LAW AND PRACTICE

RELATING TO

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THE LAW AND PRACTICE RELATING TO THE FORMATION OF COMPANIES (LIMITED BY SHARES).

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THE LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS

WITH AN APPENDIX OF STATUTES, RULES,
AND OFFICIAL FORMS.

BY

VALE NICOLAS,

OF THE MIDDLE TEMPLE, BARRISTER-AT-LAW

AUTHOR OF "THE LAW AND PRACTICE RELATING TO THE FORMATION OF COMPANIES (LIMITED BY SHARES)."

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TO

THE RIGHT HONOURABLE

SIR ROLAND VAUGHAN WILLIAMS,

A LORD JUSTICE OF HIS MAJESTY'S
COURT OF APPEAL,

This Work

IS, BY PERMISSION,

MOST RESPECTFULLY DEDICATED.

PREFACE.

THE object of this book is to present in as concise a form as possible the whole of the law relating to letters patent for inventions, and such matters of practice as relate particularly to patent grants.

The author believes that the text refers to all the reported cases which are now of any importance. It contains no reference to matters and cases which are of historical interest only.

As the decisions concerning grants of compulsory licences under section 22 of the Patents Act, 1883—now repealed—will, it is conceived, be of little or no value, as authorities, under the Act of 1902, they are not here referred to.

Although the author has spared no pains to prevent defects and errors, he does not venture to think that the book is altogether free from these. Whatever its shortcomings, he hopes that the treatise may be found useful by members of the legal profession and others interested in the subject-matter.

V. N.

4, NEW SQUARE, LINCOLN'S INN,
September, 1904.

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LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

Subject-Matter of Letters Patent.

THE STATUTE OF MONOPOLIES—AS TO WHAT IS A "MANUFACTURE"—IMPROVEMENTS—COMBINATIONS—PROCESSES—PRINCIPLES—PRODUCTS—NOVELTY—UTILITY—INVENTION.

The subject-matter of letters patent for inventions entirely depends upon the Statute of Monopolies (21 Jac. I. c. 3).

S. 6 of the Act—the all-important section in connection with patent grants—preserves the prerogative of the Crown to grant letters patent for inventions in the case only of "*any manner of new manufactures* within this realm to the true and first inventor and inventors of such manufactures, *which others at the time of making such letters patent and 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 subject-matter of letters patent must therefore be a "manufacture"; and that manufacture must be new (see p. 7, *infra*), useful (see p. 16, *infra*), and have involved ingenuity of invention (see p. 20, *infra*). Further, it must not be contrary to law, nor mischievous to the State by raising the prices of commodities at home, or hurt of trade, or generally inconvenient.

As to What is a "Manufacture."

It is impossible to lay down an abstract definition of all that the term "manufacture" may import (see *per* Lopes, L.J., in *Blakey* v. *Latham* (1889) 6 R. P. C. at p. 189). By the large interpretation given to the word, "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" (*per* Lord Westbury, L.C., in *Ralston* v. *Smith* (1865) 11 H. L. C. at p. 246). The term also includes applied principles (see p. 6, *infra*), and applications of old things to new uses (see p. 24, *infra*). But the thing produced must, it seems, be a *vendible* article (see *per* Heath, J., in *Boulton* v. *Bull* (1795) 2 H. Bl. at p. 482). And a valid patent cannot be granted for a thing to be used for an illegal purpose (see p. 1, *supra*); but no objection can be taken to the validity of a patent on the ground that it was applied for merely to evade the provisions of a statute (see *Re Vaisey's Patent* (1894) 11 R. P. C. at p. 593).

Improvements. — The term "manufacture" includes an improvement on a known machine; indeed, as was pointed out by Lord Mansfield in *Morris* v. *Branson* (1776) 1 W. P. C. 51, if there could be no patent for an improvement, almost every patent could be revoked.

The improvement need not be great; "it is sufficient if it is an improvement *at all*" (*per* Alderson, B., in *Morgan* v. *Seaward* (1836) 1 W. P. C. at p. 172; *Edison* v. *Woodhouse* (1887) 4 R. P. C. at pp. 92, 93; *Moser* v. *Marsden* (1893) 10 R. P. C. at p. 358). But the improvement must have involved the exercise of ingenuity or invention (*Carter* v. *Leyson* (1902) 19 R. P. C. at pp. 477, 478; and see p. 20, *infra*).

An improvement on a machine or process may be by way of an addition thereto (*Morris* v. *Branson* (1776) 1 W. P. C. 51) or of an omission therefrom (*Arnold* v. *Bradbury* (1871) 6 Ch. at p. 714; *Russell* v. *Cowley* (1835) 1 W. P. C. at p. 469). Mere change of size of a part of a combination may constitute an improvement sufficient to support a patent (*Edison* v. *Woodhouse* (1887) 4 R. P. C. at p. 92; *Moss* v. *Malings* (1886) 3 R. P. C. at pp. 378, 379; *cf. Bearn* v. *Rylands* (1900) 17 R. P. C. at p. 712). And there may be a patent for an improved mechanical equivalent of an old thing (see *per* Lord Halsbury, L.C., in *Vickers* v. *Siddell* (1890) 7 R. P. C. at p. 303; *Thomson* v. *American Braided Co.* (1889) 6 R. P. C. 518).

An improved thing produced by a new and *ingenious* application of a known contrivance to an old thing is a "manner of new manufacture" within the meaning of the statute (*per* Lindley, L.J., in *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 524; and see *per* Romer, J., in *Adamant Stone Co.* v. *Corpn. of Liverpool* (1897) 14 R. P. C. at p. 21). See, further, p. 24, *infra*.

The discoverer of an improvement must, in his claim, strictly confine himself to the improvement; if he claims the machine or process upon which he has improved, he will invalidate his grant (*Minter* v. *Mower* (1835) 1 W. P. C. at p. 142; and see p. 74, *infra*). And if the patentee's invention consists of an improvement upon a machine for which a patent exists, the use of the improvement with the former invention, during the existence of the former patent, without licence, will be an infringement of the former patent (see p. 160, *infra*).

As to the amount of invention necessary in order to support a patent for an improvement, see pp. 20—24, *infra*.

Combinations.—A new combination of old materials is a "manufacture" within the Statute of Monopolies, if "the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public, than that produced before by the old method" (*per* Tindal, C.J., in *Crane* v. *Price* (1842) 1 W. P. C. at p. 409; and see *per* Bacon, V.-C., in *Murray* v. *Clayton* (1872) 7 Ch. at p. 577, *n.*). But a patentee cannot make a combination within the meaning of the patent law by *calling* it a combination. A combination, in point of law, must be a combination which is both new and useful (see *per* Grove, J., in *Bamlett* v. *Picksley* (1875) Griff. P. C. at p. 44).

A patent may be good for combination, although when it is taken to pieces there is not one single part of the process or of the machinery called into use to create that combination which is new in itself (*per* Pollock, B., in *Davis* v. *Feldman* (1884) 1 R. P. C. at p. 14, affirmed, on appeal, at p. 193). A claim for a combination is not a claim that each part thereof is new. "On the contrary, each part may be old, and yet a new and useful combination of such old parts may be valid, as has been often decided" (*per* Lord Campbell, C.J., in *Lister* v. *Leather* (1858) 8 E. & B. at p. 1017; and see *Vickers* v. *Siddell* (1890) 7 R. P. C. at p. 304; *Lucas* v. *Miller* (1900) 17 R. P. C., at p. 171).

Where a combination consists of parts, some of which are old and some are new, the inventor may claim not only the combination as a whole, but also each new part (see pp. 75, 76, *infra*). Where all the parts are old, the inventor must clearly show that it is in respect of the new combination, and of that only, he seeks protection (see p. 76, *infra*).

A combination, to be the subject of a valid patent, must have

involved ingenuity or invention in its production. If it was obvious, the patent cannot be supported. But the amount of invention involved need not be great. "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" (*per* Jessel, M.R., in *Hinks* v. *Safety Co.* (1876) 4 C. D. at pp. 615, 616). See, further, p. 21, *infra.*

Where the use of soap and water in the process of felting was known, and the use of rollers was also known, a patent for the use of soap and water in conjunction with rollers was held to be good subject-matter for a patent (*Allen* v. *Rawson* (1845) 1 C. B. 551). And where the shearing of cloth from list to list by shears was known, and the shearing it from end to end by means of rotary cutters was also known, a patent for a machine to shear from list to list by means of rotary cutters was held to be patentable. (*Lewis* v. *Davis* (1829) 1 W. P. C. 488). In *Hinks* v. *Safety Co.* ((1876) 4 C. D. at p. 615), Jessel, M.R., considered that the substitution in a lamp of a round wick for a flat wick was sufficient to support a patent. For further examples of patents for combinations upheld where only slight alterations have been made, see *Fawcett* v. *Homan* (1896) 13 R. P. C. 398; *Goddard* v. *Lyon* (1894) 11 R. P. C. 354; *Birch* v. *Harrap* (1896) 13 R. P. C. 615; *Bunge* v. *Higginbottom* (1902) 19 R. P. C. 187; *Edison* v. *Woodhouse* (1887) 4 R. P. C. 79; *Moss* v. *Malings* (1886) 3 R. P. C. 373; *Vickers* v. *Siddell* (1890) 7 R. P. C. 292; *Thomson* v. *American Braided Co.* (1889) 6 R. P. C. 518; and see pp. 20—24, *infra.*

Processes.—It is now well settled that the term "manufacture" includes a process (*Gibson* v. *Brand* (1842) 1 W. P. C. at pp. 633, 638). The term may mean the machine when completed or the mode of constructing the machine (*per* Parke, B., in *Morgan* v. *Seward* (1837) 1 W. P. C. at p. 193). It includes both process and result (*per* Coleridge, J., in *Bush* v. *Fox* (1854) Macr. P. C. at p. 176). And see *per* Pollock, C.B., in *Stevens* v. *Keating* (1847) 2 W. P. C. at p. 182.

You may have a good claim for a process, even though the process is made up of a combination of perfectly well-known steps, provided the result is to arrive at a new article, or a better article, or a cheaper article (see *per* Vaughan Williams, L.J., in *Kopp* v. *Rosenwald* (1903) 20 R. P. C. at p. 159; and see *Crane* v.

Price (1842) 1 W. P. C. at p. 409). The omission of a step in some known process may constitute patentable subject-matter (*Russell* v. *Cowley* (1835) 1 W. P. C. at p. 469.)

In *Booth* v. *Kennard* ((1856) 26 L. J. Ex. 23), the patentee claimed for making gas "direct from seeds and matters therein named . . . instead of making it from the oils, resins, or gums, previously extracted from such substances"; and the Court held, assuming the invention to be new, it was good subject-matter for a patent. The patent was subsequently avoided for want of novelty (p. 305). In *Hills* v. *London Gas Light Co.* ((1860) 29 L. J. Ex. 409), the invention consisted in the purification of coal gas by means of hydrated or precipitated oxides of iron, and also a process whereby the materials so used were to be re-oxidized, and thus renewed for use, and the patent was supported. For further examples of patents for processes which have been supported, see *Benno Jaffé* v. *Richardson* (1894) 11 R. P. C. 93; *Hall* v. *Jarvis* (1822) 1 W. P. C. 100; *Russell* v. *Cowley* (1835) 1 W. P. C. 463; *Badische* v. *Dawson* (1889) 6 R. P. C. 387; *British Vacuum Co.* v. *Suction Cleaners* (1904) 21 R. P. C. 303.

The specification of a patent for a process must point out the mode by which the process is to be performed, so as to accomplish the object in view; if it does not, it will be a statement of a principle only, and the patent will be bad (*Borill* v. *Keyworth* (1857) 7 E. & B. at p. 735; *Hills* v. *London Gas Co.* (1860) 29 L. J. Ex. at p. 424; *Neilson* v. *Harford* (1841) 1 W. P. C. at p. 355; see, further, p. 6, *infra*). And it must indicate the essence of the invention (see *Kopp* v. *Rosenwald* (1903) 20 R. P. C. 154), and be more than a mere "prescription" (see *Kopp* v. *Rosenwald*, *supra*, at p. 160).

The process to support a patent must, of course, be distinct from and not merely a colourable imitation of another. But "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" (*per* Tindal, C.J., in *Walton* v. *Potter* (1841) 1 W. P. C. at pp. 590, 591; and see *per* Lord Westbury in *Curtis* v. *Platt* (1864) 3 C. D. 139, *n.*; *Thomson* v. *Moore* (1890) 7 R. P. C. at p. 332.)

Principles.—No mere philosophical or abstract principle can answer to the word "manufacture." Something of a corporeal and substantial nature—something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill—is requisite to satisfy this word (*per* Abbott, C.J., in *R.* v. *Wheeler* (1819) 2 B. & Ald. at p. 350).

A principle, *per se*, cannot, therefore, be the subject of a valid patent (see *per* Alderson, B., in *Jupe* v. *Pratt* (1837) 1 W. P. C. at p. 146; *per* Lord Halsbury, L.C., in *Pneumatic Tyre Co.* v. *Tubeless Tyre* (1899) 16 R. P. C. at p. 79). But you may take out a patent for a principle *coupled with a mode of carrying the principle into effect* (*per* Alderson, B., in *Jupe* v. *Pratt*, *supra*; and see *per* Clerk Hope, L.J., in *Household* v. *Neilson* (1843) 1 W. P. C. at p. 683; *per* Cotton, L.J., in *Automatic Weighing Co.* v. *Knight* (1889) 6 R. P. C. at p. 304; *per* Lord Davey in *Chamberlain* v. *Mayor of Bradford* (1903) 20 R. P. C. at p. 684; *Ashworth* v. *English Card Co.* (1903) 20 R. P. C. at p. 797; *Edison-Bell* v. *Smith* (1894) 11 R. P. C. at pp. 397, 398.)

"I take the distinction," said Alderson, B., in *Neilson* v. *Harford* (1841) 1 W. P. C. at p. 342, "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." The same learned Judge in *Jupe* v. *Pratt* (1 W. P. C. at p. 146), said that when you have invented a mode of carrying a principle into effect, you are entitled to protect yourself from *all other* modes of carrying the same principle into effect. But, as was pointed out by Cotton, L.J., in *Automatic Weighing Co.* v. *Knight* ((1889) 6 R. P. C. at p. 304), this expression was used by Baron Alderson during the discussion, and probably 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" (*per* Cotton, L.J., *ibid.*). But you cannot prevent others carrying the principle into effect by substantially different means; see p. 163, *infra*.

A claim to *every* mode of carrying a principle into effect amounts to a claim to a principle; for "there is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself" (*per* Alderson, B., in *Neilson*

v. *Harford* (1841) 1 W. P. C. at p. 355; *Automatic Weighing Co.* v. *Knight* (1889) 6 R. P. C. at p. 308; *cf. Edison-Bell* v. *Smith* (1894) 11 R. P. C. 389).

Although a principle, as distinct from the machine by which it is proposed to be applied, cannot be the subject of a patent, the consideration of the principle sought to be so applied may be material in determining the essence of the invention (*Thomson* v. *Moore* (1889) 6 R. P. C. at p. 450; (1890) 7 R. P. C. 325).

Products.—A product, *per se*, cannot, it is conceived, form the subject of a valid grant—that is to say, a product cannot be patented apart from the mode of producing it (see *Kopp* v. *Rosenwald* (1902) 19 R. P. C. 205; (1903) 20 R. P. C. 154) any more than a principle can be patented apart from a mode of carrying the principle into effect.

Novelty.

The Statute of Monopolies exempts only letters patent for *new* manufactures granted to the true and *first* inventor (see p. 1, *supra*). Hence, the subject-matter of a patent must be new.

The Consideration for the Grant is the Novelty of all.—And as the consideration for the grant is the novelty of *all* (see *per* Parke, B. in *Morgan* v. *Seaward* (1837) 1 W. P. C. at p. 196), if anything claimed turns out to be old the *whole* grant will be void (*Morgan* v. *Seaward*, *supra*; *Roberts* v. *Heywood* (1879) 27 W. R. 454; *Marchland* v. *Nicholson* (1893) 10 R. P. C. 417; *Cassell Co.* v. *Cyanide Syndicate* (1895) 12 R. P. C. 232; *Wilson* v. *Wilson* (1903) 20 R. P. C. 1). See, further, p. 74, *infra*.

Effect of Prior Publication or User Abroad.—The novelty of an invention will be defeated by proving prior publication or prior user. But as the Statute of Monopolies only refers to manufactures new "within this realm" (see p. 1, *supra*), prior publication or user in a foreign country will not affect the validity of a patent (*Rolls* v. *Isaacs* (1881) 19 C. D. at p. 275).

Such of the colonies as are themselves empowered to grant patents for inventions are not considered within the realm; and an invention already published there may form the subject of a valid British patent (*Rolls* v. *Isaacs*, *supra*). Whether the use of an invention in any of the colonies *not* so empowered would invalidate subsequent letters patent for the same invention taken out at home, *quære* (see *Brown* v. *Annandale* (1842) 1 W. P. C. 433).

Prior Publication.

The publication of a machine or process, within the realm, in a book (*Stead* v. *Williams* (1844) 2 W. P. C. at p. 142; *Household* v. *Neilson* (1843) 1 W. P. C. 718, *n.*), or a specification (*Jones* v. *Berger* (1843) 1 W. P. C. at p. 550; *Harris* v. *Rothwell* (1887) 4 R. P. C. 225), or any other work or document (see *Rucker* v. *London Electric Corpn.* (1900) 17 R. P. C. at p. 283), will invalidate a subsequent grant of letters patent for that machine or process, although the machine or process was never actually put in use prior to the date of the grant (*Stead* v. *Williams* (1844) 2 W. P. C. 151; *Patterson* v. *Gas Light Co.* (1877) 3 A. C. at p. 244).

Publication in Foreign Language.—The fact that the prior description was in German (*Harris* v. *Rothwell* (1887) 4 R. P. C. 225; *Rucker* v. *London Electric Corpn.* (1900) 17 R. P. C. at p. 295), or French (*Lang* v. *Gisborne* (1862) 31 Beav. 133; *Pickard* v. *Prescott* (1892) 9 R. P. C. 195), or any other language commonly known in this country (*Harris* v. *Rothwell*, *supra*, at p. 232), makes no difference.

Publication by Provisional Specifications.—As provisional specifications which are abandoned are not published (see p. 36, *infra*), the abandonment of a provisional specification does not amount to publication (see *Oxley* v. *Holden* (1860) 8 C. B. (N. S.) at p. 708; *Lister* v. *Norton* (1886) 3 R. P. C. at p. 206). But when published, a provisional specification may be a sufficient anticipation of a subsequent patent (*Laurence* v. *Perry & Co.* (1885) 2 R. P. C. at p. 187).

Effect of s. 1 of the Patents Act, 1902.—So soon as the Board of Trade direct that s. 1 of the Patents Act, 1902, is to come into operation, an invention covered by any patent granted on an application to which s. 1 of the Act applies, will "not be deemed to have been anticipated by reason only of its publication in a specification deposited pursuant to an application made in the United Kingdom not less than *fifty years* before the date of the application for a patent therefor, or of its publication in a provisional specification of any date not followed by a complete specification" (s. 2).

Publication a Question of Fact.—The specification of a prior patent must, of necessity, be considered as a publication (*Hill* v. *Evans* (1862) 4 De G. F. & J. at p. 300; *Defries* v. *Sherwood* (1897) 14 R. P. C. at p. 319). In other cases the question of publication is one of fact. Each case must depend upon its own

circumstances; and the effect, extent, and operation of the document by which the invention is alleged to be communicated to the public, so as to anticipate the invention of the person taking out letters patent for the invention, vary infinitely as the facts must vary (see *per* Lord Halsbury, L.C., in *Pickard* v. *Prescott* (1892) 9 R. P. C. at pp. 200, 201). The existence of a single copy of a work, though printed, brought from a depository where it has 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 (*per* Tindal, C.J., in *Stead* v. *Williams* (1844) 2 W. P. C. at p. 143).

Publication need not be a Matter of Common Knowledge.—The publication need not be a matter of common knowledge; it is sufficient to invalidate a subsequent patent if it is a matter of public knowledge (see *per* Lindley, L.J., in *Savage* v. *Harris* (1896) 13 R. P. C. at p. 367). If the invention is described in a document which has been previously accessible to the public, the patent will be bad, although it is not shown that the document has ever been actually consulted (*United Horse Nail Co.* v. *Stewart* (1885) 2 R. P. C. at p. 133; *Harris* v. *Rothwell* (1887) 4 R. P. C. at p. 230).

Documents in Public Libraries.—If a document containing a description of the subject of a patent has been deposited, prior to the date of the patent, in the Patent Office Library (*United Horse Nail Co.* v. *Stewart* (1885) 2 R. P. C. at p. 133; *Harris* v. *Rothwell* (1887) 4 R. P. C. 225; *United Telephone Co.* v. *Harrison* (1882) 21 C. D. 720; *Rucker* v. *Electric Corpn.* (1900) 17 R. P. C. at p. 295), or in any other place to which the public are admitted, and to which persons in search of information on the subject to which the patent relates would naturally go for information (*Harris* v. *Rothwell* (1887) 4 R. P. C. 225), the patent will be void. In the case of *Rucker* v. *Electric Corpn.*, *supra*, the fact that a paper containing a description of a patented arrangement was laid on the table of the public reading room in the Patent Office two days prior to the date of the patent, was held to invalidate the grant.

But in some cases, although a document may have been deposited in the Patent Office Library, or some other public place, the proper inference, in the absence of proof to the contrary, is, that nobody ever did see it there, *e.g.*, where it has been placed on a shelf in a private room in the Patent Office and not catalogued (*Plimpton* v. *Malcolmson* (1876) 3 C. D. at pp.

566, 567), or in an inner room at the British Museum (*Otto* v. *Steel* (1886) 3 R. P. C. at pp. 112, 113, 114), or even in a room at the Patent Office open to the public, if it has not been entered in the catalogue (*Plimpton* v. *Spiller* (1877) 6 C. D. 412; but it was not strictly proved, in this case, that the volume relied upon was ever accessible to the public).

Sales Need not be Shown.—Once a book has been printed and offered for sale, it is not necessary to prove that a single copy has ever been sold. "A publication takes place," said Lord Romilly, in *Lang* v. *Gisborne* (1862) 31 Beav. at p. 135), "when the inventor of any new discovery, either by himself or by his agents, makes a written description of it, and prints it in a book and sends it to a bookseller's to be published in this country. I am of the opinion that it is not at all necessary to establish the fact that one volume of that book has been sold, for I think that as soon as an inventor informs the public of what his invention consists, and prints it in a book which he sends to a publisher to sell, from the moment that the book is exposed for sale in the bookseller's shop, there becomes, in point of law, a complete publication of the invention." But this must not be taken to mean that where only one volume is sent to a bookseller and exposed for sale by him, that a publication has taken place. "Suppose the bookseller had put one volume in his shop window as exposed for sale for one day, and the next day, by direction of the author, destroyed all the volumes, that would not do, and I do not think that Lord Romilly intended that it would" (*per* Jessel, M.R., in *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 562). Lord Romilly's observations are to be read in this sense: "that, if a man publishes a book—that is, a large number of copies—and sends them to booksellers for sale, and they are, for a reasonable time, exposed in the window, so that you may infer the people have known and seen them, and may reasonably so infer, though you do not prove one has been sold—if the other side cannot prove that one has *not* been sold, you may reasonably infer that some of those books have been sold" (*per* Jessel, M.R., in *Plimpton* v. *Malcolmson*, *supra*).

Official Documents.—Where the description of an invention is contained in a document the contents of which are disclosed to public officers, who cannot keep it secret without a breach of duty, the document is public property from the time the public officers know of it (*Patterson* v. *Gas Light Co.* (1877) 3 A. C. 239).

The Prior Description.—A prior publication will not invalidate a patent unless it has imparted such information as will enable anyone working upon it to reckon with confidence on the result (see *per* Lord Cholmsford in *Betts* v. *Neilson* (1868) 3 Ch. at p. 435, and *per* Lord Calonsay (1871) L. R. 5 H. L. at p. 24). Putting a man on the road to a place is not the same thing as taking him there (see *per* Lord Westbury in *Hill* v. *Evans* (1862) 4 De G. F. & J. at pp. 301, 302). "The description in the book must be equivalent to a specification" (*per* Jessel, M.R., in *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 568; but see *infra*).

Hence, a mere suggestion is not sufficient. All patents, almost, are suggested by something. It very seldom comes into the head of any man to do a thing without something or other suggesting the idea to him to do it (see *per* Lord Coleridge, C.J., in *American Braided Co.* v. *Thomson* (1888) 5 R. P. C. at p. 120.) The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information 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 (*per* Lord Westbury in *Hill* v. *Evans* (1862) 4 De G. F. & J. at p. 300; and see *Defries* v. *Sherwood* (1897) 14 R. P. C. at pp. 318, 319; *Thomson* v. *Batty* (1889) 6 R. P. C. at pp. 98, 99; *Ehrlich* v. *Ihlee* (1888) 5 R. P. C. at p. 450; *Shrewsbury* v. *Sterckz* (1896) 13 R. P. C. at p. 53; *Cassell Gold Co.* v. *Cyanide Syndicate* (1895) 12 R. P. C. at p. 256).

But the description contained in the prior document need not be sufficient to enable any workman of ordinary skill to carry out the invention subsequently patented. There is not the same necessity for accurate description of how an invention shall be carried into effect, for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee (*per* Grove, J., in *Philpott* v. *Hanbury* (1885) 2 R. P. C. at p. 43). The sufficiency or insufficiency of a specification for the guidance of a workman of ordinary skill does not afford a crucial test of prior publication. A patentee's specification may be insufficient in this respect, and yet be sufficient to convey to *men of science and employers of labour* information which will enable them, without any exercise of inventive ingenuity, to understand his invention, and to give a workman the specific directions which he failed to communicate. In this case his

invention is published as completely as if his description had been intelligible to a workman of ordinary skill (see *per* Lord Watson in *King* v. *Anglo-American Brush Corpn.* (1892) 9 R. P. C. at p. 320; and see *Philpott* v. *Hanbury*, *supra*; *Savage* v. *Harris* (1896) 13 R. P. C. at pp. 368, 369).

A prior description of an invention which can be made out only from a perusal of several documents, will not amount to a publication of the invention at law (see *per* James, L.J., in *Von Heyden* v. *Neustadt* (1881) 50 L. J. Ch. at p. 128; *Moseley* v. *Victoria Rubber Co.* (1887) 4 R. P. C. at p. 252). "It may be that each one of the features of the patentee's construction and arrangement can be picked out of prior specifications, but this is not enough" (*per* Vaughan Williams, L.J., in *Patent Exploitation* v. *Siemens* (1903) 20 R. P. C. at p. 237).

Identity in Terms.—Although two specifications may be identical in terms it does not follow that one is necessarily an anticipation of the other (see *per* Lord Westbury in *Betts* v. *Menzies* (1862) 10 H. L. C. at pp. 152, 153.) Identity of purpose and not of name, is the criterion in judging of the similarity or dissimilarity of inventions. "This thing," said Lord Cottenham, L.C., in *Re Cutler's Patent* (1839) 1 W. P. C. at p. 427, "may be called a pin, and may be correctly called a pin, and the other no doubt may be called a pin, but it is not because they go by the same name they are to be considered as identical—they are not used for the same purpose in any one respect."

The Court ought not to be astute to defeat a useful and practically successful invention by reason only of paper anticipations (*per* Cozens Hardy, L.J., in *Patent Exploitation* v. *Siemens* (1903) 20 R. P. C. at p. 242). Nevertheless, if the invention has been previously published, the Court has no alternative.

Publication by Drawings.—An invention may be anticipated by the publication of a drawing merely (see *Herrburger* v. *Squire* (1889) 6 R. P. C. at p. 198; and see *Electric Construction Co.* v. *Imperial Tramways* (1900) 17 R. P. C. at p. 550). And a drawing will be an anticipation, it is submitted, if it conveys to *highly* skilled persons information which will enable them to construct, without the exercise of inventive ingenuity, the invention subsequently patented (see p. 11, *supra*).

Publication by Exhibition of Models.—The exhibition of a model in public may be an anticipation of a patented invention

(*Winby* v. *Manchester Tramways* (2) (1891) 8 R. P. C. at pp. 66, 67; *Humpherson* v. *Syer* (1887) 4 R. P. C. at p. 415; *Lifeboat Co.* v. *Chambers* (1891) 8 R. P. C. 418; *cf. Ehrlich* v. *Ihlee* (1888) 5 R. P. C. at pp. 206, 207). But where the conditions of s. 39 of the Patents Act, 1883, are complied with, an unpatented invention may be exhibited at industrial and international exhibitions without prejudice to the validity of a patent for the invention subsequently applied for. That section provides that:—

> The exhibition of an invention at an industrial or international exhibition certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with; namely—
>
> (*a*) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and
>
> (*b*) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

And see s. 3 of the Patents Act, 1886, which provides for the extension of the section to exhibitions held out of the United Kingdom.

Publication by Communications to Individuals.—An invention will be published if it is communicated to any member of the public who is under no obligation as to secrecy (*Humpherson* v. *Syer* (1887) 4 R. P. C. at pp. 413, 414, 415; *Westley* v. *Perkes* (1893) 10 R. P. C. at p. 193; *cf. Heinrichs* v. *Bastendorff* (1893) 10 R. P. C. at pp. 163, 164). But if the communication be made to any person or number of persons under the bond or seal of confidence, that communication does not enure to the benefit of the public, and there is no publication (*Humpherson* v. *Syer* (1887) 4 R. P. C. at p. 414; *Morgan* v. *Seaward* (1837) 1 W. P. C. at p. 195; *Blank* v. *Footman* (1888) 5 R. P. C. at p. 656; *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 527). The test is—"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 when the plaintiff took out his patent?" (*per* Fry, L.J., in *Humpherson* v. *Syer*

(1887) 4 R. P. C. at p. 414). If, however, the persons to whom the invention is communicated in confidence should commit a breach of that confidence and disclose the secret to others, a publication will have taken place (*Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at pp. 259, 516; *Blank* v. *Footman* (1888) 5 R. P. C. at p. 653; *Humpherson* v. *Syer* (1887) 4 R. P. C. at p. 416); and it is no answer to prove that each of the others was in his turn pledged to secrecy (see *per* Kekewich, J., in *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 259).

Hence, if an inventor confidentially discloses his discovery to workmen, or engineers, or chemists, or draftsmen (see *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 527), or experts (*Blank* v. *Footman* (1888) 5 R. P. C. at p. 656), or to any other persons, in order to obtain assistance or advice, there is no publication.

Prior User.

Prior User means User in Public.—"When it is said that a process has been disclosed or an invention has been disclosed by means of user, it is not necessary that such user should be a user by the public proper, provided only there is a user in public, that is to say, in such a way as contra-distinguished from a mere experimental user with a view of patenting a thing which may or may not be existing" (*per* Pollock, B., in *Croysdale* v. *Fisher* (1884) 1 R. P. C. at p. 21). Prior user means, therefore, user *in public*; not *by* the public (see *per* Lord Abinger, C.B., in *Carpenter* v. *Smith* (1842) 1 W. P. C. at p. 543; *Gill* v. *Coutts* (1896) 13 R. P. C. at pp. 136, 137).

If an article has once been used in this country no patent can be subsequently taken out in respect of it, even if the article was manufactured abroad, or was manufactured here for the purpose of exportation (see *Carpenter* v. *Smith* (1841) 1 W. P. C. at p. 536).

How Prior User may be Established.—Prior user may be established by showing that the invention, or a material part of it (see *Hill* v. *Thompson* (1818) 1 W. P. C. at p. 249; *Badham* v. *Bird* (1888) 5 R. P. C. 238), was, prior to the date of the patent:—

(*a*) Actually sold (*Jensen* v. *Smith* (1885) 2 R. P. C. 249; *Hoe* v. *Foster* (1899) 16 R. P. C. 33). The sale will be fatal though the article was sold by the inventor himself (*Hoe* v. *Foster*, *supra*, at p. 40; *Wood* v. *Zimmer* (1815) 1 Holt, at p. 60), and to only one individual (*Losh* v. *Hague* (1838) 1 W. P. C. at p. 205; *Morgan* v. *Seaward* (1837) 1 W. P. C. at p. 195), and there was no demand or use for it by the public (*Losh* v. *Hague*, *supra*).

(*b*) Offered or exposed for sale, though no sale was ever effected (*Oxley* v. *Holden* (1860) 8 C. B. (N. S.) 666; *Mullins* v. *Hart* (1852) 3 Car. & K. 297).

(*c*) Used in public in any manner (*Young* v. *Rosenthal* (1884) 1 R. P. C. at p. 32; *Dewrance* v. *Fletcher* (1899) 16 R. P. C. 150; *Brereton* v. *Richardson* (1884) 1 R. P. C. 165; *Gill* v. *Coutts* (1896) 13 R. P. C. 125; *cf. Morgan* v. *Seaward* (1837) 1 W. P. C. at p. 195), though by only one person (*Stead* v. *Williams* (1843) 2 W. P. C. at p. 136).

Instances of Prior User.—In *Carpenter* v. *Smith* ((1842) 1 W. P. C. 540), the fact that a lock, for which A. had a patent, had previously been used by an individual on a gate adjoining a public road, was held fatal to the validity of A.'s grant. The decision in this case was followed in *Betts* v. *Neilson* (1868) 3 Ch. at p. 436. In *Stead* v. *Williams* ((1843) 2 W. P. C. at p. 136), it was proved that the porch of a private dwelling-house had been paved with wood, prior to the date of a patent, in a manner similar to that described in the specification of the patent. Cresswell, J., told the jury, that if they thought the paving was substantially the same as that described in the specification, the patent would be bad. And see *Stead* v. *Anderson* (1846) 2 W. P. C. at p. 149. In *Re Taylor's Patent* ((1896) 13 R. P. C. at p. 487), a patent for fire-grates was revoked on the ground that a similar grate had been used in a private house before the date of the patent.

User which does not Affect Validity.—The novelty of an invention will not be affected by prior secret user (*Hill* v. *Thompson* (1818) 1 W. P. C. at pp. 244, 245; *Young* v. *Rosenthal* (1884) 1 R. P. C. at p. 32; *cf. Hoe* v. *Foster* (1899) 16 R. P. C. 33; *Dick* v. *Tullis* (1896) 13 R. P. C. at p. 157); or confidential user (*Humpherson* v. *Syer* (1887) 4 R. P. C. at pp. 411, 413; *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 527; *Ticklepenny* v. *Army and Navy Society* (1888) 50 R. P. C. 405); or experimental user (*Jones* v. *Pearce* (1832) 1 W. P. C. at p. 124; *Cornish* v. *Keene* (1835) 1 W. P. C. at p. 508; *Re Newall & Elliott* (1858) 4 C. B. (N. S.) 269; *Walton* v. *Bateman* (1842) 1 W. P. C. at p. 619; *Galloway* v. *Bleaden* (1839) 1 W. P. C. at p. 525; *Winby* v. *Manchester Tramways* (1889) 6 R. P. C. 359; *Lyon* v. *Goddard* (1893) 10 R. P. C. at p. 342; *Electrolytic Co.* v. *Holland* (1901) 18 R. P. C. 521; *cf. Re Adamson's Patent*, 25 L. J. Ch. 456; *Hoe* v. *Foster* (1899) 16 R. P. C. 33; *Dick* v. *Tullis* (1896) 13 R. P. C. at p. 157); or user for a different purpose (*Muntz* v.

Foster (1844) 2 W. P. C. at p. 108; *Walton* v. *Bateman* (1842) 1 W. P. C. at pp. 617, 618; *cf. Edison* v. *Woodhouse* (1887) 4 R. P. C. at p. 107).

Effect of Discontinued User.—The fact that the user has for a long period been discontinued makes no difference (see *Haggenmacher* v. *Watson* (1897) 14 R. P. C. at pp. 363, 631; *King & Co.* v. *Anglo-American Brush Corpn.* (1889) 6 R. P. C. at pp. 424, 425). "It may very well be that a patent, otherwise good, will not be invalidated by the discovery afterwards that the same invention had been practised by, *e.g.*, the ancient Romans. But an invention practised within the memory of living man, and by men still living, is scarcely in that category" (*per* Lord Kyllachy in *Dick* v. *Tullis* (1896) 13 R. P. C. at p. 157).

Where, however, the user has been abandoned, the inference is that the user was experimental only (*Household* v. *Neilson* (1843) 1 W. P. C. at p. 713; *Stead* v. *Williams* (1843) 2 W. P. C. at p. 135; *Walton* v. *Bateman* (1842) 1 W. P. C. at p. 619; *Kane* v. *Guest* (1899) 16 R. P. C. at p. 442; *Morgan* v. *Windover* (1888) 5 R. P. C. at pp. 302, 303). And a patent will not be invalidated by prior user of an imperfect or useless machine (*Jones* v. *Pearce* (1832) 1 W. P. C. at p. 124; *Murray* v. *Clayton* (1872) 7 Ch. at p. 581; *Edison* v. *Woodhouse* (1887) 4 R. P. C. at p. 91; *Lyon* v. *Goddard* (1893) 10 R. P. C. 121, 334, (1894) 11 R. P. C. 354; *Galloway* v. *Bleaden* (1839) 1 W. P. C. at p. 525; *Moseley* v. *Victoria Rubber Co.* (1887) 4 R. P. C. 241), unless, indeed, no further ingenuity or invention was necessary to achieve the successful result (see *Kaye* v. *Chubb* (1888) 5 R. P. C. 641, and the above cases).

User under Provisional Protection.—Where an invention has been provisionally protected, the invention may, during the period between the date of the application and the date of sealing the patent, be used and published without prejudice to the patent to be granted for the invention (s. 14 of the Patents Act, 1883; see *Lister* v. *Norton* (1886) 3 R. P. C. 200).

