic before being introduced into the fabric, and then being rendered elastic by the application of heat. It was contended that this was neither a new manufacture, nor an improvement of an old manufacture, but was merely the application of a known material, in a known manner, to a purpose known before. 'That it is a manufacture' (said *Tindal, C. J.*, delivering the judgment of the Court) 'can admit of no doubt; it is a vendible article, produced by the hand and art of man. Whether it is new or not, or whether it is an improvement of an old manufacture, was one of the questions for the jury, upon the evidence before them; but that it came within the description of a manufacture, and so far is an invention which may be protected by a patent, we feel no doubt whatever. The materials, indeed, are old, and have been used before; but the combination is alleged to be, and, if the jury are right in their finding, is, new; and the result or production is equally so. The use of elastic threads or strands of india-rubber, previously covered by filaments wound round them, was known before; the use of yarns of cotton, or other non-elastic material, was also known before; but the placing them alternately side by side together as a warp, and combining them by means of a weft when in extreme tension, and deprived of their elasticity, appears to be new; and the result, viz., a cloth in which the non-elastic threads form a limit up to which the elastic threads may be stretched, but beyond which they cannot, and therefore cannot easily be broken, appears a production altogether new. It is a manufacture at once ingenious and simple.'

A patent was granted for an improved mode of, and apparatus for, bending wood for the handles of walking-sticks, &c., and the specification described the apparatus as being a vice for holding a stick, previously softened in moist sand, placed close to a hollow mandrel, on which the bend-

ing was effected by sending a jet of lighted gas into it, and then securing the stick on the mandrel by a strip of steel. The heat stiffened the fibres of the wood, and the curvature was rendered permanent. In a suit to restrain the defendants from infringing the patent, its validity was called in question, on the ground that the invention was not new; but *Sir W. P. Wood, V. C.*, granted the injunction, saying, 'When it is stated that because wood is bent by coach-makers and others in a variety of ways by the application of heat, you cannot have a patent for the application of heat to the bending of walking-sticks, that is the same sort of reasoning that was pressed on the Court with reference to an invention for an improvement on navigation. It was said that the operation of a propelling power by presenting a screw-propeller to the action of water was nothing new—that it was like the action of a windmill with reference to the wind. That reasoning, however, did not succeed.' (*Dangerfield* v. *Jones*, 13 L. T. N. S. 142.)

5. *Chemical processes, sometimes in combination with mechanical contrivances*, whereby something useful is produced or effected. Under this head the following examples may be given: the distillation of bituminous minerals for the production of illuminating and lubricating oils (*Young* v. *Fernie*, 4 Giff. 597); the purification of coal gas by means of oxides, chlorides, &c. (*Hills* v. *London Gas Light Company*, 5 H. & N. 312); the precipitation of the solid animal and vegetable matter contained in sewage water with a view to its employment as manure (*Higgs* v. *Goodwin*, E. B. & E. 529); the preparation of dyeing materials (*Steiner* v. *Heald*, 6 Exch. 607; *Simpson* v. *Holliday*, 5 N. R. 340, L. R. 1 H. L. 315; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C. 449); the electro-deposition of nickel (*The Plating Co.* v. *Farquharson*, 1 Griffin, P. C. 187); the manufacture of alum (*Kurtz* v. *Spence*, 5 R. P. C. 161); the mixture of two or more substances in certain definite proportions forming a compound substance useful for its preservative, sanitary, or other useful properties (*Bewley* v. *Hancock*, 6 De G. M. & G. 402; *Muntz* v. *Foster*, 2 W. P. C. 103; *Bailey* v. *Roberton*, L. R. 3 App. Ca. 1055).

Many substances have been produced by chemists in their laboratories in small quantities, which, if they could be produced in large quantities at a moderate cost, so as to be merchantable commodities, would be extensively used by the public. An inventor who succeeds in doing this will not be considered to have been forestalled because the substance has been already produced on a small scale as a chemical curiosity. He will be held to have been the true and first inventor, and his patent will be supported because he has discovered a method of making for sale an article useful to the public, and has thereby created a new manufacture. 'What the law looks to,' said *V. C. Stuart*, in the case of *Young* v. *Fernie* (4 Giff. 611), 'is the inventor[1] and discoverer who finds out and introduces a manufacture which supplies the market for useful and economical purposes with an article which was previously little more than the ornament of a museum. The plaintiff is an inventor of this class, and his patent is entitled to the protection of the law. I find that he has ascertained by a course of laborious experiment a particular class of materials among many, and a particular process among many, which has enabled him to create and introduce to the public a useful manufacture, which amply supplies the market with that which, until the use of the materials and processes and temperature indicated by him, had never been supplied for commercial purposes. At the date of his patent something remained to be ascertained which was necessary for the useful application of the chemical discovery of paraffine and paraffine oil. This brings it within the principle stated by *Lord Westbury, C.*, in the case of *Hills* v. *Evans* (4 De G. F. and J. 288). The manufacture with the materials and process indicated by him, according to the sense in which I understand the word "manufacture" to be used in the statute, was a new manufacture not in use at the date of his patent.'

[1] The inventor in this case was referred to by Professor Huxley, P.R.S., in his Anniversary Address to the Royal Society 1883, as 'Mr. James Young, a chemist whose skilful application of theory to practice yielded him a colossal fortune.'

CHAPTER III.

THE INCIDENT OF UTILITY.

THE two chief incidents which are required by law to attend every invention that claims the protection of a patent are Utility and Novelty.

If one of several heads of invention is useless the patent is void (*Morgan* v. *Seward*, 2 M. & W. 544; *Simpson* v. *Holliday*, L. R. 1 H. L. 315; *Templeton* v. *Macfarlane*, 1 H. L. C. 595). And if part of an invention is found to be meritorious and part useless, the patent is likewise void (*United Horsenail Co.* v. *Stewart*, 2 R. P. C. 132).

A patent for a useless invention is thought by some to be void at common law; by others, by force of the Statute of Monopolies, which renders void grants of privileges which tend to the hurt of trade, or are generally inconvenient. For if a monopoly were allowed in a useless invention, other persons would be prevented from improving it, or turning it to any account whatever, so that combinations of utility might be impeded. It would stand in the way of real inventors, and hence be mischievous to the public generally. (See the observations of *Parke, B.*, in *Morgan* v. *Seward*, 1 W. P. C. 196.) On the trial of *Palmer* v. *Wagstaff* (Newton's Lond. Journ. vol. xliii. p. 151), *Chief Baron Pollock* said that in legal language it is a fraud on the law of patents for any person to take out a patent with a view to the obstruction of improvements. The evidence showed that the plaintiff's patent, which it was alleged the defendant had infringed, had never been worked; no attempt had been made to bring the candles of the patented construction before the public; and the patent was only then brought into play for the purpose of stopping the defendant from a course of improvement.

'A patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the ingenuity of mankind and the introduction of other inventions adapted to the particular subject to which the invention may be applicable, cannot, in my judgment, be supported.' (Per *Pollock, C. B.*, in *Crossley* v. *Potter*; Macr. P. C. 240.)

It is to be observed that the recital in the Letters Patent of the Crown's willingness 'to encourage all inventions which may be for the *public good*' clearly points to the quality of utility as one of the considerations for the grant, which failing, the patent will be invalid.

If an invention contains no degree of usefulness whatever, over and above inventions already known, then the patent is void. (*Manton* v. *Parker*, Dav. P. C. 327; W. P. C. 192 *n.*; *Manton* v. *Manton*, Dav. P. C. 348.)

'A mere trifling matter' (said *Sir W. P. Wood, V. C.*, in *Dangerfield* v. *Jones*, 13 L. T. N. S. 142) 'or a thing of no value will not do, inasmuch as the whole theory of the patent law is based upon the assumption that it is something of real value. You must show that you have invented something useful, a new and useful improvement in manufacture.'

It is a fatal objection to a patent that the invention as put into practice in the only way described in the specification is not only useless, but dangerous. (*Easterbrook* v. *Great Western Railway Co.*, 2 R. P. C. 207.)

'In (patent) law utility means an invention better than the preceding knowlege of the trade as to a particular fabric. It does not mean abstract utility. . . . If there is any new point of utility in the invention which was not in any previous known thing, then you may say it is useful; but if you think it is not as good as those existing before, or no better than those existing before in any particular point, then you would say it was not useful.' (*Mr. Justice Grove* to the jury in *Young* v. *Rosenthal*, 1 R. P. C. 41.)

When an action is tried before a jury, it is for them, not the Court, to decide the question of utility when the point

has been raised by appropriate pleadings ;[1] and the question will go before them in the general shape of utility or no utility. They have not to consider to what extent the invention is useful, but only whether it is of any use at all. *Mr. Baron Parke*, in *Neilson* v. *Harford* (1 W. P. C. 314), speaking of a patent for the use of hot-blasts in furnaces, laid it down that if the apparatus were an improvement, so as to be productive, practically, of some beneficial result, no matter how great, provided it is sufficient to make it worth while (the expense being taken into consideration) to adapt such an apparatus to the ordinary machinery in all cases of forges, cupolas, and furnaces, where the blast is used, then that there would be utility sufficient to support the patent. The *quantum* of improvement (should an improvement be in dispute) is not a material point; it is enough that they can find *any* improvement. (*Alderson, B.*, in *Morgan* v. *Seward*, 1 W. P. C. 172, 186.) In other words, in order to quash a patent on this ground, a jury must expressly find that the invention is of no use.

It has been decided over and over again that the slightest amount of utility is sufficient to sustain a patent. (Per *Mr. Justice Grove* in *Philpot* v. *Hanbury*, 2 R. P. C. 37.)

But it must be kept in mind that it is the *invention* which is required to possess utility, not merely the thing produced. As *Pollock, C. B.*, remarked, on trying the case of *Palmer* v. *Wagstaff* (above cited), it is not sufficient for the maintaining of a patent to prove that the article produced under it is useful; it must be the invention that effects the utility. Thus a patented manufacture should be either better in quality, or cheaper in cost, than that which it is intended to supplant.

It was held, however, in the case of *Lewis* v. *Marling*

[1] That the patentee must go into proof of the utility of his invention, in case that issue is raised, is shown by what fell from the judges in the cases of *Rex* v. *Arkwright*, Dav. P. C. 138; *Manton* v. *Parker*, Dav. P. C. 327; *Manton* v. *Manton*, Dav. P. C. 333; *Bovill* v. *Moore*, Dav. P. C. 399; *Brunton* v. *Hawkes*, 4 B. & Ald. 541; *Russell* v. *Cowley*, 1 W. P. C. 467; *Hill* v. *Thompson*, 1 W. P. C. 237; *Minter* v. *Wells*, 1 W. P. C. 129; *Crane* v. *Price*, 1 W. P. C. 411; *Derosne* v. *Fairie*, 5 Tyr. 393; 2 Cr. M. & R. 476.

(1 W. P. C. 490) that the uselessness of part of an invention will not vitiate the patent, unless that part is described as something essential. The case arose out of a patent for an improved machine for shearing woollen cloths, in which the patentee claimed, amongst other things, the use of a brush for raising the wool on the surface of the cloth to be shorn, but not as an essential part of the machine. Before any machine was made for sale this part of the invention was discovered to be useless, and no machines were ever sold with the brush attached. It was contended that this uselessness of part vitiated the whole, but *Lord Tenterden* said, 'If the patentee mentions that as an essential ingredient in the patent article which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void, because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful.' *Bayley, J.*, thought that if the patentee had known the brush to be unnecessary, the patent would be bad, on the ground that this was a deception; but if he believed it to be proper, and only by a subsequent discovery found out that it was not necessary, it would form no ground of objection.

In the case of *Haworth* v. *Hardcastle* (1 W. P. C. 480) the jury found specially that the invention was useful upon the whole, but that the machine was not useful in some cases. The judges of the court of C. P. thought that this finding of the jury did not negative the utility of the machine in the generality of cases, but rather led to the inference that in the generality of cases it was useful, and the patent was therefore held to be valid.

If an improvement of the trade (using these words in their commercial sense) has taken place in consequence of an invention, this affords a good test of its utility. The invention patented by Lord Dudley consisted in substituting pit-coal for charcoal in the manufacture of iron. Neilson patented a process of smelting iron by blowing the furnace with hot in place of cold air. Crane smelted iron

by means of anthracite instead of ordinary fuel, and combined the hot-blast with this. All these processes were productive of great improvements in the manufacture of iron, and the patents were all supported by the Courts.

It is a proof of utility that an article of commerce commands an extensive sale within a short time of the first manufacture and sale. It is also cogent but not conclusive evidence of novelty. (*American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 113; *Ehrlich* v. *Ihlee*, 5 R. P. C. 198; *S. C.* on App. 5 R. P. C. 437.)

It does not, however, follow necessarily that a patent is bad because the invention is not commercially useful. (Per *Mr. Justice North* in *United Telephone Co.* v. *Bassano*, 3 R. P. C. 313; and see *Ehrlich* v. *Ihlee*, 5 R. P. C. 450.)

The element of commercial pecuniary success has no relation to the question of utility in Patent Law generally, though where the question is of improvement, by reason of cheaper production, such a consideration is of the very essence of the patent itself, and the thing claimed has not really been invented unless that condition is fulfilled. (*Badische Anilin und Soda Fabrik* v. *Levinstein*, House of Lords, 4 R. P. C. 462.) And in the same case (p. 466) Lord Herschell said: 'I do not think that it is a correct test of utility to enquire whether the invented product was at the time of the patent likely to be in commercial demand or capable of being produced at a cost which would make it a profitable speculation to manufacture it.' (See also *Kurtz* v. *Spence*, 5 R. P. C. 182.)

It has been said from the Bench, that the fact of a published invention not meeting with public acceptance is some presumption against its utility. It is something to be taken into consideration, when the question of utility is raised in a court of justice, that a machine has not been called for by the public. (*Morgan* v. *Seward*, 1 W. P. C. 186.)

But the utility of an invention must be judged by reference to the state of things at the date of the patent. If the invention was then useful, the fact that subsequent

improvements have replaced the patented invention, and rendered it obsolete and commercially of no value, does not invalidate the patent. (Per *Lindley, L. J.*, in *Edison & Swan Co.* v. *Holland*, 6 R. P. C. 283.)

It has also been said that if the invention is not worked by the inventor that fact is *primâ-facie* evidence of want of utility. But 'that' (said *Jessel, M. R.*, in delivering judgment in the case of *Otto* v. *Linford*, 46 L. T. N. S. 35) 'is subject to this observation, that you may make and vend an improvement upon it, and if you have found out immediately after you have patented your invention that it can be improved, it does not by any means show that the first invention was useless.' Then, referring to the case of *Renard* v. *Levinstein* (10 L. T. N. S. 177), which arose out of a patent for a dye, he said, 'There they never sold an ounce of dye made according to the patent because immediately afterwards the inventor had discovered an improvement, and they had always sold the improved dye, and they were obliged to call a witness to show that they had made a few ounces of dye and tried it, and that it would dye. The answer was that under those circumstances the mere fact of not selling the original dye was nothing at all. So in this case (*Otto* v. *Linford*) we have rather a stronger illustration, because the inventor has patented these modifications, and it turns out that what he has used, made, and sold have been almost entirely number threes. No. 1 itself does not appear ever to have been sold. But then they say that No. 1 will work, and they call witnesses to prove it, and there is no denial from the other side. Therefore there is evidence of utility. It is very small indeed as regards No. 1, but it is quite sufficient for the support of a patent; and as to this question of utility, as we know, very little will do.'

CHAPTER IV.

THE INCIDENT OF NOVELTY.

THE statute of James declares excepted from the invalidating clause 'all letters patent and grants of privilege of the sole working or making of any manner of *new* manufactures to *the true and first inventor* of such manufactures, *which others at the time of making such letters patent and grants should not use.*' Moreover, the patent contains clauses rendering the grant voidable in case the invention is not a new invention as to the public use and exercise thereof, or in case the patentee is not the true and first inventor of the invention.

The meaning of all this is that if it should be proved that the invention is destitute of novelty the patent is void. If several distinct heads of invention are claimed in the specification, and one of them is old, that will invalidate the whole patent (*Turner* v. *Winter*, 1 W. P. C. 77; 1 T. R. 602; *Bloxam* v. *Elsee*, 6 B. & C. 178; *Morgan* v. *Seward*, 1 W. P. C. 196; *Kay* v. *Marshall*, 2 W. P. C. 71; *Cropper* v. *Smith*, 1 R. P. C. 87; *S. C.* 2 R. P. C. 17). The Crown having been misled as to the extent of the invention, the grant of a patent in respect of it is void. It was on this principle that the Court, in deciding *Morgan* v. *Seward*, looked at the cases of *Hill* v. *Thompson* (1. W. P. C. 237), and *Brunton* v. *Hawkes* (4 B. & A. 541), in which a patent for several inventions was held to be altogether void because one was not new. The want of *novelty* is a fatal defect by the express wording of the statute, so far as relates to that which is old; and the whole patent is rendered void by the construction that the consideration for the grant is the novelty of all the parts claimed to be new, which considera-

tion failing, or, as it is sometimes expressed, the Crown being deceived, the patent is void.

The two chief questions under the head of Novelty are:—

1. Was the patentee the *true* inventor of that for which he has obtained a patent?

2. If so, was the invention new to the public at its date? This includes the narrower question, Was the patentee the *first* inventor of the subject-matter of his patent?

As regards the first of these questions it must be answered in the negative if the patentee obtained the invention from another person, inventions imported from abroad being excluded from consideration. And as to the second question it must also receive a negative reply, (i) if the invention had got into public use; or (ii) if the invention had become known to the public (*a*) by a description of it in a printed book accessible to the public; or (*b*) by a description in an earlier specification; or (*c*) by prior publication by the inventor or another person.

It has been broadly laid down that when the public has become possessed of an invention in any manner whatever, no valid patent for it can be subsequently obtained, either by the true and first inventor, or by any other person ('Hindmarch on Patents,' p. 33, referred to by the judges with approval in the cases of *Patterson* v. *Gaslight Co.*, L. R. 3 App. C. 235; *Lister* v. *Norton*, 3 R. P. C. 211; *Humpherson* v. *Syer*, 4 R. P. C. 414). There are, however, certain exceptions to the universality of this rule, as will be shown further on in this chapter.

The enquiry will be whether the invention had become part of the public stock of knowledge before the date of the patent. 'If that means' (said *Lord Justice Fry* in *Humpherson* v. *Syer*) 'the knowledge that every member of the public possesses, it is clear that the definition will meet very few of the cases in which publication has taken place.'

TRUE INVENTOR.[1]

A discovery may be both useful and quite new to the world at large; yet if it can be shown that the person, upon whose statement that he was the true inventor the patent was granted, does not really answer to that designation, the patent is not saved from the clause in the statute of James, which declares that all monopolies are invalid.

'A man may publish to the world,' said *L. C. J. Tindal*, in *Gibson* v. *Brand* (1 W. P. C. 628), 'that which is perfectly new in all its uses, and has not before been enjoyed, and yet he may not be true and first inventor; he may have borrowed it from some other person . . . and then the Legislature never intended that a person who had taken all his knowledge from another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill.'

Rival Inventors.—One of the earliest cases on this subject is that of Dollond, the optician, who brought an action for an infringement of his patent for a new method of making the object-glasses of refracting telescopes. It was alleged, on the part of the defendant, that Dollond was not the true and first inventor of the method, inasmuch as Dr. Hall had made the discovery before him. But since Dr. Hall had confined it to his closet, and had not communicated it to the public, it was held (1766) that Dollond was to be considered the first and true inventor as required by the statute. The case was not reported, and our knowledge of it is derived from the mention made of it in the case of *Boulton* v. *Bull* (2 H. Bl: 469). Dollond's case was followed by numerous others, the result of which may be thus stated:—If two persons make the same invention about

[1] It must be kept in mind that the word 'patentee' in this section signifies, in the case of a patent granted to several persons jointly under the Act of 1883, only the person who claimed to be the inventor of the subject-matter of the patent, and does not include other non-inventors who may have joined him in obtaining the grant.

Moreover, it will be shown hereafter that the importer of an invention from abroad is held by the courts of law to fall within the meaning of the words 'true and first inventor.'

the same time independently of each other, he who first obtains a patent has an exclusive right to the invention (*Forsyth* v. *Riviere*, Chit. Prerog. Cr. 182); and he will be held the first inventor, although, in point of fact, the date of his invention was subsequent to that of the other person, provided that there was not such a use of the invention previously to the patent as amounted to what is technically called 'public use.'

In *Lewis* v. *Marling* (1 W. P. C. 496), *Bayley, J.*, said, 'If I make a discovery, and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else has made a similar discovery in his mind, unless it has become public.' And *Parke, J.*, said, 'There is no case in which a patentee has been deprived of the benefit of his invention because another had also invented it, unless he had also brought it into use.' Again, in the case of *Hill* v. *Thompson* (1 W. P. C. 244), *Dallas, J.*, said, 'It is not enough to have discovered what was unknown to others before, if the discovery be confined to the knowledge of the party having made it; but it must have been communicated more or less, or it must have been more or less made use of, so as to constitute discovery as applied to subjects of this sort.'

Joint Inventors.—It may happen that a given invention results from the combined operation of two or more minds, in which case it is necessary that all the inventors should apply for the patent. Patents have sometimes been disputed on the ground that the patentee owed a material part of the invention to another person; and if this can be made out on satisfactory evidence, it is fatal.

Assistants and Workmen.—It must, however, be taken to be undoubted law, that the suggestions and aid of workmen employed by the inventor to carry out his ideas will have no such effect. An inventor is entitled to something more than the mere manual labour of the persons he employs. If the substantial part and leading idea, the principle of an invention, belong to one person, he may properly call in the assistance of another to work it out and improve it;

and after obtaining the benefit of that assistance, he may legally procure a patent for the invention. The observations of *Alderson, J.*, to the jury on trying *Minter* v. *Wells* (1 W. P. C. 132) will throw light upon this point. 'Minter [the patentee] and Sutton [a workman employed by Minter] were together about the time the invention took place: which of the two suggested the invention, and which carried it into effect, is a question for you to decide. If Sutton suggested the principle to Minter, then he would be the inventor. If, on the other hand, Minter suggested the principle to Sutton, and Sutton was assisting him, then Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Minter uses for the purpose of enabling him to carry his original conception into effect. You will judge which is the more probable of the two. Minter makes out his *primâ-facie* case; he is the person who takes out the patent. If Sutton has received a compensation, nothing would have been more simple and easy than that he should have taken out the patent, and still Minter might have had the same benefit to-day; and there is no apparent reason why Sutton should not have taken out the patent which Minter has taken out, unless they were both desirous to ruin the invention; for suppose two persons are engaged on an invention of this description, they know perfectly well between themselves who is the real inventor of it, and who is the workman to carry into effect the conception; but they would destroy the value of it to both if they did not take it out in the name of the right person.' See also *Bloxam* v. *Elsee* (6 B. & C. 169), *Minter* v. *Mower* (1 W. P. C. 138), and *Barber* v. *Harris* (Holroyd, 60), which show that a man may direct other persons to do certain things and yet be the true inventor.

In *Allen* v. *Rawson* (1 C. B. 551), a case where the validity of a patent was contested on the ground that parts of the invention owed their origin to two workmen, it was held that more convenient modes of carrying out the main principle of an invention and subordinate improvements

suggested by persons in the employment of the patentee may be safely adopted by him and embodied in his specification. 'I take the law to be' (said *Mr. Justice Erle*, before whom the action for an infringement was tried) '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 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; and if so embodied the patent is not avoided by evidence that the agent or servant made the suggestions of the subordinate improvement of the primary and improved principle.' When a new trial was moved for, on the ground that the judge had misdirected the jury, it was refused. On that occasion *C. J. Tindal* said, 'It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend upon its own merits. But when we see that the principle and object of an invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the patent void.'

A firm of manufacturing chemists employed E., a scientific chemist, in their laboratory as analyst and experimentalist. The manufacture of alum free from impurities being a desirable object, it occurred to E. to try experiments with peroxide of manganese for that purpose, and he was thereupon instructed by the firm to make the suggested experiments. This he did with the assistance of one member of the firm, and whilst having communications with the other. The experiments succeeded, and a patent was obtained for the discovery by the firm in their own names. The judge,

at the trial of an action where the validity of the patent came in question, held that they were justified in applying for the patent. Although many stages of the discovery may have been due to E., yet he was the agent of his employers. His labours were theirs, he worked in their laboratory and with their materials as well as with their assistance, and the benefit of the discovery belonged to them. (*Kurtz* v. *Spence*, 5 R. P. C. 180.)

But where the patentee has no closer connection with the invention than that of being simply the employer of the inventor, he will not be able to sustain his patent. Thus, in Arkwright's case, it appeared that Arkwright, the patentee, had been told of a particular roller, part of the machinery by Kay, and that, perceiving the value of the invention, he took Kay into his service for two years, during which time he employed him to make models, and subsequently claimed the invention as his own, making it the foundation of a patent. Arkwright adopted in the same way a crank invented by Hargrave. In the face of this evidence, Arkwright's claim to be the true and first inventor fell to the ground. (*Rex* v. *Arkwright*, 1 W. P. C. 64.) Again, in the case of *Barker* v. *Shaw* (1 W. P. C. 126 *n.*), an action for the infringement of a patent for an improvement in making hats, a witness proved that he had made the improvement whilst employed in the patentee's workshop, whereupon the plaintiff was nonsuited.

In these cases it was clear that the patentee was not the true and first inventor, since the source of the invention could be traced elsewhere. Whenever this can be done (with the exceptions stated in the note on page 29) the patent is invalid. It is so, as we have seen, although the real inventor should be in the service of the patentee; and, *à fortiori*, will it be so where there is still less connection between them. In Tennant's case it was proved that, before the grant of the patent, conversations had taken place between Tennant (the patentee) and a chemist, who had suggested to Tennant the basis of the patented improvement. This piece of evidence, in addition to slight

evidence of user, induced the Court to nonsuit the plaintiff. (Dav. P. C. 429.)

PRIOR PUBLIC USER.

One of the first cases which the books contain was decided in 1798. Tennant brought an action for the infringement of his patent for a method of using calcareous earths instead of alkaline substances in bleaching. It was proved, on the one hand, that bleachers were generally ignorant of the patented bleaching liquor until after the date of the patent. On the other hand, it was proved that a certain bleacher had used the same method of preparing bleaching liquor for five or six years previously to the date of the patent; and that the method had been kept secret from all except his two partners, and two servants employed in preparing the liquor. On this evidence the previous user was held to render the patent invalid (1 W. P. C. 125).

The evidence given in *Lewis* v. *Marling*, to impugn the patentee's claim of novelty, was that several years previously a similar machine was in use at New York, and that a specification had been sent over in 1811 to a person residing at Leeds, who employed two engineers to manufacture a machine from it, which, however, was never finished. The specification was shown to several persons, but the machine was never brought into use. In 1816 a model of a machine for shearing from list to list, by means of a rotatory cutter, was brought over from America, and shown to two or three persons in the manufactory of the importer; but no machine was ever made from it, nor was it publicly known to exist. Moreover, one Coxon, many years previously, had made a machine to shear from list to list, and this was tried by a person called as a witness; but he did not think it answered, and soon discontinued the use of it. *Lord Tenterden* told the jury that if it could be shown that the patentee had seen the model or specification, that might rebut the claim of invention. But there was no evidence of that kind; and he left it to them to say

whether the invention had been in public use and operation before the granting of the patent. They found that it had not; and on the motion for a new trial the judges thought there was no reason to find fault with the verdict.

Losh's patent was for improvements in the wheels of railway carriages, and these improvements consisted in constructing the pieces composing the entire wheel of malleable iron, and then welding them together. It was contended by the defendant in the case of *Losh* v. *Hague* (1 W. P. C. 202) that the invention was not new, inasmuch as one Paton had, previously to the date of Losh's patent, and under a patent of his own, described a mode of constructing wheels of wrought iron, which differed little, if at all, from those patented by Losh; moreover, that although the first wheel made under Paton's patent was riveted, all Paton's other wheels, thirty pairs in number, were made with the circumference of the inner rim entirely of wrought iron, and then welded into one piece. 'The question you have to try,' said *Lord Abinger* to the jury, 'on the originality of Losh's invention, is not whether Paton's patent contains that perfect periphery that is required in this case, but whether wheels have been publicly made on this principle.' (The jury by their verdict found that wheels had been previously made on the same principle as Losh's wheels.) 'If,' continued his lordship, 'the wheels had been made and sold to any one individual, the public's not wanting them because there were no railways, their not being adapted to any particular use, which at that time was open to the public to apply them to, makes no difference. You have it in evidence that thirty pairs were made with a complete continuous circumference all round. If they were so made and sold, or used at all, though not for any purpose that then made them popular or desirable, still they were made with that particular advantage which is claimed by Losh's patent, namely, a periphery made of one continuous piece of wrought iron, as well as the spokes. But that is not all the evidence; there are two parties from Manchester. One, Horsefall, says that he remembers, nearly twenty-eight years

ago, that there were three trucks, having each three wheels, and those wheels were made of wrought-iron spokes in a wrought-iron circumference, and there is one exhibited before you which was actually in use at that time; the other, Roberts, confirms that, and has stated that they existed for many years, and that they have been used.'

In charging the jury assembled to try the action of *Cornish* v. *Keene* (1 W. P. C. 508), *Tindal, C. J.*, said that 'if the invention was at the time the letters patent were granted in any degree of general use; if it was known at all to the world publicly, and practised openly, so that any other person might have the means of acquiring the knowledge of it as well as the person who obtained the patent, then the letters patent are void. Now it will be a question for you to say whether, upon the evidence which you have heard, you are satisfied that the invention was or was not in public use and operation at the time the letters patent were granted. It is obvious that there are certain limits to that question; the bringing it within that precise description which I have just given must depend upon the particular facts which are brought before a jury. A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments, and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent and protect himself in the sole making of the article for fourteen years; and it will be no answer to him to say that another person before him made the same experiments, and therefore that he was not the first discoverer of it, because 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 that comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has the right to clothe himself with the authority of the patent and enjoy its benefits. That would be an extreme case on one

side; but if the evidence, when properly considered, classes itself under the description of experiment only, and unsuccessful experiment, that would be no answer to the validity of the patent. On the other hand, the use of an article may be so general as to be almost universal. In a case like that you can hardly suppose that anyone would incur the expense and trouble of taking out a patent. That would be a case where all mankind would say, "You have no right to step in and take that which is in almost universal use, for that is, in fact, to create a monopoly to yourself in this article without either giving the benefit to the world of the new discovery, or the personal right to the value of the patent, to which you would be entitled from your ingenuity and from your application." Therefore it must be between these two limits that cases will range themselves in evidence; and it must be for a jury to say whether, supposing these points to be out of the question in any particular case, the evidence which has been brought before them convinces them that the subject of the patent was in public use and operation at that time, at the time when the patent *itself* was granted by the Crown. If it was in public use and operation, then the patent is a void patent, and amounts to a monopoly; if it was not, the patent stands good.'

The case of *Carpenter* v. *Smith* (1 W. P. C. 530) arose out of an alleged infringement of a patent for an improved lock. 'I think,' said *Lord Abinger* to the jury, 'that what is meant by "public use and exercise" is this: a man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions and apply them. . . . The meaning of these words, "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 which another man has to a patent for the same invention. Now "public use" means this: that the use of it shall not be secret, but public. If a man invents a thing for his own use, whether he sells it or not—if he invents a lock, and puts it on his own gate, and has used it for a dozen years, that is a public use of it. If it were otherwise, see what the consequence would be. If Mr. Davies has a lock which he directed to be made and put on his gate sixteen years ago at least; if that was not a public use which prevented a man from taking out a patent, any man might go and take a model of that lock, and get a patent for it. How can he be the inventor of it? Because, to obtain a patent, a man must be the inventor; and if it has been once in public use, that is, used in a public manner, not used by the public, yet if it has been used by half-a-dozen individuals, or one,[1] in a public manner, any man having access to it, how can he be said to be the inventor, if by merely gaining access to that he takes out a patent? A man cannot be said to be the inventor of that which has been exposed to public view, and which he might have had access to if he had thought fit. . . . If you are of opinion (not that they were generally adopted by the public and used by the public, for that, in my opinion, is a perfect fallacy) that the use of them is public, and the exercise of the invention was public, and not kept secret so that the public might have no benefit from it, then I think that part of the issue you ought to find for the defendant.' The learned judge summed up the evidence as

[1] 'If a person' (asked *Dallas, J.*, *Hill* v. *Thompson*, 1. W. P. C. 240) 'had done precisely all that is specified to be done in this specification, and had not communicated it to any one, could he be prohibited by the patent from doing that which he had done before, though known to no one but himself; or could it be considered as new, if practised by only one person, but not communicated to the world?' And *Tindal, C. J.*, in *Cornish* v. *Keene* (1 W. P. C. 511), observed that 'if the defendants had shown that they practised it (*i.e.* the patented invention), 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.'

to a public user in this way:—Twenty-six years ago Freer produced to Tilsley a model of a lock, and desired him to make six dozen like it, and afterwards a dozen and a half. Tilsley employed Walker to execute the order, and gave him the model. The locks were made, and Freer paid for them. 'Here you have an article manufactured by an English manufacturer, and sold; and in my opinion, if it was sold even for the assumed purpose of being sent to America, I cannot but think that that would be a destruction of the novelty of the plaintiff's invention. When a model is sent to a workman, who sells seven and a half dozen, and sells them for a certain price, I must say I think the invention was used and publicly exercised. There is no secrecy in the manufacture of them; it is not shut up in the closet of the workman who makes them, but the man who makes them gives directions to another workman; he sells them for his own profit.'

These observations of *Lord Abinger* were made at the trial of an action which terminated in favour of the defendant. On the motion for a new trial, on the ground of misdirection, the judges of the Court of Exchequer expressed themselves satisfied with his lordship's view of the law and refused a rule, *Alderson, B.*, saying that '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.'

The point as to public use was again raised in an action for infringing a patent for paving streets with wooden blocks. It was shown that, some time before the date of the patent, the carriage-way of a porch of Sir W. Worsley's dwelling-house in Yorkshire had been laid with blocks of wood, on a system apparently similar to the plaintiff's. *Cresswell, J.*, told the jury, that if they thought the plaintiff's method of constructing the wooden pavement was the same as that adopted at Sir W. Worsley's, the invention must be deemed to have been made public. It had been publicly used, and made known to all persons who went to the house, so far as ocular inspection could acquaint them with it. Whether it

had been used by one or used by five, the learned judge thought made no difference. (*Stead* v. *Williams*, 2 W. P. C. 136.)

In another action for infringing the same patent brought against another defendant, it was proved that the pavement at Sir W. Worsley's was on a different principle from the plaintiff's. *Parke, B.*, told the jury that if the mode of forming and laying the blocks at Sir W. Worsley's had been precisely similar to the plaintiff's, that would have been a sufficient user to destroy the plaintiff's patent, though put in practice in a spot to which the public had not free access. (*Stead* v. *Anderson*, 2 W. P. C. 149.)

A patent for an improved anchor was granted in 1838 to one Porter. On the trial of an action, brought by Porter's assignee, for an infringement, it was shown that in 1826 an anchor-smith had invented an anchor similar to Porter's, and had sold a few of that make to various shipowners for use in their ships. This was held such a public user as sufficed to invalidate the patent. (*Hornblower* v. *Bloomer*, 2 W. P. C. 199.)

Hancock v. *Somervell* (reported in Newton's L. J., vol. xxxix. p. 158) is a case in which peculiar circumstances tending to show public user were adduced in evidence for the purpose of rebutting the claim to novelty, and it raised the interesting question whether publication in this country of an *article* made abroad, there having been no disclosure of the secret of making it, is equivalent to a publication of the *invention*, so as to render void a patent afterwards obtained in this country by another inventor for a similar invention. Hancock's patent was for improvements in the preparation of caoutchouc, and the invention consisted in combining sulphur with the caoutchouc, which rendered it elastic at all temperatures. The defendants imported from America shoes made of caoutchouc, which, when analysed, were found to contain sulphur along with oxide of lead and other ingredients. In an action for an infringement of the patent it was proved that previously to the date of the plaintiff's patent specimens of caoutchouc prepared by

sulphur were sent to England by Goodyear, of New York, and were shown to Hancock, but the secret of the manufacture was not communicated to him. Negotiations were commenced for the sale of the invention to Hancock, but never completed. It was stated in evidence that Goodyear's agent left specimens with Hancock, supposing that it would not be possible for him to discover the process by which it was prepared. However, Hancock made experiments, and discovered that sulphur endowed caoutchouc with the property of elasticity at all temperatures, and he then took out his patent. *Mr. Justice Williams* left it to the jury to say whether, supposing the shoes to have been manufactured in England, they could have been made without infringing the plaintiff's patent; and then he proceeded to make these remarks upon the novelty issues:—'The defendants do not deny that Hancock is to be considered the inventor, notwithstanding Goodyear had previously made the discovery, provided the invention had not been published or in use in this country before the date of the patent. The defence consists of this: not only had Goodyear discovered the invention first, but also that the invention had been substantially published, and was in use—not in secret use, but in public use—before the date of the patent; that the material being in public use, the ready means of the invention were also necessarily before the public; because it is said the article presented in itself such means of knowledge to the public as to enable anyone of ordinary competence to reproduce the article. If you should be of opinion that the material was in use before the date of the patent, then the question resolves itself into this: what is your opinion as to whether the publication of the material was substantially a publication of the invention? If you should find that the material was in public use, but that, notwithstanding, the invention remained still a matter to be discovered, in my opinion the plaintiff's case would not be affected by the circumstance of the material being in public use. If, on the other hand, you should think not only that the material was in public use (and I should here

say that I do not think it is necessary the use should be actual sale—if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, handing about the country for the purpose of attracting customers); if you should think, also, that the material being so in use, it was so palpable how you could make it, when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it; if you do not think that, then I think the plaintiff's case is unaffected by the circumstance of the material being before the public in the way I have been describing.' The jury found a verdict for the plaintiff, and thus the foreign inventor lost the benefit of a very valuable invention by not taking the precaution to obtain a patent in this country before opening negotiations for the sale of the manufactured article.

On the trial of *Muntz* v. *Foster* (2 W. P. C. 103–108), *Tindal, C. J.*, said to the jury, 'I look upon the invention to consist in this, that Muntz has by an experiment ascertained that a certain mixture of the alloy of zinc with copper will have the effect of producing a better sheathing (for the bottom of ships) by reason and by means of its oxidating just in sufficient quantities—that is, not too much, so as to wear away and impair the sheathing and render the vessel unsafe, but enough, at the same time, to keep by its wearing the bottom of the vessel clean from those impurities which before attached to it. And if it was shown, as possibly it might be, that sheets had been made of metal before, in the same proportion which he had pointed out, and if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground. . . . In my judgment it will not go far enough [to show that sheets of this particular alloy had been previously made], unless they can show there has been some application of them before to this very useful purpose. . . . I do not think that the circumstance of showing that the combination of these two materials in a metal plate will of itself destroy this patent, when no attention at the time was paid to the

purpose for which this patent was taken out, and it was made merely in the ordinary course of melters of metals for the various and ordinary purposes of life. I do not think that the circumstances of showing, that in the long time that has passed before us in the different, and I may say infinitely varying, combinations that must have been made for the various purposes for which brass and other metal was manufactured for ordinary and common purposes of life—to call a workman to show that on some occasion or occasions he had combined them in those proportions for another and different purpose; it does not appear to me that such destroys the patent.'

The question of public user arose in the case of *Heath* v. *Smith* (2 W. P. C. 268). An action for the infringement of a patent under which the invention claimed was an improved method of making cast steel, by fusing carburet of manganese along with common iron or steel. It was proved at the trial that five manufacturers of steel had used substantially the process patented by the plaintiff before the date of his patent, not by way of experiment, but in the way of their trade, and to the extent of hundreds of tons. Two of the manufacturers had kept the process a secret. The other three had openly practised it; but it had not become generally known, and the trade was not made acquainted with it until the plaintiff took out his patent. It was held, after argument, by the Court of Queen's Bench, that there had been a public use of the process, and that the patent was, therefore, invalid. One of the judges pointed out this consequence of an opposite decision, that a man who made a discovery would be obliged to take out a patent for it in order to free himself from liability to action in the event of another man making the same discovery and procuring a patent. The process adopted by the five manufacturers was to place iron, manganese, and carbon in a crucible. The application of heat, according to the scientific witnesses, made first a carburet of manganese, and then made that substance unite with the iron. Now the Court of Exchequer Chamber had previously held

that this process was an infringement of the patent, the specification of which claimed 'the use of carburet of manganese in any process for the conversion of iron into cast steel;' for although the plaintiff only mentioned carburet as a well-known substance which he put into the crucible, his patent was held to cover every mode of operating whereby carburet of manganese, however formed, was made to act upon iron. The result by the two processes was identical. The process used by Smith, the defendant in this action, was similar to that of the five manufacturers. If it was the same as the plaintiff's, he had a good defence; for the process was not new, and the plaintiff's patent was invalid: if it was not the same as the plaintiff's, then there was no infringement.

Where the defendants at the trial of an action for the infringement of a patent for a method of manufacturing penholders proved that they had made penholders according to the method which the plaintiff afterwards patented, and that such penholders had been placed in their warehouse for sale, though no sale was proved, *Sir J. Jervis*, *C. J.*, the presiding judge, held that the plaintiff's invention was destitute of novelty. (*Mullins* v. *Hart*, 3 Car. & K. 297.)

The sale in England of articles made abroad is an anticipation of a subsequently patented invention. (*Jensen* v. *Smith*, 2 R. P. C. 249.)

The following later cases on the subject of prior user may be referred to: *Croysdale* v. *Fisher*, 1 R. P. C. 17; *Brereton* v. *Richardson*, 1 R. P. C. 165; *Lister* v. *Norton*, 3 R. P. C. 199; *Podmore* v. *Wright*, 5 R. P. C. 380.

It was decided by *V. C. Bacon* in the case of *Rolls* v. *Isaacs* (L. R. 19 Ch. D. 268) that the prior user of an invention in a colony does not affect the validity of a patent subsequently obtained for the same invention in the United Kingdom.

But, in order to break down the patent of the person who was *de facto* the first to produce a useful article by the

patented process, the fact of anticipation, if that is relied on, must be very clearly made out. (*Von Heyden* v. *Neustadt*, 50 L. J. N. S. Ch. 126.)

When previous public user of the invention is relied upon as ground of the invalidity of a patent, it is not necessary to show that such user continued up to the time of the patent being granted. Even if discontinued, the patent will be invalidated. (*The Householl Co.* v. *Neilson*, 1 W. P. C. 709, in the *House of Lords*. And see the remarks of *Sir W. P. Wood, V. C.*, on *Jones* v. *Pearce* in *Tangye* v. *Stott*, 14 W. R. 386, as well as the case of *King, Brown & Co.* v. *Anglo-American Brush Corporation*, 6 R. P. C. 414.) Their lordships, however, in delivering judgment in the first of these cases, expressly left it an open question whether a patent for an invention would or would not stand, if a similar invention had formerly been in use but had ceased to be used long before the date of the patent, and the thing had been completely lost sight of until discovered again and patented.

Secret User, from which the inventor derives a profit, and being not merely a user by way of experiment, will certainly deprive his after-acquired patent of its validity. But there is still the question whether prior secret user by someone other than the patentee is sufficient to vitiate a patent. This point has never been judicially decided in an English court; but we have a dictum of Mr. Justice Erle, uttered in the above case of *Heath* v. *Smith*: 'If one party only,' said that learned judge, 'had used the process, and had brought out the article for profit, and kept the method entirely secret, I am not prepared to say that then the patent would have been valid.' Tennant's case (*ante*, p. 33) may be referred to, as well as Lord Abinger's remark in *Carpenter* v. *Smith* (*ante*, p. 37) and the note on page 38.

Fraud.—By the thirty-fifth section of the Patents Act of 1883 it is enacted that 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.

Abandoned Experiments of other Persons.—A patent is not invalidated by the fact that persons other than the patentee had previously made experiments in the direction of the invention, if such experiments did not result in the utilization of the discovery. Few patents, indeed, could be sustained if previous experiments, approaching the patented invention, were held to vitiate them. In almost every case experiments of some kind or other have been made in the same track, and many beneficial inventions have been but a step beyond what has before been reached by experiments which seemed fruitless, and were abandoned.

The question whether the evidence amounts to proof of public use, or whether it only proves that abandoned experiments had been made, is frequently of considerable delicacy; since, as it has been remarked from the Bench, a slight difference in the evidence will establish either the one proposition or the other. (*Cornish* v. *Keene*, 1. W. P. C. 519.)

In *Galloway* v. *Bleadon* (1 W. P. C. 525), *Tindal, C. J.*, said, 'A mere experiment, or a mere course of experiments, for the purpose of producing a result which is not brought to its completion, but begins and ends in uncertain experiments, that is not such an invention as should prevent another person, who is more successful, or pursues with greater industry the chain in the line which has been laid out for him by the preceding inventor, from availing himself of it and having the benefit of it. . . . That there had been many experiments made upon the same line, and almost tending, if not entirely, to the same result, is clear from the testimony you have heard; and that these were experiments known to various persons. But if they rested on experiment only, and had not attained the object for which the patent was taken out, mere experiment, afterwards supposed by the parties to be fruitless, and abandoned because they had not brought it to a complete result, that will not prevent

a more successful competitor who may avail himself, so far as his predecessors have gone, of their discoveries, and add the last link of improvement in bringing it to perfection.' See also the observations of the same learned judge in *Cornish* v. *Keene* (1 W. P. C. 508).

In *Jones* v. *Pearce* (1 W. P. C. 124), an action brought for an infringement of a patent for an improved construction of carriage-wheels, the defendants contended that wheels similar in principle to those for which the patent had been obtained had been invented several years previously by a Mr. Strutt, made under his orders, and used in a cart employed on the public roads for upwards of a year. These wheels were afterwards laid by, the spokes having occasionally got bent. *Patteson, J.*, told the jury that if 'you are of opinion that Mr. Strutt's wheel was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention, which came afterwards, was his own invention, and remedied the defects of Mr. Strutt's wheel, then there is no reason for saying that the plaintiff's patent is not good.'

On the trial of an action for infringing a patent for improvements in cards for carding fibrous substances, which improvements consisted in using caoutchouc as a substitute for leather as an elastic bed in which the teeth were fixed, it was given in evidence, in support of a plea denying the novelty of the invention, that a certain material, called Hancock's patent leather, had been made and sold previously to the patent; and it was suggested, rather than proved, that this material was substantially the same thing as the elastic bed in which the carding teeth were fixed. It appeared that the patent leather had been supplied to certain manufacturing firms, during the space of about a year and a half, several years before the date of the patent, and that it had been used in the construction of cards, but had not been employed for that purpose since that time. 'Supposing,' said *Cresswell, J.*, to the jury 'that the article (Hancock's patent leather) did embody the principle of the

plaintiff, so as to present to persons using it the properties, qualities, and advantages in principle of that article which the plaintiff makes, the question for you will be, whether that user is not to be considered rather in the nature of an experiment, than of any public use of the article, so as to deprive the plaintiff of the fruit of his discovery in respect of this manufacture.' (*Walton* v. *Bateman*, 1 W. P. C. 619.)

At the trial of *Stead* v. *Williams* (2 W. P. C. 135), *Cresswell, J.*, said to the jury, 'I take it that there is a great difference between the knowledge of an invention as a thing that would answer and was in use, and the knowledge of it as a mere experiment that had been found to be a failure, and thrown aside. If a person has had a scheme in his head and has carried it out, but after a trial has thrown it aside, and the thing is forgotten and gone by, then another person re-introducing it may, within the meaning of the Act, be the inventor and the first user of it, so as to justify a patent.'

In the case of *Tangye* v. *Stott* (W. N. 1866, p. 68), it appeared that the plaintiff was the assignee of a patent obtained for improvements in pulley-blocks, and that previous to the patent there had been described in a book a pulley similar in principle to that patented, from which description one Moore had made a pulley. This he had tried a few times and then laid aside. The defendant had also made a pulley from the description in the book. It was held, however, that although the principle had been made known, the facts above mentioned were of the nature of experiments, and that as the patentee was the first to carry the invention fully into effect his patent was good.

In *Hills* v. *London Gas Light Co.* (5 H. & N. 312) it appeared that Mr. Croll had purified many thousand feet of gas by a mode for which Hills subsequently obtained a patent, and this gas was sold. The jury, on the trial of an action brought by Hills for the infringement of his patent, found that this was by way of experiment, and the Court refused to disturb the verdict. In delivering judgment on the defendants' rule for a new trial, the Court said, 'The

word "experiment," in the cases referred to, has been used, not as the sole test upon a matter of this sort, but as indicating a class of practice, and for the purpose of showing that if there has been a user of an invention not of a substantial character, but in the character of an experiment, then, although the thing has been done before, it does not preclude a person from taking out a patent for it; so that although what Croll did may not have been strictly in the nature of an experiment, still the jury have so found it, and we cannot grant a new trial.'

Other cases bearing upon the question of prior experimental user are *Brereton* v. *Richardson* (1 R. P. C. 165); *Moseley* v. *Victoria Rubber Co.* (4 R. P. C. 253); *Morgan* v. *Windover* (4 R. P. C. 417); *S. C.* on Appeal (5 R. P. C. 295); and in H. of L., 7 R. P. C. 130; *Edison and Swan Co.* v. *Holland*, Court of Appeal (6 R. P. C. 277, 283); *Winby* v. *Manchester, &c., Tramways Co.* (6 R. P. C. 359).

Prior Imperfect Machines.—The fact that there had previously been made a machine which turned out a failure will not invalidate the right of a patentee who has made a successful machine with the same object, although there may be a certain degree of similarity between some of the details of the two machines (*Murray* v. *Clayton*, 7 L. R. Ch. 570). And in *Barlow* v. *Baylis* (1 Griff. P. C. 44), where a machine, alleged to be an anticipation of a patented machine, was shown to have been so imperfect as to be incapable of doing the promised work 'more or less badly,' it was held not to have deprived the later machine of the attribute of novelty.

Earlier Inventions having a similar object.—It is sometimes argued that a patentee is not to be deemed the true and first inventor, if a patent for a similar object had been previously obtained by another inventor; but this contention will not prevail when it can be shown that the earlier patentee had not secured the principle, and that the means by which the object is attempted to be accomplished are substantially different in the two cases.

Kneller obtained a patent for an apparatus for the

evaporation of liquids and solutions at a low temperature. The apparatus consisted of pipes or tubes, along which air was forced nearly to the bottom of the vessel containing the liquid to be evaporated, which air, passing through small holes in the submerged tubes, traversed the liquid and carried off the aqueous particles. The invalidity of this patent was attempted to be proved by showing that an invention having a similar object in view had been previously patented. But when it appeared that the earlier invention consisted in propelling a quantity of heated air into the lower part of the vessel containing the liquid, and causing such air to pass through the liquid in streams, by means of a perforated coil of pipe or colander, the jury found that, although the principle of both inventions consisted in forcing air in finely divided streams through a fluid, for the purpose of facilitating evaporation, yet the modes by which this was effected in the two cases were sufficiently distinct to acquit the latter invention of being a piracy of the former; and that the latter patent was not invalidated by reason of want of novelty in the invention. The Court was of the same opinion, upon the application for a rule to set this verdict aside. (*Hullett* v. *Hague*, 1 Carp. Rep. 501; 2 B. and A. 370.)

In *Minter* v. *Mower* (1 W. P. C. 140) it appeared that the plaintiff had taken out a patent for an improvement in reclining chairs, which consisted in the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acted as a counterbalance to the pressure against the back. Mower, the defendant, made chairs in imitation of Minter's chair, and contended, in an action for an infringement of the patent, that the plaintiff was not the first and true inventor, alleging that one Brown had, previously to the patent, made chairs embodying a similar principle. It appeared, however, that although Brown's chair contained a similar principle to that patented, it was encumbered with machinery which rendered it a very different thing from the plaintiff's. *Lord Denman* said that, supposing Brown's chair to have been a chair with a self-

adjusting leverage (*i.e.* a chair similar to the plaintiff's), if the encumbering additional part had been away, 'then the question is, whether the principle of self-adjustment was at all discoverable or thought of at that time.' Because, it seems to me, if that principle might have been deduced from the machinery of the chair that was made, but it was so encumbered and connected with other machinery that nobody did make that discovery, or ever found out that they could have a chair with a self-adjusting leverage, by reason of that or any other defect in the chair actually made; it seems to me that does not prevent this from being a new invention, when the plaintiff says, I have discovered, throwing aside everything but this self-adjusting leverage itself, something that will produce an effect, which I think a very beneficial one.'

PUBLICATION IN PRINTED BOOKS.

It has been repeatedly held that an inventor's claim to novelty is destroyed by showing the previous publication of the invention in some printed book in use in Great Britain. *Mr. Justice Buller*, in *Rex* v. *Arkwright* (1 W. P. C. 72), said, 'It is admitted that this is not a new discovery; for Emmerson's book was produced, which was printed a third time in the year 1773, and that is precisely the same as this.' 'Although' (said *Tindal, C. J.*, in *Cornish* v. *Keene*, 1 W. P. C. 507) 'it is proved that the invention is a new discovery, so far as the world is concerned, yet if anybody has been able to show that although that was new—that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A or B, or taken it from a book printed in England, and which was open to all the world—then it would become an important question whether he was the first and original inventor of it.' In the course of the argument of the case of *The Household Company* v. *Neilson* (1 W. P. C. 673), an appeal from the Court of Session in Scotland to the House of Lords, *Lyndhurst, L. C.*, asked, 'If the machine is published in a book, distinctly and closely described, corresponding with

the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed books, without reference to anything that has been done.'

If the foreign book containing a description of an invention has been circulated in England (*Reg.* v. *Steiner*, Newton's Lond. Jour. vol. xl. p. 71), or even if only four copies of the foreign book are sent over to a bookseller in this country and by him exposed for sale, only one being actually sold to a public library (*Lang* v. *Gisborne*, 31 Beav. 133), a patent subsequently obtained by an independent inventor is invalid.

However, where the book relied upon as evidence of a disclosure before the date of his patent of the patentee's invention, a skate, was an American book containing a copy of a drawing of the skate attached to the patentee's American patent, and which book had been received by a librarian of the Patent Office Library in London about thirty-seven days before the date of the English patent without being entered either in the list of donations or in the catalogue of the library, and nothing more was known of it until another librarian found it many months afterwards on a shelf in a corridor leading to the public room, which corridor was open to the public, all this was held by *Sir G. Jessel, M. R.*, and afterwards by the Court of Appeal, not to prove a publication sufficient to invalidate the patent. (*Plimpton* v. *Spiller*, L. R. 6 Ch. D. 412.)

In the case of *Otto* v. *Steel* (31 Ch. D. 241, and 3 R. P. C. 112) *Mr. Justice Pearson* held that the simple fact that a copy of a French book was in the inner library of the British Museum was not sufficient publication to lead to the inference that whatever was found in that book had become part of the public stock of common knowledge.

Two specifications in the German language of German patents, with drawings, were deposited in the Library of the Patent Office, London, the one more than two years, the other forty days, before the date of a British patent, and

entries of these specifications were published in the official Patents Journal and their subject-matter stated, a footnote being appended to the effect that the specifications might be seen in the Library. It was held that this amounted to a publication of the inventions in this country. (*Harris* v. *Rothwell*, 31 Ch. D. 416; *S. C.* 3 R. P. C. 383; 4 R. P. C. 225.)

It may be inferred from some of the preceding cases that when the validity of a patent is contested on the ground of the invention having been previously communicated to the world by a book, it is not necessary to show that the patentee derived his knowledge of the invention from such book. And it was expressly decided in *Stead* v. *Williams* (2 W. P. C. 142), that if the invention has been already made public by any description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the true and first inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted.

The application of this rule must depend upon the particular circumstances of each case. The existence of a single copy of the work in a depository where it had long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation. The question will be, whether, upon the whole evidence, there has been such a publication as to make the description a part of the public stock of information. (See also *Plimpton* v. *Malcolmson*, L. R. 3 Ch. D. 531; *Plimpton* v. *Spiller*, L. R. 6 Ch. D. 412; *Von Heyden* v. *Neustadt*, 50 L. J. N. S. Ch. 126; *United Telephone Co.* v. *Harrison*, L. R. 21 Ch. D. 721.)

If a published drawing of a machine is sufficient of itself to enable a mechanist to construct the machine, that would be enough to invalidate a subsequent patent for a similar machine. (Per *Lord Esher, M. R.*, in *Herrburger* v. *Squire*, on Appeal, 6 R. P. C. 198.)

PUBLICATION IN THE SPECIFICATION UNDER A PRIOR PATENT.

The law as regards the publication of the invention in the specification under a prior patent is precisely the same as that with reference to a publication in a printed book. The invention has been deprived of its requisite attribute of novelty if it has been described in a previous specification, whether the patent has or has not expired.[1] If, prior to his obtaining a patent, any part of that which is of the substance of the invention has been communicated to the public in the shape of a specification of any other patent, he cannot claim the benefit of his patent. (*Lord Ellenborough*, in *Huddart* v. *Grimshaw*, 1 W. P. C. 86; and see *Jones* v. *Berger*, 1 W. P. C. 550.)

In the case of *Macnamara* v. *Hulse* (2 W. P. C. 128), an action for the infringement of a patent for a method of paving streets with blocks in the form of two solid rhombs placed one in front of the other, in opposite directions, so that each side of a block was bevelled both inwards and outwards; it was proved that the defendant used blocks, each consisting of a single solid rhomb, and then fastened two together by pins, so that two of the defendant's blocks thus fastened exactly resembled one of the plaintiff's blocks. This was the infringement complained of. The defendant, at the trial, put in the specification of an expired patent, obtained by one M'Arthy, for a pavement in which each block had two bevels inwards and two outwards on the same side. If M'Arthy's block were cut into two, it would make two blocks similar to the plaintiff's; if cut into four, it would make four blocks similar to the defendant's. Both judge and jury thought that, under the circumstances, the plaintiff's invention was destitute of novelty. The plaintiff asserted that the defendant had infringed his patent by

[1] The operation of this Rule is now narrowed by Art. 4 of the International Convention, and by Sect. 103 of the Patents Act, 1883. Any person who has duly registered an application for a patent in any of the States of the Union enjoys a right of priority to a British patent for a period of seven months from the date of his foreign application, although the invention may have been meanwhile published or used in this country.

cutting his block into two. The defendant showed that the plaintiff, in forming his block, had only cut M'Arthy's block into two. The plaintiff, in support of his own patent, was bound to contend that M'Arthy's invention and his own were distinct; but then if he established that, it followed that his own and the defendant's were likewise distinct, in which case there was no infringement.

Even the specification under a worthless patent might sufficiently disclose the invention so as to anticipate a subsequent patent. (Per *Lord Halsbury, C.*, in *Kaye* v. *Chubb*, 5 R. P. C. 648.)

But if the prior inventor had not shown how the invention is to be practically carried out, and an independent inventor does this and fully explains the mode in which the result is obtainable, his patent will be held good. In the case of *Betts* v. *Menzies* (10 H. L. C. 117) it was held that a general description in a prior specification or in a published book, even if suggesting information or involving some speculative theory pertinent to the invention in question, is not to be considered as anticipating a subsequent patent involving a practical invention unless the antecedent publication contains the same amount of practical and useful information. Betts's patent was for the production of a material capable of application to many useful purposes by combining thin sheets of lead and tin by means of pressure. It appeared that as far back as 1804 one Dobbs had patented a process for making a new material by combining lead and tin by pressure, but he did not with any precision define the relative thicknesses of the sheets of metal nor the degree of pressure to be applied, whereas Mr. Betts entered minutely into those points. Moreover, it was not shown that the earlier process had ever been carried into practice. Under these circumstances the House of Lords held that Betts's invention had not been anticipated. See also the observations of *Wood, V. C.*, in the subsequent case of *Betts* v. *De Vitre* (11 L. T. N. S. 445), in which the validity of the same patent was in question.

Under a patent for the purification of gas, Mr. Croll

claimed the use of oxides of iron, which expression was held to mean both hydrated and anhydrous oxides of iron. Mr. Hills afterwards obtained a patent for the use of anhydrous oxide of iron for the same purpose; but it was said, in an action which he brought for the infringement of his patent, that he had been anticipated by Croll. On his part it was argued that as it was a fact that some oxides would answer the object in view, and some would not, it became a subject for investigation and experiment to ascertain what oxides it would be proper to employ, and that when he had made the discovery he was entitled to a patent in respect of it. The Court of Exchequer held that this discovery might properly be the subject of a patent. (*Hills* v. *London Gas Light Company*, 5 H. and N. 312.)

If a specification contains a general statement which gives no clear intimation either by its own construction or in the opinion of a workman of ordinary skill, either as to the result or as to the means, and if a person should out of the general words which describe nothing discover something not inconsistent with them but not disclosed by them, he may obtain a patent for his discovery. But if in a specification one of the modes described in it gives a clear result by clear means, although the person who took out the patent does not see that result, and another person by studying the specification more carefully perceives the result, he has no right to take out a patent for it. (Per *Lord Esher, M. R.*, in *Kaye* v. *Chubb*, 4 R. P. C. 298.)

The antecedent description of an invention which will have the effect of depriving a subsequently patented invention of the attribute of novelty, must (according to *Lord Westbury, C.*, in *Hills* v. *Evans*, 4 De G. F. & J. 288) 'be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery, without the necessity of making further experiments and gaining further information, before the invention can be made useful. If something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another

valid patent. . . . 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. The invention must be shown to have been before made known. Whatever, therefore, 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 and accurate, and gives a specific rule of practical application. . . . 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.'

According to *L. J. Brett*, in *Otto* v. *Linford* (Court of Appeal, 46 L. T. N. S. 39), the question to be considered is whether the prior specification, fairly read by a person conversant with such matters, would give a reasonably clear description of the later invention—that is, supposing it to relate to a machine, whether it would give a reasonably clear description of a machine that would effect what the machine of the later inventor effects. (See also *Von Heyden* v. *Neustadt*, 50 L. J. N. S. 126; *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 252; *Bray* v. *Gardner*, 4 R. P. C. 400; *Haslam* v. *Hall*, 5 R. P. C. 19; *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 122.)

'Even if there is identity of language in two specifications' (said *Lord Westbury*, in *Betts* v. *Menzies*, 10 H. L. C. 152), 'and (remembering that those specifications describe external objects) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predicate of the two with certainty that they describe the same identical external object, unless you ascertain that the terms of art used in the one have pre-

cisely the same signification, and denote the same external objects at the date of the one specification as they do at the date of the other.'

Where a provisional specification contained an incomplete description of a piece of mechanism which was omitted from the complete specification, and another patent was afterwards obtained for similar mechanism, the passage in the preceding patent was held not to be a prior publication so as to vitiate the second patent, because the description was not sufficient to enable a workman to make the object. (*Stoner* v. *Todd*, L. R. 4 Ch. D. 58.)

PRIOR PUBLICATION BY INVENTOR.

We now come to a series of cases which declare the law with regard to a publication of the patented invention before the date of the patent—not by persons other than the patentee, but by the patentee himself. A person may be the true and first inventor of that for which he has obtained a patent, and yet he may have disentitled himself to the benefit of it by prior dealings with or prior publication of the invention. The law says that a man may not first publish his discovery and then obtain protection for it against the public, whom he has already made acquainted with it. Having done that, he has no longer anything to give as a consideration for the grant.

Some of the cases will show inventors who intend to protect their inventions that they should be extremely cautious how they deal with them before applying for patents.

An inventor does not lose his right to a patent by keeping his invention to himself after its completion, provided there is no profitable user of it (*Bentley* v. *Fleming*, 1 C. & K. 587). But it may be remarked that, although not destructive of his right, delay is here especially dangerous, and the fact might, under certain circumstances, be used as a strong argument against a patentee.

In the same case of *Bentley* v. *Fleming* it was held that an inventor might safely deposit a machine of his invention,

for a reasonable time, in a room open to the public, for the purpose of having its properties tested.

In *Bramah* v. *Hardcastle* (Holroyd, 81), which was an action for infringing a patent for a water-closet, it appeared that the patentee had made two or three of these machines before he obtained his patent; but it was admitted that this fact would not of itself invalidate the patent. (See also *Lewis* v. *Marling*, 4 C. & P. 57; and *Moss* v. *Malings*, 3 R. P. C. 378.)

Where the article had been manufactured for sale, and offered for sale, although not sold, this was held to be such a user of the invention as rendered a subsequently obtained patent bad. (*Oxley* v. *Holden*, 8 C. B. N. S. 666.)

Where delay occurred in the issue of a patent without the patentee's fault, the manufacture by him of articles before the date of the patent for the purpose of being sold after the date was held not to render the patent invalid. (*Betts* v. *Menzies*, 4 Jur. N. S. 477.)

In *Wood* v. *Zimmer* (Holt, N. P. C. 57) it appeared in evidence that a great quantity of verdigris made according to the patented process had been sold by the inventor in the course of four months before the patent was obtained, and *Gibbs, C. J.*, held 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.'

In July 1875 a patent was granted to Thomas Muir for improvements in the manufacture of meal and flour. On the trial of an action for the infringement of this patent the patentee himself proved that in June 1875 he had made flour according to the patented process and had sold it in the ordinary way of business. The action was thereupon dismissed. (*Germ Milling Co.* v. *Robinson*, 3 R. P. C. 253, and see *Re Adamson's Patent*, 6 De G. M. & G. 420.)

Patterson, one of the three gas referees appointed by the Board of Trade under the City of London Gas Act of 1868, procured a patent for an improved mode of purifying coal gas on March 9, 1872. He had obtained a knowledge of the patented process in the course of his labours as

referee, and it appeared that it had been described by the three referees, including Patterson, in an official report, which, though dated January 31, 1872, and printed about that time, was kept back from the authorities to whom it ought to have been presented as soon as printed, until March 26. A suit for an infringement of the patent having been decided in Patterson's favour, the case went before the Court of Appeal (*Patterson* v. *Gas Light and Coke Company*, L. R. 2 Ch. D. 812), and then to the House of Lords (L. R. 3 App. Cas. 239), where it was held that the knowledge obtained in the discharge of his duty by one referee, and by him communicated to his colleagues, became at once public property, and could not be treated by them as confidential, nor could one of their number take out a patent for it.

It was contended in *Thomson* v. *Batty* (6 R. P. C. 84) that because the patentee of an invention relating to improvements in the mariner's compass had previously published a mathematical paper discussing the objects to be aimed at, the difficulties to be overcome, and the conditions to be satisfied in all attempts to improve the compass, he had disclosed his invention to the public and was not afterwards entitled to a patent. But the judge at the trial of an action for infringement held that what the patentee had done was very far from disclosing how the principles enunciated in the paper were to be realised in an improved instrument, and that as he had shown this by his specification after much thought and many experiments, he was entitled to a patent for his very useful invention.

Confidential Communications.—If, however, the inventor communicates his discovery to a few persons under the bond or seal of confidence, there is no publication. In *Morgan* v. *Seward* (1 W. P. C. 194), an action which arose out of Galloway's patent for an improved method of constructing paddle-wheels, it was given in evidence that before the date of the patent, Curtis, an English engineer, made for Morgan, the managing director of the Venice and Trieste Company, two pairs of wheels upon the principle mentioned in the

specification. Galloway, the patentee, gave instructions to Curtis under an injunction of secrecy, because he was about to take out a patent. The wheels when completed at Curtis's factory were not shown or exposed to the view of those who might happen to come there. After remaining a short time they were sent to Venice in April 1829. Curtis deposed that they were sold to the company, without saying by whom, and Morgan paid Curtis for them. Galloway obtained a patent on July 22, 1829, and it was assigned by him to Morgan. Upon these facts it was contended that the invention, at the date of the letters patent, was not new, in the legal sense of that word. *Parke, B.*, delivered the judgment of the Court of Exchequer, before whom the point was argued, in these words:—'The word "manufacture" in the statute must be construed in one of two ways: it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in England, either by the patentee himself or any other person; nor, indeed, any use of the machine in a foreign country before the date of the patent. If the term "manufacture" be construed to mean "the mode of constructing the machine," there has been no use or exercise of it in England, in any sense which can be called "public." The wheels were constructed under the direction of the inventor, by an engineer and his servants, with an injunction of secrecy, on the express ground that the inventor was about to take out a patent, and that injunction was observed; and this makes the case, so far, the same as if they had been constructed by the inventor's own hands, in his own private workshop, and no third person had seen them whilst in progress. The operation, indeed, was disclosed to the plaintiff Morgan; but there is sufficient evidence that Morgan at that time was connected with the inventor, and designing to take a share in the patent. A disclosure of the nature of the invention to such a person under such circumstances must surely be considered private and confidential. The only remaining circumstance is,

that Morgan paid for the machines, with the privity of Galloway, on behalf of the steam company; but there was no proof that he paid more than the price of the machines, as for ordinary work of that description; and the jury would also be well warranted in finding that he did so with the intention that the machine should be used abroad only by this company, which, as it carried on its transactions in a foreign country, may be considered as a foreign company. . . . It must be admitted that if the patentee himself had, before his patent, constructed machines for sale, as an article of commerce, for gain to himself, and been in the practice of selling them publicly—that is, to any one of the public who would buy—the invention would not be new at the date of the patent. This was laid down in the case of *Wood* v. *Zimmer*. . . . But we do not think that the patent is defeated on the ground of the want of novelty, and the previous public use or exercise of it, by a single instance of a transaction such as this.' And see the remarks of *L. J. Fry* in *Humphersen* v. *Syer* (4 R. P. C. 414; also the case of *The Useful Patents Co.* v. *Rylands* (2 R. P. C. 262).

Experiments by the Patentee.—It has been decided that when the disclosure of the secret took place during the course of experiments made by the patentee with the view of testing or improving the invention (such disclosure being unavoidable and not more than was necessary for the purpose), this will not take away the inventor's right to a patent.

Before applying for a patent the inventor of a machine entrusted it to a person for the purpose of trying experiments, and it was held that he had not thereby made it public. (*Bentley* v. *Fleming*, 1 Car. & K. 578.)

Shortly before an application was made for improvements in constructing and stopping bottles, 600 dozen of bottles made by the inventor according to the specification under the patent subsequently obtained were sent to a person as samples. It was held by *Mr. Justice Chitty* that they were sent out by way of experiment, and

that the fact did not render the patent invalid. (*The Useful Patents Co.* v. *Rylands*, 2 R. P. C. 262.)

Adamson invented certain machinery whilst engaged in the execution of a contract for the erection of a pier. This machinery he used on the works for four months before he applied for a patent. It was held that there had been public user, and not merely experiments inasmuch as he had derived a profit from the employment of the invention after its utility had been ascertained, and during all that time the public had free access to it. (*Re Adamson's Patent*, 6 De G. M. & G. 420.)

A series of experiments performed in the presence of others may however be not only successful, but also actually of pecuniary benefit to the inventor, and yet it will not necessarily be held that he has given the invention to the world. That the coincidence of actual immediate profit with the carrying on of experiments is not of itself sufficient to render a subsequently obtained patent void was decided in the case of *Newall* v. *Elliott* (4 C. B. N. S. 269), where it appeared that the inventor of a machine for paying out telegraph wire had not procured a patent until after he had laid down a cable in deep sea by means of the machine. Experiments on dry land had been indecisive; an opportunity for making decisive experiments was presented in the course of executing a Government contract for laying down a cable at sea. Such experiments were made, and the Court held that they did not amount to a gift of the invention to the world.

PRIOR PUBLICATION BY OTHER PERSONS.

The two following cases will show that prior publication of the invention by persons other than the patentee may take place without reference to public user, or publication in a book, or specification. Saxby obtained a patent in 1874 for improvements in signalling apparatus on railways. The invention comprised a combination of two old contrivances having the same object in view. To show prior publication the following facts were proved. The particular improvement in question had been previously suggested to the mind of a

Mr. Edwards, who was in the employment of the London and North-Western Railway Company, and who, by merely placing the two old contrivances side by side, had made working drawings, which it was admitted showed a combination substantially the same as Saxby's subsequently patented modification. Two sets of tracings were made from the drawings in Edwards's office, where four or five draughtsmen were kept, and they were afterwards sent to the offices of the L. & N. W. R. Company at Crewe, where there were seventeen or eighteen draughtsmen. The general public visited these offices, and there was evidence that the drawings or tracings had there been seen by an engineer who was not in any way connected with the railway company. No secrecy or concealment was imposed or observed in regard to the drawings and tracings with reference either to the draughtsmen in these two offices or to members of the general public who might happen to visit them. Further, the particular combination had been explained by Edwards to a person in Saxby's employment, and rough sketches of the drawing were left with him. The drawings and tracings were laid before the chief engineer of the railway company, and they were submitted to their locomotive committee. Besides all this a working apparatus was made from the drawings by a person in the employment of the company, and this was placed in the pattern-shop, where it was subjected to trial. All this occurred before the end of the year 1873. It was held by a Divisional Court, by the Court of Appeal, and by the House of Lords, that these facts amounted to evidence of a publication of the invention, that such a disclosure of it had been made as placed it within reach of the public, and therefore that Saxby's patent was invalid. (*Saxby* v. *Gloucester Waggon Co.*, 2 Griffin P. C. 54.)

The defendant applied for a patent in respect of a waste water preventer in January 1885, but did not proceed with his application. In the next month the plaintiff applied for a patent in respect of what was substantially the same invention, and in due course a patent

was granted to him. An action for infringement having been brought it was proved that before the date of the patent the defendant had openly exhibited in his shop to at least two persons, without any injunction of secrecy, the apparatus described by him in his provisional specification. It was held by the Court of Appeal that there had been publication of the invention, and that the patent was invalid. (*Humpherson* v. *Syer*, 4 R. P. C. 407.) In this case *L. J. Fry* framed the enquiry in this form: Is it the fair conclusion from the evidence that some English people, under no obligation to secrecy arising from confidence or good faith towards the patentee, knew of the invention at the date of the patent?

PUBLIC EXHIBITIONS.

If an inventor desires to exhibit at an industrial or international exhibition an invention which he has not yet patented, but for which he intends to obtain a patent, he should proceed under the 39th section of the Act of 1883, Rule 15 of the Patents Rules, 1890, and the 3rd section of the Act of 1886. The 39th section enacts that (*a*) the exhibition of an invention at an industrial or international exhibition certified as such by the Board of Trade, or (*b*) the publication of any description of the invention during the period of the holding of the exhibition, or (*c*) the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or (*d*) 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. But the exhibitor must, before exhibiting the invention, give the Comptroller the notice prescribed by Rule 15 of his intention so to do; and the application for a patent must be made before or within six months from the date of the opening of the exhibition. The inventor must also furnish to the Comp-

troller a brief description of the invention with drawings if necessary, and such other information as the Comptroller may require. The notice must bear a stamp of 10*s*. (See Form O, *post*, p. 402.)

By the 3rd section of the amending Act of 1886 it was enacted that it should be lawful for the Queen, by Order in Council, from time to time to declare that section 39 of the Patents Act of 1883 shall apply to any exhibition (held out of the United Kingdom) mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said section, of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

CHAPTER V.

AMOUNT OF INVENTION REQUIRED TO SUPPORT A PATENT—PATENTS FOR 'APPLICATIONS.'

THESE subjects are closely connected with that of Novelty, but it will be more convenient to separate the cases and treat of them in a distinct chapter. In contesting the validity of a patent, it is often objected that there had been no exercise of ingenuity on the part of the alleged inventor in arriving at his invention, and that mere accident or good luck is not entitled to a patent privilege. Where, however, the utility of the invention is great, and the novelty undoubted, these facts will come in aid of an apparent want of ingenuity on the part of the inventor.

'If a patentee would succeed it is necessary for him to show not merely newness in the sense of doing a thing which has not been done before, but he must show newness in the shape of novelty by producing a thing which requires some exertion of mind that could properly be called invention.' (Per *Mr. Justice Willes* in *Tatham* v. *Dania*, 1 Griff. P. C. 213. And see what fell from *L. J. Cotton* and the other LL.JJ. in *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 123; *Britain* v. *Hirsch*, 5 R. P. C. 232; and *Ccle* v. *Saqui*, 6 R. P. C. 41.)

A person having obtained a patent for adapting an iron plate to the heel of a boot similar to what had been previously adapted to the toe, brought an action for an infringement. In the Court of Appeal *L. J. Cotton* said: 'In my opinion a thing is not to be called new in the sense of *Crane* v. *Price*, simply because that particular thing has never been seen before. To be new in a patent sense it is necessary that the novelty must show invention, and it is

not sufficient to be new in the patent sense for the patentee to be the true and first inventor, if it is merely using that which has been used for an analogous purpose before the date of the patent.' (*Blakey* v. *Latham*, 6 R. P. C. 187.)

It is impossible, however, to lay down any general rule as to the amount of ingenuity which is essential to support a patent. In nice cases there can be no certainty previous to a judicial decision on the point whether any given patent is or is not impeachable on the ground of want of ingenuity; which phrase cannot be regarded, perhaps, as different from want of novelty. All that can be done is to study the decisions already made, and to be guided by those cases which approach nearest to the one about which doubt may be felt. Some of the decisions, indeed, seem to conflict with others; and it will require a good deal of acute discrimination on the part of those who are called on to advise inventors, to distinguish the line which separates what is patentable from what is not patentable.

The question whether that which is claimed as an improvement of an existing machine was the result of a sufficient amount of invention often raises one of the most difficult points of patent law. 'There are many cases in which the moment you see the specification or improvement you can say without any evidence at all, "This is a most remarkable, elaborate, and difficult thing to do; it must have required great invention, and there can be no dispute about it," and no dispute is ever raised. On the other hand, there are some things so clear, so simple, and so obvious, that a person having any decent amount of mechanical knowledge says at once it is so easy that it requires no invention at all; it is a mere mechanical equivalent, or that sort of thing, that any ordinary workman can do without any difficulty. Then there are a great number of cases between, where the improvement is no doubt small, but it may require a considerable amount of invention to effect it.' Per *Sir G. Jessel, M. R.*, in *Saxby* v. *The Gloucester Waggon Company* (Court of Appeal shorthand writer's notes; see an abridged report in 2 Griff. P. C. 54).

'In point of law' (said *L. C. J. Tindal*, in *Crane* v. *Price*, 1 W. P. C. 411), 'the labour of thought or experiment, and the expenditure of money, are not the essential grounds of consideration on which the question whether the invention is or is not the subject-matter of a patent ought to depend; for if the invention be new and useful to the public, it is not material whether it be the result of long experiment and profound search, or of some sudden and lucky thought, or mere accidental discovery.' In either of the two last cases, the practical realisation of a good idea will be considered a sufficiently meritorious consideration for the exclusive privilege granted to the inventor, although the actual amount of thought expended in making the invention was trifling. The case of water-tabbies, so often mentioned in courts of law, is a case in point. The invention (according to *Mr. Justice Buller* in *Boulton* v. *Bull*, 2 H. Bl. 463, 1 Carp. 117) first owed its rise to the accident of a man spitting on a floor-cloth, which changed its colour, whence he reasoned, had his patent, and made, it is said, a considerable fortune by it.

The making of iron gas-tubes without the use of a mandrel, viz. by welding them without striking them on a solid surface, 'seems to be a very simple invention' (said *Lyndhurst, C.B.*, in *Russell* v. *Cowley*, 1 W. P. C. 467); 'but it has been productive of great advantages inasmuch as it has enabled the manufacturer to construct pipes of lengths much beyond what could be done previously to this discovery.' Here the great utility of the invention came in aid of the apparent smallness of the step, and the patent was sustained.

Lace made from cotton thread had the defect of being covered with a kind of down, which injured its appearance and diminished its value. A similar defect was removed from muslin by passing it over rollers of heated iron, and from mitts and stockings by the action of flame, fed by oil or alcohol. It occurred to Mr. Hall that the flame of gas might be employed in the manufacture of cotton lace; and after some failures he succeeded in inventing a method for

removing the unsightly fibres by the flame of gas. A patent obtained for this invention was held good. (*Hall* v. *Jarvis*, 1 W. P. C. 100.)

The case of *Lewis* v. *Davis* (1 W. P. C. 488) is often cited to show that a small degree of invention suffices to sustain a patent, provided it be attended with useful results. The object of the patent was the shearing of cloth from *list to list* by means of rotatory cutters. Now a rotatory cutter to shear from *end to end* was known, and cutting from list to list by *means of shears* was also known. 'However' (said *Lord Tenterden, C. J.*, to the jury, on the trial of an action for the infringement of the patent, in which the question of novelty was raised), 'if before the plaintiffs' patent the cutting from list to list, and the doing that by means of rotatory cutters, *were not combined*, I am of opinion that this is such an invention by the plaintiffs as will entitle them to maintain the present action.'

In the case of *Hinks* v. *Safety Lighting Company* (L. R. 4 Ch. D. 607), *Sir G. Jessel, M. R.*, held that the substitution of a flat wick for a solid round wick in a lamp was a sufficient ground for a patent; because, notwithstanding the apparent smallness of the invention, it had the effect of largely increasing the illuminating power of the lamp; in other words, it was a very useful invention. In giving judgment in the plaintiff's favour the learned judge made the following remark:—'Where a slight 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 the subject of a patent; and as far as a rough test goes, I know of no better.' (See also *Frearson* v. *Loe*, L. R. 9 Ch. D. 48.)

The specification under E. L. Hayward's patent for improvements in pavement lights, described a combination of three things, viz. a frame, a flange, and a piece of glass moulded below into a particular form of prism; the object being, when the apparatus was inserted in a floor or pavement, to throw light coming from above into a room or

space beneath, in a lateral direction. Now these three things taken separately were old. However, the Court of Appeal held, affirming the decision of the divisional court, that although a glass prism of another form had been employed in the decks of ships for the purpose of admitting light in a manner resembling, to a certain extent, the plan adopted by Hayward, this was a novel combination of old parts with a useful result; and farther, that the combination displayed a sufficient amount of invention to support the patent. The Lords Justices were of opinion that Hayward was an inventor, since he had found out something new, and had made a useful article that had not been made before. 'If it is not an invention' (said *L. J. Bramwell*), 'it is very strange that it has never been done before. . . . It is not the less an invention because it required but small inventive powers to enable the patentee to do it.' (*Hayward* v. *Hamilton*, 1 Griff. P. C. 115.)

In *Reynolds* v. *Amos* (3 R. P. C. 215), *V. C. Bacon* held that the application of chains in compressing and storing ensilage was a patentable invention; but this must be considered an extreme case.

In the case of *The Edison & Swan Electric Light Co.* v. *Woodhouse* (4 R. P. C. 79), an action for the infringement of an electric lamp, one of the main questions in dispute was whether Edison's carbon *filament* had been anticipated by the previous employment by Swan of a carbon *rod*. It was held in the Court of Appeal by two judges against one that the disuse of Swan's lamp showed that it had not been successful, whilst Edison's lamp had been accepted by the public, and that the difference between a carbon rod and a carbon filament was the difference between failure and success. It might be that a patent for the filament alone could not be sustained, but when the filament was part of a combination which was useful and took the place of a rod in a combination that was useless, there was no reason why the new useful combination might not be the subject of a good patent.

The preceding cases may be compared with a series,

which we will now cite, where the inventions were adjudged insufficient to support patents.

Brunton took out a patent for (amongst other things) an alleged improvement in anchors. The two flukes were made in one, and had such a thickness of metal in the middle that they might there be pierced with a hole for the insertion of the shank. Previously the two flukes had been joined by welding them to the shank. The real improvement was in the avoidance of welding, and this was done by well-known means. There was no proof that the anchors made by the new process were better than those previously made; and since the invention seemed to be nothing more than the adoption of a known operation practised in analogous cases, it was held not patentable. (*Brunton* v. *Hawkes*, 4 B. & Ald. 540.) 'Now' (said *Abbott, C. J.*, in his judgment), 'a patent for a machine, each part of which was in use before, but in which the combination of different parts is new and a new result is produced, is good, because there is novelty in the combination. Here formerly three pieces were united together; Brunton only unites two; and if the union had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent; but I think that a man cannot be entitled to a patent for uniting two things instead of three, where that union is effected in a mode well known and long practised for a similar purpose.' (*Brunton* v. *Hawkes*, 1 Carp. Rep. 410.)

In the case of *Kay* v. *Marshall* (2 W. P. C. 34), it appeared that Kay had procured a patent for improved machinery for preparing and spinning flax, and the invention was declared in the specification to consist of new machinery for macerating flax previous to drawing and spinning it; and also for improved machinery for spinning the same after having been so prepared. It appeared that the improvement in the spinning machinery was nothing more than the placing of certain portions of a well-known machine within two inches and a half of each other, instead of at a greater distance. It was shown that the dis-

tances between the parts in question had not been fixed in previous machines, but had been varied according to circumstances; and, further, that the reach used in *cotton* spinning had actually been less than two inches and a half. It was held by the Court of C. P. that the adoption of a particular distance did not, under these circumstances, constitute such an invention as would support a patent. 'Suppose,' said *Tindal, C. J.*, on delivering judgment, 'suppose a patent to have been first obtained for some entirely new method, either chemical or mechanical, of reducing the fibres of flax to a short staple, we think that a second patent could not be taken out for an improved mode of machinery in spinning flax which consisted of nothing more than the spinning of short staple of flax by a spinning machine of a reach of a given length, not less than that already in use for the spinning of cotton, the effect of which would be to prevent the first patentee from working his invention with the old machine at the proper reach.' Or, as *Lord Cottenham* put it in the House of Lords, if the plaintiff (Kay) has a right to tell the rest of the world that they shall not use the common spinning machine with rollers at two and a half inches distance, then the existence of the patent deprives all the rest of the world of the right of using the ordinary spinning machine in the form in which they had a right to use it before the patent was granted.