Utility.

The Statute of Monopolies says nothing whatever about utility, but utility has been grafted into it because of the words "mischievous to the State" (see p. 1, *supra*); that is to say, it has been found by experience to be mischievous to the State to

grant patents which are not useful as well as new (see *per* Lindley, L.J., in *Elias* v. *Grovesend* (1890) 7 R. P. C. at p. 467; *per* Vaughan Williams, L.J., in *Ward* v. *Hill* (1903) 20 R. P. C. at p. 200). It is essential, therefore, to the validity of a patent that the subject-matter should be useful; if anything claimed turns out to be useless the patent will be bad (see p. 74, *infra*).

The Amount of Utility need not be Great.—It is well settled that the slightest amount of utility—not an infinitesimal *scintilla*, but a very slight amount—is sufficient to sustain a patent (see *per* Grove, J., in *Philpott* v. *Hanbury* (1885) 2 R. P. C. at p. 37; and see *Morgan* v. *Seaward* (1836) 1 W. P. C. at p. 172; *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 582; *Badische* v. *Levinstein* (1887) 4 R. P. C. at p. 462; *Cole* v. *Saqui* (1888) 5 R. P. C. at p. 495; *Pirrie* v. *York Street Co.* (1893) 10 R. P. C. at p. 39; (1894) 11 R. P. C. 429).

Meaning of Utility.—Utility is often a question of a degree, and always has reference to some object. "Useful for what?" is a question which must be always asked, and the answer must be, "Useful for the purposes indicated by the patentee" (*per* Lindley, L.J., in *Lane-Fox* v. *Kensington Electric Co.* (1892) 9 R. P. C. at p. 417; and see *Cornish* v. *Keene* (1835) 1 W. P. C. at p. 506; *Easterbrook* v. *G. W. R.* (1885) 2 R. P. C. 201). The test, in the language of Charles, J., is, "Does the invention really do, when put in practice by a competent man, what it assumes to do?" (*Wilson* v. *Union Oil Mills* (1892) 9 R. P. C. at p. 70; and see *Tolson* v. *Speight* (1896) 13 R. P. C. at p. 722).

Utility does not mean Abstract, Comparative, or Competitive Utility.—Utility does not mean abstract utility (see *per* Grove, J., in *Young* v. *Rosenthal* (1884) 1 R. P. C., at pp. 34, 35). Nor does it mean comparative or competitive utility (*per* Buckley, J., in *Welsbach Co.* v. *New Incandescent Co.* (1900) 17 R. P. C. at p. 252). An invention is not to be held lacking in utility merely because it does not compare favourably in some respect with other known machines (*Faccett* v. *Homan* (1896) 13 R. P. C. at p. 405). An article which is good, though not so good as that previously known, but which can be produced more cheaply by another process, is useful, in that it is better in point of cost, although not so good in point of quality (*Welsbach Co.* v. *New Incandescent Co.* (1900) 17 R. P. C. at p. 252; and see *Atkins* v. *Castner-Kellner Co.* (1901) 18 R. P. C. at p. 295; *Elias* v. *Grovesend* (1890) 7 R. P. C. at p. 461). And a machine

may be useful at law although it costs more to produce than the one it competes with; it may satisfy the condition of utility although it is so expensive as to be commercially useless (*Wilson* v. *Union Oil Mills* (1892) 9 R. P. C. at pp. 69, 70). It need not be so useful as to exclude everything else of the same kind (*Tetley* v. *Easton* (1852) Macr. P. C. at p. 63); an invention may be useful although, owing to other circumstances, the public will not make use of it (*per* Lindley, L.J., in *Fawcett* v. *Homan* (1896) 13 R. P. C. at p. 405).

Inventions are Useful if they Offer Advantages.—An invention is useful for the purposes of the Patent Law when the public are thereby enabled to do something which they could not do before, or to do, in a more advantageous manner, something which they could do before; or, to express it in another way, an invention is patentable which offers to the public a useful choice (see *per* Buckley, J., in *Welsbach Co.* v. *New Incandescent Co.* (1900) 17 R. P. C. at p. 252; and see *Ward* v. *Hill* (1903) 20 R. P. C. at p. 199). To arrive at the same result with less expense (*Case* v. *Cressy* (1900) 17 R. P. C. at p. 262; *Elias* v. *Groresend* (1890) 7 R. P. C. at p. 461), or in a more convenient or speedy manner (see *per* Mathew, L.J., in *Ward* v. *Hill* (1903) 20 R. P. C. at p. 203), is sufficient to establish the degree of utility which will support a patent.

Commercial Prosperity is no Criterion.—The element of commercial pecuniary success has no relation to the question of utility in Patent Law generally (*Badische* v. *Levinstein* (1887) 4 R. P. C. at pp. 462, 466; *Atkins* v. *Castner-Kellner Co.* (1901) 18 R. P. C. at p. 295; *cf. Wilson* v. *Wilson* (1903) 20 R. P. C. at p. 17). A great many very meritorious patents would go to the wall if it were so (*per* Wills, J., in *Sunlight Co.* v. *Incandescent Co.* (1897) 14 R. P. C. at p. 775). The one which to-day may be in large demand may to-morrow be a drug in the market; and *vice versâ* (see *per* Lord Herschell in *Badische* v. *Levinstein* (1887) 4 R. P. C. at p. 466). But where the invention relates to an improvement by reason of cheaper production, the element of commercial prosperity is of the very essence of the patent itself (see *per* Lord Halsbury in *Badische* v. *Levinstein*, *ibid.*, at p. 462; *Atkins* v. *Castner-Kellner Co.* (1901) 18 R. P. C. at p. 296).

Evidence of Utility and Want of it.—A large demand, on the other hand, is strong evidence of utility (*Cole* v. *Saqui* (1888)

5 R. P. C. at p. 495—this patent was held bad on appeal for want of novelty; *Ehrlich* v. *Ihlee* (1888) 5 R. P. C. at p. 449; *Automatic Cover* v. *Stockford* (1902) 19 R. P. C. at p. 461; *Cornish* v. *Keene* (1835) 1 W. P. C. at pp. 506, 507; *Moss* v. *Malings* (1886) 3 R. P. C. at p. 378). But such evidence is by no means conclusive. In *Wilson* v. *Wilson* ((1903) 20 R. P. C. 1) it was proved (see note in the report on p. 8) that the plaintiff company had sold over eighteen millions of their patented articles, but the House of Lords, nevertheless, held that the patent was lacking in utility.

And better evidence of the utility of an invention cannot possibly be had than the fact that the person alleging non-utility has attempted to infringe the patent (see *per* Kay, J., in *Lucas* v. *Miller* (1885) 2 R. P. C. at p. 160) or has thought sufficiently well of the invention to adopt a great deal of it (see *per* Vaughan Williams, L.J., in *Ward* v. *Hill* (1903) 20 R. P. C. at p. 200). "It scarcely lies in the mouth of the defendant, if he has infringed, to deny the validity of that which he has taken the trouble to borrow" (*per* Bowen, L.J., in *Miller* v. *Searle Barker* (1893) 10 R. P. C. at p. 111).

It is *primâ facie* evidence of want of utility if the patented article has never been put into practice (see *per* Jessel, M.R., in *Otto* v. *Linford* (1882) 46 L. T. at p. 41; *Hinks* v. *Safety Co.* (1876) 4 C. D. at p. 616). But an invention may be useful although, owing to other circumstances, the public will not use it (see *per* Lindley, L.J., in *Fawcett* v. *Homan* (1896) 13 R. P. C. at p. 405). "A patent is not to be defeated simply because . . . in consequence of subsequent improvements, no article was in fact made in accordance with the specification" (*per* Cotton, L.J., in *Edison* v. *Holland* (1889) 6 R. P. C. at p. 277; and see *Otto* v. *Linford* (1882) 46 L. T. at p. 41; *Badische* v. *Levinstein* (1887) 4 R. P. C. at p. 466). "Nor is it a fatal objection to a patentee's claim that one part (of the invention) has in practice not been found to be so useful as the others, so that it has dropped out of commercial use" (*per* Kekewich, J., in *Ehrlich* v. *Ihlee* (1888) 5 R. P. C. at p. 203).

General Utility is Sufficient.—Where you have general utility, that is, utility of the invention as a whole, you are not bound to prove that each part is equally useful (*per* Kekewich, J., in *Ehrlich* v. *Ihlee* (1888) 5 R. P. C. at p. 203; and see *Miller* v. *Searle Barker* (1893) 10 R. P. C. 106; *Badische* v. *Levinstein* (1887) 4 R. P. C. at p. 466).

Invention.

The subject-matter of letters patent must not only be new and useful, but it must have involved some ingenuity or invention (see *per* Lindley, L.J., in *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 524; *Acetylene Co.* v. *United Alkali Co.* (1903) 20 R. P. C. at p. 172). "A thing may be new, but unless it has some invention it is not patentable" (*per* Lord Halsbury, L.C., in *Rickmann* v. *Thierry* (1897) 14 R. P. C. at p. 114; and see *Cole* v. *Saqui* (1889) 6 R. P. C. at p. 44).

Difference between Invention and Discovery.—An invention is not the same thing as a discovery (*per* Lindley, L.J., in *Lane-Fox* v. *Kensington Electric Co.* (1892) 9 R. P. C. at p. 416; and see *Case* v. *Cressy* (1900) 17 R. P. C. at p. 261). Discovery adds to the amount of human knowledge, but it does so only by lifting the veil and disclosing something which before had been unseen or dimly seen. Invention also adds to human knowledge, but not merely by disclosing something. Invention necessarily involves also the suggestion of an act to be done, and it must be an act which results in a new product, or a new result, or a new process, or a new combination for producing an old product or an old result (*per* Buckley, J., in *Reynolds* v. *Smith* (1903) 20 R. P. C. at p. 126; affirmed 20 R. P. C. 410). When Volta discovered the effect of an electric current from the battery on a frog's leg he made a great discovery, but no patentable invention (*per* Lindley, L.J., in *Lane-Fox* v. *Kensington Electric Co.* (1892) 9 R. P. C. at p. 416).

It is often extremely difficult to draw the line between patentable inventions and non-patentable discoveries. "On the one hand, the discovery that a known thing—such, for example, as a Planté battery—can be used for a useful purpose for which it has never been used before, is not alone a patentable invention; but, on the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention if there is novelty in the mode of using it as distinguished from novelty of purpose, or if any new modification of the thing, or any new appliance is necessary for using it for its new purpose, and if such mode of user, or modification, or appliance involves any appreciable merit" (*per* Lindley, L.J., in *Lane-Fox* v. *Kensington Electric Co.*, *supra*; and see p. 24, *infra*).

Invention is a Question of Fact.—The question, whether there is ingenuity in the matter of a patent is a question of fact; it depends on a true view of all the circumstances in the

particular case, and it cannot be governed in any case by a finding of fact, on a totally different invention, by any other tribunal (see *per* Bowen, L.J., in *Lyon* v. *Goddard* (1893) 10 R. P. C. at pp. 345, 346: *Rickmann* v. *Thierry* (1897) 14 R. P. C. at p. 115). "Of all the questions which ever arise in Patent Law, the most difficult is to say where there is not sufficient invention to support a patent" (*per* Lindley, M.R., in *Dredge* v. *Parnell* (1898) 15 R. P. C. at p. 88).

Amount of Invention need not be Large.—It is well settled law that the amount of invention necessary to support a patent need not be great (see *Crane* v. *Price* (1842) 1 W. P. C. at pp. 410, 411). Mere simplicity will not prevent there being invention" (*per* Lord Halsbury, L.C., in *Rickmann* v. *Thierry* (1897) 14 R. P. C. at p. 115). If an apparatus be valuable by reason of its simplicity, there is danger of being misled by that very simplicity into the belief that no invention was needed to produce it. But experience has shown that not a few inventions, some of which have revolutionised the industries of this country, have been of so simple a character that when once they were made known it was difficult to understand how the idea had been so long in presenting itself, or not to believe that they must have been obvious to everyone (*per* Lord Herschell in *Vickers* v. *Siddell* (1890) 7 R. P. C. at pp. 304, 305). When once the patentee has found out the invention, all mechanicians can say at once: "Dear me, what a simple thing; it did not require any invention for him to do it." But the answer to that is, and must always be, this—"The thing was wanted; there was a thing which would not do what was wanted; by finding out some small addition I have found out the thing which would do" (*per* Lord Esher, M.R., in *Lyon* v. *Goddard* (1893) 10 R. P. C. at p. 343). "It is always easy to say a thing is obvious when it has been pointed out" (*per* Lord Herschell in *Longbottom* v. *Shaw* (1891) 8 R. P. C. at p. 337; and see *Electrolytic Co.* v. *Evans* (1900) 17 R. P. C. at p. 741; *Hinks* v. *Safety Co.* (1876) 4 C. D. at pp. 615, 616; *Thomson* v. *American Braided Co.* (1889) 6 R. P. C. 518).

But a mere *scintilla* of invention is not enough to justify a monopoly (*Carter* v. *Leyson* (1902) 19 R. P. C. at p. 478; *Bearis* v. *Rylands* (1900) 17 R. P. C. 704; *cf. Parker* v. *Satchwell* (1901) 18 R. P. C. at p. 308).

Tests of Invention.—The test of invention as applied by Lord Chelmsford (*Penn* v. *Bibby* (1866) 2 Ch. at p. 136)

in a case of analogous user is: "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"; and see *Elias* v. *Gravesend* (1890) 7 R. P. C. at p. 461.

"The way to ascertain whether a novel and useful improvement in machinery required invention in the true sense is to consider how matters stood first before the improvement was discovered" (*per* Romer, L.J., in *Taylor* v. *Annand* (1900) 17 R. P. C. at p. 137) in order to see what were the exigencies sought to be supplied by the new article (see *per* Lord Halsbury, L.C., in *Taylor* v. *Annand* (1901) 18 R. P. C. at p. 62). If, having regard to what was known, no further invention was necessary—if the improvement was so obvious to persons of ordinary intelligence and acquaintance with the subject-matter as to present no difficulties—the patent cannot be sustained (*Cooper* v. *Badeker* (1900) 17 R. P. C. at p. 213; *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 524; *Stolzenberg* v. *Humphreys* (1901) 18 R. P. C. at p. 124; *Williams* v. *Nye* (1887) 7 R. P. C. 62).

The labour of thought, or experiments, 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 of a patent, ought to depend. If the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether of some sudden and lucky thought, or mere accidental discovery (*per* Tindal, C.J., in *Crane* v. *Price* (1842) 1 W. P. C. at p. 411; and see *Liardet* v. *Johnson* (1778) 1 W. P. C. at p. 54). "An invention which comes to a man by a happy flash of inspiration or without any prolonged experiment or thought may be as good a subject-matter of a patent as one which has only been arrived at after long and difficult experiments" (*per* Lord Herschell, in *Longbottom* v. *Shaw* (1891) 8 R. P. C. at p. 337).

An invention need not be important and necessary for the public good (see *per* Lord Herschell in *Thomson* v. *American Braided Co.* (1889) 6 R. P. C. at p. 528; and see *per* Grove, J., in *Young* v. *Rosenthal & Co.* (1884) 1 R. P. C. at pp. 34, 35).

Evidence of Invention.—The fact that the patented article is very useful (*Taylor* v. *Annand* (1901) 18 R. P. C. at p. 63; *Elias* v. *Gravesend* (1890) 7 R. P. C. at p. 461; *Duckett* v. *Whitehead* (1895) 12 R. P. C. 376), or that it supplies a long-

felt want (*Brooks* v. *Lamplugh* (1898) 15 R. P. C. at p. 48; *Ehrlich* v. *Ihlee* (1888) 5 R. P. C. at p. 456; *Taylor* v. *Annand* (1901) 18 R. P. C. at p. 63; *White* v. *Bertrams* (1897) 14 R. P. C. at pp. 512, 746), or that it has been in great demand (*Longbottom* v. *Shaw* (1891) 8 R. P. C. at p. 336; *Thomson* v. *American Braided Co.* (1889) 6 R. P. C. at pp. 527, 528; *Parker* v. *Satchwell* (1901) 18 R. P. C. at p. 308), is evidence of invention.

But such evidence is by no means conclusive; if the result was obvious the patent cannot be sustained. As to utility, see *Williams* v. *Nye* (1890) 7 R. P. C. at pp. 66, 67; *Morgan* v. *Windover* (1890) 7 R. P. C. at p. 136; *Stohwasser* v. *Humphreys* (1901) 18 R. P. C. at p. 124; *Bearis* v. *Rylands* (1900) 17 R. P. C. 704. As to a felt want, see *Cooper* v. *Baedeker* (1900) 17 R. P. C. 209; *Wood* v. *Raphael* (1897) 14 R. P. C. at p. 500; *Gosnell* v. *Bishop* (1888) 5 R. P. C. at p. 158. And as to a large demand, see *Longbottom* v. *Shaw* (1891) 8 R. P. C. at p. 336; *Carter* v. *Leyson* (1902) 19 R. P. C. at p. 477, 478; *Savage* v. *Harris* (1896) 13 R. P. C. at p. 374; *Gosnell* v. *Bishop*, *supra*; *Blakey* v. *Latham* (1889) 6 R. P. C. at p. 187; *Stohwasser* v. *Humphreys* (1901) 18 R. P. C. at p. 124.

There is no Invention in the Mere Application of Old Things to Analogous Subjects.—There is no sufficient invention in *merely* applying a well-known thing, in a manner or to a purpose which is analogous to the manner or to the purpose in or to which it has been previously applied (see *per* Lord Westbury in *Harwood* v. *G. N. R.* (1865) 11 H. L. C. at pp. 682, 683; *per* Lord Davey in *Riekmann* v. *Thierry* (1897) 14 R. P. C. at p. 121; *Elias* v. *Gravesend* (1890) 7 R. P. C. at p. 468: *Bearis* v. *Rylands* (1900) 17 R. P. C. at p. 98). "It would be a very extraordinary thing to say, that because 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" (*per* Lord Abinger in *Losh* v. *Hague* (1838) 1 W. P. C. at p. 208).

Examples.—For instance, there is no such invention as will support a patent in applying a fish-plate, previously in use for the purpose of supporting timbers placed vertically upon one another, to the rails of railways (*Harwood* v. *G. N. R.*, *supra*), or in applying a floor-plate, previously used for giving rigidity to other machines, to a lace machine (*Cropper* v. *Smith* (1884) 1 R. P. C. 81), or in applying a tap, which has been previously used to intercept or permit the flow of water, to a bottle to intercept or permit the flow of wine (*Hazlehurst* v. *Rylands*

(1892) 9 R. P. C. at p. 8), or in applying to a window, for the purpose of expelling air or diminishing light, a screen which has been previously used for other purposes, *e.g.*, to diminish heat from a fire-grate (*Sharp* v. *Brauer* (1886) 3 R. P. C. 193), or in applying springs, which have been previously used at the back of a carriage, to the front (*Morgan* v. *Windover* (1890) 7 R. P. C. at p. 134), or in applying a locking bolt, previously used for locking a bicycle when ridden, to a bicycle when it is at rest (*Singer* v. *Rudge* (1894) 11 R. P. C. at pp. 466, 467), or in applying a groyne, previously used for land purposes, to sea purposes (*Case* v. *Cressy* (1901) 18 R. P. C. at p. 422), or in applying a plate, previously used on the toe of a boot, to the heel of a boot (*Blakey* v. *Latham* (1889) 6 R. P. C. 184). For other examples of patents held bad on this ground, see *Rose's Patents* v. *Braby* (1894) 11 R. P. C. at p. 216; *Nicoll* v. *Sugars* (1893) 10 R. P. C. 240; *Albo-Carbon Co.* v. *Kidd* (1887) 4 R. P. C. 535; *Dredge* v. *Parnell* (1899) 16 R. P. C. 625; *Glover* v. *American Steel Co.* (1902) 19 R. P. C. 103.

Exception.—If, however, 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, it may form the subject of a valid patent (see *per* Lord Chelmsford, L.C., in *Penn* v. *Bibby* (1866) 2 Ch. at p. 136; and see *Pirrie* v. *York Street Co.* (1894) 11 R. P. C. at p. 432; *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 524; *Brooks* v. *Lamplugh* (1898) 15 R. P. C. at p. 48; *Thomson* v. *American Braided Co.* (1889) 6 R. P. C. 518; *Morgan* v. *Windover* (1890) 7 R. P. C. at p. 136; *Elias* v. *Groresend* (1890) 7 R. P. C. at p. 469).

Other Cases of no Invention.—A more skilled application of well-understood tools and well-understood processes is not patentable (*per* Lord Halsbury, L.C., in *Dredge* v. *Parnell* (1899) 16 R. P. C. 625).

There is no invention in proposing to do at twenty places something which has been done at one (see *per* Farwell, J., in *Rucker* v. *London Electric Corpn.* (1900) 17 R. P. C. at p. 295).

Nor, in most instances, is there any invention in merely altering the shape of a known thing (*Heyes* v. *Hallmark* (1892) 9 R. P. C. 25), or changing the size of a part of a combination (*Edison* v. *Woodhouse* (1887) 4 R. P. C. at p. 92), or varying known proportions (see *Savage* v. *Harris* (1896) 13 R. P. C. at pp. 367, 368); but see p. 2, *supra*.

CHAPTER II.

On Obtaining the Grant.

THE APPLICANT—THE TRUE AND FIRST INVENTOR—THE APPLICATION—THE SPECIFICATIONS—REFUSAL BY COMPTROLLER TO PROCEED—ACCEPTANCE OF THE SPECIFICATIONS.

The Applicant.

Individuals.—Any person, whether a British subject or not, may make an application for a patent (s. 4 (1) of the Patents Act, 1883); and two or more persons may make a joint application for a patent, and a patent may be granted to them jointly (s. 4 (2), *ibid.*). But the applicant, or one of the applicants, must be the true and first inventor (see p. 26, *infra*).

Letters patent may be granted to infants (*Chearin* v. *Walker* (1877) 5 C. D. 850; and see s. 99 of the Patents Act, 1883), aliens (s. 4 (1), *ibid.*; *Re Wirth's Patent* (1879) 12 C. D. 303), lunatics (see s. 99, *ibid.*), and married women (see Married Women's Property Act, 1882). Whether a beneficed clergyman can become a patentee is not, having regard to the prohibition from trading contained in s. 29 of the Pluralities Act, 1838 (1 & 2 Vict. c. 106), altogether clear.

Corporations.—The term "person" in the Act of 1883 includes a corporation (s. 117 of the Patents Act, 1883). But a corporation cannot, it is submitted, be a sole patentee except in respect of an invention communicated from abroad (see *Re Société Anonyme* (1895) 13 R. P. C. 54), or under the International and Colonial Arrangements (see p. 227, *infra*; "*Instructions to Applicants for Patents*," issued by the Patent Office); for, having no mind, it cannot be an "inventor." But a corporation may apply for and be granted a patent jointly with the inventor (s. 5 of the Patents Act, 1885).

Legal Representatives.—If an applicant dies before the patent is sealed, the patent may be granted to his legal representative, and sealed at any time within twelve months after the applicant's death (s. 12 (3) of the Patents Act, 1883). And if a person

possessed of an invention dies without applying for a patent, application may be made by, and a patent for the invention granted to, his legal representative (s. 34 (1), *ibid.*). Every such application must be made within six months of the death of the deceased, and must contain a declaration by the legal representative that he believes such person to be true and first inventor of the invention (s. 34 (2), *ibid.*).

Servants.—The mere existence of a contract of service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service, even though the invention may relate to subject-matter germane to and useful for his employer in his business, and even though the servant may have made use of his employer's time, and servants, and materials in bringing his invention to completion, and may have allowed his employer to use the invention while in his employment (see *per* Byrne, J., in *Worthington* v. *Moore* (1903) 20 R. P. C. at p. 48; *Heald's Applications* (1891) 8 R. P. C. at p. 430; and see p. 41, *infra*). But the relations of servant and employer may be of such a close and confidential character that the servant will not be allowed to hold a patent, taken out by him during his term of service, as against his employer (*Worthington* v. *Moore*, *supra*).

Officials.—Persons occupying official positions are, in some circumstances, incompetent to obtain valid letters patent for inventions, the knowledge of which they acquired in the course of discharging their official duties (see *Patterson* v. *Gas Light Co.* (1877) 3 A. C. 239).

Firms.—A firm, as such, cannot apply for a patent, but a joint application may be made by all the individual members of the firm.

The True and First Inventor.

By virtue of s. 6 of the Statute of Monopolies (see p. 1, *supra*), every patent must be granted to the "true and first inventor." A valid patent may, however, be granted to several persons jointly some or one only of whom are or is the true and first inventors or inventor (s. 5 of the Patents Act, 1885); and, as has already been stated (see p. 25, *supra*), provision is made for the granting of a patent to the legal representatives of the true and first inventor. If the patentee was not the true and first inventor, the Crown has been deceived in its grant and the patent is void (*Minter* v. *Wells* (1834) 1 W. P. C. at p. 129).

The First Inventor means the First Publisher.—The first inventor means, in patent law, not the first discoverer, but the first publisher (*Dollond's Patent*, 1 W. P. C. 43). Hence if A. makes an invention, but never discloses it to the public, and B. subsequently makes the same invention, and takes out a patent for it, B. will be the true and first inventor (*Cornish* v. *Keene* (1835) 1 W. P. C. at p. 508; *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 556). And as between several persons who simultaneously make the same invention, the one who first applies for a patent is the true and first inventor (*Cornish* v. *Keene, supra*; *Plimpton* v. *Malcolmson, supra*; *Ex parte Henry*, (1872) 8 Ch. 167).

Whether Master or Servant is the True Inventor.—Where a servant makes an invention, the servant, and not the employer, is the inventor, even though the invention is made in the employer's time, and with the use of the employer's materials, and at the employer's expense (*Worthington* v. *Moore* (1903) 20 R. P. C. at p. 48; *Heald's Applications* (1891) 8 R. P. C. at p. 430), and at the employer's express request (*Re Marshall's Patent* (1900) 17 R. P. C. 553).

But an inventor may, and very often does, avail himself of the assistance of a workman or skilled person in carrying out his invention. In this case, the invention remains the property of the employer; and if the person employed makes a discovery *accessory to* the main principle of the invention, and tending to carry it out in a better way, the discovery is the property of the employer, and may be embodied in his patent (see *Allen* v. *Rawson* (1845) 1 C. B. at p. 567; *Re David* (1886) 2 Griff. P. C. 26; *Minter* v. *Wells* (1834) 1 W. P. C. at p. 132). See, further, p. 41, *infra*.

It is, however, 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 depends upon its own merits (see *per* Tindal, C.J., in *Allen* v. *Rawson*, *supra*, at p. 574). Where E. had an idea which he communicated to T., and T. mentioned it to H., and H. made a sketch of the proposed machine, it was held that E. was not the true and first inventor (*Elias* v. *Groresend* (1890) 7 R. P. C. 455).

Importers.—It is well settled that an importer of an invention now within the realm is a true and first inventor. "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 the realm*; so that if they be new here, it is within the statute; for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing" (agreed by Holt and Pollexfen in *Edgebury* v. *Stephens*, 1 W. P. C. at p. 35; *Stead* v. *Anderson* (1849) 2 W. P. C. at p. 149; *Edmund's Patent* (1886) Griff. P. C. at p. 283; *Moser* v. *Marsden* (1893) 10 R. P. C. at p. 359).

Communications from Abroad.—An invention communicated from abroad is patentable—on the ground of being an importation—and the person to whom the invention is communicated is considered the true and first inventor (see *Pilkington* v. *Yeakley Co.* (1901) 18 R. P. C. at p. 461). The applicant may himself improve on the invention communicated, and the specification need not show on its face that any improvement has been made (*Moser* v. *Marsden* (1893) 10 R. P. C. at p. 359).

It was held in *Wirth's Patent* (12 C. D. 303) that a foreigner resident abroad could obtain letters patent for an invention communicated to him by another foreigner also resident abroad. But the applicant must, now, be resident in England. He may, however, be merely an agent or trustee for the foreign invention (*Beard* v. *Egerton* (1846) 3 C. B. 97).

The communication must come from *abroad*. A communication of an invention made in England by one British subject to another does not make the person to whom the communication is made the true and first inventor (*Marsden* v. *Saville Street Co.* (1878) 3 Ex. D. 203). Scotland, in this connection, is within the realm (*Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 555; s. 16 of the Patents Act, 1883). But persons receiving communications from the Colonies, which are empowered to grant letters patent, are true and first inventors (*Rolls* v. *Isaacs* (1878) 19 C. D. at p. 275).

Whether the foreign inventor may himself come over to this country and communicate the invention is not altogether clear. The question was raised, but not decided, in *Pilkington* v. *Yeakley Co.* (1901) 18 R. P. C. at p. 461.

The Application.

Form of the Application.—A person desirous of obtaining letters patent for an invention must leave at the Patent Office

(25, Southampton Buildings, Chancery Lane, W.C.), or send to that office by post, an application in the prescribed form (s. 5 (1) of the Patents Act, 1883). The application must be accompanied by either a provisional or complete specification (s. 5 (2), *ibid.*); see p. 55, *infra*.

The application must contain a declaration to the effect that the applicant is in possession of an invention whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors (s. 5 (2), *ibid.*). Every application must be accompanied by a statement of address to which all notices, requisitions, and communications of every kind may be sent by the Comptroller, or by the Board of Trade; and such statement is binding upon the applicant until a substituted address for service is furnished by him to the Comptroller. The Comptroller may, in any particular case, require that the address for service be in the United Kingdom or the Isle of Man (Patents Rules, 1903, Rule 7).

The Prescribed Forms.—The Patents Rules, 1903, contain three forms of application:—(1) A form for inventions discovered within the realm (Form A.); (2) a form for inventions communicated from abroad (Form A. 1); and (3) a form for inventions patentable under International and Colonial Arrangements (Form A. 2).

Although the application and the various steps should be in accordance with the prescribed forms, the statute will not fail in its operation because a form has to be slightly modified (*Re Grenfell's Patent* (1890) 7 R. P. C. at p. 152).

The Specifications.—The application must be accompanied by either (*a*) a provisional specification (see pp. 56 *et seq.*), or (*b*) a complete specification (see pp. 58 *et seq.*).

If a complete specification is left in the first instance a provisional specification is unnecessary. If a provisional specification only is left with the application, the applicant may, as the law now stands, leave his complete specification at any later period within nine months from the date of the application (s. 8 (1) of the Patents Act, 1883).

S. 1 (8) of the Patents Act, 1902, requires the complete specification to be lodged within six months from the date of application; but this section is only to come into operation at such date as the Board of Trade may by order direct, and applies only to applications made after that date (s. 1 (2), *ibid.*). No order has yet been made by the Board.

Unless the complete specification is left within the prescribed time the application is deemed to be abandoned (s. 8 (2) of the Patents Act, 1883). But abandonment does not prevent the inventor making another application for the same invention, even though actual user during the currency of the first provisional protection is shown (*Lister* v. *Norton* (1886) 3 R. P. C. 199).

The Comptroller may extend the time for leaving the complete specification for a period not exceeding one month (s. 3 of the Patents Act, 1885). An application for extension of time should be made on Form U., and must state in detail in what circumstances and upon what grounds the extension is applied for, and the Comptroller may require the applicant to substantiate such allegations by such proof as he may think necessary (Patents Rules, 1903, Rule 10).

Applications by Legal Representatives.—Every application for a patent made by the legal representative of a person dying possessed of an invention must be made within six months of the death of the deceased, and must contain a declaration by the legal representative that he believes the deceased to be the true and first inventor (s. 34 (2) of the Patents Act, 1883); and the probate of the deceased's will, or the letters of administration granted of his estate and effects, or an official copy of such probate or letters, must be produced at the Patent Office in proof of the applicant's title as legal representative, and must be supported by such further evidence as the Comptroller may require (Patents Rules, 1903, Rule 6). But such evidence may be dispensed with in certain cases (see p. 31, *infra*).

Joint Applications.—Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly (s. 4 (2) of the Patents Act, 1883); but the true and first inventor or inventors must join in the application (s. 5 of the Patents Act, 1885; see, further, p. 26, *supra*).

Although each applicant must sign the application, the Comptroller cannot refuse to accept a complete specification which is not signed by all the applicants (*Re Greafell's Patent* (1889) 7 R. P. C. 151).

If joint applicants for a patent quarrel, and then each delivers a different specification, the Comptroller may refuse to accept the specifications (*Re Apostoloff's Application* (1896) 13 R. P. C. 275).

Where disputes arose between joint applicants, and one threatened to withdraw from the joint application, an injunction was granted to restrain him withdrawing or abandoning

the application, or doing any act to prevent the issue of the patent (*Wool Syndicate* v. *Riches* (1902) 19 R. P. C. 127).

Applications by Persons under Disability.—If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by the Act or by any of the rules made under the authority of the Act, 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 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 are, for the purposes of the Act, as effectual as if done by the person for whom he is substituted (s. 99 of the Patents Act, 1883). And where, under the 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 so produced or left, the Comptroller may, with the sanction of the Board of Trade, and upon production of such other evidence, and subject to such terms as they may think fit, dispense with any such act or thing, document, declaration, or evidence (Patents Rules, 1903, Rule 78).

Applications under International and Colonial Arrangements.—As to these, see p. 228, *infra*.

Mode of leaving Applications.—The application may be left at the Patent Office by hand (see Patents Rules, 1903, Rule 8), or may be sent by a prepaid letter through the post. If sent through the post the application is deemed to have been left at the time when the letter containing the same would be delivered in the ordinary course of post (Rule 80, *ibid.*). In proving service by post, it is sufficient to prove that the letter was properly addressed and put into the post (Rule 80, *ibid.*). The handing of a letter to a postman in the street to put into the

post is not a posting of the letter (*Re London and Northern Bank* [1900] 1 Ch. 220).

Applications for patents sent through the post are, so far as is practicable, opened and numbered in the order in which the letters containing the same are respectively delivered in the ordinary course of post; and applications left by hand are in like manner numbered in the order of their receipt at the Patent Office (Patents Rules, 1903, Rule 8).

Applications must be for only One Invention.—No application can be for more than one invention (see s. 33 of the Patents Act, 1883). But an applicant who includes in his specification by mistake, inadvertence, or otherwise, more than one invention, may, with the consent of the Comptroller, at any time before the date allowed for the acceptance of his complete specification (see p. 35, *infra*), amend the same so as to apply for one invention only, and may make application for each such invention accordingly. Every such application, if the applicant notifies his desire to that effect to the Comptroller, bears the date of the first application (Patents Rules, 1903, Rule 9). If the Comptroller objects to an application on the ground that it includes more than one invention, the applicant may appeal to the Law Officer (see *Robinson's Patent*, Griff. P. C. 267). If a patent for more than one invention is granted, no person, in any action or proceeding, can take any objection to the patent on that ground (s. 33 of the Patent Act, 1883).

Correction of Clerical Errors.—The Comptroller may, on request in writing accompanied by the prescribed fee, correct any clerical error in or in connection with an application for a patent (s. 91 of the Patents Act, 1883).

Employment of Patent Agents.—Although many inventors do, and are competent to, draft their own specifications, the employment of a qualified patent agent or a solicitor is, in the majority of cases, essential or prudent (see, further, p. 230, *infra*).

Examination of Application and Specifications.

Reference to an Examiner.—Every application is referred by the Comptroller to an Examiner, who ascertains and reports to the Comptroller whether—

(1) The nature of the invention has been fairly described; and

(2) The application, specification, and drawings (if any) have been prepared in the prescribed manner; and

(3) The title sufficiently indicates the subject-matter of the invention (s. 6 of the Patents Act, 1883).

Where a complete specification is left after a provisional specification, the Examiner has further to ascertain whether—

(4) The complete specification has been prepared in the prescribed manner (see p. 59, *infra*); and

(5) The invention described in the complete specification is substantially the same as that which is described in the provisional specification (s. 9 (1) of the Patents Act, 1883).

The Examiner's report is not in any case published or open to public inspection, and it is not liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding certifies that production or inspection is desirable in the interests of justice, and ought to be allowed (s. 9 (5), *ibid.*, as amended by s. 3 of the Patents Act, 1888).

Refusal by Comptroller to Proceed.—If the Examiner reports unfavourably as to (1), (2), or (3), 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, if the Comptroller so directs, bears date as from the time when the requirement is complied with (s. 2 of the Patents Act, 1888). And if the Examiner reports unfavourably as to (4) or (5), the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction (s. 9 (2) of the Patents Act, 1883). From the decision of the Comptroller refusing to accept an application or requiring an amendment (s. 2 of the Patents Act, 1888), or refusing to accept a complete specification (s. 9 (2) of the Patents Act, 1883), an appeal lies to the Law Officer (see p. 224, *infra*).

The Examiner's report does not fetter the judgment of the Comptroller, who may exercise his judgment independently (*Re C.'s Application* (1890) 7 R. P. C. 250).

The Comptroller may also refuse to accept an application for a patent if it is not in respect of only one invention (see p. 32, *supra*), or of a "manner of manufacture" within the Statute of Monopolies (*Re Cooper's Application* (1902) 19 R. P. C. 53; *Re Johnson's Application* (1902) 19 R. P. C. 56; *Re Bridge's Application* (1901) 18 R. P. C. 257). And he may refuse to grant

a patent for an invention the use of which would, in his opinion, be contrary to law or morality (s. 86 of the Patents Act, 1883).

Hearing Before the Comptroller.—Before exercising any discretionary power adversely to the applicant, the Comptroller must 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 (s. 94 of the Patents Act, 1883; Patents Rules, 1903, Rule 28). 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 must notify in writing to the Comptroller whether or not he intends to be heard (Rule 29, *ibid.*).

Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require (Rule 30, *ibid.*).

The Comptroller's decision in the exercise of any discretionary power is to be notified to the applicant, and to any other person who appears to him to be affected thereby (Rule 31, *ibid.*).

Appeal to Law Officer.—Where the Comptroller refuses to accept an application, or requires an amendment, the applicant may appeal from the decision to the Law Officer (s. 2 of the Patents Act, 1888; s. 9 (2) of the Patents Act, 1883: see, as to the procedure on such appeals, p. 224, *infra*).

Search as to Novelty.—At the present time, no search is required to be made by the Comptroller as to the novelty of the invention in respect of which application for a patent is made; in fact, the Comptroller is precluded, by reason of the last five words of s. 46 of the Act of 1883, from making any inquiry as to novelty (*Re Cooper's Application* (1902) 19 R. P. C. 53).

S. 1 of the Act of 1902.—But so soon as the Board of Trade by order direct that s. 1 of the Patents Act, 1902, is to come into operation (s. 1 (11)), the examiner will, where a complete specification has been deposited, have to make a further investigation for the purpose of ascertaining "whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and deposited pursuant to any application for

a patent made in the United Kingdom within fifty years next before the date of the application" (s. 1 (2)). If it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant will have to be informed thereof, and will be at liberty, within such time as may be prescribed, to amend his specification, and the amended specification will have to be investigated in like manner as the original specification (s. 1 (2)). The Examiner will have to report to the Comptroller the result of his investigations in such manner as the Board of Trade may direct (s. 1 (3)). If the Comptroller is satisfied that no objection exists to the specification on the above ground, he will, in the absence of any other lawful ground of objection, have to accept the specification (s. 1 (5)). If the Comptroller is not so satisfied, he will, after hearing the applicant, and unless the objection be removed by amending the specification to the satisfaction of the Comptroller, have to determine whether a reference to any, and, if so, what, prior specifications ought to be made in the specification by way of notice to the public (s. 1 (6)).

The investigations and reports required by the section will not in any way guarantee the validity of the patent, and no liability will be incurred by the Board of Trade or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon (s. 1 (9)). The Board of Trade, with the sanction of the Treasury, will be at liberty to prescribe an additional fee, not exceeding 1*l.*, in respect of the investigation, which will be payable on the sealing of the patent (s. 1 (10)). An appeal will lie from the decision of the Comptroller to the Law Officer (s. 1 (7)).

Acceptance of the Specifications.

Time for Acceptance of Complete Specification.—Unless a complete specification is accepted within twelve months from the date of application, the application (except in the case of an appeal having been lodged against the refusal to accept) becomes void (s. 9 (4) of the Patents Act, 1883). But the Comptroller may, on payment of the prescribed fee, extend the time for acceptance of the complete specification for a further period not exceeding three months (s. 3 of the Patents Act, 1885). An application for extension of time for accepting a complete specification must be made on Form V., and must state in detail in what circumstances and upon what grounds the extension is applied for, and the Comptroller may require proof of the allegations (Patents Rules, 1903, Rule 10).

Notice and Advertisement of Acceptance.—On the acceptance of a provisional or complete specification, the Comptroller must give notice of acceptance to the applicant, and must advertise the acceptance of the complete specification in the Official Journal of the Patent Office (Rule 11, *ibid.*; s. 10 of the Patents Act, 1883).

Public Inspection of Application and Specifications.—Upon the acceptance of the 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 (Rule 12, *ibid.*; s. 10 of the Patents Act, 1883). Where an application for a patent has been abandoned (see p. 30, *supra*), or become void (see p. 35, *infra*), the specification or specifications are not at any time open to public inspection or published (s. 4 of the Patents Act, 1885).

If the complete specification left with a convention application (see p. 228, *infra*) is not accepted within twelve months from the date of the first foreign application, it is open to public inspection at the expiration of that period (Rule 15, *ibid.*).

Rights of Inventor after Acceptance of Provisional Specification.—Where an application for provisional protection has been accepted, the invention may, during the period between the date of the application and the date of sealing the patent, be used and published without prejudice to the patent to be granted for the invention (s. 14 of the Patents Act, 1883; and see p. 16, *supra*).

Rights of Inventor after Acceptance of Complete Specification.—After acceptance of the complete specification, and until the date of sealing the patent, or the expiration of the time for sealing, the applicant has the like privileges and rights as if a patent had been sealed on the date of the acceptance of the complete specification; but he cannot institute any proceeding for infringement until the patent has been granted (s. 15 of the Patents Act, 1883).

CHAPTER III.

The Grant.

SEALING OF THE PATENT—DATE, AREA AND DURATION OF THE GRANT—MAINTENANCE OF THE PATENT—LOSS OF THE PATENT—USE OF THE WORD "PATENT" AND OF THE ROYAL ARMS—OPPOSITION TO THE GRANT.

Sealing of the Patent.—Provided there is no opposition (see p. 40, *infra*), or, in the case of opposition, if the determination is in favour of the grant of a patent, the Comptroller causes a patent to be sealed (s. 12 (1) of the Patents Act, 1883). The patent is sealed with the seal of the Patent Office, but it has the same effect as if it were sealed with the Great Seal of the United Kingdom (s. 2, *ibid.*).

The patent is to be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except where (1) the sealing is delayed by an appeal to the Law Officer, or (2) the sealing is delayed by opposition to the grant, or (3) the applicant dies before the expiration of the fifteen months, or (4) the Comptroller has enlarged the time for leaving a specification (s. 12 (3), *ibid.*; s. 3 of the Act of 1885).

In the first two cases the patent is sealed at such time as the Law Officer directs; in case (3) the patent may be granted to the legal representative of the deceased and sealed at any time within twelve months after the deceased's death; in case (4) a further extension of four months is allowed for sealing (s. 12 (3) of the Act of 1883; s. 3 of the Act of 1888).

If some delay is caused through opposition, but the applicant neglects for an unreasonable time to comply with the requisition of the Comptroller, the case will not be one of delay caused "by opposition" (*Re A. & B.'s Application* (1896) 13 R. P. C. 63).

Date of the Patent.—Every patent is dated and sealed as of the day of the application (s. 13 of the Patents Act, 1883); and that date is conclusive (*Acetylene Co.* v. *United Alkali Co.* (1903) 20 R. P. C. at p. 167). But no proceedings can be taken in respect of an infringement committed before the publication of the complete specification (s. 13, *ibid.*). A patent granted on a

convention application (see p. 228, *infra*) is entered in the Register as dated of the date on which the first foreign application was made (Patents Rules, 1903, Rule 52).

In the case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications does not prevent the sealing of a patent on an earlier application (s. 13 of the Patents Act, 1883).

A patent granted to the true and first inventor is not invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequently to the fraudulent application during the period of provisional protection (s. 35, *ibid.*).

Area of the Grant.—The patent when sealed has effect throughout the United Kingdom and the Isle of Man (s. 16 of the Patents Act, 1883); the grant does not extend to the Channel Islands.

Duration of the Grant.—The term limited for the duration of every patent is fourteen years from its date (s. 17 (1), *ibid.*). The duration of a patent granted on a convention application (see p. 228, *infra*) is reckoned as from the date of the first foreign application (Patents Rules, 1903, Rule 52). The term of a patent may, in certain cases, be extended on petition to His Majesty in Council (see p. 137, *infra*).

Every patent, however, ceases if the patentee fails to make the prescribed payments within the prescribed times (s. 17 (2) of the Patents Act, 1883), unless an extension of time is granted by the Comptroller (see *infra*).

Maintenance of the Patent.—If the patentee intends at the expiration of the fourth year from the date of his patent to keep the patent on foot, he must, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee (Patents Rules, 1903, Rule 66; for fees payable, see p. 239, *infra*). The time for payment of renewal fees in respect of a patent granted on a convention application (see p. 228, *infra*) is reckoned as from the date of the first foreign application (Rule 52, *ibid.*).

If the last day fixed for paying any fee falls on Christmas Day, Good Friday, or on a Saturday or Sunday, or a Bank Holiday, or any day observed as a day of public fast or thanksgiving, the fee may be paid on the day next following such day, or days, if two or more of them occur consecutively (s. 98 of the Patents Act, 1883).

On payment of the proper fee, the Comptroller issues a certificate that the fee has been paid, and that by virtue of such payment the rights of the patentee remain in force (Rule 68, *ibid.*). Application for a renewal certificate should be on Form J. (Rule 66, *ibid.*).

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 time for making the payment (s. 17 (3) of the Patents Act, 1883). Thereupon the Comptroller must, if satisfied that the failure has arisen from any of the causes above-mentioned, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time for making the payment for a period not exceeding three months (s. 17 (4) of the Patents Act, 1883).

An application for an enlargement of time for payment should be on Form K., and should state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make the 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 (Rule 67, *ibid.*).

If any proceeding is taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before enlargement, the Court may, if it thinks fit, refuse to award any damages in respect of the infringement (s. 17 (4) of the Patents Act, 1883).

Loss of the Patent.—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 to be sealed (s. 37 of the Patents Act, 1883). An application for a duplicate should be on Form N.

Use of the word "Patent."—If any person represents that any article sold by him is a patented article, when no patent has been granted for it, he is liable for every offence on summary conviction to a fine not exceeding five pounds (s. 105 of the Patents Act, 1883).

A person is deemed to represent that an article is patented, if he sells the article with the word "patent," or "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 (s. 105 (2), *ibid.*).

It is an offence to sell an article with "Patent" or "Patented"

applied to it if only provisional protection has been obtained (*R.* v. *Wallis* (1886) 3 R. P. C. 1; *R.* v. *Crampton* (1886) 3 R. P. C. 367). But it is no offence to use the words "Patent applied for" (see *R.* v. *Wallis*, *supra*, at p. 3). And, by virtue of s. 15 of the Act of 1883, which gives to an applicant whose complete specification is accepted the same rights as if the patent had been sealed (see p. 36, *supra*), it is no offence to represent an article as patented after the complete specification has been accepted, although no patent has been sealed (*R.* v. *Townsend* (1896) 13 R. P. C. 265). It is probably no offence to represent an article as patented where the patent has expired (see *Thearin* v. *Walker* (1877) 5 C. D. 850).

Use of the Royal Arms.—A person who, without the authority of His 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 deceive, in such manner as to be calculated to lead others to believe that he is so authorised, is liable on summary conviction to a fine not exceeding twenty pounds (see s. 106 of the Patents Act, 1883).

OPPOSITION TO THE GRANT.

Grounds of Opposition.—S. 11 (1) of the Patents Act, 1883, as amended by s. 4 of the Patents Act, 1888, provides "that any person (see p. 49, *infra*) may at any time within two months from the date of the advertisement of the acceptance of a complete specification, give notice (see p. 51, *infra*) at the Patent Office of opposition to the grant of the patent," on any of the following grounds, viz.:—

1. *That the applicant obtained the invention from the opponent, or from a person of whom the opponent is the legal representative.*

The words "obtained the invention" mean "obtained the invention which is purported to be patented"; they refer to the identity of the invention, and not the right of the person from whom it was obtained to be regarded as the true and first inventor (*Re Thwaite's Application* (1892) 9 R. P. C. 515). A person may oppose on the first ground although he does not himself intend to apply for a patent for the invention obtained from him (*Re Thwaite's Application*, *supra*, at p. 516).

Having regard to the fact that by allowing the issue of a patent the matter is not closed, but it is left open to the

opponent to challenge, in a Court of law, the validity of the patent, a patent will not be refused on this ground unless the Comptroller or Law Officer is satisfied that no jury could reasonably come to a decision in favour of the applicant (see *per* Clarke, S.-G., in *Re Stuart's Application* (1892) 9 R. P. C. at p. 458).

Where the evidence is of a conflicting nature, the Comptroller will usually allow the patent to be sealed without prejudice to the opponent's appeal to the Law Officer (*Lake's Patent* (1886) Griff. P. C. 294; *Evans's Patent* (1884) Griff. P. C. 279).

If the opposition is directed only to a portion of the invention, a patent may be granted for the portion not opposed (*Re Thwaite's Application* (1892) 9 R. P. C. 515).

Inventions Communicated from Abroad. S. 11 only applies to communications between persons in the United Kingdom and the Isle of Man; it does not apply to communications made abroad. For, prior to the passing of the Act of 1883, the law was well settled that a person importing into the realm an invention was the true and first inventor within the meaning of the Statute of Monopolies, and it mattered not under what circumstances he had obtained the invention abroad, and the Act of 1883 has made no alteration in the law in this respect. The merit of an imported invention lies in the importation; and the Comptroller, therefore, has no jurisdiction to inquire as to the circumstances under which the invention was obtained by the importer (*Edmund's Patent* (1886) Griff. P. C. at p. 283).

Where, therefore, an invention has been communicated from abroad, the person from whom it has been obtained cannot oppose on the first ground of opposition (*Edmund's Patent, supra*; *Re Higgin's Patent* (1892) 9 R. P. C. 74; *Re Lake's Patent* (1888) 5 R. P. C. 415; *Re Spid's Patent* (1888) 5 R. P. C. 281). But the grant of a patent for an invention communicated from abroad may be opposed on the ground that the invention was not communicated to the applicant, but to the opponent, who alone had authority to apply for a patent (*Fischer's Case* (1882) Griff. P. C. 284; and see *Edmund's Patent, supra*).

Opposition by Master or Servant.—The mere existence of a contract of service does not *per se* disqualify a servant from taking out a patent for an invention made by him during his term of service (see p. 26, *supra*). But if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests

improvements in detail of the machine, which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them (*per* Davey, S.-G., in *Re David* (1886) 2 Griff. P. C. 26; *cf. Re Marshall's Patent* (1900) 17 R. P. C. 553). And where an expert is employed by an inventor for the purpose of making experiments, the benefit of discoveries made during the experiments belong to the employer, and he alone is entitled to claim originality in the matter (see *Re Homan's Patent* (1889) 6 R. P. C. 104; *Kurtz* v. *Spence* (1888) 5 R. P. C. at p. 181).

Terms of Sealing where Invention is Joint Production of Applicant and Opponent.—If it appears that the invention has not been wholly invented by the applicant, and that part of the merit of the invention is due to the opponent, the patent will, as a general rule, be granted to the applicant and opponent jointly (*Eadie's Patent* (1885) Griff. P. C. 279).

Where the parties objected to a patent being granted to them jointly, the Comptroller allowed separate patents to issue, upon the condition that each party agreed to assign to the other one half-share of the respective patents, and to pay one-half of the renewal fees (*Garthwaite's Patent* (1886) Griff. P. C. 284).

In *Re Russell's Patent* ((1857) 2 De G. & J. at p. 135), the patent was sealed on the following terms: That the patent should be granted to two trustees, one to be named by each party; each party to have a free licence to himself and partners; all costs of both sides properly incurred in the matter of the patent to be borne and paid equally by both; a deed to be prepared accordingly, and settled, if the parties differed, by the conveyancing counsel of the Court. In *Lake's Patent* ((1886) Griff. P. C. 294), the grant was made to the applicant subject to the filing of an agreement by which the applicant undertook to do all necessary acts for securing to the opponent the full rights of a joint patentee, and the opponent undertook to take no proceedings for revocation of the patent when granted. In *Evans's Patent* ((1884) Griff. P. C. 279), the patent was granted to the applicant on the condition that he assigned one half-share of the patent to the opponent, and that the opponent (who had already obtained a patent for substantially the same invention) assigned one half-share of his patent to the applicant.

Who are "Legal Representatives."—The term "legal representative" must be construed in its ordinary sense—as meaning

an executor or administrator of a deceased person (*Edmund's Patent* (1886) Griff. P. C. at p. 282). The term does not include a person holding a power of attorney (*Edmund's Patent, supra*) or the legal assignee of an invention (*Re Spiel's Patent* (1888) 5 R. P. C. 281).

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

More patents are opposed on this ground than on any other.

"Patented" means an invention which is not only described in a prior specification, but *claimed*: as only that is patented which the inventor claims (*Von Buch's Application* (1887) 2 Griff. P. C. 40; *Re Bartlett's Application* (1892) 9 R. P. C. at p. 514). Hence, an objection cannot be based on inventions which have only been provisionally protected (*Bailey's Patent* (1884) Griff. P. C. 269).

A person may oppose on this ground of opposition as soon as a complete specification has been *accepted* (see s. 15 of the Patents Act, 1883; *L'Oiseau's Application* (1887) 2 Griff. P. C. 36).

In deciding whether to grant or refuse a patent on this ground, the question of infringement is not considered (*Re Newton's Application* (1900) 17 R. P. C. at p. 124); and a patent will not be stopped merely because the invention is not new (*Re Nahnsen's Application* (1900) 17 R. P. C. 203) or does not show subject-matter (*Todd's Application* (1892) 9 R. P. C. at p. 488; but see p. 33, *supra*, and *Re Bridge's Application* (1901) 18 R. P. C. 257).

A patent will only be stopped where the two inventions are substantially identical (*Cumming's Patent* (1884) Griff. P. C. 277; *Stubbs's Patent* (1884) Griff. P. C. 298; *Re Tattersall's Patent* (1892) 9 R. P. C. at p. 151; *Re Nahnsen's Application* (1900) 17 R. P. C. 203). But if the applicant's invention is only colourably different (*Re Smith's Application* (1896) 13 R. P. C. 200; *Re Walker's Application* (1888) 5 R. P. C. 345; *Re Wallis's Application* (1888) 5 R. P. C. 347; *Re Daniel's Application* (1888) 5 R. P. C. at p. 415; *Re Wylie's Application* (1896) 13 R. P. C. 97), or merely consists in the substitution of mechanical equivalents (*Re Whittaker's Application* (1896) 13 R. P. C. 580; *Re Haythornthwaite's Application* (1889) 7 R. P. C. 70; *Re Smith's Application, supra*), the patent will be refused. It will also be refused if the applicant's arrangement involves no invention (*Re Bridge's Application* (1901) 18 R. P. C. 257).

A very clear case is required to stop a patent where the claims in two specifications have to be combined and pieced together to amount to a prior claim (see *per* Webster, A.-G., in *Ross's Patent* (1891) 8 R. P. C. 477).

Validity of Prior Patent will not be Considered.—Whether the prior patent is bad on the ground of disconformity (*Green's Patent* (1885) Griff. P. C. 286; *Re Haythornthwaite's Application* (1889) 7 R. P. C. 70), or want of novelty (*Re Thornborough's Patent* (1896) 13 R. P. C. 115), or any other ground (*Re Thornborough's Patent, supra*; *Green's Patent, supra*), is immaterial, and will not be considered.

Whether Prior Patent is still in Force is Immaterial.—The fact that the prior patent has lapsed or has expired makes no difference. "The Act allows an application for a patent to be opposed on the ground that the invention has been previously patented, and so long as the opponent's invention has been patented—if it were a hundred years ago—it would not make any difference" (*per* Gorst, S.-G., in *Lancaster's Patent* (1884) Griff. P. C. at p. 291; and see *Glossop's Patent* (1884) Griff. P. C. 285; *Re Stewart's Application* (1896) 13 R. P. C. at p. 628; *Re Hall's Patent* (1888) 5 R. P. C. at p. 285).

Disclaiming Clauses.—It is now the well recognised practice that where there is any doubt as to the identity of the two inventions, the doubt should be given in favour of the sealing of the patent (see *per* Webster, A.-G., in *Welch's Patent* (1884) Griff. P. C. at p. 301). But where the question is a doubtful one, the patent will usually only be sealed on the condition that a disclaiming clause is inserted in the specification (see *Welch's Patent, supra*; *Re Tattersall's Patent* (1892) 9 R. P. C. 150).

Disclaiming clauses may be either general or special. A general disclaimer is a disclaimer as to the existing state of knowledge; a special disclaimer is a disclaimer as to something which is claimed by a specific specification.

"The principles upon which the Law Officers have acted now for some years in allowing disclaiming clauses are, first, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent; and, secondly, if it is clear that the public would be misled by the later specification without disclaimer" (*per* Webster, A.-G., in *Re Stell's Patent* (1891) 8 R. P. C. at p. 236).

Disclaimers are of no value to the prior patentee except for the purpose of preventing the public being misled, or of preventing unfair dealing by means of patents which might be subsequently granted (*Re Stell's Patent, supra*; *Re Guest's Patent* (1888) 5 R. P. C. at p. 315); and a prior patentee who asks for a disclaimer must satisfy the Comptroller, or the Law Officer on appeal, that it is necessary for his protection (*Re Stell's Patent, supra*, at p. 237).

General Disclaimers.—Where there are several prior patents relating to the same subject-matter, a general disclaimer only will be ordered (see *Guest's Patent* (1888) 5 R. P. C. at p. 315; *Re Welch's Patent* (1891) 8 R. P. C. 442).

In *Re Curtis's Application* ((1892) 9 R. P. C. 495) the applicant was required to state that he "is aware that nitro-glycerine explosives have been made from the use of one variety of insoluble nitrated cotton, though such variety contained some proportion of soluble nitrated cotton, and that no claim is made thereto, but what is claimed is the use of the explosive produced from a mixture of insoluble nitrated cotton with soluble nitrated cotton in the proportions indicated in the specification."

In *Re Guest's Patent* ((1888) 5 R. P. C. 312) the disclaimer ran as follows: "We are aware that various arrangements of cycles have been heretofore proposed, having either a jointed back-bone or the frame divided into portions joined together *with one or more joints. Such arrangements have been defective, owing to the nature of the joint or joints used.*" The words in italics were required to be added by the Law Officer.

In *Re Newton's Application* ((1900) 17 R. P. C. 123) the statement inserted was as follows: "I wish it to be understood that I am aware that it has been proposed to use, in a loom for weaving tufted fabrics, a tube frame having bearings for a plurality of tuft yarn carrying spools, and tuft yarn carrying spools arranged in such bearings, and I declare that what I claim is:—"

There is no objection to a patentee inserting (provided he does it fairly) what he believes to be a statement of prior knowledge. But he must not put any construction of his own on prior specifications. For example, after stating that certain materials have been treated before in a certain way, and to which process he makes no claim, the applicant may say: "For further details I refer to the specification of A."; but he must not state: "For instance, in the specification of A., flocks are introduced

into the milling machine along with the fabric, when by the action of the machine, the flock is felted and fastened into the fabric" *Re Atherton's Patent* (1889) 6 R. P. C. 547).

Special Disclaimers.—A later patentee ought not to be compelled to insert a special reference to the earlier specification of the opponent, unless it is practically admitted by the later applicant that the governing principle was, for the first time, discovered or disclosed in the opponents' specification (*per* Webster, A.-G., in *Re Welch's Patent* (1891) 8 R. P. C. at p. 443). "I have never considered," said Webster, A.-G., in *Re Guest's Patent* (1888) 5 R. P. C. at p. 315, "that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear that there is no other publication except the one that is mentioned." And see *Re Hill's Application* (1888) 5 R. P. C. at p. 601; *Re Norton's Application* (1900) 17 R. P. C. at p. 124; *Re Marsden's Patent* (1896) 13 R. P. C. at p. 88.

A special reference will not be required to be inserted where the applications for the two inventions are practically concurrent (*Re Greenhalgh's Application* (1897) 14 R. P. C. at p. 388), or where the reference is desired merely by way of calling attention to the existence of the prior patent (*Re Adam's Application* (1896) 13 R. P. C. 548).

Where it appears that the applicant's invention is a mere improvement upon the opponent's (*Hoskins' Patent* (1884) Griff. P. C. 291; *Re Norton's Application* (1900) 17 R. P. C. at p. 124; *Re Norman's Patent* (2) (1888) 5 R. P. C. 279; *Re Lorinstein's Application* (1894) 11 R. P. C. 348; *Re Marim's Application* (1894) 11 R. P. C. 314; *Re Adam's Application* (1896) 13 R. P. C. 548; *Re Thornborough's Patent* (1896) 13 R. P. C. 115), or where the prior patent is shown to be a master or pioneer patent (*Re Hoffman's Patent* (1890) 7 R. P. C. 92; (*Re Sachse's Application* (1900) 18 R. P. C. 221; *Re Hill's Application* (1888) 5 R. P. C. at p. 601; *Re Welch's Patent* (1891) 8 R. P. C. at p. 443), or where the applicant's main claim is shown to have been anticipated by the prior patent and the very minimum of invention is left (*Re Sachse's Application*, *supra*), a specific reference will be ordered.

An opponent who desires his patent to be construed as a master or pioneer patent, must bring the state of knowledge before the Comptroller (*Re Southwell's Application* (1899) 16 R. P. C. 361). But in cases where it appears that the applicant's

claim is for a mere minimum of invention, the position of a master patent is not to be discussed in any narrow spirit (*Re Sachse's Application* (1901) 18 R. P. C. 221).

In *Hoskins' Patent* ((1884) Griff. P. C. 291), where the applicant's invention was only an improvement on the opponent's, the form of special disclaimer was as follows: "This invention refers to improvements in the description of cots invented by G. N., for which invention a patent, No. ——, of ——, has been granted to him, and it consists, etc."

In *Re Newman's Patent* (2) ((1888) 5 R. P. C. 279), another case of an improvement, the disclaimer ran: "I am aware of the prior patent granted to R. A., dated ——, No. ——, and I do not claim anything described and claimed in the specification of that patent, and in particular I do not claim the apparatus as shown and described with reference to figure ——."

In *Re Lynde's Patent* ((1888) 5 R. P. C. 663), where the opponent's was shown to be a master patent, the following disclaimer was ordered: "I am aware of E.'s patent, No. ——, of ——, and do not claim anything claimed and described therein." The same form of disclaimer was inserted in *Re Wallace's Patent* (1888) 6 R. P. C. 134; and see *Re Hoffman's Patent* (1890) 7 R. P. C. 92.

In cases where the insertion of a disclaimer would unfairly prejudice the patent, a mere reference to the prior patent has been ordered instead of a disclaimer (see *Re Van Gelder's Patent* (1892) 9 R. P. C. 325; *Re Maxim's Application* (1894) 11 R. P. C. at p. 316).

The fact that the opponent's patent has expired is rather a reason for mentioning it than for not mentioning it (*Re Hall's Patent* (1888) 5 R. P. C. at p. 285).

The Law Officer, it seems, is not bound by a decision of the Court of Appeal, before the time for appealing to the House of Lords has expired, as to the construction of a prior specification (*Re Hoffman's Patent* (1890) 7 R. P. C. at p. 93).

Striking Out and Amending the Description and Claims.—In some cases a claim, and the description to which it relates, are ordered to be struck out (*Re Hall's Patent* (1888) 5 R. P. C. 283); and the insertion of a disclaimer may be required in addition (*Re Hamilton's Application* (1902) 19 R. P. C. at p. 35).

In *Re Hamilton's Application* (*supra*) Carson, S.-G., ordered four out of six claims to be struck out, and certain disclaimers to remain.

In *Teague's Patent* ((1884) Griff. P. C. 298), the opponent was

given the option of requiring the insertion of a special disclaimer or the omission of certain parts of the specification and drawings.

Amendments.—Sometimes a patent is sealed on condition that the claim or description is amended (see *Re Hill's Application* (1888) 5 R. P. C. 599). But amendments must not be considered as a matter of course (*Re Crist's Application* (1903) 20 R. P. C. 476). A specification ought to be so framed by the applicant in the first instance that a patent may properly be granted; and it is not at all a matter of course that, if the specification is presented in such a form that the patent cannot be granted without amendment, the necessary amendments will be made (*per* Finlay, S.-G., in *Re Thomas's Application* (1899) 16 R. P. C. at pp. 70, 71; and see *Re Lupton's Application* (1897) 14 R. P. C. at p. 262).

No amendment will be allowed which amounts to a claim to an invention which was not in the least the distinctive subject-matter which the applicant had in view when he filed his complete specification (*Re Harrild's Application* (1900) 17 R. P. C. at p. 619; and see *Re Crist's Application* (1903) 20 R. P. C. 475). The applicant will not be allowed to say: "True, what I have originally claimed, if you take it as it is stated, is anticipated, but I can show you that there is something else in addition, which is not anticipated, and I ask you, now that I have found out that I have been anticipated in the main claim, to allow the necessary changes in the specification to put forward the distinctive matter" (*Re Mills' Application* (1901) 18 R. P. C. at p. 324).

In a proper case, a patent may be sealed with a claim entirely differing from that in the specification as originally framed (*Re Harrild's Application* (1900) 17 R. P. C. at p. 619); but an amendment which practically amounts to the re-writing of the whole specification, and the formation of some new claim, will not be allowed (*Re Crist's Application* (1903) 20 R. P. C. at p. 476).

If the necessary disclaimer or excision would have the effect of leaving nothing which can properly form subject-matter for a patent, the patent will be refused (*Re Hedge's Application* (1895) 12 R. P. C. at p. 137).

3. *That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.*

This ground of opposition was given by the Patents Act, 1888. Under the law prior to that Act, an inventor might develop his invention in the interval between the leaving of the provisional and the complete specifications (see p. 70, *infra*); and the Act has made no alteration in the law in this respect (*Re Edwards' Patent* (1894) 11 R. P. C. 461).

Hence, a patent will not be refused on this ground where the additional matter included in the complete specification amounts only to an improvement on or to fair development of the invention disclosed in the provisional specification (*Re Millar's Application* (1898) 15 R. P. C. 718; *Re Edwards' Patent, supra*; *Re Anderson's Patent* (1890) 7 R. P. C. 323; and see p. 70, *infra*). But if the complete specification describes or claims an invention which is different to the invention disclosed in the provisional specification, the patent will be stopped, or will be granted only upon the condition that the complete specification is amended so as not to claim the extra invention (see *Wilson's Application* (1892) 9 R. P. C. 512, *n.*)

In *Re Birt's Application* ((1892) 9 R. P. C. 489), Webster, A.-G., asked for, and referred to, the applicant's original drawings, for the purpose of ascertaining what the applicant really intended by the words he used in his specifications.

Disconformity in Itself is no Ground of Objection.—Disconformity, *per se*, is no ground of objection to the grant of a patent (*Newman's Patent* (1888) 5 R. P. C. at p. 278; *Re Haythornthwaite's Application* (1890) 7 R. P. C. at p. 71); to stop a patent, the opponent must show that the complete specification not only describes or claims a different invention, but also that the different invention forms the subject of an application made by him in the interval between the filing of the two specifications.

Who may Oppose.

S. 11 (1) of the Act (see p. 40, *supra*) provides that "any person" may oppose on any of the three grounds. The question who may oppose on the first and third grounds involves no difficulty.

As to the second ground, viz., that the invention has been patented in this country on an application of a prior date, it has now been settled by the Court of Appeal that "any person" must be read as meaning only a person *interested* in the prior patent, and that a member of the public having no interest is not entitled to be heard, either before the Comptroller or the Law

Officer, in opposition to the grant of a patent (*R.* v. *Comptroller-General* (1899) 16 R. P. C. 234). But a person interested in one prior patent is entitled to rely in support of his opposition upon specifications other than those in which he is interested so long as they are germane to the particular question (*Re Stewart's Application* (1896) 13 R. P. C. 627; and see *Re J. and J.'s Application* (1902) 19 R. P. C. 555).

An agent for the grantee of a patent (*Heath's Patent* (1886) Griff. P. C. at p. 290), or a mere manufacturer under a patent (*Re Macrory's Patent* (1888) 5 R. P. C. 285; *Re Bairstow's Patent* (1888) 5 R. P. C. at p. 289; but see *Re Meyer's Application* (1899) 16 R. P. C. 526), is not entitled to be heard in opposition. But a licensee under a prior patent (*Re Hill's Application* (1888) 5 R. P. C. 599), or an assignee of a prior patent (see *Glossop's Patent* (1884) Griff. P. C. 285; *Re Marsden's Patent* (1896) 13 R. P. C. 87), may oppose.

A foreign patentee who is entitled to have his patent antedated under s. 103 of the Patents Act, 1883 (see p. 227, *infra*), so as to be prior in date to an application, is not entitled to oppose the application on the ground that the invention had been patented by him on an application of prior date (*Everitt's Application* (1888) 2 Griff. P. C. 28; but see *Re Main's Patent* (1888) 7 R. P. C. 13).

A person may oppose once the complete specification of the prior invention has been *accepted* (see p. 43, *supra*); and he may oppose although the prior patent has lapsed or expired (see p. 44, *supra*).

Bogus Oppositions.—Where an opposition is not a genuine one, but is entered merely for the purpose of delaying the sealing of the patent, the applicant runs a grave risk of entirely losing his patent, and the Law Officers will refuse to extend the time for sealing without satisfactory evidence that the proceedings are not collusive (*Re A. B.'s Application* (1902) 19 R. P. C. at p. 404; *Re A. B.'s Application* (1902) 19 R. P. C. 556). In the former case Carson, S.-G., said: "I am aware that this process has been resorted to for the purpose of extending the time in which the patent will be sealed, and that, as I understand it, for the purpose of enabling the necessary proceedings to be taken in America or other foreign countries, to ensure the patent being sealed there also in due time. . . . But I desire to say that, so far as I am concerned, I find no right whatsoever under the Act of Parliament that any such oppositions should be entered for this indirect

purpose; and I consider oppositions so entered a gross abuse, either by applicants for patents or by patent agents, of the proceedings in the Comptroller's office, and subsequently, when appeal is taken, in this department."

Procedure on Oppositions.

Notice of Opposition.—Notice of opposition must be given at the Patent Office within two months from the date of the advertisement of the acceptance of the applicant's complete specification (s. 11 (1) of the Patents Act, 1883). The notice must be on Form D. and must state the ground or grounds on which the opponent intends to oppose the grant, and must be signed by him. The notice must give an address for service within the United Kingdom, and must be accompanied by an unstamped copy, which copy must be transmitted by the Comptroller to the applicant (Patents Rules, 1903, Rule 32).

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 must be specified in the notice (Rule 35, *ibid.*).

Should the notice not be in the prescribed form, the Comptroller may give leave to amend it; for Rule 76 provides that any document for the amendment of which no special provision is made by the Acts may be amended. For examples of amendments which have been allowed, see *Re Daniel's Application* (1888) 5 R. P. C. 413; *Re Airey's Application* (1888) 5 R. P. C. 348.

Opponent's Evidence.—Where the ground of 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 a statutory declaration in support of such allegation is left at the Patent Office within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification, the opposition is deemed to be abandoned (Patents Rules, 1903, Rule 33). The Comptroller may request or allow any person who has made a statutory declaration in support of this allegation to attend before him at the hearing and make oral explanations with respect to such matters as the Comptroller may require (Rule 34, *ibid.*).

Except where the above ground is relied upon, statutory declarations need not be left in connection with an opposition; but the opponent may, within fourteen days after the expiration

of two months from the date of the advertisement of the acceptance of the applicant's complete specification, leave at the Patent Office statutory declarations in support of his opposition, and on so leaving must deliver copies thereof to the applicant (Rule 36, *ibid.*).

Applicant's Evidence.—Within fourteen days from the delivery of such copies, the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving must deliver to the opponent copies thereof (Rule 37, *ibid.*).

Evidence in Reply.—Within fourteen days from delivery of the applicant's copies, the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving must deliver to the applicant copies thereof. Declarations in reply must be confined to matters strictly in reply (Rule 37, *ibid.*).

No further evidence may be left on either side except by leave, or on the requisition, of the Comptroller (Rule 40, *ibid.*).

Evidence where Opponent leaves no Declarations.—If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within three months from the date of the advertisement of the acceptance of his complete specification, leave at the Patent Office statutory declarations in support of his application, and on so leaving must deliver copies thereof to the opponent (Rule 38, *ibid.*). Within fourteen days from the delivery of such copies, the opponent may leave at the Patent Office statutory declarations in answer, and on so leaving must deliver to the applicant copies thereof, and within fourteen days from such delivery the applicant may leave at the Patent Office his statutory declarations in reply, and on so leaving must deliver to the opponent copies thereof. The declarations in reply must be confined to matters strictly in reply (Rule 39, *ibid.*).

Enlargement of Time for Lodging Evidence.—The times prescribed by the Patents Rules, 1903, for lodging evidence, other than the times for lodging evidence referred to in Rule 33 (see p. 51, *supra*), may be enlarged by the Comptroller if he thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct (Rule 77, *ibid.*).

Power to Dispense with Evidence.—Where a person is unable to make any declaration required by the Rules, the Comptroller, with the sanction of the Board of Trade, may dispense with the evidence in certain circumstances (Rule 78, *ibid.*). See p. 31, *supra*.

Form of the Declarations.—The statutory declarations must be headed in the matter or matters to which they relate, and must be drawn in the first person, and divided into paragraphs consecutively numbered, and each paragraph must so far as possible be confined to one subject. Every declaration must state the description and true place of abode of the person making it, and must be written or printed bookwise, and must bear the name and address of the person leaving it, and must state on whose behalf it is left (Rule 25, *ibid.*).

The declaration may, in the United Kingdom, be made and subscribed before any Justice of the Peace, or any Commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding (Rule 26, *ibid.*).

Declarations should be confined to matters material to the issue; if the case is overlaid with unnecessary declarations, the costs will be fixed by the Law Officer on the party responsible for them (*Re Brand's Application* (1894) 12 R. P. C. 102; and see *Re Hedge's Application* (1895) 12 R. P. C. 136).

Specifications or models relied upon should be made exhibits; otherwise they cannot be received as evidence (*Lancaster's Patent* (1884) Griff. P. C. at p. 294; *Bailey's Patent* (1884) Griff. P. C. 269. But specifications or models not in evidence may be referred to for the purpose of better understanding the drawings (*Lancaster's Patent, supra*), or of ascertaining the state of knowledge at the date of the applicant's patent (*Jones's Application* (1885) 2 Griff. P. C. 34; and see Patents Rules, 1903, Rule 41, *infra*).