To adjust in a more beneficial manner than before the distance between two of the working parts in check-action pianos was held not to be good subject-matter for a patent. (*Herrburger* v. *Squire*, 5 R. P. C. 581; affirmed on app. 6 R. P. C. 194.)

In the case of *Tatham* v. *Dania* (1 Griff. P. C. 213), it was held by the judge who tried the action that the use of sets of rollers in a series going at different rates of speed for the purpose of making fibrous or textile materials pass through in a form more convenient and advantageous for being operated upon by the succeeding part of the machine was not the proper subject of a patent when it was shown

that a similar contrivance had been employed previously in cotton spinning.

In *Parkes* v. *Stevens* (L. R. 8 Eq. 358), *James, V. C.*, was of opinion that the substitution of a slide for a hinge in the door of a lamp could not be the foundation of a valid patent. And in the same case (affirmed L. R. 5 Ch. D. 36) it was held that the application of a sliding door to a *spherical* lamp was not patentable, as it was proved that sliding doors had been previously fitted to *cylindrical* lamps.

When it was shown that there existed a previous patent for preserving meat already salted, dried, or smoked, by dipping it into a solution of bisulphide of lime, it was held that an invention, the object of which was to preserve *fresh* meat by dipping it into a like solution, was not patentable. (*Bailey* v. *Roberton*, L. R. 3 App. Ca. 1079.)

In the case of *Saxby* v. *The Gloucester Waggon Company* (L. R. 7 Q. B. D. 305), it was decided by the House of Lords that a combination of an old locking apparatus with an old actuating apparatus for working railway signals and points did not display a sufficient amount of invention to support a patent, it having been proved that the combination was effected by obvious means and in a way that did not call for more than ordinary mechanical skill. (See also *Williams* v. *Nye*, 7 R. P. C. 37, 62.)

Notwithstanding proof of practical usefulness and of a large sale, it was held by the Court of Appeal that the making of the handles of bats used in lawn tennis and other games with two opposite grooves and with an enlarged end was not good subject-matter for a patent. (*Slazenger* v. *Feltham*, 6 R. P. C. 232.)

The discovery that a particular advantage may be obtained by using a known machine in a known manner is not a patentable invention. (*Tetley* v. *Easton*, 2 C. B. N. S. 706.)

In the process of calendering woven fabrics the use of a roller and a bowl, and the means of regulating the relative speed of their motions, were well known. In the process

of *calendering*, the roller was smooth, and the speeds of the roller and bowls were different. In *embossing*, the roller had a pattern upon it, and the speeds of the roller and bowl were equal. A patent was taken out for a combination of a patterned roller with a bowl moving at unequal speeds. The invention was held not to be one which could be the subject of a valid patent, as it amounted to nothing more than showing how to use an existing machine more beneficially than had been previously known. Although the patentee might have discovered that by making the *patterned* roller and the bowl move at different speeds instead of at the same speed, and by moving the fabric transversely when fed up, the machine could be worked more advantageously than formerly, he had no right to prohibit the owner from using his property as he thought fit. (*Ralston* v. *Smith*, 9 C. B. N. S. 117; affirmed by the *House of Lords*, 11 H. L. C. 223.)

In the case of *Patterson* v. *The Gas Light and Coke Company* (L. R. 2 Ch. D. 812, L. R. 3 App. Cas. 239), a patentee claimed the employment of sulphides of calcium in separate purifiers as a means of purifying coal gas from sulphur existing in other forms than that of sulphuretted hydrogen. Now, as it was well known to chemists, and had been long taught in books, that sulphides of calcium would absorb sulphur compounds—moreover, as it was plain that if sulphide of calcium was to be used, a separate holder must be employed, and as no special apparatus was suggested, it was held that there was no invention that would support a patent. The same patentee also claimed a method or system of employing lime purifiers in succession, whereby the contents of all the purifiers, or any required number of them, could be converted into sulphides of calcium, and also, if required, be maintained in that condition. Now, lime purifiers in succession had been in general use for a long time, and the patentee had not devised either a new process or any new apparatus. What he really thought he had discovered was that if the carbonic acid, which is the first thing taken up by the lime, was

allowed to enter the last purifiers, it would have a deleterious effect on the purifying process. It ought, therefore, to be removed at the beginning of the operation. But this, though it might be a very useful piece of advice, and an instruction of great value, was held by the Court of Appeal not to constitute of itself the subject-matter of a patent.

A specification claimed the use of solid naphthaline prepared in the form of sticks, rods, or pellets, for the enrichment of illuminating gas. Now as liquid naphthaline had been previously applied for enriching illuminating gas, and as solid naphthaline in the granular form and in the form of sticks was a known article, it was held that this application of a known article to a purpose for which the same article in another form had been previously applied was not proper subject-matter for a patent. (*Albo-Carbon Light Co.* v. *Kidd*, 4 R. P. C. 535.)

The following have been judicially held not to be patentable inventions: The use of steel hoops in a petticoat instead of whalebone hoops (*Thompson* v. *James*, 32 Bea. 570); the use of hollow iron columns filled with water in the construction of buildings and for the support of fireproof floors (*Tickelpenny* v. *Army and Navy Co-operative Society*, 5 R. P. C. 405); the substitution of a hinge or pivot for a slide in certain cooking apparatus (*Fletcher* v. *Aiden*, 5 R. P. C. 46); the substitution of a pivot for a hinge in a nail-making machine (*United Horseshoe & Nail Co.* v. *Swedish Horse Nail Co.*, 6 R. P. C. 1).[1]

PATENTS FOR 'APPLICATIONS.'

These are patents for inventions which have reference to the application of an existing article to a purpose for which other similar articles have been previously used; or

[1] Other cases in which the inventions were held to be insufficient to support patents were *White* v. *Toms* (32 L. J. Ch. 204); *Jackson* v. *Needle* (2 R. P. C. 191); *Sharp* v. *Brauer* (3 R. P. C. 193); *Guilbert-Martin* v. *Kerr* (4 R. P. C. 18); *Britain* v. *Hirsch* (2 R. P. C. 74); *S. C.* on app. 226; *Walker* v. *Longford Wire Co.* (4 R. P. C. 281); *Rowcliffe* v. *Longford Wire Co.* (4 R. P. C. 287); *Haslam Co.* v. *Hall* (5 R. P. C. 21); *Longbottom* v. *Shaw* (5 R. P. C. 497; affirmed on appeal, 6 R. P. C. 143); *Gaulard and Gibb's Patent* (5 R. P. C. 525); *Herrburger* v. *Squire*, on appeal (6 R. P. C. 194); *Windover* v. *Morgan* (7 R. P. C. 130).

to the application of a well-known process to produce a well-known article; or to the application of a well-known process to effect a result in a well-known article after the same process has been publicly applied to an analogous article. When there is nothing new in the machinery or methods employed, patents for such applications are not favoured by the law, which looks upon the inventions as wanting in ingenuity or novelty. The rule is well established that the mere application of an old mechanical contrivance to an analogous purpose is not an invention for which a patent can be granted. 'In all the cases in which a patent has been supported' (said *Lord Campbell* in *Brook* v. *Aston*, 8 E. & B. 478) 'there has been some discovery, some invention. It has not been merely the application of the old machinery in the old manner to an analogous substance. That cannot be the subject of a patent.'

In *Harwood* v. *Great Northern Railway Company* (2 B. & S. 208), *Sir A. Cockburn, C. J.*, said: 'Although the authorities establish the proposition that the same means, apparatus, or mechanical contrivance cannot be applied to the same purpose, or to purposes so nearly cognate and similar as that the application of it in the one case naturally leads to the application of it when required in some other, still the question in every case is one of degree, whether the amount of affinity or similarity which exists between the two purposes is such as that they are substantially the same; and that determines whether the invention is sufficiently meritorious to be deserving of a patent.'

'If the use or application is merely analogous' (said *Mr. Justice Chitty* in *Lister* v. *Norton*, 3 R. P. C. 205) 'it is plain that the patent cannot be granted. When it is not only analogous, but is sufficiently out of the beaten track, the patent may be upheld. These general propositions are not precise or scientific. It is impracticable to frame propositions of a scientific character on this point. Every case must be decided on its peculiar merits and with reference to its own special circumstances. The authorities are necessarily decisions on particular cases, and are useful only

as affording some guide to the decision of the case before the Court.'

The following cases will illustrate the law as thus laid down by these learned judges:—

The casting of tubular boilers in one piece, similar boilers having been previously made in several pieces which were afterwards fastened together by means of cement, was held not to be an invention for which a valid patent could be obtained, although the result was useful and beneficial to the public. It was only the application of a well-known article, viz. iron, by a well-known process, viz. casting, to the production of a well-known article, tubular boilers. (*Ormson* v. *Clark*, 13 C. B. N. S. 337; *S. C.* in error, 14 C. B. N. S. 475.)

Again, the application of *double*-angle iron (a well-known article of commerce already applied to a variety of purposes) to the construction of hydraulic joints of telescopic gas-holders, instead of making them of two pieces of *single*-angle iron attached to a plate, was held not to be patentable. (*Horton* v. *Mabon*, 12 C. B. N. S. 437; *S. C.* in error, 16 C. B. N. S. 141.)

'The use of a new material to produce a known article is not the subject of a patent,' said *V. C. Malins*, in *Rushton* v. *Crawley* (L. R. 10 Eq. 522), a case where a man had taken out a patent for the use of a kind of wool called Russian tops in the manufacture of artificial hair. (See also *Thompson* v. *James*, 32 Beav. 570.)

In the case of *Losh* v. *Hague* (1 W. P. C. 202), the question was reduced to this—Is a man who finds a particular construction of wheel already in use for carriages on ordinary roads entitled to a patent for applying it to railway carriages, such application not having been previously made? *Lord Abinger* remarked that you cannot have a patent for applying a well-known thing, capable of being applied to fifty thousand different purposes, to an operation which is exactly analogous to what was done before. His lordship put this case: 'Suppose a man invents a pair of scissors to cut cloth with; if the scissors were never in-

vented before, he could take out a patent for it. If another man found he could cut silk with them, why should he take out a patent for that?' Again—'It would be a very extraordinary thing to say, that after all mankind have been accustomed to eat soup with a spoon, that a man could take out a patent because he says you might eat peas with a spoon.'

In an action for an alleged infringement of a patent for improvements in separating the fibres of cocoa-nut husks, it was shown that the principal part of the invention consisted in passing the split husks between crushing rollers, and that, for some time previous to the date of the patent, similar rollers had been employed in treating hemp. *Lord Campbell*, who presided at the trial, told the jury that the use of the crushing rollers having been thus anticipated, no claim for their application to the crushing of cocoa-nut husks would hold good. (*Hyde* v. *Trent*, Newton's Lond. Jour. vol. 45, p. 135. See also *Tatham* v. *Dania*, 1 Griff. P. C. 213.)

So, in the case of *Regina* v. *Cutler* (Macrory's Pat. Ca. 124–138), it was held by two judges on different occasions, that the mere application of a known article to a new use, the mode of application having been previously employed in applying analogous articles to the same purpose, cannot be made the subject of a patent. In this case the patent was for improvements in the construction of the tubular flues of steam boilers. The specification claimed the application of iron tubes coated with copper or brass to this purpose. This kind of tube was not new; nor was there any novelty in the way the patentee applied the tubes in the construction of flues, uncovered tubes having been previously used in a similar way.

In *The Patent Bottle Envelope Co.* v. *Seymer* (5 C. B. N. S. 164) it was held that the use of a model or mandrel in the form of a bottle in making envelopes for bottles out of rushes or straw could not be the subject of a patent, this being merely the application of a well-known tool to work previously untried materials or to produce new forms.

On the trial of *Bush* v. *Fox* (Macr. P. C. 163), it appeared that the invention, for an infringement of which the action was brought, consisted in the use of a caisson or hollow cylinder for building under water. It was proved at the trial that a similar caisson for building on land had been described in the specification of a patent granted several years previously. This, therefore, was only a new application of a machine previously applied to another purpose. 'I think' (said *Sir F. Pollock*, *C. B.*, to the jury) 'that a man cannot, if he has applied an old invention, or part of an old invention, to a new purpose, obtain a patent for such an invention. Both the plaintiff and the other witness say that the invention consists in the application, and not in the novelty of the thing itself—in other words, that the only novelty is in the application of the apparatus. I think that a patent cannot be taken out for such an application. If a man were to take out a patent for a telescope to be used to make observations on land, I do not think any one could say, "I will take out another patent for that telescope to be used for making observations on the sea."' On appeal to the House of Lords (Macr. P. C. 179), the judge's direction was held to be right.

In *Brook* v. *Aston* (8 E. & B. 478), it appeared that the plaintiff had obtained a patent in 1856 for improvements in finishing yarns of wool and hair; and that in 1853 he had taken out a patent for a process precisely similar except that it was applicable to the finishing of cotton and linen yarns. The patent of later date was held bad because the alleged invention was only the application of an old machine in an analogous manner to another but similar object. This decision was affirmed by the Court of Exchequer Chamber (5 Jur. N. S. 1025).

In the case of *Harwood* v. *The Great Northern Railway Company* (2 B. & S. 194; 11 H. L. C. 654), a patent for the application of 'fishes' to iron rails for railways, for the purpose of securing them, was held invalid, because a similar contrivance had been employed to fasten pieces of timber

together in the construction of bridges, and had also been used in various articles of machinery. *Mr. Justice Willes* said the invention for which the patent had been obtained was 'the mere application of an old contrivance in the old way to an analogous subject without novelty or invention in the mode of applying such old contrivance to the new purpose.'

Jordan's specification claimed the construction of ships with an iron frame combined with an external covering of timber planking for the sides, bilges, and bottoms. It appeared that a combination of wood and iron in the construction of ships was well known previous to the patent, and that frames partly of iron and partly of wood had been coated with iron. The Court decided that as iron and wood had both been long used in the construction of vessels, the application of wooden planking to the iron frame of a vessel, without any peculiarity in the nature of that planking, could not be the subject-matter of a patent. The alleged invention was as to one part nothing more than the substitution of one well-known and analogous material for another—that is, wood for iron—to effect the same purpose on an iron vessel; and as to another part, it was the application of the same old invention, viz. planking with timber, which had been formerly done on a wooden frame, for an analogous purpose on an iron frame. (*Jordan* v. *Moore*, L. R. 1 C. P. 624.)

If an old combination used in one kind of machine is applied to another but cognate kind of machine in which it had not been previously found, this application will not be considered novel for the purpose of supporting a patent unless some ingenuity or invention is displayed in the application. A patented improvement in a combined mowing and reaping machine consisted of a contrivance by which the cutting knife could be made to revolve more rapidly when cutting grass than when cutting corn. It was shown at the trial of an action for an infringement that a similar contrivance had been previously applied to a hay-making machine with the view of driving the tossing rakes quickly

or slowly at the will of the operator. The patent was therefore held to be invalid. (*Bamlett* v. *Picksley*, 1 Griffin, P. C. 40.) And so, the use of a guide in a frilling machine for the purpose of keeping down the work was held by *Sir G. Jessel, M. R.*, in *Hill* v. *Tombs* ('Engineer,' April 15, 1881, p. 274), not to be a patentable invention, because 'that was the use of known means for an analogous purpose,' guides of similar character having been employed in many other machines.

A patent was obtained for supporting the front of a carriage by C springs. In an action for infringement it was held by the House of Lords, reversing the decisions of the Courts below, that this was only the application of a known article to an analogous purpose, since similar springs (for they were not, strictly speaking, C springs) had been previously used at the back of a carriage, and in their application to the front there was no invention. (*Windover* v. *Morgan*, 7 R. P. C. 130.)

Compare the preceding cases with *Penn* v. *Bibby* (L. R. 2 Ch. 127). Mr. John Penn obtained a patent for an improvement in bearings and bushes for the shafts of screw-propellers, which consisted in grooving the inner surfaces of the bearings of the shaft, and placing in the grooves strips of wood, which projected beyond the inner surface of the metal bearings, so as to support the rubbing action of the shaft whilst water was allowed to circulate freely in the intermediate channels. The metal bearings previously employed had been found unable to withstand for any length of time the friction of the screw-shaft, and it almost seemed as if the screw-propeller would have to be abandoned; but Mr. Penn's simple contrivance got over the difficulty, and the invention came into general use. It was contended that the alleged invention was merely a new application of an old and well-known thing, viz. wood, and the wooden bearings of grindstones and waterwheels were adduced as showing that the invention was not novel. 'In every case of this description' (said *Lord Chelmsford*), 'one main consideration seems to be whether the new application lies so

much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study. Now, strictly applying this test to the present case, it appears to me impossible to say that the patentee's invention is merely the application of an old thing to a new purpose. The only examples of old use . . . are of a totally different character, and for a totally different object. It is difficult to believe that bearings of this description could ever have suggested the application of wood to the bearings of screw-propellers in the way described in the patent.'

A patent was obtained for improvements in the manufacture of glass. The invention consisted of a mode of forming the sides of the chambers, where the materials were fused, in such a manner that a current of cool air might circulate and so prevent over-heating. Although the principle was previously known, yet, as the contrivance when applied to the manufacture of glass rendered the process of melting less costly and less dangerous, the patent was held good. (*Cannington* v. *Nuttall*, L. R. 5 H. L. 205.)

The existence of a patent for a certain application of a given thing (which thing is not new) will not vitiate a subsequent patent for another application of the same thing, provided that the two applications are perfectly distinct, and that the second application is not in any way comprised in the specification under the first patent. Vaucher took out a patent for an improvement in packing hydraulic and other machines by means of a lining of soft metal, whereby certain parts of the machines were rendered air-tight and water-tight. It was subsequently discovered by Newton that the same material, soft metal, could be usefully employed in diminishing the friction of machinery in rapid motion, and in preventing the generation of heat, by applying it to the surfaces in contact. It was held, in an action for an infringement of Newton's patent, that the two applications of soft metal were essentially different, and Newton's invention was not wanting in novelty. (*Newton* v. *Vaucher*, 6 Exch. Rep. 859.)

Chemical Inventions.—The same distinction, which, it has been seen, is made between mechanical applications brought about by an obvious exercise of the inventive faculty and those where it is scarcely appreciable, holds good with regard to the applications of the chemical properties of matter. Thus, in *Calvert* v. *Ashburn* (Pract. Mech. Journal, vol. ii. 2nd ser. 97), it was held that the application of caustic alkalies for the purpose of dissolving the gluten contained in flour employed in the manufacture of *size* could not be the subject of a patent, inasmuch as caustic alkalies had been previously used for the purpose of dissolving gluten in the manufacture of *starch*. See also the observations of *Lord Hatherley* and *Lord Blackburn* in *Bailey* v. *Roberton* (L. R. 3 App. Cas. 1055, 1073, 1079).

This case, in which the amount of invention was adjudged too small to support the patent, should be compared with that of *Young* v. *Fernie* (4 Giff. 597, 612), a suit for an injunction to restrain the infringement of a patent for obtaining paraffine oil by the distillation of bituminous *coals*, wherein it was proved that previously to the plaintiff's invention paraffine oil had been extracted from bituminous *shale* by distillation. It was argued for the defendants, on the authority of *Regina* v. *Cutler*, *Brook* v. *Aston*, and such cases, that bituminous shale being a substance analogous to bituminous coal, the invention of the plaintiff was not in law the subject of a patent. But *V. C. Stuart* said that there seemed to be no analogy between the cases cited and the present one. And in giving judgment in favour of the validity of the patent, his Honour observed, 'Inventions in mechanics are as widely different from inventions in economical chemistry as the laws and operations of mechanical forces differ from the laws of chemical affinities, and the results of analysis and experiment in the comparatively infant science of chemistry, with its boundless field of undiscovered laws and undiscovered substances. This observation, as applied to reported cases, will strike the mind of every lawyer who has even a slight elementary knowledge

of both sciences.' (See also the case of *Muntz* v. *Foster*, *ante*.)

In *Hills* v. *London Gas Light Company* (5 H. & N. 369), an action upon a patent for the purification of coal gas by the use of hydrated oxides of iron, it was argued that, as the property which these oxides possess of combining with sulphuretted hydrogen, the deleterious part of unpurified coal gas, was a perfectly well-known property, the mere application of the oxides to remove sulphuretted hydrogen from gas could not be the subject of a patent. The Court of Exchequer held that if a man were simply to say that he claimed the use of hydrated oxides of iron for the purification of gas, without saying how they were to be applied, the objection might possibly be well founded; but as the patentee had shown how the oxides were to be used, the objection failed. (Comp. *Ormson* v. *Clarke*, 13 C. B. N. S. 337; in error, 14 C. B. N. S. 475.)

Patents for Improvements on Inventions the Subject of Existing Patents.—Inventors after obtaining a patent frequently discover that their invention is capable of considerable improvement, and they think it desirable to take out a second patent for the improvements.

In *Lister* v. *Leather* (8 E. & B. 1004), it was held that a second patent for an improvement on an invention which is the subject of a previous patent afterwards assigned to the second patentee is not void as being contrary to public policy. And the same rule holds good in regard to a second patent obtained by the same inventor.

A patented invention which was afterwards greatly improved by a second patent obtained by the same inventor is not on that account thrown open to the world. (*Thomson* v. *Batty*, 6 R. P. C. 100.) Nor is a patent defeated because later inventions improved the articles produced, and they ceased to be made in accordance with the directions of the specification. (*Edison & Swan Co.* v. *Holland*, 6 R. P. C. 243.)

CHAPTER VI.

WHO MAY BE A PATENTEE.

By the fourth section of the Patents Act of 1883, any person, whether a British subject or not, is empowered to make application for a patent. Two or more persons may make a joint application, and a patent may be granted to them jointly. By the fifth section of that Act, an application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors.

No application will be entertained at the Patent Office unless the person or persons claiming to be the true and first inventor or inventors are applicants (*Marshall's Application*, 5 R. P. C. 661), but other persons who are non-inventors may join in the application, and in that case the patent will be issued to all the applicants, who will be joint patentees. (Patents Act, 1885, s. 5.) Although there is no form enabling an inventor and an incorporated company to apply jointly for a patent, this may be done, since by sect. 117 of the Act of 1883 'person' includes a body corporate.

For a long series of years the strict letter of the statute of James has been so far relaxed as to allow persons simply importing an invention from a foreign country into this realm to obtain a patent in respect of it, provided that such an invention is new and useful, the administrators of the law always reading the word 'inventor,' in the statute, as embracing an importer. 'I must look on it (said *Jessel, M. R.*) as a sort of anomalous decision, not depending on any principle whatever, which has acquired by time and recognition the force of law.' The first decision on this point

since the Statute of Monopolies, was in the case of *Edgebery* v. *Stevens*, to be found in the second volume of 'Salkeld's Reports,' p. 477: 'If the invention be new in England a patent may be granted, though the thing was practised beyond sea before; for the statute speaks of new manufactures within this realm; so that if it 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.'

In *Carpenter* v. *Smith* (1 W. P. C. 535), *Lord Abinger* said, 'A man has a right to a patent not only for his own original invention, but he has a right to a patent if he is the first person who brings into England an invention which is used abroad and not known in England.'

Previous to the Act of 1883 it had been decided (*Chappell* v. *Purday*, 14 M. & W. 318) that an alien might be the grantee of a patent; and *In re Wirth's Patent* (L. R. 12 Ch. D. 303), that a patent might be granted to an alien resident abroad for an invention communicated to him by another alien also resident abroad, but Form A of the Patents Rules, 1890, renders it necessary that the applicant for a communication patent must be resident in the United Kingdom (see p. 395). In *Beard* v. *Egerton* (3 C. B. Rep. 97), it was held that the grant might be taken either in the alien's name or in the name of a British subject in trust for him.

It has long been a common practice, which the new Act has not abrogated, to grant patents to British subjects resident in Great Britain in respect of inventions communicated from abroad. If the grantee is the agent of the foreign inventor, the letters patent are subsequently assigned to the latter or his nominee. But in these cases it is necessary for the applicant to state in his application that the subject-matter was communicated to him from abroad. (*Milligan* v. *Marsh*, 2 Jur. N. S. 1083.) (See the form of application A 1 in the second schedule of the Patents Rules, 1890.)

By the International Convention and section 103 of the Patents Act of 1883 a foreign patentee has an absolute right of priority for his invention for a period of seven months from

the date of his foreign application, notwithstanding any intermediate publication or use of the invention in this country. A British patent under the Convention will only be granted to the person who made the foreign application. It will not be granted to an agent. (*Shallenberger's Application*, 6 R. P. C. 550; *Carez's Application*, 6 R. P. C. 552.)

A British subject has never been permitted to obtain a patent for an invention derived from another British subject residing in the United Kingdom, and it seems doubtful whether a valid patent could be obtained in respect of an invention communicated by an alien permanently domiciled here.

No objection can be taken to a patent on the ground that one of the grantees is an infant. (*Cheavin* v. *Walker*, L. R. 5 Ch. D. 858.) And there can be no doubt that female inventors, whether married or single, are entitled to the grant of a patent.

In consequence of the decision of the Court in *Marsden* v. *Saville Street Foundry Co.* (L. R. 3 Ex. D. 203), a clause (sect. 34) was introduced into the Patents Act of 1883, by which it was provided that 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; but 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 or to have been the true and first inventor of the invention.

By the twelfth section of the same Act (sub-section 3 *b*) it is enacted that if the applicant for a patent dies before the expiration of fifteen months from the date of application (and before the patent shall have been sealed), the patent may be granted to his legal representative, and sealed at any time within twelve months after the applicant's death.

The word 'patentee' as used in the Patents Acts signifies 'the person for the time being entitled to the benefit of the patent' (s. 46 of the Act of 1883).

CHAPTER VII.

PROCEDURE ON APPLYING FOR A PATENT—THE TITLE.

THE proceedings on the application for a patent[1] commence with the preparation of a Declaration, to the effect that the applicant is in possession of an invention whereof he, or in the case of a joint application one or more of the applicants, claims or claim to be the true and first inventor or inventors. With this is combined a petition that a patent may be granted to the applicant or applicants for the invention. The form of the declaration, which must bear the stamp of 1*l.*, is set forth in the second schedule to the Patents Rules, 1890. The declaration must be signed by the applicants, but need not be made under the Statutory Declarations Act, 1835. When left at the Patent Office it must be accompanied by either a provisional or complete Specification (see the next chapter), and that specification must in either case commence with the title (Patents Act, 1883, sect. 5). The application and specification are then referred by the Comptroller to an examiner, part of whose duty is to ascertain and report whether the title sufficiently indicates the subject-matter of the invention (sect. 6); and if he reports that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may require it to be amended (sect. 7). He is virtually empowered to make other amendments in the title under

[1] Stamped forms of application have been placed on sale at the chief post-offices of the United Kingdom. Applications, as well as any other document, notice, &c., required to be left at the Patent Office, may be sent in a prepaid letter through the post. See section 97 of the Act of 1883, and Rule 16A of the Patents Rules, 1890.

The procedure on applications is regulated by Rules 8, 9, 10, 16A, 17, 17A, and 23 of the Patents Rules, 1890.

sects. 7 and 9 of the Act of 1883. (*Dart's Patents*, 1 Griff. P. C. 307.)

THE TITLE.

The title is the short statement by which the inventor sets forth in very general terms the object of the invention; and this being repeated in the body of the declaration, and finally transferred into the patent, is styled the Title of the Patent. Thus he may apply for a patent in respect of 'Improvements in locomotive steam engines,' or for 'A new or improved sewing machine,' or for 'Improved methods of purifying illuminating gas.' The words here placed between marks of quotation would be the titles of the respective patents.

At a time when a provisional specification was not required to be lodged with the petition, and when consequently the title could not be officially compared with a description of the invention, it not unfrequently happened that the title was incorrect, and patents were sometimes lost from want of care in this particular. For if the title was too comprehensive—that is, if it extended to matters not included in the invention, the patent was bad. If, on the other hand, it was too narrow, besides excluding by its very terms something which the inventor might have secured, the patent would likewise be held bad in case the specification went beyond the title.

But now, since the title is accompanied by an outline or full description of the invention, in the shape of a provisional or complete specification, and the papers are submitted to an official examination, any false step that the inventor may make in regard to the title will probably be detected, and can be rectified. This, however, will involve delay and trouble, and the inventor will do well to take some pains to frame an unobjectionable title at first.

In framing the title the inventor must carefully avoid the use of language which will lay it open to the charges of being 'too large, uncertain, inapplicable, inexplicable, inconsistent, vague, ambiguous, and at variance with the specification'—charges which it appears from a reported case

were once heaped upon an unfortunate title relating to the simple matter of paving with wood.

With the view of showing the inventor who is engaged in preparing his application for a patent what are the principal errors to be avoided in framing the title, the following cases have been selected from those decided by the Courts under the old law.

Where the title bore evidence upon its face of an intention to deceive the public as to the subject-matter of the invention, this was a point which weighed heavily against the patentee. (*Cook* v. *Pearce*, 8 Q. B. 1044.)

The title of the invention spoke of a *tapering* brush; the specification disclosed the invention of a brush in which the bristles were of an unequal length, but there was no tapering to a point. The patent was held bad. (*Rex* v. *Metcalf*, 2 Stark. R. 249.)

The title was 'Certain improvements in the flageolet, whereby the fingering will be rendered more easy, and notes produced that were never before produced.' It appeared that only one new note was produced by the improved instrument, and this was held to be a fatal objection. (*Bainbridge* v. *Wigley*, Parl. Rep. 197.)

The title was 'A new and improved method of drying and preparing malt;' but the invention specified was a process of producing a colouring matter for beer, by submitting malt, prepared in the ordinary manner, to a high temperature. This patent was likewise held bad. (*Rex* v. *Wheeler*, 2 B. & Ald. 345.)

A patent was obtained for an improved method of lighting cities, towns, and villages; but it appeared that the invention consisted in the improvement of an old street lamp. The title was held too general in its terms, and the patent could not be supported. (*Cochrane* v. *Smethurst*, 1 Stark. 205.)

Another patent held bad, by reason of having too general a title, was that contested in the case of *Campion* v. *Benyon* (1 Carp. Rep. 418). The patent was for 'A new and improved method of making double canvas and sailcloth with

hemp and flax, or either of them, without any starch whatever;' but it appeared that double sailcloth had been made without starch before the patent, and the invention proved really to be a new method of preparing hemp and flax, with a view to its being woven into canvas and sailcloth.

The title of Felton's patent described the invention as a machine for giving an edge to knives, razors, scissors, and other cutting instruments; but the invention appeared, from the specification, not to be applicable to scissors, and the patent was adjudged to be void. (*Felton* v. *Greaves*, 3 C. & P. 611.)

In *Newall* v. *Elliott* (10 Jur. N. S. 955; *S. C.* 13 W. R. 11), *C. B. Pollock* stated that, when Attorney-General, he had refused an application for a patent for 'An improvement in locomotion,' such a title being too general.

On the other hand, the titles in the following cases were held sufficiently certain: 'Improvements in the manufacture of plated articles,' when there was only a single improvement (*Nickels* v. *Haslam*, 8 Scott, N. R. 97). 'A *new or improved* method of obtaining the reproduction of all the images received in the focus of the camera obscura,' leaving it a matter of doubt whether the method was altogether a new one, or only an improvement (*Beard* v. *Egerton*, 3 C. B. 97). A process for more distinctly showing the finer lines of an engraving by means of a glazed surface on the paper designed to receive the impression was held sufficiently described by the words 'Certain improvements in copper and other plate printing' (*Sturtz* v. *De la Rue*, 5 Russ. 322). Title, 'Improvements in Carriages:' the specification described improvements in adapting German shutters to carriages. But as such shutters can only be applied to covered carriages, and the title spoke generally of carriages, it was contended that it was too large. After argument, it was held a sufficiently accurate title; *Tindal, C. J.*, observing that it would endanger the validity of very many patents which have hitherto been free from exception, if the mere fact that their titles were given in such terms as to be capable of comprising other inventions besides that con-

tained in the specification were sufficient to avoid them, in the absence of any proof of intention to commit a fraud on the Crown, or to deceive or mislead the public. (*Cook* v. *Pearce*, 8 Q. B. 1044.)

A patent was obtained for 'Improvements in machinery for the manufacture of bobbin net lace.' It was objected that the invention really was only for making a spot during a particular part of the process, and was useless where that addition was not wanted. The Court, however, overruled the objection. (*Fisher* v. *Dewick*, 1 W. P. C. 264.)

The title and specification must be read together; and if the former should be ambiguous, the latter may explain it. Thus the title of Neilson's patent was an invention 'for the improved application of air to produce heat in furnaces where bellows or other blowing-apparatus are required.' The invention disclosed by the specification was the introduction into the furnace of air heated between the blowing-apparatus and the furnace; and it was held that this answered sufficiently well to the title. (*Neilson* v. *Harford*, 1 W. P. C. 312, 373; *Lister* v. *Norton*, 3 R. P. C. 203.)

CHAPTER VIII.

THE PROVISIONAL SPECIFICATION.

THE fifth section of the Patents Act of 1883 directs that the application [1] for a patent must be accompanied by either a provisional or complete specification. The latter instrument is the subject of the next chapter; it is to the former that we now draw the reader's attention. According to the third subsection of the same section, a provisional specification must describe the nature of the invention, and be accompanied by drawings if required; whilst by the fifth subsection it is directed that it must commence with the title. (As to size, form, &c., of the drawings, if any, see Patents Rules, 1890, rr. 30–33.) It ought not to comprise more than *one invention* (sect. 33), and the Comptroller may refuse to accept it if it does comprise more. (As to the meaning of the words 'one invention' see p. 96.) The applicant, however, is authorised by Rule 19 of the Patents Rules, 1890, to amend the application so as to make it apply to one invention only; and he can then make application, if he thinks proper, for separate patents for the other inventions. In that case every such application will be dated as of the date of the first application, as if originally made on that date.

[1] The form of the application is given as already stated in the second schedule to the Patents Rules, 1890, Form A. In case of an application on a communication from abroad Form A 1 must be used. For the form of provisional specification see Rules 5 and 6 (2) of 1890, and Form B in the second schedule to those rules. As to the procedure the reader is referred to the note on p. 89.

Specifications and all other documents must be written or printed in large and legible characters upon one side only of strong wide-ruled foolscap paper measuring thirteen by eight inches, leaving a margin of two inches on the left-hand; and the signatures of the applicants or agents thereto must be written in a large and legible hand (see Rule 10).

Then by the sixth section the Comptroller is directed to refer every application to an examiner, who is to ascertain and report to him 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. If the examiner reports (sect. 7 as altered by the 2nd sect. of the Patents Act, 1888) that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who will, 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. (*Brown's Application*, 2 Griffin, P. C. 1.) When an application has been accepted, the Comptroller will give notice thereof to the applicant, and by Rule 21 of the Patents Rules, 1890, he will advertise such acceptance in the official journal of the Patent Office. If (subs. 5 of sect. 2, Act 1888), after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the Comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.

Under section 4 of the Patents Act of 1885, where an

application for a patent has been abandoned or become void, the specification and drawings (if any) shall not at any time be open to public inspection or be published by the Comptroller.

When the legal representative of a deceased inventor intends to apply for a patent, under the authority of the 34th section of the Patent Act of 1883, the application must be made within six months of the decease, and it must contain a declaration by the legal representative that he believes the person whom he represents to have been the true and first inventor of the invention. An official copy of or extract from the will or letters of administration must accompany the application in proof of the applicant's title. (Rule 20 of 1890.)

'*One Invention.*'—It has been already stated that by sect. 33 of the Act of 1883 the provisional specification ought not to comprise more than one invention. The question whether a provisional specification comprises more than one invention will often be a delicate one, and no general rule can be laid down for the inventor's guidance. If the words of the Act were interpreted strictly patents would be greatly multiplied, whilst a liberal interpretation cannot go far in the face of the clear language of the statute. The Comptroller must be left to exercise his discretion on the facts of each case subject to appeal to the law officer. It has been said by a law officer that if there are several heads of invention it ought to be shown in the provisional specification that they have all a common object. Under the title of Improvements in Railway Carriages, an attempt to include improvements in the seats, doors, windows, coupling apparatus, and illumination would doubtless be a failure, and yet all these heads of invention have the common object of improving a railway carriage.

The following cases have been decided by the law officers on appeal and have been reported.

Where there is a new combination of parts and some of the subordinate parts are themselves new, they may all be included along with the entire combination in the same

specification. But where a specification describes a combination of parts and also comprises a minor combination which is stated to be applicable not only to the purpose of the entire combination but to a purpose distinct therefrom, the latter application must be considered a different invention and ought not to be included in the same specification. (*Jones's Patent*, 1 Griff. P. C. 265; *Hearson's Patent*, 1 Griff. P. C. 266; *Robinson's Patent*, 1 Griff. P. C. 267.)

Alternative devices for effecting the same object ought to be treated as one invention; for example, several devices of an analogous nature, or cognate devices, for securing the rails on a railway. (*Jones's Patent*, 1 Griff. P. C. 265.)

The thirty-third section of the Act of 1883 enacts that 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.

Office of the Provisional Specification.—A general description of the invention, fairly showing its real nature, is sufficient for the provisional specification. An applicant is not bound to describe the way in which his invention can be carried into effect. (*Woodward* v. *Sansum*, 4 R. P. C. 174; *Siddell* v. *Vickers*, 8 R. P. C. 426.) It is enough if its principal and essential features are set forth.

In the next chapter it will be shown that it is not allowable to vary the invention in any important respect when the complete specification is in preparation, or to introduce new matter into that instrument; and the chief object of the provisional specification is to afford means for securing the identity of the invention at the time of application and when finally specified.

The provisional specification is not intended to ascertain the *entirety* but the *identity* of the invention, said *Pollock, C. B.*, in *Newall* v. *Elliott*, 1 H. & C. 797. And see also *Foxwell* v. *Bostock*, 4 De G. J. & S. 298.

'The office of the provisional specification' (said *Mr. Justice Byles* in *Newall* v. *Elliott*, 4 C. B. N. S. 269) '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.'

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

'The office of the provisional specification' (said *Lord Chelmsford* in *Penn* v. *Bibby*, L. R. 2 Ch. 127) 'is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officer what is to be the subject-matter of the patent. It is not at all necessary that the provisional specification should describe the mode or modes in which the invention is to be worked or carried out.'

For further remarks by various learned judges as to the office of the provisional specification, see *Woodward* v. *Sansum* (4 R. P. C. 178), *Siddell* v. *Vickers* (5 R. P. C. 79, 426), *Crampton* v. *Patents Investment Co.* (5 R. P. C. 397).

When an inventor is engaged in preparing his provisional specification, he ought to keep in mind that every part of the invention, excepting details, intended to be claimed by the complete specification, ought to be foreshadowed in the preliminary instrument.

It sometimes happens that, after a provisional specification has been lodged, an inventor thinks it desirable to abandon it and lodge another in a different form. Under the old law it was held that a patent obtained upon a second provisional specification, when filed within the six months' term of provisional protection, was valid, as the first specification had not become public by the mere fact of abandonment. And in *Lister* v. *Norton* (3 R. P. C. 206) it was held that where an inventor had lodged a provisional specification, and then within six months had lodged a second one for the same invention, proceeding upon the latter to obtain a patent dated in 1881, it was no objection to the patent

that the patentee had in the interval between the dates of lodging the two specifications, and therefore before the date of his patent, publicly exercised his invention and sold the products.

By the fourteenth section of the Patents Act of 1883, 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 termed provisional protection.

This protection, however, gives the applicant no rights against the public. He is only protected against the consequences of his own publication in case of his employing workmen, making experiments, or exercising the invention (*Ex parte Bates & Redgate*, L. R. 4 Ch. 577); that is to say, he will not thereby prejudice the patent afterwards granted to him. He must not forget, however, that as he cannot take any legal proceedings for infringements committed before the publication of the complete specification (sect. 13), his dealings with the invention even under protection should be conducted with due caution.

CHAPTER IX.

THE COMPLETE SPECIFICATION.

WHETHER there ever existed an implied compact between a patentee and the public with regard to a disclosure of the invention, as many lawyers formerly supposed and some doubted, is a question which it is unnecessary to discuss in these pages. It is sufficient for all practical purposes to say that the Patents Act of 1852 imposed upon every patentee the duty of particularly describing and ascertaining the nature of the invention, and in what manner it was to be performed; and that the Patents Act of 1883 has laid upon every applicant a like obligation in identical language (sect. 5, subs. 4). The instrument by which the applicant undertakes to satisfy the requirements of the law is known as the Complete Specification. It is by this instrument that the public are made acquainted with the inventor's secret, and he is bound to describe it clearly and fully, with the view of enabling others, when the proper time comes, to work the invention if they desire to do so. In the meantime the public are entitled to know what it is they are prohibited from using, that they may not unawares incur liability.

The reader will perceive before he arrives at the end of this chapter that the security of a patentee's privileges largely depends upon the shape given to this instrument. It is therefore necessary that he should exercise the greatest care and circumspection in its preparation. As Sir George Jessel, then Master of the Rolls, once remarked in court, 'it is very difficult to draw a complete specification.' And the judges on the bench very frequently complain of the ambiguities, obscurities, and other defects of the specifica-

tions that go before them, not only rendering the task of interpretation difficult, but putting in peril the whole edifice which the patentee has laboriously built. It may be thought, perhaps, that after the document has passed the ordeal of official examination no further question ought to arise as to its sufficiency. An inventor, however, should not place too great reliance upon this, but should adopt every means in his power to make not only the complete but the provisional specification perfectly correct, and in accordance with both the letter and the spirit of the law, that they may, if at any time disputed, be held good upon their own merits.

After an account of the procedure has been given the greater part of this chapter will be devoted to a statement of the rules by which the inventor should be guided in preparing this important instrument. These rules will make him acquainted with the chief requirements of the law, and will put him on his guard as to the faults which he is most likely to commit. Our remarks will be supported throughout by references to the reported cases.

PROCEDURE.

We have seen in the last chapter that, by the fifth section of the Patents Act of 1883, an application for a patent must be accompanied by either a provisional or a complete specification. In the great majority of cases an inventor needs further time for making experiments and testing the invention with a view to its improvement and the working out of details, all which may be safely done under the protection of a provisional specification; but if he lodges the complete instrument at the time of application he deprives himself of the opportunity of improving the invention, and of adding, perhaps greatly, to its value. Moreover, inventors who wish to obtain patents in other countries should bear in mind that the previous publication of an invention by a complete specification in this country may be a bar to a valid patent unless the case is one that

falls within the operation of the fourth Article of the International Convention as to Patents.

The complete specification, whether left on application or subsequently, must, in the words of the Act, '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.' It must commence with the title, and must end with a distinct statement of the invention claimed. The form of the instrument is Form C, given in the second schedule of the Patents Rules, 1890.[1] If left with the application (sect. 6) the papers are referred by the Comptroller to an examiner, whose duty it is to ascertain and report to the Comptroller whether the nature of the invention has been fairly described, and whether 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. If the examiner reports in the negative, the Comptroller may require the application, specification, or drawings, to be amended before he proceeds with the application, subject to appeal to the law officer, who, after hearing the applicant and the Comptroller, may make an order determining whether, and subject to what condition, if any, the application shall be accepted. When an application has been accepted, the Comptroller will give notice thereof to the applicant.

If the applicant (sect. 8) does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.[2] But by the third section of the Act of 1885 the Comptroller has power to extend the time for another

[1] A fee of 4*l.* is payable on filing a complete specification with the application: if filed afterwards the fee is 3*l.* As to the size of paper, &c., see the footnote on page 106.

[2] Whenever the last day for leaving a document at the Patent Office shall happen to fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or on a day observed as a holiday at the Bank of England, or on any day observed as a public fast or thanksgiving, the document may be left on the day next following any of these days (sect. 98).

month on payment of the prescribed fee. And Rule 50 of the Patents Rules, 1890, requires the application for an extension of time to state in detail in what circumstances and upon what grounds the extension is applied for. The Comptroller may require proof of the applicant's allegations.

If the complete specification is not left within due time the application will be deemed to be abandoned. The nine months will expire on that day of the ninth month which corresponds to the day of the application. Where a complete specification is left after a provisional specification the Comptroller will refer both 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 described in the provisional. If the examiner reports that these conditions 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 such refusal is subject to appeal to the law officer, who, if required, will hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions the complete specification shall be accepted (subsect. 3).

The fact that the complete narrows the range of the provisional specification (*e.g.* where the provisional specification sets forth a principle, whilst the complete only claims special mechanism) affords the Comptroller no ground of itself for refusing to accept the former. (*Everitt's Case*, 2 Griffin P. C. 27.)

In the opinion of two law officers, if the specification ends with a real statement of the invention claimed, distinct from the description of the invention in the body of the specification, the Patent Office has no power to inquire whether the claim is in conformity with the preceding description or not. But a claim which says no more than 'I claim the improved machine substantially as described' would not be enough. That would be held to be merely a

colourable compliance with the 5th subs. of sect. 5 of the Act of 1883, and not 'a distinct statement of the invention claimed.' (*Smith's Patent*, 1 Griffin P. C. 268.)

In *Siddell* v. *Vickers* (5 R. P. C. 416) it was held that the 5th subs. of sect. 5 of the Act of 1883 is merely directory, and that non-compliance with the direction does not invalidate the patent.

As a patentee cannot recover damages in respect of infringements committed before the publication of the complete specification (sect. 13 of the Act of 1883), it is desirable in many cases to file it with as little delay as possible.

By subs. 4 of sect. 9 of the Act of 1883, 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 will become void at the expiration of that time. But the Comptroller is empowered, by sect. 3 of the Act of 1885, to extend the time for three months on payment of the prescribed fee.

In the event of the applicant's death before leaving a complete specification, no power is expressly given by the Act to his legal representatives to leave a specification at the Patent Office, or to the Comptroller to accept it if tendered. But perhaps it may be held that such powers are impliedly given by subsection (3 *b*) of the twelfth section of the Act of 1883.

On the acceptance of the complete specification the Comptroller will give notice thereof to the applicant, and will advertise the acceptance in the official journal, and the application and specification or specifications, with the drawings, if any, will then be open to public inspection (sect. 10, and Rules 21 and 22).[1]

After the acceptance of a complete specification, and

[1] If anyone wishes to be informed as soon as a complete specification is accepted, or an application for an amendment is entered, he should forward a copy of Form Q (bearing a stamp of 5*s*.), with a request for such information.

until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him (sect. 15).

It was decided in *Ex parte Henry* (L. R. 8 Ch. 167) that a second applicant who had filed a complete specification along with his petition under the ninth section of the Patents Act of 1852, and had thereby become entitled for six months to 'the like powers, rights, and privileges, as might have been conferred on him by letters patent duly sealed, as of the date of the application,' did not acquire the rights of a patentee so as to prevent a person who had previously applied for a patent for a similar invention from obtaining a patent.

It is directed by section 9, subsection 5 (as amended by sect. 3 of the Act of 1888), that the reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed. Specifications accompanying applications which have been abandoned or become void are not to be open to public inspection or published (sect. 4 of the Act of 1885).

Clerical Errors.—In case of clerical errors in a specification they could only be amended formerly by order of the Master of the Rolls. (*Johnson's Patent*, L. R. 5 Ch. D. 503, and the cases there cited.) This jurisdiction still subsists. (*Re Gare's Patent*, L. R. 26 Ch. D. 105.) In *Dixon's Patent* (January 15, 1881) the M. R. required from the applicant an undertaking not to take proceedings for infringements committed before the date of the amending order. But now, by sect. 18 of the Act of 1883, such

errors may be amended, after the patent has been granted, by the Comptroller on such terms as he may think fit. Before the issue of the patent clerical errors in or in connection with the application may be corrected by him under the 91st section of the Act of 1883.

DRAWINGS.

The Patents Act of 1883 (sect. 5, subsect. 4) directs that a complete specification must be accompanied by drawings if required.[1] Those who are called upon to interpret the instrument will look both at the words and the drawings, with the view of making them explain each other, and of arriving at the patentee's meaning. (*Abbott, C. J.*, in *Bloxam* v. *Elsee*, 1 C. & P. 564.) Many inventions can be explained perfectly well without any drawings; but wherever machines are the subject of or connected with the invention, drawings should always accompany the specification, for in such a case the relation of the parts will be clear at once through a visual representation, when a verbal description might be utterly unintelligible. Care must be taken that the patentee does not bind himself to the particular form given in the drawing when he does not so intend. It may be that only a particular form is required to be secured, because no other form will effect the proposed result. In such a case, if the form is not copied, the invention is not made use of. But in most cases it is more than one form which is sought to be protected by patent, and the form given in the drawing is only to be taken as an illustration. This fact ought to be distinctly shown in the specification.

In *Arnold* v. *Bradbury* (L. R. 6 Ch. 706) it was contended by the defendants in a suit for restraining the infringement of a patent for an improved ruffle, and the

[1] Rules 30–33 of the Patents Rules, 1890, contain regulations as to the sizes and methods of preparing the drawings accompanying the provisional or complete specifications. Rule 33 directs that if an applicant desires to adopt the drawings lodged with his provisional specification as the drawings of his complete specification he should refer to them as those 'left with the provisional specification.'

machinery for making the same, that the patentee had not described the mode in which the ruffle was made; but *Lord Hatherley, C.*, held that as the machine was very simple, and as the drawing showed how it was worked, that was sufficient. (See also *Hastings* v. *Brown*, 1 E. & B. 454; *Morton* v. *Middleton*, 1 Cr. S. 3rd Ser. 722; *Daw* v. *Eley*, L. R. 3 Eq. 500 *n.*, 14 W. R. 126; *Poupard* v. *Fardell*, 18 W. R. 127.)

It seems that a patentee will not be allowed, in an action brought by him for an infringement, to refer to a drawing as descriptive of a material part of the invention not described in the letterpress of the specification. (*Clark* v. *Adie*, L. R. 10 Ch. 667; affirmed on appeal, L. R. 2 App. Cas. 315; *Macfarlane* v. *Price*, 1 Stark, 199, 1 W. P. C. 74 *n.*)

In the matter of *Pullan's Patent* (May 1878), leave was given by the Lord Chancellor upon an *ex parte* application to correct a filed specification by the addition of drawings alleged to have been omitted through inadvertence. The drawings so added were not described in the specification. Some months after the addition was effected an application was made to the Lord Chancellor by a person who had been threatened with an action for infringing the patent to re-hear the original application. The Lord Chancellor decided to hear the matter afresh, and upon reading the affidavits filed on both sides, and finding that his order had been made on imperfect information, ordered the added drawings to be struck out of the specification, with costs.

RELATION OF THE COMPLETE TO THE PROVISIONAL SPECIFICATION.

We have seen that the provisional specification need not contain all the details by which the invention is proposed to be carried into effect; it is sufficient if a broad outline of the invention is there sketched, so that its whole nature is ascertainable. On the other hand, it is permissible for a patentee to let drop some of the features of the provisional specification when he comes to prepare his complete specification, provided there is no fraud; that the

essential features of the invention are preserved; and that the complete specification does not claim something different from the invention described in the provisional specification. (*Thomas* v. *Welch*, L. R. 1 C. P. 192; *Penn* v. *Bibby*, L. R. 2 Ch. 134; *Stoner* v. *Todd*, L. R. 4 Ch. 58; *Wright* v. *Hitchcock*, L. R. 5 Ex. 46.)

It is essential that the nature of the invention shall be the same, but upon principle and authority (said *Lopes*, *L. J.*, in *Woodward* v. *Sansum*, 4 R. P. C. 178) it is clear that improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts with the view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification are allowable.

Although portions of the provisional specification may within the limits above mentioned be omitted from the complete specification without endangering the validity of the patent; and although the invention set forth in the earlier document may be expanded and developed when the complete instrument comes to be prepared, in accordance with the fuller knowledge which the inventor may then possess, yet he must carefully keep within the lines originally laid down, and must sedulously avoid introducing into the complete specification anything which can be construed as a larger or different invention. A material addition to, or deviation from, the invention for which he originally sought protection will not be permitted. Thus, where the provisional specification set forth an invention for preserving animal substances in a fresh state for some time, which consisted in the application of a definite mixture of an aqueous solution of gelatine with an aqueous solution of bisulphite of lime, whilst the complete specification, in addition to the use of that mixture, claimed the use for the same purpose of an aqueous solution of the bisulphite of lime alone, this was held to be a distinct matter not covered by the provisional specification. It was an invention 'larger than and different from that disclosed

in the provisional specification,' and the patent was, therefore, invalid. (*Bailey* v. *Roberton*, L. R. 3 App. Cas. 1055, affirming the decision of the Court of Session in Scotland).

The plaintiff's provisional specification stated the invention to be an improved method of treating oils for various applications, and it set forth a particular method of thickening them. The complete specification claimed (1) the particular method of thickening oil limited to lubricating purposes; and (2) the combining of such thickened oils with mineral oils as thereinbefore described. The body of the specification stated that the combining of thickened oils with mineral oil, irrespective of the precise means adopted for thickening them, was part of the invention; that is, the invention was alleged to cover the combining of oils thickened by other methods than by the one claimed by the first claim. It was held by a Judge of the Court of Session, Scotland, that there was a fatal variance between the two specifications. (*Hutchison* v. *Patullo*, 4 R. P. C. 332.)

The title of one of Mr. Edison's important patents obtained in this country in the year 1877 was 'Improvements in instruments for controlling by sound the transmission of electric currents and the reproduction of corresponding sounds at a distance.' In the first part of the provisional specification the description of the invention referred entirely to the transmission of sound or the controlling of sound by means of electric currents; and in the latter part different methods of carrying out this invention under the varying conditions of use were alluded to. The patentee's complete specification described, in addition to the invention known as the Telephone, which was worked by electricity, a very ingenious instrument called the Phonograph, which is a purely mechanical contrivance and has nothing whatever to do with electricity or magnetism, nor has it necessarily anything to do with the transmission of sound to a distance. The inventor described it as a means of recording the sounds produced by the human voice or otherwise by causing the movements of a diaphragm to be registered on paper or soft sheet metal, and then the paper might be

used in an instrument to reproduce the sound upon a delicate diaphragm by giving to the same a vibration similar to that originally given by the voice. The mode of applying the phonograph, a complete instrument in itself, to the transmission of the sounds over a telegraph line was also described. It was held by *Mr. Justice Fry*, who presided at the trial of an action for the infringement of the patent, that the nature of the phonograph had not been fairly described in the provisional specification, and that the patent was therefore invalid. (*The United Telephone Co.* v. *Harrison*, L. R. 21 Ch. D. 746.)

See also *Penn* v. *Bibby*, L. R. 2 Ch. 127; *Horrocks* v. *Stubbs*, 3 R. P. C. 221; *Gaulard and Gibbs' Patent Appeal*, 6 R. P. C. 225; *King, Brown & Co.* v. *Anglo-American Brush Corporation*, in the Court of Session, Scotland, 6 R. P. C. 414.

An inventor is not bound to describe in his provisional specification any mode of carrying the invention into effect, but if he does this, and if, before lodging the complete specification, he discovers an improvement in such mode, or if he discovers a different mode, he is bound to give to the public in that instrument the benefit of what he has discovered, although there may be improvement and even invention which was not known to him at the time. Per *L. J. Cotton*, in *Woodward* v. *Sansum* (4 R. P. C. 175). And in the same case (p. 178) *L. J. Lopes* said: 'It is said the complete specification describes a new and separate invention not covered by the provisional specification. If this can be established the patent would be bad. A provisional specification was never intended to contain a complete and exhaustive description of the invention. It was intended to be sufficiently specific to disclose the nature of the invention so as to protect the inventor until the time for filing the complete specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping within what I may call the ambit of his invention as disclosed in his provisional specification.'

In *Bailey* v. *Roberton* (L. R. 3 App. C. 1055) *Lord Blackburn* said in the House of Lords that it is no objection to the complete specification if it shows that there has been discovery since lodging the provisional, and that something has been added by way of supplement to make the invention really workable, the nature of the invention remaining the same.

Under a patent for improvements in laying down marine telegraphic cables, certain guiding rings for controlling the delivery of the cable were described and claimed in the complete specification, although they were not mentioned in the provisional specification. It was held that the patent was not thereby invalidated. (*Newall* v. *Elliott*, 4 C. B. N. S. 269.)

In *Lucas* v. *Miller* (2 R. P. C. 155) it was held that *matters of detail, even those that had not occurred to the* inventor at the time of lodging the provisional specification, may be introduced into the complete instrument, if they give a better method of carrying out the invention or of working it more easily.

These cases show that when an inventor elaborates his invention and renders it specific, when he gives a more particular and detailed description of it in the complete specification, he will be allowed to follow out his original design, and to give a fair development of it, even to the *addition of improved methods of carrying it into effect, but* he must not make a new departure nor introduce anything that cannot be brought within the meaning and purport of the provisional specification.[1]

If any part of the invention, as described in the complete specification, does not fall within the title, the patent

[1] In the following cases the patents were attacked on the ground of variance between the complete and provisional specifications, but the objections were overruled in all: *Watling* v. *Stevens*, 3 R. P. C. 30; *S. C.* on appeal, 3 R. P. C. 151; *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 248; *Morgan* v. *Windover*, 4 R. P. C. 417; affirmed on appeal, 5 R. P. C. 295; reversed on another point in H. L., 7 R. P. C. 130; *Siddell* v. *Vickers*, on appeal, 5 R. P. C. 416; *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 397; *S. C.* on appeal, 6 R. P. C. 287; *Gaulard and Gibbs' Patent*, 5 R. P. C. 532.

will be invalid. (*Croll* v. *Edge*, 9 Scott, C. B. R. 479; *Crossley* v. *Potter*, Macr. P. C. 240.) However, where the title of a patent was for 'Certain Improvements in the Doors and Sashes of Carriages,' and the patentee, in his specification, said, 'I have shown my invention as applied to railway-carriage doors and windows, although they are equally applicable to the doors and windows of any other description of carriage, or in any position where doors and windows are subject to jar and vibration,' this was held not to extend his claim beyond the title (*Oxley* v. *Holden*, 8 C. B. N. S. 707). See also *Newall* v. *Elliott* (10 Jur. N. S. 954).

A patentee will not be allowed to read the provisional specification with the view of aiding or supplying a defect in the complete specification. (*Mackelcan* v. *Rennie*, 13 C. B. N. S. 52.)

RULES TO BE OBSERVED IN PREPARING SPECIFICATIONS.

Good Faith.—The first thing that an inventor about to prepare his specification should bear in mind is, that he is bound to act with *good faith*. There must be no studied ambiguity or equivocal language; no attempt to keep anything secret; he must take the public into his confidence, and make a full disclosure of his invention; and the whole statement must be fair, open, explicit, and honest. If he acts in any other manner, it will go hardly with him when his specification comes to be examined in a court of justice.

Definition of the Invention.—The next point to be attended to is the accurate definition of the invention, so that the reader may clearly understand of what it consists. In the case of *Macfarlane* v. *Price* (1 Stark. 199; 1 W. P. C. 74), *Lord Ellenborough* said that the patentee in his specification 'should say, My improvement consists in this; describing it by words if he can, if not by reference to figures. But here the improvement is neither described in words nor by figures. . . . A person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover from what he is warned in a case like this.' 'Every party' (said *Cresswell, J.*,

in *Gibson* v. *Brand*, 1 W. P. C. 640) 'is bound to tell the public clearly by his specification what he claims, and what they may do or not do without risk of an action for infringing his patent.'

In *Philpott* v. *Hanbury* (2 R. P. C. 33), the patent was held bad because the patentee had not told the public the nature of the invention in reasonably accurate language. 'It forms a condition' (said *Mr. Justice Grove*), 'without the fulfilment of which the patent is void, that the patentee should state the nature of his invention, in order that persons reading his specification should know, and should know with reasonable clearness and facility, what they are prohibited from using by the letters patent without his permission or licence.' In regard to the specification before him, the learned judge said that he could not satisfactorily frame any formula of words which would describe or reasonably define what the nature of the invention was. 'The specification has not disclosed what is the real nature of the invention which the patentee says he has made.'

And again, in *Fairburn* v. *Household* (3 R. P. C. 128, *S. C.* affirmed on appeal, 3 R. P. C. 263), a patent was held invalid because the specification did not indicate with anything approaching to clearness or certainty what it was that the patentee claimed as a novelty, what it was that he relied on as the real invention he sought to protect. (And see also *Rowcliffe* v. *Morris*, 3 R. P. C. 17.)

A patentee sometimes obtains a second patent for improvements upon an invention which formed the subject-matter of a previous patent, and the second specification usually refers to the first. Care should be taken in preparing the second specification to make it distinguish clearly the later improvements from the earlier invention. (*Eades* v. *Starbuck Waggon Co.* W. N. 1881, p. 160.)

When the invention is partly original and partly communicated from abroad, it would seem desirable that the respective parts should be distinguished in the specification. (*Renard* v. *Levinstein*, 10 L. T. N. S. 177.)

In the case of a patent for an invention communicated

from abroad, it is no answer to an objection that the specification did not sufficiently describe the invention, to say that the patentee has stated all that was communicated to him. (*Wegmann* v. *Corcoran*, L. R. 13 Ch. D. 65.) On the other hand, where an invention communicated from abroad is sufficiently described in the specification, it is not a valid objection to the patent obtained by an agent in this country, that the foreign inventor is possessed of information which has not been set forth in the specification. (*Plimpton* v. *Malcolmson*, L. R. 3 Ch. D. 351.)

Must fully describe the means of carrying the invention into effect.—Besides furnishing a lucid and precise definition of the invention, the inventor must set forth how it is to be carried into effect so that the promised result may be duly accomplished. The specification must show plainly how the aim and object of the invention can be achieved, and with that view all necessary details, directions, and explanations must be correctly given; all the parts, apparatus, materials, and ingredients must be accurately described; proportions, quantities, times, temperatures, and the like, so far as they are respectively material, must be stated, precisely if it can be done, approximately if that only is possible; whilst the needful processes and operations must be fully communicated and clearly unfolded. These things should be taken in proper order, and expressed in perspicuous language.

'It is most important' (said *Mr. Baron Alderson*, in *Morgan* v. *Seward*, 1 W. P. C. 170) 'that patentees should be taught that they are bound to set out fully and fairly what their invention is. . . . The specification ought to contain a full description of the way in which it is to be done. . . . The patentee ought to state in his specification the precise way of doing it. If it cannot be completely done by following the specification, then a person will not infringe the patent by doing it.'

The specification ought to mention everything which is essential to the carrying into effect of the invention. In a patent for trusses, the patentee omitted to state that the steel of which they were made was to be tempered with

tallow, and *Lord Mansfield* held it void. (*Liardet* v. *Johnson*, 1 W. P. C. 53.) When a patent was granted to Dr. James for fever powders, he stated in his specification the materials of which they were composed, but omitted to describe the quantity of the ingredients. This being the case, said *Lord Mansfield*, he never durst bring an action for infringement, and it was certainly wise in him not to do so, as no patent could stand on such a specification. (1 W. P. C. 54 *n.*) The specification of Neilson's patent omitted all mention of water-tuyeres; if the apparatus (said *Parke, B.*) would not be beneficial without them, then it is of no use to the public as it is described in the specification, and the specification would be bad. (*Neilson* v. *Harford*, 1 W. P. C. 317.) When a patentee prepared the specification of his invention of spinning machinery, he said nothing as to the difference in the velocity of certain rollers. Having brought an action for an infringement, and gone into evidence to show what his invention was, *Buller, J.*, remarked, 'The man comes to give an account of the invention, and says, I had calculated, and the difference of the velocity was to be as five to one. Now he has not said a word of that in his specification. In that, he has kept back the knowledge he had as to the size of the rollers and their velocity, and it is left to people to find it out as chance may direct.' The patent was accordingly held bad. (*Rex* v. *Arkwright*, 1 W. P. C. 70.) Again, under a patent for improvements in steam-engines and paddle-wheels, a difference which had to be made in the length of certain rods was not given in the specification, and it was attempted to explain this by saying that the difference in the length, being small, would not be very material. 'But the whole question' (said *Alderson, B.*) 'is small, therefore it ought to have been specified; and if it could not be ascertained fully, it should have been so stated. . . . The small adjustment of these different lengths may have been made for the purpose of making the machine work more smoothly; if so, it is just as much necessary that it should be stated in the specification as that the tallow (referring to the case of *Liardet* v. *Johnson*) should be

mentioned.' (*Morgan* v. *Seward*, 1 W. P. C. 182.) The drawing attached to the specification under a patent for improvements in lamps did not show, and the specification itself did not state, where the air was to be admitted in the second burner, and without admitting air the wick would not burn. *Jessel, M. R.*, held that the specification was insufficient; and to the argument that a workman would correct the drawing by putting in the opening, the judge replied that where the invention is of a trifling nature, and the whole merit very small, if a patentee undertakes to teach people how to do things better, he must fully describe his plan, and not leave anything for the invention of others. (*Hinks* v. *Safety Lighting Company*, L. R. 4 Ch. D. 607.)

A patent was obtained for improvements in floating docks. In an action for an infringement it was proved that the construction of floating docks was not new, but the plaintiff alleged that his invention consisted in the application of iron so as to form airtight and watertight chambers. Now there was no mention of iron in the specification, and it was held both by the judge on the trial and by the Court of Common Pleas that the plaintiff had not duly described the nature of the invention, and in what manner it was to be carried out. (*Mackelcan* v. *Rennie*, 13 C. B. N. S. 52.)

The specification under a patent for an invention for preserving animal substances in a fresh state for a long time stated that it consisted in the application of certain solutions, numbered 1, 2, 3, and 4, to the matters intended to be preserved. The mode of applying the solutions numbered 2, 3, and 4 was set forth, but nothing was said as to the mode of applying solution No. 1. It was held both by the Court of Session in Scotland, and by the House of Lords on appeal, that the patent was bad on account of the want of a sufficient description of the manner in which the invention was to be performed. (*Bailey* v. *Roberton*, L. R. 3 App. Cas. 1055.)

The plaintiff's specification, filed in 1873, contained two claims; the first for a method of thickening oils for lubricating purposes; the second for combining thickened oils

with mineral oils. The patentee described his method of thickening, but not the process of mixing the oils, nor did he state any proportions. It was held in the Court of Session, Scotland, that if skill were required to make the oils combine under the second claim, the specification was defective; because the method of carrying out the invention had not been shown; and that if no skill were required there was no proper subject for a patent. (*Hutchison* v. *Patullo*, 5 R. P. C. 351.)

Grave doubts were entertained by the Lords Justices in the Court of Appeal with respect to the sufficiency of a specification which described an hydraulic machine, adapted, according to the evidence, to work only at high pressure, there being no advantage gained, as was admitted, in working it at low pressure. Now the patentee had not set forth this important fact in his specification. (*Ellington* v. *Clark*, 5 R. P. C. 327.)

Where a specification claimed a combination of three elements, and the third element was not stated or explained, the patent was held invalid. (*Gaulard & Gibbs' Patent*, 5 R. P. C. 595.)

Description must not be vague and general.—When a patentee attempts to secure a right of an extensive nature, the description of the process must not be vague and general. Thus in *Booth* v. *Kennard* (2 H. & N. 84), an action brought for the infringement of a patent for improvements in the manufacture of gas, the specification was held bad, because it claimed generally the exclusive privilege of making oil directly from oleaginous seeds; and, instead of describing particularly how this was to be done, only stated that the mode of using the materials might be 'the same as in the apparatus used in the ordinary mode of making gas from coal.' The Court deemed such a description too vague and general when coupled with a sweeping claim like that above mentioned.

However, in *Edison & Swan United Electric Light Co.* v. *Woodhouse* (4 R. P. C. 105), an action for the infringement of a patent for an electric lamp, it was contended by

the defendant that the specification was bad on account of vagueness, since the evidence showed that it was essential to success in preparing the lamp that the temperature should be gradually increased, and this was not stated. But, said *L. J. Fry*, 'if the language of a specification is clear enough to guide a competent workman and enable him to obtain the desired result, we cannot see how the Court can hold the language insufficient in point of law. No doubt it is for the Court and not for a workman to construe the specification, but if a workman says it is a sufficient guide to him, and the Court believes him, the Court must hold that as regards clearness of description the specification is in point of law sufficient.' (See also *Edison & Swan Co.* v. *Holland*, 6 R. P. C. 243.)

Must precisely describe all materials and ingredients.—A specification, in describing materials and ingredients required for carrying the invention into effect, must not employ general terms which cover what is unsuitable as well as what is suitable. The public has a right to look for definiteness and precision in this respect, and ought not to be put off with vagueness and loose generalities. Experiments would be required to discover which one of the various objects included under the general term is suitable, and that task the law declares ought not to be imposed upon the public. For instance, a specification stated that *fossil salt* should be employed. Now there are various kinds of fossil salt, but it was shown that the only kind fit for the object in view was *sal gem*, and it was, therefore, held that the specification had given an inadequate explanation of the matter. (*Turner* v. *Winter*, 1 W. P. C. 80.)

The specification under a patent for certain methods of making cements described a method of making cement from gypsum, in the course of which an alkali, neutralised by an acid, was directed to be used; sulphuric acid and potash being stated to be the best acid and alkali for the purpose. Another method for making cement from limestone and chalk was then described, and consisted also in the use of an alkali, neutralised by an acid. An action was

brought for an infringement of this patent. The infringement complained of was the employment of borax in making cement, borax being composed of an acid (boracic acid) and an alkali (soda). Now if the patentee confined himself to sulphuric acid and potash, then the defendant was not liable, seeing that he had used neither; if he claimed the use of all acids and alkalies, his claim was bad, because it was proved that there were some acids and alkalies which would not answer the purpose; and if he claimed only those acids and alkalies which were proper and suitable, he was bound to state in the specification what they were, otherwise experiments would be necessary to discover what were suitable and what were not. (*Stevens* v. *Keating*, 2 W. P. C. 194.) See also *Muntz* v. *Foster* (2 W. P. C. 109).

Under a patent for improvements on preserving animal substances for use as food, the specification stated that the invention consisted of 'the use of the alkaline and earthy sulphites.' But as it was shown that some of the earthy sulphites are poisonous, and that some of the alkaline sulphites possess properties which render them unsuitable for the purpose in view, it was held that the claim to the use of 'the alkaline and earthy sulphites' was too wide and vague, and that the specification ought to have defined more precisely the materials to be employed. (*Bailey* v. *Roberton*, L. R. 3 App. Cas. 1078.)

In *Wegmann* v. *Corcoran* (L. R. 13 Ch. D. 63), it appeared that the plaintiff had obtained a patent for an improved machine or apparatus for treating or preparing meal. The specification stated that the squeezing rolls of the improved machine were to have 'a surface consisting of a material containing so much silica as not to colour the meal or flour,' and the patentee preferred to make them of 'iron coated with china,' and finely turned with diamond tools. It was shown that there are two kinds of china—Oriental or Chinese china, which contains 73 per cent. of silica, and is very hard; whilst the china usually made in this country contains only about 40 per cent. of silica, and is much softer. Now the first kind of china would answer the pur-

pose, but the second would not. It was therefore held by the Court of Appeal, affirming the decision of the Court below, that although the invention was useful in milling operations, the specification was ambiguous and inadequate, as it did not state what kind of china was to be employed. Experiments would have been required to discover a suitable material for the apparatus.

Pooley took out a patent in 1874 for improvements in the manufacture of bread, the main feature of which was the employment of a mixture of wheat flour and malt flour in given proportions. When instructing his agents how to use his invention the patentee sent them a formula which was very different from that given in the specification; and in the course of time he issued other formulæ, all different from that specified. It was held at the trial of an action for an infringement of the patent, that on this evidence the specification had not properly set forth the invention. The directions sent out to the agents were to enable them to do that which, according to their testimony, they could not do from the specification. (*Pooley* v. *Pointon*, 2 R. P. C. 167.)

It is not obligatory on a patentee, when referring to materials and ingredients to be used in carrying his invention into effect, to enter into minute details as to such materials and ingredients, if they are known in the shops, and can be readily purchased under the names which he gives them. (*Mackintosh* v. *Everington*, 2 Carp. Rep. 191.)

The names of articles mentioned in a specification must be taken to be used in their ordinary commercial sense. Thus, a direction in a specification to use dry arsenic acid in the manufacture of dyes was held to refer to the ordinary arsenic acid of commerce (which is dry to the touch, although it contains water in combination), not to anhydrous arsenic acid, which could not be commonly bought in the trade, and which would not answer the purpose. (*Simpson* v. *Holliday*, 20 Newt. Lon. J. 118; 5 N. R. 340; L. R. 1 H. L. C. 315.) And see *Sturtz* v. *De la Rue* (1 W. P. C. 83 *n.*); *Stevens* v. *Keating* (2 W. P. C. 183, 187); *Muntz* v.

Foster (2 W. P. C. 104); *Badische Anilin und Soda Fabrik* v. *Levinstein*, House of Lords (L. R. 12 App. C. 710; 4 R. P. C. 463).

A person who takes out a patent for an invention consisting of the use of known materials in new proportions, though bound to state the most suitable proportions within his knowledge, is not bound to limit his claim to the precise proportions recommended by him in his specification. (*The Patent Type Founding Company* v. *Richard*, Johns. 381.)

Whether or not a specification describes with sufficient accuracy the material out of which an article is to be made is a question for the jury, where the case is tried before one. (*Bickford* v. *Skewes*, 1 W. P. C. 214; *Derosne* v. *Fairie*, 1 W. P. C. 154; *Elliot* v. *Turner*, 2 C. B. 446; *Wallington* v. *Dale*, 7 Ex. 888.)

Must describe the best method of operating.—A patentee is bound to describe the most advantageous method within his knowledge for carrying his invention into effect; and he ought to put the public in possession of his secret in as ample and beneficial a way as he himself uses it. In *Wood* v. *Zimmer* (Holt, N. P. 57) a patent for a method of making verdigris was contested. It seemed that verdigris was made by the process set forth in the specification; but that the patentee was in the habit of secretly putting aquafortis into the boiler. The copper, forming one of the ingredients, was thereby more rapidly dissolved; but the verdigris produced was neither better nor cheaper than that made according to the specification. *Gibbs, C. J.*, considered, however, that this was a prejudicial concealment, and held the patent to be invalid.

Letters patent were obtained for a mode of making a medicine, composed of three salts, commonly sold in the shops under certain well-known names. The specification, instead of simply mentioning these salts by their names, described the processes by which they were produced, and then pointed out the proportions in which the salts were to be combined in order to form the medicine. The methods

of producing the separate salts were not essential to the combination, and formed no part of the invention. It was held at *Nisi Prius* that the specification was bad, *Abbott, C. J.*, saying that it is the duty of anyone to whom a patent is granted to point out in his specification the plainest and most easy way of producing that for which he claims a monopoly; and to make the public acquainted with the mode which he himself adopts. If a person would be led to suppose a laborious process necessary to the production of any one of the ingredients, when in fact he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. (*Savory* v. *Price*, 1 Ry. and Moo. 1; 1 W. P. C. 83.)

There are many other cases which show that if the patentee knows of any circumstance which conduces to the advantage of his manufacture or process, he is bound to mention it in his specification. Nothing of importance can be withheld or concealed without danger to the patent. In *Turner* v. *Winter* (1 W. P. C. 81), *Buller, J.*, said, that if the patentee make the article for which the patent is granted of cheaper materials than those which he has enumerated, although the latter may answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to derive the same benefit as he himself does.

If a patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect, he ought to state it in his specification. Per *Alderson, B.*, in *Morgan* v. *Seward* (1 W. P. C. 170).

But a patentee is not bound to explain which of several methods, all more or less possible, is the most or the least advantageous; yet all the methods described by him must be more or less possible, and he is bound to state what methods are possible, and to avoid stating as possible the methods, if any, which are not. (*Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R. 12 App. C. 710; 4 R. P. C. 449; *Kurtz* v. *Spence*, 5 R. P. C. 183.)

In *Sturtz* v. *De la Rue* (1 W. P. C. 83), it appeared that the patentee had mentioned in his specification a certain substance, under the name of the *finest and purest chemical white lead*, which was to be used in giving paper a glaze, preparatory to its receiving an impression from an engraved plate. He himself imported from Germany, for this purpose, a preparation called *Kremnitz white*; but he said nothing about this in his specification. It was shown that there was no article known in the chemists' shops in London which answered to the patentee's name, and that the purest white lead which could be purchased there did not answer the purpose. It was held, on these facts, that the patentee had not made that full disclosure which he ought to have made; and his patent was adjudged void. 'A man has no right' (said *Pollock, C. B.*, in his address to the jury on the trial of *Tetley* v. *Easton*, Macr. P. C. 76) 'to patent a principle, and then to give the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it.' (See also *Derosne* v. *Fairie*, 1 W. P. C. 158.) In *Walton* v. *Bateman* (1 W. P. C. 622), *Cresswell, J.*, laid down this rule:—If a man knows a better mode than that which he states to the public, his patent will be vitiated. And in *Heath* v. *Unwin* (2 W. P. C. 243), *Coleridge, J.*, said, 'If the inventor of an alleged discovery, knowing of two equivalent agents for effecting the end, could by the disclosure of one preclude the public from the other, he might for his own profit force upon the public an expensive and difficult process, keeping back the simple and cheap one, which would be directly contrary to the good faith required from every patentee in his communication with the public.'

In *Neilson* v. *Harford* (1 W. P. C. 321) the judge told the jury that if the patentee believed that certain internal 'partitions in the hot-blast apparatus were useful, the patent would be void, since he had omitted to say anything about them in the specification.

Must communicate the latest information.—It frequently occurs that in the interval between the application and the

lodging of the complete specification, the inventor discovers that the original invention is capable of material improvement. The intervening period is allowed him for the very purpose of improving the details of his invention; and if he fails to communicate to the public the best information he possesses at the time of lodging the complete specification, the patent will be held void. In *Crossley* v. *Beverley* (1 W. P. C. 117) it was objected that the patentee had added something to the invention as finally specified, but, said *Bayley, J.*, 'I think that if between taking out the patent and filing the specification, the inventor makes a discovery which will enable it better to effectuate the thing for which the patent was obtained, not only is he at liberty to introduce them into his patent, but it is his bounden duty so to do, and it is not sufficient for him to communicate to the public the knowledge he has obtained before the specification.' And in *Woodward* v. *Sansum* (4 R. P. C. 166) *L. J. Cotton* said that an inventor is bound to give the public in his complete specification the benefit of what he has discovered, after filing his provisional specification, in regard to the mode of carrying the invention into effect, although there may be improvement and even invention which was not known to him at the time. (See also *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 397, and the section on the relation of the complete to the provisional specification, *ante*, p. 107.)

It should, however, be kept in mind that the additions must strictly relate to the invention as it stood at the date of the application. The introduction of new heads into the specification or an extension of the subject-matter of the original invention will not be permitted. (*Crossley* v. *Potter*, Macr. P. C. 240; *Bailey* v. *Roberton*, L. R. 3 App. Ca. 1055.) 'The complete specification,' said *Lord Chelmsford* in *Penn* v. *Bibby* (L. R. 2 Ch. D. 58), 'is in a sense supplemental to the provisional specification, not going beyond nor varying from it as to the nature of the invention, but conveying additional information which may have been acquired during the currency of the provisional specification

as to the manner in which the invention is to be performed.'

But need not set forth every application.—An inventor who obtains a patent for the useful application of a principle is not to be called on to set forth every mode of applying it. It is sufficient if he shows some of its useful applications, those applications being the best illustrations of the invention known to him. See what fell from *Lord Abinger* in *Neilson* v. *Harford* (1 W. P. C. 356), and see *Badische Anilin und Soda Fabrik* v. *Levinstein* (L. R. 24 Ch. D. 176; *S. C.* in H. of L. 4 R. P. C. 466). But it must be borne in mind that a patentee cannot, by making a general claim, cover improvements and applications of which he was ignorant at the date of his specification. (*Tetley* v. *Easton*, Macr. P. C. 77.)

Where a patentee by his specification under a patent for the production of certain aniline colouring matters had claimed all the shades from red to brown producible by the various processes described in the specification, whilst only one shade was known to have any present commercial value, it was held by the court of first instance and afterwards by the House of Lords that he was not bound to indicate the respective advantages for dyeing purposes of the different shades of colour produced or to select the most valuable shade and give specific directions how to produce it. (*Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R. 12 App. C. 710; 4 R. P. C. 464.)

Must be intelligible to workmen of ordinary skill.—The specification is to be considered as addressed to persons of *ordinary* skill and ability, acquainted with the particular subject. It must be intelligible to such persons, and the directions must be such that, by pursuing them, they would produce without difficulty the result which the patentee describes. (*Tindal, C. J.*, in *Gibson* v. *Brand*, 1 W. P. C. 631; *Beard* v. *Egerton*, 8 C. B. 165.) *Lyndhurst, L. C.*, said, in *Sturtz* v. *De la Rue* (1 W. P. C. 83 *n.*), that the specification must describe the invention in such a way that a person of ordinary skill in the trade should be able to

carry on the process. And *Lord Denman*, in *Bickford* v. *Skewes* (1 W. P. C. 218), said that the specification is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in the branch of manufactures to which it relates. The persons whom the specification ought to be designed for are persons of *ordinary* skill and ability; not those of special and unusual practice, knowledge, and capacity—not persons at the head of their profession.

A specification ought to be so framed as to be understood by the ordinary workman using that amount of skill and intelligence which is fairly to be expected from 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 or correct an erroneous description. Per *Jessel, M. R.*, in *Plimpton* v. *Malcolmson* (L. R. 3 Ch. D. 568). See also *Neilson* v. *Harford* (1 W. P. C. 371); *Houschill Co.* v. *Neilson* (1 W. P. C. 692); *Edison & Swan Co.* v. *Woodhouse*, 2nd action (4 R. P. C. 108); *Moseley* v. *Victoria Rubber Co.* (4 R. P. C. 242); *Bray* v. *Gardner* (4. R. P. C. 406).

Where the specification under a patent for a chemical operation was concerned, *Mr. Justice Maule* said, 'A competent workman must be taken to know the known properties of iodine, silver, and nitric acid, or else the specification should have included a statement of the properties of each of these substances.' (*Beard* v. *Egerton*, 8 C. B. 165.)

But when placed in the hands of a person of ordinary skill and intelligence, 'possessed of knowledge in the particular industry' (*Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R. 12 App. C. 710; 4 R. P. C. 463), the specification must be sufficient to show him how the invention is to be carried into effect without further assistance, and without needing large corrections or fresh invention on his part. There must be no necessity to try elaborate experiments in order to ascertain the meaning of the instrument or to accomplish

the end promised by the patentee. In *Rex* v. *Arkwright* (1 W. P. C. 66), *Buller, B.*, said that the specification must be such that mechanical men of common understanding (the validity of a patent for a machine being in dispute) must be able to make the machine by following its directions, without any new additions or inventions of their own. In the luminous address of *Mr. Baron Alderson* to the jury on the trial of the case of *Morgan* v. *Seward* (1 W. P. C. 170) he said that a specification ought to be framed so as not to call on 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 actual 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. . . . The specification 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. And *Parke, B.*, in *Neilson* v. *Harford* (1 W. P. C. 371), said that, to be valid, a specification should be such as, if fairly followed out by a competent workman, without addition or invention, would produce the machine for which the patent is taken out. It had been previously laid down, in *Rex* v. *Wheeler* (2 B. & Ald. 349), that a specification which casts upon the public the expense and labour of experiments and trial is undoubtedly bad. It would, however, seem that if any degree of benefit can be produced by complying with the directions of the specification, and without having recourse to experiments, that would be sufficient to save the patent; it is not necessary that the maximum degree of benefit should be produced. (*Neilson's Patent*, 1 W. P. C. 318, and see *Otto* v. *Linford*, 46 L. T. N. S. 39.) In an action for infringing a patent for an improved mode of paving streets with blocks, so shaped that each side of a block was bevelled both inwards and

outwards, it was objected by the defendant that the specification gave no direction as to the angle at which the bevels were to be made. The judge who tried the case (*Lord Abinger*) told the jury that if any angle would be of some use, the specification was good; but if some particular angle was essential, then, as the specification left that to be discovered by experiment, it was deficient and bad. (*Macnamara* v. *Hulse*, 2 W. P. C. 129.) But *Mr. Justice Bayley* said (in the case of *Crompton* v. *Ibbotson*, 1 Carp. Rep. 462) that a patentee, knowing that given materials will not answer the purpose, is bound so to word his specification as to prevent others from trying experiments on that which he knows will not answer. In this case a patent for an improved method of dyeing and finishing paper came into question; the specification described the paper as being conducted to a heated cylinder by means of cloth, 'which cloth may be made of any suitable material, but I prefer it to be made of linen warp and woollen weft.' Now the patentee had ascertained from repeated trials that no other substance would answer the purpose. It was held that the public had not the full benefit of the inventor's discovery, and persons misled by the specification might be induced to make experiments which the patentee knew would fail. (1 W. P. C. 83.) This, however, must be considered an extreme case.