The Hearing.—On completion of the evidence, if any, or at such other time as he may see fit, the Comptroller must appoint a time for the hearing of the case, and must give the parties ten days' notice at the least of such appointment (Patents Rules, 1903, Rule 41).

If either party does not desire to be heard he must, as soon as possible, notify the Comptroller to that effect. If either party desires to be heard he must leave Form E. at the Patent Office; the Comptroller may refuse to hear either party who has not left that form prior to the date of the hearing (Rule 41, *ibid.*).

If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory declaration already filed, give to the other party and to

the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer (Rule 41, *ibid.*).

At the hearing the applicant begins; but where the opponent charges fraud, his evidence will be taken first, as the *onus probandi* is on him (*Luke's Patent* (1886) Griff. P. C. 294).

Either party may be represented by his agent, solicitor or counsel.

The Comptroller has no power to summon witnesses or to have the declarants cross-examined *viva voce* (*Hatfield's Patent* (1884) Griff. P. C. 288).

After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, the Comptroller must decide the case and notify his decision to the parties (Rule 41, *ibid.*).

Irregularity in Procedure.—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 (Rule 76, *ibid.*).

Costs.—The Comptroller has no power to award costs.

Appeal from Comptroller's Decision.—From the decision of the Comptroller an appeal lies to the Law Officer (s. 11 (2) of the Patents Act, 1883). For the procedure on such appeals, see p. 224, *infra*.

An appeal lies by an opponent against the mere refusal to require a reference to the opponent's patent (*Re Bromhill's Patent* (1888) 6 R. P. C. 135).

Only persons being, in the opinion of the Law Officer, "entitled to be heard" may be heard on an appeal (s. 11 (3) of the Patents Act, 1883); and the Law Officer is the final authority for determining whether a person is entitled to be heard, whether before the Comptroller or on appeal, in opposition to the grant of a patent (*R.* v. *Comptroller-General* (1899) 16 R. P. C. 233). As to the class of persons so entitled, see pp. 49, 50, *supra*.

CHAPTER IV.

The Specifications.

THE PROVISIONAL SPECIFICATION—THE COMPLETE SPECIFICATION—THE CLAIMS—CONSTRUCTION OF THE SPECIFICATION—AMENDMENT OF THE SPECIFICATION.

General Remarks.—An application for letters patent must be accompanied by either (*a*) a provisional specification or (*b*) a complete specification (s. 5 (2) of the Patents Act, 1883).

If a complete specification is left in the first instance no provisional specification is required. If a complete specification is not left with the application it may be left, at the present time, at any subsequent period within nine months from the date of application. But so soon as the Board of Trade by Order direct that s. 1 of the Act of 1902 is to come into operation, the complete specification will have to be left within six months from the date of application (see p. 29, *supra*).

Although a provisional specification is not published until the complete specification is published (see p. 36, *supra*), the invention may be used during the period between the date of application and the date of sealing without prejudice to the patent to be granted (s. 14 of the Patents Act, 1883).

Advantages in Leaving only a Provisional Specification in the First Instance.—If application is made in the first instance for provisional protection only, the chief advantages are that—(1) less immediate outlay is involved: (2) the inventor has nine months (when s. 1 of the Act of 1902 is in operation the time will be six months; see p. 29, *supra*) within which to perfect the details of his invention; (3) the inventor is enabled to test the commercial value of his invention at a trifling cost; (4) an inventor, who has reason to fear a prior application, may secure immediate protection in respect of an invention the details of which he has not as yet fully mastered; and (5) if the invention should prove unsatisfactory, the inventor may abandon his application without prejudice to a subsequent application (see p. 30, *supra*).

Disadvantages.—No proceedings for infringement can, however, be taken until the patent has been granted (s. 15 of the Patents Act, 1883), and then only for infringements committed after the publication of the complete specification (s. 13, *ibid.*). And the applicant cannot use the word "patent" or "patented," or any words representing that the invention is patented, until the complete specification has been lodged and accepted (see p. 39, *supra*).

The Provisional Specification.

The provisional specification, if any, must be left with the application (s. 5 (2) of the Patents Act, 1883; see p. 29, *supra*), and must

(1) Commence with the title (s. 5 (5), *ibid.*);
(2) Describe the nature of the invention (s. 5 (3), *ibid.*); and
(3) Be accompanied by drawings, if required (s. 5 (3), *ibid.*).

The Title.—S. 5 (5) of the Patents Act, 1883, provides that a specification, whether provisional or complete, must commence with the title; but this provision is directory only (see *Vickers* v. *Siddell* (1890) 7 R. P. C. at p. 306).

The title must sufficiently indicate the subject-matter of the invention (s. 6, *ibid.*). If it does not do so, the Comptroller may refuse to accept the application, or require an amendment; but an appeal lies from the Comptroller's decision to the Law Officer (s. 2 of the Patents Act, 1888).

Formerly, when no provisional specification had to be filed, the accuracy of the title was a matter of the utmost importance, as disconformity between the title and the specification was fatal to the validity of the grant. Now, the provisional specification bears to the complete specification much the same relation as that which, before the Patent Law Amendment Act, 1852, the title bore to the specification (see *per* Lord Chelmsford, L.C., in *Penn* v. *Bibby*, 2 Ch. at p. 133). The title now, therefore, is not of such importance; and few, if any, defective titles are passed by the Comptroller. In very few reported cases, since the introduction of a provisional specification, has a defective title been set up as a ground of objection to the validity of a patent, and in each case the objection has been rebutted (see *Pirrie* v. *York Street Co.* (1893) 10 R. P. C. at p. 45; *Dowling* v. *Billington* (1890) 7 R. P. C. at p. 200; *Shaw* v. *Jones* (1889) 6 R. P. C. at p. 335; *Leadbeater* v. *Kitchin* (1890) 7 R. P. C. at pp. 239, 240).

Nevertheless, should the Comptroller pass a title which does

not sufficiently indicate the subject-matter of the invention (*Pirrie* v. *York Street Co.*, *supra*; but see *Leadbeater* v. *Kitchin*, *supra*), it is conceived that objection could be taken to the validity of the patent on that ground, notwithstanding the reference to an Examiner (see *Vickers* v. *Siddell* (1890) 7 R. P. C. at p. 303).

Should an applicant desire to omit a part of the invention described by the title an amendment of the title is probably not necessary; a disclaiming clause might be inserted in the complete specification, indicating that part only of the invention originally covered by the title was intended to be claimed (*Dart's Patent*, Griff. P. C. at p. 308; and see *Brown's Patent* (1887) 2 Griff. P. C. 1). An amendment in the title and provisional should be confined to excision only, and the excision should be such as does not extend the scope of the title (*Dart's Patent*, *supra*).

Description of Nature of Invention.—The provisional specification must describe the nature of the invention. But it need not *particularly* describe the nature of the invention or the mode of performing it; the complete specification is left to do this (see p. 59, *infra*).

The office of the provisional specification is only to describe generally and fairly the nature of the invention. It need not enter into all the minute details as to the manner in which the invention is to be carried out (see *per* Byles, J., in *Re Newall & Elliot* (1858) 4 C. B. (N. S.) 269; *Lucas* v. *Miller* (1885) 2 R. P. C. at p. 159; *Pneumatic Tyre Co.* v. *East London Co.* (1897) 14 R. P. C. at pp. 98, 99), or contain such a description of the invention as will enable a skilled workman to make it (see *per* Jessel, M.R., in *Stoner* v. *Todd* (1876) 4 C. D. at p. 60; *per* Romer, J., in *Pneumatic Tyre Co.* v. *East London Co.* (1897) 14 R. P. C. at pp. 98, 99), or describe the nature of the invention otherwise than roughly, so long as it is fairly described (*Pneumatic Tyre Co.* v. *East London Co.*, *supra*, at p. 98; *United Telephone Co.* v. *Harrison* (1882) 21 C. D. at p. 747), or detail the particular advantages of the invention (*Pneumatic Tyre Co.* v. *East London Co.*, *supra*, at p. 99).

The 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 the ambit of his invention as disclosed in his provisional specification (*per* Lopes, L.J., in *Woodward* v. *Sansum* (1887) 4 R. P. C. at p. 178).

The function of the provisional is, therefore, to ascertain, not the entirety, but the *identity* of the invention (see *per* Smith, L.J., in *Cassel Co.* v. *Cyanide Syndicate* (1895) 12 R. P. C. at p. 257); it bears to the complete specification a relation similar to that which a writ of summons bears to the statement of claim. The inventor must describe his invention sufficiently to ear-mark it and enable it to be identified with the invention to be more particularly described in the complete specification (*Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 529).

The provisional specification must, however, be sufficiently comprehensive to include the invention comprised in the complete specification; if it does not the patent is altogether void (see p. 70, *infra*). Matters which are contained in the complete, and not in the provisional, must, therefore, be matters of detail only. But a part of the invention comprised in the provisional may be omitted in the complete (see p. 71, *infra*).

The Drawings.—A provisional specification is very seldom accompanied by drawings; but there may be cases in which it is expedient, if not essential, that drawings should be left in order that the specification may include all that the applicant may desire to claim in his complete specification. Where drawings accompany the provisional specification, the complete specification need not be accompanied by drawings, but may refer to the drawings which accompanied the provisional specification (s. 2 of the Patents Act, 1886). The subject of drawings is fully considered later (see pp. 64, 65, *infra*).

The Complete Specification.

The complete specification may be left with the application for letters patent (see p. 29, *supra*), or, at the present time, within nine months from the date of the application (s. 8 (1) of the Patents Act, 1883). But so soon as the Board of Trade by Order direct that s. 1 of the Patents Act, 1902, is to come into operation, the specification will have to be left within six months from the date of the application (s. 1 (8) of the Patents Act, 1902: see p. 29, *supra*).

Requirements as to Contents.—The complete specification must—

(1) Commence with the title.

(2) Particularly describe and ascertain the nature of the invention (see *infra*).

(3) Particularly describe and ascertain in what manner the invention is to be performed (see p. 61, *infra*).

(4) Be accompanied by drawings, if required (see p. 64 *infra*).

(5) Make a full disclosure (see p. 66, *infra*).

(6) Not contain any misleading suggestion (see p. 68, *infra*).

(7) Not be ambiguous (see p. 69, *infra*).

(8) Conform with the provisional specification (see p. 70, *infra*).

(9) End with a distinct statement of the invention claimed (see p. 72, *infra*).

(1) **Title.**—This requirement has already been dealt with (see p. 56, *supra*).

(2) **Description of Nature of Invention.**—A complete specification, whether left on application or subsequently, must *particularly* describe and ascertain—(1) the nature of the invention; and (2) in what manner it is to be performed (s. 5 (4) of the Patents Act, 1883).

These two requirements, although often confused and overlapping, are really distinct, and it is always necessary to keep clearly before one's mind, and not to commit the mistake of supposing, that compliance with one is necessarily compliance with the other. One set of words may sufficiently disclose both the nature of the invention and the mode of performing it; but in a well-drawn specification the two conditions are kept distinct (see *per* Lindley, L.J., in *Edison* v. *Holland* (1889) 6 R. P. C. at pp. 279, 280; *per* Grove, J., in *Philpott* v. *Hanbury* (1885) 2 R. P. C. at p. 38).

The first condition imposes upon the patentee the necessity of stating in clear and intelligible language what his invention really is, so that others may know what addition the patentee has made to what was known before, so that they may know what they are not at liberty to do without his consent during the existence of the patent; in other words, so that they may know what the monopoly is that is granted to the patentee (see *per* Lindley, L.J., in *Edison* v. *Holland*, *supra*; *per* Grove, J., in *Philpott* v. *Hanbury*, *supra*).

The second condition (see pp. 61—64, *infra*) imposes upon the patentee the necessity of stating in clear and intelligible language, in what manner the patented invention is to be performed, so that others may learn from the specification how practically to avail themselves of the patented invention when the patent has expired; how they are to do what is necessary to carry out the new invention, the nature of which has been previously disclosed (see *per* Lindley, L.J., in *Edison* v. *Holland*, *supra*; *per* Grove, J., in *Young* v. *Rosenthal* (1884) 1 R. P. C. at pp. 31, 32).

With reference to the degree of clearness and distinctness of the language necessary to be used to comply with these conditions, it is obvious that no hard-and-fast rule can be laid down; the degree of clearness can only be stated in language which itself admits of considerable latitude in its application. On the one hand, the patentee must make the nature of his invention, and how to perform it, clear and intelligible; on the other hand, it is not necessary for him to instruct persons wholly ignorant of the subject-matter to which his invention relates in all that they must know before they can understand what he is talking about (*per* Lindley, L.J., in *Edison* v. *Holland* (1889) 6 R. P. C. at pp. 279, 280; *per* Grove, J., in *Philpott* v. *Hanbury* (1885) 2 R. P. C. at p. 38; and see p. 61, *infra*).

What is Sufficient Description.—In complying with the first requirement, *i.e.*, in describing the nature of his invention, the patentee does all that is necessary, if he makes the nature of his invention plain to persons having a reasonable competent knowledge of the subject, although from want of skill they could not themselves practically carry out the invention (*per* Lindley, L.J., in *Edison* v. *Holland*, *supra*). He must state the nature of his invention in reasonably accurate language (*per* Grove, J., in *Philpott* v. *Hanbury* (1885) 2 R. P. C. at p. 38), and should clearly point out what the object of his invention is (*Allen* v. *Duckett* (1893) 10 R. P. C. 397); but he need not describe the pith and marrow of his invention (*per* Vaughan Williams, L.J., in *Bunge* v. *Higginbottom* (1902) 19 R. P. C. at p. 193).

The test of sufficiency is—"Is the specification such that a fair man, willing or wishing to understand the specification, can reasonably gather from it what the patentee considers his invention and what he says he prohibits the public from using?" (*per* Grove, J., in *Philpott* v. *Hanbury* (1885) 2 R. P. C. at p. 38; and see *per* Alderson, B., in *Morgan* v. *Seaward* (1836) 1 W. P. C. at

p. 173). If "No," then the patent is altogether bad (*Philpott* v. *Hanbury*, *supra*; *Allen* v. *Duckett* (1893) 10 R. P. C. 397).

(3) **Description of Mode of Performing the Invention.**—In complying with the second requirement, *i.e.*, in describing in what manner the invention is to be performed, the patentee does all that is necessary if he makes it plain to persons having reasonable skill in doing such things as have to be done in order to work the patent, what they are to do in order to perform his invention. If, as may happen, they are to do something the like of which has never been done before, he must tell them how to do it, if a reasonable competent workman would not himself see how to do it on reading the specification, or on having it read to him (*per* Lindley, L.J., in *Edison* v. *Holland* (1889) 6 R. P. C. at p. 280).

The description need not be such as will enable a person *wholly ignorant* of the subject-matter to carry out the invention (see *per* Jessel, M.R., in *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 568). "No sort of specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch" (*per* Lord Ellenborough, C.J., in *Harmar* v. *Playne* (1809) 11 East, at p. 108).

On the other hand, the description must be something more than that which would only enable persons of *exceptional skill* to perform the invention; because those persons would, upon a mere hint in the specification, probably *invent* a machine which would answer the purpose extremely well (see *per* Parke, B., in *Neilson* v. *Harford* (1841) 1 W. P. C. at p. 314; and see *per* Jessel, M.R., in *Plimpton* v. *Malcolmson* (1876) 3 C. D. at pp. 568, 569).

To whom the Specification is Addressed.—The persons to whom the specification is addressed are *artisans of ordinary skill in the particular art or manufacture to which the invention relates* (see *per* Lord Cairns, L.C., in *British Dynamite Co.* v. *Krebs* (1896) 13 R. P. C. at p. 192; *per* Lord Halsbury, L.C., in *Tubes* v. *Perfecta Co.* (1903) 20 R. P. C. at p. 96; *Lister* v. *Norton* (1886) 3 R. P. C. at p. 203; *Plimpton* v. *Malcolmson* (1876) 3 C. D. at pp. 568, 569; *Neilson* v. *Harford* (1841) 1 W. P. C. at pp. 314, 315). A specification for improvements in gas-motor engines is addressed to gas-motor engine makers and workers, and not to the public outside; consequently you do not require the same amount of minute information that you would in the case of a totally new machine, applicable to a totally new kind of manufacture (*per* Jessel, M.R., in *Otto* v. *Linford* (1882) 46 L. T. (N. S.) at p. 41).

THE SPECIFICATION MUST NOT LEAVE PERSONS TO EXPERIMENT OR INVENT.—If the description of the mode of performing the invention is not sufficient to enable a workman possessed of ordinary skill in the particular industry to obtain the desired result without fresh experiment or research, or without the exercise of his inventive faculties, it will be bad, and the patent invalid (see *per* Lord Halsbury in *Badische* v. *Levinstein* (1887) 4 R. P. C. at pp. 462, 463; *Bradford Dyers* v. *Bury* (1902) 19 R. P. C. at p. 7; *Simpson* v. *Holliday* (1866) L. R. 1 H. L. at pp. 320, 321; *Wegmann* v. *Corcoran* (1878) 13 C. D. at p. 65). The specification may call upon a workman to exercise all the actual existing knowledge common to the trade (*Lane-Fox* v. *Kensington Electric Co.* (1892) 9 R. P. C. at p. 247); but it must not call upon him to exercise his invention or ingenuity (*Lane-Fox* v. *Kensington Electric Co.*, *supra*; *Morgan* v. *Seward* (1836) 1 W. P. C. at p. 174; *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 569), or to make experiments (*R.* v. *Wheeler* (1819) 2 B. & Ald. at pp. 353, 354; *Hinks* v. *Safety Co.* (1876) 4 C. D. 607; *Wegmann* v. *Corcoran* (1878) 13 C. D. 65: and see the other cases quoted above); and—to use the words of Sir George Jessel in *Plimpton* v. *Malcolmson* (*supra*) taken from those of Baron Alderson—it must not "take the form of a problem" (see *per* Smith, J., in *Lane-Fox* v. *Kensington Electric Co.* (1892) 9 R. P. C. at p. 248).

INFORMATION AS TO COMMON DETAILS NEED NOT BE GIVEN.—An inventor, however, need not give any directions respecting details which the persons to whom the specification is addressed must be assumed to know (*Kane* v. *Boyle* (1901) 18 R. P. C. at pp. 335, 336; *British Dynamite Co.* v. *Krebs* (1896) 13 R. P. C. 190; *Re Goulard's Patent* (1889) 6 R. P. C. at p. 224; *Badische* v. *Levinstein* (1887) 4 R. P. C. at p. 463; *Leonhardt* v. *Kalle* (1895) 12 R. P. C. 103; *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 570. For instance, the specification of an invention for an improved gas machine need not give any directions respecting a condenser; for a workman who is accustomed to construct gas apparatus will know that he must put in a condenser (see *Crossley* v. *Beverley* (1829) 1 W. P. C. at p. 110, *n.*). And in the specification of an invention relating to a supply of electricity from dynamos worked in series with alternating currents, the inventor need not tell the public to *rigidly* couple the dynamos; for any workman of ordinary skill who would be employed to put up the dynamos would know that the dynamos

must keep time, and that the ordinary mode of effecting this would be a rigid coupling (*Hopkinson* v. *St. James's Electric Co.* (1893) 10 R. P. C. at pp. 61, 62).

"If a patentee says that something must be done, which a reasonable competent man would know how to do, the patentee need not tell him how to do it, nor warn him to be careful, and to exercise such forethought and attention as the delicacy of the process to be used, or the material to be employed, plainly demand. . . . The fact that a workman may use a wrong tool when he has a right one, which a little thought will lead him to see ought to be used, does not warrant the inference that a specification is bad if it does not tell him what tool to use" (*per* Lindley, L.J., in *Edison* v. *Holland* (1889) 6 R. P. C. at p. 282).

Test of Sufficient Description.—It is very difficult to describe in words the distinction between an amount of practice, without which failure is probable, but the necessity for which does not destroy a patent, and an amount of experiment and invention, without which failure is certain, and the necessity for which destroys a patent. The test by which to decide such a question is to be found by asking whether anything new has to be found out by a person of reasonable competent skill, in order to succeed, if he follows the directions contained in the specification. If "Yes," the patent is bad; if "No," it is good so far as this point is concerned (see *per* Lindley, L.J., in *Edison* v. *Holland* (1889) 6 R. P. C. at p. 282).

All the Modes of Operation need not be Stated.—A patentee need not describe *every* method known to him of carrying his invention into practical effect (see *Coles* v. *Baylis* (1886) 3 R. P. C. at p. 182; *Patents Exploitation* v. *Siemens* (1903) 20 R. P. C. 225), or all the materials or substances which will answer his purpose (see *Bickford* v. *Skewes* (1839) 1 W. P. C. at p. 218; *Leonhardt & Co.* v. *Kallé & Co.* (1895) 12 R. P. C. at p. 116); he is not bound to make a catalogue of mechanical equivalents (*Sandoe* v. *Szalay* (1904) 21 R. P. C. at p. 337). But the *best* method known to him of performing his invention must be stated; if it is not, the Crown will have been deceived in its grant, and his patent will be bad (see p. 67, *infra*).

Proportions.—And when dealing with new proportions of materials or ingredients, although he should state which are the best proportions (see p. 67, *infra*; *cf. British Dynamite Co.* v. *Krebs* (1896) 13 R. P. C. at p. 192), the patentee need not limit himself

to definite proportions (see *Neilson* v. *Betts* (1871) L. R. 5 H. L. at p. 21; *Otto* v. *Linford* (1882) 46 L. T. (N. S.) at p. 41). If he does, others who use different proportions may be held not to infringe his patent (see *Macnn* v. *Anderson* (1898) 15 R. P. C. 121).

Effect of Errors in Description.—An error which appears on the face of the specification, or the drawings which it refers to, or which would be at once discovered in following out the instructions given, will not vitiate the patent (see *Miller* v. *Searle, Barker* (1893) 10 R. P. C. at p. 111; *Simpson* v. *Holliday* (1866) L. R. 1 H. L. at pp. 320, 321; *Otto* v. *Linford* (1882) 46 L. T. (N. S.) 35). But it is otherwise if the error was only discoverable by further experiment or inquiry, or if it amounts to a false suggestion (see *Simpson* v. *Holliday, supra*; *Hinks* v. *Safety Co.* (1876) 4 C. D. at pp. 616, 617; *Wegmann* v. *Corcoran* (1879) 13 C. D. at p. 90).

(4) **The Drawings.**—The complete specification must be accompanied by drawings, if required (s. 5 (1) of the Patents Act, 1883). It may, however, refer to the drawings which accompanied the provisional specification (s. 2 of the Patents Act, 1886), in which case the complete specification should refer to the drawings as they left with the provisional specification (Patents Rules, 1903, Rule 24).

No drawings are necessary where the invention can be carried into effect without them (*Savage* v. *Harris & Son* (1896) 13 R. P. C. at p. 93). But in the case of complicated mechanism, drawings are most desirable, if not absolutely essential: for "it is impossible not to recognise the fact that there are difficulties in the use of human language which become aggravated when you are dealing with complex machinery, and, indeed, unless the Patent Law allowed people to eke out their descriptions by giving plates and pictures of what it is they do, in some cases it would be almost hopeless to expect that you could, with sufficient precision, mark out the boundaries of thought for that which you intended to claim as the subject-matter of your invention" (*per* Lord Halsbury, L.C., in *Tubes* v. *Perfecta Co.* (1903) 20 R. P. C. at p. 96).

The drawings form part of the specification (*Macfarland* v. *Price*, 1 W. P. C. 74, *n.*; *Taylor* v. *Annand* (1900) 17 R. P. C. at p. 137; *Miller* v. *Searle, Barker* (1893) 10 R. P. C. at p. 111). They may be called in aid of it (*Mathews* v. *Parmenter* (1896) 13 R. P. C. at p. 519; *Bloxam* v. *Elsee* (1825) 1 Car. & P. 558); and may limit the generality of the claim (see *British Motor Co.* v.

Friswell (1901) 18 R. P. C. at p. 506). But the drawings are subsidiary to the verbal description, and they cannot be relied upon as a description of a material part of an invention if the specification omits all reference to that part (*Hattersley* v. *Hodgson* (1903) 20 R. P. C. 591; *Clark* v. *Adie* (1877) 2 A. C. 315; and see *Otto* v. *Linford* (1882) 46 L. T. (N. S.) 35).

Effect of Errors in Drawings.—An *obvious* error in a drawing will not vitiate the patent (*Otto* v. *Linford* (1882) 46 L. T. (N. S.) 35; *Miller* v. *Searle, Barker* (1893) 10 R. P. C. at p. 111; *cf. Hinks* v. *Safety Co.* (1876) 4 C. D. 607).

Rules as to Drawings.—When drawings are furnished the following of the Patents Rules, 1903, must be observed:—

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

19. Drawings must be made on pure white, hot-pressed, rolled, or calendered drawing paper of smooth surface, good quality, and medium thickness. Mounted drawings, and drawings on toned paper or Bristol or other board, must not be used. Drawings must be on sheets which measure 13 inches from top to bottom, and are either 8 inches or 16 inches wide, the narrower sheets being preferable. Each sheet should be provided with a border line half an inch from the edge of the paper, and the figures should be placed in an upright position. If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary, and the figures should be numbered consecutively throughout.

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

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

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

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

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

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

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

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

21. Drawings must bear the name of the applicant (and, in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the left-hand top corner; the number of sheets of drawings sent, and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter should appear on the drawings.

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

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

23. Drawings must be delivered at the Patent Office free from folds, breaks, or creases.

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

(5) **Disclosure.**—It is a principle of Patent Law that there must be the utmost good faith in the specification (*per* Lord Lyndhurst, L.C., in *Sturtz* v. *De La Rue*, 1 W. P. C. 83). For "patents are to be considered as bargains between the inventor and the public, to be judged of on the principles of good faith, by making a fair disclosure of the invention, and to be construed as other bargains" (*per* Alderson, B. in *Neilson* v. *Harford*, 1 W. P. C. at p. 341; and see *per* Lord Halsbury in *Tubes* v. *Perfecta Co.* (1903) 20 R. P. C. at p. 95). To support a patent, therefore, it is necessary that the specification should make a full and fair disclosure. "If the patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad" (*per* Bayley, J. in *Lewis* v. *Marling*

(1829) 1 W. P. C. at p. 496; and see *per* Buller, J. in *R.* v. *Arkwright* (1785) 1 W. P. C. at p. 66). But this must be taken to mean a suppression of things *material* for the public to know (see p. 62, *supra*); and if the patentee makes a full and fair communication *so far as his knowledge at the time extends*, he has done all that is required (*per* Bayley, J. in *Lewis* v. *Marling*, *supra*).

Best Mode of Operation must be Stated.—The patentee must, in the first place, state the best method known to him of carrying out his invention (see *per* Lindley, L.J., in *Edison* v. *Holland* (1889) 6 R. P. C. at p. 282). He must disclose the means of producing his invention in equal perfection, and with as little expense and labour, as it costs him himself (*Wood* v. *Zimmer*, 1 W. P. C. 82, *n.*) If he can perform his invention in one way more beneficial than another, he must disclose the more beneficial mode (*British Dynamite Co.* v. *Krebs* (1896) 13 R. P. C. at p. 195; *Thomson* v. *Batty* (1889) 6 R. P. C. at p. 101). But where the patentee discloses several modes of carrying his invention into effect, it is not incumbent upon him to distinguish their respective advantages (*Badische* v. *Levinstein* (1887) 4 R. P. C. 449).

Cheapest Method must be Stated.—He must also state the cheapest materials or ingredients with which the patented article can be produced (*Turner* v. *Winter* (1787) 1 W. P. C. at pp. 81, 82; *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 580); and if the materials or ingredients directed to be used can only be obtained abroad, that fact should be mentioned (*Stutz* v. *De La Rue*, 1 W. P. C. 83).

Improvements must be Stated.—Moreover, the patentee must disclose any improvement discovered by him subsequently to lodging his provisional specification (*Crossley* v. *Beverley* (1830) 1 W. P. C. at p. 117; and see p. 70, *infra*).

Everything Material must be Stated.—In short, the patentee must communicate everything material for the public to know. If anything that gives an advantageous operation to the thing invented be concealed, the specification is void (*Wood* v. *Zimmer*, 1 W. P. C. 82, *n.*; *Tetley* v. *Easton* (1852) Macr. P. C. at p. 76: *Lewis* v. *Marling* (1829) 1 W. P. C. at p. 496; *Allen* v. *Duckett* (1893) 10 R. P. C. at p. 401).

In *Liardet* v. *Johnson* (1778) 1 W. P. C. 53), a patent for trusses for ruptures was held void because the patentee omitted to state

what was very material for tempering steel, namely, rubbing it with tallow. In *Morgan* v. *Seaward* ((1836) 1 W. P. C. at p. 182), Alderson, B., informed the jury that the specification should have stated, which it did not, that a slight difference in the length of certain rods was necessary to successfully perform the patented invention. In *Sturtz* v. *De La Rue* (1 W. P. C. 83), the grant was declared void because the patent omitted to state that certain materials directed to be used could only be obtained on the Continent.

Disclosure by Accident.—It is, doubtless, no objection to the validity of a patent to show that some essential material or ingredient was disclosed by a mere accident or fluke (see *per* Vaughan Williams, L.J., in *Badische* v. *La Société Chimique* (1898) 15 R. P. C. at p. 368).

Disclosure by Agents.—Where an agent takes out a patent for a foreign inventor, the specification need only state the best means of carrying out the invention known to the *agent*; for the agent is the patentee, and what the law requires is that the *patentee* shall tell the public what he knows (*Plimpton* v. *Malcolmson* (1876) 3 C. D. at pp. 582, 583; *Wegmann* v. *Corcoran* (1879) 13 C. D. 65). But if the original inventor has not told the agent enough to enable him so to describe the invention as that it can be constructed by the aid only of the specification, the patent will, of course, be invalid (*Wegmann* v. *Corcoran*, *supra*).

(6) **Misleading Suggestions.**—As there must be the utmost good faith in the specification (see p. 66, *supra*), it follows that, if in the specification there is anything which tends to mislead the public, the patent is void (see *per* Ashurst, J., in *Turner* v. *Winter* (1787) 1 W. P. C. at p. 80; *Re Owen's Patent* (1899) 17 R. P. C. 68; *Crompton* v. *Ibbotson*, 1 W. P. C. 83).

The patent will be void if the mode, or even one of the modes, directed by the specification, does not produce the desired result (*R.* v. *Cutler* (1848) Macr. P. C. 137; *Turner* v. *Winter* (1787) 1 W. P. C. at p. 81; *Monnett* v. *Beck* (1897) 14 R. P. C. 777), or if the specification states as necessary to perform the invention something which is not necessary (*R.* v. *Arkwright* (1785) 1 W. P. C. at p. 70; *Lewis* v. *Marling* (1829) 1 W. P. C. at p. 496; *Re Owen's Patent* (1899) 17 R. P. C. 68), or if the specification suggests that the invention may be made from materials or substances which will not answer the purpose (*Crompton* v. *Ibbotson*, 1 W. P. C. 83; *Sturtz* v. *De La Rue*,

1 W. P. C. 83; *Simpson* v. *Holliday* (1866) L. R. 1. H. L. 315), or if the specification leads the public to suppose that a laborious process is necessary to the production of the patented article when, in fact, it is not (*Savory* v. *Price*, 1 W. P. C. 83), or if the specification specifies certain proportions of materials or ingredients which will not do (*Pooley* v. *Pointon* (1885) 2 R. P. C. at p. 172), or if the specification represents that the machine described is capable of doing more than it really can (*Crossley* v. *Potter* (1853) Macr. P. C. at p. 245). But a patent is not bad merely because the most sanguine expectation of the patentee as to a favourable result is not realised in full (*Saccharin Corpn.* v. *Chemicals Co.* (1900) 17 R. P. C. at p. 38).

(7) **Ambiguity.**—"The object of the specification is, that it is the price which the party who obtains the patent pays for it, and it would be a hard bargain on the part of the public if he were allowed to clothe his discovery and his description in characters so dark and so ambiguous, that no one could make from it when the fourteen years have expired, and he should not have paid the price for which he enjoyed the exclusive privilege, but that he should have it in his own hands still for as long a period as he chooses; and, therefore, it is always a proper answer, when a patent is set up, to say that you have not so described it, that it may be understood" (*per* Tindal, C.J., in *Walton* v. *Potter* (1841) 1 W. P. C. at pp. 595, 596).

Hence, it is incumbent on a patentee to describe his invention in the clearest and most unequivocal terms of which the subject is capable; and if it appears that there is any unnecessary ambiguity affectedly introduced into the specification, the patent is void (see *per* Ashurst, J., in *Turner* v. *Winter* (1787) 1 W. P. C. at p. 80; *Galloway* v. *Bleaden* (1839) 1 W. P. C. at p. 524). The patentee must be explicit in the words which he uses (*per* Farwell, J., in *Glover* v. *American Steel Co.* (1902) 19 R. P. C. at p. 109). He must not give people a mechanical problem and call it a specification (*per* Jessel, M.R., in *Plimpton* v. *Malcolmson* (1876) 3 C. D. at p. 576).

A patentee may invalidate his grant by leaving the persons to whom the specification is addressed (see p. 61, *supra*) in doubt as to what is the object of his invention (*Hastings* v. *Brown* (1855) 22 L. J. Q. B. 161; *Allen* v. *Duckett* (1893) 10 R. P. C. at pp. 400, 401; *Gandy* v. *Reddaway* (1885) 2 R. P. C. 49; and see p. 60), or as to the manner in which it is to be performed (*Bradford Dyers* v. *Bury* (1901) 19 R. P. C. at p. 7; and see

p. 61, *supra*), or as to what materials or ingredients are to be used (see *Gandy* v. *Reddaway* (1885) 2 R. P. C. at p. 54; *Sturtz* v. *De La Rue*, 1 W. P. C. 83; *Turner* v. *Winter* (1787) 1 W. P. C. 77; *Crompton* v. *Ibbotson*, 1 W. P. C. 83; *Derosne* v. *Fairie* (1835) 1 W. P. C. at pp. 157, 158; *Glover* v. *American Steel Co.* (1902) 19 R. P. C. at pp. 109, 110).

(8) **Disconformity.**—If the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification, the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction (s. 9 (2) of the Patents Act, 1883; and see p. 33, *supra*).

It was contended in *Vickers* v. *Siddell* ((1890) 7 R. P. C. 292) that the new machinery of the Comptroller and Examiner (see p. 32, *supra*) has superseded the power of raising any objection to the validity of a patent on the ground of disconformity. But Lord Halsbury, L.C., there said (at p. 303) that he was unable to take that view. The Court of Appeal decided, in the later case of *Nuttall* v. *Hargreaves* ((1891) 8 R. P. C. 450), that disconformity is still fatal to the validity of a patent grant; and in *Castner-Kellner Co.* v. *Commercial Corpn.* ((1900) 17 R. P. C. 593) the House of Lords held a patent invalid for disconformity.

A patentee, therefore, will still invalidate his grant if he claims in his complete specification an invention which is different from that disclosed in his provisional specification.

In deciding whether a complete specification goes beyond the limits allowed by law, two questions only have to be considered, viz.: (1) What is the nature of the invention for which the patentee had obtained provisional protection? and (2) Is what is described in the complete specification an invention of a different nature from the former? (*per* Lindley, L.J., in *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 526). If the invention set out and claimed by the complete specification is an invention different from the invention set out in the provisional specification, the patent is bad (*Watling* v. *Stevens* (1886) 3 R. P. C. at p. 151; *Bailey* v. *Roberton* (1878) 3 A. C. 1055).

Improvements may be Introduced.—An inventor may, in fact it is his bounden duty to, introduce into his complete specification any improvement discovered by him between the date of his application and the date of lodging his complete specification (see *Crossley* v. *Beverley* (1830) 1 W. P. C. at p. 117; *Miller* v. *Scarle, Barker* (1893) 10 R. P. C. at p. 111;

Pneumatic Tyre Co. v. *Ixion Tyre Co.* (1897) 14 R. P. C. at p. 869; *Crompton* v. *Patents Investment Co.* (1888) 5 R. P. C. at p. 397; *Woodward* v. *Sansum* (1887) 4 R. P. C. 166; *Lucas* v. *Miller* (1885) 2 R. P. C. 155; *Pneumatic Tyre Co.* v. *East London Co.* (1897) 14 R. P. C. at pp. 100, 573). But he cannot, under colour of an improvement, obtain the advantages of provisional protection for an invention the nature of which he has not described in his provisional specification (see *per* Lindley, L.J., in *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 526).

NEW MODES OF OPERATION MAY BE INTRODUCED.—And the patentee is not tied down to the particular methods of obtaining his object as described in the provisional specification; so long as the methods described in the complete specification are really *within the invention* disclosed in the provisional specification, the former methods may differ from the latter without invalidating the grant (see *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 526; *Woodward* v. *Sansum* (1887) 4 R. P. C. at p. 177; *Watling* v. *Stevens* (1886) 3 R. P. C. 147; *Ward* v. *Hill* (1903) 20 R. P. C. at pp. 201, 203; *Re Geipel's Patent* (1904) 21 R. P. C. at. p. 389; *Siddell* v. *Vickers* (1888) 5 R. P. C. at p. 426).

EFFECT OF ABANDONING PART OF THE INVENTION.—The abandonment in the complete specification of a part of the invention comprised in the provisional specification does not affect the validity of the patent (*Pneumatic Tyre Co.* v. *East London Co.* (1896) 14 R. P. C. at pp. 98, 573; *Thomas* v. *Welch* (1866) 1 C. P. at p. 201; *Re Goulard's Patent* (1888) 5 R. P. C. 525; *Ward* v. *Hill* (1903) 20 R. P. C. at p. 200). The abandonment is a notification to the public that the inventor could not work or thought useless the part omitted (*Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 342), and others may use the part omitted without infringing the patent (*Sandow* v. *Szalay*, *supra*, at p. 345). But if that which is omitted goes to the *essence* of the invention, the omission will amount to disconformity (see *per* Vaughan Williams, L.J., in *Ward* v. *Hill* (1903) 20 R. P. C. at p. 198).

ATTITUDE THE COURT ADOPTS.—Having regard to the provisions made for the comparison of the two documents by an Examiner (see p. 32, *supra*), the Court will not decide against the validity of a patent on the ground of disconformity, unless the invention described in the complete specification is

unmistakably different from that disclosed in the provisional specification. If a case is on the border line, the patent ought to be held good rather than bad (see *per* Lindley, L.J., in *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 527; *Chadburn* v. *Mechan* (1895) 12 R. P. C. at p. 135).

Disconformity may be Cured by Amendment.—Disconformity may be cured by amendment (see *Moser* v. *Marsden* (1896) 13 R. P. C. 24); but the amendment must, of course, be such as entirely removes the defect (see *Lane-Fox* v. *Kensington Electric Co.* (1892) 9 R. P. C. 413).

Reported Cases.—For examples of patents held void on the ground of disconformity, see, in addition to the case quoted above, *United Telephone Co.* v. *Harrison* (1882) 21 C. D. 720; *Brooks* v. *Lamplugh* (1898) 15 R. P. C. 33; *Osmonds* v. *Balmoral Co.* (1898) 15 R. P. C. 505; *Tubeless Tyre* v. *Trench Tyre Co.* (1899) 16 R. P. C. 291; *Cera Co.* v. *Dobbie* (1892) 11 R. P. C. 10; *Castner-Kellner Co.* v. *Commercial Corpn.* (1900) 17 R. P. C. 593; *Savage* v. *Brindle* (1900) 17 R. P. C. 228; *Adams* v. *Stevens* (1898) 16 R. P. C. 225; *Nuttall* v. *Hargreaves* (1891) 8 R. P. C. 450; *Magee* v. *Tangyes* (1896) 14 R. P. C. 255.

For examples of patents attacked but not held void on this ground, see *Watling* v. *Stevens* (1886) 3 R. P. C. 147; *Ward* v. *Hill* (1903) 20 R. P. C. 189; *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. 516; *Re Geipel's Patent* (1904) 21 R. P. C. 379; *Sutcliffe* v. *Abbott* (1902) 20 R. P. C. 50; *Lucas* v. *Miller* (1885) 2 R. P. C. 155; *Moseley* v. *Victoria Co.* (1887) 4 R. P. C. 241; *Crompton* v. *Patents Investment Co.* (1889) 6 R. P. C. 287; *Pneumatic Tyre Co.* v. *Ixion Tyre Co.* (1897) 14 R. P. C. 853; *Newall* v. *Elliot* (1858) 4 C. B. (N. S.) 269; *Pneumatic Tyre Co.* v. *East London Co.* (1897) 14 R. P. C. 573; *Birmingham Tyre Syndicate* v. *Reliance Co.* (1902) 19 R. P. C. 298.

(9) **The Claims.**—The complete specification "must end with a distinct statement of the invention claimed" (s. 5 (5) of the Patents Act, 1883). A "distinct statement" means something more than a separate paragraph." "I think," said Lopes, L.J., in *Siddell* v. *Vickers* (1888) 5 R. P. C. at p. 433, "the Legislature contemplated a distinct summary of the main features of the invention, something to which the reader might readily refer and learn therefrom, without referring to the body of the specification what the characteristic features of the invention claimed were."

The claim, however, is a part of the specification (*Tubes* v. *Perfecta Co.* (1903) 20 R. P. C. at p. 99), and must be read and construed with reference to the body of the specification, and not as if it was an isolated sentence having no connection with or reference to that which precedes it (see *per* Lindley, L.J., in *Edison* v. *Woodhouse* (1887) 4 R. P. C. at p. 107; *Electric Construction Co.* v. *Imperial Tramways* (1899) 16 R. P. C. at p. 638; *Edison-Bell* v. *Smith* (1894) 11 R. P. C. 389).

Office of the Claim.—The office of the claim is to define and limit with precision what it is which is claimed to have been invented and therefore patented (*per* Lord Chelmsford in *Harrison* v. *Anderston Foundry Co.* (1876) 1 A. C. at p. 581). The claim is "not intended to be any description of the means by which the invention is to be performed, but introduced for the security of the patentee, that he may not be supposed to claim more than what he can support as an invention. It is introduced, lest in describing and ascertaining the nature of his invention, and by what means the same is to be performed (particularly in the case of a patent for an improvement), the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new (*per* Lord Cottenham, L.C., in *Kay* v. *Marshall* (1836) 2 W. P. C. at p. 39). Its purpose "is to show how much of that which is described, or how little is intended to be the subject of the patent, and to disclaim all which is not included in the claims which follow" (*per* Kay, J., in *Ratcliff* v. *Longford* (1887) 4 R. P. C. at p. 286; and see *Edison-Bell* v. *Smith* (1894) 11 R. P. C. at p. 401; *Lucas* v. *Miller* (1885) 2 R. P. C. at p. 159).

Prior to the Act of 1883 there was no *necessity* in any case for a claim; its real object was rather to *disclaim* things which were old (see *Plimpton* v. *Spiller* (1877) 6 C. D. at p. 426; *Siddell* v. *Vickers* (1888) 5 R. P. C. at p. 428). Now, it is not correct to speak of a claim as a "disclaimer," as one can only protect what is claimed (see *per* Lord Herschell in *Parkinson* v. *Simon* (1895) 12 R. P. C. at p. 406).

When a Claim will be Bad.—Great care is requisite in the framing of the claims. If the patentee throws his net too wide—as patentees constantly do—to catch people who do infringe the real invention, the patent will be bad (see *per* Lindley, L.J., in *Dick* v. *Ellams* (1900) 17 R. P. C. at p. 202;

per Pollock, C.B., in *Crossley* v. *Potter* (1853) Macr. P. C. at pp. 245, 246).

A patentee will invalidate his grant if he—

(1) Claims something which is old (*Hill* v. *Thompson* (1817) 1 W. P. C. at p. 237; *Rushton* v. *Crawley* (1870) 10 Eq. 522; *Clark* v. *Adie* (1877) 2 A. C. 315; *Wilson* v. *Wilson* (1903) 20 R. P. C. 1; *Cropper* v. *Smith* (1884) 1 R. P. C. 81; *Dowler* v. *Keeling* (1898) 15 R. P. C. 214; *Kynoch* v. *Webb* (1900) 17 R. P. C. 100; *Reynolds* v. *Smith* (1903) 20 R. P. C. 123, 410; *cf.* *British Dynamite Co.* v. *Krebs* (1896) 13 R. P. C. at pp. 193, 194).

(2) Claims more than he has invented, that is to say, something which is the mere subject of his speculation, or imagination, or his endeavouring to grasp more than he is entitled to (see *per* Pollock, C.B., in *Tetley* v. *Easton* (1852) Macr. P. C. at pp. 72, 73, 76; *Hill* v. *Thompson* (1817) 1 W. P. C. at p. 237; *Jordan* v. *Moore* (1866) 1 C. P. 624; *Crossley* v. *Potter* (1843) Macr. P. C. 240).

(3) Claims an invention which is different from the invention disclosed in the provisional specification (see p. 70, *supra*).

(4) Claims something which is useless or impracticable (*Simpson* v. *Holliday* (1866) L. R. 1 H. L. 315; *Stevens* v. *Keating* (1847) 2 W. P. C. at p. 184; *Kurtz* v. *Spence* (1888) 5 R. P. C. 161; *Adamant Stone Co.* v. *Corpn. of Liverpool* (1896) 14 R. P. C. 11; *Wilson* v. *Wilson* (1903) 20 R. P. C. at p. 17; *Re Scott's Patent* (1903) 20 R. P. C. at p. 261; *Re Owen's Patent* (1900) 17 R. P. C. at p. 79; *Wegmann* v. *Corcoran* (1879) 13 C. D. 65; *Pether* v. *Shaw* (1893) 10 R. P. C. 293). It has been said that if a part of a machine is claimed which is useless, but that part is not described as *essential*, the validity of the patent will not be affected (*Lewis* v. *Marling* (1829) 1 W. P. C. at p. 495; and see *Haworth* v. *Hardcastle* (1834) 1 W. P. C. at pp. 483, 484; *R.* v. *Cutler* (1848) Macr. P. C. 137). But see, now, *Ward* v. *Hill* (1903) 20 R. P. C. at p. 199; *Re Owen's Patent* (1900) 17 R. P. C. at p. 79; *United Horseshoe Co.* v. *Swedish Horsenail Co.* (1889) 6 R. P. C. at p. 8; *United Horsenail Co.* v. *Stewart* (1885) 2 R. P. C. at p. 132.

(5) Claims a bare principle, *i.e.* a principle not coupled with a mode of carrying it into effect (see p. 6, *supra*). And if the patentee claims *every* mode of carrying a principle into effect, his claim will amount to a claim to a principle; for there is no difference between claiming a principle to be carried into effect in any way you will and claiming the principle itself (see p. 6, *supra*).

(6) Claims a method or process which the specification has not described (*Monnet* v. *Beck* (1897) 14 R. P. C. at p. 847; and see *Booth* v. *Kennard* (1857) 26 L. J. (N. S.) Ex. 305; *Tetley* v. *Easton* (1852) Macr. P. C. at p. 71).

Claims for Improvements.—When the invention is for an improvement, the patentee must be careful to claim only the improvement and to state clearly and distinctly of what the improvement consists (*Kynoch* v. *Webb* (1900) 17 R. P. C. at pp. 111, 112, 115, 116; *Macfarland* v. *Price*, 1 W. P. C. 74, *n.*; *Foxwell* v. *Bostock* (1864) 4 De G. J. & S. 298). He cannot take a well-known existing machine, and, having made some small improvement, place that before the public and say: "I have made a better machine. There is the sewing-machine by so-and-so; I have improved upon that: that is mine; it is a much better machine than his." He must distinctly state what is and lay claim only to his improvement (see *per* Lord Hatherley in *Harrison* v. *Anderston Foundry Co.* (1876) 1 A. C. at p. 547). For example, supposing that a compensation pendulum was now for the first time invented, it would not do to patent improvements in clocks in general terms, and give a specification of the whole machinery of a clock, introducing somewhere in the course of the description the mode of making a compensation pendulum, and then end by claiming the arrangement and the combination aforesaid. The patentee must say expressly: "I claim the invention of a compensation pendulum, and I make it thus" (see *per* James, V.-C., in *Parkes* v. *Stevens* (1869) 8 Eq. at p. 366).

Claims for New Combinations.—Where, however, the invention consists in a new combination of old parts, there is no necessity to distinguish what is new from what is old; the combination itself is, *ex necessitate*, the novelty (*Harrison* v. *Anderston Foundry Co.* (1876) 1 A. C. at p. 578; *Peckover* v. *Rowland* (1893) 10 R. P. C. at pp. 237, 238; *Goddard* v. *Lyon* (1894) 11 R. P. C. 354; *Hookham* v. *Johnson* (1897) 14 R. P. C. at p. 558; *cf. Kynoch* v. *Webb* (1900) 17 R. P. C. 100). But the patentee must make it clear that what he claims is the *combination only*; not the specific things which make up the combination (*Rowcliffe* v. *Morris* (1886) 3 R. P. C. at p. 24; *Kynoch* v. *Webb* (1900) 17 R. P. C. at p. 108).

Claims for Subordinate Integers.—Besides claiming a combination as a whole, the patentee may claim certain of

the parts which go to make up the whole, provided the parts so claimed themselves constitute independent inventions (*Clark* v. *Adie* (1877) 2 A. C. at p. 321). But if protection is desired for the subordinate parts or integers, it must be made plain that the patentee has had in his mind and has intended to claim them (*Clark* v. *Adie, supra ;* and see *British Dynamite Co.* v. *Krebs* (1896) 13 R. P. C. 190 ; *Pneumatic Tyre Co.* v. *Casswell* (1896) 13 R. P. C. 164). Moreover, the patentee is at the peril of justifying the subordinate parts claimed as themselves matters which ought properly to form the subject of letters patent (*Clark* v. *Adie, supra*) ; if any one of them is lacking in novelty (*Cropper* v. *Smith* (1884) 1 R. P. C. 81 ; *Dowler* v. *Keeling* (1898) 15 R. P. C. 214 ; *Electric Construction Co.* v. *Imperial Tramways* (1900) 17 R. P. C. 537 ; *Dick* v. *Ellams* (1900) 17 R. P. C. 196 ; *Reason* v. *Moy* (1903) 20 R. P. C. 205 ; *Re Scott's Patent* (1903) 20 R. P. C. 257 ; *Roberts* v. *Heywood* (1879) 27 W. R. 454 ; *Parkinson* v. *Simon* (1895) 12 R. P. C. 403 ; *Wilson* v. *Wilson* (1903) 20 R. P. C. 1 ; and see p. 7, *supra*), or utility (*Adamant Stone Co.* v. *Corpn. of Liverpool* (1897) 14 R. P. C. at p. 22 ; *Wilson* v. *Wilson* (1901) 18 R. P. C. 139 ; *Ward* v. *Hill* (1903) 20 R. P. C. at p. 199 ; and see p. 16, *supra*), or invention (*Clark* v. *Adie* (1877) 2 A. C. at p. 321 ; and see p. 20, *supra*), the patent will be wholly bad. Where, however, the Court is satisfied that a subordinate part claimed was intended to be claimed, not *in gross*, but as *appendant* to the main claim, the patent will be upheld, although the claim to the subordinate part, if read by itself, claims something which is old (*British Dynamite Co.* v. *Krebs* (1896) 13 R. P. C. 190 ; *Plimpton* v. *Spiller* (1877) 6 C. D. 413 ; *Parker* v. *Satchwell* (1901) 18 R. P. C. at p. 307 ; *Tetley* v. *Easton* (1853) Macr. P. C. at pp. 87, 88). But "you are not to put a forced construction on the specification, as not intending to claim something that is old, because it was foolish or suicidal of the patentee to claim it" (*per* Lord Davey in *Kynoch* v. *Webb* (1900) 17 R. P. C. at p. 116 ; and see *Wilson* v. *Wilson* (1902) 20 R. P. C. 1 ; *Electric Construction Co.* v. *Imperial Tramways* (1900) 17 R. P. C. at p. 549). If a really independent claim to something old, however inadvertently or carelessly it be made, is in fact made, the Court is bound to hold the patent void (see *per* Brett, L.J., in *Plimpton* v. *Spiller* (1877) 6 C. D. at p. 433).

"SUBSTANTIALLY AS DESCRIBED."—The words "substantially as hereinbefore described" are commonly inserted at the end of a claim ; as to their effect see p. 78, *infra*.

BETTER TO CLAIM TOO LITTLE THAN TOO MUCH.—When framing their claims, patentees will do well to bear in mind the advice given by Pollock, C.B., in *Crossley* v. *Potter* (1853) Macr. P. C. at p. 256—that is, that 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."

The provisions of s. 5 (5) of the Act (see p. 72, *supra*) are directory only, and should a specification be passed by the Examiner (see p. 32, *supra*) which does not "end with a distinct statement of the invention claimed," objection to the patent on the ground of want of a distinct claim cannot be taken (*Vickers* v. *Siddell* (1890) 7 R. P. C. at pp. 303, 306; *Kelly* v. *Heathman* (1890) 7 R. P. C. 343; *Tubes* v. *Perfecta Co.* (1903) 20 R. P. C. at pp. 99, 100).

Construction of the Specification.

Provisional Specification cannot Aid.—The meaning and intention of the patentee must be gathered from the complete specification alone; the provisional specification cannot be referred to either to explain or enlarge the meaning of the complete (*Mackelcan* v. *Rennie* (1862) 13 C. B. (N.S.) 52), although the provisional may, it seems, be looked at for the purpose of ascertaining what is the real object of the invention (see *per* Lord Esher, M.R., in *Parkinson* v. *Simon* (1894) 11 R. P. C. at p. 503). If the complete specification omits all reference to a part of the invention disclosed in the provisional specification, the inference is that the inventor could not work or thought useless the part omitted, and has therefore abandoned it altogether (*Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 342).

Rules of Construction.—It was at one time considered that the specification should be construed favourably or benevolently (see *per* Jessel, M.R., in *Hinks* v. *Safety Co.* (1876) 4 C. D. at p. 612; *Cropper* v. *Smith* (1884) 1 R. P. C. at p. 89). But it is now clear the document is to be construed neither benevolently nor malevolently (see *per* Chitty, J., in *Lister* v. *Norton* (1886) 3 R. P. C. at p. 203; *cf. per* Vaughan Williams, L.J., in *Patent Exploitation* v. *Siemens* (1903) 20 R. P. C. at p. 234), but in the same manner as any other document (see *per* Lord Esher, M.R., in *Nobel's Co.* v. *Anderson* (1894) 11 R. P. C. at p. 523;

Electric Construction Co. v. *Imperial Tramways* (1899) 16 R. P. C. at p. 638; *Cropper* v. *Smith* (1884) 1 R. P. C. at p. 89.

The *whole* instrument must be looked at (see *per* Lord Halsbury, L.C., in *Tubes* v. *Perfecta Co.* (1903) 20 R. P. C. at p. 96); it must be construed as if it had to be construed the day after it was published (see *per* Lord Esher, M.R., in *Nobel's Co.* v. *Anderson* (1894) 11 R. P. C. at 523); and the then existing state of knowledge or circumstances must be regarded (*Nobel's Co.* v. *Anderson, supra*; *Badisch* v. *Levinstein* (1887) 4 R. P. C. at p. 468; *British Motor Syndicate* v. *Andrews* (1901) 18 R. P. C. at p. 95).

Construction of the Claims.—With regard to the claim, it is a part of the specification, and must be read and construed with reference to the body of the specification, and not as if it were an isolated sentence having no reference to or connection with what precedes it (see p. 73, *supra*). It is not proper to look first at the claim, and then at the description, but first to read the description, in order that one's mind may be prepared for what it is the inventor is about to claim (see *per* Lord Hatherley in *Arnold* v. *Bradbury* (1871) 6 Ch. at p. 712; *Tubes* v. *Perfecta Co.* (1903) 20 R. P. C. at p. 99; *Edison-Bell* v. *Smith* (1894) 11 R. P. C. at pp. 395, 396).

Effect of the Words "Substantially as Described."—The claim commonly terminates with the words "substantially as hereinbefore described." The effect of such words is to limit the claim to the method or process described in the body of the specification (see *Brooks* v. *Lamplugh* (1898) 15 R. P. C. at p. 49; *Chadburn* v. *Mechan* (1895) 12 R. P. C. at p. 134; *Goddard* v. *Lyon* (1894) 11 R. P. C. at p. 362; *Welsbach Co.* v. *New Incandescent Co.* (1900) 17 R. P. C. at p. 250; but see *per* Rigby, L.J., in *Pneumatic Tyre Co.* v. *Tubeless Tyre Co.* (1898) 15 R. P. C. at p. 243; *per* Collins, L.J., in *Marshall* v. *Chameleon Patents* (1901) 18 R. P. C. at p. 403). Where there are several claims, the insertion of these words at the end of each has been said to be extremely embarrassing (see per Fry, L.J., in *Fairfax* v. *Lyons* (1891) 8 R. P. C. at p. 407); but as to the disastrous consequences which may result from omitting them, see *Reason* v. *Moy* (1903) 20 R. P. C. 205. The use of the word "substantially" is quite unnecessary. "The law says if a man, although not literally infringing the letter of the patent, yet substantially infringes it, it is an infringement" (per Grove, J., in *Young* v. *Rosenthal* (1884) 1 R. P. C. at p. 33).

AMENDMENT OF THE SPECIFICATION.

Amendments Required by the Comptroller.

As has already been mentioned (see p. 33, *supra*), the Comptroller may require an amendment of the specification where the nature of the invention is not fairly described, or the specification or drawings has or have not been prepared in the prescribed manner, or the title does not sufficiently indicate the subject-matter of the invention (s. 2 of the Patents Act, 1888); and where the complete specification is lodged after a provisional specification, he may refuse to accept the complete, if it has not been prepared in the prescribed manner, or if it disconforms with the provisional, until it has been amended to his satisfaction (s. 9 of the Patents Act, 1883).

All amendments of specifications, before they have become public property, must be made under the sections above referred to; all amendments afterwards must be made under s. 18 (*Jones's Patent* (1884) Griff. P. C. 313; *Dart's Patent* (1884) Griff. P. C. 307; see *infra*). Although the power to require amendments under s. 2 of the Act of 1888, or s. 9 of the Act of 1883, is vested in the Comptroller alone, yet if an applicant points out a proper amendment before his specification has become "public property," the Comptroller, it seems, should allow it to be made (see *Jones' Patent*, *supra*; *Dart's Patent*, *supra*). But amendments will not be allowed as a matter of course (see *Re Crist's Application* (1903) 20 R. P. C. at p. 476; *Re Thomas's Application* (1899) 16 R. P. C. 69).

Amendments Required by the Patentee under s. 18.

All amendments after the specification has become "public property" must be made under s. 18 of the Act of 1883 (see *supra*); and if any action for infringement or proceeding for revocation is pending, the leave of the Court must first be obtained (see p. 85, *infra*).

S. 18 (1) provides that "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." But no amendment is 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 (S. 18 (8), *ibid.*).

What Amendments are Permissible.—A disclaimer may be used for the purpose of turning an ambiguous specification into a clear specification (*Moser* v. *Marsden* (1893) 10 R. P. C. 350; (1896) 13 R. P. C. 24), but not for the purpose of turning an insufficient description into a sufficient one (*Re Johnson's Patent* (1896) 13 R. P. C. 659).

A disclaimer may be allowed which consists in striking out ninety-nine hundredths of what was contained in the original specification (*Re Dellwik's Patent* (1898) 15 R. P. C. at p. 688). But a disclaimer which has the effect of claiming a different invention will not be allowed (see *infra*).

Where there is a specific claim to the invention as a whole, but no claim to any subordinate part, the patentee cannot strike out the whole claim and insert an independent claim to a subordinate part (see *Re Serrell's Patent* (1889) 6 R. P. C. at p. 103). But "if you have got a claim for A., B., C., D., E., and F., and you confine it to F., that is a narrower claim than the original, and it is not different, because it is included in the old claim" (*per* Davey, S.-G., in *Cochrane's Patent* (1885) Griff. P. C. at p. 305).

If the principle of the invention is amply described in the original specification, an amendment by way of fuller description will not be allowed (*Nordenfelt's Patent* (1887) 2 Griff. P. C. at p. 18; and see *Re Johnson's Patent* (1896) 13 R. P. C. at p. 663).

Leave to amend will be refused if the amendment imports subsequent knowledge into the specification (see *Re Johnson's Patent, supra*; *Beck's Patent* (1886) 2 Griff. P. C. 10), or if it has the effect of claiming a new invention (*Re Parkinson's Patent* (1896) 13 R. P. C. at p. 513; *Moser* v. *Marsden* (1896) 13 R. P. C. 24; *Re Lancaster's Application* (1903) 20 R. P. C. at p. 368; *Re Hattersley's Patent* (1904) 21 R. P. C. 233; *Re Lang's Patent* (1890) 7 R. P. C. at pp. 471, 472; *Re Harrild's Application* (1900) 17 R. P. C. at p. 619; s. 18 (8) of the Patents Act, 1883).

Where the patentee claims specific parts of his invention, he will be allowed to amend by claiming those parts in combination only, *provided* he has clearly intended to claim them conjointly (*Re Bateman's Disclaimer* (1854) Macr. P. C. 116; *Kelly* v. *Heathman* (1890) 7 R. P. C. 343; *cf. Re Hattersley's Patent* (1904) 21 R. P. C. 233). In the first case, the patentees were allowed to disclaim the words "firstly," "secondly," and "thirdly," and to substitute the word "or" for the word "secondly," and the word "and" for "thirdly."

A claim for several integers or for several processes may be amended so as to be confined to only one (*Cochrane's Patent* (1885) Griff. P. C. at p. 305; *Re Ryland's Patent* (1888) 5 R. P. C. at p. 668; and see *Re Hattersley's Patent* (1904) 21 R. P. C. at p. 238; *cf. Re Serrell's Patent* (1889) 6 R. P. C. at p. 103).

Where a patentee has chosen to claim an improved method apart from particular means, he will not be allowed to practically re-write his specification by inserting all the particular means (*Re Nairn's Patent* (1891) 8 R. P. C. at p. 445).

Drawings may be added by amendment (see *Re Lang's Patent* (1890) 7 R. P. C. 469). In *Morgan's Patent* ((1886) 2 Griff. P. C. 17), a misdescription of one of the drawings was amended, although the patent was ten years old.

Amendment may be allowed where an applicant for a patent in respect of an imported invention has misdescribed the invention through misunderstanding the inventor's instructions (*Re Johnson's Patent* (1896) 13 R. P. C. at p. 662).

In *Re Vidal's Patent* ((1898) 15 R. P. C. 721), the words "a process of preparing" were not allowed to be altered to the words "the manufacture of," on the ground that the alteration would enlarge the claim.

The Law Officer (s. 18 (4) of the Patents Act, 1883) or the Comptroller (s. 18 (5), *ibid.*; *Hearson's Patent* (1884) Griff. P. C. at p. 310) may allow an amendment subject to conditions.

Reasons against Leave to Amend.—It requires a strong case, and a clearer case, for granting leave to amend where the application is made late in the life of a patent, because the Comptroller or Law Officer must be satisfied that the mistake was an original mistake, and he must try to put himself back in the position of the parties at the time (see *per* Webster, A.-G., in *Re Johnson's Patent* (1896) 13 R. P. C. at p. 663; *cf. Re Lang's Patent* (1890) 7 R. P. C. at p. 471).

The fact that a complete specification was filed in the first instance is to be considered as a reason against the application (*Nordenfelt's Patent* (1887) 2 Griff. P. C. 18).

If a patentee has, by abstaining from taking proceedings to amend, acquiesced in the assertion of the opponent that the patent is a bad one, and the opponent, on the strength of that, has created a business which it is afterwards sought to attack by an application to amend the patent, leave may be refused altogether or granted only on special terms (*Re Allison's Patent* (1898) 15 R. P. C. at p. 411).

The section provides that a patentee may seek leave to amend from "time to time"; but second applications for leave are not encouraged (*Re Haddan's Patent* (1885) 2 Griff. P. C. 12; *cf. Chatwood's Patent* v. *Mercantile Bank* (1899) 17 R. P. C. 23).

Effect of Amendment.—An amendment takes effect from the date when leave to amend is given (*Andrews* v. *Crossley* (1892) 9 R. P. C. 165). Once an amendment has been allowed, it is conclusive, except in the case of fraud (s. 18 (9) of the Patents Act, 1883), and the regularity of the amendment cannot be subsequently questioned (*Moser* v. *Marsden* (1895) 13 R. P. C. 24; *Re Dellwik's Patent* (1896) 13 R. P. C. 591).

An amendment is in all Courts and for all purposes to be deemed to form part of the specification (s. 18 (9), *ibid.*). An amended claim, when admitted by the proper authorities, is a complete substitute, to all effects and purposes, for the claim originally lodged. "The validity of the amended claim must, therefore, be determined in the same way, and on the same footing, as if it had formed part of the original specification: and the claim, as it stood before amendment, cannot be competently referred to, except as an aid in the construction of its language after amendment" (*per* Lord Watson in *Moser* v. *Marsden*, *supra*, at p. 31; and see *Reason* v. *Moy* (1903) 20 R. P. C. at p. 211).

Where an amendment by way of disclaimer, correction, or explanation has been allowed, no damages can be given 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 granted in good faith and with reasonable skill and knowledge (s. 20 of the Patents Act, 1883; see p. 209, *infra*).

Who may Amend.—S. 18 (1) provides that "an applicant or a patentee" may seek leave to amend (see p. 79, *supra*). A request for leave to amend may therefore be made by an applicant for a patent, or a patentee, or the person for the time being entitled to the benefit of a patent" (s. 46 of the Patents Act, 1883).

An assignee, though he has granted a mortgage (see *Van Gelder* v. *Sowerby Bridge Society* (1890) 7 R. P. C. at p. 211), is a person entitled to the benefit of the patent, and competent to apply for leave. But a mortgagee cannot, it seems, apply alone (see *Van Gelder* v. *Sowerby Bridge Society*, *supra*, at p. 212). A mortgagor, it is submitted, should apply with his

mortgagee (see *Re Church's Patents* (1886) 3 R. P. C. 95); and although each co-owner is entitled to the benefit of the patent, one should not apply without the other or others.

A person who has obtained his grant under the International Convention, cannot claim greater privileges than a national applicant, and he is liable to the same restrictions as a subject or citizen of the country in which he is making the application; his specification is to be construed in exactly the same way as though the patent had been applied for by a British subject resident here (*Re Vidal's Patent* (1898) 15 R. P. C. 721).

The Request to Amend.—The request to amend must be left at the Patent Office and must state the nature of the amendments and the reason for the same (s. 18 (1) of the Patents Act, 1883), and, when not made in pursuance of an order of the Court, must contain a statement that no action for infringement or proceeding for revocation is pending (Patents Rules, 1903, Rule 42).

The request must be signed by the applicant, and must contain an address for service within the United Kingdom; and it must be accompanied by a duly certified copy of the original specification and drawings, showing in red ink the proposed amendment (Rule 42, *ibid.*).

It must be advertised by publication of the request and the nature of the proposed amendment in the Official Journal of the Patent Office, and in such other manner (if any) as the Comptroller may direct (s. 18 (2), *ibid.*; Rule 42, *ibid.*).

When no notice of opposition is given, or the opponent does not appear, the Comptroller must determine whether, and subject to what conditions, if any, the amendment ought to be allowed (s. 18 (5), *ibid.*).

Opposition to Amendment.—At any time within one month from the first advertisement of the request to amend, "any person" may give notice at the Patent Office of opposition to the amendment (s. 18 (2) of the Patents Act, 1883). But "any person" must be construed as meaning only a person who, in the opinion of the Law Officer, is entitled to be heard, and it seems whose interest is equivalent to the interest of a person entitled to be heard in opposition to the grant of a patent (see *R.* v. *Comptroller-General* (1899) 16 R. P. C. 233).

The notice of opposition must be on Form G., and must state the ground or grounds on which the opponent intends to oppose the amendment, and must be signed by him. It must state his

address for service in the United Kingdom, and must be accompanied by an unstamped copy, which copy must be transmitted by the Comptroller to the applicant (Rule 44, *ibid.*).

Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving must deliver copies thereof to the applicant (Rule 45, *ibid.*).

Upon such declarations being left, and such copies being delivered, the applicant may, within fourteen days from the delivery of such copies, leave at the Patent Office statutory declarations in answer, and on so leaving must deliver to the opponent copies thereof, and within fourteen days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving must deliver to the applicant copies thereof. Declarations in reply must be confined to matters strictly in reply (Rule 46, *ibid*).

No further evidence can be left on either side except by leave, or on the requisition of the Comptroller (Rule 46, *ibid.*).

Where Opponent Leaves no Declarations.—If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within two months from the date of the first advertisement of the application for leave to amend, leave at the Patent Office statutory declarations in support of his application, and on so leaving must deliver to the opponent copies thereof (Rule 47, *ibid.*).

Within fourteen days from the delivery of such copies, the opponent may leave at the Patent Office statutory declarations in answer, and on so leaving must deliver to the applicant copies thereof, and within fourteen days from such delivery the applicant may leave at the Patent Office his statutory declarations in reply, and on so leaving must deliver to the opponent copies thereof. Statutory declarations in reply must be confined to matters strictly in reply (Rule 48, *ibid.*).

For form of Statutory Declarations, see p. 53, *supra*.

The Hearing.—On completion of the evidence (if any), or at such other time as he may see fit, the Comptroller appoints a time for the hearing of the case, and gives the parties ten days' notice at the least of such appointment (Rule 46, *ibid.*).

If either party does not desire to be heard, he must as soon as possible notify the Comptroller to that effect. If either party

desires to be heard, he must leave Form E. at the Patent Office; the comptroller may refuse to hear either party who has not left that form prior to the date of hearing (Rule 46, *ibid.*).

After hearing the party or parties desirous of being heard, or if neither party desires to be heard then without a hearing, the Comptroller decides the case and notifies his decision to the parties (Rule 46, *ibid.*).

The Comptroller cannot decide adversely to an applicant for amendment without (if so required by the applicant within the prescribed time) giving him an opportunity of being heard personally or by his agent (s. 94 of the Patents Act, 1883).

Costs.—The Comptroller has no power to award costs; he cannot, therefore, make it a condition precedent that a sum shall be paid by the applicant to the opponent where the sum is intended to defray the opponent's expenses connected with the opposition (*Pietschmann's Patent* (1884), Griff. P. C. 314).

Requirements after Amendment.—Where leave to amend is given, the applicant must, if the Comptroller so requires, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended (Rule 49, *ibid.*).

Every amendment of a specification must be advertised forthwith by the Comptroller in the Official Journal of the Patent Office, and in such other manner (if any) as the Comptroller may direct (Rule 50, *ibid.*).

Appeal from Comptroller's Decision.—From the decision of the Comptroller an appeal lies to the Law Officer, whether the application to amend is opposed or not (s. 18 (3) and (6) of the Patents Act, 1883).

For the procedure on such appeals, see p. 224, *infra*.

Amendments Pending Action.

When and so long as any action for infringement or proceeding for revocation of a patent is *pending* (s. 5 of the Patents Act, 1888) the patentee must obtain the leave of the Court before he can seek leave to amend (s. 19 of the Act of 1883). No action is "pending" where an action has been discontinued or concluded (*Cropper* v. *Smith* (1884) 1 R. P. C. 254); and where an appeal is pending, application can be made under s. 18 without leave (*Cropper* v. *Smith*, *supra*).

If an application for leave to amend has been made *before* any action for infringement or proceeding for revocation is brought, the applicant can proceed without leave of the Court although

an action for infringement or proceeding for revocation is commenced before the amendment is allowed (*Woolfe* v. *Automatic Picture Gallery* (1903) 20 R. P. C. 177).

S. 19 provides 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." Leave may be given on a second application; the section is not confined to one (*Chatwood's Patent* v. *Mercantile Bank* (1900) 17 R. P. C. at p. 24).

The right of amendment in this case, it will be noticed, is not so extensive as that given by s. 18. Under s. 19 the patentee can only amend by way of *disclaimer* (see *Re Armstrong's Patent* (1897) 14 R. P. C. at p. 754); and that word must be read strictly, and does not include corrections or explanations, except such explanations as may be required for the purpose of defining the disclaimer (*Re Owen's Patent* (1898) 15 R. P. C. 755).

The matter of granting or refusing leave is entirely a discretionary one (*Re Armstrong's Patent* (1897) 14 R. P. C. at p. 754; *New Conveyor Co.* v. *Edinburgh Commissioners* (1904) 21 R. P. C. 147); and the discretion does not become fixed by the exercise of the discretion by a particular Judge in a particular case (see *per* Chitty, J., in *Re Dellwik's Patent* (1896) 13 R. P. C. at p. 598; and see *Allen* v. *Doulton* (1887) 4 R. P. C. at p. 385). Neither the Court of Appeal nor the House of Lords will interfere with the exercise of the Judge's discretion, unless it is clearly of opinion that the discretion has been wrongly exercised (*Re Armstrong's Patent*, *supra*; *Ludington Cigarette Co.* v. *Baron Cigarette Co.* (1900) 17 R. P. C. at p. 748), or unless the Judge did not exercise his discretion at all (*Allen* v. *Doulton* (1887) 4 R. P. C. at p. 386).

If the application is a trumpery or trifling one (*Re Dellwik's Patent* (1896) 13 R. P. C. at p. 598), or if it appears that no disclaimer could make the patent a good one (*Re Armstrong's Patent* (1896) 13 R. P. C. 508; (1897) 14 R. P. C. 747), leave will not be given. Leave may be given although the plaintiff has known of the infringement for a considerable time, *e.g.*, nine years before action brought; but the plaintiff will be put on terms (*Carrigall* v. *Armstrong* (1903) 20 R. P. C. 523).

The Court will consider the proposed amendments in order to

see whether the case is a trumpery one; but it will not inquire whether they ought or ought not to be allowed, as the Comptroller and Law Officer are the sole authorities in this matter (*Re Dellwik's Patent* (1896) 13 R. P. C. at p. 598; and see *Re Hall* (1888) 5 R. P. C. at p. 310).

Imposing Terms.—The Court or a Judge may impose terms as to "costs and otherwise" (s. 19). The words "costs and otherwise" authorise the Judge to impose what terms he pleases (*Lang* v. *Whitecross* (1890) 7 R. P. C. at p. 392).

Terms are nearly always imposed; but the Judge has absolute discretion in the matter, and there is no hard-and-fast rule (see *Lang* v. *Whitecross*, *supra*, at p. 393; *Goulard* v. *Lindsay* (1888) 5 R. P. C. at p. 196).

Wherever leave is given to amend, care ought to be taken of the defendant in the action as well as of the plaintiff; and care ought to be taken that no injustice is done to the defendant by reason of the amendment. But there is no form of order which is invariably to be followed in all cases; adequate protection may be given to the defendant in various cases in various forms (see *per* Lindley, L.J., in *Bray* v. *Gardner* (1887) 4 R. P. C. at p. 44).