In connection with this subject the following observations of *Lord Westbury, C.*, are worthy of attention:—'When it is stated that an error in a specification, which any workman of ordinary skill and experience would perceive and correct will not vitiate a patent, it must be understood of errors which appear on the face of the specification, or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture; and the reason is because such errors cannot possibly mislead. But the proposition is not a correct statement of the law if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true

of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describes several processes or several combinations of machinery, and affirms that such will produce a certain result which is the object of the patent, and some one of the processes or combinations is wholly ineffectual and useless, the patent will be bad, although the mistake committed by the patentee may be such as would at once be observed by an ordinary workman. (*Simpson* v. *Holliday*, 13 W. R. 577.)

But when in the case of the *Edison & Swan Co.* v. *Holland* (6 R. P. C. 277) it was objected in the Court of Appeal that the specification did not sufficiently show how the invention was to be carried into effect, *L. J. Cotton* said, 'It is necessary that this should be done so as to be intelligible, and to enable the thing to be made without further invention—not, as was pressed upon us, by an ordinary workman, but by a person described by *Lord Ellenborough* in *Huddart* v. *Grimshaw* (1 W. P. C. 85–7) as a person skilled in the particular kind of work, or, as said by *Lord Loughborough* in *Arkwright* v. *Nightingale* (1 W. P. C. 60), a person conversant in the subject. But in my opinion it is not necessary that such a person should be able 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.'

In the case of *British Dynamite Company* v. *Krebs* (Goodeve's Cases, p. 88) the House of Lords reversed the decision of the Lords Justices of Appeal on the ground that the description of the mode of manufacture as set out in the specification had been conclusively proved to be sufficient for all practical purposes. The four law lords were unanimously of opinion that since it was shown in evidence that the patented article had been made by following the instructions of the specification, the Judges of the Court of Appeal ought not to have disregarded this, nor to have relied upon their own opinions that they, persons practically

unacquainted with the subject, would not have been able to manufacture the article without more instructions than the specification contained.

It would seem from *Crossley* v. *Beverley* (3 C. & P. 515), that in construing a specification, the state of the particular manufacture at the date of the patent must be kept in view. In this case, in describing a gas apparatus, no directions were given as to a condenser; but since a workman capable of constructing a gas apparatus knew that he would have to put it in, the specification was held sufficient. The patent in *Russell* v. *Cowley* (1 W. P. C. 459) was for a method of manufacturing iron tubes without the use of a mandrel. The specification gave no directions as to leaving out the mandrel; but it was held that an intelligent workman would sufficiently understand, from the purport of the specification, that a mandrel was not to be used. So, in *Beard* v. *Egerton* (8 C. B. R. 165), it was held that a competent operator would perceive, on perusing the whole specification, that it would not be necessary to interpose an operation at a certain stage in the process of daguerreotyping.

Again, in *Otto* v. *Linford* (46 L. T. N. S. 39) the specification under a patent for gas motor engines did not state the proportion of atmospheric air to be let into the chamber where the inflammable gas was fired with the view of producing a gradual in place of an explosive ignition. Nevertheless it was held that as exact proportions were not required to be mentioned, and as there was enough information in the specification to enable a maker of machinery to construct a working engine without exercising his inventive powers, the specification was sufficient.

It sometimes occurs that the drawing attached to the specification is erroneous in some particular, so that if an attempt were made to construct the machine by the drawing it could not be done, or if made it would not work. If, however, the text has correctly described the construction, or if the error is of a kind which an ordinary workman would easily perceive and rectify, requiring not experiments, but merely regulation, then the error in the figure will be

disregarded, and will not be held to vitiate the patent. (*Otto* v. *Linford*, 46 L. T. N. S. 35.)

Combinations.—It has been already stated (Chap. II.) that a number of well-known things, such as implements, machines, or parts of machines, may be combined so as to form a new and useful instrument or machine; and a patent obtained for such combination will be valid, care being taken that the specification does not claim the old parts as well as the novel combination. The combination may also comprise additions of a novel character along with old parts.

The treatment of a combination in a specification ought to have reference to the facts of the case and to the inventor's intentions in regard to what he wishes to secure by the patent. If he desires to protect a simple combination and nothing more, it is not necessary that he should distinguish old parts from new parts. It may be that all the parts are old, in which case he can only lay claim to their combination as being a new and useful invention. But it often happens that some of the constituent parts of the combination are also new and useful inventions. In such a case he has a right to protect them, but if he seeks to do so they ought to be specially pointed out, fully described, and expressly claimed. (See the section on the Claims.)

In the case of *Foxwell* v. *Bostock* (4 De G. J. and S. 298) *Lord Westbury, C.*, laid down the rule to be that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty, otherwise and in a more specific form than by the general description of the entire machine. 'On both principle and authority it is most necessary that the specification should ascertain the improvement, when the patent is for an improved, that is, for a new combination. At the date of this patent many combinations of machinery, or, in other words, many machines for sewing or stitching by a needle and shuttle, were known and used. If in that state of things a patent is taken out for an improved arrangement or combination, the patentee

is bound to show in what the improvement consists, and how it is to be effected. But this obligation is not discharged by a description of the entire machine which embodies the improvement, but which description does not distinguish the improvement; and thereby renders it undiscoverable, except upon a minute comparison and collation of all existing combinations with the new combination that is claimed. A specification so framed has the effect of concealing rather than of disclosing the invention.' The plaintiff's counsel stated that the improvement consisted of an arrangement of three cams on one shaft, by the direct action of which the three principal movements in a needle and shuttle machine were effected. The plaintiff's evidence went to show that this arrangement formed the novelty and utility of the machine. 'But this clear and simple statement is not to be found anywhere in the specification. It is true that the cams and shafts are described indiscriminately with the rest of the machine in the specification, but there is nothing to indicate that it is this addition which constitutes the improved arrangement or the new combination.' The specification was therefore held to be defective and the patent invalid.

Lord Westbury's language in *Foxwell* v. *Bostock* has given rise to much comment in later cases, and the decisions have been conflicting; but the Courts now refuse to understand it as deciding that where a combination is alone claimed it is necessary to distinguish the new parts from the old. It is now firmly established that where the only invention sought to be protected by the patent is the combination, and that is properly set forth, it is sufficiently described without separating new parts from old. Under the circumstances supposed, it can be of no moment, so far as the point before us is concerned, whether the parts are all old or partly old and partly new, and therefore a description of the parts and of the manner of arranging them into a working whole, followed by a claim restricted to the combination, will be a sufficient description of the invention.

Thus in *Harrison* v. *The Anderston Foundry Co.* (L. R. 1 App. C. 574) it was objected to the patentee's claim for a combination that he had not shown what was the novelty of the invention as he ought to have done according to the case of *Foxwell* v. *Bostock*; but *Lord Cairns, C.*, in giving judgment in the House of Lords said:—'If there is a patent for a combination, the combination itself is *ex necessitate* the novelty; and the combination is also the merit, if it be a merit, which remains to be proved, by evidence. So also with regard to the discrimination between what is new and what is old. If it is clear that the claim is for a combination and nothing but a combination, there is no infringement unless the whole combination is used, and it is in that way immaterial whether any and which of the parts are new.'

When the case of *Moore* v. *Bennett* (1 R. P. C. 142) was taken to the House of Lords, *Lord Selborne, C.*, and two other law lords overruled the unanimous decision of the three Lords Justices in the Court of Appeal (which had followed *Foxwell* v. *Bostock* too literally), and laid down the law to be that where the claim is for a new combination and not for particular subordinate things included in that combination, and where the manner of arriving at it and working it, and the purpose for which it is useful, are all sufficiently described in the specification, so that anyone acquainted with the subject will know in what respect it differs from the things that have gone before, it is unnecessary to go on to specify the subordinate parts of it as constituting new elements and a new thing, if a claim to subordinate parts as distinct from the entire combination is not intended to be made.

'When a combination and nothing more is claimed, the combination being a novelty, it is immaterial that the patentee should point out how far he claims for particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim. That seems to me to be the true law as laid down in

Harrison v. *The Anderston Foundry Co.*, without a reference to which case *Foxwell* v. *Bostock* ought not to be read; because it is possible to misread *Foxwell* v. *Bostock* unless you correct your impression of it afterwards by the judgment of the House of Lords in *Harrison* v. *The Anderston Foundry Co.*' (Per *L. J. Bowen* in *Proctor* v. *Bennis*, Court of Appeal, 4 R. P. C. 358. See also *Clark* v. *Adie*, L. R. 2 App. C. 328; *Watling* v. *Steven*, 3 R. P. C. 37; *Kaye* v. *Chubb*, 5 R. P. C. 649.)

When, however, an inventor's improvement of a complicated machine bears but a small proportion to the whole machine, it is highly desirable, if not imperative, that, if he ventures to claim the entire improved machine, he should not do so without distinctly pointing out the small addition or alteration which constitutes the improvement. In such a case Lord Westbury's quoted words may well be held to apply. In *Harrison* v. *The Anderston Foundry Co.* Lord Hatherley said in substance that it is not competent to a man to take a well-known existing machine and, having made some small improvement, to place that before the public, without explaining the improvement. 'You must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted I think by L. J. James in another case (*Parkes* v. *Stevens*, L. R. 8 Eq. 366), I think it will not do if you invented the gridiron pendulum to say "I have invented a better clock than anybody else," not telling the public what you have done to make it better than any other clock that is known.' Again, in *Moore* v. *Bennett* (1 R. P. C. 143), *Lord Selborne, C.*, said, 'The case of *Foxwell* v. *Bostock* was qualified or explained in *Harrison* v. *Anderston Foundry Co.* . . . and so explained it appears to me to amount to no more than this: that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must condescend upon that which is

improved. For example, if a machine had been long in use in the brush trade and some particular improvement . . . had been made, the general combination remaining the same, then, according to the decision in *Foxwell* v. *Bostock*, by describing it as a new combination you would be misdescribing it, because, indeed, the thing discovered would be a particular improvement upon a particular part of that combination. And upon the principle that the specification should not be vague, but should give sufficient information, it ought not to disguise the real invention by a claim so wide that anyone would suppose something to be claimed as new which is not, but it should do it sufficiently and with proper precision.'

Having studied the rules previously propounded as those by which he ought to be chiefly guided in preparing his specification, the patentee may now be cautioned on the subject of certain faults, which, if committed, would have a disastrous effect upon its validity, and against which, therefore, he cannot be too vigilantly upon his guard.

Ambiguity to be eschewed.—The fatal effect of ambiguous language in a specification is illustrated by the case of *Hastings* v. *Brown* (17 Jur. 648; *S. C.*, 1 E. & B. 454). A patent was obtained for arrangements for raising ships' anchors, and the specification claimed as the invention 'a cable-holder to hold without slipping a chain cable of any size,' but it could not be gathered from it whether the inventor claimed a cable-holder to hold chain cables of any *one* size, or to hold chain cables of different sizes. Now, a cable-holder to hold a chain cable of any one size was already known at the date of the patent. 'The patentee,' said *Lord Campbell*, when the case was argued before the Court of Queen's Bench, on a motion to enter a nonsuit, 'ought to state distinctly in his specification what is his invention, and to describe the limits within which he is to enjoy a monopoly. That is not done in this case with respect to the nature of the cable-holder. What is claimed [in the pleadings] is a right to construct a capstan which will raise chain cables of different dimensions. Does the

plaintiff disclose in his specification that he claims that invention? If it is only claimed with regard to one cable, then there is no infringement of the patent. The vice of the specification is, that it is quite equivocal what the claim is. There is nothing in the title which at all assists us; and when we look to the description in the specification, which speaks of "a chain cable of any size," I think that the proper construction to be put upon the words is that they mean "one chain cable." At all events, they are capable of that meaning; and if the specification is equivocal, it is bad.' And *Mr. Justice Coleridge* added, 'If the specification on a fair interpretation be equivocal, it is insufficient.' The rule for a nonsuit was accordingly made absolute.

In *Turner* v. *Winter* (1 W. P. C. 80), *Ashurst, J.*, said that if there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, the patent is void, and it was laid down in *Galloway* v. *Bleaden* (1 W. P. C. 524), that if there is a want of clearness in the specification, so that the public cannot afterwards avail themselves of the invention, much more if there is any studied ambiguity in it, so as to conceal the invention from the public, no doubt the patent would be completely void.

Must not set forth two methods when only one is effective.—If two methods of doing a thing are described in the specification, and by one of these it cannot be done, the specification is bad. (*Regina* v. *Cutler*, Macr. P. C. 137; *Beard* v. *Egerton*, 8 C. B. 165.)

Medlock's specification of his invention for making red and purple dyes from aniline commenced the description of the process thus:—'I mix aniline with dry arsenic acid and allow the mixture to stand for some time, *or* I accelerate the operation by heating it to or near its boiling-point until it assumes a rich purple colour, and then I mix it with boiling water and allow it to cool: when cold it is filtered and decanted.' When the case went before the House of Lords, it was held, in affirmation of the view

taken by the Lord Chancellor, that on the construction of the whole specification two processes, a hot and a cold process, were described, and as it was proved that only the hot process was effective, the specification was declared to be bad and the patent consequently invalid. It was urged that every person well informed on the subject could see that the cold process was ineffective, but 'this,' it was said, 'would be to correct the specification by the superior intelligence of the reader.' (*Simpson* v. *Holliday*, 13 W. R. 577, affirmed L. R. 1 H. L. 315.)

Must not contain misdirections or misrepresentations.—If the specification contains language calculated to mislead in regard to an important part of the patented process, as where it contains positive misdirections as to the mode of operating, or as to the materials to be employed, the patent will likewise be void. 'You must not mislead people' (said *Jessel, M. R.*, in *Plimpton* v. *Malcolmson*, 3 L. R. Ch. D. 531, 576) 'by telling them to do something wrong, and leaving them to find out the mistake. . . . You must not give people mechanical problems and call them specifications.'

On the trial of *Palmer* v. *Wagstaff* (Newton's Lond. Journ. vol. xliii. p. 131), an action brought by a candle manufacturer for an infringement of a patent for improvements in the manufacture of candles, it was alleged that the specification contained a positive misdirection as to the position in which the wicks were to be placed in the process of manufacture. The object proposed was the production of a candle requiring no snuffing, by using two or more plaited wicks, arranged in such a manner that they would separate and bend outwards as the candle was burned. Now, it was shown that if the directions of the specification were followed, the candle would require lighting at the bottom instead of the top. If lighted at the top, the wicks converged instead of diverging, and produced a long snuff. The judge (*Pollock, C. B.*) told the jury that this was a serious mistake; and though the verdict was given against the plaintiff upon other points than those connected with

the validity of the specification, there is reason to suppose that this instrument could not have been supported. Where a specification claimed the process of purifying sulphate of alumina by means of peroxide of manganese whether in the hydrated or anhydrous form, and it was proved that the use of the latter form was impracticable, the patent could not be sustained. *Kurtz* v. *Spence* (5 R. P. C. 184). See also *Savory* v. *Price* (1 Ry. and Moo. 1; 1 W. P. C. 83); *Bickford* v. *Skewes* (1 W. P. C. 218).

It may be inferred, from the case of *Huddart* v. *Grimshaw* (1 W. P. C. 85), that the assertion in the specification of something being important, when in point of fact it is not, will vitiate the patent, because there is evidence of an attempt to deceive. Again, if anything is said to be immaterial which is in reality material, this will be a fatal defect. Thus, in *Neilson* v. *Harford* (1. W. P. C. 313), *Parke*, *B.*, said, 'The patentee states that the size and form of the vessel in which the air is heated, previous to its being driven into the furnace, are immaterial. Now, my strong opinion is that the clause is an incorrect statement, and that being untrue vitiates the specification, and prevents the patent from being a good patent.' See also *Simpson* v. *Holliday* (13 W. R. 577, affirmed L. R. 1 H. L. 315).

Misrepresentations as to the object or capabilities of the invention, or as to other important matters, will deprive the inventor of the benefit of his patent. For instance, a patent was obtained for a machine for making paper in single sheets from one to twelve feet wide. It was proved that a single machine would make paper only of one definite width, and that if paper of some other width was required, another machine must be employed. It was held by the Court of K. B. that the capability of the machine had been misrepresented in an important respect, and that the patent was void. (*Bloxam* v. *Elsee*, 6 B. & C. 169.) And see *Crossley* v. *Potter* (Macr. P. C. 249). If the patented apparatus, as described, fails to effect what the inventor avers that it will effect, although it may do some

very small part of the proposed work, the patent is bad. (*Easterbrook* v. *Great Western Railway Company*, 2 R. P. C. 301.)

But on the trial of *Cole* v. *Saqui* (5 R. P. C. 494), an action for the infringement of a patent, the specification under which said in effect that the invention was capable of application to other purposes beyond that for which protection was claimed, but did not describe how those purposes were to be effected, Mr. Justice Kay held that this did not invalidate the patent. 'I can see no objection to a patentee stating in his specification that what he has invented with reference to one particular machine may be applied to other machines.'

Technical and Scientific Terms.—In making use of technical language great care should be taken that the words are employed in their true meanings, and in their proper significations. To give an example, a valuable patent was placed in jeopardy by the misuse of certain chemical terms in the specification. The inventor gave directions for using in the process for which he obtained his patent, hydro-carbon gas, carbon gas, and carbonic gas. Now, amongst chemists a hydro-carbon gas means a gas composed only of hydrogen and carbon; but the gas which the inventor had in view was one containing oxygen also, and therefore not a true hydro-carbon, which would not have effected his purpose. Again, his terms carbon gas and carbonic gas include carbonic acid gas and carbonic oxide, both of which were unsuitable. These were serious objections, and if the specification had been interpreted with the strictness with which some other specifications have been construed, the mistakes would have been held fatal; but a benign view of the matter was taken, and the objections were not allowed to prevail. (*Edison* v. *Woodhouse*, 3 R. P. C. 183.)

Simple Mistakes.—Simple mistakes, being merely words used in an inaccurate sense, which words are often used, and are explained by the context, or by the drawings annexed, will not avoid the patent. Thus, in *Bloxam* v.

Elsee (1 C. & P. 558; 1 Carp. Rep. 439), the specification made use of the expressions *vis de pression*, *vis de répulsion*, and *vis de réaction*, for different screws; but the context and the drawings showed what was meant, and the objection taken on this ground was not sustained. In another specification the word 'discolour' was used, with the meaning 'discharge the colour.' This, though a mistake in translating the French word 'décolorer,' was held not important enough to vitiate the instrument. A court of law will not insist upon accuracy in minute and unimportant matters; it will not insist upon strict logical correctness; it will overlook such evident errors as the mention of 'imponderable substances.' (*Pollock, C. B.*, in *Tetley* v. *Easton*, at Nisi Prius, Newton's Lond. Journ. vol. xlii. p. 58.) All it requires is that the patentee shall make his meaning clear, and that his language shall be intelligible to the persons to whom it is addressed.

It was said in the House of Lords that after a patent has stood enquiry and the test of time, the Courts do not encourage verbal objections to the form of the specification. (*Neilson* v. *Betts*, L. R. 5 H. L. 1.)

CLAIMS.

Before the passing of the Patents Act of 1883 it had become usual for patentees to insert at the close of their specifications certain clauses which were known as 'Claims.' The insertion of claiming clauses was not then prescribed by the law, but they offered the patentee an opportunity of summing up his invention, of setting forth in a brief form what he considered to be its pith and substance, and of protecting himself against the danger of being supposed to claim more than he desired to claim.

By the fifth subsection of the fifth section of the Act of 1883 it is directed that 'a complete specification must end with a distinct statement of the invention claimed.'

The import of these words was discussed in the case of *Siddell* v. *Vickers* (5 R. P. C. 416); one of the Lords Justices (p. 428) thought that 'distinct' means no more

than a claim independently of and apart from the description of the nature of the invention and of the way in which it is to be carried into effect. But the other two LL. JJ. were of opinion that the words 'distinct statement' mean more than a separate paragraph. They thought that the Legislature contemplated a distinct summary of the main features of the invention, something to which the reader might readily refer and from which he might learn without turning to the body of the specification what the characteristic features of the invention claimed were. They held that a claim which referred to a combination of parts for effecting a certain purpose 'as hereinbefore set forth' did not satisfy the requirement of the Act. However, all three Judges were of opinion that the words of the sub-section are merely directory, and that non-compliance with this direction does not invalidate the patent (pp. 429, 432, 433).

Under the old law all the claiming clauses might be struck out of the specification by disclaimer, if there remained sufficient in the specification to show distinctly what the invention was. (*Thomas* v. *Welch*, L. R. 1 C. P. 192.) But this cannot now be done, since the Act of 1883 requires every specification to end with a claim.

Some patentees introduce a large number of claims into their specifications, but this is a dangerous practice, for the risks are proportionately increased. In one of Mr. Edison's patents there were no fewer than thirty claims, all of which except one were afterwards struck out by successive disclaimers.

Everything not claimed is implicdly disclaimed.—Whilst a claim is primarily intended to mark off what the inventor conceives to be his exclusive property and to warn the public not to trespass within the fence he has set up, it practically operates also as a disclaimer of everything described in the specification except what is expressly claimed. (*Harrison* v. *Anderston Foundry Company*, L. R. 1 App. Cas. 574.) This ought to be kept in mind by the inventor when he is preparing this part of his specification, and

he should be careful neither on the one hand to include matters that are beyond the boundary of the invention nor on the other to restrict his rights within too narrow limits by leaving out what he might have claimed. In the latter case the patentee is exposed to defeat if he brings an action against some one who has made use of that which he omitted to claim. (*Jackson* v. *Wolstenhulmes*, 1 R. P. C. 105; *Fairburn* v. *Household*, Court of Appeal 3 R. P. C. 263.)

'The real object of what is called a claim' (said *James, L. J.*, in *Plimpton* v. *Spiller*, L. R. 6 Ch. D. 412, 426) 'is not to claim anything which is not mentioned by the specification, but to disclaim something. A man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly well known and in common use; he describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention and the mode of carrying that invention into effect, by way of security he says, "But take notice I do not claim the whole of that machine; I do not claim the whole of that *modus operandi*, but that which is new, and that which I claim, is that which I am now about to state." That really is the legitimate object of a claim, and you must always construe a claim with reference to the whole context of a specification.'

'It has long been the practice' (said *Jessel, M. R.*, in *Hinks* v. *Safety Lighting Company*, 4 Ch. D. 607) 'to insert in specifications the distinct claim of what is said to be comprised in the patent; meaning that nothing else is comprised, that everything else is thrown open to the public; or, to put it into other words, if a man has described in his specification a dozen new inventions of the most useful character, but has chosen to confine his claim to one, he has given to the public the other eleven.'

Claims ought to show clearly what is intended to be claimed.—Particular attention should be given to the framing of the claims so that it may be seen without difficulty

what it is the inventor wishes to secure. Where a specification was so worded that it was not clear whether the patentee intended to claim a novel combination of parts, or the parts themselves, some or all of which were old, the patent was held to be invalid. (*Rowcliffe* v. *Morris*, 3 R. P. C. 17, and see *Fairburn* v. *Household*, 3 R. P. C. 263.)

A claim for a combination will not be deemed too vague when there is proof that a competent workman can make the combination from the specification without experiment. (*Edison & Swan United Electric Light Co.* v. *Woodhouse*, 4 R. P. C. 92.)

Where the description in a specification was in the first instance too general, but the inventor afterwards in describing his invention referred to certain figures in drawings annexed to the specification, and the claim was for the invention *described with reference to those figures*, the specification was held sufficient. (*Daw* v. *Eley*, 14 W. R. 126, and on another hearing, L. R. 3 Eq. 497.) See also *Russell* v. *Cowley* (1 W. P. C. 465); *Thomas* v. *Welch* (L. R. 1 C. P. 192).

In *Kay* v. *Marshall* (2 W. P. C. 39), *Cottenham, C.*, said, 'The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as the means of making a machine according to the patentee's improvements. If, therefore, the specification containing the description be sufficiently precise, it cannot be of any consequence that expressions are used in the claim which would be too general if they proposed to be part of the description.' See also *Lister* v. *Leather* (3 Jur. N. S. 811; *S. C.* in error, 8 E. & B. 1004); and *Easterbrook* v. *G. W. R. Co.* (2 R. P. C. 208).

If all the parts are old only the combination should be claimed.—If all the parts of an invention, taken separately, are old, the patent being obtained only for a novel combination of them, the patentee, in preparing the specification for such an invention, must take care to limit his claim to the new combination. (*Lister* v. *Leather*, 3 Jur. N. S. 811; *S. C.* in error, 8 E. & B. 1004; *Seed* v. *Higgins*, 8 H. L.

C. 550; *Potter* v. *Parr*, 2 B. & S. 259; *Kay* v. *Marshall*, 2 W. P. C. 71.)

Tetley's patent was for improvements in machinery for raising and impelling water. The specification described a great number of mechanical contrivances for effecting the object in view, and concluded by claiming, as the patentee's invention, the several contrivances, 'both when all used in combination, and when used severally.' It was shown, on the trial of the first action for an infringement, that several of these contrivances were old; and with regard to one in particular, which the defendants were charged with infringing, that a person named Hales had previously procured a patent for something substantially the same. The plaintiff afterwards entered a disclaimer as to several parts of his specification, and brought another action against the same defendants. The jury again returned a verdict for the defendants. A rule to set aside the verdict, and for a new trial, having been obtained, the legal questions came on for argument before the full court. It appeared that the amended specification described a centrifugal pump, composed of a hollow wheel, revolving within a case furnished with pipes for conveying the water. This wheel was not stated to be old, nor was it disclaimed. The specification claimed generally the machinery for raising and impelling water. It also claimed the application of the inventions before mentioned, 'both when all used in combination, and when used severally.' It was held that the hollow revolving wheel was thereby claimed, and as this was an old invention, the specification was bad. By a second disclaimer the patentee's claims were reduced to the single one of 'the means of increasing the action of the machine by causing the liquid to enter the wheel at both sides;' and he then brought a third action for the infringement of his patent. Unfortunately it was shown that previous inventions had embraced a contrivance for the admission of the water on both sides of the wheel; and *Mr. Justice Willes* directed the jury to find for the defendant, for the reason that, although the wheel had been previously

combined with apparatus which made the combination useless, yet that the contrivance in question had been made public property, and could not of itself be made the subject of a patent. The Court of C. P. said that the use of a wheel known before, in a manner known before, could not be deemed an invention capable of sustaining a patent, and held that the judge was right. (*Tetley* v. *Easton*, Macr. P. C. 48; 2 C. B. N. S. 706.)

New parts and minor combinations must be expressly claimed.—Where a patentee claims in his specification an entire combination only, he will be deemed not to have claimed any of the novel minor combinations if any such there be. A combination of three parts is a different thing from a combination of two of them; and if a patentee desires to secure the minor combination he must distinctly claim it. (*Clark* v. *Adie*, L. R. 10 Ch. 667; affirmed on appeal, L. R. 2 App. Cas. 315.)

With respect to patents granted before the Act of 1883 came into operation, it was held in *Nordenfeldt* v. *Gardner* (1 R. P. C. 69), when the patent was for an improvement consisting of an addition to an old mechanical combination, that as the improvement was made clearly manifest on the face of the specification, where it was sufficiently pointed out what the improvement was, the patent was not invalid although there was no mention of the improvement in the claims. On the other hand, where a patentee had omitted from his claim a process which was properly described in the body of the specification, an action brought by him for the infringement of the process was dismissed. (*Jackson* v. *Wolstenhulmes*, 1 R. P. C. 105.)

The claims must not cover too much.—The inventor should beware of claiming more than he is strictly entitled to, since a failure in part is a failure altogether, and that to which he has a just right will fall along with that which does not belong to him. To use *Lord Eldon's* illustration —if there be a patent both for a machine and for an improvement in the use of it, and it cannot be supported for the machine, although it might for the improvement merely,

it is good for nothing on account of its attempting to cover too much. (*Hill* v. *Thompson*, 1 W. P. C. 247.)

Therefore, if an inventor lays claim to a principle in addition to a method of carrying it into effect, and it should turn out that the principle was known and had been previously applied to a similar purpose, in such case the patent cannot stand.

In the specification under the patent which formed the ground of dispute in *Hill* v. *Thompson* (1 W. P. C. 239), the patentee claimed not only the use of a particular quantity of lime in smelting iron, but the discovery of the usefulness of lime in that process generally. It appeared, however, that lime had been previously used for the purpose, and the patent was accordingly held bad, although, if the patentee had restricted his claim to the particular proportions of lime and metal, it might have been sustained. Again, the specification under Minter's patent, for an improvement in the construction of chairs, was faulty for a similar reason: its claim was too extensive. The improvement consisted in applying a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acted as a counterbalance to the pressure against the back. It was proved that one Brown had previously invented a chair on the same principle, but his application of it was encumbered with additional machinery. If Minter had restricted his claim to the particular mode in which he effected the thing, his patent would have been valid; but since the specification went generally to the application of a self-adjusting leverage to the given purpose, it claimed more than he was entitled to; and if the patent had been held good, Brown could not have continued to make his chair without infringing it. (*Minton* v. *Mower*, 1 W. P. C. 138.)

Under a patent for improvements in stoves the specification claimed the construction of stoves made in such a manner that the fuel should be introduced from beneath. Now it was shown at the trial of an action of *scire facias* that grates had been previously constructed on this principle; and although the particular method of effecting the

object was new, yet *Lord Ellenborough* held that as the patentee had claimed the principle, which was not new, the patent was bad. If the inventor had limited his claim to his own mode of carrying the principle into effect his patent would have been upheld. (*Rex v. Cutler*, 1 Stark. 354, 1 W. P. C. 76.)

The case of *Rex* v. *Else* (1 W. P. C. 76) affords another instance of the same error. The specification claimed in effect the exclusive right of combining silk and cotton thread, and then of making lace of the combined material. It was proved that silk and cotton thread had previously been combined in some mode or other; and although the material so constructed was unfit for making lace on account of its coarseness, yet as the patentee did not confine himself to any particular mode of combining the two, his claim was held to extend to every mode, and was therefore bad.

Fisher and Gibbons obtained a patent in 1844 for an invention of a machine in which a shuttle was combined with a needle for producing stitches to ornament fabrics. In 1846 Thomas procured a patent for improvements in machinery for sewing and stitching various fabrics. His specification was construed as claiming generally the use of needles in combination with shuttles for producing stitches; and although he showed one particular form of a needle and shuttle machine which was a different combination from that described by Fisher and Gibbons, it was held that, having regard to the language employed, his claim could not be confined to that particular combination. His patent was, therefore, invalid in consequence of the patentee claiming too much. (*Thomas* v. *Foxwell*, 5 Jur. N. S. 37; 6 Jur. N. S. 271.)

Under a patent for improvements in weaving figured fabrics, the specification described mechanism for weaving coach lace, but the patentee said that he did not confine himself to narrow goods only, as his improvements were applicable to the production of carpets. It was shown that the specified mechanism could not be adapted to the weaving of carpets by merely enlarging it, but required certain

additions to be made to it before it could be employed for that purpose. *Sir F. Pollock, C. B.*, told the jury, at the trial of an action for an infringement, that if carpets could not be made by the means stated in the specification, the patent was not good ; and the jury returned a verdict in favour of the defendant. (*Crossley* v. *Potter*, Macr. P. C. 240.)

So likewise if a specification claims a novel combination of parts forming an entire machine, and also makes a claim to a subordinate combination which is not new, the patent cannot stand. (*Cropper* v. *Smith*, 1 R. P. C. 81.)

Under a patent for an invention for constructing belts for driving machinery the specification claimed to make belts of that class of cotton canvas which was known in the market as hard woven canvas. Now it was proved that there were ten qualities of such canvas in the market, and that at the most three of them would answer the purpose. In the absence of evidence that an ordinary workman would know which quality to select without trying experiments, it was held by the Court of Appeal that the specification claimed too much. (*Gandy* v. *Reddaway*, 2 R. P. C. 49.)

A specification claimed the use of all peroxides of manganese for a given purpose, but it was shown that only the hydrated peroxide would have the desired effect, and the patent was therefore declared to be invalid. (*Kurtz* v. *Spence*, 5 R. P. C. 161.) See also *Ralston* v. *Smith* (9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223); *Booth* v. *Kennard* (2 H. & N. 84); *Saunders* v. *Aston* (13 B. & Ad. 886; 1 W. P. C. 75 *n.*); and *Haworth* v. *Hardcastle* (1 W. P. C. 484.)

We must not forget, however, the remarks made by *Jessel, M. R.*, in the case of *Frearson* v. *Loe* (L. R. 9 Ch. D. 58) : '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.'

Vague, speculative claims to be avoided.—A patentee will not be allowed to make wide hypothetical or speculative claims based on mere conjecture or surmise, nor will his patent be permitted to cover matters of which he was ignorant at the date of his patent. In the specification under a patent for improvements in machinery for raising water, the patentee said, 'If any gases or elastic media other than atmospheric air are used, with which to charge the case [part of the machinery], I claim the sole right to do so.' *Pollock, C. B.*, who tried an action brought for infringing this patent (*Tetley* v. *Easton*, Macr. P. C. 48), remarked upon this passage, that, in point of law, the patentee had no right to make such a claim; the law would not permit a patentee to claim more than he has invented. 'It will permit him to claim that which he has invented by means of successful experiments or otherwise, and which he has given to the public, but not that which is the mere subject of his speculation or imagination, or of his endeavouring to grasp more than he is entitled to. I think we are bound to give, as far as possible, the fullest effect to an invention; but, on the other hand, I think we are also bound to oppose the endeavours to make a patent grasp at and embrace a number of matters that were never in the head of the inventor.'

In another part of the specification, the patentee described a wheel with straight arms, and then he said, 'I propose to construct the wheel of every variety of configuration, so long as it is constructed with a channel in the interior.' The defendant had made use of a wheel with *bent* arms, and the patentee treated this as an infringement, although he admitted that at the time he obtained his patent he had never thought of bent arms, and also that curved arms almost trebled the effect of the machine. The judge told the jury that the patentee's claim to every shape of arm would not stand. To hold that it was good would be to reward a man who had rashly and ignorantly

taken out a patent on a subject he had not appreciated. The same learned judge, when presiding at the trial of *Stevens* v. *Keating* (2 W. P. C. 184)—an action for infringing a patent for processes for combining materials to form cements—said, with reference to that part of the specification which was held to claim the use, not only of a particular acid, but of all acids which might succeed, that no patentee could be allowed to make such a claim, and to say, Whereas other substances will succeed, I claim them all.

A perusal of these cases will show that it is safer for a patentee to restrict his claim to the use of those processes, or those materials, which he has found by actual trial to answer the purpose, than to extend it to matters of which he has no accurate knowledge; since, in doing this, he may either claim something which will not answer the object in view, something which is not new, or something which he does not sufficiently describe. The law will aid him, without any general claim in his specification, in repressing infringements which are an illegal imitation of his process behind a colourable variation, or by means of mechanical or chemical equivalents.

'The safest course for patentees to adopt' (said *Pollock, C. B.*, to the jury on the trial of *Crossley* v. *Potter*, Macr. P. C. 256) 'in framing their specifications is, instead of including everything, to confine themselves specifically to one good thing, and a jury will always take care that if that be a real invention, no man under colour of improvement shall be allowed to interfere with that which is the offspring of their genius.'

In the case of *Arnold* v. *Bradbury* (L. R. 6 Ch. 706) *Lord Hatherley, C.*, said that a claim must be very large and vague indeed to justify any court in saying, independently of evidence, that it is impossible to sustain a patent based upon it. In that case he decided that the claims for making ruffles 'by machinery' meant by the described machinery, and that there was no ground for holding that the claims were too large *per se*. In the course of his

judgment, he remarked that it was a singular fact that no case had been cited from t' law books of any claim being held to be too large on a unt of the greatness of the claim independently of external evidence. But he referred to an American case (*Wyatt* v. *Stone*, 1 Storey 273) where the patentee had claimed every method of cutting ice by machinery.

CHAPTER X.

ON THE INTERPRETATION OF SPECIFICATIONS.

FORMERLY there was a disposition in the Courts to take part against patentees, under the impression that monopolies were not to be encouraged, attaching the old odious sense of the term to the phrase indicating a patent privilege for an invention. The judges were then astute to detect flaws in specifications, to the language of which they were accustomed to apply a rigorous criticism. Then came a change, and some of the judges thought that a specification ought to be read with indulgence; that a liberal construction should be put upon it, and that the words should receive a benign or a benevolent interpretation. But of late years the Courts have laid down that specifications are to be construed like other written documents, that is, with a disposition to read them fairly, and with an endeavour to ascertain their real meaning, not straining the language nor giving effect to petty objections. In the case of *Newton* v. *Halbard* (Hil. Term, 1872) *Mr. Justice Grove* said, 'A specification should not be construed in a technical or captious spirit, but with a fair intention to give it effect if it be reasonably intelligible.' In the case of *Harrison* v. *The Anderston Foundry Company* (L. R. 1 App. Cas. 574) *Lord Chelmsford* said, 'In the construction of a specification it appears to me that it ought not to be subjected to what has been called a benign interpretation, or to a strict one. The language should be construed according to its ordinary meaning, the understanding of technical words being, of course, confined to those who are conversant with the subject-matter of the invention.' 'I am

anxious' (said *Sir G. Jessel, M. R.*, in *Hinks* v. *Safety Lighting Company*, L. R. 4 Ch. D. 607), 'as I believe every judge is who knows anything of patent law, to support honest *bonâ-fide* inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections or on mere cavillings with the language of the specification, so as to deprive the inventor of the benefit of his invention. This is sometimes called a "benevolent" mode of construction. Perhaps that is not the best term to use, but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent.' See also the remarks of the same learned judge, and of *Brett, L. J.*, in *Plimpton* v. *Spiller* (L. R. 6 Ch. D. 412). Also the observations of *Sir G. Jessel, M. R.*, in *Otto* v. *Linford* (Court of App. 46 L. T. N. S. 35). In *Dudgeon* v. *Thomson* (L. R. 3 App. Cas. 53), *Lord Blackburn* said, 'I apprehend the duty of the Court is fairly and truly to construe the specification, neither favouring the one side nor the other; neither putting an unfair gloss or construction upon the specification for the purpose of saving a patent, nor in order to extend it.'

The same learned judge, in *Clark* v. *Adie* (L. R. 2 App. Cas. 423), said, 'In construing the specification we must construe it like all written documents, taking the words and seeing what is the meaning of those words when applied to the subject-matter; and in the case of a specification which is addressed, not to the world at large, but to a particular class, namely, skilled mechanicians possessing a certain amount of knowledge, it is material for the tribunal to put itself in the position of such a class, . . . and by the admission of evidence or otherwise put itself in a position to understand and then to say what the words of the specification mean when applied to such a subject-matter.' In delivering the judgment of the Court of Appeal in the same case (L. R. 3 Ch. D. 142), *L J. James* said, 'It cannot be effectually contended that there is any principle to be applied

to the construction of specifications which differs from that applicable to the construction of every written instrument whatever. Of course, in ascertaining the meaning of words used, you endeavour to put yourself as much as possible in the position of the person using them.' (See also *Simpson* v. *Holliday*, 13 W. R. 577, *S. C.* L. R. 1 H. L. 315; *Edison and Swan Electric Light Co.* v. *Holland*, 5 R. P. C. 474.)

'A specification' (said *Mr. Justice Fry* in *Wegmann* v. *Corcoran*, L. R. 13 Ch. D. 77) 'ought to be read as a whole, and with the view of ascertaining whether it fairly and honestly and with sufficient exactitude describes the invention.' And in *Plimpton* v. *Spiller* (L. R. 6 Ch. D. 412) *L. J. James* said, 'You must always construe a claim with reference to the whole context of a specification.'

'If any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent, rather than a construction which renders it invalid.' (Per *L. J. Lindley* in *Needham* v. *Johnson*, 1 R. P. C. 58.) 'We ought if possible to construe a claim so as to support a patent.' (Per *Sir B. Brett, S. C.* 55.)

As to the interpretation of old specifications which are brought forward to prove anticipation, there is the important case of *Betts* v. *Menzies*, in the House of Lords (10 H. L. C. 117), in which it was held that even where there is an identity of language in two specifications, if such identity consist merely in technical terms, it must be considered impossible for the judge to say what exact meaning the first patentee attributed to such terms, if any long interval of time, such as the interval from 1804 to 1848, elapsed between the two specifications. Under these circumstances the judge ought not to take upon himself to decide as to the identity of the inventions, guided only by the similarity of language. He cannot assume that the inventions are substantially the same because the expressions employed are similar. The identity or dissimilarity is a fact which cannot be decided without hearing evidence on the point, and if the case is tried before a jury it is a

fact for their decision. And in a subsequent case on the same patent, *Sir W. P. Wood, V. C.*, appears to have considered that it is no ground of proof of the effect of a long anterior patent that scientific persons of the present day, with all the superior knowledge obtained by the advance of science, depose that they could produce the same results by the process disclosed by the earlier patent, as that described in the subsequent one. (*Betts* v. *De Vitre*, 11 L. T. N. S. 445.)

Where there is doubt as to the meaning of particular expressions, competent persons may be called for the purpose of explaining the matter; but evidence is not admissible to explain or alter the plain and precise words of a specification, or for the purpose of correcting mistakes in it. (*Neilson* v. *Harford*, 1 W. P. C. 313.) In *Elliot* v. *Turner* (2 C. B. 446), it was held that the words of a specification are to be construed according to their ordinary and proper meaning, unless there be something in the context (which may be explained by evidence) to show that a different construction ought to prevail. Of course it is allowable to call persons of skill in the department of practical art to which the invention belongs for the purpose of saying whether or not they understand the specification, and whether or not they could execute its directions, so as to produce a useful result. (See *C. J. Tindal's* remarks in *Walton* v. *Potter*, 1 W. P. C. 595.)

In examining a specification with the view of ascertaining its sufficiency, the Court will not take into consideration what the patentee says he thought of, meant, or intended at the time he prepared it. The Court will notice only what the ordinary workman says. *Kaye* v. *Chubb* (4 R. P. C. 289).

Although a tribunal will look with extreme jealousy at any attempt on the part of a patentee to derogate from his own grant after he has assigned the patent, yet in construing the specification the language must not be forced from its true meaning in order to avoid imposing a hardship on the assignee. (*Hocking* v. *Hocking*, House of Lords, 6 R. P. C. 75.)

It must be borne in mind that a specification will be construed with reference to the state of knowledge at the time it was prepared. Thus, the specification under a patent for a chemical invention will be held to refer to what was known at the time, and not to anything which was discovered subsequently. The language will not be deemed too wide because it is extensive enough to embrace unsuitable ingredients of later discovery. As a patentee would not be allowed to secure the exclusive use of materials unknown at the date of the patent, although the words of the specification are sufficiently ample to cover them, it would be manifestly unjust to hold that his language, having become applicable by the advance of knowledge to more than he contemplated, should render the patent void, if it was properly limited and accurate at the time it was employed.

In 1878 a patent was obtained for certain methods of preparing colouring matters from naphthylamine, a substance derived from one of the products of the distillation of coal. In an action for infringing the patent the defendant contended that as two substances named naphthylamine (viz. the alpha and beta forms) were known to chemists at the date of the patent, one of which would not answer the purpose, the specification was insufficient by reason of its not stating which of the two was to be used. But it was held by the judge who tried the action, and by the House of Lords, that as the alpha form (the suitable one) was the only one in the market at the date of the patent, the beta form being a costly substance known only to a few chemists as a laboratory product, the specification was sufficiently explicit. (*Badische Anilin und Soda Fabrik* v. *Levinstein*, 2 R. P. C. 73; *S. C.* House of Lords, 4 R. P. C. 463.) See also *Crossley* v. *Beverley* (3 C. & P. 515).

Where a specification has received an interpretation in the Court of Appeal and afterwards goes there again on appeal from the decision in another action against another defendant, the construction previously put upon it will be adopted and will not be allowed to be questioned. (*Auto-*

matic Weighing Machine Co. v. *Combined Weighing Machine Co.*, 6 R. P. C. 367.)

Construction of Claims.—'You must always construe a claim with reference to the whole context of a specification.' (Per *Sir W. M. James, L. J.*, in *Plimpton* v. *Spiller*, L. R. 6 Ch. D. 412.) 'Every claim in every patent must be read and construed with reference to the specification, and not as if the claim was an isolated sentence having no connection with or reference to what precedes it.' (*Edison & Swan United Electric Light Company* v. *Woodhouse*, Court of Appeal, 4 R. P. C. 107, and see *Kaye* v. *Chubb*, 5 R. P. C. 641.)

As to the construction of a claim which can be read in two senses, one of which would make the patentee appear to claim something which was well known and in common use, see *Cropper* v. *Smith*, Court of Appeal, W. P. C. p. 81, and *Westinghouse* v. *Lancashire and Yorkshire Railway Company*, *ibid.* p. 98. And see what fell from *Tindal, C. J.*, in *Haworth* v. *Hardcastle*, 1 W. P. C. 484. If one construction would imply that the claim is practically a repetition of what has gone before and entirely superfluous, yet so long as it does not seek to enlarge the monopoly beyond what the patentee is entitled to, it will not make the patent invalid. (*Plimpton* v. *Spiller*, L. R. 6 Ch. D. 412.)

It was decided by the House of Lords in *The British Dynamite Company* v. *Krebs* (Goodeve's cases, p. 88) that an appendant claim to something old did not vitiate a patent. In this case the patentee had claimed the manufacture of the dynamite which was found to be new, and also claimed the means of firing by special ignition as described. Some of these means of firing being old and well known as applied to other explosives, the House of Lords construed this claim as being only appendant to dynamite, and upheld the patent. It is not, however, advisable for inventors to make claims of this kind, which if held to extend the patent would invalidate it, and if held not to extend it are simply useless.

The following decisions have reference to the interpre-

tation of 'claims:'—*Kay* v. *Marshall* (2 W. P. C. 39); *Lister* v. *Leather* (3 Jur. N. S. 811, *S. C.* in error 8 E. and B. 1004); *Palmer* v. *Wagstaff* (9 Exch. 494); *Macalpine* v. *Mangnall* (3 C. B. 496); *Templeton* v. *Macfarlane* (1 H. L. C. 595); *Sellers* v. *Dickinson* (5 Exch. 312); *Seed* v. *Higgins* (8 H. L. C. 550); *Thomas* v. *Foxwell* (6 Jur. N. S. 271); *Dangerfield* v. *Jones* (13 L. T. N. S. 142); *Thomas* v. *Welch* (L. R. 1 C. P. 192); *Jordan* v. *Moore* (L. R. 1 C. P. 624); *Daw* v. *Eley* (L. R. 3 Eq. 497); *Hinks* v. *Safety Lighting Co.* (L. R. 4 Ch. D. 607); *Wright* v. *Hitchcock* (L. R. 5 Ex. 73).

CHAPTER XI.

OPPOSITIONS TO THE GRANT OF PATENTS.

An inventor's application for a patent may be opposed under the eleventh section of the Act of 1883, amended by the Act of 1888, which enacts that 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. The opponent is restricted by the Acts of 1883 and 1888 to three grounds: viz. (i) that the applicant had obtained the invention from him, or from a person of whom he is the legal representative; or (ii) that the invention had 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. The last ground was substituted by the 4th sect. of the Patents Act, 1888. Where such notice is given the Comptroller will give notice of the opposition to the applicant, and will, on the expiration of the 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.

As to the procedure in cases of opposition before the Comptroller, see rules 34–44 of the Patents Rules, 1890. The notice of opposition must state the grounds of opposition. When a ground of opposition is that the invention has been previously patented, the title, number, and date of

the alleged prior specification must be duly specified. The opponent's evidence in support of his case and the applicant's evidence in reply must be in the form of statutory declarations. At the hearing before the Comptroller no matter can be gone into which has not been stated in the notice of opposition. He may allow amendments in notices of opposition at the hearing. (See Patents Rules, 1890, R. 16; *Lake's Application*, 2 Griff. P. C. 35; *Airey's Application*, 5 R. P. C. 348.)

Where a notice of the hearing before the Comptroller did not reach the opponent's agent and the case was decided against the opponent in his absence, the Comptroller suggested that the opponent should appeal, and this being done the law officer referred the case back to the Comptroller for rehearing. (*Warman's Application*, 2 Griff. P. C. 43.)

Appeal to the Law Officer.—When a person intends to appeal to the law officer against the Comptroller's decision, he must file in the Patent Office a notice of his intention, within fourteen days from the date of the decision. (See the Rules of the Law Officers in the Appendix).

When the Comptroller requires an amendment to be made, but does not at once settle the words of the amendment, it is the practice to regard the time for appealing to the law officer as dating from the day of forwarding to the opponent a copy of the amendment approved by the Comptroller. (*Chandler's Patent*, 1 Griff. P. C. 273).

When a notice of appeal is given by one party, the other party will not be allowed to question at the hearing another part of the Comptroller's decision unless he has also given notice of appeal, or has obtained the consent of the other side. (*Bairstow's Patent*, 5 R. P. C. 287.) When the appellant is one of the opponents, it is the practice, going beyond the rule, to send him notice of the hearing before the law officer.

At the hearing the parties may appear in person, or be represented by counsel, solicitors, or patent agents. The onus of proof lies on the opponent. (*Ex parte Sheffield*, L. R. 8 Ch. 237.) The more important decisions of the law

officers are now officially reported, so that more uniformity may be looked for than formerly, when it was not unusual to find different law officers holding different views on the same points. They are always reluctant to stop patents, because applicants cannot appeal from their decisions; but if the law officer entertains no doubt that the invention has been anticipated by a prior patent he will refuse the application. (*Aire and Calder, &c., Application*, 5 R. P. C. 345; *Waller and Ratcliff's Application*, 5 R. P. C. 347; *Daniel's Application*, 5 R. P. C. 413.)

The infringement of an existing patent was formerly not considered a ground for refusing an application, for the reason that it was possible that the later invention covered a valuable improvement, and according to the present practice if the later invention is an improvement on an invention under an existing patent, the application must be distinctly made for the improvement separate from the already patented invention. (*Hoskin's Patent*, 1 Griffin, P. C. 291.)

Under the old system, if the law officer was at all doubtful as to the effect of the evidence before him, he would allow the patent to proceed, that the question might be tried in a court of law. In the case of *Dance's Patent* (P. M. J. vol. vi. 2nd series, 298), *Atherton, A. G.* (1861), finally gave his judgment as follows:—'I allow this patent to proceed, thinking that the question of fact, whether Dance or Stevens invented, and the mixed question of fact and law, whether the invention had been made public before Dance applied for protection, admit of too much doubt to justify a law officer in stopping the patent.'

And so in other cases where much doubt hung about the matter; for example, where the evidence was conflicting, and the law officer was unable to decide which side was speaking the truth, he would allow the application to proceed, as was done by *Giffard, S. G.*, May 6, 1876, in the matter of *Liddell's Patent*, No. 3872, 1875.

And in *Re Russell's Patent* (2 De G. and J. 130), where

the novelty of the invention was contested, *Lord Cranworth*, *C.*, thought that in such a case it was better to run the risk of putting the party opposing to the costs of ulterior proceedings than to withhold the Seal, for the obvious reason that the former course, if wrong, would only create a remediable injury, whilst the latter course, if wrong, would cause an irremediable injury. (See also *Re Tolson's Patent*, 6 De G. M. and G. 422; *Re Lowe's Patent*, 25 L. J. Ch. 454; *Re Simpson and Isaac's Patent*, 21 L. T. o. s. 81; *Re Spence's Patent*, 3 De G. and J. 523.)

And under the new law it is the well-recognised practice that if there is doubt as to the applicant's right to a patent the question should be determined in his favour, and the patent sealed. (*Chandler's Patent*, 1 Griff. P. C. 270; *Welch's Patent*, 1 Griff. P. C. 300; *Jones' Patent*, 2 Griff. P. C. 33.) It is no part of the law officer's duty to decide the validity or invalidity of patents. (*Newman's Patent*, 5 R. P. C. 277.) If a strongly controverted question of scientific anticipation should arise, the patent will not be stopped. (*Lake's Patent*, 6 R. P. C. 548.)

The first ground of opposition mentioned in the Act is that the applicant had obtained the invention from the opponent, or from a person of whom he is the legal representative. The fact that a workman has assisted his master in improving the details of the machine invented by the master and sought to be patented by him affords no ground of opposition to the grant of a patent to the master. (*David & Woodley*, 2 Griff. P. C. 26.) As to the words 'legal representative,' it was held that an agent regularly appointed by power of attorney does not fulfil the requirement. (*Edmund's Patent*, 1 Griff. P. C. 281.)

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

The opponent must be a person who has a real interest in the prior patent, or a person who was the originator of the invention sought to be patented. A patent agent does not fall within the description. (*Heath & Frost's Patent*, 1

Griff. P. C. 289. And see *Hookham's Application*, 2 Griff. P. C. 32.)

A person was allowed to be heard on the ground that he had had an interest under a lapsed prior patent, alleged to anticipate the applicant's invention, and had manufactured under it. (*Glossop's Patent*, 1 Griff. P. C. 285.) But the simple fact that a person had manufactured under a prior patent is not sufficient. (*MacEvoy's Patent*, 5 R. P. C. 285.) Nor is it enough to allege that the opponent is going to work the invention under the prior patent. (*Bairstow's Patent*, 5 R. P. C. 287.)

'*Patented in this country on an application of prior date.*' —An opponent was allowed to be heard although the prior patent had expired. (*Lancaster's Patent*, 1 Griff. P. C. 293.) But if the invention has been only described but not claimed, it has not been patented in this country. (*Von Buch*, 2 Griff. P. C. 40.) And an invention which has only received provisional protection cannot be cited against the applicant. (*Bailey's Patent*, 1 Griff. P. C. 269; *Paterson's Patent*, 1 Griff. P. C. 296.) But a person whose complete specification has been accepted at the Office, although his patent has not been issued, is entitled, under section 15 of the Act of 1883, to be heard in opposition. (*L'Oiseau & Pierrard*, 2 Griff. P. C. 36.)

Where the opponent proves that the invention is described and claimed in the complete specification under a prior patent, it is no answer to say that the invention is not comprised in the provisional specification of the former patent (*Green's Patent*, 1 Griff. P. C. 286); or that the claim in the complete specification goes beyond the title and provisional. (*Newman*, 2 Griff. P. C. 40; see also *Haythornthwaite's Application*, 7 R. P. C. 70.)

Where it is clear that a claim is covered by an earlier patent the applicant will be ordered to strike it out. (*Hall & Hall's Patent*, 5 R. P. C. 283; *Webster's Patent*, 6 R. P. C. 163.) And an applicant is frequently required to state in his specification that he is aware of a given patent and that he does not claim anything which is described and claimed in the

specification under it. (*Newman's Patent*, 5 R. P. C. 271; *Gozney's Application*, 5 R. P. C. 597; *Lynde's Patent*, 5 R. P. C. 663.) Even a reference to an expired patent is sometimes required to be inserted. (*Hall's Patent*, 5 R. P. C. 283.) In the cases of *Guest and Barrow's Patent* (5 R. P. C. 312); and *Sielaff's Application* (5 R. P. C. 484), a disclaimer of a principle was ordered to be inserted. The reference to an earlier specification must not put a construction on the latter. (*Atherton's Patent*, 6 R. P. C. 547.)

Rival Applications.—When two contending applicants for a patent claimed to be independent contemporaneous discoverers, the law officer usually refused to allow the grant to issue to either separately, but offered it to the two jointly. And so in a case of opposition before *Lord Cranworth, C.*, where a master and his foreman had both invented certain improvements, for which the master alone applied for a patent, but was opposed by the foreman on the ground of prior invention by the latter, the patent was ordered to be vested in trustees for the benefit of both. (*Re Russell's Patent*, 2 De G. & J. 130.) Where there was ground for supposing that the applicant owed part of the invention to the opponent, the Comptroller decided to seal a patent for the invention to the two as joint inventors. (*Eadie's Patent*, 1 Griff. P. C. 279.)

Evans's application was opposed by Cutting on the ground that the former had obtained the invention from the latter. Cutting afterwards made an application in respect of substantially the same invention, but that application was not opposed by Evans. As it appeared that the two had been jointly experimenting on the invention, *Sir R. Webster, A. G.*, directed that a patent be issued to Evans on condition that he assigned one half share to Cutting, and that Cutting should assign a half share of his patent to Evans, and if Cutting refused to assign, then Evans's patent was to be sealed forthwith. There being a difficulty in carrying out this arrangement, the law officers afterwards directed that Evans's patent should not be sealed, but that Cutting should assign one half share of his patent to Evans,

the assignment to contain provisions as to payment of the patent fees. (*Evans & Otway's Patent*, 1 Griff. P. C. 279. And see *Garthwaite's Patent*, 1 Griff. P. C. 284; *Luke's Patent*, 1 Griff. P. C. 294.)

Where an employer opposed the application of a person who was or had been in his service, on the ground that the invention sought to be patented probably resulted from investigations or experiments directed and paid for by the employer, the law officer, being satisfied of the *bona fides* of the opposition, granted his warrant on condition that the applicant should submit his provisional specification to the inspection of the opponent, and should strike out such portions of it as contained matters of the kind referred to by the opponent. This was done by *Coleridge, S. G.*, in the case of *Healey's Application*, No. 85, 1872, and also in the case of *Conniff's Application*, No. 3895, 1872.

In a case where there were rival applications for a patent for the same invention, and there was a conflict of evidence as to priority of discovery, the patent was awarded by the Lord Chancellor to him who was first in a position to seal it. (*In re Lowe's Patent*, 25 L. J. N. S. 454.) But now priority of sealing will confer no advantage on a later applicant, inasmuch as by section 13 of the Act of 1883 a patent must be dated and sealed as on the day of the application.

In cases of rival applications where the law officer was satisfied that one of the applicants was entitled to one part of the invention, whilst the other could more fairly claim another part, he issued his warrants to both, limiting the provisional specifications accordingly. This was done by *Coleridge, S. G.*, in the matter of *Craig* and *Macfarlane's Applications*. (P. M. J. vol. iv. 3rd series, 366.) Macfarlane had applied for Letters Patent for 'Improvements in rollers for paper-making machines,' and obtained the usual provisional protection. He claimed to have invented both a 'coutch-roll' and an 'underpress roller' for a paper-making machine. The application was opposed by Craig, on the ground that he was the first inventor of an underpress

roller, covered with vulcanite and vulcanised india-rubber, which formed part of Macfarlane's provisional specification, and for which Craig had also applied and obtained the usual protection. Craig contended that Macfarlane, who had obtained the material for the covering of the rollers from a rubber company, was at that time in Craig's employment, and that he had only applied for his patent after the rollers had been experimented with by Craig at one of his mills, and had been found successful. Craig submitted that the experiments adduced by Macfarlane had only reference to the coutch-roll of the machine, and that Macfarlane had not proved that he had ever experimented on the underpress roller. *Coleridge, S. G.*, decided to grant his warrant for the sealing of Macfarlane's patent for the coutch-roll alone, and to grant his warrant for the sealing of Craig's patent for the underpress roller.

In the case of *Ex parte Bates & Redgate* (L. R. 3 Ch. 577), where the second applicant had procured the Great Seal without having been opposed, before the first applicant petitioned for the Seal, *Lord Hatherley, C.*, only permitted the first applicant to include in his patent so much of the invention as was not covered by the patent already sealed, and, moreover, he ordered the first applicant's patent to bear date after the second applicant's.[1]

And so, where the law officer had reported that part of an invention for which a patent was sought was the subject of an existing patent, the Lord Chancellor ordered that part to be excluded from the new patent. (*Ex parte Manceaux*, L. R. 6 Ch. 273.)

The principle of these cases was that the Crown would

[1] In *Ex parte Dering* (13 Ch. D. 393), where two applicants had applied on the same day for the same invention, *Lord Cairns, C.*, refused to follow the decision in *Ex parte Bates & Redgate* as to the post-dating of the patent, on the ground that the Legislature intended patentees to have the full term of protection given by provisional specification, and ordered the applicant's patent to be sealed, and dated as of the day of application, although the sealing was opposed by the second applicant, who had already had the Great Seal affixed. (See the remarks on these cases by *Mr. Justice Kekewich* in *Kurtz* v. *Spence*, 5 R. P. C. 178.)

not grant a second patent in derogation of a former grant, and would not assume, without *scire facias*, that the first patent was void. See *Ex parte Bailey* (L. R. 8 Ch. 61) and *Ex parte Henry* (L. R. 8 Ch. 167, 169).

And this principle has been kept in view by the Comptroller and the law officers with regard to applications under the Act of 1883, disclaimers, as already stated, being frequently directed to be inserted in specifications, referring to an earlier patent.

Mala Fides.—Under the old law, if a case of *mala fides* could be made out, the Chancellor would interfere to prevent injustice. Thus, where a servant having filed a provisional specification, his master afterwards filed a provisional specification for the same invention, and then after obtaining a patent, a complete specification, there was grave suspicion that the master had surreptitiously obtained a knowledge of the servant's invention, and therefore the servant's patent was ordered to be sealed and dated as of the day of his application, notwithstanding the existence of the master's patent. (*Ex parte Scott & Young*, L. R. 6 Ch. 274.) The consequence of this would be that by virtue of section 24 of the Patent Act of 1852 acts done under the patent first sealed would be an infringement of the patent with an earlier date. (See *Saxby* v. *Hennett*, L. R. 8 Ex. 210.)

When the opposition was founded on a prior patent granted to the opponent, and the applicant alleged that the invention for which that patent was granted had been communicated by him in confidence to the patentee who had fraudulently obtained a patent for it, the Lord Chancellor directed the applicant's patent to be sealed, so as to give him an opportunity of trying the question in a court of law. *Re Vincent's Patent* (L. R. 2 Ch. D. 341). And see section 35 of the Patents Act 1883.

And where it was shown that the applicant had derived the principle of the invention from a rival applicant, the Seal would be refused to the former.

In April 1853 Hadden made application for a patent

for a method of making gun-cartridges. His plan obviated the necessity of biting off the end of the cartridge when the gun was being loaded, and its main feature consisted in making it weaker at one end, so that when rammed down it burst open and the powder ran into the breech of the gun. After lodging the provisional specification, Hadden had some conversation with Lott, to whom he described the general features of the invention. Shortly afterwards Lott applied for a patent for an invention having a similar object, and his specification described a collapsing chamber in the cartridge to hold the charge of powder, which chamber would be burst open by the action of the ramrod. This method of carrying out the general idea was different from the one adopted by Hadden. The Solicitor-General, having issued his warrant for the sealing of Lott's patent, the case was carried before the Lord Chancellor, who held that the two inventions were substantially the same, the material part in each being that one end of the cartridge was made weaker than the other with a view to its bursting under the action of the ramrod. Holding that Lott had obtained this idea from Hadden, the Chancellor refused to seal Lott's patent. (See also *Marshall's Application*, 5 R. P. C. 661.)

Herschell, S. G., in the case of Macfarlane's Patent (March 1883), opposed by the Animal Charcoal Company, Limited, declined to issue the warrant under the following circumstances. Macfarlane was manager of the company and Jones was a consulting engineer, and Ingham a chemist also employed by the company. It was asserted that Macfarlane was not the inventor of his alleged invention, but that it was based partly on suggestions made by Jones and partly on suggestions made by Ingham, all of which had been experimented upon in the company's works under Macfarlane's management. Although Macfarlane showed at the hearing that he had obtained an American patent for the invention in his own name during the pending of the opposition, the law officer, believing that the suggestions had been originally made by Jones and Ingham, declined to grant the patent.

In the case of *Griffin's Applications* (6 R. P. C. 296), the law officer refused to seal the applicant's patents, as there was strong reason for believing that the applicant had acquired his knowledge of the inventions from the opponent.

In the case of *Abel's Application*, No. 1908, 1876, opposed by De Muller, August 2, 1876, *Giffard, S. G.*, held that he could not take any official notice of alleged fraudulent proceedings abroad on the part of the foreign communicator of Abel's invention as against the opponent. He could not look behind the applicant Abel, who, as the first importer or introducer of the invention into Her Majesty's realm, was in law the inventor. And this course was followed in *Edmund's Patent*, 1 Griff. P. C. 281; and *Lake's Patent*, 5 R. P. C. 415.

COSTS.

The Comptroller has no authority to award costs; but the law officers have power, under the thirty-eighth section of the Act of 1883, to order costs to be paid by either party, and any such order may be made a rule of Court. See the Law Officers Rules, 11 and 12. As a general rule costs follow the event, but there may be special circumstances to influence the law officer. It is to be hoped that in any future legislation power will be given to the Comptroller to deal with costs of oppositions. It seems to be but just that in cases of frivolous and unsuccessful oppositions the opponents should pay the costs of the applicant.

CHAPTER XII.

THE PATENT: ITS DATE, DURATION, AND EXTENT.

By the twelfth section of the Patents Act of 1883 it is enacted that if there is no opposition to the grant of a patent, or in case of opposition if the determination is in favour of the grant, the Comptroller shall cause a patent to be sealed with the seal of the Patent Office, and a patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom. It is further directed that a patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except (1) where the sealing has been delayed by an appeal to the law officer, or by opposition to the grant, in which case the patent may be sealed at such time as the law officer may direct; and (2) if the applicant should die before the expiration of the fifteen months, in which case the patent may be granted to his legal representative, and sealed at any time within twelve months of the applicant's death.

But by the third section of the amending Act of 1885 it was enacted that a complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively, after the said nine and twelve months respectively, as the Comptroller may, on payment of the prescribed fee, allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said period specified in the principal Act. Applications for

enlargement of time must state on what circumstances, and upon what grounds the enlargement is applied for. (See the Forms U and V.)

By the thirteenth section of the Act of 1883 it is directed that every patent shall be dated and sealed as of the day of the application. The same section provides that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application. This proviso was intended to apply to such cases as *Ex parte Bates & Redgate* (L. R. 3 Ch. 577) and *Ex parte Manceaux* (L. R. 6 Ch. D. 274); see these cases cited in the chapter on Oppositions.

In the event of the death of an applicant for a patent before the sealing of the patent, it may be granted, under section 12 subsection (3 *b*) of the Act of 1883, to his legal representative, and sealed at any time within twelve months after the death of the applicant. In such a case application must be made to the Comptroller, who will require to be furnished with an official copy of or extract from the will or letters of administration, in proof of the applicant's title as legal representative.

By the eighty-sixth section of the Patents Act of 1883 the Comptroller may refuse to grant a patent for an invention, the use of which would, in his opinion, be contrary to law or morality.

The sixteenth section of the Act of 1883 directs that every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man, leaving out the Channel Islands, which have been previously included.

The duration of every patent is by the seventeenth section of the Act of 1883 directed to be limited therein to fourteen years from its date. According to the case of *Russell* v. *Ledsam* (14 M. & W. 574), the time runs from the day of the date of the patent, including that day: for instance, a patent for fourteen years, dated February 26, 1825, was held to expire at twelve o'clock on the night of February 25, 1839. As to the mode of obtaining an exten-

sion of the term, and the principles which guide the Privy Council in deciding upon the application, the reader is referred to Chapter XIV.

By the thirty-third section of the Act of 1883 every patent may be in the form set forth in the first schedule, but this form the Board of Trade has power, under the 101st section subsection 2, to alter or amend. Further, by the thirty-third section a patent is to be granted for one invention only, but no objection to a patent can be taken in an action or other proceeding on the ground that it comprises more than one invention.

On reference to the form of patent printed in the Appendix to this volume it will be seen that the Crown grants unto A. B. especial licence, full power, sole privilege and authority, that he, the said patentee, by himself, his agents or licensees, at all times thereafter during the term of fourteen years from the date, may make, use, exercise, and vend his invention within the United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them shall in his or their discretion seem meet; 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, all the Queen's subjects whatsoever are strictly commanded not to infringe the patent. It is, however, provided that, if it shall be made to appear to the Crown or the Privy Council that the grant is contrary to law, or prejudicial or inconvenient to the subjects of the realm in general, or that the invention is not a new invention as to the public use and exercise thereof within the United Kingdom, &c., or that the said patentee is not the first and true inventor thereof within the realm, the patent shall be void.

There are also other provisoes, the two most important of which make the grant void—first, if the said patentee shall not pay all fees by law required to be paid in respect of the 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, second, if the said patentee shall not supply or cause to be supplied for the service of the Crown all

such articles of the said invention as may be required by the officers or commissioners administering any department of the 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.

By the operation of the seventeenth section of the Act of 1883 every patent will cease if the patentee fails to make the prescribed payments within the prescribed times. A payment of 50*l.* must be made before the end of the fourth year and 100*l.* before the end of the eighth year (or before the end of the seventh year, in case of patents dated prior to January 1, 1884). Or instead of these payments annual fees may be paid. These annual fees and the prescribed times for payment are set forth in the Appendix to this volume. As to the procedure in regard to certificates of payment or renewal see rules 45–48 of the Patents Rules 1890.

It is, however, provided by the seventeenth section of the Act of 1883 that if 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; and 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, but not for more than three months. (As to the procedure, see rule 49 of the Patents Rules 1890, and form K.) It is further provided that 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.

In the case of *Williams* v. *Nash* (28 Bea. 93) it was held that a payment on the third anniversary of the date was a sufficient compliance with the statute which prescribed the

payment of a stamp duty of 50*l.* *before the expiration* of the third year. The patent was dated on February 26, 1855, and the third year's stamp duty was paid on February 26, 1858.

Under the ninety-eighth section of the Act of 1883, whenever the last day for paying a fee at the Patent Office shall happen to fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or on a day observed as a holiday at the Bank of England, or on any day observed as a public fast or thanksgiving, the fee may be paid on the day next following any of these days.

Where any prescribed payment has not been made in due time, and no application has been made to the Comptroller for an enlargement of the time, and the patent has consequently become void, nothing short of a special Act of Parliament can restore its validity. But such Acts are more difficult to obtain since the Act of 1883 came into operation than formerly.

In case clerical errors should have been made in Letters Patent, the Master of the Rolls had and still has power to correct them (*Re Nickels' Patent*, 4 Bea. 563; *Re Gare's Patent*, L. R. 26 Ch. D. 105); but the application must be made within a reasonable time (*Re Blamond's Patent*, 3 L. T. N. S. 800). In the case of *Adam's Patent* (1 W. R. 259), a doubt having been expressed as to the jurisdiction of the Master of the Rolls, the order was made by the Lord Chancellor. But now the powers of amendment given to the Comptroller by section 18 of the Patents Act 1883 seem extensive enough to cover clerical errors in patents.

In the event of a patent being lost or destroyed, or if its non-production should be accounted for to the satisfaction of the Comptroller, he is empowered by the thirty-seventh section of the new Act to cause a duplicate thereof to be sealed.

In the case of *Feather* v. *The Queen* (6 B. & S. 257), it was decided that the Crown has a right to the free use of any patented invention (see the case more fully stated at

the end of the chapter on Infringements); and this decision applies to all patents granted before the commencement of the Act of 1883, or on applications then pending; but as to patents granted afterwards, they will have the same effect against the Crown as against a subject (section 27). The officers or authorities administering any department of the service of the Crown, their agents, contractors, or others are to be entitled to use any invention for the service of the Crown on terms to be agreed upon with the approval of the Treasury; or if an agreement cannot be effected, then on such terms as the Treasury, after hearing all parties interested, shall settle.

By the forty-fourth section of the Patents Act of 1883 the Secretary of State for War is empowered to acquire by purchase or gift the benefit of any inventions of improvements in munitions of war, and of any patent obtained for the same, and to prevent the disclosure of such inventions.

The effect of the forty-fifth section is that patents issued or applied for before the commencement of the Act will not have the benefit of the provision binding the Crown, nor will they come under the liability imposed by the clauses relating to compulsory licences. But in all other respects, including the proceedings for amendments, prolongations, and revocations, the Act of 1883 will extend to patents granted before the commencement of the Act, or on applications then pending, except slight differences on the payment of the annual fees. (See Appendix.)

By the thirty-fifth section of the Act of 1883 a patent granted to the true and first inventor is not to 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.

The 113th section of the Patents Act of 1883 repeals all the statutes described in the third schedule of the Act, but goes on to enact that the repeal shall not affect the *past operation* of any of those statutes. Now, the twenty-fifth

section of the Patents Act of 1852 declares that any British patent which bears date after a foreign patent for the same invention (being a foreign invention) shall be void at the expiration of such foreign patent. Consequently, any British patent granted before the commencement of the Act of 1883, and standing in this relation to a foreign patent, will be void by the operation of these two clauses, in case the foreign patent shall have expired before the commencement of the Act of 1883. That is to say, since the earlier Act has already rendered the British patent void, that 'past operation' of the Act will not be affected by its repeal by the Act of 1883. But if the twenty-fifth section of the earlier Act at the time of its repeal has not had an invalidating operation on a patent, then the British patent will not be touched, and the clause in question will have no effect. As regards patents which have been obtained on applications pending at the commencement of the new Act, it is presumed that the third subsection of the forty-fifth section of that Act will effectually protect them from the operation of the twenty-fifth section of the Act of 1852.

The operation of sect. 113 on patents granted under the Act of 1852 was considered with reference to other points in the cases of *Singer* v. *Stassen* (1 R. P. C. 121) and *Brandon's Patent* (1 R. P. C. 154).

It was held by *Baron Huddleston* in the case of *Nordenfeldt* v. *Gardner* (1 R. P. C. 10 and 73), that in order to invalidate a British patent on the ground of the invention being a foreign invention for which a Belgian patent had been obtained prior to the date of the British patent and had lapsed, the foreign patent must have been not merely applied for, but actually obtained before the British patent, and this, although the foreign patent when granted bore a date earlier than that of the British patent.

When a patent is granted to two or more persons, each may use the invention without being liable to account to the other. (*Mathers* v. *Green*, 1 Law Rep. Ch. Ap. 29, before *Lord Cranworth, C.*) See, however, the earlier case of *Hancock* v. *Beuley* (Johns. 601), as to the rights of parties

where Letters Patent are vested in trustees for two or more persons as tenants in common.

In case of the death of the patentee intestate before the expiration of the patent, his interest under it passes to his personal representatives, and not to his heir. In case of bankruptcy the property in the patent will pass to the trustee or assignee, like the rest of the bankrupt patentee's personal assets. (*Bloxam* v. *Elsee*, 9 D. & R. 215.)

CHAPTER XIII.

AMENDMENTS OF SPECIFICATIONS.

It has been shown that where a material part of an alleged invention is not new or not useful, the patent is altogether invalid; and that if a patentee claims by his specification more than he is entitled to, the patent is likewise void. The fatal effect of an inconsistency between the title and the specification, or between the provisional and the complete specification, has also been pointed out. To remedy a law which in many cases bore unjustly upon patentees, the Act of 5 and 6 Wm. IV. c. 83 empowered a patentee to take steps for altering his specification by disclaimer. That Act, however, as well as other Acts relating to disclaimers, were repealed by the Act of 1883, which substituted the following provisions for those of previous statutes. By the eighteenth section it is enacted that—

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

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

(5) Where no notice of opposition is given or the person so giving notice does not appear, the Comptroller shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

(6) When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.

(7) The law officer shall, if required, hear the person making the request and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all Courts and for all purposes be *deemed* to form part of the specification.

(10) (As amended by the fifth section of the Act of 1888.) 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.

The procedure on applications for amendments is regulated by rules 52–59 of the Patents Rules, 1890.

After specifications have become public property they must be amended under section 18. Any other amendments are to be dealt with under sections 7 and 9 of the Act of 1883. (*Jones' Patent*, 1 Griff. 313.) Where an applicant desires, prior to the acceptance of his complete specification, to omit

part of the invention covered by the original title, the Comptroller should give him the option of either filing the specification with the original title and inserting a disclaiming clause, or should amend the original title in the application and the provisional specification, as he is virtually empowered to do under ss. 7 and 9, the amendment being confined to simple excision. (*Dart's Patent*, 1 Griff. P. C. 307.)

According to the report of *Hearson's Application* (1 R. P. C. 214), both the then law officers were of opinion that the Comptroller has power to impose conditions on giving leave to amend a specification by way of disclaimer. But he cannot give costs. (*Pietschmann's Patent*, 1 Griff. P. C. 310.)

The twenty-first section directs that every amendment of a specification shall be advertised. This will be done by the Comptroller under rule 59.

Appeal to the Law Officer.—The law officers rules will be found in the Appendix. By sect. 38 of the Act of 1883 they have power to examine witnesses on oath.

There is no appeal from the order of the law officer when he grants or refuses leave to amend on the appeal to him from the decision of the Comptroller. Nor, according to the decision of a Divisional Court and the Court of Appeal in the case of *Van Gelder's Patent* (6 R. P. C. 22), can a writ of prohibition be obtained, prohibiting the law officer from allowing the amendment of a specification.

An amendment which has been allowed by the Comptroller or law officer can be questioned in a Court of Law if it is contrary to subs. 8 of s. 18 of the Act of 1883, that is, if it makes the specification claim an invention larger than, or different from, the invention originally claimed. (*Van Gelder's Patent*, 6 R. P. C. 22; *Gaulard and Gibbs' Patent*, 6 R. P. C. 225.)

Who is entitled to oppose.—When the ground of opposition is that the invention as described in the amended specification is the same as that comprised in a prior patent, it is not competent for any member of the public to oppose; the opponent must show that he has an interest in the prior patent. (*Bell's Patent*, 2 Griff. P. C. 11.)

Grounds of Opposition.—These are usually some of the following: that the proposed amendment will introduce disconformity between the provisional and the complete specification; that the scope of the invention will be enlarged; that the amended specification will claim an invention substantially different from that claimed by the original specification; that the invention will be made the same as that described in a prior specification.

It is not a good ground of opposition that the invention will be restricted within narrower limits by the amendment, provided that the invention so restricted is covered by the origiual specification. *Cochrane's Patent* (1 Griff. P. C. 304); *Ashworth's Patent* (2 Griff. P. C. 6); *Nordenfelt's Patent* (2 Griff. P. C. 19).

Conditions imposed on allowing Amendments under the old law.—It had become a common but not invariable practice under the old law for the law officers, on applications for leave to amend specifications under the Act of 5 & 6 Wm. IV., to impose as a condition that no action for an infringement before the date of the disclaimer should be brought either against certain persons or against any of the public. See *Holmes* v. *London and North-Western Railway Co.* (Macr. P. C. 31) and *Smith's Patent* (Macr. P. C. 232).

In *Re Tranter's Patent* of 1865, which was a patent for fire-arms and cartridges, an application was made in August 1873, by the assignees of the patent, for leave to disclaim certain portions of the matters claimed in the specification, and the application was opposed by manufacturers of fire-arms and cartridges chiefly on the ground that they had embarked large capital in the manufacture of cartridges, and that they ought to be protected in their manufacture against any proceedings on the part of proprietors of a patent which had been allowed to remain in its imperfect state for a long time, inasmuch as the effect of the disclaimer would be to enable the applicants to take such proceedings. *Coleridge, A. G.*, granted the leave sought for on the condition that the applicants 'should undertake that no legal proceedings be taken against the

opponents in respect of the manufacture, use, or sale of cartridges, or for any alleged infringement of the patent in question when amended by disclaimer.' And this decision was followed by *Giffard, S. G.*, in the case of *Re Jones's Patent*, on the application of Mr. Batley, the assignee, for similar leave.

On an application for leave to disclaim parts of the specification under *Crabtree's Patent*, No. 2775 of 1878, *James, A. G.*, Feb. 12, 1881, allowed the application upon terms that no action should be brought against any person in respect of any machine which had prior to the hearing been made or sold by any of the opponents. He directed that lists of such machines should be supplied and verified if required by statutory declaration.

The principle of these cases received considerable extension in *Re Medlock's Patent* (Newton's L. J. N. S. vol. xxii. p. 69). That was an application for leave to enter a disclaimer of part of a specification under a patent for preparing a red or purple dye. The patent had been declared invalid on the ground that, of the two alternative processes described in the specification, confessedly only one would answer. (See *Simpson* v. *Holliday*, 13 W. R. 577, cited *ante*.) The application was opposed by several chemical manufacturers, some of whom had been made defendants in suits instituted by the owners of the patent. *Collier, S. G.*, would only consent to grant the leave sought for on the terms that the applicants should bring no action against the opposers 'for any infringement of the patent by the use or continued use, *during the continuance of the patent*, of any processes for manufacturing red and purple dyes *in use by them at the present time*.' The applicants refused to accept this condition, and the Solicitor-General consequently disallowed the disclaimer.

The law officer, however, did not always insist upon the patentee giving an undertaking of this nature. It was sometimes thought right that he should be at liberty to seek compensation for the past infringement of the patent. (*Re Lucas's Patent*, Macr. P. C. 234.)

Conditions under the Act of 1883.—An order having been obtained during the progress of an action for an infringement to amend a specification under a patent issued under the Act of 1852, subject only to the payment of the costs by the plaintiff, application was made to the Comptroller, who gave leave to amend as proposed without imposing any conditions. On appeal to the law officer, *Herschell, S. G.*, he held that the leave should be made subject to the condition that no action should be brought or proceeding taken in respect of any infringement prior to January 1, 1884, but without prejudice to any question in the pending action. (*Re Hcarson's Patent*, 1 R. P. C. 214.) See also *Westinghouse's Patent* (1 Griff. P. C. 315); *Ashworth's Patent* (2 Griff. P. C. 6); *Haddan's Patent* (2 Griff. P. C. 12). The ground for fixing that date is that infringements subsequent to January 1, 1884, would be brought within the scope of the 20th sect. of the Act of 1883. Hence, such a condition is not usually imposed on allowing amendments in specifications under patents issued since the latter Act came into operation. (*Allen's Patent*, 2 Griff. P. C. 3.) There may be special circumstances to induce the law officer to impose the condition that no action should be brought for anything done at any time before the amendment. (*Ashworth's Patent*, 2 Griff. P. C. 9.) This was a patent under the Act of 1852.

The law officer sometimes thinks it right to require the insertion of an additional disclaimer. (*Hampton & Facer's Patent*, 2 Griff. P. C. 13.)

'*Explanations.*'—*Sir R. Webster, A. G.*, said in *Beck and Justice's Patent* (2 Griff. P. C. 10), 'My idea of the function of an explanation (sect. 18, subs. 1, of the Act of 1883) is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. I do not think it is intended that he should put in subsequently acquired knowledge. I do not mean to lay down a hard-and-fast rule, but, speaking broadly, it was intended to permit a man to amend, correct, and explain the enunciation of his invention as he intended

originally to give it.' And see *Nordenfelt's Patent* (2 Griff. P. C. 18).

The amendment of a specification by inserting the correct description of a drawing which had been misdescribed was allowed in the case of *Morgan's Patent* (2 Griff. P. C. 17).

Application to a Judge for liberty to apply to amend pendente lite.—When a patentee has brought an action for the infringement of his patent, or when proceedings for its revocation are pending, he is prevented by the 10th subs. of sect. 18 of the Act of 1883 from applying directly in the usual way to the Comptroller for leave to amend the specification. But by the 19th sect. of that Act it is enacted that 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. Under rule 58 of the Patents Rules, 1890, an office copy of the judge's order must be left at the Patent Office along with the request for leave to amend. (*Codd's Patent*, 1 Griff. P. C. 305.)

After judgment it is both too late and unnecessary to make application to the judge for liberty to apply to amend, since the judge has then no power to make an order, and the patentee is at liberty to apply directly to the Patent Office in the ordinary way, even if an appeal to the House of Lords be pending. (*Cropper* v. *Smith*, 1 R. P. C. 254; and see *Lawrence* v. *Perry*, 2 R. P. C. 187.)

It seems that where more than one legal proceeding relating to a patent is pending it is not necessary to apply for leave to disclaim in all of them. (*Hall and others*, 5 R. P. C. 306.) And in the same case it was held by a Divisional Court that after a judge's order had been obtained giving liberty to apply to the Comptroller for leave to amend the specification, a writ of prohibition to prevent him pro-

ceeding with the hearing of the application ought to be refused.

The discretion given to the Court or a judge by the 19th sect. is absolute in each particular case upon the particular circumstances of that case, and will not be interfered with by the Court of Appeal unless it can be shown to have been absolutely wrong. (*Allen* v. *Doulton*, 4 R. P. C. 383; *Lang* v. *The Whitecross Company*, 6 R. P. C. 570.)

The terms to be imposed on the person seeking to amend should be such as to give full protection to the other party. *Bray* v. *Gardner* (4 R. P. C. 40).

The Court of Appeal in *Singer* v. *Stassen* (1 R. P. C. 122) held that liberty to apply for disclaimer during action should be given upon the terms that the costs of the amendment should be the defendants' costs in any event, and that the specification, as amended, should not be receivable in evidence in the action. In *Codd* v. *Bratby* (1 R. P. C. 209), leave to amend was given upon the terms that the specification when amended should not be given in evidence at the trial; that no evidence of infringement should be given prior to the date of filing the amended specification; and that the costs of the motion be paid by the plaintiffs. In the *Fusee Vesta Co.* v. *Bryant & May* (4 R. P. C. 71), it was ordered that the costs of the defendants in the action up to and including the plaintiffs' application to amend, and consequent upon the amendment, should be borne by the plaintiffs in any event. See also *Gaulard* v. *Lindsay* (5 R. P. C. 192); *Haslam Co.* v. *Goodfellow* (5 R. P. C. 29); *Lang* v. *The Whitecross Co.* (6 R. P. C. 570); *Gaulard and Gibbs' Patent* (5 R. P. C. 189); as to the terms upon which liberty to apply to the Comptroller for leave to amend the specification will be given. The last of these cases was a petition for revocation, and the two former were actions for infringements, in which, on giving the liberty applied for, the condition was imposed that the action should be confined to the specification as amended, and therefore damages for infringements prior to the amendment could not be claimed.

Seeing what are the terms usually imposed on a plaintiff when making application to the Court for liberty to apply for leave to amend his specification, it may in some cases be worth consideration whether both time and money would not be saved by discontinuing the action as soon as defects are discovered in the specification, applying for leave to amend at the Patent Office in the ordinary way, and then bringing a fresh action if that course is thought desirable.

Amendments must not enlarge or materially vary the original invention.—We have seen that under the eighth sub-section of the eighteenth section of the Act of 1883 '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 the amendment.'

It is part of the duty of the Comptroller and the law officers, when hearing applications for leave to amend, to see that the proposed amendment does not extend the scope of the patent, or alter the claims in such a way that the invention would become something substantially larger than or substantially different from what it was originally. (*Heath and Frost's Patent*, 1 Griff. 310.) When it is clear to the Comptroller or to the law officer that a proposed amendment would contravene subs. 8 of s. 18, it is his duty to disallow it (*Heath and Frost's Patent, ubi supra*); but when the question is doubtful, he ought to allow the patentee to make the amendment at his peril. (*Lake's Patent*, 2 Griff. P. C. 16.)

Where a specification claims both a general combination and some of the subordinate parts, a disclaimer may sever and reject the claim to any of the parts. But a specification cannot be altered so as to be made to claim a combination or parts if they were not previously claimed. In the matter of *Serrell's Patent* (6 R. P. C. 103), *Sir R. Webster, A. G.*, said that in his opinion where a specification contains a distinct and specific claim to the operation of what is believed to be new, the patentee cannot be allowed to

strike out the whole of the claim and insert another claim to a subordinate part.

On the other hand, care should be taken in preparing a disclaimer that sufficient of the invention is left to support the patent. (*Gaulard and Gibbs's Patent*, 5 R. P. C. 525; *United Horseshoe Co.* v. *Swedish Horsenail Co.*, 6 R. P. C. 1.)

If there is a claim to all methods of effecting a certain result, it may be cut down by disclaimer to the particular method described in the specification. (*Ashworth's Patent*, 2 Griff. P. C. 6.)

Disclaimers under the old law.—The first section of the earlier Act (5 and 6 Wm. IV. c. 83), now repealed, under which disclaimers were first authorised, disallowed such 'as shall extend the exclusive right granted by the letters patent.'

In the matter of *Bateman and Moore's Patent* (Macr. P. C. 116), an application was made (1854) to *Bethell*, *S. G.*, for leave to alter the specification, so as to make it disclaim the separate parts of the invention, and claim only the combination. The Solicitor-General said that he should require to see from the specification itself that it had not been intended to claim the separate parts, but their combination only. Finding some indication of an intention to claim the apparatus as a whole, he gave the patentees permission to reject certain words in the claiming part of the specification which were inconsistent with such a construction.

Several cases came before the Courts in which the construction of the prohibitive words of the earlier Act was debated. 'The object of the Act authorising disclaimers' (said *Lord Westbury* in the case of *Ralston* v. *Smith*, 11 H. L. C. 223) 'was plainly this: that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of being severed, leaving the original description in its integrity good and sufficient, without the necessity of addition, then

you may, by the operation of a disclaimer, lop off the vicious matter, and leave the original invention, as described in the specification, untainted and uninjured by that vicious excess.'

The operation of a disclaimer under the old law was considered in the case of *Seed* v. *Higgins* (8 E. & B. 755). The patentee described in his specification, and illustrated by drawings, some machinery for preparing cotton, and after saying that the apparatus so described represented one practicable mode of carrying out the invention, he proceeded to state that he did not intend to confine himself to this particular method, but claimed as his invention the application of the law or principle of centrifugal force for a certain purpose. He afterwards disclaimed his claim to the application of the law or principle, and limited his claim to the application of centrifugal force acting in a certain manner as described in the specification. This was held to be a limitation of his claim to the particular apparatus described, whereby the principle was applied in a certain way, and afforded no ground for contending that the disclaimer described a different invention from that described in the specification. This view was also taken on appeal by the Court of Exchequer Chamber (8 E. & B. 771) and by the House of Lords (8 H. L. C. 550).

In the case of *Ralston* v. *Smith* (11 C. B. N. S. 471), it was decided by the Court of Exchequer Chamber, and afterwards by the House of Lords (11 H. L. C. 223), that a disclaimer is bad which is in effect an attempt to turn a specification for an impracticable generality into a grant for a specific process, comprised within the generality in one sense, but not to be discovered there without going through the same course of experiment which led to the discovery of the specific process in the disclaimer. The specification in this case was expressed in general terms, embracing a great number of modes of engraving upon rollers any desired design for the purpose of embossing woven fabrics. It was afterwards found that only rollers with circular grooves would answer, and the patentee there-

upon, by disclaimer, limited his invention to such rollers. 'Now' (said *Lord Chelmsford*), 'as these were not specifically described in the original specification, but were merely involved in the general terms which were used, the patentee had not complied with the conditions of the letters patent in particularly describing and ascertaining the nature of his invention. When, therefore, by his disclaimer he confines his claim to circular grooved rollers as his sole invention, though in one sense he may be said to narrow a right, yet he really extends it, because he thereby describes his alleged invention sufficiently to enable him now to assert a right under the patent which he never could have successfully maintained upon the original specification alone.'

Other decisions as to disclaimers under the old law were *Cannington* v. *Nuttall* (L. R. 5 H. L. 205) and *Dudgeon* v. *Thomson* (L. R. 3 A. C. 34).

Under that part of the Act of 5 and 6 William IV. c. 83 which enacts that 'no objection shall be made, in any proceeding whatsoever, on the ground that the party making such disclaimer or memorandum of alteration had not such authority in that behalf,' it was held that the disclaimer of a patentee who had assigned all his interest in the patent could not be objected to. (*Wallington* v. *Dale*, 7 Exch. 888.) The language of the Act of 1883 is that 'leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud.'

Powers of the Master of the Rolls.—The Master of the Rolls has power to allow amendments in a specification filed under the Act of 1852, or which is otherwise to be considered as a record under the authority of the M. R., notwithstanding s. 18 of the Act of 1883. (*Gare's Patent*, L. R. 26 Ch. D. 105.)

The Master of the Rolls may without action order a disclaimer to be removed from the file, when filed without the consent of the patentee. (*Re Berdan's Patent*, L. R. 20 Eq. 346.)

The M. R. refused to cancel a memorandum of altera-

tion made under 5 and 6 William IV. c. 83, when application was made to him for that purpose, on the ground that it extended the patentee's privilege and infringed the petitioner's patent rights, for he held he had no jurisdiction. (*Re Sharp's Patent*, 3 Beav. 245.)

To amend clerical errors in a specification application must be made to the Master of the Rolls or the Comptroller as before stated.

The following cases decided by the Lord Chancellor or Master of the Rolls relate to the amendment of clerical errors under the old law: *Re Sharp's Patent* (3 Beav. 245); *Re Redmund* (5 Russ. 44); *Re Ruberry's Patent* (1 W. P. C. 649); *Re Dismore* (18 Beav. 538); *Re Johnson's Patent* (L. R. 5 Ch. D. 503).

COSTS.

The Acts do not authorise the Comptroller to award costs. (*Pietschmann's Patent*, 1 Griff. P. C. 314.) But the law officer is empowered by the thirty-eighth section of the Patents Act of 1883 to order costs to be paid by either party, where leave to amend is opposed, and any such order may be made a rule of Court. It is usual to let costs follow the event, but the law officer exercises his discretion according to the circumstances of each case. See the Law Officers Rules, 11 and 12.

CHAPTER XIV.

EXTENSION OR PROLONGATION OF LETTERS PATENT.

NOTWITHSTANDING the merit and utility of his invention, a patentee frequently finds himself nearly at the expiration of the term for which his patent was granted without having reaped the reward which he was fairly entitled to expect. This may have happened from various causes. To perfect the invention, to make arrangements for the manufacture, and to bring the product to the notice of the public may have been attended with great expenses, which were never repaid. It sometimes occurs that the public are slow to acknowledge the merit of an invention of real value, and the patentee's privilege is on the point of expiring before they can be brought to extend their patronage to it. It may be that the patentee's monopoly has been infringed, and that much time has been lost and large costs have been incurred in enforcing or defending his just rights. Or it may be that the patentee did not himself possess sufficient means, and was never fortunate enough to meet with a capitalist to advance what was necessary to work the invention. From some one of these causes, or from several of them combined, it happens not seldom that a patentee fails to derive any benefit, even if he escapes loss, from an invention of real merit and value.

In order to afford the unsuccessful but meritorious patentee an opportunity of remedying this hardship at a less cost than a special Act of Parliament, the statute of 5 and 6 William IV. c. 83 empowered him to petition the Queen in Council for a prolongation of the term of his patent; and now by the twenty-fifth section of the Patents

Act of 1883 it has been enacted that a patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent. But in the case of *Brandon's Patent* (1 R. P. C. 154), it was held that owners of patents existing before January 1, 1884, could apply for prolongations at any time before the expiration of such patents. Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension. If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the Committee shall consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard on the petition. The Judicial Committee are to 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. If they report that the patentee has been inadequately remunerated, her Majesty in Council may extend the term of the patent for seven, or in exceptional cases fourteen, years; or may 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.

An assignee may apply for an extension, but he does not stand altogether in the same favourable position as the patentee. (*Claridge's Patent*, 7 Moo. P. C. 394.) It is chiefly with the view of rewarding a meritorious inventor that the extension of a patent is granted. If, however, the assignee be a person who has assisted the inventor with funds to enable him to perfect the invention and bring it into use, this circumstance is a favourable feature in a petitioning assignee's case. (*Norton's Patent*, 1 Moore, P. C. C. N. S. 339, in which case the petitioners, who were a public company, were refused a prolongation which they applied for after the death of the inventor.) See also the

cases of *Cardwell's Patent* (10 Moo. P. C. C. 488); *Pitman's Patent* (8 Moo. P. C. C. N. S. 297); *Hutchison's Patent* (14 Moo. P. C. C. 364); *Normand's Patent* (L. R. 3 P. C. C. 193); *Reece's Patent* (51, Engineer, 207); *Sillar's Patent* (Goodeve's cases, 581). But public companies have in some cases been successful petitioners, *Houghton's Patent* (7 Moo. P. C. N. S. 309); *Napier's Patent* (13 Moo. P. C. 543); *Church's Patents* (3 R. P. C. 95).

THE PETITION AND THE PROCEDURE.[1]

The proceedings commence by the insertion of advertisements in the public prints, giving notice of the patentee's intention to apply for a prolongation of his patent (see the Privy Council Rules), and a petition setting forth the facts must then be presented to her Majesty in Council, at any time before the expiration of the patent, though it will be prudent not to delay presenting the petition much after six months before the expiration.

All facts material to the petitioner's title, and to the history of the patent, must be stated in the petition (*Johnson's Patent*, L. R. 4 P. C. C. 83), which ought to be a clear and candid statement of the circumstances under which the petitioner presents himself before the tribunal. In one case, when material facts were omitted, the hearing was postponed, and the petition directed to be amended. (*Hutchison's Patent*, 14 Moore, P. C. C. 364.) In other cases where important facts were not set forth, the applications were refused. (*Pitman's Patent*, 8 Moore, P. C. C. N. S. 293; *Horsey's Patent*, 1 R. P. C. 225.) Where the patentee had assigned his patent before applying for an extension, and had omitted to state this fact in his petition, it was dismissed, leaving the inventor or his assignee, if he thought proper, to apply again. (*Mitchell's Patent*, February 1882.) A mortgagee ought to be made a party to the petition. (*Church's Patents*, 3 R. P. C. 95.) And the legal personal re-

[1] Forms of Petition for Extension of a Patent, Objections to Extension and a Petitioner's Accounts will be found in Mr. W. N. Lawson's *Law and Practice under the Patents Acts*, 2nd ed. pp. 507-524.

presentative of the deceased patentee must, under certain circumstances, join in the petition. (*Willacy's Patent*, R. 5 P. C. 690.)

If foreign patents have been obtained, the fact should be mentioned. (*Pitman's Patent*, L. R. 4 P. C. 86; *Adair's Patent*, 6 App. Cas. 176; *Newton's Patent*, 1 R. P. C. 177).

Important facts having been inadvertently omitted from the petition, leave was applied for and granted to file supplementary particulars before the hearing. (*In Re Reece's Patent*, 51 Eng. 207.)

Any person may enter a caveat addressed to the Registrar at the Council Office against the extension. Having done so, he is entitled to have notice from the petitioner of any special application and of the hearing, and may be heard in opposition, when the case is entered upon, before the Judicial Committee. The caveat must be entered in the name of the actual opponent, not in that of the patent agent. (*Lowe's Patent*, 8 Moore, P. C. C. 1.) As to the right of an alien living abroad to be heard in opposition to an extension, see *Schlumberger's Patent* (9 Moore, P. C. C. 1).

By the sixth of the Privy Council Rules persons who have entered caveats must, within a fortnight after service on them of copies of the petition, lodge at the Council Office notice of the grounds of their objection. In *Ball's Patent* (4 App. Ca. 171), it was held to be unnecessary to state the particulars if the grounds are given. The Crown may adduce evidence against a patent irrespective of the objections, *Duncan Stewart's Patent* (3 R. P. C. 9); *Church's Patents* (3 R. P. C. 95).

By the ninth rule the petitioner must lodge at the Privy Council Office, at least one week before the day fixed for the hearing, six printed copies of his specification, and also four copies of his accounts. If the accounts are not filed in due time the Committee may refuse to go into the question. (*Johnson's and Atkinson's Patents*, L. R. 5 P. C. 87; *Chatwood's Patent*, L. R. 5 P. C. 88, note.)

Under the eighth section of the 7 and 8 Vict. c. 69, the Judicial Committee may appoint one of the clerks of the

Privy Council to take any formal proofs required to be taken in dealing with the matter before them, and may proceed on the clerk's report as if the proofs had been taken by the Committee itself; and this section was not repealed by the Patents Act of 1883. By the sixth sub-section of the twenty-fifth section of that Act it was enacted that her Majesty in Council might make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings should be regulated according to the existing procedure and practice in patent matters of the Judicial Committee. The rules now in force will be found reprinted in the Appendix to this volume.

THE HEARING.

The Judicial Committee of the Privy Council is empowered by the twenty-eighth section (sub-section 2) of the new Act to call in the aid of an assessor specially qualified in any proceeding before them relating to patents.

Not more than two barristers will be heard on each side: that is to say, two in support of the applicant's case and two in opposition. Where, however, more parties than one oppose, and they have separate and independent grounds of opposition, each will be allowed two counsel. The Attorney-General usually appears to watch the case on behalf of the Crown. The petitioner may appear in person.

The petitioner must be prepared at the hearing with evidence to show that there is an invention, and that the invention possesses utility, the word here meaning substantial merit and usefulness to the public, not merely the *scintilla utilitatis* which is sufficient to justify the grant of a patent in the first instance. He must further show that all reasonable means had been taken to make the invention productive; and if his case is that he has never been reimbursed his expenses, he must give reasonable evidence of the amount of his loss. If, however, there is a balance of profit, but to an extent incommensurate with his fair expectations, he will be required to show what the real profit

has been. Where the statement of the accounts is unsatisfactory the Committee will either direct that question to be taken before considering the merits of the invention, or adjudicate without reference to them. (*Clark's Patent*, L. R. 3 P. C. 421; *S. C.* 7 Moore, P. C. C. N. S. 255; *Wield's Patent*, L. R. 4 P. C. 89; *S. C.* 8 Moore, P. C. C. N. S. 300.) But where the accounts are satisfactory on their face the usual course is to go into the question of merits first. (*Houghton's Patent*, L. R. 3 P. C. 462.) (See the section on the Accounts, *post*.)

The merit and substantial utility of the invention ought to be shown by the testimony of persons of experience and weight. (*McDougal's Patent*, L. R. 2 P. C. 1; *Betts' Patent*, 1 Moo. P. C. 49; *Stoney's Patent*, 5 R. P. C. 519.) Where the utility of the invention as a whole was not apparent the petition was dismissed. (*Willacy's Patent*, 5 R. P. C. 690.)

The petitioner must show that the parties interested had made efforts to bring the invention into public use.

Delay for a prolonged period on the part of an inventor in attempting to bring his invention into use is a good reason for refusing to grant an extension unless some reasonable excuse can be shown. (*Norton's Patent*, 1 Moore, P. C. C. N. S. 339.)

If the invention has not been brought into use, in spite of the earnest endeavours of the persons interested in the patent, that circumstance will be taken as a strong presumption that it is wanting in practical utility, and, if not satisfactorily explained, the application will be refused. (*Southworth's Patent*, 1 W. P. C. 487; *Kollman's Patent*, 1 W. P. C. 565; *Jones' Patent*, 1 W. P. C. 579; *Bakewell's Patent*, 15 Moore, P. C. 385; *Allan's Patent*, L. R. 1 P. C. 507; *Herbert's Patent*, L. R. 1 P. C. 389; *Patterson's Patent*, 6 Moore, P. C. 469; *Wield's Patent*, 8 Moore, P. C. N. S. 300.) For instance, the patentee may show that he was incapacitated for business for a long period by an accident. (*Roper's Patent*, 4 R. P. C. 201.)

The presumption of non-utility in the invention may

also be rebutted by evidence showing its merit and utility. (*Hughes' Patent*, L. R. 4 App. Cas. 174.) The petitioner should be prepared with evidence to show that there is a reasonable probability of an increased use or sale in the immediate future.

It is open to those who oppose the extension to adduce evidence to show that the invention is wanting in novelty or utility, or that it is imperfect; and they may likewise point out defects in the specification. It is sufficient to state the grounds of objection to an extension without stating the particulars. (*Ball's Patent*, 4 App. Cas. 171.) But in *Saxby's Patent* (L. R. 3 P. C. 294) the Council refused to go into the questions of novelty or utility where the merit of the invention had been proved and the patentee had been inadequately rewarded. Lord Cairns said, 'In point of fact it is not the practice of this tribunal to decide upon the novelty or utility of the invention, although it would abstain from prolonging a patent which was manifestly bad.' See also *Cockings' Patent* (2 R. P. C. 151); *Church's Patents* (3 R. P. C. 95). However, in *Stewart's Patent* (3 R. P. C. 7), evidence that the invention had been anticipated by previous patents and by user of machines was admitted, and the petition was dismissed.

The fact of improvements having been made by other persons in the patentee's invention after the date of his patent does not afford ground of opposition to an application for an extension if the invention has a merit of its own, and if the patentee has not reaped a benefit in proportion to that merit. (*Galloway's Patent*, 1 W. P. C. 727; *Napier's Patent*, 6 App. Cas. 174.)

Nor is it a valid ground of objection that the manner of working the invention had been varied since the filing of the specification. (*Heath's Patent*, 2 W. P. C. 257.)

'If a patentee has allowed his foreign patents, obtained after the date of the British patent, to lapse, that is not a ground for refusing the prayer of the petition. (*Adair's Patent*, 6 App. Cas. 176; and see *Johnson's Patent*, L. R. 4 P. C. 79; *Hills' Patent*, 1 Moore, P. C. N. S. 258.)

But if the invention as originally specified proved a failure (*Bell's Patent*, 2 W. P. C. 160), or when it was only made completely successful by adopting improvements introduced by other persons from abroad (*Woodcroft's Patent*, 1 W. P. C. 740), the patentee was thought disentitled to an extension.

On the other hand, if the introduction of the invention has been strongly opposed by persons engaged in the trade (*Stafford's Patent*, 1 W. P. C. 563; *Roberts' Patent*, 1 W. P. C. 573), or if the patentee has never been able to raise the necessary funds (*Wright's Patent*, 1 W. P. C. 575), or if he has been engaged in heavy litigation arising out of the patent (*Heath's Patent*, 2 W. P. C. 257; *Russell's Patent*, 2 Moore, 496 P. C.; *Pettit Smith's Patent*, 7 Moore, P. C. 133), these have been considered good grounds for granting an extension.

If litigation, involving the question of the validity of the patent, should be going on at the time of the application for a prolongation, the Committee will not go into the question, but will assume the patent to be valid (*Betts' Patent*, 1 Moore, P. C. C. N. S. 49), unless a court of law has already decided against the validity of the patent (*Jones' Patent*, 9 Moore, P. C. 41), or, unless the invalidity is beyond all reasonable doubt, in which case they will not grant an extension. (*Woodcroft's Patent*, 2 W. P. C. 30; *Hills' Patent*, 1 Moore, P. C. C. N. S. 258; *McInnes' Patent*, L. R. 2 P. C. 54; *S. C.* 5 Moore, P. C. C. N. S. 72; *Stewart's Patent*, 3 R. P. C. 9.) If a competent tribunal should, after the grant of a new patent, decide that the original patent was invalid, the new patent will share its fate, and will be invalid likewise. (*Kay's Patent*, 1 W. P. C. 571.) On the hearing of the application to extend the term of *Honiball's Patent* (3 Eq. Rep. 230; *S. C.* 2 W. P. C. 208), it was said that the grant of an extended term is to be considered as a new grant by new letters patent, subject to the same conditions, open to the same objections, and in ordinary cases entitled to the same advantages as the original grant. So that, in point of fact, the extension decides nothing, one

way or other, as to the validity of the patent. And, therefore, where it is only a matter of doubt as to the validity of the patent—as, for example, where the evidence is conflicting—the extension will be granted, if there appear good grounds *aliunde* for that course.

When it appeared that a patentee had agreed by deed with a public company to grant an exclusive licence, and also covenanted with them to obtain at the expiration of the term a prolongation of the patent for the same purpose, the application for a prolongation was refused by the Privy Council, on the ground that the agreement was contrary to public policy and repugnant to the spirit of the statute 5 and 6 William IV. c. 83. (*Cardwell's Patent*, 10 Moore, P. C. C. 488.)

THE ACCOUNTS.

'It is the duty of a patentee to take upon himself the onus of satisfying the Committee in a manner which admits of no controversy of 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 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 may 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 that he has received.' (Per *Lord Cairns* in *Re Saxby's Patent*, L. R. 3 P. C. 292; *S. C.* 7 Moore, P. C. C. N. S. 85. See also *Re Clark's Patent*, L. R. 3 P. C. C. 421; *S. C.* 7 Moore, P. C. C. N. S. 255; *Wield's Patent*, L. R. 4 P. C. C. 89.) In the case of *Yates and Kellett's Patent* (4 R. P. C. 150), the petitioners applied at the hearing for an adjournment to give them time to amend the accounts, but the application was refused and the petition was dismissed. The accounts must, therefore, be full, clear, unreserved, and

properly proved. (*Hills' Patent*, 1 Moore, P. C. C. N. S. 258.) Where the patentee has dealt with his patent only through the medium of assignments and licences, the work of making out correct and complete accounts ought to be easy. His difficulties will be much increased if he has himself entered upon the manufacture of the patented article along with another business, unless he has had the foresight to perceive the propriety of keeping separate books. It is desirable that a patentee should from the first keep his accounts under the patent distinct from those of any other business in which he may be engaged, so that in the event of his applying for an extension, he may be able to give satisfactory evidence of everything paid and received on account of the patent. (*Betts' Patent*, 1 Moore, P. C. N. S. 49; *Duncan and Wilson's Patent*, 1 R. P. C. 257). In the latter case the petition was dismissed because the expenditure of the patent business was not sufficiently distinguished from that of the petitioner's general business.

The profits of every branch of the manufacture connected with the patented invention must be set forth, even those of a subsidiary and independent business, if that business is carried on for the purpose of employing the product as a feeder of the patented manufacture. On the hearing of the petition for a prolongation of *Newton's Patent* (51 Engineer 208), it appeared that the petitioners (Nobel's Explosives Company), who were assignees, had not only manufactured dynamite, the object of the patent, but had also made nitro-glycerine (one of the ingredients of dynamite) and the nitric acid with which that nitro-glycerine was prepared. In making out their accounts in support of their case they treated the matter as if they had bought nitro-glycerine in the market, keeping out of view the profits they had made by the manufacture of nitric acid and nitro-glycerine; their contention being that the latter profits ought not to be taken into consideration in estimating the dynamite profits. It was, however, held that the profits from every branch of their manufacture must be brought into the account; and, as the profits derived from the sub-

sidiary manufacture had been very large, the petition was dismissed with costs. See also *Bailey's Patent* (1 R. P. C. 1).

Where the patent has been assigned to a company, not only must the patentee's profits be shown, but the account of the company should be deposited. (*Deacon's Patent*, 4 R. P. C. 119.)

The profit, year by year, ought to be shown (*Perkins' Patent*, 2 W. P. C. 6), including the profits made by sales abroad. (*Hardy's Patent*, 6 Moore, P. C. 441.) The profits made under foreign patents, if any, must be shown. (*Adair's Patent*, 6 App. Cas. 176; *Newton's Patent*, 1 R. P. C. 177; L. R. 9 App. C. 592.) If books of account are not forthcoming, the petitioner will be required to explain their absence. (*Markwick's Patent*, 13 Moore, P. C. C. 310.) If a patentee so deals with his rights that he is unable to show what amount of profit has been made by working the patent, or what has been received by licensees under licences, he will be considered to have disentitled himself to an extension. (*Trotman's Patent*, L. R. 1 P. C. 118; *Saxby's Patent*, L. R. 3 P. C. 294.) In taking an account of the profits and loss the patentee is entitled to charge for personal expenses and loss of time devoted to the patent and in endeavouring to bring the invention into use. (*Trotman's Patent*, L. R. 1 P. C. 135; *Newton's Patent*, 14 Moore, P. C. C. 156; *Perkins' Patent*, 1 W. P. C. 6; *Carr's Patent*, L. R. 4 P. C. 541; *S. C.* 9 Moore, P. C. C. N. S. 379; *Poole's Patent*, L. R. 1 P. C. 514; *Furness' Patent*, 2 R. P. C. 175.) Travelling expenses, salaries of clerks, and commissions on sales where the patentee has acted as salesman have been allowed (*Bailey's Patent*, 1 R. P. C. 1), and the cost of making experiments has been allowed. (*Kay's Patent*, 1 W. P. C. 572.) In some cases the profits made by the patentee as manufacturer have been permitted to be deducted (*Betts' Patent*, 1 Moore, P. C. N. S. 49; *Galloway's Patent*, 1 W. P. C. 729; *Duncan and Wilson's Patent*, 4 R. P. C. 119); in other cases such profits were not allowed to be deducted. (*Muntz's Patent*, 2 W. P. C. 121; *Saxby's Patent*, L. R. 3 P. C. 292.) Where

manufacturer's profits are allowed to be deducted there is no specific rule as to the proportion, since they vary in different businesses, but in *Hills' Patent* (1 Moore, P. C. 251) and in *Duncan and Wilson's Patent* (2 R. P. C. 260) two-thirds of the net profits were deemed too large a proportion. Law expenses incurred by the patentee in maintaining his rights are in general allowed in deduction of profits, but this will not be done when the patentee has compromised suits and given up costs to which he had an apparent title. (*Hills' Patent*, 1 Moore, P. C. C. N. S. 258.) In the matter of *Bailey's Patent* (1 R. P. C. 1), where the administrator of a patentee claimed at the bar to be allowed some deductions from the profits not mentioned in the petition or accounts, it was held that no such deduction could be made, and evidence on the point was inadmissible.

A petition was dismissed where the accounts were insufficient as not distinguishing the expenditure on that part of the invention which was proved useful. (*Willacy's Patent*, 5 R. P. C. 690.)

GROUNDS OF DECISION UPON THE MERITS.

The jurisdiction conferred upon the Judicial Committee by the Legislature, being an extraordinary one, is to be exercised, as remarked in the Council Chamber, only on the most special grounds alleged and proved in reference to each case, and at the discretion of the Committee; for the extension of a patent is a matter of favour, not of right. In considering their decision the Committee is, according to the twenty-fifth section of the Act of 1883, to '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 coming to a decision they seek to meet the justice of the case with respect to the meritoriousness and public usefulness of the invention, and the adequacy or inadequacy of the patentee's remuneration, regard being had to the patentee's opportunities, the adverse circumstances with which he had to contend, and his general management

of the matter. If he has met with loss, as the total result of his transactions under the patent, and there has been no neglect or gross mismanagement on his part, there is good *primâ-facie* ground for an extension; but, if a certain amount of profit has been derived from working the patent, a decision is less easily formed. The question to be considered, it has been said, is not simply what the patentee has received, but what the patent has gained or what it ought to have gained with proper management.

Assuming that the patentee's conduct in regard to this part of the case is not open to remark, it is obvious that the merit of the invention is now an element to be considered, since a few hundred pounds may very well reward an invention of small utility, whilst 10,000*l.* may be an inadequate payment for a discovery of great public benefit, the working of which has been attended with heavy losses and great anxieties. The amount of inventive power will be taken into consideration, as well as the amount of time and trouble expended by the inventor in making experiments, either previously to his discovery, or in testing it, or in carrying it out. Inventors have different degrees of meritoriousness. It is not, however, to be assumed, that because the step in improvement taken by an inventor is small, his merit is likewise small, and his invention unimportant. A very small addition or alteration may have altogether escaped notice until seized and turned to account by an acute mind, and its adoption may lead to most important consequences in the manufacture with which it is connected. The reward of such an invention ought not to be made proportionate to its apparent insignificance. Common justice dictates that the benefit an inventor has conferred on the public ought to be regarded; and the advisers of the Crown, acting under this idea. will give him the opportunity of reaping a recompense in some degree commensurate with the value of the result. In delivering judgment on an application to the Privy Council for an extension of *Soames' Patent* (1 W. P. C. 729), *Lord Brougham* used these words: 'The whole history of science,

from the greatest discoveries down to the most unimportant—from the discovery of the system of gravitation itself, and the fractional calculus itself, down to the most trifling step that has ever been made—is one continued illustration of the slow progress by which the human mind makes its advance in discovery. It is hardly perceptible, so little has been made by any one step in advance of the former state of things, because generally you find that just before there was something very nearly the same discovered or invented.' His lordship proceeded to say, that in the case of a new principle or a novel invention—for instance, a new process—the smallness of the step did not furnish any argument against its importance. But when a new application only is under consideration, such an application as might easily suggest itself to any person—a new application of a well-known simple process, which had been employed with respect to other substances—then, when a patentee comes to apply for an extension of his patent, the smallness of the step involved in the patented invention will be taken into consideration in determining the length of the extension. In this case the invention consisted in an application of mechanical pressure to separate the solid and fluid constituents of cocoa-nut oil. The invention having been of moderate benefit to the public, the moderate extension of three years was granted to the patentee. See also the remarks of *Lord Kingsdown* on *Hills' Patent* (1 Moore, P. C. C. N. S. 258), and of *Lord Cairns* in *Saxby's Patent* (L. R. 3 P. C. 294), as well as the case of *Derosne's Patent* (4 Moo. P. C. 418).

To justify an extension for a longer time than seven years the invention must be clearly shown to possess a very exceptional degree of merit and public usefulness. In the cases of *Moncrieff's Patent* (22, Iron 35), *Ruthven's Patent* (Pract. M. J., 2nd ser., 8, 159), and *Stoney's Patent* (5 R. P. C. 518), a prolongation of ten years was recommended. It is very seldom indeed that the full term of fourteen years is granted. (*Mitchell's Patent*, 30 Newton, L. J. c. s. 356.)

In the case of a patent obtained for an invention

imported from abroad, which invention had been previously patented in a foreign country, the British patent became void under the twenty-fifth section of the 15 and 16 Vict. c. 83 at the expiration of the foreign patent; and when application for a prolongation of such a patent was made, it was refused. (*Aube's Patent*, 9 Moo. P. C. 43; *Poole's Patent*, L. R. 1 P. C. 514; *Adair's Patent*, L. R. 6 A. C. 176; *Hills' Patent*, 1 Moo. P. C. N. S. 258.) And this rule was even extended to cases of patents for imported inventions, when the foreign patent was dated shortly after the British patent. (*Newton's Patent*, 14 Moore, P. C. C. 156; *Normand's Patent*, L. R. 3 P. C. 193; *S. C.* 6 Moore, P. C. C. N. S. 477; *Blake's Patent*, L. R. 4 P. C. 535; *S. C.* 9 Moore, P. C. C. N. S. 373.)

This Act having been repealed, no objection can now be founded on the authority of these decisions with reference to patents issued under the new Act; nor, apparently, with reference to patents previously issued, which had not been avoided by the statute of Victoria. But if any patent granted before the commencement of the new Act had been rendered void by the operation of the statute before that date, then it would seem that the cited decisions would still be applicable in case an extension of the patent were petitioned for.

Before the Act of 1883 was passed, it had been decided that the Crown, at any time before the Great Seal was affixed, could countermand the warrant for sealing, upon a proper case being made out. Thus where patentees had applied for a prolongation of their patent, and had obtained a recommendation from the Judicial Committee of the Privy Council, upon which an order was drawn up for a prolongation, a petition was afterwards presented to the Crown, seeking to revoke this order; and this being referred to the Judicial Committee, it was held that this Committee had authority, under 3 and 4 William IV. c. 4, s. 4, to entertain such a petition, and to recall the warrant for sealing the letters patent. (*Schlumberger's Patent*, 9 Moore, P. C. C. 1.)

THE NEW PATENT.

If the Judicial Committee reports favourably on the petition the patent may be extended under sect. 25 of the Act of 1883, for seven, or in exceptional circumstances for fourteen, years. Or a new patent may be granted for the time therein mentioned with any restrictions, conditions, and provisions that the Committee think fit to insert therein. If a new patent is issued, as is usually the case, it is dated the day after the expiration of the original term, and it will be subject to all the provisions of the Act of 1883. If anyone should use the invention in the interval between the expiration of the original term and the grant of the new patent, he is not liable for an infringement. Moreover, those who may have invested capital in working it during that interval may attend before the Committee, and oppose the application, or prefer a claim to have their acts protected and their expenditure made good. (*Russell* v. *Ledsam*, 14. M. and W. 574.)

Where a patent seems deserving of prolongation only in respect of one head of invention out of several, the prolongation will be granted solely with reference to that head. (*Bodmer's Patent*, 8 Moore, P. C. C. 282; *Lee's Patent*, 10 Moore, P. C. C. 226; *Napier's Patent*, 6 App. Cas. 174; *Church's Patents*, 3 R. P. C. 102.)

In the case of two cognate patents which had different terms to run, it was ordered that the extensions granted should be such that they should both expire on the same day. (*Johnson's and Atkinson's Patents*, L. R. 5 P. C. 87.)

Where the invention is one of great merit, and the patentee has assigned his interest in it to another person for a sum which, looking at the profits likely to be derived from working the invention, appears an inadequate consideration, the Privy Council will see that the patentee receives further reward. With this view, a condition is sometimes introduced into the new patent, making it void in case a fixed annual sum, or a certain share in the profits,

be not paid to the patentee by the assignee. (*Whitehouse's Patent*, 1 W. P. C. 473; *Hardy's Patent*, 6 Moore, P. C. C. 441; *Morton's Patent*, 51 Eng. 274.)

So also where a patentee had mortgaged his patent, and he and his mortgagees asked for a prolongation, it was granted to the patentee alone. (*Bovill's Patents*, 1 Moore, P. C. C. N. S. 348.) But in *Church's Patents* (3 R. P. C. 95) the patentee undertook to give the mortgagee the same security over the new patents that he had over the old. Again, where the petition had been presented by the patentee and the assignee of a moiety of the patent, and the patentee had died before the hearing, a prolongation was granted on the condition that the assignee should hold one moiety of the new term on trust for the personal representatives of the deceased patentee. (*Herbert's Patent*, L. R. 1 P. C. 399.) Other special conditions are sometimes inserted in the new letters patent: for example, that the patented article should be sold to the public at a certain price (*Hardy's Patent*, 6 Moore, P. C. C. 441); that licences should be granted on certain terms (*Mallet's Patent*, L. R. 1 P. C. 308; *S. C.* 4 Moore, P. C. C. N. S. 175); or that the Admiralty should have the privilege of using the invention (in this case an improved propeller for steam and other vessels) without licences from the patentee. (*Pettit Smith's Patent*, 7 Moore, P. C. C. 133.) But in the cases of *Lancaster's Patent* (2 Moore, P. C. C. N. S. 189) and *Carpenter's Patent* (*ibid.* 191) the Judicial Committee refused to insert this latter condition. For instances of other special conditions introduced into the new patent, see *Bodmer's Patent* (8 Moore, P. C. C. 282); *Normandy's Patent* (9 Moore, P. C. C. 452).

When a prolongation of a patent term has once been granted, the jurisdiction of the Judicial Committee is exhausted, and they have no power to entertain an application for a further extension. (*Goucher's Patent*, 2 Moore, P. C. C. N. S. 532.)

When an order has been made by her Majesty in Council for the extension of a patent, or for the grant of a

new patent, an office copy of such order must be forthwith left at the Patent Office that it may be entered in the register. (See Rule 74 of the Patents Rules 1890.)

COSTS.

The seventh sub-section of the twenty-fifth section of the Patents Act of 1883 directs that the costs of all parties of and incident to proceedings for the extension of a patent 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.

Where the ground of opposition to a patentee's application is frivolous, costs have been awarded to him; but where the case is difficult and doubtful and there is fair ground for opposition costs will not be given to a successful petitioner. (*Church's Patents*, 3 R. P. C. 95.) On the other hand, if a successful opposer has conducted his case in a proper manner, he may obtain his costs. (*Honiball's Patent*, 9 Moore, P. C. C. 394; *Johnson's Patent*, L. R. 4 P. C. 75; *Hills' Patent*, 1 Moore, P. C. C. N. S. 271; *Wield's Patent*, L. R. 4 P. C. 89; *S. C.* 8 Moore, P. C. C. N. S. 300; *Newton's Patent*, 51 Eng. 208.) Costs of opposition have been given against a petitioner who abandoned his application. (*Mackintosh's Patent*, 1 W. P. C. 739; *Hornby's Patent*, 7 Moore, P. C. 503; *Milner's Patent*, 9 Moore, P. C. C. 39; *Morgan-Brown's Patents*, 3 R. P. C. 212.)

It is not unusual for the Privy Council to award opposers a lump sum for costs, to be (when more than one) divided between them. In the case of *Newton's Patent* (51 Eng. 208), the opposers were so awarded 1,000*l*. In the case of *Johnson's Patent* (L. R. 4 P. C. C. 83), the opposers were ordered to receive 500*l*., and in *Ball's Patent* (4 App. Cas. 171) an order was made for payment of 400*l*. to the opposers in lieu of costs.

By the Privy Council Rules in patent cases, the taxing

officer is empowered to allow or disallow at his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

SELECTED DECISIONS OF THE PRIVY COUNCIL.

The following cases have been selected to illustrate what has been said with reference to the considerations guiding the Judicial Committee in arriving at a conclusion in regard to the term of extension under different circumstances.

On an application for an extension of a patent granted to James Kay, for improved machinery for preparing and spinning flax, it was shown that the patentee had expended 500*l.* in experiments, 500*l.* in obtaining his patent, 2,200*l.* in law expenses, and that he had made about 6,800*l.* profit. The invention was one of great utility, was used by nearly all the flax-spinners in the kingdom; but looking at the sum already cleared by the patentee, it was thought that a prolongation for three years would satisfy the justice of the case. (*Kay's Patent*, 1 W. P. C. 568.)

Richard Roberts obtained a patent for improvements in spinning-jennies, the value of which was so great that, during the last three or four years of the original term, 5,000*l.* a year had been made by the patentee. In consequence, however, of piracies, of combinations amongst work-people, but chiefly of a fire, supposed to have been the act of an incendiary, which destroyed the patentee's premises, and entailed a loss of 10,000*l.* beyond the insurance, the profits did not reach the amount of loss by several thousand pounds. The Committee of the Privy Council, guided by the ingenuity of the invention, and the peculiar character of the resistance to its introduction, were of opinion that seven years' prolongation was merited. (*Roberts' Patent*, 1 W. P. C. 573.)

L. W. Wright applied for an extension of his patent for improvements in bleaching apparatus, and gave evidence before the Committee of his pecuniary embarrassments, and the disputes which had arisen out of his partnership with various persons; which embarrassments and disputes

had prevented the introduction of the invention to the trade. He showed that the invention had been successfully practised by several bleachers, but that he had hitherto derived no benefit whatever from it. The Committee reported that it would be proper to prolong the term for seven years. (*Wright's Patent*, 1 W. P. C. 575).

A patent for a new method of preparing iron plates for tinning was granted in 1839 to Thomas Morgan, who, being unable to work the invention, had sold his patent right for 200*l.* to persons who applied, in conjunction with the patentee, for an extension of the term. The assignees had made a profit of about 1,000*l.* a year for three years, and the patentee, in addition to the sum received from them, was making about 2*l.* a week out of the patent. The invention appearing to possess only a moderate degree of merit, the Committee thought that the benefit received by the patentee and his assignees was a sufficient reward, and they refused the application. (*Morgan's Patent*, 1 W. P. C. 737.)

Beanlands' petition for an extension of his patent for quadrants for opening, shutting, and fastening windows was dismissed, on the ground that, the accounts having shown that his profits amounted to 700*l.*, and those of his licensees to upwards of 300*l.*, the patentee had been adequately remunerated, considering the small merit of the invention and the absence of great public utility. (*Beanlands' Patent*, 4 R. P. C. 489.)

A patent for printing yarns of any fibrous materials was granted in 1828 to Bennet Woodcroft, who, on the expiration of the original term, applied for an extension. The patented process gave to cloth made of yarn, printed by it, a peculiarly clouded appearance, and the invention gave rise to the manufacture of clouded silks and fabrics. During the first four years of the patent 7,000*l.* were realised under it. Certain duty, however, was taken off other goods, and from this cause and others a large capital invested in working the patent ceased to be profitable, and the patent right became of small value. At a subsequent

time the invention, under an improved form, was stated to have become of considerable value, and it was thought proper to apply for an extension of the patent. But the Committee, having regard to the amount of profit already realised, and to the fact that the invention, in its improved and valuable form, was introduced from abroad by other persons than the patentee, refused the application.

In 1840 Orlando Jones obtained a patent for improvements in the manufacture of starch. His method consisted in applying a weak solution of caustic alkali to rice. It was shown, at the hearing of an application for an extension of the patent, that the principle of the invention had been discovered by another person prior to the date of Jones' patent, although Jones was not aware of the fact. The invention being thus shown to have no novelty, the application was refused, and costs to the amount of 100*l.* were decreed against the petitioner.

On the application for an extension of Derosne's patent, for improvements in refining sugar, it appeared that the patentee's net profit had been about 3,300*l.* But the benefit to the public was so great, being appreciable in every pound of sugar consumed, that an extension of six years was granted. (*Derosne's Patent*, 2 W. P. C. 1.)

G. F. Muntz applied for an extension of his patent for improvements in the manufacture of sheathing for ship bottoms, and showed that he had made 55,000*l.* by the manufacture during the existence of the patent. The applicant contended that this sum did not represent his profit as an inventor and patentee, but his profit as a manufacturer. But the Committee of the Privy Council said it was impossible to sever these two heads of profit. It was by means of the patent that he had made the profit. It had given him a monopoly preference; because as patentee he was enabled to sell and trade in a manner which, but for his invention and his patent, he could not have done. The application for a prolongation of the patent was refused. (*Muntz's Patent*, 2 W. P. C. 113.) See also *Hills' Patent* (1 Moore, P. C. C. N. S. 258);

Saxby's Patent (L. R. 3 P. C. 292; *S. C.* 7 Moore, P. C. C. N. S. 82).

A patent was obtained in 1831 by A. M. Perkins for improvements in an apparatus for heating air in buildings, heating fluids, &c.; and in 1845 he applied for an extension, on the ground that he had been inadequately rewarded. The ingenuity of the invention, and its application to a great number of purposes, having been shown, the accounts were investigated; when it appeared that there had been a profit of 15,176*l.* upon gross receipts to the amount of 64,920*l.* The patentee claimed further to reduce the sum representing his profits, by deducting 500*l.*, the cost of experiment, 2,700*l.* interest at five per cent. on the average amount of capital employed, and 5,400*l.* for an allowance of 400*l.* a year to the patentee for his personal superintendence of the business. These sums reduced the profits to 6,576*l.* net. An extension of five years was granted, the invention being ingenious and useful. (2 W. P. C. 7).

An application for the extension of a patent for improvements in the manufacture of steel was opposed on the ground that, whereas the patented process consisted in the addition of carburet of manganese to the crucible, it had been subsequently discovered that a better process of making steel was to place carbonaceous matter and manganese separately in the crucible, and this process obtained generally in practice. The Privy Council thought that the merit of the original invention was not thereby materially detracted from, and they granted an extension for seven years. In granting so long a time, the litigation going on in the courts of law was taken into account, as it was thought probable that some time would elapse before the litigation would terminate and the patentee's representatives have the benefit of the extension granted. (*Heath's Patent*, 2 W. P. C. 257).

Whitehouse, an ingenious mechanic, procured a patent for improvements in the manufacture of iron tubes, which he assigned to his master, Russell, who laid out 14,000*l.* in works to carry out the manufacture. The tubes were in

great demand, being applicable to a variety of new purposes; but, as the manufacture was simple, many expedients were adopted for evading the patent, and Mr. Russell was involved in much litigation, in consequence of which, combined with the loss incurred by surreptitious manufacture and sale, his profits were very considerably reduced. There was evidence to show the value and importance of the invention, the losses he had suffered from infringements, and the great reduction that would take place in the value of the premises and machinery (much of which was fitted only for the particular manufacture) if the patent were thrown open. He further showed that his life had been endangered by the anxiety of certain law proceedings. One witness stated that, if the manufacture were thrown open, it would hardly be worth following: the process was so beautifully simple, that it would almost be within the reach of any person of capital. The net profits amounted to about 13,000*l.*; but this was shown to be not much greater than the ordinary profits on stock without the protection of a patent. The Committee thought the patent ought to be extended for six years, the original patentee receiving 500*l.* a year out of the profits for that time. (*Whitehouse's Patent*, 1 W. P. C. 473.)

A patent for forging and shaping small articles in metal was obtained by Mr. Ryder in 1841: when he applied for an extension, he pleaded that though the profits had been 7,000*l.*, they had only been made during the last four years. This, however, was held to be no ground for the application in the face of the large sum realised, and the petition was dismissed. (*Ryder's Patent*, 'Pract. Mech. Journ.' vol. vii. p. 238.)

In *Ruthven's Patent* ('Pract. Mech. Journ.' 2nd Series, vol. viii. p. 159), which was a patent for improvements in the propulsion of vessels, the invention was proved to be of very great merit, and to have failed in being brought into general use through circumstances altogether independent of the will and without the fault of the inventor, who had not merely derived no profit, but had suffered

considerable loss from his patent. It was shown, moreover, that the Admiralty had then lately instituted experiments with a view to the adoption of the invention, and that several friends of the inventor were willing to provide large capital for working the invention, should a prolongation be obtained. Evidence was also given that from the nature of the invention it would necessarily be a long time before its merit could be properly brought before the public. Under these circumstances the Judicial Committee (stating that they considered the case exceptional) granted a prolongation for the unusual period of ten years.

In the case of *Sillar's Patent* (Goodeve's cases, p. 581), it appeared that the patent had been sold by the patentees to a Joint Stock Company, who had paid them a sum which seemed to be commensurate with the value of the invention. The company had afterwards floated their shares in the market, and had thereby made considerable profit. They then applied for an extension of the patent, but it was refused, although they had been considerable losers by working the invention.

Major Childs obtained a patent in 1869 for improvements in the manufacture of bread and biscuits. By this invention a nutritious aërated bread could be made by machinery with regularity and certainty. Down to 1873 the inventor had failed in his endeavours to get the invention fairly worked, but in that year he became chairman of the Aërated Bread Company, and let them have the use of his patent. It was not until 1883 that a large central manufactory was started in London for the making of bread by his process. He received a salary of 600*l.* as chairman and managing director of the company, which was paying 8 per cent. on the shares, of which he held 12,000. The counsel appearing for the Crown estimated that the inventor had made a profit under the patent of between 20,000*l.* and 30,000*l.*, including the rise in the value of the shares held by him. The Judicial Committee were satisfied that the invention possessed considerable merit, and, although the inventor had made for the last five years a profit which

was increasing, they came to the conclusion that he had not been sufficiently remunerated, and a prolongation for five years was granted. (*Childs's Patent*. The 'Times,' Dec. 1883.)

A petition for a prolongation of Deacon's two patents obtained for improvements in measuring the flow of water through pipes was presented in 1887. The accounts showed that the patentee had made a profit of 6,000*l*., and that he had besides an interest in a public company to which the patents had been assigned. The invention being very meritorious, an extension of three years was recommended. (4 R. P. C. 119.)

Nussey and Leachman in 1876 obtained a patent for improvements in machinery for pressing fabrics. An application for its extension was heard in December 1889, when their lordships, remarking that they could not say there had been no utility, but finding there had been a net profit of 4,000*l*., and looking at the degree of merit and amount of remuneration, declined to report that the patentees had not been adequately remunerated. It was also stated that the Privy Council had taken into consideration the fact, although they had not decided the case wholly upon it, that the petitioners had got new letters patent for improvements upon the patent, which had almost shut out the use of that patent. (7 R. P. C. 22.)

The exceptional period of ten years was granted in the case of *Stoney's Patent* (5 R. P. C. 518), where it appeared that the invention possessed considerable merit, but had a very small scope for its employment, whilst the patentee had derived no profit from it. This was a patent for improvements in sluices and floodgates. Mr. Justice Groves' instructive judgment may be usefully consulted with reference to the case which a petitioner for an extension ought to make out before the Privy Council.

CHAPTER XV.

ASSIGNMENTS AND LICENCES.

Power both to assign and to license is by implication given to the patentee by the patent.

It is desirable to register both assignments and licences as soon as may be after their execution. If his assignment is not registered an assignee cannot maintain an action for an infringement against third parties except licensees from the assignor subsequent to and with notice of the assignment. See *Chollet* v. *Hoffmann* (7 E. & B. 636); *Hassall* v. *Wright* (L. R. 10 Eq. 510), cases under the old law. See the Chapter on Registration, and Rules 67–72 and 77 of the Patents Rules 1890.

Rules 67 to 72 prescribe a somewhat complicated system of registry for assignments and licences. In all cases there must be a request in writing to the Comptroller to register, and the original document to be registered, together with an attested copy, must be left with the Comptroller. The practice of registration under the Act of 1852 was quite as effective and much more simple.

ASSIGNMENTS.

To be a valid instrument, an assignment ought to be a deed under hand and seal. It is usual to introduce into assignments covenants on the part of the patentee that he is the true and first inventor, and that the patent is valid. In those cases where the assignor does not part with his entire interest in and under the patent it may be well to insert a covenant binding him not to seek leave to amend the specification or drawings without the written consent of the assignee.

Under the twenty-fifth section of the Patents Act of 1852, a patent obtained in the United Kingdom for an invention previously patented in a foreign country came to an end at the expiration of the foreign patent. But as this provision has not been inserted in the Patents Act of 1883, it is not now of importance for an assignee to see that the foreign patent is kept on foot, although when the assignment deals with a British patent obtained under the Act of 1852 it is still incumbent upon him to see that the foreign patent had not expired prior to January 1, 1883.

A patentee is empowered, by the thirty-sixth section of the Act of 1883, to 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.

This provision seems to be of very doubtful utility, and prudent patentees may well hesitate to make assignments under it. To assign a patent for a place or district might not improbably land both parties in grave difficulties which do not all lie on the surface.

It is no answer to an action to enforce a contract for the purchase of a patent for a stipulated sum (*Hall* v. *Conder* 2 C. B. N. S. 22) to plead that the patent is wholly worthless and of no utility, and that the subject-matter of the patent was not the novel invention of the plaintiff, there being no proof of fraud, and no express warranty. Such a contract was held merely to have the effect of placing the purchaser in the same situation as the seller was with reference to the patent, and the purchaser is bound to take it with all its faults. This being so, it is desirable to consider whether or not an express warranty of the patent should not be introduced into contracts of this nature. See also *Smith* v. *Neale* (2 C. B. N. S. 67).

The purchaser ought invariably to have a search made by a competent person at the Patent Office and elsewhere as to the novelty of the invention, prior to his entering into a contract for the purchase.

One of two or more joint patentees cannot assign more

than his share of the patent. (*In Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475).

The assignee of part of patent separate from other parts may bring his action for an infringement of such part without joining as plaintiffs those persons who have distinct interests in the other parts, but have no interest in the damages sought to be recovered. (*Dunnicliff* v. *Mallet*, 7 C. B. N. S. 209.) This decision was mentioned with approval by the Court when delivering judgment in the case of *Walton* v. *Lavater* (8 C. B. N. S. 184), where it was unsuccessfully contended that the assignee of an undivided share of a patent had not a sufficient legal interest to sue for its infringement.

It has been held that one co-owner of a patent may sue alone for the recovery of profits due for the use of the patent without making his co-owners parties. (*Sheehan* v. *G. E. Ry. Co.*, 16 Ch. D. 59.) (See, however, *Van Gelder &c. Co.* v. *Sowerby*, 7 R. P. C. 41.)

The assignee of a share of the profits of the patent is entitled to call on a licensee of the patentee for an account, but the assignee suing must make the assignor and the assignees of other shares of the profits parties to the suit, and must offer to pay any moneys due from the assignor to the accounting licensee. (*Bergmann* v. *Macmillan*, L. R. 17 Ch. D. 427.)

The assignee of the original assignee takes subject to his covenants if he has notice of them. (*Werderman* v. *Société Générale d' Electricité*, L. R. 19 Ch. D. 247.)

Where a patent is assigned to two persons and one dies, the survivor may sue for an infringement committed during the lifetime of the other. (*Smith* v. *London and North-Western Railway Company*, 2 E. & B. 69). In the event of a patentee's bankruptcy, the patent becomes vested in the trustee, who may sue for infringements committed before the bankruptcy. (*Hesse* v. *Stevenson*, 3 Bos. & P. 577; *Bloxam* v. *Elsee*, 9 Dowl. & R. 215; *S. C.* 6 B. & C. 169.)

Where a partnership at will was formed for the purpose of working an invention for which a patent had been previously obtained and registered in the name of one of the

partners alone, it was held that the patent became an asset of the partnership, and each partner acquired a right to work the invention. Also that this right was not taken away by the registered owner assigning the patent to a third party who had notice of the existence of the partnership. (*Kenny's Button-holing Company* v. *Somerville*, 37 L. J. Rep. N. S. 878).

It is not contrary to public policy for a patentee, on the assignment of his patent, to contract to assign to the purchaser all future patents which the vendor may obtain having relation to the invention already patented or being of similar nature. (*Printing and Numerical Registering Company* v. *Sampson*, L. R. 19 Eq. 462.)

A body corporate may take an assignment of a patent, and be registered as the proprietor thereof in its corporate name. (See Rule 73 of the Patents Rules 1890.)

A patentee, after assigning all his interest in a patent for a valuable consideration will not be allowed in an action against himself for an infringement to raise the question whether the patent is void for want of novelty (*Walton* v. *Lavater*, 8 C. B. N. S. 162, 187; and see also *Chambers* v. *Crichley*, 33 Bea. 374), unless the patent has been made invalid by the assignee's disclaimer. (*Hocking* v. *Hocking*, 4 R. P. C. 434.)

But a patentee whose patent has been assigned by the trustee under his bankruptcy is not estopped in an action brought by the assignee against the patentee for an infringement from showing that the patent is bad for want of novelty in the invention. (*Cropper* v. *Smith*, 1 R. P. C. 92; and see *Goucher* v. *Clayton*, 11 Jur. N. S. 107.)

LICENCES.

Licences have various intents. In their most general form they are nearly tantamount to an assignment of the patentee's whole rights. But usually they are for a term shorter than that mentioned in the patent, and sometimes they do not extend to the whole of the invention. A licence may be restricted, likewise, to a particular district.

What is called an *exclusive licence* is one by which the patentee binds himself not to empower any other person to exercise the patent privilege, either at all or within a given district.

A licence to A. to manufacture a patent article is an authority to his vendees to vend it without the consent of the patentee. (*Thomas* v. *Hunt*, 17 C. B. N. S. 183).

The consideration for the grant of a licence is usually an immediate money payment or a periodical payment, which may be either of a certain amount or dependent upon the extent to which the licensee uses the invention. In the last case care should be taken not to create a partnership when no partnership is contemplated. See *Ridgway* v. *Philip* (1 Cr. M. & R. 415); *Elgie* v. *Webster* (5 M. & W. 518).

In preparing licences the following points should be attended to:—The patentee ought to enter into the usual qualified covenants that the patent is valid, and that he has a right to grant the licence. The licensee should covenant to pay any sums the payment of which is postponed to a future time. Where the payments are to vary with the extent to which the licensee shall use the invention, there ought to be covenants, on the part of the licensee, to render properly verified accounts, and to allow periodical inspections of books, machinery, stock, &c. If it be intended that the licensee should not be permitted to question the validity of the patent or the sufficiency of the specification, recitals should be introduced affirming these points, or express covenants debarring the licensee from raising the question. But recitals can only affirm the facts as they stood at the time of the execution of the deed: covenants may be made to apply to all future time. Recitals, however, will have the effect of estopping the parties from disputing the facts recited. (*Bowman* v. *Taylor*, 2 Ad. & El. 278; *Hills* v. *Laming*, 9 Exch. 256.) In the absence of such recitals or covenants, a licensee, when sued for money reserved by the licence, may, where the contract is executory, or where there is the taint of

fraud, set up, as a defence, that the patent is void. (*Hayne* v. *Maltby*, 3 T. R. 438; and see *Pidding* v. *Franks*, 1 Mac. and Gord. 56.) On the other hand, refer to the case of *Lawes* v. *Purser*, 6 Ell. and Bl. 930. This was an action brought by a patentee upon an agreement whereby the defendant contracted to pay a certain sum per ton of an article manufactured and sold by him, by permission of the plaintiff to him given at his request, the sole manufacture and sale of such article being the subject of the plaintiff's letters patent. The invention having been used by the defendant, he refused to pay the stipulated sum, pleading that the letters patent were void, and that he had a right to make and sell the article without licence. It was held that the defendant was not entitled to set up such a defence, the contract having been executed, and no fraud being alleged. But one of the judges thought that if the defendant had given notice that he disputed the validity of the patent, and would in future use the invention in his own right, such notice would change the position of the parties: for after it the patentee might sue the defendant for an infringement of his patent for any subsequent user; and perhaps, in an action on the agreement for the price of such subsequent user, the invalidity of the patent might be a defence.

Although the licence deed may contain no express power of revocation the licensor is entitled to treat the licence as forfeited and to determine it, if its terms and conditions have been broken. A simple notice in writing is sufficient for the purpose, an instrument under seal not being necessary. (*Ward* v. *Livesey*, 5 R. P. C. 102). But it will be prudent to insert a clause giving the patentee power to render the licence void, in case of non-payment of royalties or other sums reserved, or on non-performance of any of the covenants. Power is sometimes reserved to place the royalties in the hands of a stakeholder during litigation affecting the patent.

It seems that a licence is not assignable to a third person in the absence of an express or implied power to

assign, such as where the licence is granted to the licensee, his executors, administrators, or assigns. (*Bower* v. *Hodges*, 22 L. J. C. P. 198.)

There is no decision as to the power of one grantee to grant a valid licence without the consent of his co-grantees, but it would probably be held that he cannot.

It was held by *Lord Romilly, M. R.*, in *Mathers* v. *Green* (34 Beav. 170), that when one of three joint patentees had granted licences, he was bound to account to his co-patentees for the royalties received.

As licensees sometimes exercise their right of making or dealing in articles *ejusdem generis*, but outside the patent under which they are licensed, it may be well to consider in some cases whether a covenant should be introduced restraining them from so doing. It is frequently stipulated that articles made by a licensee shall be marked in such a way as to show that they were made under the patent.

In the case of an exclusive licence it is desirable that the licensee should covenant to pay a certain minimum sum at stated periods in the shape of royalty; and in some cases to insert covenants on the part of the patentee to proceed against persons infringing the patent (see *Henderson* v. *Mostyn*, L. R. 3 C. P. 202), or to permit the licensee to proceed in the patentee's name.

When a sum of money has been paid for a licence, and the consideration fails, the money may be recovered. Thus in *Knowles* v. *Bovill* (22 L. T. N. S. 70), it appeared that a patentee had granted to the plaintiff a licence to use his patent, and had agreed to apply for a prolongation of the patent of which the plaintiff was to have the benefit; and he further agreed to grant a licence under a new patent, for which he had applied. The patentee, however, died shortly afterwards without having done anything. It was held that the plaintiff could recover the money paid from the patentee's executors.

In *Chanter* v. *Leese* (4 M. & W. 295, affirmed on appeal, 5 M. & W. 698), there was a licence not under seal to use

six patents, one of which was found to be invalid; it was held that there was a failure of consideration, as there was no proof that the licensee had used the five good patents and there was no apportionment of the annual payments.

On the other hand, it has been decided that annual sums paid in consideration of a licence cannot be recovered by action when the patent turns out to be void (*Taylor* v. *Hare*, 1 Bos. and Pul. N. R. 260); except where fraud is proved. (*Lovell* v. *Hicks*, 2 Y. and C. 472). To meet this case it will be prudent to have a covenant in the licence, under which the parties may readjust their accounts in the event of the patent proving void or voidable.

A licensee during the continuance of the licence cannot set up as a defence to an action for the royalty that the invention was not new or not useful, or that the patentee was not the first inventor, or that the specification is insufficient. (*Noton* v. *Brooks*, 7 H. & N. 499; *Trotman* v. *Wood*, 16 C. B. N. S. 479; *Smith* v. *Scott*, 5 Jur. N. S. 1356; *Chanasse* v. *Stevens*, W. N. 1874, p. 193; *Adie* v. *Clark*, L. R. 2 App. Cas. 423; *Liardet* v. *Electric Lighting Co.*, W. N. 1883, p. 96.) But when in such a case the claim in the specification is susceptible of two constructions, one of which would make the specification bad, and the other and more natural one would make it good, it was held that the licensee may insist that the latter is the true construction. (*Trotman* v. *Wood*, 16 C. B. N. S. 479). But now see *Adie* v. *Clark* cited above. Even where no formal licence has been executed, a person who has paid money in the nature of a royalty will not be allowed to dispute the validity of the patent. (*Crossley* v. *Dixon*, 10 H. L. C. 293.) Furthermore, a licensee will not be permitted to use the invention without payment of the royalties he has covenanted to pay, even after the patent has been found invalid in proceedings between other parties. (*The Grover & Baker Sewing Machine Company* v. *Millard*, 8 Jur. N. S. 713.)

The plaintiff held an exclusive licence from the patentee of a machine to use the invention within a certain district for four years, and the licence was registered at the Patent

Office. After the date of the licence and before the time expired the defendants brought into the district certain machines which they had purchased from persons who had bought them from the patentee outside the district. It was held that as there was no proof that the defendants had notice of the licence they were not liable in an action to restrain the use of the machines within the district. (*Heap* v. *Hartley*, 5 R. P. C. 603; *S. C.*, on appeal, 6 R. P. C. 496.)

A licensee has, however, a right to have it ascertained what is the field covered by the specification as properly construed, and is entitled to say that he has not gone inside that field. He may seek to have the boundary of the patentee's invention defined with the view of showing that he had not rendered himself liable to make the payments stipulated in the licence. (*Adie* v. *Clark*, L. R. 4 App. Cas. 423; *Couchman* v. *Greener*, House of Lords, 1 R. P. C. 197; *Useful Patents Co.* v. *Rylands*, 2 R. P. C. 255; *Crosthwaite* v. *Steele*, 6 R. P. C. 190.) And after a licence has been determined, a licensee is at liberty to dispute the validity of a patent in a suit for an injunction to restrain an infringement. (*Dangerfield* v. *Jones*, 13 L. T. N. S. 142; *Axmann* v. *Lund*, L. R. 18 Ch. D. 330; and see *Neilson* v. *Fothergill*, 1 W. P. C. 290).

In an action for infringement the defendant, being the mortgagee of certain articles made under a licence which the plaintiff alleged had been revoked, disputed the fact of revocation, and at the same time contended that the patent was invalid. It was held that he must elect which of these lines of defence he would take. (*Post Card Automatic Supply Co.* v. *Samuel*, 6 R. P. C. 560).

A licence was granted during the period of provisional protection. The scope of the invention was afterwards considerably limited. The licensees contended that the licence was void, but it was held upon the particular words of the licence that the licensees were bound by the deed. (*Otto* v. *Singer*, 7 R. P. C. 7.)

An exclusive licensee has no right to bring an action

for an infringement in his own name without joining the patentee. (*Heap* v. *Hartley*, 5 R. P. C. 602; *S. C.* on appeal, 6 R. P. C. 496.) An ordinary licensee has no right to apply in the name of the owner for an injunction to restrain infringements (*Newby* v. *Harrison*, 1 J. & H. 393), nor has the agent of the patentee. (*Adams* v. *North British Railway Company*, W. N. 1873, p. 191.)

A patentee will not be allowed to publish advertisements and circulars calculated to deter the public from dealing with his licensee. (*Clark* v. *Adie*, 21 W. R. 764.)

The following cases relate to licences connected with partnerships: *Chambers* v. *Crichley* (33 Bea. 374); *Axmann* v. *Lund* (L. R. 18 Eq. 330); *Hough* v. *Chamberlain* (25 W. R. 742).

Formerly when the patent was silent as to the form of licence, a simple licence, without covenants, need not have been under seal (*Chanter* v. *Dorhurst*, 12 M. & W. 823; *Reuss* v. *Lever*, Ch. Div. April 9, 1879; *V. C.* Hall); nor, it seems, if it was not a deed, did it require a stamp. (*Chanter* v. *Johnson*, 14 M. & W. 408.) But now the form of patent set forth in the first schedule of the Act of 1883 requires licences to be in writing under the hand and seal of the patentee. A stamp of 10*s.* must be impressed in ordinary cases, and an *ad valorem* stamp on the consideration-money when a fixed sum is paid. When a licence contains a covenant for the payment of a minimum royalty, the Stamp Office insists upon payment of an *ad valorem* duty upon the gross minimum royalty reserved, and this although the licence contains power for licensor or licensee to determine the licence.

Compulsory Licences.—The twenty-second section of the Patents Act of 1883 introduced an entirely new regulation as to licences by empowering the Board of Trade to order a patentee to grant licences to persons petitioning the Board.

'If on the petition of any person interested it is proved to the Board of Trade that, by reason of the default of a patentee to grant licences on reasonable terms, (*a*) the

patent is not being worked in the United Kingdom; or (*b*) the reasonable requirements of the public with respect to the invention cannot be supplied; or (*c*) any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licences on such terms as to amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus,' which will require an application to the High Court of Justice.

Patents granted before the commencement of the Act, or on applications then pending, are excepted from the operation of this provision. (Sect. 45.)

As to the procedure on petitions for compulsory licences see Rules 60–66 of the Patents Rules 1890.

As to the persons representing the Board of Trade in all matters authorised to be done by the Board under the Patents Act of 1883, and as to the documents and certificates issued by the Board, see the 25th sect. of the Act of 1888, or sect. 102A of the Act of 1883.

The orders of the Board in relation to this difficult and delicate matter seem to be absolute and final, no appeal from their decision being given by the Act; nor is any power to award costs given to the Board. From the wording of the section it is clear that the three grounds for application are independent of each other, any one if properly proved being sufficient to authorise the Board to make an order on a defaulting patentee. To rebut the charge that a patent is not being worked in the United Kingdom the patentee, whether British or foreign, would probably be required to show that any manufacture established in this country was of a real and substantial nature carried on *bonâ fide* under the same conditions and to the same extent as a licensee, not exclusive, would carry it on under a reasonable royalty.

Up to the time of the publication of this book very few petitions have been presented to the Board of Trade for compulsory licences, and not a single order has been made

under the powers given to it. This section of the Act, though apparently a dead letter, may yet have had a certain indirect effect, by inducing patentees to come to terms privately with persons who desire to take licences, when otherwise they might have refused to do so. And in some cases foreigners who have obtained British patents for their inventions may possibly have been prompted to establish manufactories in this country instead of manufacturing the goods abroad and importing them.

In case a patentee should have made a *bonâ-fide* grant of an exclusive licence, it may be doubted whether he would be ordered by the Board to grant other licences, and still more whether such an order, if made, would be enforced by mandamus in a court of law.

CHAPTER XVI.

THE REGISTRATION OF PATENTS, ETC.

THE twenty-third section of the Patents Act of 1883 directs that there shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed. The Register of Patents will be *primâ-facie* evidence of any matters by the 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.

By the eighty-seventh section of the Act, 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 the Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Any equities in respect of such patent may be

enforced in like manner as in respect of any other personal property.

Notices of trusts, expressed, implied, or constructive, are not to be entered in the register nor to be received by the Comptroller. (Sect. 85.)

The probate of a patentee's will or the letters of administration must be registered, in order that when the executor, administrator, or legatee comes to deal with the patent the chain of title may be complete.

The procedure as to the registration of patent documents is set forth in Rules 67–77 of the Patents Rules 1890. A fee of ten shillings is payable for each entry on the register. The Patent Office refuses to register any document until the patent affected has been sealed. Deeds left for registration must be duly stamped.

The Court may (sect. 90), on the application of any person aggrieved by the omission without sufficient cause of the name of any person (or of any other particulars, sect. 23 of Act of 1888) from the register or by any entry made without sufficient cause in 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. Further, 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 must direct that due notice of the rectification be given to the Comptroller; and Rule 74 of the Patents Rules 1890 requires an office copy of the order to be left at the Patent Office.

In *Re Parnell's Patent*, 5 R. P. C. 130, Mr. Justice North said he saw that there may be documents which can be properly entered on the register although dated before the date of a patent, but in many instances the objections

against the registration of such pre-dated documents would be insuperable.

It would seem that under the Judicature Acts there lies an appeal from any order made by a judge under section 90 of the Act of 1883. (*Morgan's Patent*, 24 W. R. 245.)

If any rectification of a register 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 must be served on the Comptroller, and he is to rectify the register accordingly. (Sect. 111.)

The Comptroller is empowered (sect. 91) to correct any clerical error in the name, style, or address of the registered proprietor of a patent.

The making of false entries in the register; the making of any writing falsely purporting to be a copy of an entry therein; and the tendering in evidence of any such writing, are declared to be severally misdemeanours. (Sect. 93.)

The former registers of patents and of proprietors are to be deemed parts of the register of patents kept under the new Act (sect. 114), which is directed to be open at all convenient times to the inspection of the public, subject to such regulations as may be prescribed. (See Rule 79.)

Certified copies, sealed with the seal of the Patent Office, of any entry in such register will be given to any person requiring the same on payment of the prescribed fee. (Sect. 88, and see Rule 79.)

The thirty-fifth section of the Patents Act of 1852 provided that until registration of an assignment the grantee of the patent should be deemed the proprietor of the exclusive privileges thereby granted; and it was held in *Chollet* v. *Hoffmann* (7 E. and B. 636) that an assignee could not bring an action for an infringement against third parties until his assignment had been registered. But in the case of *Hassall* v. *Wright* (L. R. 10 Eq. 509), *Sir R. Malins*, V. C., was of opinion that an assignee of a patent might maintain a suit against the assignor and subsequent licensees of the assignor with notice of the assignment to

restrain them from using the patent, although at the time of the institution of the suit the assignment had not been registered. And from the same case it seems that the judge thought that registration related back to the date of the assignment, so as to enable the assignee to maintain a suit to restrain infringement instituted between the dates of the assignment and registration. No case bearing upon this point has been reported since the Act of 1883 came into operation. When the executors of a patentee obtained probate of their testator's will and assigned his patent, but the probate was not registered till after the assignment, it was held that the assignment was valid. (*Ellwood* v. *Christy*, 10 Jur. N. S. 1079; S. C. 11 L. T. N. S. 342.)

Under the thirty-eighth section of the Patents Act of 1852, which gave power to the Courts to expunge entries in the register of patents similar to that conferred by the ninetieth section of the new Act, the Master of the Rolls ordered the registry of a second assignment of a patent to be expunged on the application of the assignees under a prior assignment, which had not been registered until after the second, as it appeared that the second assignment had been executed for a fraudulent and improper purpose. (*Re Green's Patent*, 24 Bea. 145.) In another case, the Master of the Rolls said that if there were two deeds assigning the patent *simpliciter* to two different persons, and the second was registered before the first, and if it were clearly proved that the second deed was executed with full and complete notice of the prior one, though subsequently registered, he conceived he should have power to direct an entry to be made upon the register, stating the facts. In *Re Morey's Patent* (25 Bea. 58), it was said to be the duty of the Court to insert on the register any facts relating to the proprietorship, but not the legal inferences to be drawn from them. One of two joint patentees assigned by deed his interest in the patent to a third person, and released him from all claims on the part of both patentees. At the instance of the other patentee the Master of the Rolls ordered the

entry of the assignment to be expunged. (*Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475.)

In the matter of the same patent (L. R. 4 Ch. 784) it was decided that there was no appeal from such an order of the Master of the Rolls. But the jurisdiction having now been transferred to the High Court of Justice (*Re Morgan's Patent*, 24 W. R. 245), it would seem to be subject to appeal.

In *Speckhart* v. *Campbell* ('Times,' March 13, 1884), it was held by the Court of Appeal that a person (who in this case was a foreigner) may bring an action in his own name for an infringement when the patent is registered in the name of another person, if that other person is a trustee for the plaintiff.

Registration of an exclusive licence for a district is not in itself notice to the world. (*Heap* v. *Hartley*, 5 R. P. C. 603.)

CHAPTER XVII.

INFRINGEMENTS.

This chapter will be devoted to a discussion of the substantive law and the reported cases; and the next will treat shortly of the practice connected with the proceedings for infringements in the High Court of Justice.

The rights of a patentee may be violated in several ways. 1. The invention may be overtly exercised exactly as the specification has described it without the permission of the patentee. 2. The invention may be copied not textually and literally, but with certain changes and variations, such as additions, omissions, transpositions, or substitutions of parts, so as to produce something colourably different from the original. 3. By dealing in articles made by the patented method without the licence, express or implied, of the patentee. 4. By the user of articles made by an infringement of the patent.

As to the first mode of infringing a patent, nothing more need be said at present, because, when the fact is capable of proof, the remedy can be readily applied. It is the second method of encroaching on his rights that gives most trouble to the patentee. Certain devices (mechanical equivalents, transpositions of parts, &c.) having been employed to give a different appearance to the copy, with the design of seeming not to trespass within the pale set up by the patentee, and with the view of causing that copy to be mistaken for a distinct thing, it becomes the patentee's task to expose the scheme and to show that the pretended novelty is in truth an infringement in disguise. The lead-

ing idea, or principle, as it is usually termed, remaining the same, the contrivances will be considered identical, and when that is capable of satisfactory proof, the continuance of the infringement may be stopped by application to a court of law, and the infringer may be compelled to make compensation for the injury he has committed. Further, a machine may display ingenuity in its construction and may have been the work of an honest and independent inventor, yet if there is a previous patent for what is substantially the same thing it must be deemed an infringement.

A person will not be allowed to deprive an inventor of the fruits of his discovery by substituting a well-known equivalent, either chemical or mechanical, for some part of the patented invention. Where the question arises as to the infringement of the patent for a machine, the substance and not merely the form of the invention will be looked at in a court of justice. Therefore, when it is shown that two machines are alike in principle, and that the constructor of the second machine has carried the principle of the first into effect by substituting one mechanical equivalent for another, here it will be held that there has been an infringement. (See *Morgan* v. *Seward*, 1 W. P. C. 171; *Thorn* v. *Worthing Skating Rink Company*, L. R. 6 Ch. D. 415 *n.*; *Adair* v. *Young*, L. R. 12 Ch. 21.)

'It will not be the less an infringement' (said *Lord Cairns, C.*, in *Dudgeon* v. *Thomson*, L. R. 3 App. Cas. 44) 'because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist and yet the thing protected by the specification be taken notwithstanding.' And in the same case (p. 53) *Lord Blackburn* said, 'If part of the property in the invention be really taken, there is an infringement, however much that may be disguised or sought to be hidden. If that is detected by the patentee, and if what is taken is really part of his property given to him by the letters patent, he has a right to proceed against the infringer, however ingeniously the colours may have been contrived to try to

conceal the fact that there has been a taking of part of the property.'

The following cases will show clearly that to make a colourable alteration in a patented invention, or to arrive at the same result by means which are substantially the same, although independently discovered, will be an infringement of the patent. Walton took out a patent for making cards for carding textile materials with the aid of caoutchouc, the object being to obtain an increased degree of elasticity and durability. The wire teeth were described as inserted in a foundation of slices of caoutchouc, on the back of which a piece of cloth was cemented. The claim was not confined to the use of caoutchouc in slices, but he claimed the exclusive right of making cards by fixing the teeth in caoutchouc as the fillet, or sheet, or medium. After the date of this patent, Potter and Horsfall took out a patent for a new material for forming the backs of cards, and their mode of preparing it was by repeatedly passing a woven fabric of a peculiar construction through, and saturating it with, a solution of caoutchouc, and then drying it to evaporate the solvents, and leave the fabric impregnated and coated with caoutchouc, the object being to render the fabric so dealt with extremely elastic in the direction of the thickness of the fabric, so as to impart elasticity to the wire teeth when set. It was held (*Walton* v. *Potter*, 1 W. P. C. 585) that Potter's process fell within the generality of Walton's claim, and was an infringement of his patent. At the trial, *Tindal, J.*, told the jury that, 'when a party has obtained a patent for a new invention 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 invention, to obtain either 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 evasion of the right.' Then referring to a card purchased from the defendants, which was produced to the jury, he said, 'Now, what you have to say is, whether you are satisfied that the card produced

is a specious variation in form only, an ingenious alteration in the mode of adaptation, or whether it is really and substantially a new discovery on the part of the defendants. In the one case it would be an infringement of the patent; in the other it would not. . . . 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 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 has been before granted exclusively to another; and therefore the question again comes round to this, whether you are of opinion that the subject-matter of this second patent is perfectly distinct from the former, or whether it is virtually bottomed upon the former, varying only in certain circumstances which are not material to the principle and substance of the invention.'

Under a patent for improvements in apparatus for the manufacture of sulphate of soda, &c., the plaintiff claimed the use of iron retorts worked in connection with each other. The essence of the invention was held to be the use of two chambers with separate furnaces worked in connection with each other, so that the materials might be decomposed in one and then removed to and finished in the other. The defendant for the same purpose employed two chambers, one of iron, the other of brick. This was decided to be an infringement of the patent. (*Gamble* v. *Kurtz*, 3 C. B. 425.)

Trotman obtained a patent for improvements in anchors. His mode of making the improved anchor was to affix the

'palm' and 'horn' to the back of the 'arm' by a separate operation. It was held that the making of similar anchors by forging the arm, palm, and horn all in one piece was an infringement. (*Trotman* v. *Wood*, 16 C. B. N. S. 479.)

In 1871 E. L. Hayward obtained a patent for an improved pavement-light. A piece of glass in the form of a prism was fitted into a frame and let into a floor with the object not only of allowing light to pass through, but also of sending it obliquely into the room below. In 1874 Hamilton took out a patent for a contrivance for the same purpose. He employed also a prism of glass shaped like that used by Hayward, except that pieces were cut out of it. The Court of Appeal held that as the notches had no effect on the strength of the apparatus, nor any optical effect, affording, in fact, no advantage whatever, there was no substantial difference between the two contrivances, and the second patent was therefore adjudged to be an infringement of the earlier one. (*Hayward* v. *Hamilton*, 1 Griff. P. C. 115.) And in *Hayward & Eckstein* v. *Pavement Light Co.* (1 R. P. C. 207), the judge at the trial of an action for the infringement of the same patent held that the use of glass moulded so as to form a curve was an infringement.

It is not permissible for a person to evade a patent by making immaterial transpositions of parts of a machine (*Cropper* v. *Smith*, W. N. 1883, p. 49; 1 R. P. C. 84); or by making one part act indirectly instead of directly (*Kaye* v. *Chubb*, 4 R. P. C. 23; *S. C.* on appeal, 5 R. P. C. 641); or by altering the shape of part of a machine in an unimportant particular (Per *Parke, B.*, in *Barber* v. *Grace*, 1 Exch. 339); or by transposing the action of some of the parts, as, for example, in a brick machine, moving the clay against the cutters, instead of making the cutters move against the clay (*Murray* v. *Clayton*, L. R. 7 Ch. 570); or, in a machine for marking out the court in the game of lawn tennis, removing the marking wheel from behind to the front, and substituting a revolving brush for a feeding wheel (*Osmond* v. *Hirst*, 2 R. P. C. 265); or in a mechani-

cal musical instrument, employing a rotating wind chest and a fixed music sheet in place of a fixed wind chest and a rotating music sheet. (*Ehrlich* v. *Ihlee*, 5 R. P. C. 188; affirmed on appeal, 5 R. P. C. 437.) In *Parkes* v. *Stevens* (8 Eq. 367), it was laid down by *V. C. James*, that a man could not evade a patentee's right by substituting a spring for a weight. And in *Winby* v. *Manchester, &c., Steam Tramways Co.* (6 R. P. C. 359), it was held that a patent was not to be evaded by substituting a weighted lever for a spring.

The specification under a patent for a telephone claimed a combination of a diaphragm or tympanum with a tension-regulator. In this arrangement the diaphragm was placed next the mouth when speaking into the instrument, and its vibrations acted on the tension-regulator behind. Bassano employed for the same purpose an apparatus in which a tension-regulator was nearest the mouth and what was equivalent to a diaphragm was placed behind. It was held that he had infringed the patent. (*United Telephone Co.* v. *Bassano*, 3 R. P. C. 295. See also *United Telephone Co.* v. *St. George*, 3 R. P. C. 321.)

And it has been held that a patent for improvements in a known process secures those improvements to the patentee, whether applied to the process as known at the date of the patent, or to the same process altered and improved by discoveries not known at that time, so long as that process remains essentially the same. (*Electric Telegraph Company* v. *Brett*, 10 C. B. 881.)

When the Principle is New.—'When you have invented some mode of carrying the principle into effect,' said *Alderson, B.*, in *Jupe* v. *Pratt* (1 W. P. C. 146), 'you are entitled to protect yourself from all other modes of carrying the same principle into effect.'

'There never were two things to the eye more different,' said *Alderson, B.* (1 W. P. C. 146), commenting upon the case of *Crossley* v. *Beverley*, 'than the plaintiff's invention of a gas-meter, and what the defendant had done in contravention of the patent right. The plaintiff's invention was

different in form, different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve it. The scientific men, all of them, said, the moment a practical scientific man has got that principle in his head he can multiply, without end, the forms in which that principle can be made to operate.'

A patent having been obtained for the application of a self-adjusting leverage to chairs, an action for an infringement was brought in which the defendant contended that the plaintiff claimed a principle, inasmuch as the defendant's method of applying the leverage to chairs was different from the plaintiff's. 'But,' said *Mr. Baron Parke*, 'for the application of a self-adjusting leverage to a chair, cannot he patent that? He claims the combination of the two, no matter in what shape or way you combine them; but if you combine the self-adjusting leverage, which he thus applies to the subject of a chair, that is an infringement of the patent' (*Minter* v. *Mower*, 1 W. P. C. 134.)

In the case of the *Household Company* v. *Neilson* (1 W. P. C. 685), *Lord Justice Clerk Hope* said, 'You may obtain a patent for a mode of carrying a principle into effect; and if you discover not only the principle, but how it may be applied to a practical result by a mechanical contrivance and apparatus, and show that you are aware that no particular modification or form of the apparatus is essential in order to obtain benefit from the principle, then you may take out your patent for the mode of carrying it into effect, and are not under the necessity of confining yourself to one form of apparatus. . . . You may generally claim the mode of carrying the principle into effect by mechanical contrivance, so that any sort of apparatus applied in the way stated will more or less produce the benefit, and you are not tied down to any form.'