The Court usually imposes the condition that the amended specification shall not be given in evidence (*Bray* v. *Gardner*, *supra*, at pp. 42, 43; *Singer* v. *Stassen* (1884) 1 R. P. C. at p. 124; *Allen* v. *Doulton* (1887) 4 R. P. C. 377; *Codd* v. *Bratby* (1884) 1 R. P. C. 209). In *Lang* v. *Whitecross* ((1890) 7 R. P. C. 389) leave to use the amended specification as evidence was granted on condition that no damages be recovered, or claim for injunction be founded on anything done before disclaimer.

And the patentee will, as a general rule, be required to defray all costs occasioned by the amendment (*Singer* v. *Stassen*, *supra*; *Codd* v. *Bratby*, *supra*; *Bray* v. *Gardner* (1887) 4 R. P. C. 40; *Haslam* v. *Goodfellow* (1887) 5 R. P. C. 28; *Carrigall* v. *Armstrong* (1903) 20 R. P. C. at p. 524). In several cases he has been required to pay all costs up to and including the application consequent upon the amendment (*Fusee Vesta Co.* v. *Bryant & May* (1887) 4 R. P. C. 71; *Goulard* v. *Lindsay* (1888) 5 R. P. C. 192).

The Court usually imposes the further term that the patentee shall waive all claim to relief in respect of any infringement committed before the date of the disclaimer (*Goulard* v. *Lindsay* (1888) 5 R. P. C. 192; *Codd* v. *Bratby* (1884) 1 R. P. C. 209).

But in this, as in other cases, there is no fixed rule (see *Lang* v. *Whitecross* (1890) 7 R. P. C. at p. 393).

DEELEY *v.* PERKES.—In *Deeley* v. *Perkes* ((1896) 13 R. P. C. 581), the order made by the House of Lords in a proceeding for revocation, provided that: "No action shall be brought for infringement of the patent in respect of any guns or parts of guns made prior to" the conclusion of the hearing of the appeal. This form of order was adopted in *Ludington Cigarette Co.* v. *Baron Cigarette Co.* (1900) 17 R. P. C. at pp. 214, 745; *Re Allison's Patent* (1900) 17 R. P. C. 513; and in *Jandus* v. *Arc Lamp Co.* (1903) 21 R. P. C. 115; and see *Re Scott's Patent* (1903) 20 R. P. C. at p. 263). But the order made in *Deeley* v. *Perkes* must not be regarded as laying down a settled form (*Ludington Cigarette Co.* v. *Baron Cigarette Co.* (1900) 17 R. P. C. at p. 216). It would not have been made had it been a case of mere infringement (*ibid.*, at p. 745); and it should, it seems, only be made in special circumstances (*ibid.*, at p. 216). In *Re Geipel's Patent* (1903) 20 R. P. C. at pp. 556, 558, Buckley, J., after consideration of the order made in *Deeley* v. *Perkes*, made an order in this form: "That if the specification be amended, no injunction shall be asked in any action brought for infringement of the patent in respect of any steam traps made prior to this date *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." But this form of order was not altogether favoured by the Court of Appeal ((1904) 21 R. P. C. at p. 387).

MEYER *v.* SHERWOOD.—In *Meyer* v. *Sherwood* ((1890) 7 R. P. C. 284) the plaintiff, at the close of the defendant's case, asked that the trial might be postponed, in order that he might apply at the Patent Office for leave to disclaim. The application was granted. After amendment, and at the further hearing, the plaintiff applied for leave to amend his pleadings. Smith, J., held, that if leave were granted it could only be on the terms of the plaintiff paying all costs up to the time of application, and recovering no damages up to the same date; and that, in the circumstances, the proper course would be to dismiss the action with costs. The Court of Appeal affirmed the decision, but Lindley, L.J., considered that the order might have reserved to the plaintiff "liberty to bring a fresh action for an injunction, if so advised."

AMENDING THE PLEADINGS.—The order, now, usually allows both parties to make all necessary amendments in their pleadings after disclaimer (*Re Chatwood's Patent* (1899) 16 R. P. C. at p. 373; *Haslam* v. *Goodfellow* (1888) 5 R. P. C. 28).

Restriction on Recovery of Damages.—By virtue of s. 20 of the Patents Act, 1883, where an amendment has been allowed, no damages are to be given 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 (see p. 209, *infra*).

Procedure.—The application for leave to apply to amend may be made by summons at chambers, or by motion, or at the hearing.

When leave has been obtained, s. 18 applies to the case as if that section stood without the three words in it—"correction or explanation" (*Re Lang's Patent* (1890) 7 R. P. C. at p. 471; *Re Hall* (1888) 5 R. P. C. at p. 310; see p. 79, *supra*).

Where a request for leave to amend is made in pursuance of an order of the Court or a Judge, an office copy of the order must be left with the request to amend (see p. 83, *supra*) at the Patent Office (Patents Rules, 1903, Rule 43).

In *Re Hearson's Patent* ((1884) 1 R. P. C. 213) the Law Officer granted leave to amend upon the condition that no action should be brought in respect of any infringement committed prior to the amendment. But the present practice is not to impose terms in excess of those imposed by the Court (*Re Pitt's Patent* (1901) 18 R. P. C. 478).

Where two actions for infringement of the same patent are pending, the Comptroller cannot refuse to hear an application for leave to amend because liberty to apply for leave has not been obtained in both actions (*Re Hall* (1888) 5 R. P. C. 306).

CHAPTER V.

Devolution, Disposition, and Registration of Patents.

DEVOLUTION — ASSIGNMENTS — VOLUNTARY LICENCES — COMPULSORY LICENCES—REGISTRATION OF PATENTS—RECTIFICATION OF THE REGISTER.

Devolution.

A PATENT is a choso in action (*British Mutoscope Co.* v. *Homer* (1901) 18 R. P. C. at pp. 179, 180).

On death, the patent passes to the executors or administrators of the deceased patentee; and the executors may effect a proper assignment of the patent before probate is registered (*Ellwood* v. *Christy* (1864) 10 Jur. (N. S.) 1078). The interest of co-patentees is joint; and on the death of one his interest passes by survivorship to the other, unless there has been a severance of the joint interest (*National Co.* v. *Gibbs* (1899) 16 R. P. C. 339; (1900) 17 R. P. C. 302).

On bankruptcy, the patent vests in the trustee in bankruptcy, and, if before his discharge a bankrupt obtains letters patent, the grant vests in the trustee for the benefit of the creditors (*Hesse* v. *Stevenson* (1803) 3 Bos. & P. 565; approved in *Re Roberts* [1899] 1 Q. B. at p. 130). But the interest in an unpatented invention does not pass (see *per* Lord Alvanley in *Hesse* v. *Stevenson*, *supra*, at pp. 577, 578).

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 (see p. 25, *supra*).

Assignments.

Power to assign is vested in the patentee by the terms of the grant; and the right to assign is recognised by ss. 36 and 87 of the Patents Act, 1883.

A patentee may assign either the whole or any part of his patent (*Walton* v. *Lavater* (1860) 8 C. B. (N. S.) 162; *Dunnicliff* v. *Mallet* (1859) 7 C. B. (N. S.) 209); and a patent may be assigned for a particular place in or part of the United Kingdom or the Isle of Man (s. 36, *ibid.*).

A patent may be assigned to a body corporate (see s. 117, *ibid.*); and a body corporate may be registered as proprietor by its corporate name (Patents Rules, 1903, Rule 59; see p. 108, *infra*).

Agreement to Assign.—An agreement usually precedes the actual assignment where the patent has not yet been granted, or where the proposed assignee desires to test first the value or validity of the patent, or where the patent is to be assigned to a company about to be formed.

An agreement to assign operates as an equitable assignment (*Stewart* v. *Casey* (1891) 9 R. P. C. at pp. 12, 13, and see p. 94, *infra*), which may be specifically enforced (see *Jandus* v. *Johnson* (1900) 17 R. P. C. at p. 376).

For Forms of Agreement to Assign, see the Encyclopædia of Forms and Precedents.

Form of the Assignment.—A legal interest in a patent can only be assigned by deed (*Stewart* v. *Casey* (1892) 9 R. P. C. at p. 13); and if made by an agent the agent must be authorised under seal to execute the deed (*Hazlehurst* v. *Rylands* (1891) 9 R. P. C. at p. 7). But an instrument not under seal, which purports to be an assignment, effectually passes the immediate equitable interest (*Stewart* v. *Casey*, *supra*).

If an assignment is expressed to take effect upon the happening of a certain event, the legal interest vests in the assignee upon the happening of the event without further assignment (*Cartwright* v. *Amatt* (1799) 2 Bos. & P. 43).

An assignment may be made of a patent *to be* granted (*Re Parnell's Patent* (1888) 5 R. P. C. 126); but such a document cannot be entered on the Register of Patents, unless it is executed immediately before the grant and can be clearly identified as referring to the invention which is the subject of the patent subsequently granted (*Re Parnell's Patent*, *supra*, at p. 128).

Where the assignor conveys as "beneficial owner" the usual covenants for title are implied (s. 7 of the Conveyancing Act, 1881).

For Forms of Assignments, see the Encyclopædia of Forms and Precedents.

Validity of Patent.—This should be the subject of an express covenant; for there is no implied warranty of validity (*Hall* v. *Conder* (1857) 2 C. B. (N. S.) 22; *Nadel* v. *Martin* (1903) 20 R. P. C. at pp. 138, 723). But an assignment estops the assignor from himself disputing the validity of the patent (*Oldham* v. *Langmead*, cit. in *Hayne* v. *Maltby* (1789) 3 T. R. at p. 441; *Chambers* v. *Crichley* (1864) 33 Beav. 374; *Hocking* v. *Hocking*

(1887) 4 R. P. C. 434; (1889) 6 R. P. C. 69). If, however, a patentee becomes bankrupt, and his trustee in bankruptcy assigns the patent, the patentee is not estopped from afterwards denying the validity of the patent as against the assignee (*Cropper* v. *Smith* (1885) 10 A. C. 249). And the assignor cannot be restrained from giving evidence as to matters which may show that the patent is bad (*London and Leicester Co.* v. *Griswold* (1886) 3 R. P. C. at p. 253).

If the consideration is not to be payable if in the opinion of the assignee or some third party the patent is invalid, it should be stated that such opinion is to be conclusive, if such is the intention (see *Hazlehurst* v. *Rylands* (1892) 9 R. P. C. 1).

Where the assurance is to contain a covenant guaranteeing the validity of the patent, it should be made clear whether the guarantee is to be in the nature of a condition entitling the defendants to repudiate on the patent being declared invalid, or a mere warranty for the breach of which the remedy is to be damages only (see *Nadel* v. *Martin* (1903) 20 R. P. C. 723).

If the assignor guarantees the validity of the patent, the assignees may themselves raise the question of validity in an action for the purchase money brought by the assignor (*Nadel* v. *Martin* (1903) 20 R. P. C. at pp. 735, 736).

Future Improvements.—It is not against public policy for the patentee to agree to assign all future improvements on or patent rights with respect to the invention assigned, and an agreement to that effect may be specifically enforced (*Printing Co.* v. *Sampson* (1875) 44 L. J. (N. S.) Eq. 705; *London and Leicester Co.* v. *Griswold* (1886) 3 R. P. C. 251).

In *Pneumatic Tyre Co.* v. *Dunlop* ((1896) 13 R. P. C. 553), D., a patentee, assigned certain patents to P., and covenanted that any improvements on the inventions patented which he should become "possessed" of should be held to be part of the property assigned, and should be duly communicated by D. to P., and that D. should do all acts necessary to vest the improvements in P. D. subsequently became, by purchase, interested with other persons in two patents, which were said to be improvements on the patents assigned. The plaintiffs, who had become possessed of P.'s interest, asked that D. might be ordered to assign the two patents to them. It was held, in the circumstances, that "possessed" meant possessed as an original inventor, or under sole control, and that the covenant did not apply to the two patents.

The purchaser should require the patentee to covenant that any future invention relating to the subject-matter of the patent shall be assigned; not merely any "improvement in or addition to" the invention (see *Davies* v. *Curtis* (1903) 20 R. P. C. 561).

Maintenance of the Patent.—Where the assignment is not an absolute one, *e.g.*, where it is in respect of a particular district, or of only a part of the patent, the payment of the renewal fees should be made the subject of an express covenant (see *King* v. *Oliver* (1884) 1 R. P. C. 23). Apart from any express stipulation, the assignee is under no obligation to keep the patent on foot, at any rate where he is under no obligation to manufacture (*Re Railway Appliances* (1888) 38 C. D. 597).

Infringements.—A legal assignee may sue for an infringement of the patent; and as a grantor must not defeat his own grant, the assignee may sue the assignor if he makes use of the invention assigned (*Hocking* v. *Hocking* (1888) 6 R. P. C. 69). And the assignee of a separate and distinct portion of a patent may sue for an infringement of that part without joining one who has an interest in another part (*Dunnicliff* v. *Mallet* (1859) 7 C. B. (N. S.) 209; and see p. 171, *infra*).

Assignment is consideration of Royalties.—If a patent is assigned in consideration of a lump sum and of the payment of a royalty on all articles manufactured under the patent, the assignee is not, in the absence of express covenant, under any obligation either to manufacture the patented articles, or to keep the patent on foot (*Re Railway Appliances* (1888) 38 C. D. 597).

Reservation of Right to Work Invention Assigned.—The assignment sometimes reserves to the assignor the right to himself use the invention assigned. A reservation clause should clearly express the extent of the right reserved. In *Howard* v. *Tweedales* ((1895) 12 R. P. C. 159) T. assigned a patent, reserving a right to work the patented invention personally, which right was not to be transferable. T. entered into partnership with two others, and by an agreement between him and his firm, he agreed to employ his firm to manufacture articles under the patent on his behalf, and to sell them for him. The Court held that the firm were manufacturers, not as agents for T., but as contractors for him, and granted an injunction to restrain the manufacture.

Liability of Assignee taking with Notice of Prior Assignment.—An assignee, who takes with notice of an original assignment,

takes subject to the liabilities of the original assignee, and if the first assignment provides for an account of profits, he may be sued for these direct (*Werderman* v. *Société Générale d'Électricité* (1881) 19 C. D. 246; explained and distinguished in *Bagot Tyre Co.* v. *Clipper Tyre Co.* [1902] 1 Ch. at p. 157). But see *Wapshare Co.* v. *Hyde* (1901) 18 R. P. C. at p. 378.

Position of Co-owners.—Where a patent is vested in two or more persons, either by virtue of the grant of letters patent (*Mathers* v. *Green* (1865) 1 Ch. 29), or of an assignment (*Steers* v. *Rogers* (1893) 10 R. P. C. 245), each co-owner may work the patent without consent of the other or others, and without accounting to the other or others for the profit he makes. Hence, an agreement should be entered into binding each co-patentee or co-assignee to account.

One co-owner may assign his individual share in the patent (see *Walton* v. *Lavater* (1860) 8 C. B. (N. S.) 162), and sue infringers (see p. 171, *infra*). But no one co-owner can assign the *whole* patent; or cause to be set out in the Register of Patents any entry prejudicing the rights of the other owners; or release the rights of the other owners (*Re Horsley's Patent* (1869) 8 Eq. 475).

Where a patent is assigned by co-patentees, and the assignment contains certain covenants on their part, *e.g.*, that the patent is valid, it should be made clear whether the covenants are to be construed as joint or several (see *National Co.* v. *Gibbs* (1900) 17 R. P. C. 302).

Position of Equitable Assignees.—The position of an equitable assignee is less beneficial than that of a legal owner. His title may be defeated by a subsequent legal assignment (see *Actien Gesellschaft* v. *Temler* (1900) 18 R. P. C. at pp. 14, 15; *Wapshare Co.* v. *Hyde* (1901) 18 R. P. C. 374); he cannot sue infringers without joining the legal owner (*Bowden's Patents* v. *Smith* (1904) 21 R. P. C. 438); and he has, therefore, no defence to an action for threats (*Kensington Electric Co.* v. *Lane-Fox* (1891) 8 R. P. C. at p. 280).

An equitable assignment of a patent, or of a share or interest in a patent, may be entered on the Register of Patents under s. 23 (*Stewart* v. *Casey* (1892) 9 R. P. C. at p. 15; see p. 108, *infra*); but the document must be a complete agreement (*Re Fletcher's Patent* (1893) 10 R. P. C. 252), and one capable of specific performance (*Haslett* v. *Hutchinson* (1891) 8 R. P. C. 457) and, if made before the grant of the patent, must leave no

doubt that it refers to that patent (*Re Parnell's Patent* (1888) 5 R. P. C. at p. 128).

Assignments to War Secretary.—S. 44 of the Act of 1883 provides as follows:—

44.—(1) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor), may (either for or without valuable consideration) assign to Her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of Her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the Comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed, should be kept secret.

(4) If the Secretary of State so certifies, the application and specification or specifications, with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State.

(5) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand of the Secretary of State to receive the same, and shall if returned to the Comptroller be again kept sealed by him.

(7) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the Secretary of State to receive it.

(8) Where the Secretary of State certifies as aforesaid, after an

application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10) No copy of any specification or other document or drawing by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorised by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for same.

Registration of Assignments.—All assignments should be entered on the Register of Patents (as to this, see p. 107, *infra*).

Mortgages.

A mortgagee is not in as favourable a position as an assignee; for the mortgagor remains the person entitled to the patent within the meaning of s. 46 of the Act of 1883 (*Van Gelder* v. *Sowerby Bridge Society* (1890) 7 R. P. C. at p. 211), and may sue infringers without joining the mortgagee (*Van Gelder* v. *Sowerby Bridge Society, supra*, at p. 212). The mortgagee cannot be entered on the Register of Patents as a proprietor under s. 87 of the Act of 1883 (*Van Gelder* v. *Sowerby Bridge Society, supra*; and see p. 109, *infra*).

Voluntary Licences.

The power of granting licences is conferred by the grant of the letters patent. A licence is an authority to do that which without the licence could not be done, and which would be a violation of the patentee's monopoly. Even though it be

exclusive, it confers no interest in property; but a licence may be, and often is, coupled with a grant, and that grant then may convey an interest in property (*Heap* v. *Hartley* (1889) 6 R. P. C. at pp. 500, 501).

Licences may be exclusive or non-exclusive; they may be limited in point of duration or area; and they may be conditional on use only in connection with some other article sold by the licensor.

Form of the Licence.—A licence is usually under seal; but, notwithstanding the express terms of the grant, a deed is not essential (*Chanter* v. *Dewhurst* (1844) 13 L. J. (N. S.) Ex. 198; *Post Card Co.* v. *Samuel* (1889) 6 R. P. C. at p. 562). A licence is not a conveyance within the meaning of s. 7 of the Conveyancing Act, 1881; but it does not follow that the introduction of the words "as beneficial owner" is unimportant (see *per* Lindley, L.J., in *Guyot* v. *Thomson* (1894) 11 R. P. C. at p. 554).

The words "use and exercise" in the grant of a licence confer, in the absence of anything limiting the construction of them, a licence to exercise all the powers under the patent—to make and vend as well as use and exercise (see *per* Vaughan Williams, L.J., in *Dunlop Co.* v. *North British Co.* (1904) 21 R. P. C. at p. 181).

For Forms of Licences, see the Encyclopædia of Forms and Precedents.

Agreement to Grant Licence.—On the execution of an agreement to grant a licence, the parties, in equity, stand in the same position as if they had executed a licence (*Post Card Co.* v. *Samuel* (1889) 6 R. P. C. at p. 562; *Tweedale* v. *Howard* (1896) 13 R. P. C. at p. 531); and an agreement to take a licence may be specifically enforced (*Brake* v. *Radermacher* (1903) 20 R. P. C. 631).

The agreement may be made verbally (*Crossly* v. *Dixon* (1863) 10 H. L. C. 293; *Coppin* v. *Lloyd* (1898) 15 R. P. C. 373), and a memorandum of it subsequently signed may be entered on the Register of Patents (*Re Fletcher's Patent* (1893) 10 R. P. C. at p. 255).

An agreement to grant a licence may be made, and a licence may be granted, prior to the issue of the patent (*Otto* v. *Singer* (1890) 7 R. P. C. 7; and see *Re Parnell's Patent* (1888) 5 R. P. C. 126). If the licence is to be to use the invention for which provisional protection has been obtained, the effect of letters patent being granted for an invention *less* than the whole

invention described in the provisional specification should be considered (see *Otto* v. *Singer*, *supra*).

For Forms of Agreements for Licences, see the Encyclopædia of Forms and Precedents.

Exclusive Licences.—An exclusive licence, unlimited as to area, closely resembles an absolute assignment; but a licensee, unlike an assignee, cannot sue for an infringement (*Heap* v. *Hartley* (1889) 6 R. P. C. 495).

An exclusive licence, unless the contrary is stated, will not be construed as applying only to a particular business (see *Bown* v. *Humber Co.* (1889) 6 R. P. C. 9).

Where the licence is not to be an exclusive one, it is commonly provided that if the licensor grants more favourable terms to future licensees, the licensee is to be entitled to a corresponding reduction of royalties.

Licences to Purchasers.—A licence to manufacture a patented article imports a licence to the licensee and his purchasers to sell it (*Thomas* v. *Hunt* (1864) 17 C. B. (N. S.) 183). And the sale of a patented article imports a licence to use and resell it (*Incandescent Co.* v. *Cantelo* (1895) 12 R. P. C. 262; *Heap* v. *Hartley* (1888) 5 R. P. C. at p. 609; (1889) 6 R. P. C. 495).

But an article may be sold subject to conditions, *e.g.*, subject to use only in connection with another article supplied by the licensor; and persons who *buy with notice* of the condition are bound by it (*Incandescent Co.* v. *Brogden* (1899) 16 R. P. C. 179), but not if they buy without notice (*Incandescent Co.* v. *Cantelo* (1895) 12 R. P. C. 262).

As to a licence to use a patented article made in a particular way, see *Dunlop Co.* v. *Buckingham Co.* (1901) 18 R. P. C. 423; *Dunlop Co.* v. *Creswell* (1901) 18 R. P. C. 473.

An exclusive licensee for the sale of a patented article within a certain district cannot restrain the user of the article within the district if the person using it bought it outside the district and without notice of the licence; and the fact that the licence was entered in the Register of Patents is not sufficient to affect the purchaser with notice (*Heap* v. *Hartley* (1888) 5 R. P. C. 603; (1889) 6 R. P. C. 495).

If a licensor grants a licence to use a patented machine on condition that the machine is to remain the property of the licensor, and to be removable on notice, and the licensee's landlord distrains and sells the machine, the purchaser, if he had notice of the conditional licence, will not be allowed to use the

machine (*British Mutoscope Co.* v. *Homer* (1901) 18 R. P. C. 177).

Validity of Patent.—During the term of the licence, the licensee, in the absence of express provision, is estopped from disputing the validity of the patent (*Ashworth* v. *Law* (1890) 7 R. P. C. at p. 234; *Useful Patents* v. *Rylands* (1885) 2 R. P. C. at p. 261; *Mills* v. *Carson* (1893) 10 R. P. C. at p. 17); and he must continue to pay the royalties reserved, notwithstanding that the patent has been declared void or has been ordered to be cancelled (*African Gold Co.* v. *Sheba Gold Co.* (1897) 14 R. P. C. at p. 663).

But the doctrine that a licensee may not dispute the validity of the patent applies only to one who has obtained a licence, and not to one who can only become a licensee on complying with certain terms and conditions (*Basset* v. *Graydon* (1897) 14 R. P. C. at p. 709). And the validity of the patent may be questioned by the licensee when his licence has been determined (*Dangerfield* v. *Jones* (1865) 13 L. T. (N. S.) 142); the licensee is entitled to determine the licence and immediately afterwards say that the patent is bad (*Redges* v. *Mulliner* (1892) 10 R. P. C. at p. 27).

The right to contest the validity of the patent is sometimes expressly conferred. If there is a condition that the licence shall determine if the invention is declared invalid, and the invention is declared invalid by a competent Court but the decision is reversed on appeal, the former decision cannot be relied upon (*Cheetham* v. *Nuthall* (1893) 10 R. P. C. 321). If a licence is taken "subject to the result of an inquiry into the validity of the patent," the licensee cannot dispute the validity if he has worked under the patent, without inquiry, for a considerable time (see *Wilson* v. *Union Oil Mills* (1891) 9 R. P. C. at p. 63).

Although a licensee is estopped from questioning the validity of the patent, it is open to him, of course, when sued for royalties, to show that what he has done does not fall within the limits of the patent (*Clark* v. *Adie* (1877) 2 A. C. 423; *Crosthwaite* v. *Steel* (1889) 6 R. P. C. 190; *Neil* v. *Macdonald* (1902) 20 R. P. C. 213; *Davies* v. *Curtis* (1903) 20 R. P. C. 561).

As a licensor cannot derogate from his grant, he cannot dispute the validity of the patent as against his licensee (*Gonville* v. *Hay* (1903) 21 R. P. C. at p. 51).

Infringements.—As has been already mentioned, a licensee—even though his licence be an exclusive one—cannot sue

infringers alone (*Heap* v. *Hartley* (1889) 6 R. P. C. 495). But where the licence is exclusive, the licensee is usually expressly authorised to take action and to use the name of the licensor upon an indemnity being given as to costs. Sometimes it is stipulated that the licensor shall not commence proceedings for infringement without the consent of the licensee (see *Guyot* v. *Thomson* (1894) 11 R. P. C. at p. 544).

If the licensor covenants to take action against any infringers, and that, if he fails to do so, he will not call upon the licensees to pay any further royalties, the covenant does not come into operation until the licensor has notice of an infringement, and until after the lapse of a reasonable time for instituting proceedings (*Henderson* v. *Mostyn Copper Co.* (1868) 3 C. P. 202).

If it is provided that the licensor shall prosecute infringers till "final judgment," his undertaking does not, probably, cease on obtaining a judgment from a Court of first instance (see *Commercial Corpn.* v. *Atkins* (1902) 19 R. P. C. 93).

Maintenance of the Patent.—In the absence of any express or implied agreement, it seems that neither the licensee nor the licensor is bound to keep the patent on foot (see *Re Railway Appliances* (1888) 38 C. D. 597; *Mills* v. *Carson* (1892) 9 R. P. C. 338; (1893) 10 R. P. C. 9). The matter of payment of the renewal fees should, therefore, be the subject of an express stipulation.

If, however, the licensor undertakes to protect and defend the patent from all infringements, he must pay the fees necessary to keep the patent on foot (*Lines* v. *Usher* (1897) 14 R. P. C. 206).

Payment of Royalties.—As a licence reserving royalties does not oblige the licensee to manufacture (see *Railway Appliances* (1888) 38 C. D. 597; *Cheetham* v. *Nuthall* (1893) 10 R. P. C. at p. 333), it is sometimes provided that the licensee shall make a certain number of the patented articles each year, or shall guarantee that the royalties payable in each year shall reach a certain sum.

In the absence of agreement to the contrary, the licensee must continue to pay the royalties reserved, notwithstanding that the patent has been declared void or has been cancelled (*African Gold Co.* v. *Sheba Gold Co.* (1897) 14 R. P. C. at p. 663).

Where a licence to use several patents was granted during the residues unexpired of the terms of the patents, and it was provided that the royalties reserved should continue until the expiration of all the terms granted by the patents, it was held

that royalties must be paid for the use of any of the inventions so long as any of the patents were subsisting (*Siemens* v. *Taylor* (1892) 9 R. P. C. 393).

When sued for royalties it is open to the licensee to show that what he is doing is not within the patentee's specification (see p. 99, *supra*). It is therefore sometimes provided that any further invention relating to the patented invention discovered by either party shall be subject to the terms of the licence; if it is merely provided that any subsequent "improvement in or addition to" the invention shall be deemed to be included in the licence, the licensor may find that the licensees are working an invention which, though very similar to his, is not an "improvement or addition" (see *Davies* v. *Curtis* (1903) 20 R. P. C. 561).

Assignment of Licences.—A licence is not assignable unless a contrary intention is expressed or implied, *e.g.*, where granted to the licensee and his assigns (*Bower* v. *Hodges* (1853) 22 L. J. (N. S.) C. P. 194; *Lawson* v. *Macpherson* (1897) 14 R. P. C. at p. 697).

But although not expressly or impliedly assignable, the licensor cannot impeach an assignment if he has acquiesced in it, *e.g.*, accepted royalties from the assignee (*Lawson* v. *Macpherson*, *supra*).

Revocation of Licences.—A mere licence, whether exclusive or not, and whether verbal (*Coppin* v. *Lloyd* (1898) 15 R. P. C. 373) or written (*Redges* v. *Mullner* (1893) 10 R. P. C. at p. 27; *Ward* v. *Livesey* (1888) 5 R. P. C. at p. 106; (1896) 13 R. P. C. 710), is revocable at will.

But a licence coupled with an interest (*Ward* v. *Livesey*, *supra*), or coupled with obligations both on the licensor and licensee (*Guyot* v. *Thomson* (1894) 11 R. P. C. at pp. 553, 554), or containing terms which are inconsistent with the right to revoke (*Guyot* v. *Thomson*, *supra*, at p. 554), is not revocable at will. Where a lump sum is to be paid as well as royalties, the licence will, it seems, be treated as irrevocable, at any rate at the instance of the licensor (*Guyot* v. *Thomson*, *supra*, at p. 554); and where the words "as beneficial owner" are introduced, the presumption is that the licence was intended to be irrevocable (*Guyot* v. *Thomson*, *supra*).

Registration of Licences.—Every licence should be entered on the Register of Patents (see p. 107, *infra*).

Compulsory Licences.

Prior to the Patents Act, 1902, the power to order the grant of a compulsory licence was vested in the Board of Trade (see s. 22 of the Act of 1883). S. 22 has been repealed by s. 3 of the Act of 1902, and the jurisdiction is now vested in the Judicial Committee of the Privy Council.

S. 3 (1) of the Act of 1902 (which applies to patents granted before as well as after the commencement of the Act (sub-s. 11)) provides that any person *interested* may present a petition to the Board of Trade alleging that "*the reasonable requirements of the public with respect a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.*"

The Board of Trade must consider the petition, and if the parties do not come to an arrangement between themselves, the Board, if satisfied that a *primâ facie* case has been made out, must refer the petition to the Judicial Committee of the Privy Council, and, if the Board are not so satisfied, they may dismiss the petition (sub-s. 2).

If the petition is referred to the Judicial Committee, and the Committee are satisfied that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licences on such terms as the Committee may think just, or, if the Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by Order in Council; but no order for revocation can be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default (sub-s. 3).

If it is proved to the satisfaction of the Judicial Committee that the patent is worked or that the patented article is manufactured exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public *have been* satisfied, the petitioner is entitled to an order for a compulsory licence or, subject to the above proviso, to an order for revocation (sub-s. 5).

When "Reasonable Requirements of Public" not Satisfied.—The "reasonable requirements of the public" are not to be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented

article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, (*a*) any existing industry or the establishment of any new industry is unfairly prejudiced, or (*b*) the demand for the patented article is not reasonably met (sub-s. 6).

THE ORDER.—An Order in Council directing the grant of a licence operates, without prejudice to any other mode of enforcement, as if it were embodied in a deed granting a licence and made between the parties to the proceedings (sub-s. 7).

Parties.—On the hearing of any petition the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, must be made parties to the proceeding, and the Law Officer or such other counsel as he may appoint is entitled to appear and to be heard.

Costs.—The costs are in the discretion of the Judicial Committee; but the Committee, in awarding costs, may have regard to any previous application for, or offer of, a licence, made either before or after the application to the Committee (sub-s. 9).

Proceedings before the Board of Trade.—The proceedings before the Board of Trade are governed by the Patents Rules, 1903, Rules 69—75. These are as follows:—

> 69. A petition to the Board of Trade for an order under section 3 of the Patents Act, 1902, shall show clearly the nature of the petitioner's interest and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order, and the name and address of the patentee and any other person who is alleged in the petition to have made default.
>
> 70. The petition and an examined copy thereof shall be left at the Patent Office accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition together with any other documentary evidence in support, and the petitioner shall simultaneously with, or as soon as may be after the leaving of such petition deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.
>
> 71. The persons to whom such copies are delivered by the petitioner, may within fourteen days after being invited to do so by the Board of Trade leave at the Patent Office their affidavits or statutory declarations in answer, and if they do so shall deliver copies thereof to the petitioner, and the petitioner may within fourteen days from

such last-mentioned delivery leave at the Patent Office his affidavits or statutory declarations in reply, and if he does so shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default, such last-mentioned affidavits or statutory declarations being confined to matters strictly in reply.

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

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

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

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

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

Proceedings before the Judicial Committee.—These are governed by the Privy Council Rules, 1908, and are as follows:—

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

II. (*a*) No application to fix a time for hearing the petition shall be made unless the petitioner shall have previously given notice to the patentee, to the opponents, and to any other person claiming

an interest in the patent as exclusive licensee or otherwise, that the petition has been referred to the Judicial Committee, that it is his intention to apply to the Judicial Committee on a specified day, which day shall be not less than four weeks from the date when the notice is served or sent, to fix a time for hearing the petition, and that any person desiring to be heard before the Judicial Committee at the time so fixed must enter a caveat at the Council Office on or before the day so specified.

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

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

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

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

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

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

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

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

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

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

X. Applications to the Judicial Committee to fix a time for hearing the petition and on other matters of procedure shall be addressed in the first instance to the Registrar of the Privy Council, who shall take their Lordships' instructions thereon and communicate the same to the parties. In cases of doubt the Registrar may, or, if so requested by any of the parties, he shall enter the application for hearing before their Lordships' Board.

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

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

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

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

XIV. The Judicial Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition. Counsel on behalf of the Crown is not required to give notice of the grounds of any objection he may

think fit to take or of any evidence which he may think fit to place before the Committee.

XV. Costs incurred in the matter of any petition under this Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Judicial Committee to tax the same, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

Registration of Patents.

The "Register of Patents."—There is kept at the Patent Office a Register of Patents, wherein must 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 of or proprietorship" of patents as may from time to time be prescribed (s. 23 (1) of the Patents Act, 1883).

The Register is *prima facie* evidence of any matters by the Act directed or authorised to be inserted therein (s. 23 (2), *ibid.*; see *Jandus* v. *Johnson* (1900) 17 R. P. C. at p. 374).

Registration under the Act is not, in itself, notice to the world of the entries registered (see *Heap* v. *Hartley* (1888) 5 R. P. C. at p. 608; (1889) 6 R. P. C. at p. 499; and see *New Ixion Tyre Co.* v. *Spilsbury* (1898) 15 R. P. C. 567).

Entry of Patent Grants.—Upon the sealing of a patent the Comptroller must cause to be entered in the Register the name, address, and calling of the patentee as the grantee thereof, and the title of the invention, together with the address for service (Patents Rules, 1903, Rule 51). A patent granted on any Convention application must be entered in the Register as dated of the date on which the first foreign application was made (Rule 52, *ibid.*).

Entry of Payment of Renewal Fees.—Upon the issue of a certificate of payment of the renewal fee, the Comptroller must cause to be entered in the Register a record of the date of payment of the fee on such certificate (Rule 61, *ibid.*). If a patentee fails to make any prescribed payment within the prescribed time, or any enlargement thereof duly granted, there must be entered in the Register a notification of such failure (Rule 62, *ibid.*).

Entry of Judicial Orders.—Where an order has been made by His Majesty in Council for the extension of a patent for a

further term, or for the grant of a new patent, or where an order has been made for the revocation of a patent or the rectification of the Register under s. 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 must forthwith leave at the Patent Office an office copy of such order. The Register must thereupon be rectified, or the purport of such order must otherwise be duly entered in the Register, as the case may be (Rule 60, *ibid.*).

Right to be Entered as "Proprietor."—Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, the Comptroller must 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 (s. 87 of the Patents Act, 1883; Patents Rules, 1903, Rule 54). There is no obligation on an assignee to register the assignment if he does not wish to. Of course, he takes his chance, if he does not, of having his title defeated by someone else who does register (*New Ixion Tyre Co.* v. *Spilsbury* (1898) 15 R. P. C. at p. 571).

Effect of Registration as "Proprietor."—The person for the time being entered in the Register as proprietor of a patent has, subject to the provisions of the Act and to any rights appearing from the Register to be vested in any other person, 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 (s. 87, *ibid.*, as amended by s. 21 of the Patents Act, 1888). But any equities in respect of the patent may be enforced in like manner as in respect of any other personal property (s. 87, *ibid.*); as to the meaning of this, see *New Ixion Tyre Co.* v. *Spilsbury* (1898) 15 R. P. C. at p. 571.

Entry of Equitable Assignments.—Legal proprietorship is that which is dealt with by s. 87, and the person who is the proprietor of the patent means the proprietor of the patent in *law* (*Stewart* v. *Casey* (1892) 9 R. P. C. at p. 13). An equitable assignee cannot, therefore, be registered as "proprietor" under s. 87. But an equitable assignment of a patent, or of a share or interest in a patent, may be entered in the Register under s. 23 of the Act as a document "affecting the proprietorship" of a patent (*Stewart* v. *Casey* (1892) 9 R. P. C. 9), so long as it is complete in itself and capable of specific performance (see p. 94, *supra*).

Entry of Mortgages.—Mortgages may be entered in the Register under s. 23 as documents "affecting the proprietorship"; but a mortgagee cannot be entered as "proprietor" under s. 87 (*Van Gelder* v. *Sowerby Bridge Society* (1890) 7 R. P. C. at p. 212).

Entry of Licences.—A notification of a licence may be entered under s. 23.

Entry of Verbal Agreements.—Verbal agreements cannot be entered in the Register; but a memorandum of a verbal agreement subsequently signed may be entered under s. 23 (see *Re Fletcher's Patent* (1893) 10 R. P. C. at p. 255).