In the case of *Otto* v. *Linford* (Court of App., 46 L. T. N. S. 35), it appeared that the plaintiff had patented a

gas engine working on a certain new principle, and that the defendant had subsequently constructed an engine working in rather a different way with two pistons instead of one, and with six motions in place of four, which required the cams, slides, &c., to be altered. It was held that notwithstanding these differences, as he had borrowed the plaintiff's new principle, his engine was substantially similar to the plaintiff's, and was therefore an infringement. 'It appears to me to be pretty clear upon the authorities, that, although there cannot be a patent for an idea or principle apart from its physical embodiment in adequate apparatus, yet that if the specification discloses the idea, shows a method by which it can be carried out, and does not limit the claim of the patentee, any apparatus which by different mechanical means carries out the same idea is an infringement of the patent, though the method used and even the purpose to which the idea or principle is applied be different from those embodied in the specification.' (Per *Mr. Justice Wills*, in *Easterbrook* v. *G. W. R. Co.*, 2 R. P. C. 207.)

And the same doctrine holds good in chemical inventions. 'When a patent is taken out for a new result' (said *Mr. Justice Pearson*, in delivering judgment in the case of the *Badische Anilin and Soda Fabrik* v. *Levinstein*, 24 Ch. D. L. R. 156), 'and there is one process described in the specification which is effectual for the purpose of arriving at that new result at the time when the patent is taken out, the patentee is entitled to protection against all other processes for the same result; and no person can, without infringing upon his patent, adopt simply a different process for arriving at the same result.'

'Where the thing is wholly novel, and one that has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been done before.' (Per *Wood, V. C.*, in *Curtis* v. *Platt*, L. R. 3 Ch. 135 *n.*)

It seems a fair inference from the cited judicial dicta in the cases of *Jupe* v. *Pratt*; *Houschill Co.* v. *Neilson*; *Minter* v. *Wells*; *Easterbrook* v. *G. W. R. Co.*; and *Badische Anilin und Soda Fabrik* v. *Levinstein*, to say that they tend to establish the proposition that when a mode of carrying a principle into effect has been invented and the principle itself is new, then a patent can be obtained for securing not only that particular mode but every other mode of carrying the principle into effect. But *L. J. Cotton*, when delivering judgment in the case of the *Automatic Weighing Machine Co.* v. *Knight* (6 R. P. C. 304), an action brought for an infringement of the plaintiff's machine, commented on Baron Alderson's words in *Jupe* v. *Pratt* (cited *ante*, p. 238), and made the following remarks: 'Those were the expressions of Mr. Baron Alderson during the discussion, probably to meet something that was said by counsel, and did not express his full opinion. You can prevent anyone from using the same method of carrying that principle into effect, and you can prevent anyone from using only the same thing with a colourable difference. . . Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle, and say they do it by a different mode, and looks to see whether in effect, although the mode is not exactly the same, it is only a colourable difference. . . What I said in *Proctor* v. *Bennis* (4 R. P. C. 333) was, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variations or by mechanical equivalents, the substance of it, so as to produce the same result by practically the same means?"'. . . In the weighing machine case it had been argued by the plaintiff's counsel that his machine was the first machine which had been invented to act upon a certain principle, which principle had been adopted by the defendant, but with some differences in the mechanism, and that he was therefore liable for an infringement notwithstanding these differences. To this *L. J. Cotton* replied, 'A patent cannot be taken out for a prin-

ciple. It can only be taken out if in addition to the principle shown the patentee shows some mode of carrying that effectually into operation.' And the Court of Appeal held that there had been no infringement of the plaintiff's patent, because the defendant had employed different mechanism. See also *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.* (6 R. P. C. 367).

Where the Principle is not New.—We have seen that there are judicial dicta which imply that where the principle of an invention is new, the patentee may secure not only the method of carrying it out described by him, but all other methods that fall under the same principle. On the other hand, where the principle is not new the patentee is confined to the particular method described, and his patent will not be allowed to cover other methods. Thus in *Barber* v. *Grace* (1 Exch. 339), it was held that the pressing of woollen goods by a set of rollers, heated within by steam, was not an infringement of a patent for a mode of pressing similar goods by two cast-iron boxes filled with steam. The jury found that the former was not a colourable variation of the latter process, and the Court, after argument, approved of the finding. (See also *Easterbrook* v. *G. W. R. Co.*, 2 R. P. C. 201.)

In *Curtis* v. *Platt* (L. R. 3 Ch. D. 135 *n.*), *Sir W. P. Wood, V. C.*, said, 'When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because, otherwise, that would be to say that the whole world is to be precluded from exercising its invention for achieving some desirable and well-known object which everybody has had in view for years. One looks more jealously at the claims of inventors seeking to limit the rights of the public at large for effecting that which has been commonly known to all the world long ago. Of course no patent can be taken out for effecting this as a new object,

but only for effecting it by a new means. What those means may be, and what is the extent of the claim which the patentee has a right to insist upon as to those means, is often a matter of much difficulty.'

'Where there is the principle first introduced in the (patented) machine we look upon it with very different eyes to what we do when what the patentee has done is simply by some variation to make an improvement in an existing machine. Then he is confined to the actual thing he has produced as an improvement in an existing machine, and we cannot say, if anyone else were to take some other mechanical means of arriving at the same end, that that is an infringement.' (Per *L. J. Cotton*, in *Proctor* v. *Bennis*, L. R. 36 Ch. D. 740.)

Hence if another person invents a method of carrying out the same object different from that patented, he may obtain a valid patent for it, or he may use it without being liable for an infringement, since the inventions stand independently one of the other, each inventor being limited to his own particular combination or method. Identity of object must not be mistaken for identity of means. The patented apparatus is, under the supposed circumstances, nothing more than a particular mode of attaining a certain end, and if one man is entitled to a patent for one road to that end, any other person is on the same ground entitled to a patent for another road to the same end.

Where a patent has been obtained for improvements in an old machine and there is no novelty in the result, the patentee will be held strictly to his description of the particular means by which his invention is to be carried into effect, and the doctrine of mechanical equivalents will not be applicable. (*Curtis* v. *Platt*, L. R. 3 Ch. D. 136 *n.*, 139 *n.*; *Saxby* v. *Clunes*, 43 L. J. Ex. 228; *Dudgeon* v. *Thomson*, L. R. 3 App. Cas. 34; *Nordenfeldt* v. *Gardner*, on appeal, 1 R. P. C. 61; *Hocking* v. *Hocking*, House of Lords, 6 R. P. C. 76.)

As an example of this class of cases, *Bovill* v. *Pimm* (11 Ex. R. 718) may be referred to.

It had been long known that if grain were kept cool during the process of grinding, the flour was of superior quality. To effect this desideratum various contrivances had been adopted, and several patents had been obtained for them, before Bovill obtained one for an invention consisting of the application of ventilating vanes or screws at the centre of the grinding-stones, by which means air was supplied between the grinding surfaces. A portable ventilating machine, blowing in a screw vane, which caused a flow of air parallel to the axis of the vane, was attached externally to the eye of the upper millstone. When the screw vane was set in motion air was compelled to pass through the eye of the upper millstone into the centre of the two stones, and found its way out between them. Pimm subsequently took out a patent for improvements in grinding wheat. His plan for keeping the grain cool whilst grinding consisted in the removal from the centre of both stones of a large circular portion, and in the space thus obtained to place a fan, by the rapid rotation of which a centrifugal motion was given to the air, and it was driven between the stones. It was held that the latter method was no infringement of Bovill's; the two inventions were deemed independent original improvements, and each inventor was entitled to protection in respect of the method disclosed in their respective specifications, but could not claim beyond the method actually described.

An action was brought for the infringement of a patent dated in 1877 for improvements in machinery for winding, doubling, and twisting yarn and thread. As there were previous machines for the same purpose as the plaintiff's, all of which included a swinging-plate and a catch-plate, and as the plaintiff laid special stress on the particular form of his catch-plate as an important improvement, and when describing the machine said he did not claim the combination of a swinging-plate with any catch-plate, but only the combination of a swinging-plate with a catch-plate as described in the specification, it was held by the Court of Appeal that the plaintiff was bound to this limited

claim, and as the defendant did not use a catch-plate in his machine he had not infri[illegible]l the patent. (*Boyd* v. *Horrocks*, 6 R. P. C. 152.)

On the other hand, where there is not only novelty in the patented machine, but also in the result produced by the machine, the doctrine of mechanical equivalents will be applied in the case of an alleged infringement. For instance, a patent was obtained for an improved and self-acting mechanism for supplying and distributing fuel at intervals over the fire surface of furnaces. From the specification it appeared that the object of the patent was the automatic placing of coal on a fire by intermittent radial motion, and this object was proved, at the trial of an action for an infringement, to be new and effected by a new combination. It was also shown that in the defendant's mechanism the motion was intermittent and radial, and produced by means of a radius as in the plaintiff's mechanism; but there was this difference: that in the plaintiff's contrivance the shaft was actuated by tappets and a spring, the radius being attached to the shaft, whilst in the defendant's contrivance the radius itself was actuated by tappets and a spring, the radius working on a pin. Thus the same radial motion, with the same result, was produced by substantially similar means. The Court of Appeal, here applying the doctrine of mechanical equivalents, held that the defendant's mechanism was an infringement. (*Proctor* v. *Bennis*, 4 R. P. C. 354, 359, 361.) See also *Gosnell* v. *Bishop*, on appeal (5 R. P. C. 156, 159); *Ehrlich* v. *Ihlee*, on appeal (5 R. P. C. 437); *Thomson* v. *Moore*, Court of Appeal, Ireland (6 R. P. C. 426).

In the case of interfering patents, the following rule was laid down by *Pollock, C. B.*, in *Bush* v. *Fox* (Macr. P. C. 165): 'Whenever it appears that the use of a prior patent invention would be an infringement of a subsequent patent, the second patent cannot be sustained.' See also *Thomas* v. *Foxwell* (5 Jur. N. S. 39); *Betts* v. *Menzies* (1 Ell. & Ell. 1020); and *Kaye* v. *Chubb* (4 R. P. C. 298).

In *Saxby* v. *Hennett* (L. R. 8 Ex. 210), it was held that

where two patents are in existence for the same invention, acts done under the patent of later date are infringements of the earlier patent.

Invention of Improvements no Defence.—A person is at liberty to patent an improvement upon an invention which forms the subject of an existing patent, without rendering himself liable for an infringement; but he will not be able to use the improved invention before the expiration of the earlier patent unless he obtains the licence of the patentee. (*Lister* v. *Leather*, 8 E. & B. 1004.) It is no defence to an action for an infringement to say that the infringer has invented improvements. The case of *Saxby* v. *Clunes* (43 L. J. Ex. 228) arose out of the alleged infringement of a patent for a mode of working the points and signals of railways. When it went on appeal to the House of Lords, *Lord Chelmsford* said that, although the defendant's invention was a great improvement upon the plaintiff's, yet if, in carrying it out, the former made use of any part of the invention to which the plaintiff's patent extended, and which was new and material, it was an infringement. See also the case of *White* v. *Fenn* (15 W. R. 348).

In the case of *Proctor* v. *Bennis* (4 R. P. C. 353), an action for an infringement which went to the Court of Appeal, *Lord Justice Cotton* made the following observations: 'What was very much relied on (by the defendant) was this: that there are certain omissions in the defendant's machine of parts which there are in the plaintiff's combination, and that there are certain things in the defendant's machine not found in the plaintiff's, producing a result which is not obtained in the plaintiff's. . . . Now, if in fact the defendant has . . . made an improvement, that will not enable him to take the plaintiff's combination which he has protected without infringing the plaintiff's patent. . . . The mere fact that there are certain parts omitted or certain parts added, if he really has taken the substance and essence of the plaintiff's combination, cannot prevent his machine being an infringement of the plaintiff's. . . . If in substance and in essence the combination is taken,

and practically the same parts, or the parts in which there is a variation, or for which there are mechanical equivalents, are so arranged as to produce the same result, then the essence of the invention has been taken, and an infringement has been committed by the defendant who makes, sells, or uses these machines.' (And see *Wenham Co.* v. *May*, 4 R. P. C. 308; *Hocking* v. *Hocking*, 4 R. P. C. 442; *Ehrlich* v. *Ihlee*, appeal, 5 R. P. C. 437.)

Common Dilemma.—In actions for infringements the defendant's defence frequently endeavours to place the patentee on one or the other horn of the dilemma, an example of which is afforded by the case of *Macnamara* v. *Hulse*, cited in the chapter on Novelty. If the patentee's claim is read in a wider sense so as to cover the alleged infringement, it is met by a charge of anticipation; if read in a narrower sense so as to avoid that difficulty, there is no infringement. (*Stevens* v. *Keating*, 2 W. P. C. 194; *Downes* v. *Falcon Works*, 3 R. P. C. 70; *Kaye* v. *Chubb*, 4 R. P. C. 289; *Gosnell* v. *Bishop*, 5 R. P. C. 158; *Ellington* v. *Clark*, 5 R. P. C. 327; *Hutchison* v. *Patullo*, 4 R. P. C. 359.)

COMBINATIONS.

With regard to the infringement of patents obtained for a general arrangement and combination of numerous parts, all of them old, or some old and some new, the whole in either case forming a new apparatus or machine, questions of some complication may arise, and it may not be easy to decide in a given case whether what has been done amounts to an infringement or not. A patentee may assert that, although his invention as described in the specification has not been exactly copied by another person part by part, yet sufficient has been taken to bring it within the reach of the law and render him liable as an infringer. In other words, that the differences are merely colourable, and that the inventions specified by the patentee and practised by the defendant are substantially identical. On the other hand, the alleged infringer may aver that what he has done, though directed to the same object and producing a

similar result, has been effected by methods that were open to all the world, and that if the means employed by him are to a certain extent similar to those employed by the patentee, they yet differ so far as to render his process or apparatus a distinct and independent mode of arriving at a common end, and do not constitute an illegal copy or evasion of the patentee's method. These opposite views may both be supported by witnesses of equal weight and credibility, and thus a very difficult question of fact may be placed before a jury or submitted to the decision of a judge. Those upon whom may devolve the duty of deciding a controversy of this nature will anxiously seek to discover on which side lies the preponderance of probability after hearing the whole case.

When the case *Clark* v. *Adie*, which arose out of an alleged infringement of a patent for improvements in apparatus for clipping horses, was taken on appeal to the House of Lords (L. R. 2 App. Cas. 315), *Lord Cairns, L. C.*, made the following general remarks on infringements of patents for inventions of this nature: (1) 'One mode of infringement would be a very simple and clear one: the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise.' (2) 'The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument, but he might make an instrument which in many respects might resemble the patented instrument, but would not resemble it in all its parts. And there the question would be, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented.' (3) 'But there is a third way in which it is possible to conceive an infringement of a patent of this kind. Inside the whole invention there may be that which in 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 novel combination within the meaning which is attached by the patent law to the term "combination." . . . In a patent of that kind the monopoly would or might be held to be granted not only to 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.' Proceeding to apply these principles to the case before the House, his lordship said: 'I cannot find from beginning to end of the specification any sentence or any number of sentences, as to which, by any reasonable interpretation, you can say that they may make a claim to a subordinate combination of these particular items as constituting in itself a novelty, a new manufacture, a thing to be protected by the patent.'

In the same case (L. R. 2 App. Cas. 335), *Lord Blackburn* said: 'I incline to agree with what was said by the Exchequer Chamber in the case of *Lister* v. *Leather*, that you cannot decide in the abstract whether the using of two parts A and B of a combination A B and C is or is not using part of that invention, nor can you decide in the abstract the other question, whether or no the specification shows that A or B is sufficiently claimed as a part of the invention or not. I do not think that either of those questions can be decided in the abstract. I would wish, like the Exchequer Chamber in *Lister* v. *Leather*, before deciding, to have before me the nature of the machine, in order that I might see what A B and C are, and what is their relation to each other.'

The following propositions are deducible from the numerous cases which bear upon the infringement of patents relating to general combinations and subordinate parts:—1. If a combination alone is claimed there is no infringement unless the entire combination, or the substance of it, is taken. 2. Subordinate parts and minor combinations will not be protected unless they are expressly claimed. 3. Subordinate parts and minor combinations when claimed must be new, useful, and patentable *per se*.

In the earlier cases cited in the footnote [1] it was laid down that to take a new and material part of a combination, though not expressly claimed, was an infringement. Thus, *Lord Campbell*, in *Lister* v. *Leather* (8 E. & B. in error 1032), said that the cases established 'that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process without any express claim of particular parts.' And in *Bovill* v. *Keyworth* (7 E. & B. 725), the Court said: 'Supposing the patent to be for a combination consisting of several parts for one process, we are of opinion that the defendants are liable for having used a material part of the process, which was new, for the same purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process specified.'

In later cases the limitation was introduced that the new and material part must be capable of being by itself the subject-matter of a patent.

In *The Bottle Envelope Co.* v. *Seymer* (5 Jur. N. S. 174, C. P.), it was said by the Court that the infringement of any part of a patent process is actionable if that part is of itself new and useful, so as that it might be the subject-

[1] *Newton* v. *Grand Junction Railway Company* (5 Exch. 334); *Smith* v. *London & South-Western Railway Company* (Macr. P. C. 203); *Smith* v. *London & North-Western Railway Company* (2 E. & B. 69); *Sellers* v. *Dickenson* (5 Exch. R. 312); *Lister* v. *Leather* (8 E. & B. 1004); *S. C.* in error *ibid.* 1032; *Saxby* v. *Clunes* (43 L. J. Ex. 228); *White* v. *Fenn* (15 W. R. 348); *Harrison* v. *Anderston Foundry Company* (L. R. 1 App. Cas. 574); *Dudgeon* v. *Thomson* (L. R. 3 App. Cas. 34).

matter of a patent, and is used by the infringer to effect the object or part of the object proposed by the patentee. Where a part only of an invention has been taken, it must be shown in order to make out a case for infringement that the part is one that could stand by itself in respect to invention and in respect of use as the subject of a distinct patent. (Per *Mr. Justice Willes* in *Tatham* v. *Dania*, 1 Griff. P. C. 215.) And in *Parkes* v. *Stevens* (L. R. 8 Eq. 358), *James, V. C.*, held that a patent for a combination will not cover any part which would not be of itself patentable. In deciding this case the learned judge made these remarks on the case of *Lister* v. *Leather*, cited above: 'The authority of that case has been pressed upon me as if it really established this, which would be a most startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material, and that went to make up the combination. The marginal note, if read hastily, is calculated to give some colour to that contention. But if the judgment be read it will be found to give no warrant whatever for such, I must call it, baseless notion. . . . . It was contended (in the case before the judge) that because it (a sliding door) was as alleged a novel part of a novel combination (forming a lamp), it was protected. To say that a patent for an entire combination is a valid patent for a part when that part would not of itself have been patentable is in my judgment a *reductio ad absurdum* of the supposed principle in *Lister* v. *Leather*.'

In the case of *Harrison* v. *Anderston Foundry Co.* (L. R. 1 App. Cas. 574), *Lord Cairns, C.*, said: 'If it is clear that the claim is for a combination and nothing but a combination there is no infringement unless the whole combination is used, and it is in that way immaterial whether any or which of the parts are new.' And in the same case *Lord Chelmsford* said: 'If a patent is solely for a combination nothing is protected by it, and consequently nothing can be infringed, but the use of the entire combination.' See also *Dudgeon* v. *Thomson* (L. R. 3 App. Cas. 34), and

the remarks of *Sir G. Jessel, M. R.*, in *Townsend* v. *Haworth* (L. R. 12 Ch. D. 837 *n.*).

When, however, it is laid down that to constitute an infringement of a combination the entire combination must be taken, the proposition must be understood in this sense, that if the substance of the combination is borrowed there will be an infringement, although all the details of the invention as described by the patentee may not have been taken. It is a clear principle in patent law that a person cannot borrow some substantial part of that which as a whole is a useful invention, and thereby take the benefit of it, without rendering himself liable for an infringement.

In *Parkes* v. *Stevens* (L. R. 8 Eq. 358), *James, V. C.*, stated the law on this branch of the subject as follows: 'The law is summed up thus: the cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process; which is nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—is it really and substantially a part of the invention? Supposing that a clock was now for the first time invented and patented as a machine for measuring and indicating time, a man could not evade the patentee's right by substituting a spring for a weight, or by leaving out the whole of the striking apparatus.' See also *Walton* v. *Potter* (1 W. P. C. 586) and *Thorn* v. *Worthing Skating Rink Company* (L. R. 6 Ch. D. 415 *n.*).

The case of *Lister* v. *Leather* (said *Lord Penzance*, in *Harrison* v. *Anderston Foundry Co.*, L. R. 1 App. Cas. 574) decided nothing more than this, that though the patent is for a combination, it does not follow that there can be no infringement of it unless every part of that combination without exception is pirated. What the Court said was that the taking of a subordinate part or parts of the combination *might* be, not that it necessarily would be, an

infringement of the patent; and that whether it would be so or not depended, as the Court of Error said, 'upon what the parts taken were, how they contributed to the object of the invention, and what relation they bore to each other.' This only amounts to saying that on a question of infringement the essential nature of the invention will be regarded; and that there may be cases in which, though the patent is for an entire combination of numerous parts, a collusive imitation of that invention may be effected, though some detail of the combination is omitted or changed, which is a doctrine familiar enough in patent law.

And see *Flower* v. *Lloyd* (W. N. 1877, p. 132); *United Telephone Company* v. *Harrison* (L. R. 21 Ch. D. 720).

'I understand the rule to be that if a man uses a part of that to which the patent applies for the purpose for which the patentee intended it, and for which he has taken out his patent, and the difference is unsubstantial or colourable, the use of it is an infringement.' (Per *Mr. Justice Field* in *Burnett* v. *Tate*, 45 L. T. N. S. 143.)

It was decided in a case where the patentee's combination consisted of three old mechanical parts, that another person might use two of those parts and substitute hand-power for the third. (*Murray* v. *Clayton*, L. R. 10 Ch. 675 *n.*)

The taking of one part out of a combination of three, the part taken not being a substantial part nor capable of being made the separate subject of a patent, was held not to be an infringement. (*Garrard* v. *Edge*, 6 R. P. C. 372; affirmed on appeal, 6 R. P. C. 563.)

When a patent is for a new combination of machinery, every part being old, it may be that the manufacture of the separate parts in this country, and the exportation of them abroad, will be no infringement; but in *Goucher* v. *Clayton* (11 Jur. N. S. 462, 465) it was held to be otherwise when the part so made and exported is new and is claimed as new.

When there are several distinct heads of invention, an infringement of any one renders the infringer liable to

legal proceedings. (*Gillett* v. *Wilby*, 1 W. P. C. 271; *Edison & Swan United Electric Company* v. *Woodhouse*, 4 R. P. C. 79.)

CHEMICAL PROCESSES AND PRODUCTS.

Precisely the same rules of law are applicable to the case of chemical as to the case of mechanical inventions. The chief questions will continue to be, has the new principle discovered and applied by the patentee, or his new method of carrying out a known principle, or his new combination of parts or ingredients been borrowed by the alleged infringer?

In *Stevens* v. *Keating* (2 W. P. C. 188), it was a question whether the use of borax (a compound of boracic acid and soda) was not an infringement of a patent, the specification of which claimed the use of acids and alkalies in the preparation of cements. Both *Lord Cottenham* and *Pollock, C. B.*, held that it was an infringement.

In *Hancock* v. *Moulton* (June 1852), an application was made in the Court of Chancery for an injunction to restrain the manufacture by the defendant of vulcanised caoutchouc, alleged to be an infringement of the plaintiff's patent for obtaining a certain product by subjecting a mixture of sulphur and caoutchouc to heat. The defendant subsequently obtained a patent for the combination of hyposulphate of lead and artificial sulphuret of lead with caoutchouc; that combined mass, acted upon by heat, was alleged by the defendant to produce more beneficial results, but the results were of the same character as those which were produced by the plaintiff's patent. 'Assuming,' said *Turner, V. C.*, 'the materials thus used by the defendant to be different, the process of the defendant would *per se* be no infringement of the plaintiffs' patent. The plaintiffs confined their patent to sulphur; the defendant had used hyposulphate of lead and artificial sulphuret of lead. But it was alleged by the plaintiffs that the materials were not in truth different, or at least that the materials which produce the result are the same. It was said that sulphate

and sulphuret of lead do not of themselves produce the change, but that the change is produced by the sulphur which they contain, and which forms one of their several constituent parts; and that those parts being decomposed by heat, the sulphur combined with the caoutchouc and left a residuum of lead, which had no operation in the change which was effected. If the qualities conferred upon the caoutchouc by the process were imparted by the sulphur, it would no doubt be an infringement of the plaintiffs' patent.' The judge's opinion, after examining the evidence, was, that the evidence preponderated very considerably in favour of the plaintiffs.

In the case of *Talbot* v. *Laroche* (15 C. B. 310), the plaintiff was the inventor of a photographic process, patented in 1841. The specification claimed, amongst other things, the employment of gallic acid or tincture of galls, in conjunction with a salt of silver, to render paper more sensitive to the action of light; and also the making visible photographic images upon paper by washing them with liquids (meaning only, as other parts of the specification showed, gallo-nitrate of silver) which act upon those parts which had been previously acted on by light. Subsequently to the date of this patent the collodion process was discovered, and the defendant having practised it, the plaintiff brought this action, alleging that this process was an illegal copy of his process. It was argued by the defendant—firstly, that the plaintiff had claimed only the rendering of *paper* more sensitive to light; whereas collodion, the substance he employed, was a different thing, being a solution of gun-cotton in ether; secondly, that when the collodion was put into the camera it contained no gallic acid, a material essential to the plaintiff's process; thirdly, that in developing the image he employed pyrogallic acid, and not gallic acid. Several scientific persons gave evidence that collodion was not only a different material from paper, calling into play processes not needed when paper was employed, but that it possessed peculiar photographic properties, as was proved by the fact that gallic acid was

not required to render it sensitive, as in the case of paper; also, that pyrogallic acid was much more rapid in its action than gallic acid, and that it was, in many respects, a different thing from gallic acid. The questions submitted by the judge to the jury upon this part of the case were these: Is the use of collodion with nitrate of silver and iodide of potassium the same as the use of paper prepared with nitrate of silver, iodide of potassium, and gallic acid? Is pyrogallic acid the same as, or a chemical equivalent for, gallo-nitrate of silver? The jury returned a verdict implying that, in practising the collodion process, the defendant had not infringed the plaintiff's process.

The difficulty that sometimes exists in determining whether one chemical process is, in contemplation of law, distinct from, or an illegal copy of, another is exemplified in the history of the case of *Heath* v. *Unwin*.

Under a patent for improvements in the manufacture of iron and steel, the patentee claimed 'the use of carburet of manganese in any process whereby iron is converted into cast steel;' and his specification stated that the invention consisted in adding from one to three per cent. of the carburet to iron or blistered steel whilst in the crucible. The carburet of manganese was separately prepared, by subjecting oxide of manganese and carbonaceous matter to a strong heat, and the resulting carburet was then added to the crucible containing the metal to be converted into cast steel. Upon the trial of an action for an infringement, it appeared that the defendant did not use any single substance answering to the description of carburet of manganese; but he placed in the crucible containing the iron or blistered steel some oxide of manganese and carbonaceous matter. These two substances would form during the process of conversion, and before actual union with the melted iron, carburet of manganese in a state of fusion; but the quantity of the carburet so formed was less than one per cent. of the weight of iron in the crucible. It was held by the Court of Exchequer, that since the defendant had not contemplated the use of carburet of manganese,

and had not known prior to the investigation that took place in consequence of the action that the result of his adding the oxide and carbon was to produce the carburet —since, moreover, the patentee had expressly stated his invention to be the addition of the substance called carburet of manganese to the crucible, there was no infringement on the part of the defendant, for there was no imitation of the patentee's process behind a colourable variation. The specification was construed as claiming the use of one particular combination of carbon and manganese—namely, the carburet of that metal; and a particular mode of using that combination—namely, by putting a certain quantity by weight, in an unmelted state, into the crucible.

Heath v. *Unwin* subsequently went before the Court of Exchequer Chamber. A majority of the judges of that Court held that, inasmuch as the plaintiff had not limited his claim to the particular mode of using the carburet described in his specification, the defendant's process was an infringement of the patented invention, since it effected the manufacture of cast steel by the employment of either carburet of manganese or a chemical equivalent. A minority of the judges thought that the defendant had not infringed the patent: for, though he had used a chemical equivalent for the carburet of manganese—viz. its component parts—it was not known at the date of the patent that such component parts were equivalent to the carburet, in such special applications of it as were described in the specification, and for the purpose there mentioned. Moreover, they thought that the defendant's process was an improvement upon the plaintiff's, for the same quality of steel was made at less expense, one crucible and one heating effecting the desired result.

When this extraordinary case came before the House of Lords, the judges were called upon to attend the argument, and give their opinions. Eleven judges attended, seven of whom concurred with the Court of Exchequer Chamber, and four disagreed. Notwithstanding this large majority, the two law lords who heard the case (*Lord*

Cranworth and *Lord Brougham*) gave judgment for the plaintiff in error, thereby deciding that Heath's patent had not been infringed. 'I think,' said *Lord Cranworth*, 'that the use of substances thus producing carburet of manganese in a state of fusion was no violation of the patent. The substance for the use of which (*inter alia*) the patent was granted was a solid metallic substance capable of being broken into fragments and weighed, so that certain definite quantities might be put into the crucible with the steel. There is no evidence whatever tending to prove that, at the date of the patent, it was known to persons acquainted with the subject of manufacturing steel, that coal-tar and oxide of manganese would be a chemical equivalent for the carburet of manganese claimed by Heath. Indeed, it is obvious that the discovery of such an equivalent was made after the use of the carburet as a distinct metallic substance had been some short time in operation. It was itself a most valuable discovery, and would have legitimately formed the subject of a new patent. The costly nature of the substance claimed in the patent might, and probably would, have prevented its use altogether; and if, at the date of the specification, it was known to Heath that, by the use of two common substances, well known in commerce, more than one hundredfold cheaper than carburet of manganese, the same results precisely would be obtained as by the use of that material, the specification would have been bad, as not truly disclosing the invention. On the short ground, therefore, that the invention claimed is for the use of a particular metallic substance, viz. carburet of manganese in certain definite proportions, according to the weight of the steel under fusion, and that no such substance, nor any equivalent for it, known to be such at the date of the specification, was used by the defendant, I think that there was no evidence of infringement.' (5 H. L. C. 505, 543.) See also Mr. Justice Pearson's judgment in *The Badische Anilin und Soda Fabrik* v. *Levinstein* (2 R. P. C. 70).

On the trial of *Muntz* v. *Foster* (2 W. P. C. 96), an action brought for the infringement of a patent for an

improved manufacture of metal plates for sheathing the bottoms of ships, it appeared that the patentee claimed the invention of an alloy of 60 per cent. of copper and 40 per cent. of zinc—the copper and zinc being of the best quality—which alloy could be rolled at a red heat into sheets that furnished a sheathing for ships which was more durable, under the corrosive action of salt water, than copper sheathing; whilst it oxidated sufficiently to keep the ship's bottom clean from barnacles and other things that impeded the ship's progress. A patent had been obtained in 1800, by one Collins, for a preparation of sundry materials, to be used chiefly for the preservation of shipping or for marine purposes, the specification of which described, amongst other things, a mixture of 100 parts copper and 80 parts zinc—*i.e.* 55½ per cent. of copper and 44½ per cent. of zinc—which was to be extended into proper form by rolling. The two inventions, on their faces, seemed to be substantially the same, but the following arguments were used to prove a difference. Collins stated that other metallic substances might be added to the alloy of copper and zinc; whereas Muntz alleged that foreign ingredients would destroy the value of his composition. Collins stated that a good composition might be made of 55½ per cent. of copper and 44½ per cent. of zinc; whereas Muntz alleged that 60 per cent. of copper and 40 per cent. of zinc were the precise proportions required to produce the best metal for sheathing, and that a variation of one or two parts of copper or zinc, on one side or the other, made a very material difference in the result. Again, it was alleged on the part of Muntz that, at the time of Collins' invention, neither copper nor zinc existed of the purity required for the successful production of an alloy as suitable as Muntz's for ship-sheathing; and that before his invention it was not possible to obtain a metal which would roll hot or cold, and could at the same time serve for sheathing. The defendants alleged that the sheathing made by them was the result of following the directions of Collins' specification. (As to this part of the case, however,

Lord Lyndhurst, on the hearing of an appeal from an order of *Knight Bruce, V. C.*, said he was satisfied that the object could not be accomplished by uniting ordinary copper and zinc according to Collins' process. The defendants must, therefore, have originally used, not the ordinary, but the purest quality of the two metals, or they must have purified them in the course of the process by some mode not suggested in Collins' specification. In one case the invasion of Muntz's invention was plain and direct; in the other it was colourable and indirect.) Furthermore, witnesses stated that no person could make the compound material by following Collins' directions. The jury found a verdict for the plaintiff, the judge having taken a favourable view of Muntz's case in his address to the jury.

A man may invent improvements on a patented chemical process, by which improvements he may produce a better result in a simpler manner at less cost and with less waste, but, if these are effected by equivalent operations known to be equivalent at the date of the patent, he will be deemed an infringer if he puts them in practice. Thus, in the case of the *Badische Anilin und Soda Fabrik* v. *Levinstein* (2 R. P. C. 81; affirmed by H. of L., 4 R. P. C. 459), an action brought for the infringement of a chemical patent, *Mr. Justice Pearson* said: 'The processes employed by the defendant are processes deserving of great praise, but they are simply processes which produce exactly the same results from the same materials which are produced under the patent. The same object is pursued, the same materials are employed, the same result is obtained. I cannot do otherwise than come to the conclusion that these processes are not an invention differing from the patented one.'

In those cases where the invention consists of the employment of a material composed of several ingredients, and the inventor has stated the most suitable proportions known to him, another person will not be allowed to evade the patent by employing somewhat different proportions. (*Patent Type Founding Company* v. *Richard*, Johns. 381.)

DEALING IN ARTICLES MADE BY INFRINGING A PATENT.

The sale by a dealer of articles made in infringement of a patent is itself an infringement, and it is not necessary for the patentee to prove that the dealer was aware of the articles having been surreptitiously made by a patented process. (*Wright* v. *Hitchcock*, 5 Ex. 37; *Davenport* v. *Rylands*, L. R. 1 Eq. 303.) And this is so whether such articles have been made in this country or have been imported from abroad. (*Walton* v. *Lavater*, 8 C. B. N. S. 162; *Elmslie* v. *Boursier*, L. R. 9 Eq. 217; *Von Heyden* v. *Neustadt*, L. R. 14 Ch. D. 230; *Burnett* v. *Tate*, Q.B., April 27, 1883; *Société Anonyme* v. *Tilghman's Company*, L. R. 25 Ch. D. 1; *United Telephone Company* v. *Sharples*, 2 R. P. C. 31.) This will be so even where the persons importing the patented articles are the licensees under a foreign patent obtained by the same inventor for the same invention as that secured by the British patent. (See the two last cited cases.)

After the plaintiff has given *primâ-facie* evidence of infringement by proving that the patented article was sold by the defendant, he is not bound in ordinary cases to go on to prove that it was not obtained from himself, or from persons to whom he had sold it, or from his licensees. (*Badische Anilin und Soda Fabrik* v. *Dawson*, 6 R. P. C. 395.) The circumstances, however, may be such that the patentee is bound to prove not only the sale, but that the article was not made and sold by himself or his agents. (*Betts* v. *Willmott*, L. R. 6 Ch. 239.) In this case, a patentee having manufactories both in England and on the Continent filed a bill against a druggist to restrain him from infringing his patent for metallic capsules, the infringement consisting of the sale of a bottle of French toilet vinegar having a capsule attached similar to those manufactured under the patent, but the bill was dismissed (and on appeal *Lord Hatherley*, *C.*, upheld the Vice-Chancellor's decision) on the ground that the plaintiff had not shown that he had not himself sold through his house in

Paris the very article the use of which he sought to prohibit. A sale of the article by the patentee in one country would imply a right to use it in another. (See observation of *Cotton, L. J.*, on this case in *Société Anonyme, &c.* v. *Wilghman's &c. Company*, L. R. 25 Ch. D. 1.)

Proof of the sale of an article shown to have been made in the same way as that for which a patent has been obtained, such sale being without the leave, expressed or implied, of the patentee, is *primâ-facie* evidence of an infringement. (*Gibson* v. *Brand*, 1 W. P. C. 630.) But there must be proof that the article was made according to the patented method. Thus, on the trial of an action for an infringement, a candle with a plaited wick, made by the defendant and sold at his manufactory, was produced to the jury as evidence that he had infringed the patent. It was held that, as the patent was not for the candle itself, but for the mode of manufacturing it, the mere production of a candle similar to the plaintiff's was no evidence that it had been made by his patented method. It should have been shown how the candle had been made, seeing that it was quite possible the same result had been produced by a different method. (*Palmer* v. *Wagstaff*, 8 Exch. 840; 9 Exch. 494.)

But in *Huddart* v. *Grimshaw* (1 W. P. C. 91), it was held that the production of pieces of rope having the essential qualities of the patented article was *primâ-facie* evidence of infringement. And in *Hall* v. *Boot* (1 W. P. C. 186), it was held that the sale of an article, which might during manufacture have been improved according to a patented process, coupled with the fact of the necessary machine being in the defendant's possession, was sufficient evidence of infringement. (See also *Davenport* v. *Richards*, 3 L. T. N. S. 504.)

The point whether a mere exposure or offering for sale of a patented article amounts to an infringement, in the absence of proof of actual sale, seems to have been decided differently in the cases of *Minter* v. *Williams* (1 W. P. C. 137) and *Oxley* v. *Holden* (5 C. B. N. S. 667). In *Muntz* v.

Foster (2 Web. P. C. 101), *Tindal, C. J.*, held that the making of ten tons of metal sheathing was an infringement, although no sale was proved.

In *Speckhart* v. *Campbell* ('Times,' March 13, 1884), it was held by the Court of Appeal that the defendant, who was domiciled in Scotland, had committed an infringement in England of the plaintiff's patent by buying in London articles made in infringement of the patent, and advertising them for sale in Scotland; and by sending to a Liverpool firm, in exchange for postage stamps, samples of the article, accompanied by a letter stating the price per gross.

INFRINGEMENT BY USER.

A patentee may not only obtain compensation from a manufacturer who infringes his patent, but he may pursue the infringing articles into the hands of other persons and recover damages in respect of them without regard to what he recovered from the manufacturer. (*Penn* v. *Bibby*, L. R. 3 Eq. 308; *United Telephone Company* v. *Walker*, 4 R. P. C. 67.)

The user in this country of an article made abroad, but which is the subject of a British patent, is illegal, even when such user is merely of a passive nature, and takes place in the course of transit from one foreign country where the articles have been made to another to which they are consigned. (*Betts* v. *Neilson*, 6 N. R. 221, affirmed on appeal, *ibid.* 361; 3 De G. J. & D. 82; L. R. 3 Ch. 431; L. R. 5 H. L. 1.) In this case bottles of beer sent from Scotland protected by capsules made in contravention of an English patent were transshipped in an English port for convenience of exportation to India. It was held, first by *Wood, V. C.*, and afterwards by the Court of Appeal and the House of Lords, that, as the capsules were necessary for the preservation of the beer, there had been a user of the invention in England, and an injunction was granted. But his Honour said he could well conceive a case in which there would be no user in England, as, for instance, foreign tools infringing an English patent, packed up in boxes and

lying inert, or transshipped in course of transit in an English harbour. (6 N. R. 222.) In *Nobel's Explosives Co.* v. *Jones* (L. R. 17 Ch. D. 271), where the object of a patent in regard to a preparation of nitro-glycerine was to render it non-explosive with a view to its safe conveyance from place to place, it was held by *V. C. Bacon* that the transshipment in an English port of a quantity of nitro-glycerine prepared abroad according to the British patent was a user of the invention and an infringement of the patent. The V. C.'s decision was reversed by the H. of L., but on another ground, stated below. See also *Caldwell* v. *Van Vlissengen* (9 Hare, 415, 428), where the user was an active use.

But the doctrine of *Betts* v. *Neilson* will not be extended so as to allow an injunction to issue against persons who merely act as Custom House agents for the importers of the patented articles. (*Nobel's Explosives Co.* v. *Jones*, L. R. 17 Ch. D. 721, affirmed in H. L. 8 App. Cas. 5.)

A user of infringing articles by the pupils of the purchaser of the articles renders him liable for an infringement. (*United Telephone Company* v. *Sharples*, 2 R. P. C. 28.)

The possession of articles made in infringement of a patent is sometimes enough to afford ground for an injunction without proving user, if the circumstances are such as to show that user is intended. An injunction was granted by *V. C. Bacon* against the master of a ship, restraining him from using certain pumps constructed according to the plaintiff's patented invention and placed on board the vessel. The validity of the patent and the fact of infringement by the manufacturers of the pumps were established, but actual user of the pumps was not proved. The master, however, acted with the makers in asserting his right to use the pumps as against the patentee. It was held on appeal that the injunction was properly granted. (*Adair* v. *Young*, L. R. 12 Ch. D. 13.) And see *United Telephone Company* v. *London & Globe Telephone Company* (L. R. 26 Ch. D. 766; 1 R. P. C. 117).

But where the user of the infringing machines, which still remained in the possession of the defendants, who admitted the validity of the patent, took place only for a short time, four years before the action was brought, and there was no evidence of an intention to repeat the infringement, it was held that an injunction ought to be refused. (*Proctor* v. *Bennis*, C. of Appeal, 6 R. P. C. 538.)

On the general question of infringement by user see *The Universities of Oxford and Cambridge* v. *Richardson* (6 Ves. 689); *Minter* v. *Williams* (1 W. P. C. 137).

AGENTS.

Where an infringement is committed through an agent both employer and agent are liable; it being no justification for the agent to allege that he did the acts complained of by the order of his principal. (*Gibson* v. *Brand*, 4 M. & G. 179; *Betts* v. *De Vitre*, 11 Jur. N. S. 9; *Sykes* v. *Howarth*, L. R. 12 Ch. D. 833; *Spencer* v. *Ancoats Vale Rubber Co.*, 6 R. P. C. 46.)

CARRIERS.

Steamship carriers may be restrained by interim injunction from importing or exporting goods alleged to have been made in infringement of a patent and from parting with the possession of them, when the validity of the patent has been proved in an action against another person. In these cases the goods had been manufactured abroad and there had been no user, passive or otherwise, of the goods on board the ships. (*Washburn, &c., Co.* v. *Cunard Co.* and *Washburn, &c., Co.* v. *Dublin and Liverpool, &c., Co.* 6 R. P. C. 398.)

FOREIGN VESSELS.

By the forty-third section subs. (1) of the Patents Act of 1883, the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of Her Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, shall not be deemed an infringement of any

British patent obtained for such invention, unless it is used for the manufacture or preparation of something intended to be sold in or exported from the United Kingdom or Isle of Man. But by subs. (2) the first subsection is not to extend to vessels of any foreign state which does not show similar indulgence to British vessels under like circumstances.

Any case not coming under the protection afforded by the first subsection will be governed by the decision in *Caldwell* v. *Van Vlissengen* (9 Hare, 415), where an injunction was obtained to restrain the use on board of a Dutch vessel within British waters of certain propelling apparatus made according to a British patent.

THE CROWN.

It was decided in the case of *Feather* v. *The Queen* (6 B. & S. 257) that, as all grants made by the Crown must be construed favourably to the grantor and adversely to the grantee, there was nothing in the ordinary form of Letters Patent in use up to January 1, 1884, to debar the Crown from using the invention comprised therein, and consequently that the Crown had a right, either by itself or by its officers, agents, or servants, to exercise such invention and manufacture the patented object without paying royalties or compensation.

However, in *Dixon* v. *The London Small Arms Company* (L. R. 1 App. Ca. 632), where a manufacturing company had entered into a contract with the Government for the supply of a patented article for the public service at a fixed price, and in pursuance thereof had manufactured the article without the patentee's licence, and delivered the same and received payment, it was held by the House of Lords that the manufacturers were not in the position of servants or agents of the Crown, although they had received an indemnity from the Government against the claims of the patentee; and, therefore, that they were not entitled to the privilege of the Crown against a patentee, but were liable

to an action for an infringement of the patent. See also *Vavasseur* v. *Krupp* (L. R. 9 Ch. D. 351).

The case of *Feather* v. *The Queen* will still apply to patents granted before the commencement of the Patents Act of 1883 or on applications then pending (sect. 45), but by the twenty-seventh section of that Act a patent granted on an application made after the commencement of that Act shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject. But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

CASES OF NON-INFRINGEMENT.

It has been sufficiently shown on previous pages that when a patentee is limited to the particular combination described in his specification another person may lawfully effect the same object by employing different means. In such cases another method of attaining the same end is not an infringement.

To construct a patented machine simply as an amusement or as a model is not an infringement of the patent (*Jones* v. *Pearce*, 1 W. P. C. 125); nor is the making of the patented article for the purpose of *bonâ-fide* experiment (*Frearson* v. *Loe*, L. R. 9 Ch. D. 48); and if a person makes use of a patented process and obtains the product, not for the purpose of commercial profit, he is not guilty of infringing the patent. Thus Higgs obtained a patent for a process of precipitating, by means of hydrate of lime, the animal and vegetable matters suspended in sewage water, with a view to their use as manures. Goodwin employed the same process, but solely for the purpose of

purifying the sewage water, and he derived no profit from the product. It was held that the patent was not infringed. (*Higgs* v. *Goodwin*, E. B. & E. 529.)

It has been decided that the application of a new and material part of an arrangement to a purpose *different* from that to which it is applied in the patented combination does not infringe the patent. (*Lister* v. *Eastwood*, 9 L. T. N. S. 766; *McCormick* v. *Gray*, 7 H. & N. 25; *Newton* v. *Vaucher*, 6 Exch. Rep. 859; *Fletcher* v. *Glasgow Gas Commissioners* 4 R. P. C. 386.)

In *Newall* v. *Elliott* (10 Jur. N. S. 954; *S. C.* 13 W. R. 11), a patent for an invention of improvements in apparatus employed in laying down submarine telegraph cables, which consisted of an internal cone placed in the eye of the coil of cable, an external cylinder round the coil, and rings suspended over it, was held not to have been infringed by an apparatus in which the cable was coiled round a cylinder and prevented from slipping by means of a cylinder placed outside, it being found that this had been done before for the purpose of safe carriage, and there being no evidence that the defendants used their apparatus for any other purpose.

The mere publication of a specification is not an infringement of a prior patent. It is the use of the earlier invention that constitutes the infringement. 'Where the invention is the mode of working or the mode of manufacturing an engine, there is no infringement until another engine is worked or made in the same way. Upon the question of infringement, the specification of the defendant (the alleged infringer) is of very little importance.' Per *L. J. Brett*, in *Otto* v. *Linford* (46 L. T. N. S. 35).

The application of a natural mineral substance to effect a given purpose is not an infringement of a patent obtained for the application to the same purpose of an artificial substance having the same chemical constitution. A patent was obtained for a process of purifying coal gas by means of hydrated oxide of iron, and the method of obtaining that material artificially was described in the specification. The use for the same purpose of a natural substance called

bog ochre, containing oxide of iron, was held not to be an infringement of the patent. The specification also described and claimed a mode of revivifying the artificial oxide for subsequent use in the same way. *Lord Westbury, C.*, granted an injunction to restrain the user of the natural substance after it had been revivified by the process described in the patent. (*Hills* v. *Liverpool Gas Light Company*, 9 Jur. N. S. 140.)

It is not an infringement of a patent to sell chemical substances, knowing that the buyer intends to use them in infringing the patent. Nor is it an infringement for the seller, in consideration of the purchase, to indemnify the buyer against proceedings by the patentee, if the patent is disputed or likely to be so. If buyer and seller know the patent to be valid, an agreement for indemnity would be void as being against public policy, and the seller would not be guilty of infringement. (*Townsend* v. *Haworth*, L. R. 12 Ch. D. 826 *n.*, affirmed by the Court of Appeal. Appendix to Higgins's *Digest of P. C.*, 1880, p. 60. And see *Sykes* v. *Howarth*, L. R. 14 Ch. D. 833.)

A patent for the United Kingdom will not be infringed by acts done on board a British vessel at Malta or on the high seas. (*Newall* v. *Elliott*, 4 N. R. 429.)

Where a foreign sovereign had bought abroad articles made in infringement of a British patent, and they were brought to England to be placed on board a ship of war belonging to the foreign sovereign, it was held that, as the Court had no jurisdiction to interfere with the property of a foreign sovereign, it could not prevent him from removing the articles in question. (*Varassear* v. *Krupp*, L. R. 9 Ch. D. 351.)

INTENTION OF INFRINGER NOT MATERIAL.

In determining the question of infringement, the *intention* of the infringer is immaterial; if he violate the patentee's rights he renders himself liable to make compensation, although he acted in ignorance. In the case of *Stead* v. *Anderson* (2 W. P. C. 156), *Wilde, C. J.*, when

delivering the judgment of the Court of Common Pleas, said that, 'in the action of *Heath* v. *Unwin*, the Court of Exchequer seems to have deemed it material to consider the intention of the defendant in determining whether he had infringed a patent. But in that case the evidence negatived any such intention, and the other circumstances of the case were not such as to show an infringement; so that there was no evidence as to what the effect of such intention would be, and we think it clear that the action is maintainable in respect of what the defendant does, not what he intends.' And *Shadwell, V. C.*, said, in *Heath* v. *Unwin* (15 Sim. 553): 'I am at a loss to see how the want of intention can be any answer where the act complained of is an injury. The party complaining of the act is not the less prejudiced by it because it was committed unintentionally, and my opinion is that if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury) he is answerable for the consequences.'

In a subsequent stage of the case of *Heath* v. *Unwin*, it was admitted by *Mr. Baron Parke* that the Court of Exchequer had been in error when it took the intention of the alleged infringer into consideration, adding, 'There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself.' (25 L. J. C. P. 19). See also *Wright* v. *Hitchcock* (L. R. 5 Exch. 37); *Davenport* v. *Rylands* (L. R. 1 Ch. D. 303); and *Young & Neilson* v. *Rosenthal* (1 R. P. C. 39).

Nor can a master of workmen protect himself by alleging that the infringement was committed by them against his orders. (*Betts* v. *De Vitre*, 3 Ch. D. 430.) But where a retail dealer had, in ignorance of the plaintiff's rights, sold to an agent of the plaintiff an article made in infringement of the patent, and the article itself showed from whom its vendor had bought it, and the Court was satisfied that the infringement was innocent, accidental, and trivial,

and not such as to have produced any substantial damage to the plaintiff, *James*, *V. C.*, dismissed a bill for an injunction. (*Betts* v. *Willmott*, 18 W. R. 946.) The case went afterwards on appeal before *Lord Hatherley*, *C.*, who affirmed the decision, but upon other grounds. (L. R. 6 Ch. 239.) See also *Upmann* v. *Elkan* (L. R. 12 Ch. 145).

CHAPTER XVIII.

THE PRACTICE IN ACTIONS FOR INFRINGEMENTS.

SINCE the Judicature Acts of 1873 and 1875 have abolished the distinction between the Courts of Law and Equity, every question of law and fact, or mixed law and fact, arising in any action is now determined wholly in that division of the High Court of Justice in which the action is brought, subject to certain powers of transfer of the action from one division to another, and subject also to the further qualification that trials by jury cannot be had before a judge of the Chancery Division. (*Warner* v. *Murdoch*, L. R. 4 Ch. D. 750.)

The thirteenth section of the Act of 1883 directs that no proceeding shall be taken in respect of an infringement committed before the publication of the complete specification. And the fifteenth section provides that an applicant shall not be entitled to institute any proceedings for infringement until a patent has been granted to him.

'A plaintiff is not bound before commencing proceedings to apply to the defendant and ascertain whether he will without suit do what is required (*Upmann* v. *Elkan*, L. R. 12 Eq. 146). . . . Nor is a plaintiff compelled to rely on the promise of the offending party not to infringe again, but he is entitled to the protection of an injunction'[1] (*Geary* v. *Norton*, 1 De G. & Sm. 9; *Losh* v. *Hague*, 1 W. P. C. 200.)

Interlocutory Injunctions.—It has always been the practice of the Court of Chancery, when the plaintiff can make

[1] W. N. Lawson: Patents Designs and Trademarks Acts, 2nd ed., p. 109. In this work will be found carefully collected and arranged all the cases bearing on legal proceedings in patent actions.

out a proper case, to grant an interlocutory injunction, that is, an injunction before the trial of the action, without requiring the patent to be established. 'The principle on which the Court acts,' said *Lord Eldon*, in *Hill* v. *Thompson* (3 Mer. 622), 'in cases of this description is the following:—Where a patent has been granted, and an exclusive possession of some duration under it, the Court will interpose its injunction, without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and, upon an application being made for an injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a court of law, before it will grant him the benefit of an injunction.' And, again, in *Dudgeon* v. *Thomson* (30 L. T. N. S. 244), *Sir George Jessel, M. R.*, said, 'The Court can grant an injunction before the hearing when the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or when its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or when the conduct of the defendant is such as to enable the Court to say that as against the defendant himself there is no reason to doubt the validity of the patent.' (See also *Renard* v. *Levinstein*, 10 L. T. N. S. 94, affirmed on appeal, *ibid.* p. 177; *Betts* v. *Menzies*, 3 Jur. N. S. 357; *Clark* v. *Ferguson*, 5 Jur. N. S. 1155; *Briggs* v. *Lardeur*, 1 R. P. C, 126; *United Telephone Co.* v. *St. George*, 3 R. P. C. 33.)

When it can be shown that the patentee has had undisturbed possession for many years the Court will grant an interlocutory injunction without requiring the patent to be established, notwithstanding doubts may exist as to its validity. (*Losh* v. *Hague*, 1 W. P. C. 201; *Muntz* v. *Foster*,

2 W. P. C. 93, 95; *Betts* v. *Menzies*, 3 Jur. N. S. 357; *Briggs* v. *Lardeur*, 1 R. P. C. 126.) But in order to establish a right to an interlocutory injunction on this ground, the patentee must show actual public user of the invention (*Plimpton* v. *Malcolmson*, L. R. 20 Eq. 37), unfettered by the necessity of obtaining the licence of any prior patentee. (*Heugh* v. *Magill*, W. N. 1877, 62.) Where the patent has been the subject of several suits, all of which have terminated in favour of the patentee, an interlocutory injunction will be granted, notwithstanding a fresh fact is brought forward tending to impeach the novelty of the invention (*Newall* v. *Wilson*, 2 De G. M. & G. 282; *Davenport* v. *Jepson*, 4 De G. F. & J. 440), or the defendant offers to keep an account. (*Renard* v. *Levinstein*, 2 H. & M. 628.) And the fact that the validity of the patent has been established in Scotland is sufficient *primâ-facie* evidence to warrant the granting an interlocutory injunction in England. (*Dudgeon* v. *Thomson*, 30 L. T. N. S. 244.)

If the plaintiff has shown negligence in prosecuting his rights, even though his patent has been established against another defendant, an interim injunction will be refused. (*Bridson* v. *Renecke*, 12 Bea. 1; *Bovill* v. *Crate*, L. R. 1 Eq. 388.) But delay in taking proceedings may be explained to the satisfaction of the Court, and an injunction granted. (*United Telephone Co.* v. *Equitable Telephone Association*, 5 R. P. C. 233.) If the fact of infringement is matter of doubt, an injunction will be refused until after a trial, and even then if there is ground for supposing that a new trial will be obtained. (*Collard* v. *Allison*, 4 My. & Cr. 487; *Electric Telegraph Co.* v. *Nott*,[1] 2 Coop. C. C. 41, and the other cases collected by the reporter.) In almost all cases,

[1] In this case *Lord Cottenham, C.*, said that the Court will not grant an injunction where the legal right is disputed, unless it is satisfied that the legal right will eventually be established; nor where the legal right is disputed unless satisfied that the acts complained of are a violation of it. Where, however, the sole question is the validity of the patent, and there has been exclusive enjoyment under it for a reasonable time, the Court will interpose, by injunction, until the invalidity has been established; but the injunction will be refused if there is conflicting evidence as to the infringement.

however, the Court thinks it right, when it postpones the consideration of the injunction, to order the defendant to keep an account until the plaintiff has had an opportunity of testing the validity of his patent. But if the interlocutory injunction be granted, the Court always requires from the plaintiff an undertaking to abide by any order the Court may make as to damages in case it should ultimately be of opinion that the defendant has sustained any by the injunction which the plaintiff ought to pay. (*Wakefield* v. *Duke of Buccleuch*, 11 Jur. N. S. 523; *United Telephone Co.* v. *Equitable Telephone Association*, 5 R. P. C. 233.)

For further statements of the general principles on which the Court acts in granting or withholding interlocutory injunctions, see *Bacon* v. *Jones* (4 My. & Cr. 434); *Bridson* v. *McAlpine* (8 Bea. 229); *Davenport* v. *Jepson* (4 De G. F. & J, 440); *Plimpton* v. *Spiller* (L. R. 4 Ch. D. 286); *Thomson* v. *Hughes* (7 R. P. C. 71).

The Court, however, being now empowered to try the validity of the patent, and having the control of the proceedings, and being, consequently, able to prevent any undue delay, is less disposed than formerly to grant an interlocutory injunction, especially when the patent is new, but will generally content itself with giving directions to insure an immediate trial of the questions at issue between the parties, and order the motion for the injunction to stand to the hearing of the cause, adding, when necessary, a direction for the defendant to keep an account. The action may then proceed to trial in the ordinary way. (See the remarks of *Sir George Jessel, M. R.*, in *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 37. See also *Lister* v. *Norton*, 1 R. P. C. 114; *Jackson* v. *Needle*, 1 R. P. C. 174.)

But in a case where the patent was only six years old (*Rothwell* v. *King*, 3 R. P. C. 379), and in another where the patent was only two years old (*Coles* v. *Baylis*, 3 R. P. C. 178), injunctions were granted. In the latter case, however, the circumstances were very special.

It is a rule of the Court not to interfere until the patentee's rights have been actually violated. But where

a defendant alleges an intention and claims the right to infringe, the Court will grant an injunction, although no actual infringement may have taken place. (*Frearson* v. *Loe*, L. R. 9 Ch. D. 48; *Adair* v. *Young*, L. R. 12 Ch. D. 13.)

The case of *Crossley* v. *Beverley* (1 W. P. C. 119) shows how far the Court will go in aiding a patentee to repress infringements. It appeared that the defendants had been secretly manufacturing gas-meters, which were copies of those protected by the plaintiff's patent, their object being to pour them into the market as soon as the patent expired. A few days before the expiration of the patent, the plaintiff, having discovered what had been done, filed his bill, and obtained an injunction to restrain the using of the articles so made even after the patent expired.

Concurrent Actions against several Infringers.—When a plaintiff commences several actions at one time against separate infringers, the Court will, on the application of the several defendants, order the validity of the patent and other questions common to all the cases to be tried in one of the actions, and will in the meantime stay proceedings in the other actions; but this order will not be made until the defendants have given full discovery of the machines used by them and alleged to be infringements. (*Foxwell* v. *Webster*, 2 Dr. & Sm. 250; *S. C.* on appeal, 10 Jur. N. S, 137.)[1]

But the plaintiff is not bound by the result of the trial if it goes against him, and he may proceed against any of the other infringers, unless prevented by the order of the Court.

Issues.—It is open to either party, at any stage of the action, to move that issues may be settled, raising the various questions of fact in the cause. In a patent case the issues usually are, whether the invention is new, whether it is useful, whether it was a new manufacture,

[1] It was said by *Wood, V. C.*, in the case of *Bovill* v. *Crate* (L. R. 1 Eq. 388), that when the infringers are very numerous, the proper course for a plaintiff to pursue before filing separate bills against the infringers is to select one as a defendant, and write to the others, and ask if they object to be bound by the proceedings against that one, and have the case tried once for all.

whether the patentee was the true and first inventor, whether the specification is sufficient, and whether the defendant has infringed; but, of course, these may be varied as circumstances require. Since the Judicature Acts, however, the practice appears to be not to apply for issues, but to let the action come on for trial generally, upon the pleadings, particulars of breaches, and objections.

It is not a matter of course for the Court to grant issues, and they are sometimes refused. (*Davenport* v. *Goldberg*, 2 H. & M. 282; *Davenport* v. *Phillips*, 5 N. R. 485; *Borill* v. *Goodier*, Law Rep. 1 Eq. 36.) The Court will at any time during the progress of a suit allow the defendant to raise a fresh issue on the discovery of facts which could not with due diligence have been previously discovered. (*Holste* v. *Robertson*, L. R. 4 Ch. D. 9.)

Sometimes one of the parties in an action moves for an order that certain issues of fact should be tried before the other issues. In the *United Telephone Co.* v. *Mottishead* (3 R. P. C. 213), on the defendants admitting that the plaintiff's patent was valid, the Court directed the trial by itself of an issue whether the defendants had infringed.

Inspection of Machines and Processes.—In an action for infringement of a patent, the Court or a judge may, under the thirtieth section of the Patents Act of 1883, and 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.

The following cases were decided under the old law with reference to an inspection of the processes used or the articles made by the defendant in alleged violation of the rights of the plaintiff:—*Borill* v. *Moore* (2 Coop. C. C. 56); *Brown* v. *Moore* (3 Bligh, 180); *Morgan* v. *Seward* (1 W. P. C. 169). In the case of *The Patent Type Founding Company* v. *Walter* (Johns. 727), the defendant, a printer, who used types alleged to be made in colourable imitation of the type patented by the plaintiffs, was on motion ordered by *Wood*,

V. C., to deliver a sample of type to the plaintiffs for analysis, although a similar application had been refused by the Court of Exchequer in *The Patent Type Founding Company* v. *Lloyd* (5 H. & N. 192). However, by Order L., Rule 3, of the Supreme Court Rules 1883, the Court or a judge is empowered in any cause or matter to authorise any samples to be taken, or any observation to be made, or experiment to be tried, which may seem necessary or expedient for the purpose of obtaining full information or evidence.

Inspection will not be granted unless the Court is satisfied that there is really a case to be tried at the trial, and that inspection is essential to enable the plaintiff to prove his case. (*Piggott* v. *Anglo-American Telegraph Company*, 91 L. T. N. S. 46; *Batley* v. *Kynock*, L. R. 19 Eq. 90.)

An order for inspection was refused when the evidence of infringement only amounted to suspicion, and the grounds thereof were not stated. (*Germ Milling Co.* v. *Robinson*, 1 R. P. C. 217. And see *Cheetham* v. *Oldham*, 5 R. P. C. 617.)

The plaintiffs sued for an infringement of a patent for the manufacture of meal and flour, and obtained an order for an inspection of the process used by the defendant, who afterwards moved for leave to inspect the plaintiff's process and take samples. This was ordered. (*Germ Milling Co.* v. *Robinson*, 3 R. P. C. 11. And see *Cheetham* v. *Oldham*, No. 2, 5 R. P. C. 622.)

Where, in a suit for an injunction to restrain the infringement of a patent for a sewing machine, an application was made for an inspection of *all* the machines of every kind on the defendant's premises, the Court declined to make the order in the terms asked for, but directed the defendant to verify on affidavit the several kinds of sewing machines which he had sold or exposed for sale since the date of the plaintiff's last disclaimer, and to produce at his solicitor's office one of each class for inspection by the plaintiff's solicitor and two of their scientific witnesses. (*Singer Manufacturing Co.* v. *Wilson*, 13 W. R. 560; *S. C.*

5 N. R. 505. And see *Drake* v. *Muntz's Metal Co.*, 3 R. P. C. 43.)

A licensee who is not a party to the action cannot be compelled to give inspection in an action against his licensor. (*Germ Milling Co.* v. *Robinson*, 3 R. P. C. 14.)

Particulars of Breaches.—By the Patents Act of 1883, sect. 29, the plaintiff in an action for infringement of a patent 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. The particulars may be from time to time amended by leave of the Court or a judge.

If the particulars delivered are insufficient, further and better particulars may be required. In *Needham* v. *Oxley* (1 H. & M. 248), it was held by *Wood, V. C.*, that particulars of breaches are sufficient if, *taken together with the pleadings*, they give the defendant full and fair notice of the case made against him. See, however, the subsequent case of *Curtis* v. *Platt* (8 L. T. 657), before the same learned judge.

A plaintiff may be ordered to point out by reference to the pages and lines the parts of his specification which he alleges to be infringed. (*Lamb* v. *The Nottingham Manufacturers' Company*, Seton on Decrees, 4th ed. p. 349.) But this will not be required when the things alleged to be an infringement have been made an exhibit in the action. (*Batley* v. *Kynock*, No. 2, L. R. 19 Eq. 229.) Or when the particulars of breaches and the claims in the specification alleged to have been infringed sufficiently enable the defendant to know what he will have to meet at the trial. (*Cheetham* v. *Oldham*, No. 3, 5 R. P. C. 624.)

An application by a plaintiff for leave to amend his particulars of breaches may be made to the Court or a judge under sect. 29 (5) of the Act of 1883. An application by either party for an order for further and better particulars of breaches or objections may be made under R. S. C., O. XIX. r. 7.

Other cases bearing upon the amendment of particulars of breaches are *Flower* v. *Lloyd* (20 S. J. 860); *Church*

Engineering Company v. *Wilson* (3 R. P. C. 123); *United Telephone Company* v. *Fleming* (3 R. P. C. 268); *Cheetham* v. *Oldham*, No. 3 (5 R. P. C. 624).

Cases as to further particulars of breaches: *Elsey* v. *Butler* (1 R. P. C. 189); *Tilghman's &c. Co.* v. *Wright* (1 R. P. C. 103); *Russell* v. *Hatfield* (2 R. P. C. 144); *Moseley* v. *Victoria Rubber Co.* (3 R. P. C. 351); *Haslam Co.* v. *Hall* (4 R. P. C. 203); *Ehrlich* v. *Ihlee* (5 R. P. C. 37).

Particulars of Objections.—The twenty-ninth section of the Patents Act of 1883, subsections 2 and 3, requires the defendant to 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; and 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 these grounds is want of novelty, he must state the time and place of the previous publication or user alleged by him. And subsection 5 enables the defendant to amend such particulars from time to time by leave of the Court or judge.[1]

If a defendant relies as an objection to a patent on general public knowledge of the invention before the date of the patent, he should not mention in his particulars of objection the several books or publications which he takes to be

[1] Upon the corresponding section (41) of the Patents Act of 1852 the following cases have been reported:—*Penn* v. *Bibby* (L. R. 1 Eq. 548); *Grover & Baker Company* v. *Wilson* (W. N. 1870, p. 78); *Flower* v. *Lloyd* (L. R. 6 Ch. D. 297); *Crossley* v. *Tomey* (L. R. 2 Ch. D. 533); *Plimpton* v. *Spiller* (20 S. J. 859); *Morgan* v. *Fuller*, No. 2 (L. R. 2 Eq. 297).

It has been held that the objections cannot go beyond the pleas; they are merely to state more particularly what the pleas state generally. (*Macnamara* v. *Hulse*, 2 W. P. C. 128.) As to other points bearing upon this subject see *Palmer* v. *Wagstaff* (8 Exch. Rep. 840); *Palmer* v. *Cooper* (9 Exch. Rep. 231); *Hull* v. *Bollard* (1 H. & N. 134); *Lister* v. *Leather* (3 Jur. N. S. 816); *Greaves* v. *Eastern Counties Railway Company* (1 Ell. & Ell. 961; *S. C.* 5 Jur. N. S. 733); *Talbot* v. *Laroche* (15 C. B. 310); *Electric Telegraph Company* v. *Nott* (4 C. B. 462): *Fisher* v. *Dewick* (1 W. P. C. 551 *n.*); *Heath* v. *Unwin* (1 W. P. C. 551); *Jones* v. *Berger* (1 W. P. C. 544 *n.*); *Houchill Company* v. *Neilson* (1 W. P. C. 552); *Holland* v. *Fox* (1 C. L. R. 440).

proofs of that knowledge, or which gave to the public the means of acquiring it. General public knowledge must be proved by witnesses in the ordinary way at the trial, and they may refer if necessary to well-known books. In the meantime he may be required to strike out of his particulars those publications which go to prove public knowledge only. On the other hand, if a defendant relies on any publications as *anticipations* of the invention, he must state in his particulars the nature of the anticipation on which he relies, and what those publications are and where they are to be found; and must indicate that he relies on them as anticipations, and not as showing the state of public knowledge. In the case of a specification that part of the claim on which he relies should be shown. Generally speaking, he need not state particular pages of the books or specifications, unless the matter would be doubtful without that information. (*Holliday* v. *Heppenstall*, in the Court of Appeal, L. R. 41 Ch. D. 109; 6 R. P. C. 320.)

Previous to this enunciation of the practice a defendant had been ordered to give the pages and lines of the specifications and books to which he referred as anticipating the plaintiff's invention, and to state which of the claims in the plaintiff's specification had been anticipated by the prior specifications. (*London and Leicester Hosiery Company* v. *Higham*, Lawson's Patents Acts, 2nd ed. p. 498; see also *Harris* v. *Rothwell*, 1 Griff. P. C. 110.)

And another defendant, in referring to a book on which he relied as anticipating the plaintiff's invention, was ordered to refer to specified parts thereof, and where there were words in the particulars denoting reliance upon the whole of the various earlier specifications, they were directed to be struck out, leaving him at liberty to refer to pages and lines. (*Harris* v. *Rothwell*, 3 R. P. C. 243. And see *Fowler* v. *Gaul*, 3 R. P. C. 247.) However, it has not been unusual in practice to refer to the whole specification, and if there was no special complication this was not often objected to.

When objection is made in general words to a discon-

formity between the provisional and the complete specifications, an order for better particulars may be obtained. (*Anglo-American Brush Electric Light Corporation* v. *Crompton*, 4 R. P. C. 27.)

Under an objection that the invention is not new the defendant may show the want of novelty of one of two inventions described in the specification. (*Sugg* v. *Silber*, L. R. 2 Q. B. D. 493.)

As to the terms on which leave to amend particulars of objection are granted under special circumstances, see *Otto* v. *Steel* (2 R. P. C. 139); *Ehrlich* v. *Ihlee* (4 R. P. C. 115). Here the form of the order as to costs, where the defendant applied to amend his particulars of objection after the case had been set down for hearing, was considered. *Parker* v. *Maignen's Filtre Rapide Co.* (5 R. P. C. 207). In this case the application to amend the particulars was made on the eve of trial. *Blakey* v. *Latham* (6 R. P. C. 29); *S. C.* on appeal (6 R. P. C. 184). In this case leave to amend was granted during the trial, which was adjourned.

Other cases bearing upon the amendment of particulars of objection are *Boyd* v. *Horrocks* (3 R. P. C. 285); *Boyd* v. *Horrocks* (5 R. P. C. 557); *Parcall* v. *Toope* (7 R. P. C. 125).

The following cases were decided under the old law with reference to the amendment by the defendant of his particulars of objection:—*Penn* v. *Bibby* (L. R. 1 Eq. 548); *Wilson* v. *Gann* (23 W. R. 546); *Renard* v. *Levinstein* (13 W. R. 229; 11 L. T. N. S. 505); *Daw* v. *Eley* (L. R. 1 Eq. 38); *Edison Telephone Co.* v. *India-rubber Co.* (17 Ch. D. 137).

Interrogatories.—In a suit for an injunction a defendant denying infringement may be compelled to answer whether he used the plaintiff's materials, whether he makes any addition to them, and whether such addition makes any difference. (*Renard* v. *Levinstein*, 10 L. T. N. S. 94.) As to the limits of such discovery see *Crossley* v. *Tomey* (2 C. L. D. 53); *Crossley* v. *Stewart* (1 N. R. 426); *Rolls* v. *Isaacs* (W. N. 1878, 36); *Lister* v. *Norton* (2 R. P. C. 68); *Moseley* v. *Victoria Rubber Co.* (3 R. P. C. 351). As to the

discovery which a defendant in such a suit may obtain from the plaintiff as to his patent, see *Renard* v. *Levinstein* (11 L. T. N. S. 79); *Hoffman* v. *Postill* (L. R. 4 Ch. 673); *Germ Milling Co.* v. *Robinson* (3 R. P. C. 11); *Edison & Swan Co.* v. *Holland* (5 R. P. C. 213); *Ehrlich* v. *Ihlee* (5 R. P. C. 37).

A plaintiff may be interrogated as to documents in his possession relating to the preparation of his specification. (*Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 351.)

A defendant who has furnished particulars literally in compliance with the statute may be called upon to answer interrogatories as to the names and addresses of alleged prior users, and whether the machines are in existence. (*Birch* v. *Mather*, L. R. 22 Ch. D. 629.)

Order for Production of Models Refused.—In an action for the infringement of a patent for improvements in presses for pressing tiles, the plaintiff, after the delivery of particulars of objection, applied to a judge at chambers for an order for the production by the defendant to the plaintiff, before the trial, of all dies, models, and drawings of dies intended to be produced by the witnesses on behalf of the defendants at the hearing of the action. The judge held that as the articles called for were not shown to be in the possession or power of the defendants, he had no jurisdiction to make such an order, and the Court of Appeal held that he did rightly. (*Garrard* v. *Edge*, 6 R. P. C. 372.)

Inspection of Documents.—Communications between an inventor and his patent agent are not privileged, and therefore, where the patent agent of a party to an action for infringement is also his solicitor, the other party can claim to see the communications made to the solicitor in his capacity of patent agent, if there is otherwise no valid objection to the disclosure. (*Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 351.) In this case it was held that the defendants were entitled to inspect any communications between the plaintiff and his patent agent bearing upon the preparation of his specification under a patent for an invention which was closely connected with the invention under an earlier

patent obtained by the plaintiff and alleged to be infringed by the defendants.

The defendants in an action for the infringement of a patent belonging to persons who previously to their becoming the owners of it had in various proceedings disputed or made preparations for disputing its validity applied to the Court for an order for the inspection of certain documents relating to those proceedings. It was held by a Divisional Court that the defendants were entitled to have inspection of all except such as the plaintiffs should state on oath had come into existence merely to be communicated to the solicitor for the purpose of litigation actual or intended, and either as materials for briefs or for his advice and consideration. (*Haslam Co.* v. *Hall*, 5 R. P. C. 1.)

Litigation had taken place between two companies with regard to the validity of a patent belonging to one of them. They afterwards amalgamated and the new company brought an action for infringement against H. It was held by the Court of Appeal that H. was entitled to administer an interrogatory as to the particulars of objections delivered in the previous action between the two companies. (*Edison & Swan Co.* v. *Holland*, 5 R. P. C. 213.) In this case (p. 216), the practice with regard to applications for leave to administer interrogatories having reference to documents supposed to be in the possession of the opposite party, who has already given discovery, is stated.

Where it seems probable from a document produced by one of the litigating parties that he has in his possession other relevant documents, he may be called upon to make a further affidavit in regard to those supposed documents. (*Bown* v. *Samsom*, 5 R. P. C. 515.)

The Trial.—Under the twenty-eighth section of the Act of 1883 the action is to be tried without a jury unless the Court shall otherwise direct. Trials of patent cases have very seldom taken place before juries since the Act came into operation.

By the Arbitration Act 1889 (52 & 53 Vict. c. 49 s. 14) repealing and re-enacting with slight variations the fifty-

seventh section of the Judicature Act of 1873, the judge before whom a case requiring 'scientific investigation' comes for trial is empowered to send the issues of fact to be tried before a referee. Where a patent case had been so sent for trial before an official referee, it was contended by the plaintiff in the Court of Appeal that the case was not one that required 'scientific investigation' within the meaning of the Judicature Act, but it was held to be impossible for that Court to say that an action for the infringement of a patent did not require scientific investigation; and that, as the judge had decided that it did, the Court would not interfere with his discretion. (*Saxby* v. *Gloucester Waggon Co.*, W. N. 1880, p. 28.)

The referee will make a report as to the issues of fact which were sent to him for trial, and his findings so reported are to be considered equivalent to the finding of a jury.

On the trial of an action for the infringement of a patent the Court has power, under the Arbitration Act 1889, repealing and re-enacting with variations sect. 56 of the Judicature Act of 1873, to order without the consent of the parties that a competent person should ascertain facts or make experiments, and report the result of his inquiry for the information and guidance of the Court. (See *Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R. 24 Ch. Div. 156; *Mellin* v. *Monico*, L. R. 3 C. P. D. 142; *Edison & Swan Co.* v. *Holland*, 5 R. P. C. 459.) The Court of Appeal sometimes thinks fit to exercise this power. (*Moore* v. *Bennett*, 1 R. P. C. 129.)

By the twenty-eighth section of the Act of 1883 it is enacted that, in an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance. Under the third subsection of the same section the remuneration, if any, to be paid to such assessor shall be determined by the Court and be paid in the same manner as the other expenses of the execution of the Act.

By the nineteenth section of the Act of 1883 the judge is empowered, in an action for infringement or in a proceeding for revocation, to give liberty to the patentee to apply at the Patent Office for leave to amend his specification, and to postpone the trial. (See the chapter on Amendments.)

As to the trial of causes and issues, see Order XXXVI. Rule 5 and Rule 7 (*a*) of the Supreme Court Rules, 1883.

The defendant in an action for the infringement of a patent for a chemical process set up by his defence that he had a secret process which was not an infringement. The judge, seeing that irreparable mischief would be done to him if he were called upon to state in open Court what that secret process was, in case it should turn out that the patent was bad, allowed him not to answer certain questions which were put to him, but left him to determine for himself whether he would or not communicate his secret process to the Court, so that the Court might be able to determine whether he infringed the patent or not. The defendant, acting on the advice of his counsel, elected before the termination of the case to disclose his secret to the judge, who heard his description of it with closed doors, no persons being present except the parties and their scientific assistants. (*Badische Anilin und Soda Fabrik* v. *Levinstein*, L. R. 24 Ch. D. 156.) See also *Edison* v. *Woodhouse* (3 R. P. C. 172).

A model which has not been put in evidence may be handed up to the Court as an example of a class of machine, in order to explain counsel's argument. (*Boyd* v. *Horrocks*, Appeal, 6 R. P. C. 154.)

Where a judge at the trial of an action is of opinion that the invention under the patent is good subject-matter and is useful, and accordingly upholds the patent in these respects, his decision will be followed by another judge of co-ordinate jurisdiction in case the validity of the same patent is contested on the same grounds by another defendant. (*Slazenger* v. *Feltham*, 6 R. P. C. 132; *S. C.* on appeal, 6 R. P. C. 234.)

Evidence.—In regard to the evidence it may be useful to remember that the Court looks with distrust on experiments conducted for the express purpose of manufacturing evidence for the cause. (*Young* v. *Fernie*, 5 Giff. 577; *Betts* v. *Neilson*, L. R. 3 Ch. 429, 433.)

By the 4th subsection of the 29th section of the Act of 1883, no evidence is to be admitted at the hearing, except by leave of the Court or a judge, in proof of any alleged infringement or objection of which particulars have not been delivered.

Hence under this clause the Court at the trial has a discretionary power to allow the evidence to go beyond the particulars of breaches or objections. (*Britain* v. *Hirsch*, on appeal, 5 R. P. C. 226.)

Where particulars of breaches alleged divers sales and specified sales to two persons, evidence of a sale to a third person was allowed where the defendant admitted having had transactions with him. (*Sykes* v. *Howarth*, L. R. 12 Ch. D. 827.)

As to the mode of proving the allegation of general public knowledge, see the case of *Holliday* v. *Heppenstall*, *ante*, p. 280, under Particulars of Objections.

In actions for infringement the onus of proof with regard to want of novelty is on the defendant, and therefore in an uncontested case the plaintiff is not bound to prove the novelty of his invention. (*Peroni* v. *Hudson*, 1 R. P. C. 261.)

An offer to execute orders for swivelling pumps in response to applicants, no particular form of swivelling pump being mentioned, was held not to be evidence of an intention to infringe a patent for swivelling pumps where the specification did not claim every kind of that class of pump. It was to be presumed that the offer referred to such pumps as would not be an infringement of the patent. (*Gwynne* v. *Drysdale*, 2 R. P. C. 160; *S. C.*, appeal, 3 R. P. C. 65.)

It was said by *Lord Herschell* in the House of Lords (*Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C.

465), that neither the patentee nor any other witness could be called to prove what was the invention claimed by the specification. That question was to be answered from a critical examination of the instrument by the Court. It would seem, therefore, that the cases of *Bateman* v. *Gray* (Macr. P. C. 111) and *Crossley* v. *Potter* (Macr. P. C. 255) are overruled as far as they relate to this point.

A patentee who has assigned his patent cannot be restrained, on the trial of an action for infringement brought by the assignee against a third party, from giving information in his possession which might tend to show that the patent is invalid. (*London and Leicester Hosiery Co.* v. *Griswold*, 3 R. P. C. 251.)

A plaintiff is entitled to adduce evidence in reply for the purpose of rebutting the case set up by the defendant. (*Penn* v. *Jack*, L. R. 2 Eq. 317.)

As to the circumstances under which the Court of Appeal will admit or refuse further evidence in patent cases under Order LVIII., Rule 4, of the Supreme Court Rules, 1883, see *Hinde* v. *Osborne* (2 R. P. C. 45); *Watling* v. *Stevens* (3 R. P. C. 147); *Walker* v. *Hydro-Carbon Syndicate* (3 R. P. C. 253); *American Braided Wire Co.* v. *Thomson* (5 R. P. C. 118); *Britain* v. *Hirsch* (5 R. P. C. 226); *Spencer* v. *Ancoats Vale Rubber Co.* (6 R. P. C. 46); *Blakey* v. *Latham* (6 R. P. C. 184).

The opinion of scientific witnesses is only admissible as proof of facts. Their opinion whether there has been an infringement or not, though sometimes received in order to save time, is strictly speaking inadmissible, and if objected to ought to be rejected. The Court alone is to decide questions of law. Per *Lord Wensleydale*, in *Seed* v. *Higgins* (8 H. L. C. 550). See also *Westinghouse* v. *Lancashire and Yorkshire Railway Co.* (1 R. P. C. 229). But although it is not for a witness to construe a specification, it is allowable to ask him in an ordinary way what he understands by it. Per *Lord Halsbury, C.*, in *Kaye* v. *Chubb* (5 R. P. C. 650).

In regard to the proof of documents in the Patent Office,

or of copies or extracts from such documents, see Chapter XXIII.

Functions of the Judge and Jury at the Trial.—When a patent case is tried before a jury it is the duty of the judge, where a specification comes into question, to explain to the jury what that instrument directs to be done, and it is for the jury to say whether, upon the evidence, the promised result will be accomplished by pursuing those directions. (Per *Cresswell, J.*, in *Beard* v. *Egerton*, 8 C. B. 165; 19 L. J. C. P. 36.)

The construction of a specification belongs to the Court alone, but if the case is tried before a jury, then the attendant circumstances and the true meaning of the technical phrases, if there be any, are questions which must be ascertained by the jury. (*Neilson* v. *Harford*, 1 W. P. C. 370; *Bovill* v. *Pimm*, 11 Ex. 718; *Otto* v. *Linford*, Court of App. 46 L. T. N. S. 35; *United Telephone Co.* v. *Bassano*, 3 R. P. C. 295.) 'Where novelty or infringement' (said *Lord Campbell*, in *Seed* v. *Higgins*, 8 H. L. C. 561) 'depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises how far one machine imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact which must be left to the jury.' It is also for the Court to decide the question as to the identity of inventions described in two nearly contemporaneous specifications, when such questions can be determined by a simple comparison of the specifications. (Per *Coltman, J.*, in *Allen* v. *Rawson*, 1 C. B. 571; per *Pollock, C. B.*, in *Tetley* v. *Easton*, at Nisi Prius, Macr. P. C. 68; and per *Erle, J.*, in *Bush* v. *Fox*, Macr. P. C. 168; *Booth* v. *Kennard*, 2 Hurlst. & Norm. 84; *Thomas* v. *Foxwell*, 6 Jur. N. S. 271; *Hills* v. *London Gas Light Company*, 5 Hurlst. & Norm. 312. See, however, the observations of *C. J. Tindal*, in *Muntz* v. *Foster*, 2 W. P. C. 105.) But if anything more than simple comparison is required to determine the identity or dissimilarity of two

inventions, the question must be submitted to the decision of the jury.

'We by no means lay down as a general rule' (said *Lord Campbell, C. J.*, in *Thomas* v. *Foxwell*, 5 Jur. N. S. 37) 'that upon a question of novelty of invention such as this, raised by the comparison of two specifications, it must necessarily be a question of law for the Court. The specifications may contain expressions of art and commerce upon which experts must be examined, and there may be conflicting evidence, raising a question of evidence to be determined by the jury. But it is quite clear that there may be cases in which the Court would be bound to decide the question of novelty exclusively, for the two specifications might be, *in ipsissimis verbis*, the same; and if they be in such plain and common language that the judge is sure he understands their meaning, he is bound to construe them as he does other written documents.' 'If there be two specifications to be compared' (said *Lord Westbury, C.*, in *Hills* v. *Evans*, 4 De G. F. & J. 288–298), 'in order to arrive at a conclusion of fact, the right of drawing the inference of fact from the comparison belongs to the jury, and is a question of fact, and not a question of law.'

Steiner obtained letters patent for a new manufacture of a certain colouring matter called garancine, extracted from madder-root, and extensively used in dyeing. This colouring matter was formerly extracted by simply boiling the root in water, and the refuse matter, termed 'spent madder,' was thrown aside as useless. Steiner's process, under his first patent, obtained in 1832, was the employment of diluted sulphuric acid of a given strength, and he proposed to apply it to the extraction of the colouring matter from both fresh and spent madder. In 1843 Steiner took out another patent, specially applicable to the extraction of garancine from spent madder. A much stronger solution of sulphuric acid was now used, and heat was employed. He thus obtained a large portion of the garancine which had previously remained attached to the woody fibre. *C. B. Pollock*, at the trial of an action brought for

an infringement of the latter patent (*Steiner* v. *Heald*, 2 Car. & Kir. 1033), said, 'It appears to me that this is precisely the same as if you applied a process to grapes already imperfectly squeezed, by which you squeeze a little more juice out of them than was formerly done.' Believing the invention to be destitute of novelty, he directed the jury that, in point of law, the invention under the second patent was not patentable. The jury gave their verdict in favour of the defendant, but the verdict was set aside, and a new trial granted on the ground of misdirection. The judge, it will have been observed, treated the conclusion to be drawn from the evidence as a matter of law; whereas he ought to have left it to the jury to say whether fresh and spent madder had different properties, chemical or otherwise, or whether they were the same thing, with the difference only that part of the colouring matter had been already extracted. If the properties of the two substances were different, the invention was a new manufacture; but if the two things were the same, except that one was more charged with colouring matter than the other, in that case the invention claimed would simply have been the application of a process already known, producing a known result. It was for the jury to say, upon the evidence, whether the invention was a new manufacture or not. (*Steiner* v. *Heald*, 6 Exch. Rep. 607.)

The question of infringement is one of mixed law and fact. 'There may well be a case' (said *Lord Campbell*, in *De la Rue* v. *Dickinson*, 7 E. & B. 738) 'where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there be a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact or of fact mixed

with law, which the judge is bound to submit to the jury.' In deciding the question of infringement there is (said *Lord Wensleydale*, in *Seed* v. *Higgins*, 8 H. L. Cas. 550) 'a question of fact wholly for the jury—viz. what the defendants have done; and if scientific evidence is necessary fully to elucidate the case on either side, it is no doubt admissible; and in determining the question of infringement the judge must apply what the jury find to be true.'

It is a question for the judge whether, on proof of certain acts having been done by a defendant, the plaintiff has any case to go to the jury. Per *Lord Chelmsford*, in *Seed* v. *Higgins* (8 H. L. C. 550).

Damages: Account of Profits.—It is now settled that the plaintiff in a patent action cannot have both damages and an account of profits, but must elect between the two which he will adopt. (*Neilson* v. *Betts*, L. R. 5 H. L. 1.)

In estimating the amount of damages sustained by a plaintiff in respect of an infringement of his patent, the Court adopts a form of inquiry different from that which it employs in the analogous case of an imitation of a plaintiff's trade-mark. In the latter instance the Court will not assume in the absence of evidence that the plaintiff would have sold all the articles which the defendant has wrongfully sold. (*The Leather Cloth Co.* v. *Hirschfeld*, L. R. 1 Eq. 299.) But every sale without licence of a patent article must be a damage to the patentee, and therefore the inquiry in a patent case will extend to the sale by the defendant of *any* articles made by him since the infringement was commenced. (*Davenport* v. *Rylands*, 1 L. R. Eq. 308.) The inquiry will extend to the sales by the defendant within six years before the commencement of the proceedings (*Davenport* v. *Rylands*, L. R. 1 Eq. 302; *Crossley* v. *Derby Gas Light Co.*, 1 W. P. C. 119); but if the plaintiff be an assignee of the patent the amount will only be taken from the date of the registration of the assignment to him. (*Elwood* v. *Christy*, 5 N. R. 312.) And in stating such an account the defendant must file an affidavit, stating the number of the patented articles made by him since the date of the patent,

and the names and addresses of the purchasers to whom the same have been sold (*Murray* v. *Clayton*, L. R. 15 Eq. 115; *American Braided Wire Co.* v. *Thomson*, No. 2, 5 R. P. C. 375), and the account may be taken notwithstanding the pendency of an appeal. (*Saxby* v. *Easterbrook*, L. R. 7 Ex. 207.)

Where separate proceedings have been taken against the manufacturer and user of the patented article the plaintiff may have an account of profits against the manufacturer, and also damages against the user (*Penn* v. *Bibby*, L. R. 3 Eq. 308; *United Telephone Co.* v. *Walker*, 4 R. P. C. 67), and he cannot be compelled to accept the same royalty from a litigant as he receives from others (*ibid.*); but a patentee being himself a manufacturer of the patented article, and having been in the habit of licensing the use of his invention on payment of a fixed royalty, is not entitled to claim as against an infringer a manufacturing profit in addition to his ordinary royalty (*Penn* v. *Jack*, L. R. 5 Eq. 81); and where such a patentee had in some instances received from users (not being the manufacturers of the patented article) his ordinary royalty, it was held that in every such case no further royalty was payable by the manufacturer (*ibid.*).

Where there has been unnecessary delay in filing the bill an account of profits before the filing of the bill will not be ordered. (*Harrison* v. *Taylor*, 11 Jur. N. S. 408; *Beard* v. *Turner*, 13 L. T. N. S. 746; *Ford* v. *Foster*, L. R. 7 Ch. 616; *Crossley* v. *Derby Gas Light Company*, 1 Web. P. C. 120.)

In taking the account of profits made by the use of his invention, a successful plaintiff is entitled to know for comparison the profits made by the defendants in their business prior to the date at which they first used the plaintiff's invention. (*Siddell* v. *Vickers*, 6 R. P. C. 464.)

The material question for consideration in estimating damages is the actual loss entailed on the patentee, not the profit made by the infringer. (*United Horsenail Company* v. *Stewart*, L. R. 13 App. Ca. 413.) And in that case

it was laid down that the measure of damages was the extent to which the infringing articles interfered with the sale of the patented goods. And see *American Braided Wire Co.* v. *Thomson* (6 Times R. 251).

As to the measure of damages and the principle of assessment where the infringing articles are only partly covered by the patent, and are let out at a rental, see *United Telephone Company* v. *Walker & Oliver* (4 R. P. C. 62).

When an amendment by way of disclaimer, correction, or explanation has been allowed under the Patents Act of 1883 (see sect. 20), no damages are obtainable in any action in respect of the use of the invention before the amendment 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.

The seventeenth section of the Patents Act of 1883 directs (subsect. 4 *b*) that if any proceeding shall be taken in respect of an infringement of a patent committed after a failure to make any prescribed payment within the prescribed time and before the enlargement of the time, 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.

Perpetual Injunctions.—The plaintiff is entitled to a perpetual injunction to restrain future infringements when the validity of the patent has been conclusively established, and the fact of infringement has been proved. And if the defendant chooses to submit the injunction may be obtained without proceeding to trial.

Rule 16 of order LVIII. of S. C. R. directs that there shall be no stay of proceedings pending appeal, except so far as the Court appealed from or a judge thereof or the Court of Appeal may order. See *Flower* v. *Lloyd* (36 L. T. N. S. 444); *Washburn &c. Co.* v. *Patterson* (1 R. P. C. 158, 171); *Easterbrook* v. *G. W. R. Co.* (2 R. P. C. 201); *Hocking* v. *Fraser* (3 R. P. C. 7); *Otto* v. *Steel* (3 R. P. C. 109); *Kaye* v. *Chubb* (4 R. P. C. 23); *Humpherson* v. *Syer* (4 R. P. C. 184).

A patentee after disclaiming will not be allowed to enforce an injunction obtained before disclaiming, but must proceed *de novo*. (*Dudgeon* v. *Thomson*, L. R. 3 App. Cas. 34.)

Delivery up or Destruction of Machines.—The Court has power to order the infringing machines to be delivered up to the plaintiff, as well as any articles in the defendant's possession made by them. It may also order the destruction of machines made in violation of a patent. (*Betts* v. *De Vitre*, 34 L. J. N. S. 289, 291; *Tangye* v. *Stott*, 14 W. R. 386.) However, where the patent was for a combination, and the defendant might still use for other purposes the several parts of the machine, *Wood, V. C.*, refused to order the machines to be destroyed, but directed them to be marked so as to prevent their being used at any future time in such a way as to continue the infringement. (*Needham* v. *Oxley*, 8 L. T. N. S. 604.) In *Plimpton* v. *Malcolmson* (*Seton* on Decrees, 4th ed. p. 354), the order was that the defendant should upon oath deliver up to the plaintiff, or break up or otherwise render unfit for use, the articles complained of. See also *Frearson* v. *Loe* (L. R. 9 Ch. D. 48, 67).

SCOTLAND.

The 107th section of the Patents Act of 1883 directs that in any action for infringement of a patent in Scotland the provisions of the 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' is to mean any court to which such action is appealed.

And by the 111th section the provisions of the Act conferring a special jurisdiction on the Court as defined by the Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any pro-

ceedings relating to patents; 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.

R. S. C. O. XI. r. 2 provides that where leave is asked of the Court or a judge to serve a writ under r. 1, in Scotland or Ireland, if it shall appear that there may be a concurrent remedy in either country, the Court or judge shall have regard to the comparative cost and convenience of proceeding in England, or in the place of residence of the person sought to be served. As to Scotland, see *Re Burland's* Trade Mark (L. R. 41 Ch. D. 542); *Marshall* v. *Marshall* (L. R. 38 Ch. D. 330); and as to Ireland see *Washburn &c. Company* v. *Cunard Steamship Company and Parkes* (6 R. P. C. 398).

IRELAND.

By section 110 of the Act of 1883 all parties shall, notwithstanding anything in the 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. And by the 111th section the jurisdiction of any court in Ireland in proceedings relating to patents is not to be affected by the provisions of the Act conferring a special jurisdiction on the Court as defined by the Act, except so far as the latter jurisdiction extends; and with reference to any such proceedings in Ireland, the terms 'the Court' and 'the Court of Appeal' respectively are to mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

ISLE OF MAN.

By the 112th section of the Act of 1883 it is enacted that it shall extend to the Isle of Man, but that nothing therein 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.

COSTS AND CERTIFICATES.[1]

The successful plaintiff is entitled to his costs, unless his conduct has been such as to induce the judge to deprive him of them. (*Nunn* v. *Albuquerque*, 31 Bea. 595.)

In patent actions costs are usually allowed on the higher scale (see R. S. C. O. LXV. rr. 8, 9) on account of the importance or special nature and difficulty of the cases; and costs as between solicitor and client are obtainable under the 31st section of the Act of 1883. (See *post*.)

The plaintiff will not be deprived of costs because he did not apply to the defendant before taking proceedings (*Burgess* v. *Hateley*, 26 Bea. 249; *Upmann* v. *Forrester*, 24 Ch. D. 231), nor because the defendant was unacquainted with the plaintiff's rights, nor because he had no intention to do wrong. (*Burgess* v. *Hills*, 26 Bea. 244; *Cooper* v. *Whittingham*, 24 Ch. D. 231.)

After judgment has been delivered the counsel on both sides will at once apply to the judge for the certificates to which they may be respectively entitled. A reasonable time after trial is sometimes allowed to a party for applying on paying the costs of the motion. (*Rowcliffe* v. *Morris*, 3 R. P. C. 145.)

No appeal lies from the grant of a judge's certificate, as it is not a judgment or order within s. 19 of the Judicature Act, 1873. (*Haslam Company* v. *Hall* (2), 5 R. P. C. 144.)

It is directed by the sixth subsection of the twenty-ninth section of the Act of 1883, that on the 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 particulars 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.

The taxing master has no power without the judge's certificate to allow the successful defendant's costs of his

[1] See the cases as to costs collected in Mr. W. N. Lawson's cited work pp. 176-189.

particulars of objection which he had not been called upon to prove at the trial, as the action had been dismissed (with costs) on the ground that the plaintiff's invention was not subject-matter. (*Longbottom* v. *Shaw*, 6 R. P. C. 510.)

Although a patent is adjudged to be invalid, and the plaintiff has to pay the general costs of the action, yet on the principle that parties ought not, even when right in the action, to add to the expenses by fighting issues in which they are wrong, the plaintiff has been held to be entitled to the costs occasioned by the issues raised by those particulars of breaches which the defendant failed to prove. (*Badische Anilin and Soda Fabrik* v. *Levinstein*, 2 R. P. C. 117; *Automatic Weighing Machine Company* v. *Knight*, 6 R. P. C. 297; *Griffin* v. *Fearer*, 6 R. P. C. 396.)

Where a defendant not only denied infringement but also contested the validity of a patent, and the result was that infringement was proved, but the patent was found to be invalid, the plaintiff was held to be entitled to the costs of the issue in respect of the infringement. (*Pooley* v. *Pointon*, 2 R. P. C. 167.) And so when the plaintiffs succeeded on a distinct issue, though defeated in the action generally, they were held to be entitled to the costs of that issue. (*Blank* v. *Footman*, 5 R. P. C. 661.) But on the other hand, see *Guilbert-Martin* v. *Kerr* (4 R. P. C. 23); *Edison & Swan Company* v. *Holland* (5 R. P. C. 483); *Blakey* v. *Latham* (6 R. P. C. 38).

The plaintiffs sued for the infringement of two patents, but abandoned one at the trial, whilst they succeeded on the other. They were ordered to pay such costs as were occasioned by their suing on the abandoned patent. (*Hocking* v. *Fraser*, 3 R. P. C. 7.) And so where a plaintiff sued on three patents, but only succeeded on one, he was directed to pay such costs as had been incurred by including the other two in the claim. (*Edison* v. *Woodhouse*, 3 R. P. C. 178.)

The proprietors of two patents having brought an action on each against the same defendant, the judge allowed the plaintiffs only such costs as they would have been entitled

to had they joined both patents in one action. (*United Telephone Co.* v. *Sharples*, 2 R. P. C. 28.)

If a defendant raises issues which are abandoned at the trial, the unsuccessful plaintiff is entitled to the costs of those issues. (*American Braided Wire Co.* v. *Thomson*, 4 R. P. C. 322.)

Third parties who appeared in the Court below and in the Court of Appeal, although not made defendants, were ordered to pay costs. (*Edison & Swan Co.* v. *Holland*, 6 R. P. C. 243.)

As to the proper certificates in cases where judgment is given at the trial for the defendants who are not called upon to go into their defence, see *Germ Milling Co.* v. *Robinson* (3 R. P. C. 254); *Longbottom* v. *Shaw* (6 R. P. C. 143).

At the trial of an action for infringement, the judge found for the plaintiff, but on appeal his decision was reversed, and the Court of Appeal gave the defendant such certificates as to costs as ought to have been given by the judge who tried the case, if his decision had been in conformity with that of the Court of Appeal. (*Humpherson* v. *Syer*, 4 R. P. C. 416; *Cole* v. *Saqui*, 6 R. P. C. 45. And see *Cropper* v. *Smith*, 2 R. P. C. 61.)

When a patent case is carried to the Court of Appeal, and can there be decided at once on one short point, the Court will refuse to go on with it, simply for the purpose of ascertaining how the costs should be apportioned between the parties. (*Longbottom* v. *Shaw*, 6 R. P. C. 147; *Boyd* v. *Horrocks*, 6 R. P. C. 162; *Blakey* v. *Latham*, 6 R. P. C. 190.) But sometimes the Court of Appeal, on reversing the judgment in the Court below, will refer the case back to the judge who tried the case to deal with the question of costs. (*Combined Weighing &c. Co.* v. *Automatic Weighing Machine Co.*, 6 R. P. C. 502.)

The following cases relating to certificates of proof of particulars of breaches may be referred to: *Young* v. *Rosenthal* (1 R. P. C. 41); *Germ Milling Co.* v. *Robinson* (3 R. P. C. 260); *Bray* v. *Gardner* (4 R. P. C. 406).

And as to certificates of proof of particulars of objections, see *Cropper* v. *Smith* (2 R. P. C. 61); *Lawrence* v. *Perry* (2 R. P. C. 179); *Germ Milling Co.* v. *Robinson* (3 R. P. C. 254); *Rothwell* v. *King* (2) (4 R. P. C. 397); *Albo-Carbon Light Co.* v. *Kidd* (4 R. P. C. 539); *Badham* v. *Bird* (5 R. P. C. 238); *Oddy* v. *Smith* (5 R. P. C. 509); *Longbottom* v. *Shaw* (5 R. P. C. 502).

By the thirty-first section of the Act of 1883, it is enacted that, in an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

In a case where the defendant did not appear at the trial, and the plaintiff had judgment, the judge refused to give a certificate that the validity of the patent had come into question, holding that the section only applied when the patent was established in a case contested in Court. (*Peroni* v. *Hudson*, 1 R. P. C. 261.) On the other hand, in *Haydock* v. *Bradbury* (4 R. P. C. 74), the judge, under similar circumstances, gave the certificate.

In an action for alleged infringement, where the plaintiff proved the validity of the patent, but failed to prove the infringement, the judge gave the certificate. (*Automatic Weighing Machine Co.* v. *Knight*, 6 R. P. C. 120.)

Judgment was given for the defendant in an action for infringement, the patent being declared invalid by reason of one of the claims having been anticipated. The judge, however, gave the plaintiff a certificate that the validity of the patent had come in question in the action. (*Haslam Co.* v. *Hall*, 5 R. P. C. 26.)

Where the validity of a patent was impeached on grounds different from those brought forward in a former action, in which its validity was established, and the judge's

certificate to that effect was obtained, costs as between solicitor and client were refused, and costs on the higher scale were given to the successful plaintiff in the second action. (*Otto* v. *Steel*, 3 R. P. C. 120.)

A certificate of validity is not available in an action by the same plaintiff against another defendant, if it was given after the later action was commenced. (*Automatic Weighing Machine Co.* v. *International Hygienic Society*, 6 R. P. C. 475.)

As to other questions in regard to costs as between solicitor and client, after the validity of the patent has been established in a previous action, see *United Telephone Co.* v. *Townshend* (3 R. P. C. 10); *United Telephone Co.* v. *St. George* (3 R. P. C. 339); *United Telephone Co.* v. *Patterson* (6 R. P. C. 140).

The Vice-Chancellor of the County Palatine of Lancaster is not a Court or judge within the meaning of the 31st section, and cannot grant a certificate thereunder. (*Proctor* v. *Sutton Lodge Chemical Co.*, 5 R. P. C. 184.)

In the case of *Davenport* v. *Rylands* (L. R. 1 Eq. 308), under the corresponding section in the Act of 1852, *Sir W. P. Wood, V. C.*, decided that a patentee who has obtained this certificate may have his full costs in any subsequent action for infringement, although the validity of the patent may not have been in question in such action. See, however, *Automatic Weighing Machine Co.* v. *International Hygienic Society* (6 R. P. C. 475).

As to what is a sufficient certificate to enable the Court to direct the costs to be taxed as above mentioned, see *Betts* v. *De Vitre* (11 Jur. N. S. 11), *Bovill* v. *Hadley* (17 C. B. N. S. 435).

Other cases relating to the certificate are *Stocker* v. *Rodgers* (1 C. & R. 99); *Ball* v. *Lelm* ('Times,' April 14, 1881).

When directors of a limited company are active parties in an infringement of a patent by the company, they may be made parties to a suit against the company, and may be ordered personally to pay the costs of suit. (*Betts* v. *De*

Vitre, 11 Jur. N. S. 9, affirmed on appeal, L. R. 3 Ch. 429. See also *Spencer* v. *Ancoats Vale Rubber Co.* 6 R. P. C. 46.)

See further as to the taxation of costs in patent suits, *Smith* v. *Buller* (L. R. 19 Eq. 473); *Batley* v. *Kynock* (L. R. 20 Eq. 632); *Wegmann* v. *Corcoran* (27 W. N. 357).

CHAPTER XIX.

ACTIONS TO RESTRAIN A PATENTEE'S THREATS.

By the thirty-second section of the Act of 1883 it was enacted that if any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats. But this section is not to apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Previously to the passing of this Act it had been held that it was necessary to show a want of good faith, that is, an absence of reasonable and probable cause, as well as the untruth of his assertions, to render a patentee liable for threatening to take legal proceedings. (*Halsey* v. *Brotherhood*, L. R. 15 Ch. D. 514, and 19 C. D. 386; *Burnett* v. *Tate*, 45 L. T. N. S. 742; *Société Anonyme* v. *Tilghman's Co.*, 25 Ch. D. 1; *Sugg* v. *Bray*, 2 R. P. C. 223.) But now the threatening patentee cannot rely on the absence of proof of *mala fides* as a good defence, unless by bringing and diligently prosecuting an action for infringement he bars the application of the earlier part of the thirty-second section. Where a patentee did so, and failed to support the validity of the patent at the trial, and then the action

to restrain the issue of the circulars came on for hearing, at which evidence of *mala fides* was not forthcoming, the judge said, unless there is plain evidence of malice there is no cause of action. The action was therefore dismissed, but without costs. (*Sharp* v. *Brauer*, 3 R. P. C. 193. See also *Challender* v. *Royle*, 4 R. P. C. 371.)

It was at one time supposed that in an action for an injunction to restrain threats under the thirty-second section of the Act the validity of the threatening defendant's patent could not be impeached; but it is now settled that the plaintiff in such an action may prove, in either of two ways, that he has not infringed any legal right of the defendant, the person making the threats. Either he may show that he has not infringed a valid patent; or he may prove that the patent is invalid, and therefore that he has not infringed any legal right of the defendant. In the latter case the defendant is entitled to have the same notice of objections, and the same right of beginning and replying at the trial, as if he had been plaintiff in an action for infringement. See *Challender* v. *Royle* (4 R. P. C. 363); *Kurtz* v. *Spence* (4 R. P. C. 427; *S. C.* 5 R. P. C. 161); *Herrburger* v. *Squire* (5 R. P. C. 581); *S. C.* on appeal (6 R. P. C. 194).[1]

It may be useful, perhaps, to give in a short analytical shape the result of the cases relating to actions to restrain threats by a patentee brought by persons aggrieved under the 32nd section of the Act of 1883.

(1.) When the patentee refuses to bring an action for infringement: (*a*) if the plaintiff shows that the patent is invalid, or that he has not infringed it, he will succeed, without regard to the question of the patentee's *bona fides* in making the threats. (*Kurtz* v. *Spence*, 5 R. P. C. 161; *Herrburger* v. *Squire*, 5 R. P. C. 581.) But (*b*) if it is

[1] Besides the cases cited, the following have a bearing upon minor points in actions under the thirty-second section: *Union Electrical Power and Light Co.* v. *Electrical Power Storage Co.* (5 R. P. C. 329); *Colley* v. *Hart* (6 R. P. C. 17; 7 R. P. C. 101).

shown at the trial that the patent is valid, and that it has been infringed, the plaintiff in the threat action will fail. (*Crampton* v. *Patents Investment Co.*, 5 R. P. C. 382.)

(2.) When the patentee brings an action for infringement, and (*a*) succeeds at the trial in showing the validity of his patent and its infringement, the action for threats will be decided in his favour (*Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. 121); and (*b*) even if the patentee fails to establish the validity of his patent, or the fact of its infringement, he will still not be liable in the threat action unless absence of *bona fides* is shown (as before the Act of 1883). *Sharp* v. *Brauer* (3 R. P. C. 193); *Combined Weighing &c. Co.* v. *Automatic &c. Co.* (6 R. P. C. 502); *Colley* v. *Hart* (7 R. P. C. 101).

Threats.—The first question to be considered is, has a patentee threatened legal proceedings within the meaning of the words 'circulars, advertisements, or otherwise?' A letter from the patentee's solicitor may be a threat for which the aggrieved person may proceed against the client. (*Driffield &c. Co.* v. *Waterlow & Co.*, 3 R. P. C. 46; *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 393; *Combined Weighing &c. Co.* v. *Automatic &c. Co.*, 6 R. P. C. 506.) See, however, remarks of *North, J.*, *Barrett* v. *Day* (7 R. P. C. 54).

Notices by letters addressed by a patentee to persons who were using an invention of the plaintiff, and so framed as to lead people to believe that the patentee was complaining of the plaintiff's invention as being an infringement of the patent, were held to be threats within the meaning of the section. (*Burt* v. *Morgan*, 4 R. P. C. 278.) Then letters written 'without prejudice' may contain threats within the section. (*Kurtz* v. *Spence*, 5 R. P. C. 173.) Also a private letter written by the patentee to a customer of the plaintiff. (*Walker* v. *Clarke*, 4 R. P. C. 111.)

Pending an action for infringement, the plaintiff has no right to advertise a positive statement that the defendant has infringed, and he may be restrained if he does so advertise. (*Gaulard* v. *Lindsay*, 4 R. P. C. 189.)

But *quære* whether mere warnings to the public in

respect of the future are threats within the meaning of the section. (*Challender* v. *Royle*, 4 R. P. C. 374.)

The judges sitting *in banc* refused an injunction to restrain a patentee from sending out circulars containing a verbatim report copied from a newspaper of the trial of an action for the infringement of his patent, the trial having terminated in his favour, and the applicants for the injunction being the defendants in the action. (*Hayward* v. *Hamilton*, 'Engineer,' vol. xlviii. p. 428; *S. C.*, 1 Griffin P. C. 115.)

Interlocutory Injunctions.—An interlocutory injunction to restrain threats must not be moved for *ex parte*. Notice of motion must be given in the regular way. (*Wilson* v. *Church Engineering Co.*, 2 R. P. C. 175.) An interlocutory injunction was refused when the defendant, the patentee, undertook to proceed with due diligence with an action against the plaintiff for an infringement of the patent, but was afterwards granted on his neglecting to perform the undertaking. (*Household* v. *Fairburn*, 1. R. P. C. 109; *S. C.*, 2 R. P. C. 140.) A motion for an interlocutory injunction to restrain the circulation of circulars issued by limited licensees was ordered to stand over until after the trial of an action for infringement brought by a patentee against the plaintiffs in the action for an injunction. (*Barnett* v. *Barretts Co.*, 1 R. P. C. 9, and see *Combined Weighing &c. Co.* v. *Automatic Weighing Machine Co.*, 6 R. P. C. 504.)

Where a plaintiff, pending an action brought by him for an infringement, has obtained leave from the Court to amend, but has not yet amended, his specification by disclaimer, he will not be allowed to issue circulars threatening the customers of the defendant with legal proceedings, and the defendant in the action for infringement may move for an injunction to restrain the issue of the circulars. (*Fusee Vesta Co.* v. *Bryant & May*, 4 R. P. C. 191.)

In granting or refusing an interlocutory injunction the Court will consider not only the balance of convenience and inconvenience between the parties litigant, but also whether the plaintiff has made out a *primâ-facie* case, so as to make it seem probable that at the hearing of the action for threats

he will get a decree in his favour on the questions of infringement and, if raised, the validity of the patent. (*Challender* v. *Royle*, 4 R. P. C. 372; see also *Barney* v. *United Telephone Co.*, 2 R. P. C. 173.)

The Proviso at the end of the thirty-second section of the Patents Act of 1883 declares that the section is not to apply if the person making the threats with due diligence commences and prosecutes an action for infringement of his patent. It is not required that the action for infringement should be brought against the aggrieved person, that is, the person applying for an injunction to restrain threats. 'An action will satisfy the words of the proviso if it is a *bonâ-fide* action brought with due diligence and without collusion against a person to whom threats have been addressed in respect of the act to which the threat referred.' Per *LL. JJ. Cotton and Bowen*, in *Challender* v. *Royle* (4 R. P. C. 373–5). But it was held by *Mr. Justice Kekewich*, in *The Combined Weighing &c. Co.* v. *The Automatic Weighing Machine Co.* (6 R. P. C. 507) that in order to meet the exigency of the proviso, the patentee, if he does not sue the person who has brought an action to restrain threats, must sue a person who has committed an infringement of the same character as the infringement alleged to have been committed by the plaintiff in the threat action. It will not do to bring the action for infringement against a man who is infringing the patent in an entirely different way from that alleged to have been adopted by the man who is sueing for threats. With respect to the words 'due diligence,' they will be interpreted with reference to the time when the threats were made, not with reference to the time when the patentee had notice of what the alleged infringer was doing. Threats being made in March, and an action for infringement having been commenced in May, that was held to be due diligence. (*Challender* v. *Royle*, 4 R. P. C. 376, 372.) And see *Combined Weighing &c. Co.* v. *Automatic Weighing Machine Co.* (6 R. P. C. 508); *Colley* v. *Hart* (6 Times R. 212). For a case in which due diligence was not displayed, see *Herrburger* v. *Squire* (5 R. P. C. 594).

When a threatened action for infringement is commenced and prosecuted with due diligence after the threat, there is no ground upon which an action in respect of such threat can subsequently be commenced under the section. (*Barrett* v. *Day*, 7 R. P. C. 54.) An action by a patentee against licensees, claiming royalties in respect of articles which the licensees allege are made under another patent and not under the licence, is an action for infringement within the proviso. (See *Barrett* v. *Day*, cited above.)

Damages.—Where no special damage was proved or suggested, forty shillings damages were awarded. (*Kurtz* v. *Spence*, 5 R. P. C. 177.)

Certificate of Validity.—In an action to restrain a patentee's threats, where the validity of the patent came into question and was upheld, the judge gave a certificate to that effect under the thirty-first section of the Act of 1883, but expressed great doubt whether he had jurisdiction to grant it. (*Crampton* v. *Patents Investment Co.*, 5 R. P. C. 404.) In another action to restrain threats, another judge held that he had no power to give such a certificate. (*Kurtz* v. *Spence*, 5 R. P. C. 184.)

Costs.—When an action for infringement is brought by a patentee after proceedings to restrain threats have been taken against him, the parties ought to come to some arrangement, so as not to incur unnecessary costs by trying two actions about the same facts. (Court of Appeal: *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. 367. See also *Combined Weighing &c. Co.* v. *Automatic Weighing Machine Co.*, 6 R. P. C. 509.)

CHAPTER XX.

THE REVOCATION OF PATENTS.

The old action of *scire facias*, which was one brought in the name of the Crown for the purpose of repealing a grant of letters patent, has been abolished, so far as patents for inventions are concerned, by the twenty-sixth section of the Patents Act of 1883. By that section it is enacted that the revocation of a patent may be obtained on petition to the Court, and that every ground on which a patent might, at the commencement of the 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.

Previous to the Act of 1883, if two patents had been issued to different persons for the same invention, the first patentee could have brought an action of *sci. fa.* to repeal the second patent. (*R.* v. *Neilson*, 1 W. P. C. 671.) And where there had been a false suggestion, such as was involved in a want of novelty or utility in the invention, the patent could have been repealed by the same proceedings. Fraud, non-compliance with the conditions of the letters patent, such as filing an insufficient specification (*Rex* v. *Arkwright*, 1 W. P. C. 66), and the fact that the invention was not a patentable one (*R.* v. *Cutler*, Macr. P. C. 124), were also grounds for the action of *sci. fa.*, and are still therefore available as grounds of revocation.

In the case of *Gaulard & Gibbs' Patent* (6 R. P. C. 225), the patent was held bad on the grounds that there was disconformity between the specification as amended and the provisional specification, and that the scope of the invention had been extended.

The fact that a patent includes more than one invention,

contrary to the direction in section 33, would seem not to be a ground of revocation, since the same section declares that '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.'

A petition for the revocation of a patent may be presented by (*a*) the Attorney-General in England or Ireland, or by the Lord Advocate in Scotland; (*b*) any person authorised by these law officers; (*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 patentee's claim; (*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. That is to say, the persons who, in addition to the law officers and those whom they authorise, may present a petition for the revocation of a patent are persons who allege that they have been defrauded by the grant; or those who claim to be the true inventors of the patented invention; or those who set up anterior public user by themselves, or by persons through whom they claim. Before a petition can be presented on the ground of prior user by other persons it will be necessary to obtain the authority of a law officer.

A petition cannot be presented by an agent, although authorised by a power of attorney. (*Avery's Patent*, 4 R. P. C. 152; *S. C.* on Appeal, 4 R. P. C. 322.) And all persons beneficially interested in the patent must be made respondents. (*S. C.*)

Along with his petition the plaintiff will have to deliver particulars of his objections to the patent, and no evidence will be admitted at the trial in proof of any objection not included in such particulars, except by leave of the Court or of a judge; but the particulars delivered may be from

time to time amended by leave of the Court or of a judge. The proceedings at the trial will be similar to the proceedings in actions when the validity of a patent is in dispute. The defendant is 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 is entitled to reply. (Sub-ss. 5, 6, 7, sect. 26, of the Act of 1883.)

By the nineteenth section of the Act of 1883, the Court or a judge may, in a proceeding for the revocation of a patent, order at any time that the patentee shall, subject to such terms as to costs or 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.

Leave to disclaim after presentation of the petition was given to the patentee upon the terms of his paying all costs and undertaking to apply forthwith for the disclaimer and prosecute the application with diligence. (*Gaulard & Gibbs' Patent*, 5 R. P. C. 189.)

By the twenty-eighth section of the Act the Court in any proceeding for the revocation of a patent may, if it thinks fit, and shall, on the request of either of the parties, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance. The case shall be tried without a jury unless the Court shall otherwise direct.

The following cases have been decided by the Courts upon subsection 4 of section 26 in the Act of 1883.

In construing clause (*c*) the word fraud must be confined to grave moral culpability, and ought not to be extended to honest mistakes, although the real inventor may have suffered injury. (*Avery's Patent*, 4 R. P. C. 322.)

Cases of alleged prior user under clause (*c*). (*Walker* v. *Hydrocarbon Syndicate*, 2 R. P. C. 3; *Haddan's Patent*, 2 R. P. C. 218.)

A person who presents a petition for a revocation under

clauses (*c*), (*d*), or (*e*) is entitled at the hearing, after proving his right to present the petition, to impeach the patent on any other lawful ground. (*Morgan's Patent*, 5 R. P. C. 186.)

Where a patent has been revoked on the ground of fraud, the Comptroller is authorised by the twenty-sixth section of the new Act, on the application of the true inventor, made in accordance with the provisions of the Act, to grant him a patent in lieu of the revoked patent. The new patent is to have the same date as the date of the revocation, but is to expire at the end of the term for which the revoked patent was granted.

Where the Court has made an order for the revocation of a patent, an office copy thereof must be left at the Patent Office, that an entry may be made in the Register. (Rule 74 of Patents Rules, 1890.)

In Scotland, proceedings for the revocation of a patent are directed by the 109th section of the Act to 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 are to be made according to the forms and practice existing at the commencement of the Act.

In Ireland, by section 110, all parties are to have their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

There is no provision in the Act for service out of the jurisdiction of petitions for revocation. Where, however, the patentee was resident and domiciled in Scotland, and there was evidence that a copy of the petition and objections had been delivered to him in Scotland, and that he had written to the petitioner's solicitors that he did not intend to appear at the hearing because he was not subject to the jurisdiction of the English Courts, an order *nisi* was made (on the petitioners applying for directions as to the mode of trial) that unless the patentee should appear before a day named the petition should be tried by *viva-voce* evidence; but if

the respondent appeared it was to be open to him to dispute the jurisdiction. (*Drummond's Patent*, 6 R. P. C. 576.)

COSTS.

The Act of 1883 is silent as to costs, but the Courts under their general jurisdiction award costs to the petitioner when the patent is revoked. (*Haddan's Patent*, 2 R. P. C. 218; *Edmonds' Patent*, 6 R. P. C. 358.)

At the hearing of a petition for revocation the judge thought that he had no power to give a certificate as to proof of the particulars of objections under the twenty-ninth section, subsection 6, of the Act of 1883. (*Gaulard & Gibbs' Patent*, 5 R. P. C. 537.)

CHAPTER XXI.

OFFENCES AND THEIR PENALTIES.

The only penalties imposed by the Act of 1883 are those prescribed for the offences set forth in the 105th and 106th sections. By the 105th section it is enacted that any person who represents that any article sold by him is a patented article when no patent has been granted for the same . . . shall be liable for every offence on summary conviction to a fine not exceeding *5l.* And further, that a person shall be deemed for the purposes of the 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.

According to the case of *Cheavin* v. *Walker* (L. R. 5 Ch. D. 862), the use of the word 'Patent,' along with a representation of the royal arms as a label on an article made according to an invention for which the patent has expired, was considered to be a representation that the patent was still subsisting, and was held to disentitle the plaintiff from obtaining an injunction to restrain the wrongful use of the label. The plea of its being a trade-mark was not allowed to be set up. 'It is impossible' (said *Sir G. Jessel, M. R.*) 'to allow a man who has once had the protection of a patent to obtain a further protection by using the name of his patent as a trade-mark. No man can claim a trade-mark in a falsehood. It is a falsehood in representing the patent as still subsisting.' See also the *Linoleum Manufacturing Co.* v. *Nairn* (L. R. 7 Ch. D. 834).

By the second section of the Merchandise Marks Act,

1887 (50 & 51 Vict. c. 28), every person who (1 *d*) applies any false trade description to goods, and (2) every person who sells or exposes for, or has in his possession for, sale or any purpose of trade or manufacture, any goods or things to which any . . . false trade description is applied, shall be guilty of an offence against that Act, unless he proves that . . . he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade description, and that on the prosecutor's demand he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or that otherwise he had acted innocently. By the third section (1) of the same Act the expression 'trade description' means any description, statement, or other indication, direct or indirect, (*e*) as to any goods being the subject of an existing patent; and the use of any figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of the above matter, shall be deemed a trade description within the meaning of the Act. The expression 'false trade description' means a trade description which is false in a material respect as regards the goods to which it is applied. Persons found guilty of an offence against the said Act are liable to fine and imprisonment and to forfeit any article in relation to which the offence has been committed. (Sect. 2, *c*.)

In the case of *Gridley* v. *Swinborne* (5 Times R. 91), it was held that the sale of packets of gelatine which were marked with the royal arms and bore the words 'Under Royal Letters Patent. Swinborne's Patent Refined Isinglass,' was not an offence under the second section of the Merchandise Marks Act of 1887 when there had been a patent for the manufacture of the article, but which patent had expired many years previously. Since no proceedings were taken under sections 105 and 106 of the Patents Act of 1883, it seems to have been conceded that no offence had been committed under those sections.

To avoid all difficulty in cases of this kind, and to rebut any possible charge of fraud, manufacturers would do well

to add the number and date of the patent to the mark or label.

The fact that a provisional specification has been lodged at the Patent Office does not justify the use of the word 'Patent' as a label upon articles made according to the invention until a patent has been obtained. (*The Queen* v. *Wallis*, 3 R. P. C. 1; *The Queen* v. *Crampton*, 3 R. P. C. 367.)

By the 106th section of the Act of 1883 it is enacted that any person who, without the authority of her Majesty or any of the Royal Family or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession, by or under such authority as aforesaid, shall be liable, on summary conviction, to a fine not exceeding 20*l*.

Many persons engaged in business have been accustomed to make use of the royal arms in one way or another, and if they continue to do so they should be careful not to bring themselves within the purview of this section.

By the first section of the Act of 1888 it is enacted that any person describing himself to be a Patent Agent when he is not on the register is liable on summary conviction to a penalty of 20*l*. (See Chapter XXIV., 'On the Institute of Patent Agents.')

In Scotland any offence under the Act of 1883 declared to be punishable on summary conviction may be prosecuted in the Sheriff's Court. (Sect. 108.) In the Isle of Man any offence under the Act which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of the person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted. (Sect. 112, subsect. 3.)

The ninety-third section of the Act of 1883 enacts that if any person makes or causes to be made a false entry in

any Register kept under the 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 misdemeanor.

In the Isle of Man the punishment for a misdemeanor under the Act is imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding 100*l.* at the discretion of the Court. (Sect. 112, subsect. 2.)

CHAPTER XXII.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International Arrangements.

It is enacted by the 103rd section of the Patents Act of 1883 that, if the Crown should make any arrangement with the Government or Governments of any foreign state or states for the 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 the Act in priority to other applicants, and such patent shall have the same date as the date of the application in such foreign state. But the application must be made in this country in the same manner as an ordinary application under the Act, and within seven months from the date of the application for protection in the foreign state. A patentee under this section will not be allowed to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in this country. By the second subsection of the same section it is enacted that the publication in the United Kingdom or the Isle of Man, during the said period of seven months, of any description of the invention, or the use therein during the said period of the invention, shall not invalidate the patent which may be granted for the invention.

Then by the fourth subsection it is directed that these provisions are only to apply to those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

On March 20, 1883, a Convention was signed by representatives of various Governments, which was afterwards ratified by these Governments. Other Governments afterwards joined the Convention, and at the present time it exists between the following states: Belgium, Brazil, France, Great Britain, Guatemala, Holland and its Indian Colonies, Italy, Mexico, Norway, Portugal, Servia, Spain, Sweden, Switzerland, Tunis, United States. By the first article of this Convention it was declared that the said states formed themselves into a *Union for the Protection of Industrial Property*, which words were (according to the Protocol accompanying the Convention,[1] and having the same force, validity, and duration as the Convention itself) to be understood in their broadest sense, and to be applicable not only to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.) and to mineral products employed in commerce (mineral waters, &c.). It may here be remarked that neither agricultural products nor mineral products are patentable in this country.

By the second article of the Convention the subjects or citizens of each of the contracting states are to enjoy in all the other states of the Union the same advantages as regards patents of every kind (see the second paragraph of the Protocol) that their respective laws grant to their own subjects or citizens. They are to have the same protection and the same legal 'recourse' [*i.e.* remedies] on any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation [*i.e.* laws] of each state. With regard to this clause the third paragraph of the Protocol explains that it is not to affect the legislation [*i.e.* laws] of the contracting states relating to legal procedure, jurisdiction, &c.

Subjects or citizens of states not forming part of the Union who are domiciled or have industrial or commercial establishments on the territory of any of the states of the Union are by Article 3 of the Convention to be on the

[1] The Convention and Protocol will be found reprinted in the Appendix.

same footing as the subjects or citizens of the contracting states.

Then, by Article 4, any person who has duly registered [*i.e.* made] an application for a patent in one of the contracting states shall enjoy, as regards registration in the other states, and reserving the rights of these parties, a right of priority for six months, an additional month being allowed for countries beyond sea. Subsequent registration (*i.e.* a patent obtained on a subsequent application) in any of the other states of the Union before expiry of that period shall not be invalidated by any acts done in the interval, either by registration, by publication of the invention, or the working of it by a third party.

Article 5 declares that the introduction by the patentee into the country where the patent has been granted of articles manufactured in any of the states of the Union shall not entail forfeiture of the patent as it did in several states before the date of the Convention. But this clause is followed by another which declares that the patentee shall remain bound to work his patent in those states where the law of the country obliges him to do so. It would appear, therefore, that, although a patentee is entitled to introduce into a country articles made abroad, he must still work the invention in that country if there is a regulation to that effect. In this country there is no law of the kind, but under the 22nd section of the Act of 1883 patentees who are foreigners may be called upon, like those who are British subjects, to grant licences to work the invention, when the patents were issued under that Act.

Temporary protection is to be granted under Article 11 to patentable inventions appearing at official or officially recognised international exhibitions.

In order to carry the Convention into full effect, it was directed by Article 13 that an International Office should be organised under the name of *Bureau International de l'Union pour la protection de la Propriété Industrielle*, and that this office should be placed under the authority of the Central Administration of the Swiss Confederation, and worked under its supervision.

It was then agreed by the next Article that the Convention should be submitted to periodical revisions, with a view to improving its provisions, for which end conferences by delegates from the contracting states will be held. It was also agreed that special arrangements for the protection of industrial property might be made separately between any of the contracting states, provided that such arrangements do not contravene the provisions of the Convention.

By Article 16 it was agreed that states which did not originally take part in the Convention should be permitted to join the Union afterwards by diplomatically notifying their intention to do so to the Government of the Swiss Confederation. And by Article 18 it is provided that any state might retire from the Union by giving notice to that effect to the Government of the Swiss Confederation. At the expiration of one year from the date of the notice the state giving it will cease to be a member of the Union.

Great Britain joined this Convention on March 17, 1884, and an Order in Council under section 103 of the Act of 1883 was duly made. The Board of Trade has issued rules as to applications for patents under this Convention, and a copy of them will be found in the Appendix.

According to present regulations, 'Patents (International and Colonial Arrangements) Rules 24–29, 1890,' an application in the United Kingdom for a patent under the International Convention must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. It must be made upon form A² (stamped 1*l*., and obtainable upon prepayment of the value of the stamp, through any money order office), and, in addition to the specification, provisional or complete, must be accompanied by (1) a copy or copies of the specification and drawings as filed in the Patent Office of the Foreign State or British Possession in respect of the first foreign application, duly certified by the official chief of such Patent Office, or otherwise verified to the satisfaction of the Comptroller; (2) a

statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification be in a foreign language, a translation thereof must be annexed to and verified by such statutory declaration.

By the terms of the 103rd section patents under the International Convention can only be granted to the person who has made the foreign application. (*Shallenberger's Application*, 6 R. P. C. 550; *Carez's Application*, 6 R. P. C. 552.)

The section applies although the state in which the foreign application was made has only acceded to the Convention after the date of the foreign application. (*Main's Patent*, 7 R. P. C. 13.)

A 'renewed application' for a patent was made in the United States, and seven months later a British patent was applied for under this section. There being evidence that the original American application was no longer of any force and effect, and conferred no rights, the British patent was directed to be sealed as of the date of the 'renewed application.' (*Van de Poele's Patent*, 7 R. P. C. 69.)

An International Office (*Le Bureau International*) 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 this sum should be forwarded by money order to MM. Jent & Reinert, Imprimeurs, Berne.

Colonial Arrangements.—When it is made to appear to her Majesty that the Legislature of any British Possession has made satisfactory provision for the protection of inventions patented in this country, her Majesty is empowered, by the 104th section of the Patents Act of 1883, by Order in Council, to apply the provisions of the 103rd section, with such variations or additions as may seem fit, to such British Possession; but such order is made revocable by another Order in Council. This order has at present only been made with reference to New Zealand.

CHAPTER XXIII.

THE PATENT OFFICE—THE COMPTROLLER—GENERAL RULES—SEAL OF THE OFFICE—OFFICIAL DOCUMENTARY EVIDENCE—REGISTERS—PUBLICATIONS AND INDEXES—LIBRARY—PATENT MUSEUM.

UNTIL a new office has been provided by the Treasury, under the authority of the eighty-second section of the Act of 1883, the business relating to patents is transacted at the offices of the defunct Commissioners of Patents in Southampton Buildings, Chancery Lane. All the officers and clerks of the office are appointed by the Board of Trade, subject to the approval of the Treasury.

The Office is open to the public every week-day between the hours of ten and four, except on Christmas Day, Good Friday, the day observed as her Majesty's birthday, and the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

THE COMPTROLLER-GENERAL.

The Comptroller-General of Patents, Designs, and Trade-Marks is an officer appointed by the Board of Trade under the eighty-third section of the statute of 1883 to act under the superintendence and direction of the Board as chief of the Patent Office, which is placed under his immediate charge.

Besides acting as general manager of the business of the office, and as superintendent of the examiners and clerks therein, he has many important duties to perform, as already mentioned in the preceding chapters, in regard to the various steps to be taken on applications for patents, on oppositions to grants, on the issue of patents, on appli-

cations for extensions of time, and on applications for leave to amend specifications.

In addition to these, which may be called his routine duties, though some of them will frequently call for the exercise of much care and thought, he is required, by section 40, to issue periodically an Illustrated Journal of Patented Inventions, as well as Reports of Patent Cases decided by Courts of Law, and any other information that he may deem generally useful or important. He has to make provision for keeping on sale copies of the Journal, and also of all complete specifications for the time being in force, with their accompanying drawings. And he is directed to continue in such form as he may deem expedient the indexes and abridgments of specifications hitherto published, and to prepare and publish from time to time such other indexes, abridgments of specifications, catalogues, and other works relating to inventions as he may see fit.

He is empowered to refuse patents when the use of the invention would, in his opinion, be contrary to law or morality. (Sect. 86.)

He is enabled to correct clerical errors in or in connection with applications for patents, or in the name, style, or address of the registered proprietor of a patent. (Sect. 91.)

By Rule 16 of the Patents Rules 1890 the Comptroller is empowered to amend documents and to correct irregularities in procedure; by Rule 51 he is authorised to enlarge the time prescribed by the Rules for doing any act or taking any proceeding thereunder, and by Rule 80 large powers are given to him, with the sanction of the Board of Trade, to dispense with acts, documents, evidence, &c., required under the Rules.

By section 3 of the Act of 1885 he has power to extend the time for leaving complete specifications at the Patent Office, and for accepting complete specifications, and for sealing patents.

Where any discretionary power is by the Act given to the Comptroller, it is expressly directed by the ninety-fourth section that he shall not exercise that power adversely to

the applicant for a patent, or for 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. As to the procedure, see Rules 11–14 of the Patents Rules 1890.

In any case of doubt or difficulty arising in the administration of any of the provisions of the Act, the ninety-fifth section directs that he may apply to either of the law officers for directions in the matter.

The Comptroller is required by the 102nd section to cause a report respecting the execution by or under him of the Act to be laid before both Houses of Parliament, before the first day of June in every year, and to include therein for the year to which each report relates all general rules made in that year under or for the purposes of the Act, and an account of all fees, salaries, and allowances, and other money received and paid under the Act.

In case of the absence of the Comptroller, any act or thing directed to be done by or to him may be done by or to any officer authorised in that behalf by the Board of Trade. (Sect. 82, subsect. 4.)

GENERAL RULES.

The Board of Trade was empowered by the 101st section of the Act of 1883 to make rules for regulating generally the business of the Patent Office and all things placed under the direction and control of the Comptroller or of the Board; and particularly for regulating the practice of registration; for making or requiring duplicates of specifications, amendments, drawings, and other documents; for securing and regulating the publishing and selling of copies thereof; for securing and regulating the making, printing, publishing, and selling of indexes to abridgments of specifications and other documents in the Patent Office, and providing for the inspection of indexes, abridgments, and other documents. Such general rules are to be of the same effect as if they were contained in the Act, and are to be judicially noticed. They must be laid before the two Houses of Parliament,

either of which has power within a limited time to annul any of them.

Consolidated Rules have been issued by the Board of Trade, with the short title of the Patents Rules 1890, and are reprinted in the Appendix to this volume.

THE SEAL OF THE PATENT OFFICE.

By the eighty-fourth section of the Patents Act of 1883, it is directed that there shall be a seal for the Patent Office, and that impressions thereof shall be judicially noticed and admitted in evidence.

OFFICIAL DOCUMENTARY EVIDENCE.

By the eighty-ninth section of the same Act it is enacted that 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 and in all proceedings, without further proof or production of the originals.

Then by the ninety-sixth section a certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by the 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.

By the twenty-third section of the same Act, it is enacted that the Register of Patents to be kept at the Patent Office shall be *primâ-facie* evidence of any matters directed or authorised to be inserted therein.

Finally, by the hundredth section of the Act it is directed that copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of the 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.

REGISTERS.

The Register of Patents kept at the office and mentioned in the chapter on Registration is open to public inspection daily (with certain exceptions mentioned in Rule 78) between the hours of ten and four. Up to the end of 1883 the registers kept at the Patent Office were two. In the one called the Register of Patents were recorded, in chronological order and with the dates, all patents granted under the Patents Act of 1852, as well as the deposit or filing of specifications, disclaimers, memoranda of alterations, amendments, confirmations, and extensions, and the expiry, vacating, and cancelling of patents. The other register, called the Register of Proprietors, contains entries of the assignments of patents, or of any share or interest therein; and of licences, mentioning the districts to which they relate, with the names of persons having shares or interests in patents and licences, and the dates at which such shares or interests were acquired.

PUBLICATIONS AND INDEXES.

Besides the Illustrated Official Journal relating to Patents and Reports of Patent Cases decided in the Courts of Law and directed to be published by the fortieth section of the new Act, several other publications are issued by the Patent Office. A 'Circular of Information,' containing sixteen pages, is forwarded to applicants. Printed copies of all the specifications filed under the Patents Act of 1852, and of all

specifications enrolled previously to the passing of the said Act are purchasable for small sums at the office, with lithographed copies of the drawings accompanying such specifications. The specifications under the new Act are also printed and published, but only when the complete specifications have been filed and accepted.

Alphabetical indexes of all the specifications of patents enrolled in Chancery, from 1617 to the latest available date, have been published under the authority of the office, as well as an index arranging the specifications according to the subject-matter, and supplemental indexes continue to be published annually. Chronological indexes of patents, from the earliest date to the year 1875, have also been published. Another index, called the *Reference Index of Patents*, points out the office in which each enrolled or filed specification of a patent may be consulted; the books in which specifications, law proceedings, and other subjects connected with inventions have been noticed; also, such specifications as have been published under official authority. These indexes are of great service in tracing the history of inventions.

The volumes containing abridgments of specifications arranged chronologically in classes are of immense utility to inventors who wish to discover what has been already done in any particular branch of invention; but, unfortunately, these abridgments are not kept up to date.

Copies of the Patent Office publications are presented to the principal public offices, seats of learning, societies, institutions, libraries, British Colonies, and foreign states.

PUBLIC LIBRARY.

A library has been established in connection with the Patent Office, and this is open free to the public. The whole of the publications of the office, and also the leading *British and Foreign scientific journals and text-books* in the various departments of science and art are in this library.

PATENT MUSEUM.

The Patent Museum at South Kensington is transferre by the forty-first section of the Act of 1883 to the Department of Science and Art, which is empowered by the forty-second section to require any patentee to furnish them with a model of his invention on payment of the cost, the amount, in case of dispute, to be settled by the Board of Trade.

CHAPTER XXIV.

THE INSTITUTE OF PATENT AGENTS AND ITS REGISTER.

In the year 1882 a number of Patent Agents practising in London, being of opinion that it was highly desirable on several grounds to form an association of Patent Agents, and to obtain incorporation for it under the statutes in force, the proper steps were taken, after the memorandum and articles of association had been prepared, to effect the object in view. The Institute, as the association was named, was established to form a representative body of the Patent Agents of the United Kingdom for the purpose of promoting improvements in the law relating to patents and in the regulations under which they are administered; also to frame rules for the observance of Patent Agents in all matters appertaining to their profession and practice. The Institute is composed of Fellows, Associates (who are not Patent Agents by profession), Foreign Members (who are Patent Agents in the colonies or in foreign countries), and Honorary Members. The affairs of the Institute are managed by a Council, consisting of a President, Vice-President, and Past Presidents, together with eight ordinary members selected from amongst the Fellows. The offices of the Institute are at 19 Southampton Buildings, Chancery Lane, London. Here they keep a library, and at stated intervals meetings are held at which papers relating to patent matters are read and discussed. A volume of their Transactions is published annually.

Since its incorporation the Institute has been of material assistance to the Board of Trade in shaping some of the provisions in the Acts of Parliament bearing upon patents

and in framing rules for the regulation of the business of the Patent Office.

By the first section of the Patents Act of 1888, it was enacted that after July 1st, 1889, a person shall not be entitled to describe himself as a Patent Agent 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 that Act; and any person knowingly contravening this provision is liable on summary conviction to a fine not exceeding 20*l*. But every person who proves to the Board of Trade that he had been *bonâ fide* practising in the United Kingdom as a Patent Agent prior to the passing of the Act is entitled to be registered. The Board of Trade is authorised to make general rules for giving effect to this enactment, and it has accordingly issued a set of Rules, a copy of which will be found in the Appendix to this work.

A register is to be kept by the Institute for the registration of Patent Agents. A copy of the register is to be printed annually and placed on sale. The Institute is to appoint a Registrar to keep the register under the direction of the Board of Trade. A person who desires to be registered on the ground that, prior to the passing of the Act, he had been *bonâ fide* practising as a Patent Agent, must satisfy the Board of Trade that this was the fact before his name will be entered on the register. (Rule 5.) With the exception of persons registered on this ground, no person is to be registered unless he has passed and produced to the Registrar a certificate under the seal of the Institute that he had passed such final examination as to his knowledge of Patent Law and Practice and of the duties of a Patent Agent as the Institute shall from time to time prescribe. Before any person can present himself for the final qualifying examination of the Institute he must have passed one of the matriculation examinations of an English, Scottish, or Irish University, or the Oxford or Cambridge Middle Class Senior Local Examinations, or the Examinations of the Civil Service Commissioners, or such other examinations as

the Institute shall, with the approval of the Board of Trade, by regulation prescribe. These preliminary examinations are, however, not required in the case of solicitors in England and Ireland and law agents in Scotland, or in the case of persons who have for seven consecutive years been continuously engaged as pupils or assistants to registered Patent Agents. In these cases the final qualifying examination only is required to be passed by candidates for registration.

The Institute must hold, at least once in the year, a final qualifying examination, and it is to have the entire management and conduct of such examination, including the appointment of the examiners. The subjects of examination are (*a*) Patent Law; (*b*) Patent practice and procedure; (*c*) the preparation and interpretation of patent documents; (*d*) physical science and its applications to the arts and manufactures. Persons desiring to obtain further information as to the examination should apply to the Secretary of the Institute. The fees payable by a candidate, and those on registration and annually afterwards by Patent Agents are set forth in Appendix C. to the Rules.

The names of persons convicted of crimes, or found guilty of disgraceful conduct, are to be removed from the register. Non-payment of fees is another cause for erasing the name of a Patent Agent from the register.

APPENDIX

PART I

STATUTES, INTERNATIONAL CONVENTION, RULES, AND FORMS

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APPENDIX

PART I

Statutes

21 Jac. I. c. 3. [A.D. 1623.]

An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof.

Monopolies, etc., contrary to the laws of the realm.

Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God 1610, publish in print to the whole realm, and to all posterity, that all grants and monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesties laws, which your Majesties declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm: And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature; yet nevertheless, upon misinformations, and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesties subjects, contrary to the laws of this your realm, and contrary to your Majesties most royal and blessed intention so published, as aforesaid; for avoiding thereof, and preventing of the like to come, may it please your excellent Majesty, at the humble suit of the Lords Spiritual and Temporal, and the Commons in this present Parliament assembled, that it may be declared and enacted, and be it declared and enacted by authority of this present Parliament, 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, or of power, liberty, or faculty to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenour or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration to be had or made, or to agree or compound with any others for any penalty, or forfeitures limited by any statute, or of any grant or promise of the benefit, profit, or commodity, of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had, and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are, and shall be utterly void and of none effect, and in no wise to be put in use or execution.

Monopolies, etc., shall be tried by the common laws of this realm.

2. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licences, charters, letters patents, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending, as aforesaid, and the force and validity of them, and every of them, ought to be, and shall be for ever hereafter examined, heard, tryed, and determined by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, etc.

3. And be it further enacted by the authority aforesaid, that all person and persons, bodies politic and corporate whatsoever, which now are, or hereafter shall be, shall stand and be disabled, and uncapable to have, use, exercise, or put in use any monopoly, or any such commission, grant, licence, charter, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending, as aforesaid, or any liberty, power or faculty, grounded, or pretended to be grounded, upon them or any of them.

[Sect. 4 enacts that the party grieved by pretext of a monopoly, etc., shall recover treble damages and double costs. And sect. 5 refers to letters patent for twenty-one years already granted. The all-important section is the next.]

6. Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm, to the true

and first inventor or inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the state, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accompted from the date of the first letters patents 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.

. . . . . .

[The remaining sections of the Act have become obsolete or have been repealed.]

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46 & 47 Vict. c. 57.

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

[The sections relating to the Registration of Designs and of Trade Marks are not here reprinted.]

BE it enacted, &c., as follows:—

PART I.—PRELIMINARY.

Short title.

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

Division of Act into parts.

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

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

Commencement of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December 1883.

PART II.—PATENTS.

Application for and Grant of Patent.

Persons entitled to apply for patent.

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

(2) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.[1]

Application and specification.

5. (1) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed;[2] and must be left at, or sent by post, to the Patent Office in the prescribed manner.

(2) An application must contain a declaration[3] to the effect that the applicant is in possession of an invention, whereof he, or, in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings if required.[4]

(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.

(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.

Reference of application to examiner.

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

Power for Comptroller to refuse application or require amendment.

7. [As amended by the Patents Act of 1888.] (1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

[1] See Patents Act, 1883, s. 5.
[2] See Rules 5 and 6 of Patents Rules 1890.
[3] See Patents Act, 1885, s. 2.
[4] As to drawings, see Rules 30–33 of Patents Rules 1890.

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

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

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

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

Time for leaving complete specification.

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

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

Comparison of provisional and complete specification

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

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

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

(4) Unless a complete specification is accepted within twelve

[1] The Comptroller is empowered to grant further time, not exceeding one month. (See s. 3 of Patents Act, 1885.)

months [1] from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

(5) [As amended by the 3rd sect. of the Act of 1888.] Reports of examiners shall not in any case be published or open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specification or specifications, with the drawings, if any, shall be open to public inspection.

Opposition to grant of patent.

11. [As amended by the 4th sect. of the Act of 1888.] (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.

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

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

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

[1] The Comptroller is empowered to grant further time, not exceeding three months. (See sect. 3 of Act, 1885.)

Sealing of patent.

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

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

(3) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months[1] from the date of application, except in the cases hereinafter mentioned, that is to say—

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

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

Date of patent.

13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

Provisional Protection.

Provisional protection.

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

Protection by Complete Specification.

Effect of acceptance of complete specification

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed

[1] A further extension of four months after the fifteen months is allowed for the sealing of the patent by sect. 3 of the Act of 1885.

on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

Patent.

Extent of patent.

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

Term of patent.

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

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

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

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

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

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

Amendment of Specification.

Amendment of specification.

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

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

(5) Where no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

(6) When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.

(7) The law officer shall, if required, hear the person making the request and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before amendment.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all Courts, and for all purposes, be deemed to form part of the specification.

(10) [As amended by sect. 5 of the Act of 1888.] The foregoing provisions of this section do not apply when, and so long as, any action for infringement or proceeding for revocation of a patent is pending.

Power to disclaim part of invention during action, etc.

19. In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention

before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

Advertisement of amendment.

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

Compulsory Licences.

Power for Board to order grant of licences.

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

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

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

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

the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Register of Patents.

Register of patents.

23. (1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

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

(3) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.

Fees.

Fees in schedule.

24. (1) There shall be paid in respect of the several instruments described in the Second Schedule to this Act the

fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

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

Extension of Term of Patent.

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

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

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

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

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

(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

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

Revocation.

Revocation of patent

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

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

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

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

(*a*) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland;

(*b*) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland;

(*c*) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims;

(*d*) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee;

(*e*) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

(6) Particulars delivered may be from time to time amended by leave of the Court or a judge.

(7) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8) Where a patent has been revoked on the ground of fraud,

the Comptroller may, on the application of the true inventor, made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked; but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

Crown.

Patent to bind Crown.

27. (1) A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.

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

Legal Proceedings.

Hearing with assessor.

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

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

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

Delivery of particulars.

29. (1) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

(2) The defendant must deliver with his statement of defence, or, by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and, if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

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

(6) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they, respectively, shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

Order for inspection, etc., in action.

30. In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction inspection or account, and impose such terms, and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

Certificate of validity questioned and costs thereon.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies, then, in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

Remedy in case of groundless threats of legal proceedings.

32. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage, if any, as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Miscellaneous.

Patent for one invention only.

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

Patent on application of representative of deceased inventor.

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

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

Patent to first inventor not invalidated by application in fraud of him

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Assignment for particular places.

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

Loss or destruction of patent.

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

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and, in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.

Exhibition at industrial or international exhibition not to prejudice patent rights.[1]

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the inven-

[1] As to the extension of these provisions, with certain modifications, to industrial and international exhibitions held out of the United Kingdom, see sect. 3 of the Act of 1886.

tion 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.

Publication of illustrated journal, indexes, etc.

40. (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.

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

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

Patent Museum.

41. The control and management of the existing Patent Museum and its contents shall, from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give.

Power to require models on payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model: the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels in British waters.

43. (1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United King-

dom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

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

Assignment to Secretary for War of certain inventions.

44. (1) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression 'the inventor') may (either for or without valuable consideration) assign to her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the Comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State so certifies, the application and specification or specifications, with the drawings, if any, and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State.

(5) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State or of the law officers.

(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand of the Secretary of State to receive the same, and shall if returned to the Comptroller be again kept sealed by him.

(7) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the Secretary of State to receive it.

(8) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings, if any, shall be forthwith placed in a packet sealed by authority of the Comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorised by him to investigate the same or the merits thereof, shall not, nor shall anything be done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Existing Patents.

Provisions respecting existing patents.

45. (1) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences.

(3) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on application then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

Definitions.

Definitions of patent, patentee, and invention.

46. In and for the purposes of this Act—

'Patent' means letters patent for an invention;

'Patentee' means the person for the time being entitled to the benefit of a patent;

'Invention' means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled 'An Act concerning monopolies and dispensations, with penal laws and the forfeiture thereof'), and includes an alleged invention.

In Scotland 'injunction' means 'interdict.'

[Sections forty-seven to sixty-one relate exclusively to the Registration of Designs, and sections sixty-two to eighty-one exclusively to the Registration of Trade Marks.]

PART V.—GENERAL.

Patent Office and Proceedings thereat.

Patent Office.

82. (1) The Treasury may provide for the purposes of this Act an office, with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) Until a new Patent Office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of Patents, Designs, and Trade Marks, who shall act under the superintendence and direction of the Board of Trade.

(4) Any act or thing directed to be done by or to the Comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

Officers and clerks.

83. (1) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the Comptroller-General of Patents, Designs, and Trade Marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same, and the other expenses of the execution of this Act, shall be paid out of money provided by Parliament.

Seal of Patent Office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied, or constructive.

Refusal to grant patent, etc., in certain cases.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in registers.

87.[1] 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 to any rights appearing from such register to be vested in any other person, have power

[1] Sections 87, 88, and 90 are here given as amended by sections 21, 22, and 23 of the Act of 1888.

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.

Inspection of and extracts from registers.

88.[1] Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.

90.[1] (1) The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2) The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

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

Power for Comptroller to correct errors.

91. The Comptroller may, on request in writing, accompanied by the prescribed fee—

(*a*) Correct any clerical error in or in connection with an application for a patent; or

(*b*) Correct any clerical error in the name, style, or address of the registered proprietor of a patent.

[1] See note on previous page.

(*c*) Cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

[Section 92 relates to the alteration of a registered trade mark.]

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Exercise of discretionary power by Comptroller.

94. Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, without, if so required within the prescribed time by the applicant, giving the applicant an opportunity of being heard personally or by his agent.

Power of Comptroller to take directions of law officers.

95. The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Certificate of Comptroller to be evidence.

96. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ-facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Applications and notices by post.

97. (1) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under this Act may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the the post.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day

of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Declaration by infant, lunatic, etc.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee, if any, of such incapable person, or, if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Transmission of certified printed copies of specifications, etc.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

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

(*a*) For regulating the practice of registration under this Act;

(*b*) For classifying goods for the purposes of designs and trade marks;

(*c*) For making or requiring duplicates of specifications, amendment (*sic*), 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.

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

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

(4) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the Comptroller.

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

Annual reports of Comptroller.

102. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Proceedings of Board of Trade.

102A.[1] (1) All things required or authorised under this Act to be done by, to, or before the Board of Trade may be done by, to,

[1] This section was added to the principal Act by the 25th section of the Act of 1888.

or before the President or a secretary or an assistant-secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant-secretary of the Board, or by any person authorised in that behalf by the President of the Board shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

International and Colonial Arrangements.

International arrangements for protection of inventions.

103. [As amended by the 6th sect. of the Act of 1885.] (1) If her Majesty is pleased to make any arrangement with the Government or Governments of any foreign state or states for mutual protection of inventions, 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 in the case of a patent within seven 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 in this country, as the case may be.

(2) The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, shall not invalidate the patent which may be granted for the invention.

(3) 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.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Provision for colonies and India.

104. (1) Where it is made to appear to her Majesty that the

Legislature of any British Possession has made satisfactory provision for the protection of inventions, patented in this country, it shall be lawful for her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British Possession.

(2) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented 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.

Penalty on unauthorised assumption of royal arms.

106. Any person who, without the authority of her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland, Ireland, &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct; but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action, or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section 'Court of Appeal' shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109. (1) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

General saving for jurisdiction of Courts.

111. (1) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents, or to designs, or to trade marks; and, with reference to any such proceedings in Scotland, the term 'the Court' shall mean any Lord Ordinary of the Court of Session, and the term 'Court of Appeal' shall mean either Division of the said Court; and, with reference to any such proceedings in Ireland, the terms 'the Court' and 'the Court of Appeal' respectively mean the High Court of Justice in Ireland and her Majesty's Court of Appeal in Ireland.

(2) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification shall be served on the Comptroller, and he shall rectify the register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement, or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts;

(2) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal; Transitional Provisions; Savings.

Repeal and saving for past operation of repealed enactments, etc.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*a*) Affect the past operation of any of those enactments, or any patent granted, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(*b*) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(*c*) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Former registers to be deemed continued.

114. The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the Register of Patents kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away, abridge, or preju-

dicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. In and for the purposes of this Act, unless the context otherwise requires—

'Person' includes a body corporate;

'The Court' means (subject to the provisions for Scotland, Ireland, and the Isle of Man) her Majesty's High Court of Justice in England;

'Law officer' means her Majesty's Attorney-General or Solicitor-General for England;

'The Treasury' means the Commissioners of her Majesty's Treasury;

'Comptroller' means the Comptroller-General of Patents, Designs, and Trade Marks;

'Prescribed' means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act;

'British Possession' means any territory or place situate within her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one Legislature, as hereinafter defined, are deemed to be one British Possession for the purposes of this Act;

'Legislature' includes any person or persons who exercise legislative authority in the British Possessions; and where there are local Legislatures, as well as a central Legislature, means the central Legislature only.

In the application of this Act to Ireland, 'summary conviction' means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES TO THE PATENTS ACT OF 1883.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

Section 5. For the Forms A, B, and C the Patents Rules have substituted the Forms A, A1, A2, B and C (see pp. 393–7).

Section 33.

Form D.

Form of Patent.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:

Whereas *John Smith*, of 29 *Perry Street*, *Birmingham*, in the county of *Warwick*, *Engineer*, hath by his solemn declaration represented unto us that he is in possession of an invention for '*Improvements in Sewing Machines*,' that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

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

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion, do by these presents, for us, our heirs and successors, give and grant unto the said patentee our special licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United King-

dom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this one thousand eight hundred and and to be sealed as of the one thousand eight hundred and

Seal of Patent Office.

Section 24.

THE SECOND SCHEDULE.

Fees.

For this schedule the First Schedule to the Patents Rules 1890 has been substituted. (See p. 391.)

Section 113.

THE THIRD SCHEDULE.

Enactments Repealed.

21 James I. c. 3. [1623.]	The Statute of Monopolies. In part; namely— Sections ten, eleven, and twelve.
5 & 6 Will. IV. c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely— Section eleven.
5 & 6 Will. IV. c. 83. [1835.]	An Act to amend the law touching letters patent for inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled 'An Act to amend the law touching letters patent for inventions.'
	. . . . .
7 & 8 Vict. c. 69. (*a*) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled 'An Act for the better administration of justice in his Majesty's Privy Council, and to extend its jurisdiction and powers.' In part; namely— Sections two to five, both included.
	. . . . .
15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.

(*a*) NOTE.—Sections six and seven of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

16 & 17 Vict. c. 115. [1858.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
	. . . . .
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part; namely— Section five.
	. . . . .

PATENTS ACT, 1885.

[48 AND 49 VICT. CH. 63.]

An Act to amend the Patents, Designs, and Trade Marks Act, 1883. A.D. 1885.

BE it enacted by, &c., as follows:—

Construction and short title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment of s. 5 of 46 & 47 Vict. c. 57.

2. Whereas subsection two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that subsection mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that:—

The declaration mentioned in subsection two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

5 & 6 W. 4, c. 62.

Amendment of ss. 8, 9, & 12 of 46 & 47 Vict. c. 57.

3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the Comptroller to extend in certain cases the said times: Be it therefore enacted as follows:—

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively, after the said nine and twelve months respectively as the Comptroller may, on payment of the prescribed fee, allow, and where such extension of time has been allowed a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Specifications, etc., not to be published unless application accepted.

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.

Power to grant patents to several persons jointly.

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.

Amendment of s. 103 of 46 & 47 Vict. c. 57.

6. In subsection one of section one hundred and three of the principal Act, the words 'date of the application' shall be substituted for the words 'date of the protection obtained.'

PATENTS ACT, 1886.

[49 AND 50 VICT. C. 37.]

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.

46 & 47 Vict. c. 57.

Whereas by section five of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:—

Be it therefore enacted by, &c., as follows:—

Short title and construction 46 & 47 Vict. c. 57. 48 & 49 Vict. c. 63.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

The same drawings may accompany both specifications.

2. The requirement of subsection four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.

Protection of patents and designs exhibited at international exhibitions.

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the Comptroller the prescribed notice of his intention to do so:—

And whereas it is expedient to provide for the extension

of the said sections to industrial and international exhibitions held out of the United Kingdom: Be it therefore enacted as follows:—

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

PATENTS ACT, 1888.

[51 & 52 VICT. CH. 50.]

A.D. 1888.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

Whereas it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act:

46 & 47 Vict. c. 57.

Be it therefore enacted, &c., as follows:—

Register of patent agents.

1. (1) After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been *bonâ fide* practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5) In this section 'patent agent' means exclusively an agent for obtaining patents in the United Kingdom.

Amendments of 46 & 47 Vict. c. 57.

2. For section seven of the principal Act the following section shall be substituted, namely:—

s. 7, as to applications.

'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 invention, the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with.

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

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

'(4) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant.

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

s. 9, as to disclosure of reports of examiners.

3. In subsection five of section nine of the principal Act the words 'other than an appeal to the law officer under this Act' shall be omitted.

s. 11, as to opposition grant of patent.

4. In subsection one of section eleven of the principal Act the words from 'or on the ground of an examiner' to 'a previous application,' both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, 'or on the ground that the complete specification describes or claims an invention other than that described in the provisional specifica-

tion, 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.'

s. 18, as to amended specifications.

5. For subsection ten of section eighteen of the principal Act the following subsection shall be substituted, namely:—

'(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending.'

[Sections 6 to 20 relate to Designs and Trade Marks.]

s. 87, as to entry of assignments, etc.

21. In section eighty-seven of the principal Act, after the words 'subject to,' shall be added the words 'the provisions of this Act and to.'

s. 88, as to inspection.

22. In section eighty-eight of the principal Act, after the words 'subject to,' shall be added the words 'the provisions of this Act and to.'

s. 90, as to rectification of register.

23. In section ninety of the principal Act, after the words 'of the name of any person,' shall be added the words 'or of any other particulars.'

[Section 24 relates to Designs and Trade Marks.]

Proceedings of Board of Trade.

25. After section one hundred and two of the principal Act the following section shall be added, and numbered 102A; namely,

'(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade may be done by, to, or before the President or a secretary or an assistant-secretary of the Board.

'(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to by signed by a secretary or assistant-secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

'(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.'

[Section 26 relates to Trade Marks.]

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act; but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine. Commencement of Act.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888. Short title.

INTERNATIONAL CONVENTION AND PROTOCOL.

Article I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the protection of industrial property.[1]

Article II.

The subjects or citizens of each of the contracting states shall, in all other states of the Union, as regards patents . . . enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal recourse on any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each state.[2]

Article III.

Subjects or citizens of states not forming part of the Union, who are domiciled or have industrial or commercial establishments on the territory of any of the states of the Union, shall be assimilated to the subjects or citizens of the contracting states.

Article IV.

Any person who has duly registered an application for a patent . . . in one of the contracting states shall enjoy, as

[1] *Vide* paragraph 1 of Protocol.
[2] *Vide* paragraph 3 of Protocol.

regards registration in the other states, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other states of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by registration, by publication of the invention, or the working of it by a third party . . .

The above-mentioned terms of priority shall be six months for patents and three months for designs, models, and trade-marks. A month longer is allowed for countries beyond sea.

Article V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the states of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work (*exploiter*) his patent in conformity with the laws of the country into which he introduces the patented objects (*où il introduit les objets brevetés*).

[Articles VI.–X. relate exclusively to Designs and Trade Marks.]

Article XI.

The high contracting parties agree to grant temporary protection to patentable inventions, . . . for articles appearing at official or officially recognised International Exhibitions.

Article XII.

Each of the high contracting parties agrees to establish a special government department for industrial property, and a central office for communication to the public of patents. . . .

Article XIII.

An international office shall be organised under the name of 'Bureau International de l'Union pour la Protection de la Propriété Industrielle.' (International Office of the Union for the Protection of Industrial Property.)

This office, the expense of which shall be defrayed by the Governments of all the contracting states, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the states of the Union.

ARTICLE XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end conferences shall be successively held in each of the contracting states by delegates of the said states. The next meeting shall take place, in 1885, at Rome.

ARTICLE XV.

It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present Convention.

ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

This adhesion shall be notified diplomatically to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply, *de jure*, accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

ARTICLE XVII.

The carrying out of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are obliged to elicit their application, which they engage to do as early as possible.

ARTICLE XVIII.

The present Convention shall come into operation within one month after exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the state which shall have denounced the Convention —the Convention remaining intact for the other contracting parties.

ARTICLE XIX.

The present Convention shall be ratified, and the ratifications of it exchanged in Paris, within one year at the latest.

In witness whereof the respective Plenipotentiaries have signed it, and thereto affixed their seals.

Done at Paris the 20th of March, 1883.

PROTOCOL.

The plenipotentiaries of the contracting states, when signing the accompanying Convention, at the same time signed an explanatory Protocol, the substance of which is as follows :—

1. The words 'industrial property' are to be understood in their broadest sense ; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, etc.), and to mineral products employed in commerce (mineral waters, etc.).

2. Under the word 'patents' are comprised the various kinds of industrial patents recognised by the legislation of the contracting states, such as *improvement patents, etc.*

3. The last paragraph of Article II. does not affect the legislation of the contracting states, relating to legal procedure, jurisdiction, etc.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade-mark shall be excluded from protection in any state of the Union, because it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that state, provided that on this point it comply with the legal requirements of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and otherwise reserving the clauses of the other articles of the Convention, the internal legislation of each state remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be taken to be contrary to public order in the sense of last paragraph of Article VI.

5. Each country of the Union shall publish, if practicable, an official newspaper, in connection with the special government department mentioned in Article XII.

6. This paragraph relates to the working of the International Office at Berne, the expense of which is to be divided in a given proportion amongst the several states forming the Union.

7. The present Protocol, which shall be ratified along with the Convention, shall have the same force, validity, and duration as the Convention itself.

Rules, Forms, and Fees.

PATENTS RULES, 1890, *RELATING TO APPLICATIONS FOR PATENTS FOR INVENTIONS AND PROCEEDINGS THEREON, AND REGISTRATION OF PATENTS, WITH LIST OF FEES.*

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

Short Title.

1. These Rules may be cited as the Patents Rules, 1890. Short title.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st day of March 1890. Commencement.

Interpretation.

3. In the construction of these Rules, any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

4. The fees to be paid under the above-mentioned Acts shall be those specified in the list of fees in the First Schedule to these Rules. Fees.

Forms.

5. The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A1, A2, B, and C in the Second Schedule to these Rules. Forms. Alterations.

6. (1) An application for a patent containing the declaration mentioned in the subsection 2 of section 5 of the Act of 1883, and section 2 of the Act of 1885 shall be made either in the Form A or the Form A1, or the Form A2, set forth in the Second Schedule to these Rules as the case may be. Application.

(2) The Form B in such Schedule of provisional specification Specification.

and the Form C of complete specification shall respectively be used.

Other forms.

(3) The remaining forms other than A, A1, A2, B, and C, set forth in the Second Schedule to these Rules, may, as far as they are applicable, be used in any proceedings under these Rules.

General.

Hours of business.

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

Christmas day.

Good Friday.

The day observed as her Majesty's birthday.

The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Agency.

8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the Comptroller, and all attendances by the applicant upon the Comptroller, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and if he so require, resident in the United Kingdom.

Statement of address.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the Comptroller. He may in any particular case require that the address mentioned in this rule be in the United Kingdom.

Size, etc., of documents.

10. All documents and copies of documents except Statutory Declarations and affidavits sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in large and legible characters and, unless otherwise directed, in the English language, upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of 2 inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

Exercise of discretionary power by Comptroller.

11. Before exercising any discretionary power given to the Comptroller by the said Acts, adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may

think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

Notice of hearing.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.[1]

Notice by applicant.

13. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Comptroller may require statement, etc.

14. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby.

Decision to be notified to parties.

15. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice[2] in writing of his intention to exhibit, publish, or use the invention, as the case may be.

Industrial or international exhibitions.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made the applicant shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

16. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

Power of amendment, etc.

16A. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller or to any other person under these Rules, may be

[1] As to this notification see Form E.

[2] The form of this notice is given in Form O.

sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

Manner in which, and persons before whom, Declaration is to be taken.

17. The Statutory Declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

(*a*) In the United Kingdom before any Justice of the Peace or any Commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose af any legal proceeding.

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

(*c*) If made out of her Majesty's dominions before a British minister, or person exercising the functions of a British minister, or a consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a judge or magistrate.

17A. Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject.

Application with Provisional or Complete Specification.

Order of recording applications.

18. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

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

Application for separate patents by way of amendment.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the Comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall, if the applicant notify his desire

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

Application by representative of deceased inventor.

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require.

Notice and advertisement of acceptance.

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

Inspection on acceptance of complete specification.

22. Upon the publication of such advertisement of acceptance in the case of a complete specification, the application and specification or specifications with the drawings, if any, may be inspected at the Patent Office upon payment of the prescribed fee.

Application on Communication from Abroad.

Communication from abroad.

23. An application for a patent for an invention communicated from abroad shall be made in the form A1 set forth in the Second Schedule to these Rules.[1]

International and Colonial Arrangements.

24. The term 'foreign application' shall mean an application by any person for protection of his invention in a Foreign State or British Possession to which by any order of Her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

25. An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify all the Foreign States or British Possessions in which foreign applications have been made and the official date or dates thereof respectively. The application must be made within 7 months from the date of the first foreign application, and must be 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

[1] The Patent Office requires that applicants using Form A1 must be resident in the United Kingdom.

personal representative of such dead person, as well as by the other applicants, if any.

26. The application in the United Kingdom shall be made in the Form A2 in the second Schedule to these Rules, and in addition to the specification, provisional or complete, left with such application, must be accompanied by

(1) A copy or copies of the specification and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such Foreign State or British Possessions as aforesaid, or otherwise verified to the satisfaction of the Comptroller ;

(2) A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification or document corresponding thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

27. On receipt of such application, together with the prescribed specification and the other document or documents accompanying the same, required by the last preceding rule, and with such other proof, if any, as the Comptroller may require of or relating to such foreign application or of the official date thereof, the Comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

28. All further proceedings in connection with such application shall be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications.

29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

Sizes and methods of preparing Drawings accompanying Provisional or Complete Specifications.

Drawings for specifications.

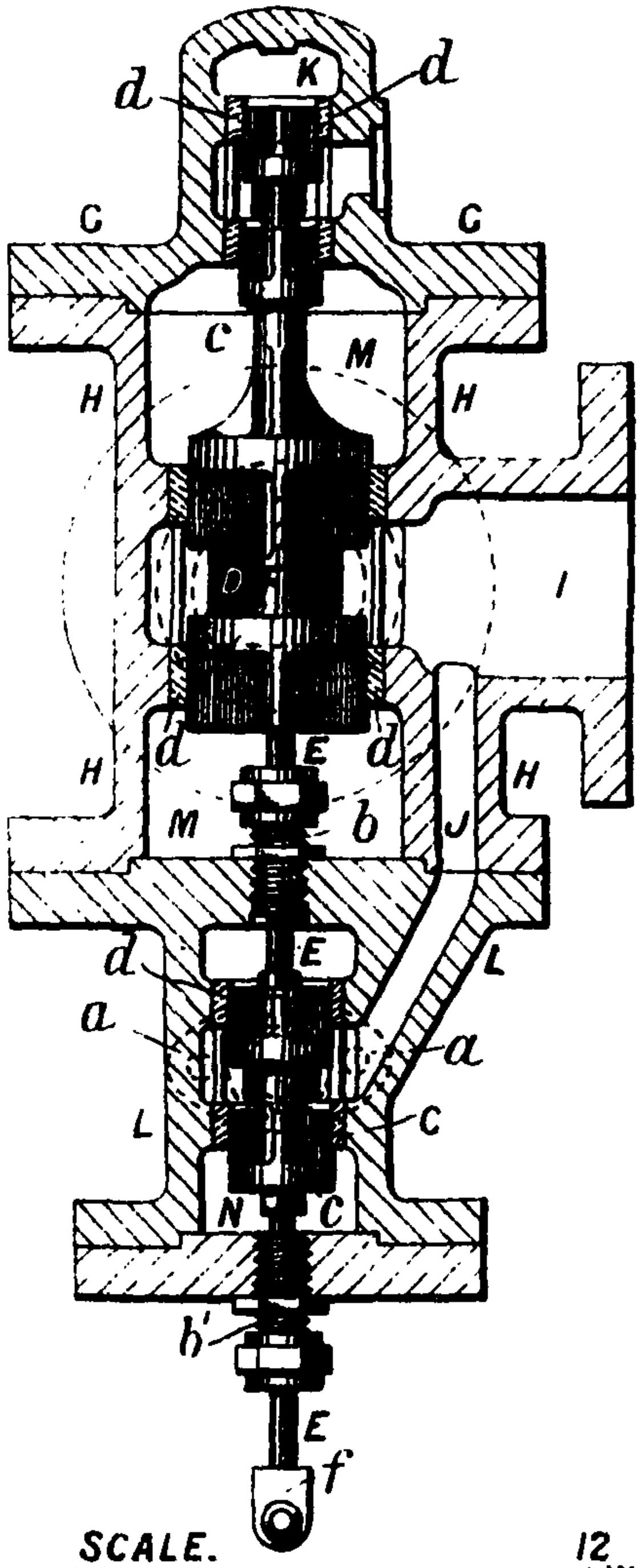
30. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but, if drawings are furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 33.