Entry of Agreements made Prior to Grant of Patent.—A document dated before the grant of the patent affected by it cannot be entered in the Register, either under s. 23 or s. 87, unless, it seems, the document was entered into immediately before the issue of the patent, and is so clear and precise as to leave no doubt as to the proposed patent referred to in it (see *Re Parnell's Patent* (1888) 5 R. P. C. 126).

Trusts cannot be Entered.—No notice of any trust, expressed, implied, or constructive, can be entered on the Register (s. 85 of the Patents Act, 1883; see *Haslett* v. *Hutchinson* (1891) 8 R. P. C. 457). But s. 85 only excludes from registration notices of trusts, as distinct from documents which create trusts in equity; the entry of an equitable assignment is not to be refused simply because the assignment creates a trust (*Stewart* v. *Casey* (1891) 9 R. P. C. at p. 15).

Application for Registration as "Proprietor."—Where a person becomes entitled to a patent, or to any share or interest therein, by assignment, or by transmission, or other operation of law (see p. 108, *supra*), a request for the entry of his name in the Register as such complete or partial proprietor, or of such share or interest therein, must be addressed to the Comptroller, and left at the Patent Office (Patents Rules, 1903, Rule 54).

The request must be on Form E., and must in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by its agent, authorised in like manner (Rule 55, *ibid.*). It must state the name, address, and calling of the person claiming to be entitled to the patent, or to any share or interest therein, and

the particulars of the assignment, transmission, or other operation of law, by virtue of which he claims to be entered in the Register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein, has been assigned or transmitted (Rule 56, *ibid.*).

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 the request, except such documents as are matters of record, must, unless the Comptroller in his discretion otherwise directs, be produced to him, together with the request and such other proof of title as he may require for his satisfaction. As to a document which is a matter of record, an official or certified copy thereof must be produced (Rule 57, *ibid.*).

There must also be left with the request an attested copy of the assignment or other document or copy required to be produced (Rule 58, *ibid.*).

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

Correction of Clerical Errors or Address.—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 (s. 91 of the Patents Act, 1883). The request should be on Form P.

If a patentee sends to the Comptroller on Form R. notice of an alteration in his address, the Comptroller will cause the Register to be altered accordingly, and may require the altered address to be in the United Kingdom (Rule 53, *ibid.*), or the Isle of Man (Rule 3, *ibid.*).

If a company is registered as "proprietor," and subsequently changes its name, alteration of name may be made by the Comptroller under s. 87 of the Act of 1883 (*Re New Ormonde Co.'s Trade Mark* (1896) 13 R. P. C. 475).

Rectification of Register at Instance of Person Aggrieved.—S. 90 (1) of the Patents Act, 1883, as amended by s. 23 of the Act of 1888, provides that 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 the 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.

The grievance must be a legal grievance; it must be a *stet pro ratione voluntas*. The applicant must show that it tends to his injury or to his damage in the legal sense of the word (see *per* Selborne, L.C., in *Re Riviere's Trade Mark* (1884) 26 C. D. 48; and see *Re Powell's Trade Mark* (1894) 11 R. P. C. 4).

A person is not "aggrieved" merely because the Comptroller has refused to grant him a patent (see *Re Normal Co.'s Trade Mark* (1887) 4 R. P. C. 123); and a common informer (*Re Powell's Trade Mark* (1894) 11 R. P. C. at p. 7; *Re Apollinaris Co.'s Trade Mark* (1890) 8 R. P. C. 137), or a person interfering from sentimental motives only (see *per* Fry, L.J., in *Re Apollinaris Co.'s Trade Mark*, *supra*, at p. 160), is not an aggrieved person.

Although a grievance in the sense intended by the section does not mean mere annoyance, yet it is not necessary that the applicant should prove that he is suffering serious damage (see *per* Fry, L.J., in *Apollinaris Co.'s Trade Mark*, *supra*, at p. 160).

If an entry in the Register is wrongly made in the first instance, but, in events which happen, subsequently becomes correct, the application will be refused (see *Re Manning's Patent* (1902) 20 R. P. C. 74).

The words "made without sufficient cause" refer to entries made at any time; they are not confined to entries made at the time of registration (*Re Batt & Co.'s Trade Mark* (1898) 15 R. P. C. at p. 539).

Procedure on Application for Rectification of Register.—The Act says nothing whatever about the method of procedure to rectify the Register; and the Rules do not prescribe how applications are to be made (see *per* Lindley, L.J., in *Re King & Co.'s Trade Mark* (1892) 9 R. P. C. at p. 360).

The application may be by motion or summons; but not, it

seems, by way of counter-claim (see *Pinto* v. *Badman* (1891) 8 R. P. C. at p. 187). The usual practice is by motion.

As, however, no special procedure is prescribed, it is sufficient, it seems, to give the opponent a written notice of the application, and an opportunity of showing cause why it should not be entertained. "There is no magic in a notice of motion. . . . All that you have to do is to take care that your opponent is there, and tell him that you are going to apply for an order—an order, not on him, but on the Comptroller; an order to rectify the Register" (per Lindley, L.J., in *Re King & Co.'s Trade Mark*, *supra*, at pp. 360, 361). But the notice should be full and sufficient to protect the opponent's rights in every respect (see *per* Bowen, L.J., in *Re King & Co.'s Trade Mark*, *supra*, at p. 365).

There is no power to serve a notice of motion out of the jurisdiction, nor in the Court to give leave for such service. Where the person affected is a foreigner, the proper course, it seems, is to serve notice of motion on the Comptroller, and to send a letter to the foreigner, accompanied by a copy of the notice, stating that an application will be made on the day mentioned in the notice affecting his interest (see *La Compagnie Générale d'Eaux Minérales* (1891) 8 R. P. C. 446).

The High Court of Justice in England has jurisdiction to make an order for rectification where the person affected is a person domiciled in Scotland or Ireland (*Re King & Co.'s Trade Mark* (1892) 9 R. P. C. at p. 364).

The Court may in any proceeding under s. 90 decide any question that it may be necessary or expedient to decide for the rectification of the 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 (sub-s. 2).

The costs are in the discretion of the Court (see p. 111, *supra*).

Any order of the Court rectifying the Register must direct that due notice of the rectification be given to the Comptroller (sub-s. 3).

Effect of Making False Entries.—If any person makes or causes to be made a false entry in the Register, or a writing falsely purporting to be a copy of an entry in the Register, or produces or tenders or causes to be produced as tendered in evidence any such writing, knowing the entry or writing to be false, he is guilty of a misdemeanour (s. 93 of the Patents Act, 1883).

Inspection of the Register.—The Register of Patents is open to the inspection of the public on every week-day except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days and the times following:—(*a*) Christmas Day, Good Friday, the day observed as His Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; (*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 (s. 88 of the Patents Act, 1883; Patents Rules, 1903, Rule 64).

Certified Copies of Entries in Register.—Certified copies of any entry in the Register may be obtained by any person requiring the same, on payment of the prescribed fee (s. 88 of the Patents Act, 1883; Patents Rules, 1903, Rule 65).

A certificate purporting to be under the hand of the Comptroller as to any entry is *primâ facie* evidence of the entry having been made, and of the contents thereof (s. 96, *ibid.*).

Copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from the Register, are admissible in evidence in all Courts, and in all proceedings, without further proof or production of the originals (s. 89, *ibid.*).

CHAPTER VI.

Revocation of Patents.

GROUNDS FOR REVOCATION—WHO MAY PETITION—THE PROCEDURE—EVIDENCE—APPEALS.

It has already been mentioned that a patent may be revoked under s. 3 of the Patents Act, 1902, if the reasonable requirements of the public with respect to the patented article have not been satisfied (see p. 102, *supra*). In this chapter it is proposed to consider the revocation of a patent on petition to the High Court under s. 26 of the Patents Act, 1883.

No proceeding by petition or otherwise lies for revocation of a patent granted for an invention in relation to which the Secretary of State for War has certified under s. 44 (9) of the Patents Act, 1883 (see p. 95, *supra*).

Grounds for Revocation.—By virtue of s. 26 of the Act of 1883 a patent may be revoked—

(*a*) On the ground that the patent was obtained in fraud of the petitioner's rights, or of the rights of any person under or through whom he claims (see p. 117, *infra*; *Re Avery's Patent* (1887) 4 R. P. C. 322; *Re Jameson's Patent* (1902) 19 R. P. C. at p. 254).

(*b*) On the ground that the petitioner, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee (see p. 117, *infra*; *Walker* v. *Hydro-Carbon Syndicate* (1884) 2 R. P. C. 3).

(*c*) On the ground that the petitioner, 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 (see p. 117, *infra*; *Re Haddan's Patent* (1885) 2 R. P. C. 218; *Re Edmond's Patent* (1889) 6 R. P. C. 355; *Re Taylor's Patent* (1896) 13 R. P. C. 482).

(*d*) On any ground on which a patent might, at the commencement of the Act of 1883, have been repealed by *scire facias*.

The grounds on which a patent might formerly have been

repealed by *scire facias* were "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty or utility, or abuse of the privileges granted by the letters patent" (Webster's Letters Patent, p. 32).

A patent may be revoked if the invention was not proper subject for a patent (see p. 1, *supra*); or if the invention was not new (see p. 7, *supra*) or useful (see p. 16, *supra*); or if the patentee was not the true and first inventor (see p. 26, *supra*); or if the specifications are defective (see pp. 56, 59, *supra*).

The mere fact that the patent was taken out to evade the provisions of an Act of Parliament is no ground for revocation of the patent (*Re Vaisey's Patent* (1894) 11 R. P. C. at p. 593).

In *Re Morgan's Patent* ((1888) 5 R. P. C. 186) the grounds raised, and held to be properly raised, were: (1) That the patentee was not the inventor of the alleged invention; (2) want of novelty; (3) disconformity; (4) prior publication; and (5) prior user. In *Re Goulard's Patent* ((1888) 5 R. P. C. at p. 529), where the fiat of the Attorney-General had been obtained, the objections taken to the patent were: (1) Want of novelty; (2) absence of sufficient invention; (3) that certain of the claims were for principle only; want of utility; (5) absence of a proper specification; (6) that the specification did not describe or ascertain the nature of the invention or the manner of performing it; (7) that the specification did not distinguish what was old from what was new; (8) that the specification was vague and calculated to mislead the public in certain specified particulars; and (9) disconformity.

Fraud.—Where the petitioner alleges that the patent was obtained "in fraud of his rights, or the rights of any person under or through whom he claims" (see p. 117 *infra*), the petitioner must prove that the patentee has been guilty of dishonest or culpable acts in obtaining the patent (see *Re Avery's Patent* (1887) 4 R. P. C.—*per* Stirling, J., at p. 165, *per* Cotton, L.J., at pp. 326, 327; and see *Re Jameson's Patent* (1902) 19 R. P. C. at p. 254). In the former case the patentee—who was advised by a patent agent that he was an inventor within the meaning of the Patent Law—applied for a patent, made a statutory declaration that he was the true and first inventor, and did not disclose the fact that part of the invention had been communicated from abroad. The patent having been granted, it was argued in the proceedings for revocation that the patent had been granted

in fraud of the petitioner's rights—he having instructed an agent in England to obtain a patent here for a part of the invention, and the agent having appointed the patentee his substitute—and that the statement that the patentee was the inventor was so recklessly untrue as to be evidence of fraud. It was held, on the evidence, that the patentee had made only an innocent mistake, and did not act in fraud of the rights of the petitioner, his principal. "The mere fact," said Cotton, L.J., "that an agent makes an honest mistake, even though that may cause loss to the principal, is not, in my opinion, an act done in fraud of the rights of the principal. . . . To be in fraud of his rights it must be either done with the intention of depriving the principal of his rights, or must be insisted upon so as to deprive the principal of his rights." This patent, however, might have been revoked on the ground that the patentee was not the true and first inventor (see pp. 327, 328); and the petition was dismissed without prejudice to any petition which the petitioner might present as a person alleging that he was the true inventor of any of the inventions included in the claim of the patent.

Patents were revoked on the ground of having been obtained in fraud of the petitioner's rights in the following circumstances:—

(*a*) The respondent and petitioner jointly applied for provisional protection. The application lapsed. Subsequently the respondent, unknown to the petitioner, and in breach of a partnership agreement, applied for and obtained a patent alone for the same invention (*Re Gale's Patent* (1891) 8 R. P. C. 438).

(*b*) A patent was granted to N. The evidence showed that the experiments resulting in the patented invention were made by C. with the assistance of H., that C. was the true and first inventor of the principal of the invention, and that the patent was taken out so as to deprive C. of his rights and gain an advantage for N. (*Re Norwood's Patent* (1895) 12 R. P. C. 214; and see *Re Norwood's Patent* (No. 2) (1898) 15 R. P. C. 98).

(*c*) A patent was granted to M. and N., who were directors of a company in which W., a workman, was employed. M. had asked W. to invent a tap which would, by the introduction of steam into cold water, give hot, cold, or warm water as required. W. perfected the tap in all details. M. paid him 10*l*. for overtime work on the models. W. presented a petition for revocation of the patent, which was revoked on the ground that it had been obtained in fraud of his rights (*Re Marshall's Patent* (1900) 17 R. P. C. 553).

Where a patent has been revoked on the ground of fraud,

the Comptroller may, on the application of the true inventor, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent revoked, but the patent so granted ceases on the expiration of the term for which the revoked patent was granted (s. 26 (8) of the Patents Act, 1883). If revoked on other grounds, the Comptroller has no such power (see *Re Marshall's Patent* (1900) 17 R. P. C. at p. 556; *Re Norwood's Patent* (1895) 12 R. P. C. at p. 219). Hence, it is most desirable to obtain a declaration that the patent was obtained in fraud of the petitioner's rights. But it is not a matter of course that the Comptroller will grant a new patent. He *may* grant the patent; he therefore has a discretion in the matter (*Re Norwood's Patent* (1895) 12 R. P. C. at p. 219).

Patentee not True Inventor. — If the petitioner relies upon the fact that he was the true inventor (see *infra*), the issue is, Does the respondent's invention so resemble the invention of the petitioner as that it constitutes an infringement? (see *per* Bacon, V.-C., in *Walker* v. *Hydro-Carbon Syndicate* (1884) 2 R. P. C. at p. 10). If the petitioner's invention was described in a prior specification, the respondent may prove the state of common knowledge so as to narrow the ambit of the petitioner's claim (*Walker* v. *Hydro-Carbon Syndicate*, *supra*).

Who may Petition for Revocation.—A petition for revocation 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 (s. 26 (4) of the Act of 1883).

Paragraphs (*c*), (*d*), and (*e*) are not to be construed as stating the only grounds that can be alleged in the petition; for, as has been stated, every ground on which a patent might, at the

commencement of the Act of 1883, be repealed by *scire facias* is a ground for revocation (see p. 114, *supra*). But if a person attacks a patent on grounds other than (*c*), (*d*), or (*e*), he must bring himself within paragraph (*b*), *i.e.*, he must obtain the fiat of the Attorney-General (*Re Morgan's Patent* (1888) 5 R. P. C. 186). Under paragraphs (*c*), (*d*), or (*e*) the petitioner may present his petition without leave of the Attorney-General; and if qualified to present his petition under any of those paragraphs, he may impeach the patent on any other ground (*Re Morgan's Patent*, *supra*). But if he alleges that he is the true and first inventor, and also prior publication, he must obtain the fiat of the Attorney-General, as these allegations are inconsistent; evidence to prove prior publication would rebut the allegation of true and first inventor (*Re Jameson's Patent* (1902) 19 R. P. C. 246). In Scotland the concurrence of the Lord Advocate is always necessary (s. 109 (1) of the Patents Act, 1883).

How to Obtain Fiat of Attorney-General.—If the petitioner is not qualified to present his petition under heads (*c*), (*d*), or (*e*) of sub-s. 4 (see p. 117, *supra*), he must obtain the fiat of the Attorney-General authorising the presentation of his petition. And if there is any doubt about his being so qualified, the fiat should be obtained; for the Court will not hear the petitioner on any ground if it appears that he has no *locus standi* (see *per* Cotton, L.J., in *Re Avery's Patent* (1887) 4 R. P. C. at p. 326; *Re Dodge's Patent* (1895) 12 R. P. C. at pp. 452, 453). The fiat, however, may be applied for after the petition has been presented; and the Court may order the petition to stand over until the fiat has been obtained (*Re Dodge's Patent* (1895) 12 R. P. C. 448; and see *Re Jameson's Patent*, *supra*).

To obtain the Attorney-General's authority under sub-s. 4 (*b*), the following papers must be sent to the Law Officers' Clerk, Royal Courts of Justice (room 549), London:—(1) Memorial to the Attorney-General asking for his authority and stating all the circumstances; (2) statutory declaration verifying the statements in the memorial; (3) two copies of the proposed petition and of the particulars proposed to be delivered with it; (4) certificate of a barrister that the petition is proper to be authorised by the Attorney-General; (5) certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful (see Griff. P. C. pp. 319, 320); and (6) declaration that the validity of the patent cannot be disputed in any legal proceedings then pending.

The Attorney-General sometimes gives or refuses his authority *ex parte*. In some cases he directs notice to be given to the parties and directs the parties to be heard before him (Griff. P. C. 320).

The Attorney-General has no power to give costs in these cases (*Welch's Application*, Griff. P. C. 320; but see s. 38 of the Act of 1883), though the costs of the application are sometimes by consent made costs in the action (*Vicker's Application*, Griff. P. C. 320).

In *Ferranti's Application* (Griff. P. C. 320), and in the *Application of King's Trustees* (*ibid.*), the authority was given without directing any notice to be given to the patentees.

See, further, the cases referred to in Griffin's Patent Cases at p. 320.

The fiat will not be granted as a matter of course; but in practice it is never refused in a reasonable case (*per* Romer, J., in *Re Dodge's Patent* (1895) 12 R. P. C. at p. 452; and see *per* Smith, L.J., in *Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at p. 533).

The Procedure.

The proceeding by *scire facias* to repeal a patent is abolished, and revocation is now obtained by petition to the Court (s. 26 (1) and (2) of the Patents Act, 1883). "The Court" means, in England, His Majesty's High Court of Justice in England (s. 117), and in Ireland the High Court of Justice in Ireland (s. 111 (1)).

In Scotland, the proceedings for revocation of a patent are 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; and service of all writs and summonses in that action must be made according to the forms and practice existing at the commencement of the Act of 1883 (s. 109; see *Weir* v. *Denny* (1894) 11 R. P. C. 657; *Montgomerie* v. *Paterson* (1894) 11 R. P. C. 221, 633).

A petition for revocation may be sent for trial at the Assizes before a Judge without a jury (see *Re Edmond's Patent* (1889) 6 R. P. C. 355).

Subject to sub-ss. 5, 6, and 7 of s. 26, the Act leaves the practice to be governed by the ordinary practice upon a petition to the High Court; and the petitioner may administer interrogatories to the respondent (*Haddan's Patent* (1884) Griff. P. C. at p. 109).

The Petition.—The petition must be presented in the name of the person qualified to present it; an attorney of the qualified

petitioner cannot present it (see *Re Avery's Patent* (1887) 4 R. P. C. 152). All persons beneficially interested in the patent at the date of the presentation of the petition must be made respondents (*Re Avery's Patent, supra*). Where a patent was assigned after the petition was presented, the assignee was allowed to be made a respondent in the place of the patentee on 50*l.* being paid into Court as security for costs (*Re Haddan's Patent* (1885) 2 R. P. C. 218).

If the petitioner is not qualified as of right to present the petition, he must obtain the fiat of the Attorney-General (see p. 118, *supra*).

The petition should be served in the usual way. But the Act contains no special provision as to the service of the petition, and where the respondent is out of the jurisdiction, personal service will not be required. The Court will merely require in the interests of justice that the patentee has full notice of the proceedings (see *Re Drummond's Case* (1889) 6 R. P. C. 576; *Re Goerz's Patent* (1895) 12 R. P. C. 370). In *Re Cercke's Patent* ((1898) 15 R. P. C. at p. 501) Romer, J., directed notice of the proceedings and copies of the petition and of the particulars of objections to be sent under registered cover to the respondent, who was abroad. The respondent did not appear at the hearing, and the patent was revoked; but no order was made as to costs. Similar directions were given in *Re Hirschfeld's Patent* ((1894) 11 R. P. C. at p. 515), and in *Re Allison's Patent* ((1900) 17 R. P. C. 297).

A respondent out of the jurisdiction will not be ordered to give security for costs (*Re Miller's Patent* (1894) 11 R. P. C. at p. 57).

Particulars of Objections.—The petitioner must deliver with his petition particulars of the objections on which he means to rely, and no evidence can, except by leave of the Court or a Judge, be admitted in proof of any objection of which particulars are not so delivered (s. 26 (5) of the Patents Act, 1883). The particulars may be from time to time amended by leave of the Court or a Judge (s. 26 (6), *ibid.*; see p. 183, *infra*).

The Court, it seems, has no power to grant a certificate, as in an action for infringement (see p. 213, *infra*), that the particulars are reasonable and proper (see *Re Goulard's Patent* (1888) 5 R. P. C. at p. 537; but see *Re Partridge's Patent* (1903) 20 R. P. C. at p. 460).

Particulars of objections are fully considered on pp 178—184, *infra*.

Interrogatories.—On making the usual deposit, the petitioner is entitled to interrogate the respondent (*Haddan's Patent* (1884) Griff. P. C. at p.109).

Consent Order.—If the respondent is satisfied that he has no case, and wishes to consent to an order for revocation, he should go to *chambers* and say that he submits to a formal order and pay the costs (*Re Scott's Patent* (1903) 20 R. P. C. 604).

Trial with Witnesses.—The petition may be ordered to go into the witness list (*Re Miller's Patent* (1894) 11 R. P. C. at p. 56; *Re Allison's Patent* (1900) 17 R. P. C. 297). An application for an order that the petition shall go into the witness list should be made when the petition comes into petition list and in the presence of both parties (*Re Borroeman's Patent* (1902) 19 R. P. C. 159).

The Trial.—The mode of trial is similar to that of an action for infringement. The case is tried without a jury, unless the Court otherwise directs (s. 28 (1) of the Patents Act, 1883). The Court may, and must, on 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 (s. 28 (1), *ibid.*). If more convenient to the parties, an order may be made for trial at the Assizes (*Re Edmond's Patent* (1889) 6 R. P. C. 355). And if an action for infringement is pending, the petition may be directed to be heard at the same time as the infringement action (*Re Edge's Patent*, W. N. (1890) at p. 149).

At the hearing, the respondent has the right to begin, and if the petitioner gives evidence impeaching the validity of the patent, the respondent has the right to reply (s. 26 (7) of the Act of 1883).

Joint petitioners should appear by the same counsel; but in some cases they will be allowed, if the other side raises no objection, to appear separately (see *Re Norwood's Patents* (1895) 12 R. P. C. at p. 221).

Evidence.—The evidence at the hearing may be given either by witnesses in Court (*Re Miller's Patent* (1894) 11 R. P. C. at p. 56) or by affidavit (*Re Gale's Patent* (1891) 8 R. P. C. at p. 439). But where fraud is alleged, the evidence should not be tendered on affidavit (see *Re Gale's Patent*, *supra*, at p. 440).

Where the evidence is given on affidavit, the respondent, as he has the right to begin, should file his evidence in the first instance (see *per* Chitty, J., in *Re Gale's Patent* (1891) 8 R. P. C.

at p. 440). If any of the deponents have been cross-examined, the cross-examination should be put before the Court, and not kept back; if withdrawn, the Court will conclude that the party cross-examined was speaking the truth (*Re Gale's Patent, supra*).

Effect of Decision in Prior Action between Same Parties.—The respondent is not precluded from showing that his patent is valid by reason of the patent having been declared invalid in an action for infringement previously brought by him against the petitioner—*i.e.*, there is no estoppel. The reason of this is, that a petition for revocation, by whomsoever brought, is a petition on behalf of the public, and is not personal to the petitioner (*Re Deeley's Patent* (1895) 12 R. P. C. at p. 199; and see *Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at p. 533; *Re Lewis's Patent* (1896) 14 R. P. C. at p. 35).

"This is almost the only instance in which the same party litigant can litigate over again the same facts which he has already put in issue before another tribunal and get a second trial, although he has already had the matter adjudicated against him once before. . . . But at the same time, it is impossible for the Judge who tries the second action not to bear in mind the fact that, unless the witnesses are so obviously unimpeachable that there is no suspicion of an attempt to mislead the Court, it is a most dangerous precedent to allow witnesses to appear and attempt to supplement evidence which has proved deficient on the former occasion" (*per* Farwell, J., in *Re Jameson's Patent* (1902) 19 R. P. C. at p. 252).

Amendment of the Specification.—When and so long as any proceeding for revocation of a patent is pending, no amendment of the specification can be made without the leave of the Court or a Judge (see p. 85, *supra*). But the Court or a Judge may at any time order that the patentee shall 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 hearing shall be postponed (see p. 86, *supra*).

The Order.—If an order has been obtained for the revocation of a patent, the person in whose favour the order has been made must forthwith leave at the Patent Office an office copy thereof. The Register of Patents is thereupon rectified, or the purport of the order will otherwise be duly entered in the Register (Patents Rules, 1903, Rule 60).

Once revoked, difficulties may arise as to the patent being

resuscitated in case of a successful appeal (see *Re Armstrong's Patent* (1897) 14 R. P. C. at pp. 755, 756; *Deeley* v. *Perkes* (1896) 13 R. P. C. at pp. 589, 590). Hence, the Court will usually stay the execution or delivery out of the order pending an appeal (see *Re Armstrong's Patent, supra*; *Re Klaber's Patent* (1902) 19 R. P. C. at p. 180); and it may grant liberty to apply for leave to amend the specification in a particular way, and direct that the order for revocation shall not take effect if the specification be so amended (*Re Scott's Patent* (1903) 20 R. P. C. at p. 263; *Re Geipel's Patent* (1903) 20 R. P. C. at p. 556; *Re Justice's Patent* (1901) 18 R. P. C. at p. 248; *Deeley* v. *Perkes, supra*).

The Costs.—The petitioner, if successful, is entitled to the costs, whether the opponent appears (*Re Edmond's Patent* (1880) 6 R. P. C. at p. 358) or not (*Re Wallace's Patent* (1895) 12 R. P. C. at pp. 445, 446; *Re Sleight's Patent* (1893) 10 R. P. C. at p. 448).

The Court, it is conceived, has no power to grant a certificate, as in an action for infringement (see p. 213, *infra*), that the particulars of objection were proven or reasonable and proper (*Goulard's Patent* (1888) 5 R. P. C. at p. 537; but see *Re Partridge's Patent* (1903) 20 R. P. C. at p. 460, where Joyce, J., granted a certificate in an undefended case). But the Court will not allow costs in respect of any objection which was not reasonably raised (*Re Dodge's Patent* (1895) 12 R. P. C. at pp. 454, 455).

A respondent out of the jurisdiction will not be required to give security for costs (*Re Miller's Patent* (1894) 11 R. P. C. at p. 57).

Appeal.—An appeal lies from the decision at the hearing to the Court of Appeal and to the House of Lords (see *Deeley* v. *Perkes* (1896) 13 R. P. C. 581).

Where an order for revocation has been made, the Court will stay execution or delivery out of the order pending an appeal (*supra*).

The Court of Appeal is always very reluctant to allow fresh evidence to be given on appeal (*Walker* v. *Hydro-Carbon Syndicate* (1886) 3 R. P. C. at p. 254); especially so where the application to tender further evidence is made by the petitioner, as no irremediable damage can result from refusing his application (see *Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at p. 533).

CHAPTER VII.

Action for Threats.

ACTION UNDER THE STATUTE OF MONOPOLIES—ACTION UNDER THE PATENTS ACT, 1883—WHAT AMOUNTS TO A THREAT—DEFENCES—PROCEDURE—REMEDIES.

Action Under the Statute of Monopolies.

Sect. 4 of the Statute of Monopolies provides that if any person be "hindered, grieved, disturbed, or disquieted" by occasion or pretext of any monopoly or letters patent, he may have his remedy for the same at the common law by an action to be grounded upon the statute, and "shall recover three times so much as the damages" which he sustained by reason of being so hindered, grieved, disturbed, or disquieted. But the Act has no operation with reference to letters patent for "any manner of new manufactures within this realm to the true and first inventor" provided they be "not contrary to the law nor mischievous to the State, etc." (see p. 1, *supra*).

In only one reported case has this statute been relied upon (*Peck* v. *Hindes* (1898) 15 R. P. C. 113). The reason for this is not altogether clear. The damages recoverable under the statute are greater than those recoverable under s. 32 of the Patents Act, 1883; the plaintiff is entitled as of right to treble damages. And under this statute the plaintiff may be any person "hindered, grieved, disturbed, or disquieted"; under the Act of 1883 only a person "aggrieved" can bring action. Moreover, the Statute of Monopolies is not confined to (though it doubtless includes) threats of legal proceedings or liability: it applies to an action at law, even though brought in good faith (see *Peck* v. *Hindes* (1898) 15 R. P. C. at p. 127). Hence, it seems, if a patentee sues for an infringement, and the defendant shows that the patent is bad, and that he has been "hindered, etc.," an action under the statute lies, and the defendant can recover treble damages.

The statute, however, does not apply to letters patent for "new manufactures within this realm to the true and first

inventor" (s. 6). But if it is shown that the patent was not in fact granted for a "new manufacture" (as to the meaning of these words see Chapter I.), and the patent is therefore invalid, the plaintiff must, it is submitted, succeed. In *Peck* v. *Hindes* (*supra*) Mathew, J., held that the statute did not apply, as the patent in question, though invalid originally, became valid subsequently by disclaimer. Had the patent in that case been hopelessly bad, it is conceived that s. 4 would have applied and that the plaintiff would have been entitled to treble damages and costs.

Action Under the Patents Act, 1883.

S. 32 of the Patents Act, 1883, provides as follows :—

> 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.

"The Legislature desires that threats of patent actions shall not hang over a man's head; that the sword of Damocles, in such a case, should either not be suspended, or should fall at once; and it is with that view that the section seems to be framed" (*per* Bowen, L.J., in *Skinner* v. *Perry* (1892) 10 R. P. C. at p. 8). A patentee must not threaten legal proceedings unless the manufacture to which the threat applies infringes the legal right of the threatener, or unless the threatener is about to forthwith bring an action to show the validity of his threats. If he cannot bring himself within the two saving clauses at the end of the section, then the section absolutely forbids him threatening legal proceedings at all; and it is *nihil ad rem* to say that what he did was *bonâ fide*, or that what he did was on a privileged occasion (see *per* Smith, L.J., in *Skinner* v. *Perry*, *supra*).

What Amounts to an Actionable Threat.—"As a matter of law, anything said, or anything written by a person, even by way of warning, if it is for the purpose of intimating to another

person that somebody else is infringing his patent, and he therefore must not buy from that person, is in the nature of a threat" (*per* Bucknill, J., in *Bishop* v. *Inman* (1900) 17 R. P. C. at p. 755). The section does not apply to mere general warnings (see *per* Bowen, L.J., in *Challender* v. *Royle* (1887) 4 R. P. C. at p. 374; *per* Lindley, L.J., in *Johnson* v. *Edge* (1892) 9 R. P. C. at p. 148). It does not prevent a patentee from saying that which the patent itself implies—that anybody infringing must expect legal proceedings to be taken against him. That is merely saying what everybody knows (*Johnson* v. *Edge*, *supra*). But a circular, though framed in general terms, may, in certain circumstances, be proper subject for an action. Thus, in *Johnson* v. *Edge* (*supra*), E., the owner of two patents for wrapping up blue, sent out the following circular as a wrapper round his blue: "Notice to grocers and others. Information of extensive violation of E.'s patent rights has been received. All parties are warned not to infringe those rights. R. & R. C. W., Solicitors." J., also a dealer in blue, brought an action against E. to restrain him from issuing threats. Held: that the circular was a threat within the section, though J., the aggrieved person, was not the person to whom the threat was issued. And see *Herburger* v. *Squire* (1888) 5 R. P. C. 581.

In *Challender* v. *Royle* ((1887) 4 R. P C. at pp. 374, 375) Bowen, L.J., said that the threat, which is the subject-matter of the action, must be about an *act done*; that threats as to something which might be done in the future would not fall within the section. But in *Johnson* v. *Edge* ((1892) 9 R. P. C. at p. 148) Lindley, L.J., said he thought the section might apply to an *intended* infringement, provided that it could be shown that the intended infringement if carried out would be an actual infringement. And see *per* Kekewich, J., in *Kurtz* v. *Spence* (1888) 5 R. P. C. at p. 171; *per* Day, J., in *Willoughby* v. *Taylor* (1893) 11 R. P. C. at p. 53. A single threat may amount to an actionable threat (*Webb* v. *Levinstein* (1898) 15 R. P. C. 78); and a threat not withdrawn is a continuing threat (*Driffield Co.* v. *Waterloo Co.* (1886) 3 R. P. C. at p. 48; *cf. English Co.* v. *Gare Co.* (1894) 11 R. P. C. at pp. 630, 631).

A threat is actionable whether it is addressed direct to the person aggrieved or to some third person. "If I threaten a man that I will bring an action against him, I threaten him none the less because I address that intimation to himself, and I threaten him none the less because I address the intimation to a third person" (*per* Bowen, L.J., in *Skinner* v. *Perry* (1892) 10 R. P. C.

at p. 7; and see *Johnson* v. *Edge* (1892) 9 R. P. C. 142). And an action is sustainable although the circular containing the threat makes no reference to the threatener's patent, if it is clear that the threatener, at the time, had his patent in his mind (see *Douglass* v. *Pinteh's Patent Co.* (1896) 13 R. P. C. at p. 680).

Examples of Actionable Threats.—The following statements have been held to be "threats" within the section:—

(1) "Notice to grocers and others. Information of extensive violation of E.'s patent rights has been received. All parties are warned not to infringe those rights. R. & R. C. W., Solicitors" (*Johnson* v. *Edge* (1892) 9 R. P. C. 143).

(2) "Notice to the pianoforte trade. I have lately ascertained that certain foreign manufacturers are infringing my patent No. —— in respect of improved pianoforte actions, particularly that portion of it relating to the armed damper. . . . As there is great difficulty in obtaining judgment against a foreign house, they being represented in some cases only by a traveller, and he having no fixed residence, under the circumstances I am compelled, and it is my intention, to take legal proceedings against all persons infringing my patent. . . . N.B.—All actions without my official tablet being affixed are an infringement of my patent" (*Herrburger* v. *Squire* (1888) 5 R. P. C. 581).

(3) "I . . . understand that you have given Mr. D. the order for the gas buoy lanterns, no price having been asked from my company. As we have supplied hundreds of lanterns, and Mr. D. has, so far as I know, not made one, I am much surprised at this. I am afraid this matter will lead to a great deal of difficulty and unpleasantness, and you must not be surprised if my company applies for an injunction against Mr. D. to restrain him from selling his gas buoy lanterns" (*Douglass* v. *Pinteh's Patent Co.* (1896) 13 R. P. C. 673).

(4) "We understand that your house is being supplied with electric light by the K. Co., which Company, as you are doubtless aware, is now being sued for damages for infringement of our patented system of electric distribution. We have been advised that you, as one of the users of the said system, are liable for the infringement. We beg, therefore, to caution you of the fact, and to offer you an indemnity upon the terms contained in the enclosed circular" (*Kensington Electric Co.* v. *Lane-Fox* (1891) 8 R. P. C. 277).

(5) "We are informed that you are making glasses with a lip of a special construction, which we have protected by patent.

If this is the case, we must request you to stop at once the manufacture of these glasses, and also to furnish us with an account of all you have made" (*Webb* v. *Levinstein* (1898) 15 R. P. C. 78).

(6) "Noticing that you are exhibiting at the above show a 'Ralli' car mounted on Cee springs, a direct infringement of our patent, we have to request that you will immediately remove same from the show, dismount same, and render us some explanation as to your infringement of our patent rights" (*Burt* v. *Morgan* (1887) 4 R. P. C. 278).

Threats by Letter or Word of Mouth.—The word "otherwise" is not to be read *ejusdem generis* with "circulars" or "advertisements" (*Skinner* v. *Perry* (1892) 10 R. P. C. at p. 5). The section includes threats made by word of mouth (*Kurtz* v. *Spence* (1888) 5 R. P. C. 161; and see *Dowson* v. *Drosophore Co.* (1894) 11 R. P. C. 536), or by letter (*Driffield Co.* v. *Waterloo Co.* (1886) 3 R. P. C. 46; *Skinner* v. *Perry* (1892) 10 R. P. C. at p. 6; *Day* v. *Foster* (1890) 7 R. P. C. 54; *Hoffnung* v. *Salsbury* (1899) 16 R. P. C. 375).

The fact that an interview or letter was "without prejudice" does not make any difference (*Kurtz* v. *Spence* (1888) 5 R. P. C. at p. 173). Nor does the fact that the threatening letter was written by the defendants' solicitors (*Driffield Co.* v. *Waterloo Co.* (1886) 3 R. P. C. 46; *Combined Weighing Co.* v. *Automatic Weighing Co.* (1889) 6 R. P. C. 502; and see *Engels* v. *Hubert Syndicate* (1902) 19 R. P. C. at p. 203).

A letter from a patentee in answer to an inquiry may be a threat (*Skinner* v. *Perry* (1892) 10 R. P. C. 1; and see *Been* v. *Welsbach Co.* (1902) 20 R. P. C. at p. 73).

In the case of a verbal threat, the person aggrieved should give the name of the person to whom the threat was made, as in an action for slander (*Dowson* v. *Drosophore Co.* (1894) 11 R. P. C. 536).

Defences to the Action.—It is a good defence to show—(*a*) That the plaintiff has, in fact, infringed; or (*b*) that, although the plaintiff has not infringed, the defendant has brought himself within the proviso, *i.e.*, he has with due diligence commenced and prosecuted an action for infringement.