Specimen drawing for Specifications.

Border line ½ an inch from edge of paper.

A. D. 1883. No. 1974. 1 Sheet
Smith's Specification 1 Sheet

FIG. 1.



0 SCALE. 12
INS. INS.

Jas Smith (Applicant)
or Jones & Co
Agents for Applicants.

Border line ½ an inch from edge of paper

Size of paper for Specification drawing { 13 inches by 8 inches. or 13 " " 16 inches.

No drawing or sketch such as requires a special engraving for letterpress should appear in the specification itself.

31. Drawings, if any, must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

Requirements as to paper, etc.

They must be made on pure white, hot-pressed, rolled, or calendered drawing paper of smooth surface and good quality,[1] and where possible without colour or Indian-ink washes.

Size of drawings.

They must be on sheets of one of the two following sizes (the smaller being preferable): 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be half an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

Quality of ink.

To insure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration of this requirement. Reference figures and letters must be bold, distinct, not less than $\frac{1}{8}$ of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shown outside the figure, and connected with the part referred to by a fine line.

Scale of drawings.

The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, etc., need be shown as effects this purpose. When the scale is shown on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Drawings to bear name of applicant etc.

Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent and the number of each sheet in the *right-hand top corner*; and

[1] As the drawings are copied at the Patent Office for publication by the process of photo-lithography, this rule must be *strictly* observed in order that correct copies may be made.

the signature of the applicant or his agent in the *right-hand bottom corner*.

No written description of the invention should appear on the drawings.

Restrictions as to wood engravings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

Copies of drawings.

32. A *facsimile* of the original drawings, but *without* colour or Indian-ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked 'true copy.'

Provisional drawings used for complete specification.

33. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those 'left with the provisional specification.'

Opposition to Grants of Patents.

Notice of opposition.

34. A notice of opposition to the grant of a patent shall be on Form D, and shall state the ground or grounds on which the person giving such notice (hereinafter in Rules 37, 38, 41, and 43 called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

Copy for applicant.

35. On receipt of such notice the copy thereof shall be transmitted by the Comptroller to the applicant.

Particulars of prior patent.

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

Opponent's evidence.

37. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

Applicant's evidence.

38. Within 14 days from the delivery of such list the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within 14 days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply,

Evidence in reply.

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

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

Closing of evidence.

39. No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application in writing made to him for that purpose.

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Notice of hearing.

41. On completion of the evidence, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the Comptroller an application on Form E. The Comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard, the Comptroller shall decide the case and notify his decision to the parties.

Disallowance of opposition in certain cases.

42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition; and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

Decision to be notified to parties.

44. The decision of the Comptroller after hearing any party who applies under Rule 41 shall be notified by him to the parties.

Certificates of Payment or Renewal.

Payment of fees of 50*l.* and 100*l.* for continuance of patent.

45. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to keep the same in force, he shall, before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee of 50*l.* or 100*l.* as the case may be.

As to patents granted

46. In the case of patents granted before the commencement of the said Acts, the above Rule shall be read as if the words

before commencement of Act.

'seventh year' were therein written instead of the words 'eighth year.'

Payment of annual fees in lieu of 50*l.* and 100*l.*

47. If the patentee intends to pay annual fees in lieu of the above-mentioned fees of 50*l.* and 100*l.*, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the thirteenth year thereof pay the prescribed fee. The Form J in the second Schedule, duly stamped, should be used for the purpose of this and the payment referred to in Rule 45.

Certificate of payment.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.[1]

Extension of time for leaving and accepting complete specification.

50. An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances, and upon what grounds, such extension is applied for, and the Comptroller may require the applicant to substantiate such allegations by such proof as the Comptroller may think necessary.

In other cases.

51. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Amendment of Specification.

Request for leave to amend.

52. A request[2] for leave to amend a specification must be signed by the applicant or patentee (hereinafter in Rules 54, 55, and 58 called the applicant) and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by

Advertisement.

publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner, if any, as the Comptroller may in each case direct.

Notice of opposition

53. A notice of opposition[3] to the amendment shall state the

[1] See Form K. [2] See Form F.

[3] The form of this notice is given by Form G.

ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

Copy for the applicant.

54. On receipt of such notice a copy thereof shall be transmitted by the Comptroller to the applicant.[1]

Opponent's evidence.

55. Within 14 days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof,

Further proceedings.

56. Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41, and 44 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Requirements thereon.

57. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31.

Leave by order of Court.

58. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office.

Advertisement of amendment.

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

Compulsory Licences.

Petition for compulsory grant of licences.

60. A petition to the Board of Trade for an order upon a patentee to grant a licence shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

To be left with evidence at Patent Office.

61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits or statutory declarations, and other documentary evidence, if any, tendered by the petitioner in proof of the alleged default of the patentee.

[1] Applications to be heard by the Comptroller must be in Form E.

Directions as to further proceedings unless petition refused.

62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the Comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure. Petitioner's evidence.

63. If and when a *primâ-facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition, and of the affidavits or statutory declarations and other documentary evidence, if any, tendered in support thereof.

Patentee's evidence.

64. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

Evidence in reply.

65. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

Further proceedings.

66. Subject to any further directions which the Board of Trade may give, the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition.

Register of Patents.

Entry of grant.

67. Upon the sealing of a patent the Comptroller shall cause to be entered in the register of patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request for entry of subsequent proprietorship.

68. Where a person becomes entitled to a patent or to any share or interest therein, by assignment, either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request [1] for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

Signature of request.

69. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor,

[1] See Form L.

or by his agent duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised in like manner.

Particulars to be stated in request.

70. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

Production of documents of title and other proof.

71. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall be produced to the Comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the Comptroller.

Copies for Patent Office.

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

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

Body corporate.

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

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

74. Where an order has been made by her Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent or the rectification of the register under section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Entry of payment of fees on issue of certificate.

75. Upon the issue of a certificate of payment under Rule 48, the Comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

Entry of failure to pay fees.

76. If a patentee fails to make any prescribed payment within the prescribed time, or any enlargement thereof duly granted, such failure shall be duly entered in the register.

Entry of licences.

77. An attested copy of every licence granted under a patent shall be left at the Patent Office by the licensee, with a request [1] that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the Comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

Hours of inspection of register.

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

(*a*) Christmas day, Good Friday, the day observed as her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

(*b*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(*c*) Times when the register is required for any purpose of official use.

Certified copies of documents.

79. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

Power to dispense with Evidence, etc.

80. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

[1] See Form M.

Repeal.

81. All general rules heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules or to any application then pending. Repeal.

Dated the 31st day of March, 1890.

M. E. HICKS-BEACH,
President of the Board of Trade.

FIRST SCHEDULE.

List of Fees Payable on and in connection with Letters Patent.
Up to Sealing.

		£ s. d.	£ s. d.
1.	On application for provisional protection .	1 0 0	
2.	On filing complete specification . .	3 0 0	
			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
7.	On application to amend specification:—		
	Up to sealing. By applicant		1 10 0
8.	After sealing. By patentee		3 0 0
9.	On notice of opposition to amendment. By opponent		0 10 0
10.	On hearing by Comptroller. By applicant and by opponent respectively		1 0 0
11.	On application to amend specification during action or proceeding. By patentee		3 0
12.	On application to the Board of Trade for a compulsory licence. By person applying		5 0 0
13.	On opposition to grant of compulsory licence. By patentee		5 0 0
14.	On certificate of renewal:—		
	Before end of four years from date of patent . .		50 0 0
15.	Before end of seven years, or in the case of patents granted under the 'Patents, Designs, and Trade Marks Act, 1883,' before the end of eight years from date of patent		100 0 0

		£	s.	d.
	Or in lieu of the fees of 50*l.* and 100*l.* the following annual fees:—			
16.	Before the expiration of the 4th year from the date of the patent.	10	0	0
17.	„ „ „ 5th „ „ .	10	0	0
18.	„ „ „ 6th „ „ .	10	0	0
19.	„ „ „ 7th „ „ .	10	0	0
20.	„ „ „ 8th „ „ .	15	0	0
21.	„ „ „ 9th „ „ .	15	0	0
22.	„ „ „ 10th „ „ .	20	0	0
23.	„ „ „ 11th „ „ .	20	0	0
24.	„ „ „ 12th „ „ .	20	0	0
25.	„ „ „ 13th „ „ .	20	0	0
	On enlargement of time for payment of renewal fees:			
26.	Not exceeding 1 month	3	0	0
27.	„ 2 months	7	0	0
28.	„ 3 months	10	0	0
29.	For every entry of an assignment, transmission, agreement, licence, or extension of patent . . .	0	10	0
30.	For duplicate of letters patent, each	2	0	0
31.	On notice to Comptroller of intended exhibition of a patent under section 39	0	10	0
32.	Search or inspection fee . . . . . each	0	1	0
33.	For office copies—every 100 words (but never less than one shilling)	0	0	4
34.	For office copies of drawings, cost according to agreement.			
35.	For certifying office copies, MS. or printed . each	0	1	0
36.	On request to Comptroller to correct a clerical error:—Up to sealing	0	5	0
	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
40.	For enlargement of time for acceptance of complete specification:—			
	Not exceeding 1 month	2	0	0
	„ 2 months	4	0	0
	„ 3 months	6	0	0

31st March, 1890. M. E. HICKS-BEACH,
President of the Board of Trade.

Approved,
R. E. WELBY,
For the Lords Commissioners of Her
31st March, 1890. Majesty's Treasury.

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SECOND SCHEDULE.

Patents, Designs, and Trade Marks Acts, 1883 *to* 1888.

Form A.

PATENT.

[*To be accompanied by two Copies of Form B. or of Form C.*]

APPLICATION FOR PATENT.

[*Here insert name and full address and calling of applicant or applicants*], do hereby declare that in possession of an invention the title of which is [*Here insert title of invention*] that [*In the*

case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors] 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 18 .

[*To be signed by applicant or applicants. In the case of a firm each member of the firm must sign.*]

NOTE.—Where application is made through an Agent (Rule 8), the authorisation on the back (if used) should be signed by the applicant or applicants.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorisation to an Agent and statement of address respectively are printed below.

(1.) *Where application is made through an Agent* (*Rule* 8).

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 18 .

[*To be signed by applicant or applicants.*]

(2.) *Where application is made without an Agent* (*Rule* 9).

hereby request that all notices, requisitions, and communications in respect of the within application may be sent to
at

day of 18 .

[*To be signed by applicant or applicants.*]

PATENT.

Form A1.

[*To be accompanied by two copies of Form B. or of Form C.*]

Application for Patent for Invention communicated from Abroad.

I, [*Here insert name and full address and calling of applicant*] of in the county of do hereby declare that I am in possession of an invention the title of which is [*Here insert title of invention*] which invention has been communicated to me by [*Here insert name, address, and calling of communicant*] that I claim to be the true and first inventor thereof; and that the same is not in use within 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 18 .

[*To be signed by applicant or applicants.*]

NOTE.—Where application is made through an Agent (Rule 8), the authorisation on the back, if used, should be signed by the applicant or applicants.

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorisation to an Agent and statement of address respectively are printed below.

(1.) *Where application is made through an Agent (Rule 8).*

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 18 .

[*To be signed by applicant or applicants.*]

(2.) *Where application is made without an Agent (Rule 9).*

hereby request that all notices, requisitions, and communications in respect of the within application may be sent to
at

day of 18 .

[*To be signed by applicant or applicants.*]

PATENT.

Form A2.

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

[*Here insert name and full address and calling of applicant, or of each of the applicants*] do hereby declare that I (or we) have made foreign applications for protection of my (or our) invention of [*Here insert title of invention*] in the following Foreign States and on the following official dates viz.: [*Here insert the names of each Foreign State followed by the official date of the application in each respectively*], and in the following British Possessions and on the following official dates, viz.; [*Here insert the names of each British Possession followed by the official date of the application in each respectively*].

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the [*Here insert the official date of the earliest foreign application*] to the best of 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 [*Here insert the official date of the earliest foreign application*].

[*Signature of applicant or of each of applicants.*]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

To be issued with **Form A, A1,** *or* **A2.**

Form B.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

[*Here insert title as in declaration*]
[*Here insert name, and full address and calling of applicant or applicants as in declaration*] do hereby declare the nature of this invention to be as follows:—[*Here insert short description of invention.*]

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon wide ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the 'Duplicate' thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows:

'Dated this day of 18 .'

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Form C.

Where provisional specification has been left, quote No. and date.
No. ____
Date. ____

PATENT.

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

[*Here insert title as in declaration.*]

[*Here insert name, and full address and calling of applicant or applicants as in declaration*] do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:

[*Here insert full description of invention*, which must end with a distinct statement of claim or claims, in the following form:—

'*Having now particularly described and ascertained the nature of my said Invention, and in what manner the same is to be performed, I declare that what I claim is:*'

Here state distinctly the features of novelty claimed. 1, 2, 3.]

NOTE.—This document must form the commencement of the Complete Specification; the continuation to be upon wide ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Complete Specification and the 'Duplicate' thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows:

'Dated this day of 18 .'

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

[*To be accompanied by an unstamped copy.*]

PATENT.

I [*Here state name and full address*] 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 the grant is opposed*].

(Signed) [*Here insert signature of opponent*]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane. London, W.C.

PATENT.

Form E.

Form of Application for Hearing by the Comptroller.

In cases of refusal to accept, opposition, or applications for amendments, etc.

Sir,

of [*Here insert address*] hereby apply to be heard in reference to and request that I may receive due notice of the day fixed for the hearing.

Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form F.

Form of Application for Amendment of Specification or Drawings.

[*Here state name and full address of applicant or patentee*] seek leave to amend the specification of Letters Patent No. of 188 , as shown in red ink in the copy of the original specification hereunto annexed.

My reasons for making this amendment are as follows: [*Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the Letters Patent*].

(Signed) [*To be signed by applicant.*]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form G.

Form of Opposition to Amendment of Specification or Drawings.

[*To be accompanied by an unstamped copy.*]

[*Here state name and full address of opponent*] hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. of 188 for the following reason: [*Here state reason of opposition*].

(Signed)

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form H.

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENCE.

[To be accompanied by an unstamped copy.]

I [*Here state name and full 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,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Form H1.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENCES.

To the Lords of the Committee of Privy Council for Trade.

THE PETITION of [*Here insert name, full address, and description*] of
in the county of
being a person interested in the matter of this petition as hereinafter described:—

SHEWETH as follows:—

1. A patent dated No. was duly granted to
for an invention of [*Here insert title of invention*].

2. The nature of my interest in the matter of this petition is as follows:—[*Here state fully the nature of petitioner's interest*].

3. [*Here state in detail the circumstances of the case under section 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licences on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.*]

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licences on reasonable terms. [*Here state the ground or grounds on*

which relief is claimed in the language of section 22, subsections (a), (b), or (c), as the case may be.]

Your petitioner therefore prays that an order may be made by the Board of Trade [*Here state the purport and effect of the proposed order, and the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question*], or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

Form I.

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENCE.

PATENT.

[*Here state name and full address*] hereby give notice of objection to the application of
for the compulsory grant of a licence under Patent No.
of 188 .

(Signed)

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Form J.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

hereby transmit the fee prescribed for the continuation in force of [*Here insert name of patentee*] Patent No. ,
of 18 for a further period of .

Name [*Here insert name and full address.*]
Address

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

(This part of the form to be filled in at the Patent Office.)

PATENT.

CERTIFICATE OF PAYMENT OR RENEWAL.

Letters Patent No. of 18 .

This is to certify that 18 .
day of 18 did this
of £ in respect of a period of , make the prescribed payment
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.]

Patent Office, London.

Seal.

PATENT.

Form K.

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

SIR,

I HEREBY apply for an enlargement of time for month in which to make the payment of £ upon my Patent, No. , of 188 . The circumstances in which the payment was omitted are as follows [*See Rule* 49.]

I am,
Sir,
Your obedient Servant,

[*Here insert full address to which receipt is to be sent.*]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form L.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS.

I [*or we. Here insert name, full address, and description*] hereby request that you will enter [*my or our*] name [*or names*] in the Register of Patents:—

[*I or we*] claim to be entitled [*Here insert the nature of the claim*] of the Patent No. of 188 , granted to [*Here give name and address, etc., of patentee or patentees*] for [*Here insert title of the invention*] by virtue of [*Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated*].

And in proof whereof I transmit the accompanying [*Here insert the nature of the document*] with an examined copy thereof. [*Where any document which is a matter of record is required to be left, a certified or official copy in lieu of an attested copy must be left.*]

I am,
Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form M.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENCE IN THE REGISTER OF PATENTS.

SIR,

I HEREBY transmit an attested copy of a licence granted to me by
under Patent No. of 188 , as well as the original licence for verification, and I have to request that a notification thereof may be entered in the Register.

I am, Sir,
Your obedient Servant,

[*Here insert full address.*]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Form N.

PATENT.

APPLICATION FOR DUPLICATE OF PATENT.

Date.

SIR,

I REGRET to have to inform you that the Letters Patent, dated [*Here insert date, No., name, and full address of Patentee*] No. granted to
for an invention of [*Here insert title of invention*] have been [*Here insert the word 'destroyed' or 'lost,' as the case may be*].

I beg therefore to apply for the issue of a duplicate of such Letters Patent. [*Here state interest possessed by applicant in the Letters Patent.*]

[*Signature of Applicant.*]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Form O.

PATENT.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

[*Here state name and full address of Applicant*] hereby give notice of my intention to exhibit a of
at the
Exhibition, which [*State 'opened' or 'is to open'*] of 18 , under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

[*Insert brief description of invention, with drawings if necessary*] herewith enclose

(Signed)

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form P.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

SIR,

I HEREBY request that the following clerical error [*or errors*] in the [*Here state whether in application, specification, or register*] No. of 18 , may be corrected in the manner shown in red ink in the certified copy of the original [*Here state whether in application, specification, or register*] hereunto annexed.

Signature
Full Address

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form Q.

CERTIFICATE OF COMPTROLLER-GENERAL.

Patent Office,
London,
188 .

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

To [*Here insert name and full address of person requiring the information*].

PATENT.

Form R.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

SIR,

[*Here state name or names and full address of applicant or applicants*], hereby request that address now upon the Register may be altered as follows:—

[*Here insert full address.*]

Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form S.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

[*Here state name and full address of applicant*] hereby transmit an office copy of an Order in Council with reference to [*Here state the purport of the order*].

Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

Form T.

PATENT.

Form of Appeal to Law Officer.

I, [*Here insert name and full address of appellant*] hereby give notice of my intention to appeal to the Law Officer from [*Here insert the 'decision' or 'that part of the decision,' as the case may be*] of the Comptroller of the day of 18 , whereby he [*Here insert 'refused [or allowed] application for Patent,' or 'refused [or allowed] application for leave to amend Patent,' or otherwise as the case may be*] No. [*Insert number and year*] of the year 18 .

Signature

Date

N.B.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

Form U.

PATENT.

Form of Application for Extension of Time for leaving a Complete Specification.

Sir,

I hereby apply for extension of time for one month in which to leave a Complete Specification upon application No. dated .

The circumstances in and grounds upon which this extension is applied for are as follows:—[*See Rule* 50.]

Sir,
Your obedient Servant,

[*To be signed by applicant or applicants or his or their agent.*]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Form V.

Form of Application for Extension of Time for Acccptance of a Complete Specification.

SIR,

hereby apply for extension of time for
month for the acceptance of the Complete Specification upon application No. dated .

The circumstances in and grounds upon which this extension is applied for are as follows:—[*See Rule* 50.]

Sir,
Your obedient Servant,

[*To be signed by applicant or applicants or his or their agent.*]

To the Comptroller,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

31st March, 1890. M. E. HICKS-BEACH,
President of the Board of Trade.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

I. When any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Acts, he shall within 14 days from the date of the decision appealed against file in the Patent Office a notice of such his intention.

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

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

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

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

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

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

VIII. The evidence used on appeal to the law officer shall be

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

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

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

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

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

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

XIV. Any notice or other document required to be given to the law officer's clerk, under these Rules, may be sent by a pre-paid letter through the post.

HENRY JAMES, A.G.

FARRER HERSCHELL, S.G.

[Not dated, but issued in 1883.]

PRIVY COUNCIL.

RULES IN PATENT CASES BEFORE THE JUDICIAL COMMITTEE.

RULES TO BE OBSERVED IN PROCEEDINGS BEFORE THE JUDICIAL COMMITTEE OF THE PRIVY COUNCIL UNDER THE ACT OF THE 5TH & 6TH WM. IV., C. 83.[1]

Rule I.—Relates to proceedings for the confirmation of patents under the second section of the repealed Statute, which has not been re-enacted.

Rule II.—A party intending to apply by petition, under section 4 of the said Act [sect. 25 of Patents Act, 1883], shall, in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (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'), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.[2]

[1] Although more than six years have elapsed since the Patents Act of 1883 was passed, the Privy Council has not yet issued a new set of rules in regard to applications for the extension of patents. The rules in use were framed under a repealed Act of Parliament and for the purpose of meeting the requirements of that Act. Though more or less obsolete, they are kept alive by the operation of the sixth subsect. of the twenty-fifth sect. of the Patents Act of 1883 until new rules are issued, as contemplated by the same

[2] The fourth section of the 5 and 6 Wm. IV. c. 83 required the applicant to advertise his intention to apply for a prolongation three times in the *London Gazette* and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resided in case he carried on no such manufacture, or published in the county where he carried on such manufacture or

Rule III.—Petitions under section 4 of the said Act [sect. 25 of Patents Act, 1883] must be presented within one week from the insertion of the last of the advertisements required to be published in the 'London Gazette.'

Rule IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act [sect. 25 subs. 1 of Patents Act, 1883] and the 1st and 2nd of these Rules, and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

Rule V.—All persons entering caveats under section 4 of the said Act [sect. 25 subs. 2 of Patents Act, 1883] and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the 1st of these Rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

Rule VI.—All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

Rule VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

Rule VIII.—The Registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow, in his discretion, all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

Rule IX.—A party applying for an extension of a patent under section 4 of the said Act [sect. 25 of Patents Act, 1883] must lodge at the Council Office six printed copies of the specification, and also four copies of the balance-sheet of expenditure

where he lived in case there should not be any paper published in such town.

In *Derosne's Patent* (4 Moo. P. C. 416, *S. C.* 2 W. P. C. 2) it was held that when the petitioner resided abroad and had no manufactory in England, he would sufficiently comply with these directions if he inserted advertisements in the newspapers published in the towns or county where his licensees were resident.

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. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this Rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General, or other Counsel, on behalf of the Crown, against granting any application made under either the second or fourth section of the said Act [sect. 25 of Patents Act, 1883] in case it shall be thought fit to oppose the same on such behalf.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

REGISTER OF PATENT AGENTS RULES, 1889.

For the purpose of giving effect to the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, the Board of Trade, by virtue of the provisions of the said Act, hereby make the following Rules:—

Register to be kept.

1. A Register shall be kept by the Institute of Patent Agents, subject to the provisions of these Rules and to the Orders of the Board of Trade, for the registration of patent agents in pursuance of the Act.

Contents of Register.

2. The Register shall contain in one list all patent agents who are registered under the Act and these Rules.

Such list shall be made out alphabetically, according to the surnames of the registered persons, and shall also contain the full name of each registered person, with his address, the date of registration, and a mention of any honours, memberships, or other additions to the name of the registered person which the Council of the Institute may consider worthy of mention in the Register. The Register shall be in the Form 1 in Appendix A., with such variations as may be required.

Printed copies to be published annually, and to be evidence of contents of Register.

3. The Institute shall cause a correct copy of the Register to be, once every year, printed, under their direction, and published and placed on sale. Such correct copy shall, in the year 1889, be printed and published at as early a date as is possible, and in every year subsequent to the year 1889 shall be printed and published on the 31st day of January. A copy of the Register for the time being purported to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the Register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act.

Registrar.

4. The Institute shall appoint a Registrar, who shall keep

the Register in accordance with the provisions of the Act and these Rules, and, subject thereto, shall act under the directions of the Institute and the Board of Trade.

Registration of persons who were patent agents prior to the passing of this Act.

5. A person who is desirous of being registered in pursuance of the Act on the ground that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, shall produce or transmit to the Board of Trade a statutory declaration in the Form 2 in Appendix A.; provided that the Board of Trade may in any case in which they shall think fit, require further or other proof that the person had prior to the passing of the Act been *bonâ fide* practising as a patent agent. Upon the receipt of such statutory declaration or of such further or other proof to their satisfaction as the case may be, the Board of Trade shall transmit to the Registrar a certificate that the person therein named is entitled to be registered in pursuance of the Act, and the Registrar shall on the receipt of such certificate cause the name of such person to be entered in the Register.

Final qualifying examination for registration.

6. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board of Trade that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent unless he has passed, and produces or transmits to the Registrar a certificate under the seal of the Institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the Institute shall from time to time prescribe.

Exemption of pupils and assistants, solicitors and law agents, from preliminary examination.

7. Any person who has been for at least seven consecutive years continuously engaged as a pupil or assistant to one or more registered patent agents, and any person for the time being entitled to practise as a Solicitor of the Supreme Court of Judicature in England or Ireland, or as a law agent before the Court of Session in Scotland, shall be entitled to be registered without passing any examination other than the final examination provided for in the last preceding Rule. The Registrar shall before registering the name of any such person as a patent agent (in addition to the final examination certificate) require proof satisfactory to the Registrar that such person has been for at least seven consecutive years continuously engaged as such pupil or assistant, or is entitled to practise as such Solicitor or Law Agent.

Qualifications of persons generally for registration.

8. Any person who is not qualified under Rule 7 must, in order to be entitled to present himself for the final qualifying examination, be—

A person who has passed one of the preliminary examinations mentioned in Appendix B., or such other examination as the Institute shall, with the approval of the Board of Trade, by regulation prescribe.

Final qualifying examinations to be held by the Institute.

9. The Institute shall hold at least once in the year, commencing with the first day of July 1889, and in every other succeeding year, a final qualifying examination, which shall be the final qualifying examination required under Rules 6 and 7; and the Institute shall, subject to these Rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters, that is to say,

(*a*) The subjects for and the mode of conducting the examination of candidates;

(*b*) The times and places of the examinations, and the notices to be given of examinations;

(*c*) The certificates to be given to persons of their having passed the examinations;

(*d*) The appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and

(*e*) Any other matter or thing as to which the Institute may think it necessary to make regulations for the purpose of carrying out this Rule.

Corrections of names and addresses in Register.

10. The Registrar shall from time to time insert in the Register any alteration which may come to his knowledge in the name or address of any person registered.

Erasure of names of deceased persons.

11. The Registrar shall erase from the Register the name of any registered person who is dead.

Erasure of names of persons who have ceased to practise.

12. The Registrar may erase from the Register the name of any registered person who has ceased to practise as a patent agent, but not (save as hereinafter provided) without the consent of that person. For the purposes of this Rule the Registrar may send by post to a registered person to his registered address a notice inquiring whether or not he has ceased to practise or has changed his residence, and if the Registrar does not within three months after sending the notice receive an answer thereto from the said person, he may, within fourteen days after the expiration of the three months, send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the Registrar; and if the Registrar either before the second notice is sent receives the first notice back from the dead letter office of the Postmaster-General, or

receives the second notice back from that office, or does not within three months after sending the second notice receive any answer thereto from the said person, that person shall, for the purposes of this Rule, be deemed to have ceased to practise, and his name may be erased accordingly.

Erasure of name for non-payment of fees.

13. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the Registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered patent agent shall not within one month from the day named in such notice pay the registration fee so due from him, the Registrar may erase his name from the Register: Provided that the name of a person erased from the Register under this rule may be restored to the Register by direction of the Institute or the Board of Trade on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the Institute or the Board of Trade (as the case may be) may in each particular case direct.

Registrar to act on evidence.

14. In the execution of his duties the Registrar shall, subject to these Rules, in each case act on such evidence as appears to him sufficient.

Erasure of incorrect or fraudulent entries.

15. The Board of Trade may order the Registrar to erase from the Register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

Erasure of names of persons convicted of crimes, and persons found guilty of disgraceful conduct.

16. If any registered person shall be convicted in her Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanor, or, after due inquiry, is proved to the satisfaction of the Board of Trade to have been guilty of disgraceful professional conduct, or, having been entitled to practise as a Solicitor or Law Agent, shall have ceased to be so entitled, the Board of Trade may order the Registrar to erase from the Register the name of such person: Provided that no person shall be adjudged by the Board of Trade to have been guilty of disgraceful professional conduct unless such person has received notice of, and had an apportunity of defending himself from, any charge brought against him.

Restoration of erased name.

17.—(1) Where the Board of Trade direct the erasure from the Register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the Register, except by order of the Board of Trade.

(2.) The Board of Trade may in any case in which they think

fit restore to the Register any name or entry erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee, as the Board of Trade may from time to time fix, and the Registrar shall restore the name accordingly.

(3.) The name of any person erased from the Register at the request or with the consent of such person shall, unless it might, if not so erased, have been erased by order of the Board of Trade, be restored to the Register by the Registrar on his application and on payment of such fee, not exceeding the registration fee, as the Institute shall from time to time fix.

Inquiry by Board of Trade before erasure of name from Register.

18. For the purpose of exercising in any case the powers of erasing from and of restoring to the Register the name of a person, or an entry, the Board of Trade may appoint a committee consisting of such persons as they shall think fit. Every application to the Board of Trade for the erasure from, or restoration to, the Register of the name of any patent agent shall be referred for hearing and inquiry to the committee, who shall report thereon to the Board of Trade, and a report of the committee shall be conclusive as to the facts for the purpose of the exercise of the said powers by the Board of Trade.

Appeal to Board of Trade.

19. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board of Trade.

Notice of appeal.

20. A person who intends to appeal to the Board of Trade under these Rules (in these Rules referred to as the appellant) shall within 14 days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the Institute a notice in writing signed by him of such his intention.

Case on appeal.

21. The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

Transmission of notice of appeal to Board of Trade.

22. The appellant shall also immediately after leaving his notice of appeal at the Institute send by post a copy thereof, with a copy of the appellant's case in support thereof, addressed to the Secretary of the Board of Trade, 7 Whitehall Gardens, London.

Directions as to hearing of appeal.

23. The Board of Trade may thereupon give such directions, if any, as they may think fit for the purpose of the hearing of the appeal.

Notice of hearing of appeal.

24. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the Institute and the Registrar.

Hearing and decision of appeal.

25. The appeal may be heard by the President, a Secretary, or an Assistant-Secretary of the Board of Trade, and the decision and order thereon of the President, Secretary, or Assistant-Secretary, as the case may be, shall be the decision of the Board of Trade on such appeal. On the appeal such decision may be given or order made in reference to the subject-matter of the appeal as the case may require.

Fees.

26. The fees set forth in Appendix C. to these Rules shall be paid in respect of the several matters, and at the times and in the manner therein mentioned. The Board of Trade may from time to time, by orders signed by the Secretary of the Board of Trade, alter any of, or add to, the fees payable under these Rules.

Alteration of regulations.

27. Any regulation made by the Institute under these Rules may be altered or revoked by a subsequent regulation. Copies of all regulations made by the Institute under these Rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board of Trade, and if within twenty-eight days after a copy of any regulation has been so transmitted, the Board of Trade by an order signify their disapproval thereof, such regulation shall be of no force or effect; and if, after any regulation under these Rules has come into force, the Board of Trade signify in manner aforesaid their disapproval thereof, such regulation shall immediately cease to be of any force or effect.

Report to Board of Trade.

28. The Institute shall once every year in the month of December transmit to the Board of Trade a report stating the number of applications for registration which have been made in the preceding year, the nature and results of the final examinations which have been held, and the amount of fees received by the Institute under these Rules, and such other matters in relation to the provisions of these Rules, as the Board of Trade may from time to time, by notice signed by the Secretary of the Board of Trade and addressed to the Institute, require.

Definitions.

29. In these Rules, unless the context otherwise requires—

'The Act' means the Patents, Designs, and Trade Marks Act, 1888.

'The Institute' means the Institute of Patent Agents acting through the Council for the time being.

'The Registrar' means the Registrar appointed under these Rules.

'Registered patent agent' means any agent for obtaining patents in the United Kingdom whose name is registered under the Act and these Rules.

Commencement.

30. These Rules shall commence and come into operation on the 12th day of June 1889, but at any time after the making

thereof any appointment or regulations may be made and things done for the purpose of bringing these Rules into operation on the said day.

31. These Rules may be cited as the Register of Patent Agents Rules, 1889. Title.

By the Board of Trade,

COURTENAY BOYLE,
Assistant-Secretary, Railway Department.

The 11th day of June, 1889.

APPENDIX A.

Form 1.

FORM OF REGISTER.

Name.	Designation.	Address.	Date of Registration.

Form 2.

FORM OF STATUTORY DECLARATION.

Register of Patent Agents Rules, 1889.

I, *A.B.* [*insert full name, and in the case of a member of a firm add*, 'a member of the firm of '], of , in the county of , Patent Agent, do solemnly and sincerely declare as follows :—

1. That prior to the 24th December, 1888, I had been *bonâ fide* practising in the United Kingdom as a patent agent.

2. That I acted as patent agent in obtaining the following patents :—

[*Give the official numbers and dates of some patents for the United Kingdom in the obtaining of which the declarant acted as patent agent.*]

3. That I desire to be registered as a patent agent in pursuance of the said Act.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at

APPENDIX B.

Particulars of Preliminary Examinations.

1. The Matriculation Examination at any University in England Scotland, or Ireland.

2. The Oxford or Cambridge Middle Class Senior Local Examinations.

3. The Examinations of the Civil Service Commissioners for admission to the Civil Service.[1]

APPENDIX C.

Fees.

Nature of Fee.	When to be paid.	To whom to be paid.	Amount.
			£ s. d.
For registration of name of patent agent who had been *bonâ fide* in practice prior to the passing of the Act.	On application and before registration.	To the Registrar at the Institute.	5 5 0
For registration of name of any person other than as above.	Do. do.	Do. do.	5 5 0
Annual fee to be paid by every registered patent agent.	On or before November 30 of each year, in respect of the year commencing January 1st following.	Do. do.	3 3 0
On entry of a candidate for the final qualifying examination.	At time of entering name.	Do. do.	2 2 0

[1] In pursuance of Rule 8 the Institute has, with the approval of the Board of Trade, prescribed the following additional examinations :—

4. The First Public Examination before Moderators at Oxford.

5. The Previous Examination at Cambridge.

6. The Examination in Arts for the second year at Durham.

7. The Examination for First Class Certificate of the College of Preceptors (40 & 41 Vict. c. 25, sec. 10).

8. An examination resulting in the obtaining of a Whitworth Scholarship.

APPENDIX

PART II

PATENT LAWS OF FOREIGN COUNTRIES

AMERICA, U. STATES OF
ARGENTINE REPUBLIC
AUSTRIA
BELGIUM
BOLIVIA
BRAZIL
CHILI
COLOMBIA
CONGO FREE STATE
COSTA RICA
DENMARK
ECUADOR
FINLAND
FRANCE
GERMANY
GUATEMALA
HAWAII
HONDURAS
ITALY
JAPAN
LIBERIA
LUXEMBOURG
MEXICO
NICARAGUA
NORWAY
ORANGE FREE STATE
PARAGUAY
PERU
PORTUGAL
RUSSIA
SALVADOR
SPAIN
SWEDEN
SWITZERLAND
TRANSVAAL
TUNIS
TURKEY
URUGUAY
VENEZUELA

PATENT LAWS OF BRITISH COLONIES AND POSSESSIONS ABROAD

BAHAMA ISLANDS
BARBADOES
BORNEO, BRITISH NORTH
BRITISH GUIANA
BRITISH HONDURAS
CANADA
CAPE OF GOOD HOPE
CEYLON
FIJI
HONG KONG
INDIA
JAMAICA
LEEWARD ISLANDS
MALTA
MAURITIUS
NATAL
NEWFOUNDLAND
N. S. WALES
NEW ZEALAND
QUEENSLAND
ST. HELENA
S. AUSTRALIA
STRAITS SETTLEMENTS
TASMANIA
TRINIDAD
VICTORIA
WESTERN AUSTRALIA

PART II

FOREIGN PATENTS.

THE inventor who is not satisfied with the protection afforded him at home should consider well the countries in which his invention is likely to come into use, and also his own personal prospects of pushing his invention abroad, before incurring a large outlay in applications for foreign patents.

There are many rules with respect to foreign patents which differ from our British regulations: for instance, the patent for an imported invention frequently expires with the determination of the grant in that country from which the invention has been imported, and the inventions patented must be put into practice within a certain definite period from the grant, and must be continued in use year by year during the term. Annual and other duties have to be paid, and in some states the patented articles must be made in the country itself, and cannot be imported, and in some prior publication at home is a bar to obtaining a valid patent afterwards.

The International Convention on patents is printed on page 373 of this appendix, and it will be found to make the following important provisions as to patents taken out by subjects of the several states who are parties to it. First, the subjects or citizens of each of the states of the Union will enjoy in all the other states the same advantages as regards patents that their respective laws grant to their own subjects or citizens. Second, any person who has made an application for a patent in any one of the states enjoys, as regards the application for a patent in the other states, a right of priority for a term of six months from the date of the earliest application, a month longer being allowed for countries beyond the sea. Third, the introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the other states does not entail forfeiture, but the patentee must work his patent in conformity

with the laws of the country into which he introduces the patented object. Fourth, the several states agree to grant temporary protection to patentable inventions for articles appearing at officially recognised International Exhibitions. The states which are parties to this Convention are indicated by an asterisk: thus: *Brazil.

The following summaries of Foreign Patent Laws have been carefully revised by patent agents and lawyers practising in the respective states.

* United States of America.

The existing laws of patents in the United States, comprising various Acts of Congress passed from time to time, have been collected and embodied in the Revised Statutes, approved June 4, 1874. There is now no difference in fees paid by citizens and foreigners.

Probably in no country in the world are the rights of inventors more cherished than in the United States, and the number of patents issued there annually far exceeds that granted in any other country.

The facilities for obtaining patents have been largely increased of late years, and no application for an invention possessing any features of novelty and utility is refused, if perseveringly and skilfully prosecuted.

Every original and first inventor, whether native or foreign, may obtain a patent for his invention, provided only it has not been in public use or on sale in the United States for more than two years previously to his application. The application must be in the name of and be executed by, the inventor himself, and must be confined strictly to a single invention.

Patentable invention includes new and useful arts, new machines and implements, new chemical compounds, and new manufactures, but mere applications involving no new results cannot be patented.

By executing and recording in the Patent Office an assignment, the patent may be issued to an assignee.

The petition to the Commissioner of Patents must be accompanied by the first fee of 15 dollars, a specification fully explaining the nature of the invention and the best mode known to the inventor of carrying the same into effect; drawings, if the invention be susceptible of such illustration, and an oath in the prescribed form. The requirement of a model is now practically abolished, being only insisted on in cases where, by reason of its compli-

cated nature, the invention cannot be understood without such aid.

The prosecution of cases before the United States Patent Office is conducted under a complex system of rules, constantly revised by the Secretary of the Interior and Commissioner of Patents, which renders such prosecution difficult and uncertain, and requires the exercise of great care and skill on the part of applicants and their attorneys.

In the order of their filing applications are taken up for examination by one of a corps of thirty skilled examiners, each of whom has under him four assistants and a number of clerks. Precedence is given to applications for inventions that have been patented abroad.

A thorough investigation is then conducted to ascertain the novelty of the invention claimed, the search extending through domestic and foreign patents, and the scientific and industrial publications of different countries bearing on the invention under examination.

If the invention is found to be wholly or partly wanting in novelty, or if the application includes more than one invention, or if any formal defects are discovered, the application is rejected, the reasons therefor being clearly pointed out.

The application may be again presented, either with or without amendment, and a reconsideration obtained. If the applicant is dissatisfied with the final action of the examiner he may appeal upon the points of disagreement to the Board of Examiners-in-Chief. From their decision appeal lies to the Commissioner of Patents in person, and from his to the supreme court of the district of Columbia. For such appeals additional fees are required.

It often happens that two or more applicants before the Patent Office claim the same invention, or that an applicant claims to be the prior inventor of a thing already patented to another. In such case the Commissioner declares an interference, which is a proceeding to determine which of the rival claimants is in law the prior inventor of the thing in dispute. This question is determined, from proofs taken in writing, in the first instance by the Examiner of Interferences. Appeals may be taken the same as in uncontested cases, except that no appeal lies to the supreme court of the district.

Provision is made by law for the reissue of a patent in case of an insufficient or defective specification, or where the patentee has claimed more than is new. Owing to abuse of this privilege, whereby patents have been unduly expanded and made to cover

different inventions from that originally patented, the courts have of late years been very severe in dealing with reissued patents, invariably declaring invalid all those that appear to have been unwarrantably broadened in scope. For this reason reissues are now looked upon with distrust and disfavour, and it becomes of great importance to the inventor that his patent should be taken out in the first instance in such shape as to fully protect the invention, thus avoiding the necessity of a reissue.

The protection afforded by caveats is now generally regarded as of little importance, and is seldom sought. The protection is only open to citizens.

All patents are issued for a term of seventeen years, but if the invention has been previously patented abroad, the patent expires with the foreign patent, or if there be more than one, with that having the shortest term. Under this provision an inventor suffers great disadvantage by delaying his United States application. The practice prevails in America, when an invention is to be patented in several countries, to first file the United States application and prosecute it to allowance. The day for issue of the patent can then be definitely fixed, and the patents in other countries are so obtained as to bear the same date with the United States patent. By this simultaneous issue the inventor may enjoy the full term of all his patents. This course of proceeding is not generally pursued by foreign inventors, who naturally apply in the first instance for the home patent as being of most consequence to them.

It has been recently decided by the Supreme Court U. S. that the United States patent continues in existence during the whole original term of the foreign patent, although the foreign patent may have lapsed.

Upon allowance of a patent the final fee of 20 dollars must be paid.

Applications not prosecuted for two years become abandoned.

No prolongations of patents can be obtained except by special Act of Congress. Improvements upon the original invention must be protected by new patents.

After issue of the patent there are no further taxes required, and no conditions are imposed upon the inventor as to working of his invention.

As the novelty of a patented invention has been established by the Commissioner of Patents after a searching investigation, the presumption of law is that the patent is valid, and the courts will so construe it as to sustain it if possible.

Patents will, however, be declared void—

1. If the specification was *made misleading* for the purpose of deceiving the public.

2. If the thing patented were really the invention of another than the patentee.

3. If the invention had been patented or described in a printed publication before the invention by the patentee.

4. If the invention had been in public use or on sale in the United States for more than two years previously to the filing of the application.

Goods made abroad according to the invention can be imported into the United States without invalidating the patent.

All articles made under the patent must be marked 'patented,' with the date of the patent.

ARGENTINE REPUBLIC.

This republic has established a Patent Office on the model of that of the United States, by a law dated October 11, 1864, and decrees and regulations of October 10, 1864, and November 8, 1866.

Patents are granted for terms of five, ten, or fifteen years for all new and useful inventions and discoveries excepting pharmaceutical compositions, providing that such inventions or discoveries have not been previously published in the republic.

Patents are granted to the inventor or to the assignees of his rights.

The Government fees on a patent are 80, 200, or 350 piastres (*pesos fuertes*), according to its term (in addition to sundry petty stamp duties), one-half of which amount has to be paid at the time of the application, and the remainder after the grant.

Certificates of addition or improvement are also granted both to the original patentee and to others. In the former case one-fourth of the fees required for an original patent have to be paid, and in the latter case one-half of the said fees.

Provisional patents are also granted for one year, the payment for which is 50 piastres. These patents are renewable at the expiration of each year.

Applications for patents are to refer to a single chief object with its accessories and applications.

Patents may be assigned. A patent is invalid if the drawing or specification is incorrect or incomplete. It also becomes void if not worked within two years from the date of issue, or if the working has been interrupted for a similar period, except by

circumstances beyond control or accident. In either case no special judicial decree is required to render the patent null and void.

Proceedings may be taken for infringement.

Articles made abroad according to the patent can be imported into the republic without invalidating the grant.

AUSTRIA.

The patent law of this empire, which has been in force since August 15, 1852, for Austria-Hungary and the principality of Liechtenstein (Germany), has been extended by additional decrees of June 27, 1878, and December 20, 1879, to Bosnia and Herzegowina, and establishes the following regulations throughout the empire :—

Patents are not allowed for alimentary preparations, beverages, and medicines, nor for discoveries, inventions, or improvements which are contrary to public health, public welfare, morality, or the interest of the state. Scientific principles or purely scientific theories cannot be patented. With these exceptions, patents are granted for every new discovery, invention, or improvement, having for its object (*a*) a new industrial product, (*b*) a new means of producing, or (*c*) a new method of producing—that is to say, new within the empire.

An invention is deemed new when it has not been put into operation or been made public in the empire before the application for the patent is made.

Foreigners, as well as Austrian subjects, may be patentees ; but with regard to inventions made by foreigners not resident in Austria, patents are only granted when a patent has been previously obtained in a foreign country for the same object, and then only to the original patentee, or his legal assignee, during the term of his foreign patent.

Two or more inventions cannot be included in a single patent, unless they refer to the same subject-matter, as essential parts of it.

The petition for a patent may be made either by the inventor, if he is a resident of the empire, or by his legal attorney. Foreigners not residing must have a legal attorney. It must state the exact title of the invention, and the number of years for which it is desired to pay the patent tax, as the maximum duration of all patents is fifteen years, provided the tax is paid at once for the entire number of years or by instalments ; the term cannot be exceeded except by special imperial authority.

The amount of Government tax is as follows :—For each of the first five years, 2*l.* 12*s.* 6*d.*; sixth year, 3*l.* 18*s.* 9*d.*; seventh year, 4*l.* 12*s.* 0*d.*; eighth year, 5*l.* 5*s.* 0*d.*; ninth year, 5*l.* 18*s.* 0*d.*; tenth year, 6*l.* 11*s.* 3*d.*; eleventh year, 7*l.* 17*s.* 6*d.*; twelfth year, 9*l.* 3*s.* 9*d.*; thirteenth year, 10*l.* 10*s.* 0*d.*; fourteenth year, 11*l.* 6*s.* 6*d.*; fifteenth year, 13*l.* 2*s.* 6*d.*, or for the entire fifteen years, 918 florins (92*l.*). In addition to these taxes there are also stamps upon petitions, upon each sheet of the specification, drawings, &c.

A description must accompany the petition, and this must contain a full, clear, and minute explanation of the invention and claims, so as to enable all competent persons to manufacture the article according to that specification ; if drawings, samples, or models are required for the full comprehension of the description, they must be supplied in duplicates, one for Austria, one for Hungary.

A patentee is entitled to establish workshops or factories, to employ the workpeople he may find requisite to carry out the object of the patent to its fullest extent, and consequently to form establishments, stores, and warehouses for the manufacture, within the entire empire, under the existing legal prescriptions. He may sell and dispose of the proceeds, and license others to use his invention, take partners, and dispose of his patent right by assignment or in any way whatsoever.

A patent will be cancelled on proof that the legal requisites for a patent do not exist, or that the description does not fulfil the prescribed conditions, or that the invention is not new, or, being an importation from abroad, that the patentee is not the real owner of the foreign patent, or that the object of the patent is contrary to law, or to the health or morality of the public, or the interest of the state.

A patent will expire not only by efflux of the term, but also in case the patentee has not begun to work his invention in the empire with native materials within a year from the date of the patent, or in case he should not work the patented invention to *its whole extent* during every two years following the first beginning of working. Articles made abroad according to the patent can be imported into the empire without invalidating the patent. Patents are invalidated if it is proved (*a*) that the description of the patent is insufficient ; (*b*) that the patented invention, before the date of the official certificate, was not novel in the empire, or that the invention had been imported without having been patented abroad, or that the Austrian patent has not been granted to the

original proprietor of the foreign patent or to his legal assignee; (*c*) if the proprietor of a valid patent proves that the invention patented at a later period is identical with his own discovery or invention previously patented.

* Belgium.

An Act bearing date May 24, 1854, and a royal decree of the same date, and an amending law of March 27, 1857, determine the law of patents in this kingdom.

Patents are granted without previous examination, at the sole risk of the applicants. They may be obtained by the inventor or by any other person with his consent, or by one of several inventors having a foreign patent. They may be obtained in the name of a firm or company. Patents of importation can be obtained for inventions previously patented abroad although the invention may have been published in specifications, &c., according to legal prescriptions.

The duration of patents is fixed at twenty years, except in the case of inventions previously patented in some other country, when the Belgian patent expires with the prior foreign patent having the longest term.

Patents are subject to an annual and progressive tax, viz.:— first year, 10 frs. (8*s*.); second year, 20 frs. (16*s*.); third year, 30 frs. (24*s*.); and so on till the twentieth year, when the tax will be 200 frs. (8*l*.). Each annual tax is to be paid in advance.

No tax is payable on patents for improvement when delivered to the original patentee; specifications can be amended by patents of addition; such patents expire with the original patent, and patents also expire with the term for which a prior patent having the longest term has been granted.

Patents confer on their owners or assigns the exclusive right of working the invention for themselves, or having it worked by persons authorised by them. Articles made according to the patent can be imported from abroad without invalidating the patent so long as the principal manufacture is in Belgium. Proceedings for infringement may be taken before the Belgian tribunals, where the patentee's rights are infringed either by the manufacture, holding, selling, or exposing for sale the patented articles.

Applicants for patents are required to lodge at the proper office, in duplicate, a full description of the invention, with draw-

ing, models, or samples, when necessary. The first annual tax is paid when the documents are lodged.

Specifications of patents are published three months after the grant. The annual tax can be paid within one month after the date when it is due without fine, and can be paid within five months after the expiration of the one month on payment of 10 frs. besides the annual tax.

The owner of a patent must work the invention in Belgium within one year from its having been worked abroad; otherwise the Government will, on presentation of a petition to that effect, declare the patent to be void, and this will be the case if a suspension of the working of the invention for one year takes place, unless good reason can be given.

Patents will become void if the invention is destitute of novelty, either by reason of having been previously worked in Belgium or of having been published in a printed work (unless the publication be entirely the result of legal requirement): if the specification is not full and complete; or in case the invention has been previously patented in Belgium or abroad, the patentee not being the proprietor of the foreign patent, or having his authorisation.

Bolivia.

A law of May 8, 1858, gives protection to inventors and to importers of new inventions for not less than ten or more than fifteen years, but the protection to importers of inventions known abroad is limited to the locality in which the imported invention is worked.

The State is authorised to buy the secret of any invention which, being useful to industry, may be for the general benefit.

The applicant for protection for inventions or improvements must lodge a specification, explaining them, and must also lodge a specimen of the manufacture or product of the invention. When the applicant is an importer he must furnish drawings or models or a detailed description of the principles, methods, and processes of the industry as well as of the product. A commission is then appointed to examine into the subject of the application and to report to the Secretary of the Interior thereon, and within three months of the report the patent, if allowed, is issued; the patent does not guarantee the merit or utility of the invention. A patentee may vary the description of his invention either before or after the grant of a patent. All transfers of the privileges must be by registered assignment.

Articles made abroad according to the invention can be imported into Bolivia without risk of invalidating the patent.

The privileges lapse if the inventor has concealed the true methods of working his invention, or if the inventor uses secret methods not detailed in his description, or if the invention has been published, or if the invention is not fully worked within a year and a day from the date of the grant.

* Brazil.

The law No. 3129 of October 14, 1882, regulates the granting of patents in Brazil. Patents are granted in Brazil for the term of fifteen years, and patents of addition are also granted expiring with the original patent. Foreigners having obtained patents abroad, and applying for their patents in Brazil within seven months from the date of the grant of their foreign patent, are not then prejudiced by any other application, or by the publication of the invention in Brazil in the meantime.

Inventors can also publicly exhibit their inventions in Brazil prior to their applications for patents, on obtaining the necessary permission for the purpose. An inventor desiring to obtain a patent in Brazil must deposit in duplicate a specification in Portuguese, together with drawings of the invention. The application must be limited to one invention only; if the invention has for its object chemical, pharmaceutical, or alimentary products, the Government will order an examination of samples; but if it involves none of these things the patent will issue as of course. During the first year of the patent only the inventor can obtain a patent for improvements. Certificates of improvements are given to the original inventors and appended to the patents.

Goods made according to the invention can be imported from abroad without injury to the patent.

The patent will continue valid so long as the previous foreign patent remains in force, on payment of a duty of 2*l*. 7*s*. 3*d*. for the first year, 3*l*. 10*s*. 10*d*. for the second year, 4*l*. 14*s*. 6*d*. for the third, and so on, increasing 1*l*. 3*s*. 7½*d*. yearly. All assignments must be registered in the Government Office. The patent will become void if the invention is not carried into operation within three years from the grant, or if the working is thereafter interrupted for more than a year, if the annuities are not duly paid, if the patentee residing out of the country has no representative in Brazil, and upon the expiration of an earlier foreign patent for the same invention.

Legal proceedings can be taken for infringements, and the patentee can recover damages. Infringers are also liable to penalties for the benefit of the Treasury. Where the infringer has been a workman of the patentee, or is associated with such workman, the circumstances are considered to be aggravated.

Penalties are also imposed on persons who wrongfully state themselves to be patentees, or continue to call themselves patentees after the lapse of the patent, and on patentees advertising as such without indicating the special object for which the patents have been granted.

CHILI.

Article 152 of the Chilian Constitution, dated May 1833, accords to every author or inventor the exclusive proprietorship of his discovery or invention for a limited period to be fixed by law.

The conditions under which such privileges are granted, and the duration of the same, are regulated by a law passed in 1840, supplemented by other laws decreed and promulgated in August 1851, and August 16, 1856, and in 1872.

The inventor of a new invention or discovery may submit the same to the Home Minister, who will refer the application to Commissioners for examination, and if their report be favourable the Minister will grant a patent.

The term of a patent cannot exceed ten years. The term is fixed by the Government. The patentee has to pay a sum of 10*l.* into the Treasury, and 10*l.* for the seal. The specification, &c., is kept secret until the expiration of the term.

Patents may be extended when the importance of the invention justifies it, but application must be made therefor six months before the expiration of the first term.

A period exclusive of the term of the patent is allowed for the erection of machinery, &c., for working the patent, but should the inventor fail to carry out the same within that period, or discontinue the working for more than a year, or produce articles inferior to the original sample, the patent becomes void. Articles made according to the invention can be imported from abroad without invalidating the patent.

Patents may be assigned. Transfers must be noted in the transfer book. Infringers of a patented article are liable to a fine and to the forfeiture of the article produced, and the establishment and implements used in its manufacture. Any person not being the true inventor fraudulently obtaining a patent is liable to fine or imprisonment.

Colombia.

The power to grant patents in Colombia is limited and defined by the law of May 13, 1869.

A patent may be obtained by the inventor, importer, or holder of a foreign patent for any invention or improvement of mechanical apparatus, combination of materials or process, and for the making and sale of any manufacture or industrial product, but not for the importation of foreign productions, whether natural or manufactured.

The duration of a patent cannot exceed twenty nor be less than five years, and in the case of an invention previously patented abroad such duration is subject to the earlier expiration of the prior foreign patent.

The inventor is required to present a petition to the executive power setting forth the nature of his invention or improvement, and stating the number of years for which a patent is desired; and if the decision be favourable, he must furnish within forty days a full description of the invention, accompanied by drawings or models if necessary. A patent will then be issued without any previous examination as to the novelty or utility of the invention. Upon the grant of the patent a fee varying from ten to twenty dollars for every year of the patent is payable, and a sum of twenty dollars must be paid on presenting the petition.

A patent is refused when the invention endangers public salubrity or security, or encroaches upon proprietary rights already acquired, and a grant may be subsequently revoked if it is found to violate existing rights. A patent also becomes void if during a whole year the invention is not worked, unless it be from unavoidable circumstances, but the importation from abroad of articles made according to the invention does not invalidate the patent. The descriptions furnished by the inventor are published only on the expiration of the grant.

Infringers may be prosecuted in accordance with the penal laws of the state.

Congo Free State.

A law of October 29, 1886, provides for the protection of inventions within this state.

Every discovery and improvement capable of being worked as an object of industry or commerce is patentable. Patents of invention, importation, and improvement are granted without

previous examination at the risk of the applicants and without guarantee.

Patents of inventions are granted for twenty years; patents of importation are limited to the term of the foreign patent; and patents for improvements expire with the original patent.

The Government fee for each patent is 100 francs paid in advance. No duty is payable on patents for improvements.

Patentees have power to prosecute and recover damages from infringers, and to obtain confiscation of the infringing articles.

All applications for patents must be signed by the applicant or his attorney, and the application must be accompanied by a specification and by drawings, models, or specimens of the invention.

Patents may be assigned, and notice of the assignment must be given to the Department for Foreign Affairs.

COSTA RICA.

There is no special law relating to the grant of patents, but the republic is authorised by the Constitution to grant patents for terms fixed by Congress. The application for a patent is attended with considerable expense, and the terms of patents granted are similar to the other South American Republics.

DENMARK.

No laws have been passed in Denmark for the protection of inventions, but inventors, whether natives or foreigners, as well the first importer, may obtain patents.

All inventions or improvements are patentable.

The patent dates from the day of the signature of the King to the patent.

Patents of invention and of importation are granted. Improvements can be protected by new patents.

The term of patents of invention is fixed by the Government, and cannot exceed fifteen years; patents are granted to foreigners for five years only.

A uniform tax of 34 kroner (= 60 francs) is required for each application for a patent. Over and above these sums are stamp duties to be paid in advance.

Prolongations are not usually granted beyond the term fixed by Government for the duration of the patent.

A slight examination of the invention is made before granting the patent.

Patents are not published, and information respecting them cannot be obtained without the intervention of the Ministry of the Interior, to whom a demand, with the special motives for the same, must be presented.

The working of the invention must be proceeded with during the first year of the patent, and continued without interruption during the whole term.

The patent does not prevent the introduction into the country of similar products manufactured abroad.

Assignments of patents are not authorised; they may, however, be accomplished by the joint demand of the proprietor and of the assignee for a new patent in the name of the latter.

The petition to the King must indicate the object of the invention.

The patent becomes void if the invention is not new, or if it has not been worked within the given time.

ECUADOR.

The law for the protection of inventions within this State is dated October 18, 1880.

Inventions are protected for not less than ten or more than fifteen years. Importers of machinery or of new methods of manufacture not previously known in the republic are entitled to exclusive privileges. If the establishment of the machine or industry imported requires an outlay of twenty-five thousand dollars protection is granted for three years, if fifty thousand dollars for six years, and if a hundred thousand or more for ten years.

The applicant for any of the classes of privilege must petition the executive power, explaining in what the invention consists, and delivering a specimen of the manufacture, also a specification of the invention; the Government thereupon appoints a Commission of three persons to examine and report thereon to the Minister of the Interior, who presents the papers to Congress, and Congress after examining the same will grant or refuse the patent.

All assignments must be made by public instruments.

Where there are conflicting applications priority is decided by the certificate of the Under Secretary of the Interior. Papers relating to patents are registered in a special register at the Ministry of the Interior. The grant of privileges is communicated by the Ministry of the Interior to the Provincial Governors, and

published in the official journal. On the expiration of the privilege, the petition, description, and other papers are to be published and deposited in the public library of the capital of the republic.

The Act contains provisions for enabling the patentee to take proceedings against and recover damages from infringers.

The privilege lapses when the invention is declared as contrary to the laws of the state, to public safety, or to the police regulations, and also if the inventor is convicted of having omitted from his description the true method of carrying his invention into practice, or of using secret methods not detailed in his description, or if the invention has been described and published in the press within or without the republic; or if the invention is not put into complete practice within a year and a day from the grant, or if the obligations of the patent are not complied with.

FINLAND.

Russian letters patent do not cover the Grand Duchy of Finland. Patents have been granted in Finland since the year 1842; a patent law was passed March 30, and came into operation on June 1, 1876.

Patents are granted for inventions or improvements in arts and manufactures. Medicines and inventions contrary to morals or public safety are not patentable. Patents are granted only to the true inventor, whether native or foreigner.

As long as the ownership of the invention is not contested, the person to whom the privilege is granted has a right—

1. To the absolute property in the invention for the time specified in the letters patent.

2. To use the invention himself, and to sell its results to the public, or to transfer the patent to another person.

3. To prosecute persons infringing the patent in the courts of law, and to recover an indemnity for the loss sustained by the infringement.

4. To treat as an infringement the making of articles in a similar manner with unessential differences.

The person applying for a patent must deliver to the Government an exact description of his invention, with all essential details and the mode of carrying it into effect, and also the necessary plans and drawings, and models, if deemed necessary, not keeping back anything requisite to be known. The inventor has also to state in what respects his invention is new, or whether

it is an improvement upon an invention already used; the novelty of the invention or improvement must be specified in the claims.

Inventions made in foreign countries may be patented in Finland when no detailed description has been published, and when they have not been already introduced into the Grand Duchy. Where an inventor has a patent for his invention in a foreign country, and has been compelled to publish a specification showing the mode of carrying his invention into effect, such publication does not prejudice the granting of a patent in Finland.

If the invention has been previously patented abroad, an authenticated statement must be given as to when the patent was issued and for what term. In such a case the duration of the Finnish patent cannot extend beyond the expiration of the patent taken out abroad by the inventor.

Patent applications are subject to an investigation into the novelty and merits of the invention.

Patents are granted for the terms of from three to twelve years (the extreme limit). The duration of the patent is fixed by the Government in accordance with the state of that part of Finnish industry to which the invention appertains or with which it is most nearly connected. No prolongation of the term originally granted can be obtained. The Government tax is 20 Finnish marks (1 Finnish mark = 1 franc) for each year of the duration of the patent, but there are extra charges of the Finnish Senate to be paid, for registering the application, the issue of the certificate of application, stamps, poor rates, the sealing, &c., amounting to some hundred marks.

The patentee is bound, within two months from the date of issue of the letters patent, to publish the specification of his patented invention in two Finnish newspapers, in the Swedish and Finnish languages.

The time prescribed within which the patented invention must be worked is generally two years, but this time may be reduced to one year, or extended, by application, to a period not exceeding four years. After this, proof of the working must be given every year.

The patent will be annulled if the patentee has not published the specification of his patented invention, or proved the working of it within the time prescribed; if it should be proved by verdict of a jury that the same invention or improvement for which a patent has been granted was already in use in Finland or else-

where, or patented by another person before the application was made ; or if it should turn out that the patent is contrary to morals or public safety.

In case of the absence of the inventor, the person applying for the patent must be duly authorised by power of attorney.

For improvements in a patented invention a new patent must be applied for.

*France.

As the country nearest our own shores, and with which our intercourse is so close, it is desirable all inventors should be well informed on the subject of the French laws.

Letters patent for inventions (*brevets d'invention*) are principally regulated in France by a law bearing date July 5, 1844, the material parts of which are as follows :—

Every new discovery or invention in any branch of industry confers upon its author, under the conditions and for the time hereafter mentioned, the exclusive right of working the same for his own benefit. Such right is constituted by the documents issued by Government denominated *brevets d'invention*, or *brevets d'importation*.

The following cannot be patented :—(1) Pharmaceutical compounds, or medicines of any kind, these being governed by special laws and regulations, principally by a decree of August 18, 1810 ; (2) schemes and projects of credit and finance.

The duration of patents is fifteen years ; the payment in respect of a patent for fifteen years is 1,500 francs. This sum is to be paid by yearly instalments of 100 francs, and the patent will expire if default is made in payment of any one instalment. The duties may all be paid up in advance when desired.

Foreigners may obtain patents in France ; and persons who have patented inventions abroad may obtain patents for them in France, the French patent expiring when the foreign patent expires.

Persons desirous of obtaining a patent must apply by petition to the Minister of Agriculture and Commerce, and give a description of the discovery, invention, or application forming the subject of the proposed patent, accompanied, when needful, by drawings.

The petition must be in the French language, and must be restricted to a single principal object, with the necessary details and its proposed applications. It must mention the duration

which the applicant desires for the patent. It must also give a title, comprehending a summary and precise designation of the subject of the invention.

No documents will be received except on production of a receipt proving payment of a sum of 100 francs (4*l.*), on account of the tax on the patent.

The patents which have been applied for in due form are delivered without previous examination, at the risk of the applicants, and without Government guarantee, either as to the reality, the novelty, or the merit of the invention, or as to the fidelity or accuracy of the description.

The patentee or the person entitled to the patent has the right, during the currency of the patent, to make alterations, additions, or improvements in the invention, and the proceedings for their protection are similar to those required to be taken in applying for an original patent. The petition is subjected to a tax of 20 francs only. The certificates of addition obtained by any one person entitled under the patent accrue to the benefit of all.

A patentee who, in respect of an alteration, addition, or improvement, desires in place of a certificate of addition expiring with the original patent to take out a principal patent must pay the annual tax levied on original patents.

Only the patentee and those claiming under him can, during a year, obtain a valid patent for an alteration, improvement, or addition to the invention forming the subject of the original patent; nevertheless, every person wishing to obtain a patent for an alteration, improvement, or addition to a discovery already patented may in the course of the said year make a formal application to the Minister of Agriculture and Commerce, which is to be transmitted to him, and remains deposited under seal. At the expiration of the year the seal is broken and the patent issued; but the original patentee always has the preference in respect of alterations, improvements, and additions for which he himself shall during the year have demanded a certificate of addition or patent.

A patentee may assign the whole or part of his property under a patent. The entire or partial assignment of a patent, whether as a gift or for valuable consideration, can only be made by a notarial act, and after payment of all the instalments of the tax. No assignment is valid with respect to third parties until after registration, but it is not necessary to register a simple licence to manufacture.

The descriptions, drawings, specimens, and models of patents issued remain deposited, until the expiration of the patents, with the *Minister of Agriculture and Commerce*, where they may be inspected by any one, free of charge. After their expiration patents can be inspected gratuitously at the Conservatory of Arts and Commerce.

Patents are null and of no effect in the following cases, viz.: (1) If the discovery, invention, or application is not new; (2) if the discovery, invention, or application is not patentable; (3) if they refer to principles, methods, systems, discoveries, and theoretical or purely scientific conceptions, the industrial applications of which are not shown; (4) if the discovery, invention, or application is contrary to the order, safety, morals, or laws of France; (5) if the title under which the patent has been applied for fraudulently indicates something which is not the true subject-matter of the invention; (6) if the description annexed to the patent is insufficient for carrying the invention into effect, or if it does not completely and fairly state the real methods adopted by the inventor.

No discovery is held new which, previously to the date of the deposit of the petition, has received publicity in France, or in a foreign country, sufficient to enable anyone to execute it, except in the case of an application made within the terms of the International Convention.

A patentee will be deprived of his rights under the following circumstances: (1) If he should fail to pay the annual payment before the commencement of each year of the term of the patent; (2) if he does not put his invention or discovery into execution in France within two years from the date of the signature of the patent, or if he shall cease for the space of two consecutive years to work the patent—unless, in either case, he can justify his inaction; (3) and, in the case of patents applied for before the International Convention came into force, if he introduces into France objects made in a foreign country similar to those protected by his own patent. This did not apply to models introduced by the patentee with the permission of the Government.

Whoever, in his trade inscriptions, advertisements, prospectuses, marks, or stamps, shall assume the title of patentee, without possessing a patent issued according to law, or after the expiration of a patent; or who, being a patentee, shall describe himself as a patentee, or refer to his patent, without adding thereto the words—'*sans garantie du gouvernement*' (without the guarantee of the Government), or the letters S. G. D. G., is liable

to a penalty of from 50 to 1,000 francs. In case of a repetition of the offence the penalty may be doubled.

The patent covers all the French colonies.

GERMANY.

The law of the Empire of Germany with respect to patents is regulated by an Act which was passed May 25, 1877, and came into operation July 1, 1877. By this law patents are granted for new inventions which admit of industrial use, with the exception of: (1) Inventions the use of which would be incompatible with the laws or the public morals; (2) inventions relating to articles of food (for nourishment or luxuries), of medicines, and of substances produced by chemical process, so far as the invention does not relate to the method of producing such articles.

An invention is not regarded as new if it has already been described in a printed publication in any country, or publicly used in Germany at the time of application for a patent.

The first applicant for a patent of invention is entitled to the grant.

The claim of the petitioner to the grant of a patent is void if the essential contents of his application have without permission been taken from the descriptions, drawings, models, implements, or arrangements of another person, or from a method of manufacture used by the same, and if such person raises opposition on that account.

The patent has no effect against a person who, at the time the patentee made his application, had already been using the invention in Germany, or who had made the necessary preparations for using the same; neither has it any effect in so far as the invention is intended to be used for the army or navy or in the interest of public welfare. In such a case the patentee is, however, entitled to an adequate compensation by the empire or the state in whose special interest a limitation of the effect of the patent has been applied for. The amount of such compensation is fixed by a court of law in case an agreement cannot be arrived at. The patent does not affect means of conveyance coming temporarily within the empire.

Patents are granted for fifteen years, commencing with the day following the day of application. If an invention is an improvement upon an earlier invention patented by the applicant, he may apply for a supplementary patent, which expires with the original patent.

A fee of 30 marks is to be paid on the issue of the patent, and a further fee must be paid for each patent at the commencement of the second and every subsequent year, amounting in the first instance to 50 marks, and increasing by 50 marks per annum for the time of duration of the patent.

The patent expires if the patentee resigns the same, or if he fails to pay the fees within three months at the latest after they have become due.

Patents are to be annulled if it is found that the invention was not patentable according to the law, or if the essential contents of the application have, without permission, been taken from the descriptions, drawings, models, implements, or arrangements of another person, or from a method of manufacture used by another.

The patent can be revoked after the expiration of three years if the patentee fails to carry out his invention in Germany to a suitable extent, or at least to do everything that he can to carry it out, or if the grant of licence to others for using the invention appears to be in the interest of public welfare, but the patentee refuses to grant such licence upon an adequate compensation.

Persons not residing in the empire can only claim grants of patents on the appointment of a representative resident in Germany.

The granting, annulment, and revocation of patents is vested in the Patent Office, which has its seat at Berlin.

The decisions of the Patent Office are subject to appeal.

At the request of the law courts the Patent Office is bound to give opinion in all questions concerning patents.

A register is kept at the Patent Office, in which the subject-matter and the duration of granted patents will be entered, as well as the names and addresses of the patentees and of the representatives appointed by them on presentation of their applications. The commencement, the termination, the expiration, the decree of annulment, and the revocation of patents must be entered in this register, and simultaneously published in the 'Reichsanzeiger.'

The essential parts of specifications and drawings, so far as their inspection is permitted to the public, will be published by the Patent Office in an official paper.

The application for the grant of a patent for an invention must be made in writing to the Patent Office. For each invention a separate application is required. The application must contain the petition for the grant of a patent, and must point out

in a precise manner the subject-matter which is to be patented. It must also be accompanied by drawings or other representations, models, and samples, where necessary.[1]

A fee of 20 marks must be paid on filing the application.

When the invention is approved by the Patent Office, the subject-matter of the application will be provisionally protected in favour of the petitioner, and a notification of the same will be officially published.

If the Patent Office is of opinion that the invention cannot be considered as patentable, the application will be rejected. The applicant can, however, make one appeal from such a decision.

After expiration of eight weeks from the day of publication the Patent Office has to decide as to granting the patent. Until that date objections against the granting can be lodged with the Patent Office. They must be made in writing and be accompanied by arguments.

Before finally deciding, the Patent Office may summon both parties to attend and be heard; it may also cause the objections to be examined by suitable persons skilled in some branch of technical science, and otherwise institute inquiries for elucidating the matter.

Against a decision by which an application is rejected, the petitioner may appeal within a stated time, usually four or six weeks after its notification, and against the decision concerning the granting of the patent on opposition, the petitioner or the opponent may appeal within a similar stated time. On filing the appeal 20 marks must be paid.

As soon as the granting of a patent has been decided upon, the Patent Office will cause a notice to that effect to be published, and then issue the patent.

If a patent is refused, this will also be publicly notified. Upon the refusal, the provisional protection shall be considered as not having taken effect.

No action will be taken upon applications which are not written in the German language.

The term within which an action may be brought for an infringement of patent right is limited to three years with regard to any single case by which such action may be supported.

[1] In the case of applications for hand fire-arms, skates, and for spindles for spinning-machines, models are always required, and samples of the product and intermediate products in chemical process cases; if the product is a tar dyestuff, samples of dyed material in three shades must also be filed; they may be demanded in other cases.

The question whether damage has been caused, and to what amount, will be decided by the court after due consideration of all circumstances.

Sentence will be passed for payment of a fine not exceeding 150 marks or imprisonment:

1. On any person placing on articles, or their packing, any designation calculated to cause the erroneous impression that such articles are protected by a patent in accordance with this law.

2. On any person who in public advertisements, on sign-boards, on business cards, or in similar notifications, employs a designation calculated to cause the erroneous impression that the articles thus mentioned are protected by a patent in accordance with this law.

The requirements of the Patent Office are so stringent, especially in respect to 'subject-matter,' that only about 40 per cent. of the applications are granted. Patents are frequently refused on most inadequate grounds, and the procedure of the office frequently entails great and unnecessary expense upon the applicant. The German mark is about equal to the British shilling.

* GUATEMALA.

The Republic of Guatemala has by a law of May 21, 1886, defined the rights of inventors.

Patents are granted for terms of from ten to fifteen years to natives of Guatemala or to domiciled foreigners,[1] or persons who have applied for patents in other countries of the International Convention.

For these patents application must be made to the Ministry of the Interior, explaining the invention or improvement, and soliciting the privilege. When the patent is granted, one exact drawing of the machine, or a detailed description of the process, with a specimen of the manufacture or product, must be furnished.

Patents will be void when they have been issued prejudicially to the rights of a third party, when the invention is not put into practice within a year from the date of the grant, or when abandoned for more than a year, or when the products are inferior to the specimens lodged.

Every person has the right of improving the invention, but

[1] A Bill was presented in Congress to modify this disposition.

not of using the original invention, and the original inventor cannot use the improvements made by another except by agreement. Articles made abroad according to the invention can be imported without rendering the patent invalid.

When the term fixed by the grant has expired the specification is published.

A tax is reserved by the patent of from five to fifty dollars for each year of the grant, payable in advance.

The same law also provides for making grants in favour of undertakings of public utility in Guatemala or in favour of the establishment of new industries or improvements upon those already existing.

HAWAII.

An Act of August 29, 1884, regulates the granting of patents, sects. 258 and 256 of the Civil Code having previously provided that the Minister of the Interior might issue patents for any time not exceeding ten years upon the inventor or importer delivering to the Minister a full specification, and in the case of a machine full drawings and, if required, a complete model thereof.

Where the invention is of a composition of matter, specimens of the ingredients sufficient for experiment must be furnished.

Where foreign patents are in existence, patents may be obtained unless the thing patented has been introduced into public use in the Hawaiian Islands for more than one year prior to the application. The patent expires on the expiration of the earliest prior foreign patent.

If upon an examination of the invention by the Commissioner of Patents, he considers that the claimant is justly entitled to a patent, and that the invention is sufficiently useful and important, the Minister of the Interior will issue the patent. The law also gives the inventor power to file a caveat, which is kept secret and gives priority for one year.

Goods made according to the invention abroad can be imported without invalidating the patent.

The fees payable for the application, commissioner's report, and the sealing amount to 30 dollars.

* HOLLAND.

No patents are granted for Holland.

HONDURAS.

The republic has not passed any special law relative to the protection of inventions, but patents are granted for terms fixed in each case. The terms of the patents granted are similar to those of the other Central American Republics.

* ITALY.

The law which governs the grants of patents for the kingdom of Italy is dated from January 31, 1864, confirming the earlier Sardinian law of October 30, 1859.

The inventor only, whether a native or a foreigner, or his assign, can obtain a patent of invention.

Inventions are considered patentable which have for their immediate object: (1) An industrial product or result; (2) any instrument, machine, &c., or mechanical arrangement; (3) any process or method of industrial production; (4) a motor, or the industrial application of a force already known; (5) lastly, the technical application of a scientific principle in such a condition that it will produce direct industrial results.

The invention must be novel.

A new invention or industrial discovery patented abroad and not yet imported into Italy, although already published by means of such foreign patent, confers the right to the inventor, or his assign, of obtaining a patent in Italy, provided the application be made before the expiration of the foreign patent, and before the importation or use of the invention by another than the inventor.

A patent of invention takes effect from the date of the application, and its duration from the last day of that one of the months of March, June, September, and December which follows next after the date of the application.

Certificates of addition are granted, and are annexed to the principal patent. Applications for certificates of addition made during the first six months by the owner of a patent have preference over applications for new patents made for the same invention by others.

Certificates of reduction, or disclaimers, may be demanded by a patentee within the first six months of his patent, for the purpose of reducing the patent to one or more parts of the invention forming the object of the description annexed to the original

demand, it being necessary to point out clearly the parts to be struck out of the patent.

Patents are granted for various terms from one to fifteen years, at the desire of the petitioner. A patent granted for an invention already patented in another country expires with that patent for which the longest term has been granted, but in no case exceeds the maximum limit of fifteen years.

Certificates of addition expire with the original patent to which they are attached.

Every patent is liable to two taxes: the one proportional, consisting of as many times 10 francs as there are years in the term demanded; the other annual, consisting of 40 francs for each of the first three years of the patent, 65 francs for each of the three following years, 90 francs for the seventh, eighth, and ninth years, 115 francs for the tenth, eleventh, and twelfth years, 140 francs for each of the three last years.

A sum of 20 francs only is required for the certificate of addition, to be paid in advance.

All certificates of prolongation necessitate, over and above the taxes, the payment of a sum of 40 francs.

Each certificate of reduction involves the payment of a tax of 40 francs.

The amount of the proportional tax for the term demanded and the first annuity is to be paid when making the application for the patent. This obligation to pay in advance the total of the proportional tax becomes burdensome if the patent should not be continued. On the other hand, as each demand for prolongation necessitates the payment of a fixed tax, and the patents demanded for more than five years have accorded to them a period of two years within which they are to be put into operation, the usual practice adopted by those who have not to consider the possible effect of the short term on subsequent patents elsewhere is to demand a patent for six years. The other annuities are paid in advance the first day of each year of the term of the patent, or in advance of the last day of March, June, September, or December respectively, and are subject to triennial augmentation, even in the case of prolongation of the patent. Three months' grace is allowed for the payment of the annuities, and if this period lapses the patent is forfeited. For the prolongation three months' grace is not admitted.

Patents demanded for a less term than fifteen years can be prolonged to this term. Each demand for prolongation must be accompanied by the receipt for the taxes and the original letters

patent, or an authentic copy of them, showing the ownership of the patent.

Demands for patents are subjected to no other examination than that in reference to the rules laid down by the authorities, with the exception, however, of patents for drinks and eatables, which are examined by the Superior Sanitary Council.

The records containing the certificates of deposit, changes, additions, cancelling, or assignment of patents are published. Persons requiring extracts from such records must make the application on stamped paper; the extracts are supplied at the expense of the applicant.

The drawings and descriptions are published three months after the grant of the patent; anyone can then obtain one or more copies at his own expense.

Every three months a list of the patents granted during the preceding three months is published in the official journal. Every six months the descriptions and drawings of the patents granted during the previous six months are published.

Patents granted for a term not exceeding five years must be put in operation within the first year of the term, and the working must be continued: an interruption for more than one year invalidates the patent.

Patents granted for more than five years have a period of two years allowed for working them; in both cases the owner of the patent should, in case of inaction, show the reason of neglect; but the want of funds is not recognised as a valid excuse.

Every deed of transfer or assignment of a patent is registered upon the grant of the original patent, and published in the official journal; such assignment is not valid as regards a third party, excepting from the date of registration in the Patent Office.

The application for a patent addressed to the Minister of Agriculture, Industry, and Commerce must contain: (1) The name and surname, and residence of the applicant, and of his attorney or agent; (2) a short and precise description, in the form of a title, of the nature and object of the discovery; (3) the length of the term for which the patent is desired.

To the application should be annexed: (1) Three copies of a description of the invention in French or Italian; (2) explanatory drawings or models (also three copies); (3) a receipt proving the payment of the taxes; (4) a list of the documents; (5) power of attorney legalised by the Consul of Italy.

An Italian patent becomes void: (1) If it has reference to any

of the inventions proscribed by the law; (2) if the title fraudulently sets forth another object than the true object of the invention or discovery; (3) if the description does not fully and faithfully point out the necessary means of carrying out the invention; (4) if the invention is not new or useful; (5) if the patent has formed the subject of a certificate granted to a third party for modification of an invention within the six months reserved to the author or his assigns; (6) if the tax be not paid within the three months from the date at which it is due; (7) if the patent has not been worked within the prescribed period; (8) if the patent has been granted to any other than the inventor or his agent.

JAPAN.

The following regulations as to patents are included in the Imperial Proclamation No. 84, dated December 18, 1888.

Inventors must apply for protection to the Minister of Agriculture and Commerce, who will give the necessary certificates. Articles of food, drink, fashion, or medicine are not patentable. Three copies of the specification with drawings (if necessary) must accompany the application, of which two copies are required. All the persons connected with the invention must sign the papers. Patent rights are granted for five, ten, or fifteen years.

Patents for inventions applicable to war purposes, or those the general use of which is deemed important, can be refused, or have conditions imposed by the Minister.

Articles that are improvements upon existing patents can only be protected with the consent of the original patentee, but if this consent is not accorded the Minister has still power, if he considers the refusal obstructive to the improvement of the invention, to grant the improver special permission to use the original invention together with the improvement, in which cases the improvers will be ordered to pay appropriate sums of money to the original patentee.

Articles patented must be marked with a mark settled by the Minister, and anyone neglecting to mark the articles cannot obtain damages from infringers.

Provisions are made for the Patents Bureau acting as arbitrators in questions connected with the rights of patentees.

Patents will become void when articles made according to the patented invention are imported and sold, or the patentee ignores importation and sale which infringes his rights, or when without good reason the invention has not been practically applied

in public within three years from the date of the certificate, or when the working is suspended for three years without good reason.

The fee payable on applications for patents is about 12*s.*, and in addition, on the issue of the certificate, the fees for five years amount to about 2*l.*, for ten years about 3*l.*, and for fifteen years about 4*l.*

Infringers are liable to imprisonment (not exceeding one year) and to fines not exceeding 40*l.*

All transfers, licences, and other dealings with patents must be registered. The patentee has power to rectify omissions or misstatements in his original application and specification. In practice the Japanese authorities refuse a patent to anyone who has patented the invention in another country.

Liberia.

An Act of the Senate and House of Representatives of the Republic of Liberia, by Act of December 23, 1864, has provided for the protection of inventions within the republic.

This Act provides for the establishment of a Patent Office under the control of the Secretary of State. All patents are issued in the name and under the seal of the republic, and signed by the President and the Secretary of State.

Citizens of Liberia or aliens may obtain patents on application in writing to the Secretary of State accompanied by proper specifications and drawings; the Secretary of State having made an examination of the alleged new invention, and being satisfied as to its novelty, will issue a patent therefor. Aliens who have obtained patents must put the inventions into actual operation in the republic within three years from the grant. The fee payable by a citizen on application for a patent is 25 dollars, by an alien 50 dollars.[1]

Patents are assignable in whole or in part, and all assignments and business must be registered in the office of the Secretary of State within one year from their execution.

Proceedings for infringement must be taken in the Supreme Court of the Republic.

Luxemburg.

Patents are granted under the law of June 30, 1880, for the term of fifteen years upon payment of an annual tax of 10 francs for

[1] The specifications and drawings are open for public inspection in the office of the Secretary of State, and certified copies may be obtained.

the first year; 20 francs for the second year, and so on, progressing at the rate of 10 francs for each year. Patents of addition are also granted, expiring with the original patent. No prolongations are granted beyond the original term. Patents are granted without examination and at the risk of the applicants. The invention protected must be put in operation in Luxemburg within three years from the date of the patent. Patents can be assigned; the deed of assignment must be registered. Applicants for patents must present their petitions, accompanied by descriptions of the invention in French or German, and drawings, models, or specimens, when necessary to the comprehension of the invention. Patents become void by default in payment of the taxes within three months of the time fixed; or if a similar patent is not applied for within three months in the states with which the Grand Duchy is allied by Customs Treaty. The patent will also be void if the invention is not good subject-matter for patent; if the description of the invention lodged is insufficient, or does not give to the best of the inventor's ability the means for carrying out the invention. Articles made abroad according to the patent can be imported into Luxemburg without invalidating the patent. Infringers of patents are liable to payment of penalties varying from 100 to 2,000 francs, irrespective of damages.

* Mexico.

A decree of May 7, 1832, governs the grant of patents in Mexico. Every discovery or new invention can be patented in Mexico. Patents are granted to the first introducer of a new invention which has not been used in Mexico; and applications for patents by inventors who have already foreign patents for the same objects are accorded a preference over others, but this preference does not extend to cases where the foreign patent has lapsed. Pharmaceutical compositions, plans for working estates, or for financial combinations, and the application of known motors to industrial purposes also known are not patentable.

Patents are granted for six or ten years. Patents for improvements are granted for the time which remains of the original patent, if such duration exceeds six years; if such duration is less than for six years, patents for importation are granted for only five years.

Every applicant for a patent must address to the Minister of Commerce a petition setting out that the petitioner is either the inventor or is the assignee of the inventor, together with a descrip-

tion of the invention, and such drawings, specimens, or models as may be necessary for the proper comprehension of the invention.

The application must be limited to one principal object, with such accessories as are necessary for carrying out the invention. This description must be written in Spanish, and must be without alterations or corrections. The drawings must be made in ink and to scale, and must be in duplicate. All the documents must be signed by the inventor or by his attorney. The duration of the patent will commence from the date of the grant.

These documents are examined by officials, and the applications are then published in the official and other journals, and oppositions to the grants can be made within two months from such publication. The Government does not guarantee the utility, novelty, or validity of the patent.

The Government publishes every three months the lists of patents granted. The description and drawings of the invention can be modified at any time during the duration of the patent. Patents of addition will be granted for improvements upon the original invention. These patents for improvements can be granted to the original inventor or his assigns only, for the first year of the patent.

Patents can be assigned in whole or in part, and assignments must be registered. Assignees are not, however, entitled to patents for improvements without assignments of those improvements. The Minister of Commerce publishes every year a catalogue of the specifications with illustrations of the drawings. Patents granted will be annulled if the alleged discovery is found to be old; if it does not come within the terms of the law for which patents are to be granted; if it is contrary to public policy; if the specification upon which the grant has been made is fraudulently expressed in indicating an object different from the true object of the invention; if the description lodged is insufficient to enable the invention to be put in operation; if the invention is not put into operation in Mexico within two years from the date of the grant, or if its working is interrupted for two years, unless the cause of inaction is satisfactorily accounted for; and also if the patentee introduces into the country the patented articles manufactured abroad (except under the provisions of the International Convention). The permission of the Minister can, however, be obtained for the introduction of models. All patented articles must bear the word 'Patented,' and 'Sans garantie du Gouvernement.

Patents are now obtained without difficulty in Mexico when the

applications are made in proper form, and the inventor is represented by a competent agent.

Nicaragua.

The resolutions of the Spanish Cortes have by decree been declared in force in this republic. By virtue thereof any person who invents, imports, or introduces an invention may, by application to the prefect of the department or the municipality, obtain a certificate granting him an exclusive right to such invention. The duration of the privilege is to an inventor ten years, to an improver seven years, and to an introducer five years. These terms may be extended by the sovereign power. The invention must be worked in the republic within two years or the privilege will cease.

In practice, however, the rules of the decrees are not closely followed, but an arbitrary power is vested in Congress, which grants a patent or withholds it as it sees fit.

* Norway.

Patents for new inventions beneficial to industry are granted in Norway under a law of June 16, 1885. An invention is not considered to be new if before the application for a patent it is already so far known that it can be carried out by experts, but publication in print or by public exhibition for a period not exceeding six months before the application will not prevent the grant.

The applicant must be the first inventor, or a person who has obtained the right from him. The proprietor of a patent has for a period of two years from the date of his application the sole right to obtain a patent for improvements or additions to the invention.

Patents are granted for fifteen years from the date of the application.

Improvements or additions may be protected either by independent patents or by patents of addition expiring with the original grant.

A fee of 30 crowns (= 1*l.* 13*s.* 1*d.*) is to be paid on lodging any application, and an annual tax is also payable of 10 crowns (= 11*s.*) for the second year, and increasing 5 crowns (= 5*s.* 6*d.*) each year.

The patent has no effect against persons who have used the invention or have made the necessary preparations for the use of the same before the application.

A patented invention may be used for the service of the Government without consent of the patentee, but in that case the patentee is entitled to compensation, to be paid by the Government, the amount of which, in case of dispute, is settled by arbitration; and a patented invention of essential value to any particular trade or industry may be appropriated to private use, but the patentee is entitled to compensation, to be paid by the person using the invention, the amount of which, in case of dispute, is settled by arbitration.

The examination of, and decision upon, applications rests with a Patent Commission, consisting of a president qualified for the bench, and five members (at least) experts in technical pursuits.

Applicants must lodge with the Patent Commission a petition and description and drawings (in duplicate) of the invention; if the applicant is not resident in Norway he must appoint a resident attorney to represent him. The specification must conclude with a definite statement of what the applicant considers to be his invention and wishes to protect.

If the application is approved it is advertised; the papers are open to the public inspection during eight weeks, and any person may lodge an opposition to the grant; the Commission then decides upon the application, and if the applicant is dissatisfied with the decision he may apply for the reconsideration of the matter, and may also appeal to a superior Patent Commission of seven members appointed for that purpose.

The invention must be put into operation in Norway within three years from the date of the grant, and the working must not be afterwards discontinued for one year.

A register of assignments is kept in which all the dealings with patents must be entered.

Actions may be brought for the repeal of the patent, and against infringers, from whom damages may be obtained by the patentee as well as penalties by the Crown.

Articles made abroad according to the patent can be imported without invalidating the grant.

Orange Free State.

The Legislative Council have, by an Ordinance No. 10 of 1888, repealed the Ordinance No. 12 of 1884, and have established a law of patents similar to that of the Transvaal. (See page 464.)

The fees for obtaining patents are also similar, except that the fee payable on sealing the patent is not less than 10*l.* or more than 50*l.* All documents must be in the Dutch language, and applications have to be advertised at the applicant's expense.

Paraguay.

There is no special law enabling inventions to be patented in this country, but patents can be obtained by inventors whether citizens or strangers, and also by the first introducers of inventions from abroad. Patents can be assigned in whole or in part.

All new discoveries and improvements are patentable, and no examination is instituted prior to the grant.

Patents date from the day of the grant. The term fixed varies from five to ten years, and is fixed by Government decree. Prolongations of the original terms can be obtained where the circumstances justify such prolongations.

Legal proceedings can be taken against the persons infringing the patent.

Peru.

Article 27 of the Constitution declares useful discoveries to be the property of the authors, and that introducers may enjoy like privileges for limited periods granted to them.

The Law of January 28, 1869, repeats the same declaration, but enacts that the right must be established by a certificate or patent. The duration of patents is not to exceed ten years, and a fee of about 20*l.* per annum is payable to the fund of public works of the province in which the invention is exercised or established.

The application must comprise a description of the invention, with plans or models, and a clear statement of the principal object, with details and an explanation of the application, the term sought for, and the nature of the security offered for the realisation of the project.

If a foreigner is an applicant, he must renounce all diplomatic intervention and submit himself absolutely and irrevocably to the laws of the republic.

An official inquiry is made in each case, and the Ministry will grant or refuse the patent upon the result.

Prolongations and modifications or alterations can only be granted by legislative resolution.

The patents are null: If the discovery, invention, or applica-

tion is not new, or the application is not for new industrial products or new applications of those already known; if based upon theoretical or scientific principles, methods, systems, or discoveries, the industrial application of which is not indicated; if the discovery appears to be contrary to law or order; if the application was fraudulent; or if the invention cannot be carried out according to the description lodged.

The invention is not to be deemed new if it had sufficient publicity to be put in practice in Peru or abroad prior to the date of application.

The patentee will lose his rights if the annuity is not paid, if he does not work the invention within two years from the date of the grant, and if he imports from abroad articles made according to the patent.

Persons interested may demand the nullity or cessation of the patent, and such demands will be considered by the Ministry.

* PORTUGAL.

Royal decrees, dated December 31, 1852, and March 17, 1868, regulate the law of patents in Portugal, including the Portuguese possessions abroad. Their principal provisions are to the following effect:—

Authors of new inventions, whether native or foreign, are entitled to secure an exclusive right to them by patent; but the patent will be no guarantee of the reality, priority, or merit of the invention. An invention can be patented, though in use in foreign countries, if it be new in Portugal.

The duration of a patent privilege cannot exceed fifteen years; but the inventor may obtain it for a less period, from one year upwards. To inventors who have already obtained a patent in a foreign country, no longer term will be granted than is sufficient to make up fifteen years from the date of the foreign patent. The importer of an invention (not being the inventor himself) can only obtain a patent for five years.

Prolongations are granted when demanded *within* the term of the first demand.

On applying for a patent, an inventor must deliver to the proper office an exact description, under seal, of the principles, means, and processes which constitute the invention, with the necessary plans in duplicate, sections, and drawings.

A patent will not be allowed to comprise more than one subject-matter of invention.

Articles made abroad, according to the invention, can be imported without invalidating the grant, but patentees are required to work their patents officially in Portugal within two years from the date of the patent, and the working must not cease for two years. The law does not, however, require actual construction in the country. An imported article properly vouched by an independent person as being made in accordance with the specification is considered to be a sufficient working, whilst advertisements in the newspapers are held to be sufficient evidence of subsequent workings.

A tax of 5,000 reis (about 28*s.*) is imposed in respect of each year of the patent, and is paid in advance.

Patent rights pass by assignment or by will.

A patent becomes void if the invention be not carried into effect within two years, or if the manufacture be adjudged a nuisance by a competent tribunal.

Russia.

The law as to privileges for inventions in Russia, including Poland and Siberia, but excluding Finland, was declared by an imperial decree of June 17, 1812. On November 22, 1833, the terms of this decree were altered, and amendments were made: November 2, 1836; July 8, 1837; October 23, 1840; August 15, 1845; July 7, 1852; May 22, 1862; July 11, 1864; October 26, 1864; November 20, 1864; February 16, 1867; April 22, 1868; March 30, 1870; June 7, 1872; December 30, 1872; January 10, 1873; October 20, 1874; and April 27, 1876.

The privilege granted for discoveries, inventions, or improvements in arts and manufactures is founded upon the letters patent and a certificate (obtained on presenting a petition to Government accompanied by a full description of the invention, with the drawings belonging to it, and paying the Government tax), which certificate states that the invention therein mentioned was presented at such a date and hour to the Government, and that the Government tax has been paid. The term of the patent begins from the day of issue of the letters patent, but infringers may be prosecuted from the date of the certificate of application.

Patent applications are subject to an investigation into the novelty, and partly into the merits of the invention.

No patents are granted for munitions of war (as, for instance, guns, projectiles, torpedoes, etc.) unless adapted to other purposes (as, for instance, sporting fire-arms, metallic cartridges, etc.), when

the grant will be made subject to the rights of the Government to use the same without compensation.

The Government does not guarantee that the invention belongs to the person who makes the application; it only certifies that for the same invention no privilege has been granted to anybody in Russia before.

The privilege granted by the Government does not prevent the true inventor from proving, in legal form, that the invention does not belong to the person who obtained the patent of invention.

Until the ownership of the invention is contested the person to whom the privilege was granted has a right:

1. To the absolute property in the invention for the specified time.

2. To use the invention himself, and to sell its results to the public, or to transfer the privilege to another person.

3. To prosecute persons infringing the privilege in the courts of law, and to recover an indemnity for the loss sustained by the infringement.

4. To treat as an infringement the making of articles in a similar manner, even with improvements upon them, as long as the essential parts of the first discovery are copied.

The applicant for a patent privilege must deliver to the Government an exact description of his invention, with all essential details, and the mode of carrying it into effect; and also furnish the necessary plans and drawings, not keeping back anything requisite to be known to enable the invention to be carried out. The inventor must state what he claims as novel. If the invention relates to sporting fire-arms, or surgical instruments, a model or specimen will be required in most cases.

Inventions made in foreign countries may be patented in Russia when no detailed description has been published, and when the inventions have not been already introduced into the Russian Empire and the foreign patents have not expired.

A patent for an imported invention has the same validity as one granted for an invention made in Russia, until it is shown that the invention had been brought into use before the grant or that it had been described in published books or papers in such a way that it could have been carried into effect without the patentee's description.

Patent privileges for original inventions, whether made in Russia or in a foreign country, patented or not patented abroad, are granted to the Russian or foreign inventor, or his assignee, for

three, five, or ten years (the extreme limit), at the option of the applicant. Patent privileges applied for by the mere importer for inventions still remaining under patent protection abroad are granted for one, two, three, four, five, or six years (the extreme limit), at the option of the applicant, but cannot endure beyond the expiration of the patent taken out abroad by the inventor himself. The Government charges amount on patents of invention for three years to 90 roubles, for five years to 150 roubles, and for ten years to 450 roubles; whilst for patents of importation the Government charges 60 roubles for each year of the duration of the patent. If the application be refused the Government tax is refunded, with the exception of from 11 to 15 roubles for the advertisements of the application in the newspapers.

A patent will be void when it is shown to the proper tribunal that a patent of invention has been applied for without the consent of the true inventor, or that the invention has been already practised in Russia, or that, at the time of the presentation of a petition for a patent, the invention had been previously described in books or periodicals published in Russia or elsewhere, so that it might have been carried into effect without further description. It will also be void where it is impossible to arrive at the promised result by following the directions of the patentee, or if the certificate of working has not been filed within the time prescribed.

No power of attorney is required for the person applying for the patent in case of the absence of the inventor or importer.

No prolongation of the term originally granted can be obtained. For improvements in a patented invention a new patent must be applied for. An invention for which a patent has been obtained must be carried into effect in Russia within one quarter of the term for which the patent was granted, and within six months after this a certificate of working from some local authority must be filed at the Ministry which issued the patent. To prove the working of the patented article, it may, if it be a machine, be imported, but if the patent is for a process, the manufacture must be carried out in Russia.

San Salvador (Central America).

The Constitution gives power to the executive to grant privileges to the authors of useful inventions, but no special law exists for regulating the grant of such privileges. It is customary,

however, for the executive in the exercise of its prerogative to follow the practice of civilised Governments.

* SPAIN.

INCLUDING THE SPANISH COLONIES OF CUBA, PORTO RICO, AND THE PHILIPPINE ISLANDS.

A greatly improved law with respect to patents for inventions came into operation on August 1, 1878.

Under this law facilities are afforded for the introduction into Spain of numerous inventions which the restrictions and cost of obtaining patents under the old law precluded. A valuable feature of the present law is, that one patent includes not only Spain, but the colonies of Cuba, Porto Rico, and the Philippine Islands, for each of which a separate and most costly patent was formerly requisite. To render the patent valid in the Spanish colonies it must be registered in the Colonial Office at Madrid.

The rights of foreigners as regards obtainment of patents are the same as those of natives.

Two classes of patents are granted, one to inventors, and another to those who, without being inventors, introduce or import a new industry into Spain or the colonies.

The proprietorship of a patent is hereditary, and can be sold or negotiated, just as any other property, according to the existing laws in Spain.

Patents are granted to one or more individuals, or to a society or company.

Patents of invention are granted to all who solicit them, without previous examination as to the novelty or usefulness of the invention.

Applicants for full-term patents in Spain must file their petition before their inventions are published or made known elsewhere, so that the invention may be considered new in Spain; in such cases the patent will be granted for *twenty years*. But if the application be delayed until after the publication has taken place in any other country the applicant is still entitled to a *ten years'* patent in Spain, provided that *two years* have not elapsed since such publication. Should *more* than *two years* have elapsed he is then in the same position as an importer or introducer of the invention, and can only obtain a *five years'* patent. The introducer not being the inventor is not entitled to a grant for more than five years.

If the applicant obtains a longer time than he is legally entitled to, he incurs the risk, on the intervention of a third person, of the Courts declaring the patent, *ipso facto*, null and void. But the patentee would be entitled to present a fresh application for the term then open to him under the law, provided no other application had been filed in the meantime.

The annual taxes are 10 pesetas (10 francs) for the first year: 20 pesetas (20 francs) the second year; 30 pesetas (30 francs) the third year, and so on successively, each year 10 pesetas (10 francs) more than the previous year.

The following documents are needed on application for a patent:—

1st. A power of attorney in Spanish, indicating the name and residence of the person in whose name the patent is to be granted.

2nd. A complete specification, explaining the invention and the points claimed. The patent will be granted on the point or points specified in the claims. The references to weights or measures in the specifications must be made in accordance with the French metrical system.

3rd. The drawings must be on *tracing cloth*, in black ink, without colours or colouring, on the French metrical scale, and in duplicate.

If, on the Patent Office authorities examining the documents and papers, it should be found that they are incomplete, or not presented according to this law, *two months* will be allowed to the applicant to correct the error if the inventor resides in Europe; *four months* if he resides in America; and *eight months* if he resides in Asia. No secrecy will be observed, as formerly, with regard to the patents granted. The specifications and drawings are open to the public in the Patent Office after the grant has been made.

Certificates of addition are granted. During the whole term of a patent, the owner, his heirs, or the person representing his rights can obtain protection for improvements on or additions to his original patent. No annuities are payable on certificates of addition, but the further improvements protected must be put into working in the same way as the original patent, and either at the same time or separately.

The certificates of addition will be granted and considered as parts of the original patents. They are solicited in the same manner as the patent, and terminate when it terminates. Instead of soliciting a certificate of addition, a new patent, inde-

pendent of the principal one, can be obtained for improvements.

The sale, cession, or negotiation of patents can be made before a notary in any country. If the cession is made in Spain a special power must be sent for it. If the cession is made before a foreign notary, out of Spain, the document or contract must be made directly in Spanish, or must be officially translated at the Spanish Legation or Consulate.

All documents sent to the Patent Office department must be legalised at the Spanish Legations or Consulates of the places whence they come. In the contracts of sale or cession, a certificate from the Patent Office of Spain must be transcribed to prove that the annual taxes on the patent are paid up to the date of the contract, and that the patent is in full force, and that the patentee has not disposed of his interest. The sale or cession of the patents, with all the requisite formalities, must be registered in the *Gobierno-Civil* at Madrid.

Two years are allowed for the official working of the patent in Spain, but this term can be prorogued by a special law passed in the *Cortes* to that effect; this can only be obtained under very exceptional circumstances, with much difficulty and at great cost.

Patents will be declared void when their owner ceases to pay the annual charges, or when he has not proved officially that he has worked the patent within the two years.

Patents may be annulled at the instance of a third person and by the sentence of a Spanish court in case it is proved the invention was not within the terms of the law when applied for, or if the specification does not sufficiently describe the manner in which the invention is to be worked.

A patent may also be annulled at the instance of a third person if it can be proved that the invention has not been put into operation within a year and a day from the date of the patent. Advertisements of the invention inserted in local newspapers are, however, sufficient to prove that the invention had been introduced. Where the invention is in actual operation in Spain or its colonies a certificate attested by a notary must be obtained from the seller or manufacturer.

The infringement of a patent is punishable with a fine. All articles wrongly manufactured under the patent infringed are to be delivered to the rightful owner of the patent, and the patentee has a right, besides, to claim damages. If the infringer is not able to pay the fine, he will be imprisoned for a proportionate length of time.

Counterfeiters of patents will be also punished according to the Spanish Criminal Code.

Governors of the Spanish colonies can no longer grant patents.

* Sweden.

Patents for new inventions of industrial products or for special methods for the manufacture of such products are granted in Sweden under a law of May 16, 1884. An invention is not considered to be new if, before the application for a patent, the invention is already by publication or working so far known that it can be worked by experts, but publication in print or by exhibition in an international exhibition will not for a period of six months before the lodging of the Swedish application prevent the grant of a patent.

The applicant must be the first inventor, or a person who has properly obtained the rights from him.

Patents of addition are granted.

Patents are granted for fifteen years from the date of the application.

A fee of 50 crowns (2*l.* 15*s.*) is to be paid on lodging the application and a fee of 25 crowns (1*l.* 7*s.* 6*d.*) at the grant. Annuities must also be paid: 25 crowns (1*l.* 7*s.* 6*d.*) during each of the 2nd, 3rd, 4th, and 5th years, 50 crowns (2*l.* 15*s.*) during each of the next five years, and 75 crowns (4*l.* 2*s.* 9*d.*) during each of the last five years.

The patent has no effect against persons who have used the invention or have made the necessary preparations for the use of the same before the lodging of the application.

A patented invention may be used for the public service or the Government without the consent of the patentee, but in that case the patentee is entitled to full compensation, which, in case of dispute, is settled by arbitration.

The examination and decision upon applications rests with the Patent Office, consisting of a commissioner, a chief-engineer, and a number of engineers.

Applicants must lodge with the Patent Office a petition, specification with claims and drawings, in duplicate. If the applicant is not resident in Sweden he must appoint a resident attorney to represent him.

If the application is approved it is advertised and the papers are open to the public inspection during two months, and any person may lodge an opposition to the grant; the Patent Office then de-

cides upon the application. If the application is rejected, the applicant may appeal to the King.

The patented invention must be commercially worked in Sweden within three years from the grant of the patent, and this working must not be afterwards discontinued for one year. The time for the working may, upon application to the Patent Office, be prolonged to four years.

Assignments must be registered.

Actions may be taken for the repeal of the patent and against infringers, from whom damages may be recovered by the patentee as well as penalties by the Crown.

Articles made abroad according to the patent can be imported without invalidating the grant.

* SWITZERLAND.

The Swiss Confederation has, by a law which came into force Nov. 15, 1888, provided for the grant of patents for inventions.

Patents are granted for fifteen years from date of application, subject to the payment in advance of annuities of 20 francs for the first year, 30 for the second, 40 for the third, and so on up to the fifteenth year.

Patents of addition are granted upon payment of a single tax of 20 francs.

Patents are forfeited if the annual taxes are not paid within three months from their falling due, and are liable to forfeiture if the invention is not carried into practice in Switzerland within three years from the grant, or if the patented article is imported from abroad, the patentee having refused equitable offers for Swiss licences.

Patents will also be declared null if the invention is not new or cannot be carried into effect, if the patentee is not the inventor or his successor, if the title of the patent is misleading with fraudulent intent, and if the specification is not sufficient or does not accord with the model. Any interested person can bring an action for annulment.

Applicants for patents not residing in Switzerland must appoint an agent of Swiss domicile.

A patentee finding he cannot work his invention without using a previously patented invention may obtain a licence if three years have lapsed since the lodging the application for the first patent; if such licence is granted the proprietor of the first patent may also obtain a licence to use the improvement.

When the public interest requires it, the Federal Assembly may, at the request of the Federal Council or of a Canton, decree the appropriation of a patent at the expense of the Confederation or of a Canton for the common use of the republic, upon payment to the patentee of an indemnity fixed by the Federal tribunal.

Application for the patent must be made to the Federal Office of Industrial Property; the application must be in German, French, or Italian, and must be limited to a single principal invention with details, and must be accompanied by a specification, with drawings, if necessary, and proof that a model of the invention or the article itself exists, and the application fee of 40 francs, together with 10 francs for the examination if no model is produced. The Federal Council may also require a model.

A provisional patent for two years may be obtained.

The complete patent must be obtained within the term of the provisional patent.

A register of patents granted is kept in which all changes relating to the existence, ownership, and enjoyment of the patent are entered, and a note is also made in the register of the lapsing, nullity, and appropriation of the patent, as well as of all compulsory licences granted.

Articles manufactured under the patent, or the packages containing the articles, are to be marked with the Federal Cross and the number of the patent.

The Federal Office publishes the descriptions and drawings annexed to applications; this publication may be postponed for six months to allow of taking out foreign patents.

Civil or criminal proceedings may be taken against infringers and against persons assisting infringers, against persons who have refused to disclose the origin of infringing articles found in their possession, and against persons who have wrongfully put upon their commercial papers, notices, or products indications tending to cause belief in the existence of a patent when none exists.

Provision is made for placing Switzerland under the terms of the International Convention, and for the protection of inventions exhibited in national or international exhibitions in Switzerland.

Transvaal (South African Republic).

Letters patent for this state are granted under a law of June 1, 1887.

All persons, whether citizens or aliens, can obtain letters patent

for new industrial inventions. Corporations and companies of which the inventor is a member have the same rights.

Application may be made in general terms at the office of the Attorney-General in the language of the Act, and must be accompanied by a description of the invention in Dutch and by payment of the fee undermentioned. Upon this application being accorded provisional protection is obtained for six months, or the applicant may lodge a detailed description, upon which he may also obtain provisional protection. The applicant cannot take any proceedings until the patent is sealed.

When the applicant is desirous of completing his patent he must give notice of his intention to proceed: this notice is advertised, and persons desirous of opposing can then do so. Oppositions are heard by the Attorney-General, who can call in expert assistance. The Attorney-General then issues his certificate, upon which the letters patent are sealed.

The sealing will be refused if the application for it is made more than three months after the date of the Attorney-General's certificate, or if the application is made after expiration of the term of provisional protection.

Patents are granted for fourteen years, subject to the payment of additional duties at the end of three and of seven years.

The patent will cease with the expiration of any prior foreign patent for the same invention.

Alterations in specifications by way of effacing, improving, or adding thereto may be made on application to the Attorney-General for that purpose.

Proceedings may be taken to obtain grants of compulsory licences where the patent right is not used in the state, or where the ordinary demand for the patented article cannot be supplied, or where anyone is prevented from deriving the full benefit of an invention in his possession.

The Act gives power to grant prolongations for additional terms (not exceeding fourteen years) if applied for six months prior to the expiration of the original term.

Registers of patent deeds and of proprietors of patents are kept, and all transfers, licences, etc., must be entered therein.

Applications to the High Court may be made by the Attorney-General and by persons interested for the cancellation of a patent upon the usual grounds.

A penalty not exceeding 25*l.* is imposed upon any person selling an article as patented which has not been patented, and a penalty not exceeding 50*l.* is imposed upon any person selling

an article as having a patent right for it, when another person has the patent right.

Actions for infringements must be taken in the High Court, and the Act gives full directions as to pleadings and the conduct of such proceedings.

The lawful representatives of a deceased inventor may obtain a patent right for the invention on making application within six months of the death.

Protection for inventions shown at international or industrial exhibitions is provided for.

The Government may demand from the inventor a model of his invention at any time on paying the cost of making same.

The fees payable for patents are:

On the deposit of the application	£1	1s.
,, ,, issuing of certificate	1	1
,, ,, sealing the patent	1	1
Before the expiration of three years	5	0
,, ,, ,, ,, ten ,,	10	0

* Tunis.

The Law of December 26, 1888, provides for the protection of inventions by patents for terms of five, ten, or fifteen years, subject to an annual tax of 100 piastres.

Petition must be made to the Prime Minister, accompanied by a specification in French, and drawings (in duplicate), together with 100 piastres. Notice of the application is then published, and oppositions can be entered within two months. The specifications, drawings, and models are open to public inspection.

Alterations, improvements, and additions may be made by the patentee or person entitled to the patent during its whole term. Certificates of addition are given subject to payment of a fee of 20 piastres. None but the patentee or persons interested through him can, during the first year, legally obtain patents for alterations, additions, or improvements, the original patentee having the preference for that year.

Patents may be assigned in whole or in part by notarial deeds, and all assignments must be registered. Licensees of the original patent have the benefit of all certificates of addition.

Protection is given to inventions exhibited at public exhibitions.

Foreigners may obtain patents, but where a patent has been

already granted abroad, the duration of the Tunis patent must not exceed that of the foreign patent.

Patents are null if the invention is not new, if the title of the patent is fraudulent, and if the specification is insufficient. No invention is considered new which has been published in Tunis or abroad before the date of the application, sufficiently to enable it to be worked.

The patentee is deprived of his rights: On non-payment of the annuity before the beginning of each year; if the invention is not worked within two years from the date of the patent, or has ceased to be worked for two consecutive years, or where the patentee has introduced into Tunis articles manufactured in foreign countries similar to those which are protected by the patent; but authority may be obtained for the introduction of models or of articles intended for public exhibitions or for trials.

Whoever calls himself patentee having no patent, or who, being a patentee, mentions his patent without the words 'without guarantee of the Tunisian Government,' is liable to a fine. Action can be taken for the annulment of the patent by any person interested,

Infringers can be prosecuted and punished by fine, and, in the case of a workman or an associate of a workman of the patentee, by imprisonment.

Turkey.

The Ottoman Government grants patents to natives or foreigners for five, ten, or fifteen years, subject to an annual tax of two Turkish pounds, but the Turkish patent will expire with the termination of any earlier foreign patent. Pharmaceutical compounds or medicines and financial combinations are not patentable, and the inventions must not have been published in Turkey or abroad. The applicant for a patent must supply a petition, a description and drawings, or samples to explain the invention. The petition must be limited to a single object, with the details which form part of it, and must indicate the term for which the patent is solicited. The term of the patent is reckoned from the date of filing the application. Patents are granted without examination and at the inventor's own risk. Inventions relating to instruments of warfare are submitted to the War Department, and such as are approved by the department are bought by the State. Inventions of this kind which are not favourably reported upon are rejected.

The term of the patent can only be prolonged by special legislation.

Certificates of alteration, addition, or improvement are granted. The patentee is, however, alone entitled to receive a certificate of addition during the first year of his patent. If such applications are made by others they will be kept secret until the first year of the patent has expired, and will then be granted.

Patents may be assigned in whole or in part by a deed of assignment, which must be registered with the Minister of Commerce; and the specifications, drawings, and models are accessible to the public, and may be copied.

Patents are invalid when the invention is not new or when they are for mere principles, when the invention is contrary to public morals, when the title of the patent is fraudulently misleading, or when the specification is insufficient. Patents will become void in default of payment of the annuities, when the invention is not worked in Turkey within two years from the date of the patent, or if the working is thereafter discontinued for two consecutive years, unless the patentee can show cause to justify his inaction, or by the introduction of articles manufactured abroad according to the invention, unless by special authorisation of the Government.

Any interested person may bring an action before the Tribunal of First Instance to rescind the patent, and infringers of patents are liable to a fine of from five to one hundred Turkish pounds.

URUGUAY.

The Law of November 12, 1885, authorises the executive to grant patents for inventions for terms of three, six, or nine years at the applicant's option, and subject to an annual payment of 25 dollars. After the grant is made the executive fixes a period within which the patented invention must be worked in Uruguay.

Application for the patent must be made by petition to the Minister of the Interior, stating the term desired, accompanied by a specification and specimens, drawings, or models. The Patent Office is to publish every two years all the privileges granted, with the specifications and drawings.

Patents of addition may be obtained. Patents may be assigned by public deed.

Provision is made for nullity and forfeiture of patents, and for the protection of patentees against infringements.

A register of patents is kept.

VENEZUELA.

A law of May 25, 1882, provides for the grant of patents for five, ten, or fifteen years for inventions not already known and used in the country, or patented or described in a printed publication in the republic or abroad, or having been in public use for more than two years prior to the application, unless such use has been abandoned.

Applications for patents must be addressed to the Federal executive power through the Minister of the Interior. The applicant must declare on oath that he is the inventor. The patent for an original invention is subject to payment of about 80 francs per annum for the whole term of the patent.

Persons who have obtained patents in foreign countries can obtain patents for Venezuela, but such patents are only granted for the number of years the foreign patent has to run.

The description of the invention patented is published in the Official Gazette after the expiration of the patent, or after the patent is declared null.

Actions for infringements may be tried before the Federal tribunals.

PATENT LAWS OF THE BRITISH POSSESSIONS ABROAD.

SINCE the Imperial Government declined in the year 1852 to issue any grants of patents for the colonies, most of our possessions abroad have themselves established patent laws, principally framed upon the British law. The number of patents granted in Canada, India, and the Australian colonies is large and is increasing. It will be seen from the following abstracts that there is now no important colony in which inventions cannot be protected.

By an Order in Council dated February 8, 1890, New Zealand is made a party to the International Convention for the Protection of Industrial Property. Victoria, Queensland, Tasmania, and Natal are the only other colonies which have at present passed the necessary laws to enable them to join the convention.

THE BAHAMA ISLANDS.

The Colonial Act, 52 Vict. cap. 23, assented to May 23, 1889, makes provision for protecting inventions in these islands.

Every person desirous of obtaining letters patent must file a complete specification in the office of the Registrar of Records, and must pay to the registrar 3*l*. Persons residing abroad must file with the specification a certified copy of any letters patent which they have obtained abroad for the same invention. The applicant must, within ten days after filing his complete specification, present a petition to the Governor, accompanied by a copy of the specification, praying for the grant. The Governor will thereupon issue letters patent for the invention for the term of seven years, unless he is of opinion the invention is not new, is not patentable in law, is already in the possession of the public, has been previously described in a printed publication, or has already been patented in the colony. Specifications are open to the public in the office of the Registrar of Records.

Legal proceedings for infringement may be taken in the Courts of the islands, the remedies being similar to those given by the English law, and the defendant may plead any matter which can be pleaded in English Courts.

Where the invention is not brought into operation within three years after filing the specification, the exclusive privilege is forfeited and ceases to exist.

Patents are assignable, in whole or in part, by instruments in writing, which must be registered in the office of the Registrar of Records.

Upon application to the Governor in Council patents may be renewed for a further term of seven years on payment of 10*l*., and for a third term of seven years on payment of 20*l*.

Registers of patents and of proprietors are kept at the office of the Registrar of Records, in which the grants of patents, assignments, and licences are entered. Writs of *scire facias* to repeal patents may be issued to the Provost Marshal if the grantee resides in the colony; if not resident, such writs are to be filed in the office of the prothonotary of the General Court, and notice thereof in writing is to be served at the last known residence or place of business of the grantee.

Barbados.

An Act dated December 12, 1883, amended by an Act of 1888, provides for the grant of privileges to inventors.

Every person filing a complete specification of his invention, with a copy, in the Colonial Secretary's Office of the island, and paying a fee of 3*l*. 6*s*. 8*d*., is entitled to the exclusive right of the invention for a term of seven years.

The privileges may be protected from infringement by proceedings taken in the courts of the island, the pleadings and proceedings being similar to those taken in the High Court of Justice in England.

The exclusive privilege will be void unless the invention is new, in case the applicant is not the first and true inventor, or if at the time the specification was filed the invention was well known elsewhere, and also known to some other person or persons in the island.

The exclusive right will cease if the invention is not brought into operation in the island within three years after filing the specification.

The privilege may be renewed for two additional terms of seven years each on application being made before the expiration of the original or renewed privilege, and on payment of 10*l*. for the second term, and 20*l*. for the third term.

Articles made abroad according to the invention protected can be imported without invalidating the privilege granted.

BORNEO (BRITISH NORTH).

The Governor of British North Borneo, by Proclamation 1 of 1887, enacted that the Ordinance of the Legislative Council of the Straits Settlements numbered XII. of 1871, entitled 'An Ordinance for granting exclusive privileges to inventors,' was adopted as the law of British North Borneo, and any reference to persons, places, or subjects in the said Ordinance should be taken as referring to corresponding or analogous persons, places, or subjects within British North Borneo. (The Straits Settlements Law is given at p. 494.)

BRITISH GUIANA.

The law relating to patents is governed by an ordinance dated July 12, 1861, No. 13.

Every inventor desirous of obtaining a patent must petition the Governor for the grant. The form of the documents is very similar to those in use in Great Britain, and the proceedings under the petition are also similar, there being a reference to the Attorney-General, whose duties in respect to patents nearly resemble those of the same officer at home. Provisional protection is granted for twelve months. The patent expires with the expiration of an earlier patent for the same invention elsewhere.

The conditions of the patents granted are nearly, if not precisely, similar to those of the British grants. A duty of 100 dollars is payable in the seventh year of the term. The patent is granted for fourteen years, and the Governor has power to prolong the patent for a term not exceeding seven years. A further duty of 100 dollars is payable on sealing a patent for a prolongation.

The ordinance also contains provisions as to disclaimers similar to those in operation at home. Proceedings for infringement must be taken in the Supreme Court of the island, or before the Chief Justice. Confirmation of a patent can be obtained when the patentee is proved not to be the first inventor, though he believed himself to be so. The letters patent will not prevent the use of the invention in foreign ships resorting to the ports of the colony.

British Honduras.

Patents are granted for this colony, under the Act for amending the law for granting patents for inventions, dated September 10, 1862, now chapter 74 of the consolidated laws of British Honduras.

The provisions of this Act bear a general resemblance to those in the British Patent Law Amendment Act of 1852. Commissioners of patents for inventions are appointed, who have power to make rules regulating grants. Every applicant must petition the Commissioners, and the petition and accompanying specification are referred to the Attorney-General for the colony. The applicant can lodge either a provisional or a complete specification in the first instance. The Attorney-General grants a certificate of allowance, which certificate is filed in the office of the Colonial Secretary, whereupon the invention is protected for six months. This protection is advertised, and the applicant is at liberty to give notice to proceed; and, on the expiration of the time allowed for oppositions, letters patent are granted for fourteen years. The letters patent are void unless duties are paid at the expiration of three and seven years from the grant. The letters patent expire on the determination of any earlier patent granted for the invention in Great Britain or in any foreign country or British colony. The letters patent will not prevent the use of the invention in foreign ships within the ports of the colony. This Act also provides for a 'Register of Patents' and a 'Register of Proprietors' being kept. All assignments and licences must be registered. Patentees may also enter disclaimers or memoranda of alteration. The Commissioners of Patents are authorised to grant prolongations of the original term not exceeding fourteen years. Actions for infringements must be brought in the Supreme Court of the colony.

The Government fees are:

	Dollars
On sealing letters patent . . .	30
Third year's duty	50
Seventh year's duty	100

Canada.

The Law of Patents for the Dominion of Canada is regulated by the Patent Act No. 61 of 1886.

This Act provides for the constitution of a Patent Office and

the appointment of a Commissioner of Patents, who is the Minister of Agriculture for the time being, also for a deputy commissioner and such clerks and officers as are necessary. A seal is also provided for, with which all patents and other documents issuing from the Patent Office are to be sealed.

Patents may be obtained by inventors or their assignees, or, in case of death, their legal representative, for all inventions not known or used by other persons before the invention thereof, and which have not been in public-use or on sale with the consent of the inventor for more than one year previous to the application in Canada. If the inventor be alive he must himself sign the application papers, as the applicant is required to make oath that he is the inventor, or, if the inventor is dead, that the applicant believes the person whose assignee or legal representative he is was the inventor, and must mention as his domicile some known and specified place in Canada. Where a foreign patent exists the Canadian application must be made before the foreign patent has been in existence for twelve months, and any person who has commenced the manufacture during such twelve months has the right to continue notwithstanding the patent; the Canadian patent expires at the earliest date at which any foreign patent for the same invention expires. Improvements upon original patents may be patented giving the inventor no right to use the original invention, nor does the original patent give any right to use the patented improvement.

A specification of the invention, accompanied by drawings where necessary, must be lodged in duplicate with the petition for the patent, and this specification must clearly describe the invention and state clearly what is claimed as new. A working model, or specimens of the ingredients and of the composition of matter, sufficient for experiments, must also be furnished, unless specially dispensed with.

The Commissioner may refuse patents:

(*a*) When he is of opinion that the invention is not patentable in law.

(*b*) When he is of opinion that the invention is already in possession of the public with the consent of the inventor.

(*c*) When he considers there is no novelty;

(*d*) Or that the invention has been described in a printed book or publication before the application, or is otherwise in the possession of the public.

(*e*) When the invention has already been patented in Canada or elsewhere, unless the Commissioner has doubts whether

the previous patentee or the second applicant is the first inventor.

The applicant is at liberty to appeal to the Governor in Council from an adverse decision of the Commissioner.

Conflicting applications are submitted to three arbitrators, one to be chosen by each party and the third by the Commissioner.

The term of each patent is fifteen years, and the full fee may be paid on application for the whole term, or for five or for ten years only; and if a partial fee only is paid the patent will expire at the termination of the term for which the fee is paid, unless the fee for the further term is paid before the expiration of the term for which the fee is originally paid, and a certificate of such further payment obtained from the Patent Office.

Patents may be surrendered and new patents issued with amended specifications where it appears there has been an insufficient description or specification, or the patentee has claimed more than was new, if such error has arisen from inadvertence, accident, or mistake, and separate patents may be issued for distinct and separate parts of the invention patented.

The patentee, his assignee, or legal representatives may disclaim anything included in the patent by mistake, but such disclaimer will not affect pending suits.

Patents are assignable as to the whole or any part, and assignments must be registered in the Patent Office.

The patent will be held void if any material allegation in the application is untrue, or if the specification contains more or less than is necessary, when such addition or omission is wilfully made; but if it appears to the Court that such omission or addition was involuntary, and it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the Court will hold the patent valid for such parts as the patentee is entitled to.

Remedies are given for the recovery of damages for infringement, and patentees may obtain injunctions to restrain infringements and orders for accounts, etc.

Where the plaintiff fails to sustain his action because his specification and claim are too wide, whilst the defendant is found to have infringed a part of the patent which is properly specified and claimed, the Court may discriminate and give judgment accordingly.

Proceedings to repeal patents may be taken by action of *scire facias*.

Patents granted are void unless the construction or manufacture of the patented invention is commenced in Canada within

two years from the date of the patent, and is thenceforward continuously carried on. The patent will also be void if the patentee imports articles made according to the invention into Canada after the expiration of twelve months from the date of the grant; the term for manufacture in Canada may be extended for a further term of two years if the patentee can prove that for reasons beyond his control he was prevented from complying with the above conditions. The term for importations may also be extended for an additional term of one year on satisfactory cause being shown. An intending applicant not having perfected his invention may file a description of it in the Patent Office, and is thereby entitled to receive, during one year from the date of his filing, notice of all applications of a conflicting nature.

The fees payable to the Commissioner of Patents are: For the full term of fifteen years, 60 dollars; for ten years, 40 dollars; for five years, 20 dollars; for a further term of ten years, 40 dollars; for a further term of five years, 20 dollars; and for lodging a caveat, 5 dollars.

The Government of Canada may use any patented invention, paying to the patentee such sum as the Commissioner reports to be a reasonable compensation; the use of the invention in any foreign ships is not prevented by the patent.

All patented articles, or the package containing them, must be stamped or marked with the word 'Patented,' and with the year of the grant: the patentee is liable to a fine of 100 dollars for selling or offering for sale any patented article not so marked. Marking an article 'Patented' which is not patented is a misdemeanor, and persons so offending are liable to fine and imprisonment.

All patents issued prior to the Act for any province now forming part of Canada remain in force for the residue of the term granted, and any patent previously granted for any province may, if the patent has not been known or used, or has not been on sale with the consent of the patentee in the other provinces, be extended over the whole of Canada for the remainder of the term mentioned in the provincial patent, and every patent previously issued upon which the fee required for the whole term has been paid shall be deemed to have been issued for the term of fifteen years, subject to its ceasing on the same conditions as those on which patents thereafter issued are to cease under this Act.

Cape of Good Hope.

This Colonial Legislature has adopted a system very similar to that of 1852 of the mother country, governed by an Act passed in 1860 (No. 17).

The applicant for a patent must deposit at the office of the Colonial Secretary a specification of his invention, which is referred to the Attorney-General, who reports upon it and issues a warrant for the grant.

A writ of *scire facias* may be sued out for the repeal of the patent.

The letters patent are void unless a stamp duty of 10*l.* is paid before the expiration of the third year, and of 20*l.* before the expiration of the seventh year of the grant. Confirmation of a patent can be obtained when the patentee is proved not to be the first inventor, although he believed himself to be so.

Extensions for a term not exceeding fourteen years may be obtained.

Letters patent for foreign inventions expire with the foreign grant. The grant does not prevent the use of the invention in foreign ships resorting to ports in the colony.

The regulations as to disclaimers and legal proceedings are similar to those of the home patents.

A register of patents and of proprietors is kept, and all assignments and licences must be registered.

There is a penalty of 100*l.* for the unauthorised use of the word 'Patent.'

Particulars of breaches and of objections are to be given in patent actions.

Ceylon.

The Inventions Ordinance No. 6 of 1859 governs the law of patents in this colony.

The inventor of any new manufacture may petition the Governor for leave to file a specification thereof; such petition must be in writing, and be signed by the petitioner or his agent, and must state the name, condition, and place of residence of the petitioner, and the nature of the invention, upon which the Governor may order the petitioner to file a specification.

The specification must be filed within six months from the date of the order, upon which the Governor may grant to the inventor the sole and exclusive privilege of making, selling, and

using the said invention in Ceylon for the term of fourteen years from the time of filing such specification; and for a further term not exceeding fourteen years, upon petition to be presented by such inventor, not more than one year and not less than six months before the expiration of the exclusive privilege granted.

The specification must be in writing, and be signed by the petitioner, and must particularly describe and define the nature of the invention, and the manner in which the same is to be carried out. The use of an invention in public by the inventor, his servants, agents, or licensees is not deemed a public use within the meaning of the ordinance.

The exclusive privilege will cease if the invention or the mode in which it is exercised is declared by the Governor to be mischievous to the State, or generally prejudicial to the public.

No specification can be filed until the petitioner has paid all fees. The fee on filing a specification is 10*l*.

Fiji.

The legislation with respect to the protection of inventions by letters patent is comprised in the Ordinances No. 3 of 1879 and No. 7 of 1882.

The inventor, his heirs, executors, administrators, or assigns can obtain letters patent for the term of fourteen years by filing in the office of the Colonial Secretary a petition accompanied by a specification and declaration. Provisional protection is granted for six months.

The rights granted in the colony will cease with the expiration of any earlier patent obtained elsewhere.

All letters patent and assignments are to be registered in the office of the Registrar General.

Letters patent may be conceded or revoked by order of the Supreme Court or a judge if the invention is of no utility, if the invention was not new at the time of presenting the petition, if the petitioner is not the true and first inventor, or if the petition or specification contains a wilfully false statement.

The Supreme Court has power to order any specification or petition to be amended.

The fees payable are:

On depositing petition and specification .	£5	5s.
For certificate of provisional protection .	3	3
For obtaining letters patent . . .	10	10
Filing memorandum of alterations in amendment of specification . .	1	1

Hong Kong.

The Ordinance for this colony is No. 14 of 1862, by which all British patents can be extended to Hong Kong. A petition, specification, and declaration are to be filed in the office of the Colonial Secretary, and notice thereof and of the intention to apply for letters patent and of the time of the sitting of the Executive Council, before whom the matter of the petition will come for discussion, together with such other particulars as the Governor shall require, must be inserted twice in the Hong Kong Government Gazette. The Governor will either grant or refuse the patent according to the advice of the Executive Council. The letters patent, when granted, are directed to be in the form prescribed by the Patent Law Amendment Act, 1852, for British letters patent, and the letters patent, if granted, confer privileges similar to those granted by British letters patent and for the term of that patent. The letters patent can be extended in cases where the British patent has been extended.

The petitioner must, in all cases, be either the patentee or the owner by assignment of the patent in Great Britain.

India.

The law of patents in India is now governed by the Inventions and Designs Act, 1888.

The inventor of a new manufacture desirous of obtaining protection in India must apply in writing to the Governor-General in Council for leave to file a specification thereof. He must state his name, occupation, and address, and, if a patent has been obtained in England, the date of the patent, and must also furnish a specification and drawings, and state the particular novelty whereof it consists. A model may also be required.

The Governor-General may, after such inquiry as he sees fit (including, where he thinks it necessary, a reference, at the cost of the applicant, to some person named by him), authorise the applicant to file a specification.

If two or more inventors apply on the same day to file specifications of identical inventions, the Governor-General may authorise both or all the applicants to file specifications: if they apply on different days, the first applicant has a preference.

If the applicant causes a specification of his invention to be filed, and pays the required fee within six months from the date

of the order giving him leave to file, the applicant is entitled to the exclusive privilege within British India for fourteen years; this privilege, however, ceases if the prescribed fees are not duly paid. The periods allowed for filing the specification, and also for payment of the fees, may be extended on application made.

The specification must be in writing signed by the applicant, and must set forth the precise invention, with such full particulars as will enable others to put the invention into practice, and, if the invention is for an improvement only, the specification must distinguish explicitly between what is old and what is new.

Four copies (at least) of the specification and drawings are required, one for the Secretary and the others for the Governors of Fort George, Bombay, and the Chief Commissioner of Burma; and the specifications are to be open for inspection at places to be appointed by these authorities.

The Secretary is to keep a book, called the 'Register of Inventions,' in which is entered every application for leave to file a specification, any order made thereon, any specification filed, and any subsequent proceeding relating to the invention.

The Secretary is also to keep an address book, where any person interested in any application or privilege may cause to be stated some place in British India where notice of any rule or proceeding relating to the privilege may be served upon him.

The inventor of a new manufacture may, at any time not more than one year and not less than six months before the time limited for the expiration of an exclusive privilege, apply to the Governor-General for an extended term, and the Governor-General may, if he is of opinion that the inventor has not been adequately remunerated, make an order extending the term for a further term not exceeding seven or, in exceptional cases, fourteen years, and upon payment of prescribed fees.

The exclusive privilege has the like effect against her Majesty as against a subject, but the officers of her Majesty may use the invention on terms to be agreed upon with the inventor, or, in default of such agreement, on such terms as may be settled by the Governor in Council.

Defective or too extensive specifications may be amended.

The exclusive privilege will not be granted: (*a*) If the invention is of no utility, (*b*) if it is not new, (*c*) if the applicant is not the inventor, (*d*) if the specification does not fulfil the requirements of the Act, (*e*) if the application contains a wilful or fraudulent misstatement, (*f*) if the application is made after the expiration of

a year after the acquisition of a foreign patent for the same invention.

The invention will be deemed new if it has not before the application been publicly used in British India or the United Kingdom, or publicly known there by means of a written publication; but the public use or knowledge is not deemed so within the meaning of the Act if the knowledge has been obtained surreptitiously or communicated to the public in fraud of the inventor or in breach of confidence, provided the inventor has not acquiesced in the public use, and that he has applied for leave to file a specification within six months after commencement of that use.

The use of the invention in public by the inventor or his licensee for a period not exceeding one year prior to his application is not deemed a public use within the Act.

If a British patentee makes an application in India within a year of the sealing of the British patent the invention shall be deemed new if the invention was not publicly used or known in India before the application, notwithstanding it may have been known or used in India or the United Kingdom before the date of the Indian application; and the same protection is given to the inventor where the invention may have become known or used during a pending application in the United Kingdom, provided that there is not more than twelve months' interval between the British and Indian applications. The inventor is also protected against an exhibition of his invention at an industrial or international exhibition certified as such by the Governor-General.

The exclusive privilege will cease if it is declared to be mischievous to the State, or prejudicial to the public, or upon the revocation or expiration of the British or any foreign patent obtained for the same invention.

The Act also contains a series of provisions relating to the proceedings which may be instituted for infringements.

The exclusive privilege may be declared void on proceedings being taken, resulting in declarations of the Indian High Court that the invention is of no utility or not new, that the applicant was not the inventor, that the specification is insufficient, or contains wilful or fraudulent misstatements, or that the invention is injurious to the public.

If the actual inventor proves to the Court that the applicant was not the actual inventor and that the privilege was obtained in fraud of the inventor, the Court may make a decree vesting the exclusive privilege in the actual inventor, and may require the

applicant to pay over to the actual inventor the profits derived by him from the invention.

On petition of any person interested, and proof that the exclusive privilege is not worked in India, or that the reasonable requirements of the public cannot be supplied, or that any person is prevented from using or working an invention of which he is possessed, the Governor-General may order, or may himself grant, licences in such terms as he may deem just.

Assignments may be made for any local area.

The fees payable under the Act are as follows :

	Rupees
Application for leave to file a specification .	10
Filing a specification	30
Extension of time for filing	20
Before the expiration of the 4th, 5th, 6th, 7th, and 8th years of the privilege . .	50
Before the expiration of the 9th, 10th, 11th, 12th, and 13th years	100
Application for extension for a further term	50
Continuance of term	100
Application for amendment	20
Petition for compulsory licence . . .	50

Jamaica.

The law of patents in this island is governed by the Act, chap. 30, of 1857.

Every inventor desirous of obtaining a patent must petition the Governor ; the petition, accompanied by a declaration as to the invention, and a specification fully describing the same, is then referred to the Attorney-General, who gives a certificate of his allowance, upon which the Governor issues letters patent.

Drawings are to be furnished in duplicate.

The patent must be brought into operation in Jamaica within two years from the date of the patent.

The term of the grant is for fourteen years, and may be extended for a further period of seven years.

The patentee is at liberty to assign all or any part of his rights, and patents may be issued to assignees of any persons who have obtained patents in other countries.

The Act makes provision as to disclaimers, and provides that a patentee may add a specification or description of any improvement upon the original invention, and have the same annexed to the original specification.

Provisions are also made as to pleadings and costs in actions, as to the writ of *scire facias*, and as to the appointment of Commissioners.

If it is proved in any action that, by mistake, accident, or inadvertence, the patentee has claimed something of which he was not the inventor, the patent shall be deemed valid for so much of the invention as shall actually be his own. Treble damages are recoverable by a patentee from unlawful users of his patented invention. The wrongful marking of goods in imitation of a patentee's mark is subject to a penalty.

All applications for patents must be accompanied by a power of attorney, bearing the English stamp duty; proved as required by the local statute, 27th Victoria, chap. 17.

The letters patent bear a stamp duty of 6*l*. 10*s*.

The fee for reference to the Attorney-General is 5*l*.

Leeward Islands.

The Leeward Islands consist of Antigua, Montserrat, St. Christopher, Nevis, Dominica, Anguilla, and the Virgin Islands. The law of patents is contained in the Acts No. 12 of 1876 and No. 16 of 1878. The Attorney-General, the Auditor-General, and the Treasurer of the Presidency of Antigua, with such other persons as may be appointed by the Governor, are the Commissioners of Patents. Patents are granted for the term of fourteen years on applications, including a petition, declaration, and specification. The proceedings in applications for patents are very similar to the proceedings under the British Patent Law Amendment Act of 1852. The patent becomes void with the expiration or determination of any earlier patent elsewhere for the same invention, and no patent granted in the colony after the determination of any earlier patent elsewhere is valid. The Acts provide for the printing of all specifications, registers of patents, and registers of proprietors. Actions for infringements are regulated by the Code of Civil Procedure. The Government fees amount to 28*l*. in the case of every unopposed patent. A duty of 10*l*. is payable at the termination of three years, and a duty of 20*l*. is payable at the end of seven years. The stamp duty on a disclaimer is 3*l*., and a fee of 2*l*. is also payable to the Attorney-General in respect of each disclaimer.

Malta.

An ordinance (No. 13 of 1889) enacted by the Governor with the consent of the Council provides for the protection of inventions in Malta.

Patents may be obtained by first and true inventors for mechanical contrivances, processes of manufacture, patterns or designs, for a term not exceeding fourteen years.

The applicant must file in the Chief Secretary's office two copies of a specification, containing a declaration that the applicant is himself, or is the authorised agent of, the true and first inventor, a description of the invention, illustrated with necessary drawings, and claims for the inventions or combinations claimed as new and for which a patent is asked.

A fee of 1*l.* is to be paid on each application, and every two years a further fee of 1*l.*, with 5 per cent. upon the profits which have arisen from the exclusive manufacture, the amount of which is to be declared by an affidavit of the applicant.

The patent is to cease whenever it is proved before the competent Civil Court that the invention claimed has been previously made publicly known in the islands or elsewhere, or that the applicant is not the first inventor or his representative.

The inventor may be required to assign his right, or to grant the use thereof, for a consideration to be determined by the Civil Court if the invention has not been put into action within twelve months subsequent to the concession, or if its working shall have been suspended for twelve months continuously.

Copies of specifications may be inspected in the Public Registry and in the Chief Secretary's office.

An inventor on filing his specification may request that it be not published, and may within a year file a second amended specification, modifying the first and setting out improvements of details.

Patents granted in the United Kingdom, in the Colonies, or in other countries may be extended to Malta for the unexpired term of the original patent.

Mauritius.

The law of patents for this colony is regulated by an ordinance of the Governor of Mauritius dated May 22, 1875. The Governor, with the consent of the Council of Government, is empowered to grant patents for inventions for a period not exceeding fourteen years, and for such further term, not exceeding fourteen years, as the Governor in Council may think fit. The patent may be applied for either by the inventor or by his executors, administrators, or assigns.

The application must be in the form of a petition and decla-

ration, and must be accompanied by a specification and drawings. These papers are referred to the Procureur-General; and if he approves of them, he is authorised to issue a certificate to that effect, and the inventor is thereby provisionally protected. A payment of 10*l.* is to be made to the Procureur-General upon the issue of his certificate. After the issue of the certificate the application is advertised in the Gazette, and any opposition thereto must be entered within one month from the advertisement. If there is no opposition the patent is sealed upon payment of 2*l.* to the Receiver-General, and upon deposit, in the office of the Colonial Secretary, of a printed copy of the petition and specification.

The patentee has power to petition the Governor for allowance to amend the specification. No patent is to be granted for an invention in respect of which a patent has been granted out of the colony and has expired. The importer into Mauritius of a new invention is not deemed an inventor unless he is the actual inventor. The use of an invention in public by the inventor, or by his servants or agents, or by any other person with his licence, for a period not exceeding one year prior to the date of the petition, is not deemed a public use within the meaning of the ordinance.

An inventor having obtained British letters patent may obtain a patent in Mauritius provided the application be made within twelve months from the date of the letters patent, although previously known or used in Mauritius, provided that such knowledge or use in Mauritius was not prior to the date of the British patent.

The ordinance also regulates the proceedings in cases of infringement of letters patent.

NATAL.

The law of patents for this colony is governed by the Colonial Act No. 4 of 1870, 'To provide for the granting in this colony of patents for inventions,' and is based on the provisions of the British Patent Law Amendment Act of 1852. The law No. 32 of 1884 provides for the extension to this colony of the provisions of the International Convention.

The power of granting letters patent for fourteen years is vested in the Lieutenant-Governor. Applicants are required to deposit in the office of the Attorney-General a description of the invention or a provisional specification; a certificate of such deposit is given to the applicant, whereupon the invention is protected for six months. In lieu of the provisional specification the appli-

cant may, if he thinks fit, deposit a complete specification with the Attorney-General. The applicant may give notice to proceed immediately after the deposit of his specification. This notice to proceed is advertised in the Government Gazette. After the expiry of the period allowed for oppositions, the Attorney-General grants his warrant, upon which letters patent are sealed. The letters patent are void unless certain duties are paid at the expiration of three and of seven years. The letters patent also expire with the determination of any British or foreign patent of an earlier date. Patentees are at liberty, with leave of the Attorney-General, to enter disclaimers or memoranda of alteration. The Lieutenant-Governor is empowered to grant prolongations of the original term not exceeding fourteen years. The law provides that a 'Register of Patents' and a 'Register of Proprietors' shall be kept.

All actions for infringements are to be brought in the Supreme Court.

The fees for sealing the letters patent are	£1 10s.
Third year's duty	5 0
Seventh year's duty	10 0

NEWFOUNDLAND.

The law of patents for this colony is defined by the Consolidated Statutes XV., chap. 54, sect. 1.

Inventors desirous of obtaining patents in Newfoundland must present a petition to the Governor for the grant, and must deliver into the office of the Colonial Secretary a specification of the invention, and, in case of a machine, a model also. The patent is granted upon this petition, after a reference to the Attorney-General.

The patent is granted for fourteen years, but may be extended for a further term of seven years. The invention must be worked in the colony within two years from the date of the grant.

The patent expires with the determination of any earlier patent elsewhere.

NEW SOUTH WALES.

The Acts of the Colonial Legislature relating to patents are dated December 6, 1832, June 19, 1879, and July 8, 1887.

Every person who, upon claiming to be the author or designer of any invention by his agent or assignee, shall be desirous of obtaining letters patent, shall pay to the Colonial Treasurer the

sum of 5*l.*, and shall, after such payment, lodge a petition to the Governor setting forth that he is the author or deviser of such invention, or the agent or assignee of the author or deviser, and specifying the particulars of such invention, and that he has paid to the Colonial Treasurer the sum of 5*l.*, whereupon, if the application is approved by the Minister of Justice, the Governor may grant letters patent.

Certificates of provisional protection may be obtained for twelve months, on payment to the Colonial Treasurer of 2*l.*

The Governor will grant letters patent to the holder of a certificate of provisional protection on a complete specification being filed, and on further payment of 3*l.* to the Treasurer.

Letters patent are dated and sealed as of the day of the deposit of the application for provisional protection, but no action can be taken in respect of any infringement committed before the deposit of the complete specification. Patents are granted for not less than seven or more than fourteen years.

Certificates of provisional protection and letters patent are assignable. Every assignment and licence must be registered in the office of the Examiner of Patents. Assignments executed in the United Kingdom or elsewhere (not being within the Australian colonies) must be registered within ninety days from the date of execution.

The Governor may appoint an examiner of patents, who, under the direction of the Minister of Justice, shall examine and report to that officer upon all petitions for letters patent.

The Act gives no power to amend specifications after the patent is issued, and there are no provisions for compulsory working.

* New Zealand.

The law of patents for this colony has been consolidated by Act No. 12 of 1889, upon the lines of the British Patents Act, 1883.

The Governor is empowered to appoint a Registrar and deputy Registrar of Patents, a place to be the Patent Office, and local offices, and Patent Office agents.

Any person may make application for a patent, and a patent may be granted to several persons jointly, of whom one only is the inventor. Patents may be obtained by the representatives of deceased inventors, if such applications are made within six months of the decease of the inventor. Mere importers cannot obtain patents.

Applications are to be made in the form set out in the schedule to the Act, and must be left at or sent by post to the Patent Office, or left at a local Patent Office.

The application must be accompanied by the declaration of the inventor, and by either a provisional or complete specification signed by the inventor; the specification must be limited to one invention.

The Registrar must examine every application, to ascertain whether the nature of the invention is described, that the papers are prepared as prescribed, and that the title sufficiently describes the subject-matter of the invention. The Registrar has power to refuse the application, or to require its amendment.

If a provisional specification has been first deposited, the complete specification must be lodged within nine months from the date of acceptance of the application, the Registrar must examine both specifications for the purpose of ascertaining that the complete specification has been prepared as prescribed, and that the invention is substantially the same as that described in the provisional specification. If the conditions have not been complied with, the Registrar may refuse to accept the complete specification until it is amended to his satisfaction, but such refusal is subject to appeal to the Court. The application is void if the specification is not accepted within twelve months from the date of application.

The acceptance is advertised in the Gazette, and oppositions may be entered, notice being lodged within two months of the advertisement.

The Registrar is empowered to hear the applicant and the opposer, and to determine whether the grant shall be made or not; this decision is subject to an appeal to the Court.

On the expiration of two months from acceptance, if there is no opposition, or, in case of opposition, if the determination is in favour of the grant, the Registrar is to seal the patent with the seal of the colony. Every patent is to be sealed as of the date of acceptance, but no proceedings can be taken in respect of an infringement committed before the publication of the specification. The patent when sealed covers the entire colony and its dependencies for fourteen years, unless the patentee fails to make the prescribed payments within the prescribed times. Every patent is to be granted for one invention only, but may contain more than one claim; but no objection can be taken to the patent on the ground that it covers more than one invention.

Power is given to the Registrar to allow enlargement of the

terms (not exceeding three months) for making the prescribed payments, where not made by accident, mistake, or inadvertence.

Inventions may be used during the term of provisional protection, without prejudice to the patent to be granted.

Amendments of the specifications may be made by leave of the Registrar subject to appeal to the Court, and applications for amendments may be opposed by any person. No amendment is to be allowed that will make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention originally claimed. Leave to amend is conclusive as to the right of the party to make the amendment allowed, except in case of fraud. Amendments may, by leave of the Court or a judge, be made during actions.

The Governor is empowered to order the patentee to grant licences, on such terms as he may think right, where it is proved that, by the default of the patentee to grant licences on reasonable terms, the patent is not being worked in the colony, or the reasonable requirements of the public are not supplied, or where any person is prevented from working to the best advantage an invention of which he is possessed.

The Governor may grant extensions of the term of patents for terms not exceeding seven, or, in exceptional cases, fourteen years, upon the report of the Court that the patentee has not been adequately remunerated.

Revocations of patents may be obtained on petition to the Court. The proceedings with respect to revocations are substantially similar to those contained in the British Act. The proceedings with respect to infringements are also substantially the same as in the English Courts.

A Register of Patents is to be kept, containing the names and addresses of grantees of patents, notifications of assignments and licences, and of extensions, amendments, and revocations.

Patents may be assigned or licensed for the whole colony, or for any particular part of it.

The exhibition of any invention at industrial or intercolonial exhibitions will not prejudice the patent right on the prescribed proceedings being taken.

The Registrar may require the patentee to furnish a model, on payment to the patentee of the costs of its manufacture.

A patent will not prevent the use of an invention for the navigation of a foreign vessel within the colonial jurisdiction; but this protection does not extend to vessels of any foreign state having patent laws which prevent the use of such inventions in

British vessels in waters within the jurisdiction of such foreign states.

The Governor has power to deal with applications for patents for improvements in instruments or munitions of war, so that the same may be kept secret, pending a reference to her Majesty's Principal Secretary of State for the War Department.

By an Order in Council the provisions of sect. 103 of the British Patents Act, 1883, is applied to New Zealand, and any person who has applied for protection in England or in any foreign state a party to the International Convention is entitled to a patent in the colony in priority to other applicants, and such patents shall take effect from the same date as the application in England or such foreign state, provided that the application in the colony is made within twelve months from the date of the English or foreign application; and the benefit of the same provision is extended to all other colonies brought within the same provisions.

The registers under the Act are open to public inspection, and extracts may be obtained of all entries therein. Entries in the registers may be corrected by the Court.

Appeals from the Registrar are heard before the Court sitting at Wellington.

Every person making false writing in registers is guilty of a misdemeanor.

The Registrar has power to correct clerical errors, to call and examine witnesses on oath, papers and documents, to require the parties to make deposits to meet costs, to order payment of costs, and to adjourn hearings; in opposed cases he must have the applicant and the opposer and their witnesses. The Registrar is required to make an annual report.

No person is entitled to call himself a patent agent unless registered as a patent agent in pursuance of the Act, under a penalty of 20*l.*

The Governor in Council is empowered to make general rules, as to publishing copies of specifications, drawings, amendments, and other documents; and as to publishing and selling indexes and abridgments of specifications, providing for the inspection of Patent Office documents, the registration of patent agents, and generally for regulating the business of the Patent Office, and all things placed under the direction or control of the Registrar.

No provisions for compulsory working are imposed.

Penalties are imposed on persons falsely representing articles to be patented.

The fees prescribed on applications for and renewals of patents are :

On lodging application with provisional or with complete specification . . .	£0	10s.
On filing complete specification . .	0	10
On application to amend	1	0
On obtaining letters patent . . .	2	0
On or before the expiration of the fourth year	5	0
On or before the expiration of the seventh year	10	0
On presenting petition for extension of term	2	0

QUEENSLAND.

The law of patents for this colony is defined by Acts No. 13 of October 13, 1884, and No. 5 of September 4, 1886. The Act of 1884 established a Patent Office for the colony under the control of a Registrar of Patents.

The provisions of the Act are to a great extent similar to those of the British Act of 1883, and the applications and proceedings thereunder bear a strong resemblance to those of the mother country. When an inventor is out of the colony, application for the patent may be made by his assignee.

Applications may be made, accompanied by either provisional or complete specifications ; these applications are referred to examiners, who report thereon to the Registrar, and the Registrar may upon this report either refuse applications or require them to be amended. The complete specification must be left within nine months from the application. The examiner compares the complete with the provisional specification and reports to the Registrar thereon. Unless the complete specification is accepted within twelve months from the date of application the application becomes void. These dates can, however, be extended on application and payment of prescribed fees.

The grants may be opposed, the Registrar hearing and deciding on oppositions subject to appeals to the law officers.

Patents are dated as of the day of application. No proceedings for infringements can be taken until after the grant of the patent.

The patent is granted for the term of fourteen years, subject to the payment of the duties mentioned below ; the times for making the payments may be extended for three months.

Powers are given for amending specifications and for disclaiming any actions, and for the grant of compulsory licences, and for the revocation of patents similar to those in force at home.

A register of patents is kept, in which all deeds, licences, etc., must be entered.

The Governor in Council has power to grant extensions of the terms of patents for terms not exceeding seven or, in exceptional cases, fourteen years, the powers given being very similar to those of the Privy Council with respect to British patents.

Patents bind the Crown, but officers of the Crown may use the invention for the Crown service on terms to be agreed on with the approval of the Minister, or, in default of agreement, terms settled by the Minister after hearing the parties.

Provision is made for the protection of patentees by legal proceedings, and remedy is given to persons aggrieved by groundless threats of legal proceedings

The representatives of a deceased inventor may obtain patents.

The exhibition of an unpatented invention at industrial or international exhibitions will not prejudice patents subsequently obtained in due time.

The Minister has power to compel the patentee to furnish a model of his invention on payment to the patentee of its cost.

The patent will not prevent the use of an invention for the purposes of the navigation of foreign vessels in Queensland waters.

In case her Majesty makes an Order in Council to apply the provisions of the 103rd section of the British Act of 1883 to Queensland, the international arrangements for the protection of the inventions are adopted, and similar arrangements are made with respect to India or any other British possession where provisions exist for protecting inventions patented in Queensland.

The Governor in Council has power to make general rules for the regulation of the business of the Patent Office.

Persons falsely representing articles to be patented are liable to fines not exceeding 5*l.* in each case, and there is also a penalty (not exceeding 20*l.*) imposed on an unauthorised assumption of the royal arms.

No conditions for compulsory working are imposed.

The fees to be paid are as under:

On application for provisional protection .	£2	0s.
On filing complete specification . . .	3	0
or		
On filing complete specification with first application	5	0

Before the end of four years . . .	£5 0
Before the end of eight years . . .	10 0

Or in lieu of the 5*l.* and 10*l.* fees:

Before the expiration of each of the 4th, 5th, 6th, and 7th years	1 0
Before the expiration of each of the 8th and 9th years	1 10
Before the expiration of each of the 10th, 11th, 12th, and 13th years . . .	2 0

St. Helena.

Under Ordinance No. 3 of 1872, British letters patent may be extended to this island. The patent right is only granted to grantees of a British patent, his executors, administrators, or assigns. The duration of the patent is limited to that of the British patent. To obtain protection the applicant must deposit certified copies of the British patent and specification in the Registry of the Supreme Court of the island. These documents are open to public inspection. A fee of 1*l.* 1*s.* is payable on filing the specification.

It is provided that all cases of doubt or difficulty not provided for by the ordinance shall be guided and governed by the English law.

South Australia.

The patent law of this colony is now embodied in several Acts, namely, 'The Patent Act, 1877' (which was passed December 21, 1877), and the Acts No. 101 of 1878, No. 201 of 1881, and No. 421 of 1887.

Every applicant for letters patent must present a petition and declaration, together with specification and drawings in duplicate. These must be signed by the applicant, who may be either the inventor or his assignee, or legatee or executor of a deceased inventor; the declaration being made before any competent authority, and the specifications and drawings attested by two witnesses. The place and date of signature must also be stated in every case. The documents may be signed under power of attorney from the applicant. The exhibition of an invention within six months of the date of filing the petition is not a ground for the refusal of a patent.

Provisional protection can be obtained for twelve months Patents are granted for fourteen years, and expire with the de-

termination of any earlier foreign patent. Extensions may be obtained for any term not exceeding seven years. A fee of 20*l.* is payable upon such extension. The invention protected may be used in foreign vessels navigating the colonial waters, notwithstanding the patent. The Government may use the patented invention on payment of an agreed royalty. In case of difference the amount to be paid is settled by arbitration. When a patent is deemed defective in consequence of the specification being insufficient, or by the patentee having claimed more than he had a right to claim, the Commissioner may, on being satisfied that the error arose from inadvertence, accident, or mistake, and was not fraudulent, and upon the surrender of the patent and the filing an amended specification, grant a new patent for the unexpired term of the original grant. A fee of 10*l.* is payable upon such a grant. Disclaimers or memoranda of alteration may also be filed, a fee of 2*l* 10*s.* being payable on each application. Confirmation of an invalid patent may be obtained when it is proved, or has been found by the verdict of a jury, that the patentee was not the true and first inventor by reason of some other person having invented the same prior to the date of the patent. A fee of 50*l.* is payable for such confirmation. A caveat may be filed, and the person filing the same will be entitled to notice of any application being made for a patent for a similar invention, within twelve months from the date of filing. There is a fee of 1*l.* payable upon each caveat.

Patents may be revoked by the Governor if, after three years from the date of the patent, it is proved that neither the patentee nor his assignee or licensee has used the patented invention to a reasonable extent for the public benefit. No revocation under this clause has up to this time taken place.

Proceedings may also be taken to revoke a patent by *scire facias*.

All assignments and licences must be registered in the Register of Proprietors. The registration fee is 1*l.* in each case.

Penalties are imposed for unauthorised use of the name of a patentee, or for counterfeiting his stamps, mark, or devices.

Fees of 2*l.* 10*s.* each have to be paid at or before the expiration of the third and seventh years respectively.

Straits Settlements.

The ordinance for granting exclusive privileges to inventors is No. 12 of 1871, dated November 15, 1871.

Exclusive privileges may be obtained by actual inventors or first importers of inventions not publicly used or known in the colony. An invention shall be deemed new if it shall not, prior to the time of applying for leave to file a specification, have been publicly used by other than the inventor in the United Kingdom or the colony; but inventors having obtained British or British-colonial patents may obtain exclusive privileges during the remainder of the term for which such British or British-colonial patents may have been granted.

Exclusive privileges are obtained by inventors petitioning the Governor in Council for leave to file a specification, whereupon the Governor may make an order authorising the petitioner to file a specification. If the specification be filed within six months after the date of the Governor's order, the Governor may grant the petitioner an exclusive right to use the invention in the colony for the term of fourteen years, and for such further term, not exceeding the term of fourteen years, as the Governor may direct, upon petition presented to him at any period not more than one year, and not less than six months, before the expiration of the original term of the exclusive privilege. Errors, defects, or insufficiency in specifications may be corrected by disclaimers or by filing amended specifications.

Actions for infringement of the exclusive privileges may be maintained in the Supreme Court of the colony; and the rules regulating such proceedings appear to be greatly in favour of the holders of exclusive privileges. Appeals from the Supreme Court may be made to her Majesty in Privy Council.

The stamp on a petition for the grant of an exclusive privilege is 50 dollars. No further duties are payable.

TASMANIA.

The law of patents in this colony was established by an Act passed November 5, 1858, amended by an Act passed in 1883. Patents are always granted for fourteen years. They expire with the determination of any earlier foreign patent for the same invention. They will not prevent the use of the invention in foreign ships resorting to the colony. There is no provision for compulsory working. Although the law provides for the grant of provisional protection, it is only granted on very full specifications.

The proceedings to obtain patents are very similar to those at home, and the provisions with respect to actions, disclaimers,

etc., are also much the same. Patents may be repealed by action of *scire facias*.

The Government fees are about 7*l*. 10*s*. on application, and a stamp duty of 15*l*. is to be paid at the expiration of the third year, and 20*l*. at the expiration of the seventh year of the grant. By law No. 2 of October 20, 1884, after reciting section 104 of the Patents Act (United Kingdom), 1883, it is enacted that any person who has applied for protection for any invention in the United Kingdom shall be entitled to a patent for his invention in priority to other applicants, and such patents shall have the same date as the protection obtained in the United Kingdom, provided the colonial application is made within seven months from the application for protection in the United Kingdom; publication in Tasmania within that period shall not invalidate the patent.

TRINIDAD.

The ordinance for granting exclusive privileges to inventors is No. 25, dated September 2, 1867.

On application to the Registrar-General of the island, and on delivery to him of a declaration, accompanied by a specification, he will issue a certificate, which must be advertised in the Official Gazette. The specification may be delivered open or in a sealed envelope. In the latter case the Registrar-General will, at the end of six calendar months from the date of the certificate, or at an earlier day at the request of the patentee, break the seal of the envelope and register the specification.

The certificate vests in the applicant the exclusive right to the invention within the island for fourteen years; but if at any time during that term it shall be made to appear that the invention is not new as to the public use and exercise thereof in the island, or that the invention is prejudicial or inconvenient to the public, then the applicant's exclusive privileges will become void.

The fees payable to the Registrar-General on leaving the declaration and specification, and for publication of same in Gazette, amount to 10*l*. 10*s*.

Disclaimers may be entered, a fee of 2*l*. being payable on each entry.

The patentee has the like remedies against infringers as the grantee of any letters patent would be entitled to in the like case in England.

VICTORIA.

The Act 53 Vict. cap. 84, passed November 25, 1889, coming into operation March 1, 1890, consolidates the law of patents in this colony and repeals all former Acts. This Act is, in most respects, similar to the British Patents Act, 1883, but there are differences which will be mentioned.

The Governor in Council is empowered to appoint and remove a Commissioner of Patents, and also as many examiners as may be necessary. The Commissioner is to have a seal with which all patents are to be sealed.

Any person, whether a British subject or not, may apply for a patent. The applicant may be the actual inventor; or his assigns; or the actual inventor jointly with the assigns of a part interest in the invention; or the legal representatives of a deceased inventor, or his assigns; or (where the inventor is not resident in the colony) any person to whom the invention has been communicated by the actual inventor, his legal representatives, or assigns.

The application must be made in the form given, and must be accompanied by either a provisional or complete specification. The application is referred by the Commissioner to an examiner, who must ascertain and report whether the nature of the invention is fairly described, and whether the application, specification, and drawings are prepared in the prescribed manner, and whether the title sufficiently indicates the subject-matter of the invention, and whether, to the best of the knowledge of the examiner, such invention is not novel, or is already in the possession of the public, with the consent of the inventor, and upon such matters as the Commissioner may require. On the report of the examiner, the Commissioner may refuse the application, or require its amendment. The applicant has power to appeal from any adverse decision to the Law Officer, who is required to hear the applicant and the Commissioner, and to decide whether the application shall be accepted or not.

If a complete specification is not left with the application, it may be left any time within nine months from the application; if not so left, the application is deemed to have been abandoned. The Commissioner has power to extend the time for leaving the complete specification for one month.

The complete and provisional specifications are referred by the Commissioner to an examiner, who is to ascertain whether

the complete specification is prepared in the prescribed manner, and whether the complete specification describes substantially the same invention as that described by the provisional specification.

The Commissioner may refuse the application upon this report, but such refusal is subject to appeal to the Law Officer.

The examiner's reports are not to be published or open to public inspection.

The Commissioner must advertise the acceptance of the complete specification, and the application is then open to public inspection, and any time within two months from the date of the advertisement any person may give notice of opposition to the application, on the ground of the applicant having fraudulently, or without his authority, obtained the invention from him, or from a person of whom he is the legal representative or assignee; or on the ground that the invention has not been communicated to the applicant by the actual inventor, his legal representative, or assigns (if not resident in Victoria); or on the ground that the invention has been patented in Victoria on an application of prior date; or on the ground of want of novelty, or of the invention having been already published or publicly used, or that the complete specification describes 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 and complete specifications, but on no other ground.

The opposition is heard and determined by the Commissioner, there being an appeal from his decision to the Law Officer. If the Commissioner is satisfied with the novelty of the invention, and there is no opposition, or, in case of opposition, if the determination is in favour of the applicant, the Commissioner issues a warrant for the sealing of the patent, and the patent is sealed as soon thereafter as may be. The patent is sealed as of the day of application, but no legal proceedings can be taken in respect of any infringement committed before the publication of the complete specification.

Inventions are protected from the consequences of use and publication, between the date of application and the date of sealing the patent. No proceedings can be taken for infringement until the patent has been granted.

Every patent covers the entire colony, and is for fourteen years, subject to payments of 2*l*. 10*s*. before the expiration of the third and of the seventh years of the term.

An applicant or patentee is empowered to amend the specifi-

cation, and the amendment may be opposed, these proceedings being similar to those in force in England.

A patentee can also apply to amend during the progress of legal proceedings for infringement or revocation.

Where an applicant, patentee, petitioner, or objector is dissatisfied with the decision of the Law Officer, he can appeal to the Supreme Court.

A Register of Patents is to be kept, containing in chronological order a statement of all patents granted, with the names and addresses of the grantees, notifications of assignments and licences, memoranda of the deposit, and filing of specifications, and disclaimers, of amendments of patents, and specifications, and of the expiry, revocation, or other determination of patents.

Prolongations may be obtained of patents for inventions of merit which have not been remunerative, for a term not exceeding fourteen years.

Confirmation of invalid patents may also be obtained, in cases where it has been found by a court of law that a portion of the invention was, unknown to the patentee, old at the date of the application.

Proceedings may be taken in the Supreme Court for the revocation of patents, upon grounds similar to those of the British Patents Act of 1883, with the additional ground, in the case of patents for communications, that the invention was not communicated by the actual inventor or his assignee.

Patent rights are good against the Crown, but may be used for the public service on terms agreed upon or settled by arbitration. The proceedings and pleadings in actions for infringements, or revocation, are very similar to the British proceedings. Remedy is given to any person aggrieved by groundless threats of legal proceedings.

The Act contains clauses for enabling the Governor in Council to make arrangements for the mutual protection of inventions with any of the other Australian Colonies, New Zealand, or Fiji, and also for the purpose of applying the provisions of sect. 103 of the British Patents Act of 1883 to the colony.

Patents for foreign inventions may be granted at any time within one year of the date of the foreign patent, notwithstanding prior use in Victoria during that period, providing such use has not been with the consent of the inventor.

A patent may be obtained by the representatives of a deceased inventor, if the application be made within twelve months of the death of the inventor.

The exhibition of inventions at industrial or international exhibitions will not prejudice patent rights, if the exhibitor gives the Commissioner one month's notice of his intention to exhibit, and application for the patent is made within twelve months from the opening of the exhibition.

The patent will not prevent the use of the invention in foreign ships in the colonial waters, but this provision does not apply to the protection of subjects of foreign states not conferring reciprocal advantages.

Penalties are imposed on persons marking goods with the name of a patentee, without leave in writing of the patentee; or who mark goods 'Patent' with the intention of imitating the stamps or marks of the patentee; or who put to sale as patented in Victoria any article not patented there, for the purpose of deceiving the public.

Western Australia.

The law of patents in this colony is comprised in an Act to amend and consolidate the law relating to patents for inventions which passed the Colonial Legislature, November 26, 1888.

The Patent Office is attached to the department of the Registrar-General. Any person may apply for a patent, and a person not the inventor may join in the application and be a co-patentee. A patent will also be granted to the legal representatives of a deceased inventor. The application must be accompanied by either a provisional or complete specification. The application is referred to an examiner, and upon his report the Registrar will accept or refuse the application. The complete specification must be left within nine months from the date of application. Persons interested may oppose the grant on the ground of the opposer being interested in an application of prior date, or that the examiner has reported that the specification comprises the same invention as is described in a previous application. The proceedings before the Registrar are subject to appeal to the Attorney-General. Specifications are not published unless the applications are accepted. Provisional protection is granted for the period between the date of application and the sealing the patent.

Patents are granted for fourteen years, but cease in case the prescribed payments are not duly made.

The Registrar has power to grant leave to amend specifications, and his decision in applications for amendments is subject to appeal to the Attorney-General.

The Governor in Council can grant licences in cases where he is satisfied that by the patentee's default to grant licences the patent is not worked in the colony, or that the reasonable requirements of the public are not supplied, or where any person is prevented from working or using to the best advantage any invention of which he is possessed.

A Register of Patents is kept, and all assignments, licences, etc., must be registered therein.

The Governor in Council may prolong the term of the patent for a further term not exceeding seven or, in exceptional cases, fourteen years.

Proceedings may be taken for revocation of patents, the proceeding by *scire facias* being abolished.

A patent is valid against the Crown, but the Crown officers may use the invention by agreement, or, failing agreement, on terms to be settled by the Court.

The proceedings relating to infringement are similar to those in force at home. Remedy is granted against patentees in case of groundless threats of legal proceedings.

Provision is made for the protection of unpatented inventions at industrial or international exhibitions.

No person can receive a patent for an invention which has been previously patented in Great Britain or any other country, but the Governor is empowered to grant letters of registration to the holder or assignee of any such patent upon payment of 15*l.*, and such letters of registration shall be deemed to be letters patent issued under the Act, and shall have the same force as letters patent. The law does not compel any working of the invention.

The fees payable before the expiration of four years and of seven years are 4*l.* in each case, and a fee of 20*l.* is payable on every extension beyond fourteen years.

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