The Proviso.—The section does not apply if the person making the threats "with *due diligence* commences and prosecutes an action for the infringement of his patent.

Hence, where a patentee commences an action for infringement, with due diligence, and prosecutes that action, he is entitled to give notice to the public that his patent is being infringed, and that he intends to insist upon his rights if infringers insist upon going on infringing (see *per* Smith, L.J., in *Dunlop Co.* v. *New Seldon Co.* (1897) 14 R. P. C. at p. 339; *Dunlop Co.* v. *Clifton Co.* (1902) 19 R. P. C. 527); and if an action for threats is brought against him, he is entitled to succeed, although he has failed in proving any infringement (*Colley* v. *Hart* (1896) 7 R. P. C. 101; *Combined Weighing Co.* v. *Automatic Weighing Co.* (1889) 6 R. P. C. 502). As to the effect of the alleged infringer issuing a circular stating that the patentee's grant is invalid, and that he will guarantee purchasers against any claim by the patentee, see *British Vacuum Co.* v. *Suction Cleaners* (1904) 21 R. P. C. 300.

The proviso is a curious one: the right of action given by the Legislature, and properly exercised at the time of the issue of the writ, may be defeated the next day by the threatener commencing an action for infringement. "A man may wait any reasonable time . . . to see what is likely to come of this action founded on the threats, look up a little more carefully than he has hitherto done the question of the validity of the patent, and the details of infringement, and so forth, and may, within a reasonable time, commence his action for infringement, and say: "You were quite right till this morning, but now you are wrong; I have commenced an action with due diligence, and there is an end of your case" (*per* Kekewich, J., in *Combined Weighing Co.* v. *Automatic Weighing Co.*, *supra*, at p. 508).

Action must be *Bonâ Fide*.—But in order to bring the case within the proviso the action must be a *bonâ fide* one (*Bishop* v. *Inman* (1900) 17 R. P. C. at pp. 753, 759; *Day* v. *Foster* (1890) 7 R. P. C. at p. 61; *Challender* v. *Royle* (1887) 4 R. P. C. at p. 373; *Dunlop Co.* v. *New Seldon Co.* (1897) 14 R. P. C. at p. 340). If it is not honestly brought, or if it is collusive (*Challender* v. *Royle*, *supra*; *Colley* v. *Hart* (1890) 7 R. P. C. 101) or brought after the action for threats for the sole purpose of evading that action (see *Johnson* v. *Edge* (1892) 9 R. P. C. 142; *Appleby's Chain* v. *Eadie Chain* (1899) 16 R. P. C. at p. 330; *cf.* *Waite* v. *Johnson Die Press Co.* (1900) 18 R. P. C. 1), the proviso cannot be relied upon. The fact that the action for infringement has been discontinued is not, in itself, evidence of *mala fides* (see *English Co.* v. *Gare Co.* (1894)

11 R. P. C. at p. 631; *Colley* v. *Hart* (1890) 7 R. P. C. at pp. 110, 111; *Peck* v. *Hindes* (1898) 15 R. P. C. 113; *cf. Bishop* v. *Inman* (1900) 17 R. P. C. 749).

ACTION NEED NOT BE AGAINST THE PLAINTIFF.—The action need not necessarily be brought against the person aggrieved (*Challender* v. *Royle* (1887) 4 R. P. C. at p. 374; *Combined Weighing Co.* v. *Automatic Weighing Co.* (1889) 6 R. P. C. 502). But the action must be brought by the threatener (*Kensington Electric Co.* v. *Lane-Fox* (1891) 8 R. P. C. 277); and it must be in respect of the same infringement (*Combined Weighing Co.* v. *Automatic Weighing Co., supra*). An exclusive licensee, however, who has an option to purchase, may rely upon an action brought by his licensor (*Incandescent Co.* v. *New Incandescent Co.* (1897) 76 L. T. 47).

THE ACTION MAY BE BROUGHT BEFORE OR AFTER THE THREATS ACTION.—It is not necessary that the action for infringement should be brought after the action for threats; it may be brought before (*Berliner* v. *Edison-Bell* (1899) 16 R. P. C. at p. 338; *Day* v. *Foster* (1890) 7 R. P. C. at p. 60).

ACTION MUST BE COMMENCED WITH DUE DILIGENCE.—The action must not only be *bonâ fide*, but must also be brought "with due diligence." The question of due diligence is one of fact; and one for the jury (see *Bishop* v. *Inman* (1890) 17 R. P. C. at p. 759). It is impossible to fix any precise time within which the action must be commenced. Due diligence in one set of circumstances may not be due diligence in another (*Colley* v. *Hart* (2) (1890) 7 R. P. C. at p. 106).

An action commenced immediately before the threats are made (*Berliner* v. *Edison-Bell* (1899) 16 R. P. C. at p. 338), or before the action for threats is brought (*Day* v. *Foster* (1890) 7 R. P. C. at p. 60; *Voelker* v. *Welsbach Co.* (1901) 18 R. P. C. 494), is commenced with due diligence.

In considering whether an action has been brought with due diligence, the time to be looked at is the time the threat was made; not the time at which the defendant had notice of what the plaintiff was doing (*Challender* v. *Royle* (1887) 4 R. P. C. at p. 376).

Actions brought three months after the issue of the threats have been held to have been brought with due diligence (*Challender* v. *Royle, supra*; *Colley* v. *Hart* (1890) 7 R. P. C. 101).

In *Edlin* v. *Pneumatic Tyre Agency* ((1893) 10 R. P. C. 311) the threats were made three years before the action for infringement was brought, and it was held that there had been no want of diligence. But in this case there had been more or less continuous negotiations between the parties. In *Herrburger* v. *Squire* ((1888) 5 R. P. C. 581) an action brought about thirteen months after the issue of the threats was held not to have been brought with due diligence. In *Voelker* v. *Welsbach Co.* ((1901) 18 R. P. C. 494) the action for infringement was commenced nearly two years before and was still pending at the commencement of the threats action. Lord Alverstone, C.J., considered—on a motion for an interlocutory injunction—that there had in the particular circumstances been no such amount of delay as amounted to want of due diligence.

On Bringing the Action by Way of Counterclaim.—Where the action for threats has been commenced *soon* after the issue of the threats, the patentee may wait a reasonable time to have the statement of claim delivered to him, in order to see whether he cannot bring his action by way of counter-claim (*Colley* v. *Hart* (1890) 7 R. P. C. at p. 108; *cf. Appleby's Chain* v. *Eadie Chain* (1899) 16 R. P. C. at p. 330). But the patentee is not bound to try the question of infringement by a counter-claim. If, however, he desires to bring a separate action, he should attempt to stay the action for threats on proper terms so as to prevent re-duplication of costs; otherwise the threat action may be dismissed without costs (*Combined Weighing Co.* v. *Automatic Weighing Co.* (1889) 6 R. P. C. at p. 509; *Automatic Weighing Co.* v. *Combined Weighing Co.* (1889) 6 R. P. C. at p. 371).

Action must be Prosecuted with Due Diligence.—Not only must the patentee with due diligence commence, but he must duly *prosecute* the action (*Challender* v. *Royle* (1887) 4 R. P. C. at p. 372); and he must not prosecute it leisurely (*Household* v. *Fairburn* (1885) 2 R. P. C. at p. 142). But it is not essential that the action should result in judgment in his favour (*Colley* v. *Hart* (2) (1890) 7 R. P. C. at p. 110; *Combined Weighing Co.* v. *Automatic Machine Co.* (1889) 6 R. P. C. 502), or even that it should be brought to trial. If the patentee discovers that his action is a hopeless one, it is his duty "to put an end to it at once, and not go on with it to trial" (see *per* North, J., in *Colley* v. *Hart*, *supra*, at p. 111; *English Co.* v. *Gare Co.* (1894) 11 R. P. C. at p. 632; *Peck* v. *Hindes* (1898) 15

R. P. C. 113; *cf. Bishop* v. *Inman* (1900) 17 R. P. C. 749; *Waite* v. *Johnson* (1900) 18 R. P. C. 1).

If the action is set down by the defendants for want of prosecution (*Combined Weighing Co.* v. *Automatic Weighing Co.* (1889) 6 R. P. C. at p. 509), or is dismissed owing to the default of the plaintiffs (*Waite* v. *Johnson* (1901) 18 R. P. C. 1), that is *primâ facie* evidence that the plaintiff has not prosecuted his action with due diligence. But if the action has been dismissed owing to the default of the plaintiff (the defendant in the threat action) it is open to him to commence a second action so as to bring himself within the proviso (*Waite* v. *Johnson*, *supra*).

The Procedure.

The Writ.—The writ is usually endorsed for (1) an injunction to restrain continuance of the threats, and (2) damages.

Interlocutory Injunction.—It requires a very strong case to warrant the granting of an *ex parte* injunction (see *Wilson* v. *Church* (1885) 2 R. P. C. 175). But leave to serve notice of motion with the writ is usually given. Where the patentee was resident abroad an *ex parte* injunction was granted on special terms (*Overton* v. *Burn* (1896) 13 R. P. C. 455).

An interlocutory injunction to restrain threats will not be granted unless the plaintiff makes out a *primâ facie* case—not merely a *primâ facie* case on the balance of convenience, but a *primâ facie* case of a right that is invaded. "It is wrong simply to grant an injunction on the ground that, even without considering whether the plaintiff has any *primâ facie* case, it cannot do the defendant any harm . . . and granting an injunction may do some good" (see *per* Cotton, L.J., in *Challender* v. *Royle* (1887) 4 R. P. C. at p. 372; *per* Bowen, L.J., *ibid.*, at p. 376; *Barber* v. *Nathan* (1902) 19 R. P. C. 331).

When there is a doubt whether the plaintiff has infringed or not, the fact that the defendant refrains from bringing an action for infringement is evidence against the defendant (*Colley* v. *Hart* (1889) 6 R. P. C. at p. 21).

In cases where it is questionable whether the threats are threats within the section, and the defendant disclaims any intention of making the threats alleged, the Court will order the motion to stand to the trial, with liberty to the plaintiff to bring it on again on two days' notice (*Douglass* v. *Pintsch's Patent Co.* (1895) 13 R. P. C. 60).

Where the defendant brings an action for infringement, the

Court, on motion by the plaintiff for an interlocutory injunction, will usually make no order, on the defendant undertaking to prosecute his action for infringement with due diligence, and expressing his intention of not issuing further threats (*Mackie* v. *Solco Co.* (1892) 9 R. P. C. 465; and see *Waite* v. *Johnson* (1901) 18 R. P. C. at p. 3). In *Engels* v. *Hubert Syndicate* ((1902) 19 R. P. C. at p. 203), Byrne, J., granted an injunction, but intimated that if the defendant brought a *bonâ fide* action for infringement he might apply to discharge the order.

Statement of Claim.—The plaintiff should allege (*a*) the threats; (*b*) that he has not infringed; and (*c*), if he thinks such is the case, that the defendant's patent is invalid.

It is now well settled that the plaintiff may raise the issue of want of validity of the defendant's patent in his threat action; if the patent is invalid there cannot be any "infringement of any legal rights" (see *Challender* v. *Royle* (1887) 4 R. P. C. at pp. 371, 372; *Kurtz* v. *Spence* (1887) 4 R. P. C. 427; *Herburger* v. *Squire* (1889) 6 R. P. C. 194).

The plaintiff may raise the issue of validity either in his statement of claim (see *Willoughby* v. *Taylor* (1894) 11 R. P. C. at p. 47; *Herburger* v. *Squire* (1888) 5 R. P. C. at p. 585), or in his reply (*Dowson* v. *Drosophore Co.* (1895) 12 R. P. C. at p. 100; but see now R. S. C., Order 23, Rule 1).

Particulars of Threats.—The defendant is entitled to particulars of the threats complained of (*Law* v. *Ashworth* (1890) 7 R. P. C. 86). In the case of a verbal threat, the name of the person to whom the threat was made should be given, as in an action for slander (*Dowson* v. *Drosophore Co.* (1894) 11 R. P. C. 536). But the plaintiff need not state the names of customers whom he has, in consequence of the threats, promised to indemnify (*Law* v. *Ashworth*, *supra*).

Malice.—It is sometimes pleaded that the threat was made falsely and maliciously, in order to support the alternative right of action at common law to which the defence that an action for infringement has been commenced is no answer (see *Colley* v. *Hart* (2) (1890) 7 R. P. C. at p. 111; *Bishop* v. *Inman* (1900) 17 R. P. C. at p. 753; *Barber* v. *Nathan* (1902) 19 R. P. C. 331; *Ripley* v. *Arthur* (1900) 18 R. P. C. 82); but if malice is alleged and persisted on, and is not proved, this may materially affect the question of costs (*Colley* v. *Hart*, *supra*, at p. 114).

Particulars of Objections.—If the plaintiff alleges that the

defendant's patent is invalid, he must deliver to the defendant particulars of objections to the patent, as if the plaintiff was defendant in an action for infringement (*Kurtz* v. *Spence* (1887) 4 R. P. C. at p. 433; see p. 178, *infra*).

Particulars of objections should, where the plaintiff is aware of the patent or patents on which the threats were based, be delivered together with the statement of claim; but where the plaintiff is not aware of the defendant's patents, he may delay giving particulars until the defendant has furnished him with a list of the patents on which he relied (see *Union Electrical Co.* v. *Electrical Storage Co.* (1888) 5 R. P. C. 329).

If the particulars are not sufficient, further and better particulars may be claimed before delivery of the defence (*Law* v. *Ashworth* (1890) 7 R. P. C. 86).

The Defence.—The defendant may (1) deny the issue of the threats, and (2) allege that the plaintiff has in fact infringed and (3) that he has with due diligence commenced and prosecuted or is prosecuting an action for infringement (see p. 128, *supra*).

If infringement is relied upon, the defendant must give particulars of the infringement (*Willoughby* v. *Taylor* (1894) 11 R. P. C. at p. 47).

Staying the Threats Action.—As has already been mentioned, the defendant is entitled to succeed, although the plaintiff has not in fact infringed, if he with due diligence commences and prosecutes an action for infringement (see p. 128, *supra*). Where an action for infringement is brought not by way of counter-claim (see p. 131, *supra*), the defendant should attempt to stay the action for threats on proper terms so as to prevent re-duplication of costs (see p. 131, *supra*). But the threats action will not be stayed until after the hearing of the action for infringement if the latter action does not relate to all of the patents which are in issue in the former action (*Dowson* v. *Prosophore Co.* (1895) 12 R. P. C. 95).

The Trial.—The action may be tried at the Assizes (*Appleby's Chain* v. *Eadie Chain* (1899) 16 R. P. C. 318), and before a jury (*ibid.*; *Bishop* v. *Inman* (1900) 17 R. P. C. 749; *Peck* v. *Hinde's* (1898) 15 R. P. C. 113).

Prima facie, the burden of proof is on the plaintiff; he therefore has, *prima facie*, the right to begin (see *Challender* v. *Royle* (1887) 4 R. P. C. at p. 371). But where the plaintiff alleges that the defendant's patent is invalid, the defendant has the same right of beginning and replying as he would have if he

had brought an action against the plaintiff for infringement (*Kurtz* v. *Spence* (1887) 4 R. P. C. at p. 433).

If the validity of the patent is in issue, the defendant must support the patent as if he were plaintiff in an action for infringement; therefore, where it is alleged that the patentee was not the true and first inventor, the defendant cannot protect himself by the mere production of the letters patent (*Kurtz* v. *Spence* (1888) 5 R. P. C. at p. 177).

It is conceived that a declaration that the defendant's patent is invalid cannot be made in a threat action (see *Herburger* v. *Squire* (1888) 5 R. P. C. at p. 595).

Costs.—These, as a general rule, follow the result (*Colley* v. *Hart* (1890) 7 R. P. C. at p. 114).

If the defendant brings a separate action for infringement he should endeavour to stay the action for threats; if he does not do so the action may be dismissed only without costs (see p. 131, *supra*).

Where the plaintiff alleges and persists on malice, which is not proved, the question of costs may be materially affected (see *Colley* v. *Hart* (1890) 7 R. P. C. at p. 114).

Certificate as to Particulars of Objections.—In *Willoughby* v. *Taylor* ((1894) 11 R. P. C. at p. 55), Day, J., certified that the plaintiff's particulars of objections were reasonable and proper. But it is conceived that s. 29 (6) of the Patents Act, 1883, which provides that in an action for infringement no costs are to be allowed in respect of any particular not certified to have been proven or to have been reasonable and proper, does not apply to threat actions. Although the action may be in substance one for infringement, yet it is only so in substance, and not in form; and it is not, it is submitted, an action for infringement within the meaning of the Act of 1883 (see *Kurtz* v. *Spence* (1888) 5 R. P. C. at p. 184).

Remedies.

Perpetual Injunction.—If successful, the plaintiff may obtain a perpetual injunction (as to interlocutory injunctions, see p. 132, *supra*), and damages.

If the defendant issues threats after injunction granted, he may be committed for contempt. But although "the Court will not for a moment tolerate a breach of an injunction, . . . and will not allow itself to be tricked or trifled with," it is "incumbent on the Court not to strain the language of an injunction

even to meet a case which would have been prohibited if foreseen" (*per* Lindley, M.R., in *Ellam* v. *Martyn* (1898) 16 R. P. C. at p. 31; *Beven* v. *Welsbach Co.* (1902) 20 R. P. C. 69; and see p. 205, *infra*).

Damages.—No order as to damages will be made unless substantial damage is proved (*Douglass* v. *Pintsch's Patent Co.* (1896) 13 R. P. C. at p. 681; *Driffield Co.* v. *Waterloo Co.* (1886) 3 R. P. C. at p. 48). In *Kurtz* v. *Spence* ((1888) 5 R. P. C. at p. 184) the plaintiffs were awarded forty shillings damages, and the defendants were ordered to pay the costs of the action, taxed on the higher scale.

If substantial damage is proved, proportionate damages may be recovered. In this case, an inquiry is usually ordered as to the amount of damage sustained (see *Johnson* v. *Edge* (1892) 9 R. P. C. at p. 146; *Skinner* v. *Perry* (1894) 11 R. P. C. 406); but if the amount of loss can be roughly estimated, the damages should be assessed by the Judge at the trial and not referred (*Ungar* v. *Sugg* (1892) 9 R. P. C. 113).

In *Ungar* v. *Sugg* (*supra*) the plaintiff was awarded 500*l.* In *Appleby's Twin Chain* v. *Eadie Chain* ((1899) 16 R. P. C. 318), where the plaintiffs alleged that the threat was also a libel on them in their trade, the jury awarded 500*l.* for the threats and 5*l.* for the libel. Where a contract has been broken off owing to the threats, the loss of profit may be taken as the measure of damages (*Skinner* v. *Perry* (1894) 11 R. P. C. 406; and see *Hoffnung* v. *Salsbury* (1899) 16 R. P. C. at p. 382).

CHAPTER VIII.

Extension of Term of Grant.

S. 25 OF THE ACT OF 1883—MATTERS CONSIDERED BY THE COMMITTEE—THE EXTENSION—WHO MAY PETITION—THE PROCEDURE—COSTS—EXCUSE FROM COMPLIANCE WITH RULES.

Where a patentee has been inadequately remunerated by his patent, His Majesty in Council may extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years, or may order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee of the Privy Council may think fit (s. 25 (5) of the Patents Act, 1883).

The application for extension is by petition to His Majesty in Council (see p. 147, *infra*), which must be presented at least six months before the expiration of the grant (s. 25 (1), *ibid.*).

If His Majesty is pleased to refer the petition to the Judicial Committee of the Privy Council, the Committee consider the same (s. 25 (3), *ibid.*); and in considering their decision, the Committee must have regard to—

(1) The nature and merits of the invention in relation to the public;

(2) The profits made by the patentee as such; and

(3) All the circumstances of the case (s. 25 (4), *ibid.*).

(1) *The Nature and Merits of the Invention.*

Nature of Invention.—Where the invention has not been brought into general use, it is important to consider the nature of the invention (*Southwaith's Patent* (1837) 1 W. P. C. at p. 487). The fact that the invention has not been brought into public use weighs against its merits (see *per* Lord Hobhouse in *Re Southby's Patent* (1891) 8 R. P. C. at p. 437); but where the invention is one which from its very nature cannot reasonably be expected to come at once, or within a short period, into general use, non-user will not be fatal to an extension (see *per* Lord Watson in *Re Semet's Patent* (1894) 12 R. P. C. at p. 16; *Re Stoney's Patent* (1888) 5 R. P. C. 518; *Re Southby's Patent* (1891)

8 R. P. C. at pp. 437, 438; *Re Thompson's Patent* (1902) 19 R. P. C. 565).

The nature of the invention is also considered to see whether it confers some unusual benefit to the public (see *Re Norton's Patent* (1863) 1 Moore (N. S.) 343; *Re Beanland's Patent* (1887) 4 R. P. C. at p. 491; *Woodcroft's Patent* (1846) 2 W. P. C. at p. 32). For instance, the fact that the invention is calculated to secure the public more safely travelling by railways (*Re Hardy's Patent* (1849) 6 Moore at p. 443; *Re Lee's Patent* (1856) 10 Moore at p. 228) or by sea (*Re Herbert's Patent* (1867) 4 Moore (N. S.) 300), or that it is useful for saving life (*Re Roper's Patent* (1887) 4 R. P. C. at p. 202), has great weight with the Committee. In all these cases extensions were granted. With them may be usefully compared the case of *Re McDougal's Patent* (1867) 5 Moore (N. S.) 1.

Merits of the Invention.—The merit of the invention must be great (*Re Beanland's Patent* (1887) 4 R. P. C. at p. 491), and must be proved (*Re Kelly's Patent* (1900) 17 R. P. C. 476). There must be more merit than would merely support a patent in a Court of Law (*per* Sir William Grove in *Re Stoney's Patent* (1888) 5 R. P. C. at p. 520). But degrees of merit will not be weighed "in golden scales." If there is considerable merit, with originality and some considerable usefulness to the public, that is sufficient (*per* Lord Brougham in *Woodcroft's Patent* (1846) 2 W. P. C. at p. 31).

The merit of an invention may be great although the invention is apparently a simple one (*Re Semet's Patent* (1895) 12 R. P. C. at p. 16). An inference against merit from the smallness of the step taken must be carefully guarded against (*Soames's Patent* (1843) 1 W. P. C. at p. 735). Some of the most valuable inventions have been very simple in their character, and yet they have struck the world as a great novelty, when they were first made (*per* Sir William Grove in *Re Stoney's Patent* (1888) 5 R. P. C. at p. 522).

The question of merit is very much a question of degree. There is no scale by which you can measure the merit in an invention, further than general opinion or the opinion of people well acquainted with the subject. The best testimony as to the merit of an invention is that it is a requisite, and that it is a requisite which had not been discovered until the patentee discovered it (*per* Sir William Grove in *Re Stoney's Patent* (1888) 5 R. P. C. at p. 523).

The merit of an importer is less than that of an inventor. The fact that the invention was imported does not take away the

merit, but it makes it much smaller (see *per* Lord Brougham in *Soames's Patent* (1843) 1 W. P. C. at p. 733; and see *Re Claridge's Patent* (1851) 7 Moore 394; *Re Peach's Patent* (1902) 19 R. P. C. 65). If the imported invention is of considerable commercial value, and the importer has embarked a large capital in endeavouring to introduce it, the patent may be extended (*Re Berry's Patent* (1850) 7 Moore 187).

An assignee does not petition on the same favourable footing as the patentee. The ground that the merits of an invention ought to be properly rewarded does not exist in the case of an assignee unless he has assisted the patentee to promote his invention (see p. 146, *infra*).

Where the patentee holds a foreign patent for his invention, as well as a British one, and he manufactures his invention exclusively abroad under the foreign patent, and imports the articles so manufactured into this country, extension of the British patent will be refused, for the merits of the case are *nil* (*Re Johnson's Patent* (1871) 8 Moore (N. S.) at p. 289).

If merit is established in respect only of a part of an invention, extension may be granted in respect of that meritorious portion (see p. 145, *infra*).

(2) *The Profits made by the Patentee.*

Accounts.—The applicant must place before the Committee accounts in a shape which will leave no doubt as to what his remuneration has been (see *per* Lord Cairns in *Saxby's Patent* (1870) 7 Moore (N. S.) 82; *Re Duncan's Patent* (1884) 1 R. P. C. at p. 260). If the accounts do not enable the Committee to form any clear opinion whether the patentee has been adequately remunerated, the petition will be refused (*Henderson's Patent* (1901) 18 R. P. C. 449; *Re Witterich's Patent* (1903) 20 R. P. C. 285; *Re Thorneycroft's Patent* (1899) 16 R. P. C. at p. 204). It is not for the Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what might be their real outcome if they were differently cast; the accounts must be full and sufficient in the first instance (*Re Saxby's Patent*, *supra*, at p. 85; *Re Henderson's Patent*, *supra*; *Re Peach's Patent* (1902) 19 R. P. C. at p. 69; *Re Tate's Patent* (1887) 4 R. P. C. 150; *cf. Perkins's Patent* (1845) 2 W. P. C. at p. 17). There may, however, be cases in which it would be proper for the Committee to unravel and investigate accounts, *e.g.*, where frauds have been committed (*Re Lake's Patent* (1891) 8 R. P. C. at p. 230). And where it is clear that the patentee's

loss has been very heavy, the Committee will not require the loss to be proved with such accuracy as is necessary in other cases (*Re Darley's Patent* (1891) 8 R. P. C. at p. 384).

Destruction of Books.—The fact that the patentee's books have been destroyed will not excuse the patentee from supplying proper accounts; if he destroys his books he destroys the very case on which he must rely for an extension (*Re Yate's Patent* (1887) 4 R. P. C. at p. 152; but see *Re Marrick's Patent* (1860) 13 Moore 310).

Patent Accounts must be Kept Distinct from other Accounts.—Matters foreign to the patent must not be mixed up in the accounts (*Re Clark's Patent* (1899) 16 R. P. C. at p. 433); expenditure in the patent business must be kept distinct from expenditure in the general business (*Re Duncan's Patent* (1884) 1 R. P. C. 257; *Re Sarby's Patent* (1870) 7 Moore (N. S.) 82; *Re Willacy's Patent* (1888) 5 R. P. C. at p. 695); receipts in respect of the patented article must be distinguished from receipts in respect of other articles (*Re Yate's Patent* (1887) 4 R. P. C. at pp. 151, 152; *Willan's Patent* (1896) 13 R. P. C. 550).

Manufacturer's Profits must be Shown.—Where the patentee manufactures the patented article, his profits as manufacturer must be shown; for the possession of the patent often secures to him his power of commanding orders as a manufacturer (see *per* Lord Cairns in *Sarby's Patent* (1870) 7 Moore (N. S.) at p. 86), and gives him a preference in the market (see *per* Lord Brougham in *Muntz's Patent* (1846) 2 W. P. C. at p. 121; and see *Re Hill's Patent* (1863) 1 Moore (N. S.) 258; *Re Betts's Patent* (1862) 1 Moore (N. S.) 49).

Profits on Foreign Patents must be Disclosed.—Profits made in respect of foreign patents for the same invention must be disclosed (*Re Newton's Patent* (1884) 1 R. P. C. 177; and see *Re Pieper's Patent* (1895) 12 R. P. C. 292; *Re Johnson's Patent* (1871) 8 Moore (N. S.) 271; *Re Barff's Patent* (1895) 12 R. P. C. at pp. 385, 386; *Re Peach's Patent* (1902) 19 R. P. C. at p. 67).

Profits of Licensees should be Shown.—Where the patentee has granted licences to manufacture in consideration of royalties, the profits of the licensees, as well as the royalties received, should be set out (*Re Trotman's Patent* (1866) 3 Moore (N. S.) 488; *Shone's Patent* (1892) 9 R. P. C. 438; but see *Re Thomas's Patents* (1892) 9 R. P. C. 367).

PROFITS OF COMPANY SHOULD BE DISCLOSED.—Where the whole or a part of the patent rights have been transferred to a company, it is essential to deposit not only the patentee's accounts of his profits, but accounts also of the profits of the company (*Re Deacon's Patents* (1887) 4 R. P. C. at p. 122); and what dealings have taken place in the shares of the company should appear (*Re Lane-Fox's Patent* (1892) 9 R. P. C. at p. 413; and see *Re Parsons' Patent* (1898) 15 R. P. C. at pp. 358, 359).

PROFITS OF EACH YEAR MUST BE KEPT DISTINCT.—The profits of each year should be kept distinct, for it is material to know in what *ratio* the profits have increased, if they have increased from year to year (*per* Lord Langsdale in *Perkins' Patent* (1845) 2 W. P. C. at p. 16; *Re Yate's Patent* (1887) 4 R. P. C. at p. 152). The fact that the profits have increased during the later years is of great weight (*Downton's Patent* (1839) 1 W. P. C. at p. 567; *Roberts's Patent* (1839) 1 W. P. C. at p. 575; *Re Cocking's Patent* (1885) 2 R. P. C. at p. 153; *Re Beanland's Patent* (1887) 4 R. P. C. at p. 491). The expenditure of each year should also be kept distinct (*Re Yate's Patent* (1887) 4 R. P. C. at p. 152).

Where the petitioner has made no profits, such strict proof of accounts as is required where profits have been made is not necessary (see *Re Thompson's Patent* (1902) 19 R. P. C. at p. 568).

What Deductions are Permissible.—Certain deductions from the gross profits must be allowed, as the Committee is only concerned with the *nett* profits. The deductions should be set out in detail and not lumped together (*Re Clark's Patent* (1870) 7 Moore (N. S.) 255; *Re Betts's Patent* (1862) 1 Moore (N. S.) at p. 61).

The deduction of a sum for personal expenses of the patentee for the exclusive devotion of his time in bringing the invention into practical operation and public notice is legitimate (*Re Carr's Patent* (1873) 9 Moore (N. S.) 379; *Re Bailey's Patent* (1884) 1 R. P. C. at p. 2; *Re Hazeland's Patent* (1894) 11 R. P. C. 467). But the patentee must satisfy the Committee that the whole of the time for which he charges has been devoted to the working of the patent (*Re Furness's Patent* (1885) 2 R. P. C. at p. 177). What sum may be deducted for personal services must depend upon the circumstances of the particular case (*Re Bailey's Patent, supra*). In *Re Joy's Patent* ((1893) 10 R. P. C. 89) a salary of 400*l.* a year for the petitioner's time and attention was allowed.

The expenses of taking out the patent, making experiments, and bringing the invention into use may be deducted (*Galloway's Patent* (1843) 1 W. P. C. at p. 729; *Roberts's Patent* (1839) 1 W. P. C. at p. 575; *Re Willacy's Patent* (1888) 5 R. P. C. at p. 695; *Kay's Patent* (1839) 1 W. P. C. at p. 572; *Bates's Patent* 1 W. P. C. 739, *n.*). But the accounts must clearly show that the expenses deducted have been incurred with regard to the patent sought to be extended (*Re Willacy's Patent* (1888) 5 R. P. C. at p. 695; *Re Duncan's Patent* (1884) 1 R. P. C. 257).

Manufacturer's Profits.—A fair manufacturer's profit may be deducted, *i.e.*, profits which are not the profits of the monopoly, but the profits which any manufacturer employed to make the patented machine would have derived *if he had no right to the patent* (*Galloway's Patent* (1843) 1 W. P. C. at p. 729; *Re Betts's Patent* 1 Moore (N. S.) 49; *Muntz's Patent* (1846) 2 W. P. C. at p. 121; and see p. 140, *supra*).

Costs of Litigation.—Expenses caused by litigation in protecting the patent may be deducted (*Betts's Patent* (1862) 1 Moore (N. S.) at p. 62; *Galloway's Patent* (1843) 1 W. P. C. at p. 729; *Kay's Patent* (1839) 1 W. P. C. at p. 572). But if the patentee compromises suits and gives up costs to which he had an apparent title, a deduction on that head will not be allowed (see *Re Hill's Patent* (1863) 1 Moore (N. S.) 258); and the patentee cannot deduct the costs of a number of quarrels he has had over commissions claimed against him from persons employed to work the patent (*Re McLean's Patent* (1898) 15 R. P. C. at p. 420).

What is "Adequate Remuneration."—This depends upon the circumstances of the case, and in particular upon the nature of the invention. In some cases no difficulty arises on this head by reason of the patentee being an actual loser (see *Stafford's Patent* (1838) 1 W. P. C. at p. 564; *Swaine's Patent* (1837) 1 W. P. C. at p. 560). Losses incurred through errors of judgment in carrying on business cannot, however, be relied upon (*Re Thorneycroft's Patent* (1899) 16 R. P. C. at p. 204); but where a loss of above 10,000*l.* had been incurred through a fire, with the result that the patentee was left an actual loser, an extension was granted (*Roberts's Patent* (1839) 1 W P. C. 573).

Profits of 2,835*l.* (*Re McInnes' Patent* (1868) 5 Moore (N. S.) 72), 3,000*l.* (*Re Pitman's Patent* (1871) 8 Moore (N. S.) 293), 4,000*l.* (*Re Nussey's Patent* (1890) 7 R. P. C. 22), 7,000*l.* (*Re Ryder's*

Patent (1855) John. 213, where the profits had all been made in the last four years), 8,000*l.* odd (*Re Bailey's Patent* (1884) 1 R. P. C. 1), and 55,000*l.* (*Muntz's Patent* (1846) 2 W. P. C. at p. 121), have, in the respective circumstances, been held adequate.

On the other hand, profits of 6,000*l.* odd (*Re Joy's Patent* (1893) 10 R. P. C. 89, where 1,000*l.* had also been made on foreign patents), 6,500*l.* odd (*Perkins's Patent* (1845) 2 W. P. C. at p. 17), 11,500*l.* odd (*Re Davies's Patent* (1894) 11 R. P. C. 27; but here over 9,000*l.* represented profits from foreign patents), and even 20,000*l.* (see *Re Thomas's Patents* (1892) 9 R. P. C. at p. 372), respectively, have been held inadequate.

(3) *All the Circumstances of the Case.*

Uberrima Fides.—The application for an extension of a patent being one purely of favour, and in no sense of right, *uberrima fides* must be observed by the petitioner (*Re Horsey's Patent* (1884) 1 R. P. C. at p. 226). The whole history, and everything bearing on the matter, must be stated on the face of the petition (*Re Staudfield's Patent* (1898) 15 R. P. C. 17; *Re Ferranti's Patent* (1901) 18 R. P. C. 518; and see *Re Adair's Patent* (1881) 6 A. C. 176; *Re Horsey's Patent, supra*). The patentee should mention any prior patents within his knowledge relating to the subject-matter of his grant (*Re Liret's Patent* (1892) 9 R. P. C. 327), and he should state if any and what foreign patents he possesses, and the amount of profit derived thereunder (see p. 140, *supra*), and whether any of the foreign patents have lapsed or expired (see p. 145, *infra*). In short, everything material for the Committee to know should be stated (*Ferranti's Patent* (1901) 18 R. P. C. 518).

Neglect to Push the Patent.—The petitioner must come prepared to show that he has done his utmost to promote his invention and get it applied; he must not lie idle or let the invention take care of itself (*Re Stoney's Patent* (1888) 5 R. P. C. at p. 523). If the inventor delays for a considerable time attempting to put his invention into practice, an extension will not be recommended, unless the cause for the delay is satisfactorily explained (*Re Norton's Patent* (1863) 1 Moore (N. S.) 343; *Re Dolbear's Patent* (1896) 13 R. P. C. at p. 205; *Re Pieper's Patent* (1895) 12 R. P. C. at p. 295; *Henderson's Patent* (1901) 18 R. P. C. 449). Want of means (*Dornton's Patent*

(1839) 1 W. P. C. 565), or illness (*Re Roper's Patent* (1887) 4 R. P. C. 201), may be sufficient excuse for the delay; and the nature of the invention may be such that it could not be expected to come into general use for a considerable time (see p. 137, *supra*).

Validity of the Patent.—The Committee will not determine the validity or invalidity of the patent; that question is left to be decided by the ordinary Courts of Justice (*Re Stewart's Patent* (1885) 3 R. P. C. at pp. 9, 10; *Re Stoney's Patent* (1888) 5 R. P. C. at pp. 521, 522). Nor will the Committee consider whether the patent has lapsed through non-payment of a fee within the prescribed time (*Re Dolbear's Patent* (1896) 13 R. P. C. at p. 205).

But if a patent is obviously and *ex facie* bad, the Committee will not recommend an extension (but see *Re Burlingham's Patent* (1898) 15 R. P. C. 195); if, however, the patent is *primâ facie* valid that will do (*Re Stoney's Patent*, *supra*, at p. 522; *Erard's Patent* (1835) 1 W. P. C. 557, note (*a*); *Woodcroft's Patent* (1846) 2 W. P. C. at p. 30; *Re Liret's Patent* (1892) 9 R. P. C. 327; *Re Cocking's Patent* (1885) 2 R. P. C. 151).

The circumstance of their being *lis pendens* respecting the validity of the patent, is no objection to the grant of an extension; in fact, a longer period of extension may be granted in this case (*Re Heath's Patent* (1853) 2 W. P. C. at p. 257).

Although the Committee will not determine the validity of the patent, they will allow evidence to show anticipation by prior publication or user; for the invention may have been so far anticipated as to be deprived of that degree of novelty which is necessary in order to justify the Committee recommending an extension (*Re Stewart's Patent* (1886) 3 R. P. C. at pp. 9, 10).

Subsequent Improvements.—The fact that great improvements have been made on the original invention, affords no ground of objection to extension (*Galloway's Patent* (1843) 1 W. P. C. at p. 727); it is rather an argument in favour of an extension (*Soames's Patent* (1843) 1 W. P. C. at p. 734). Nor is it a ground of objection that the patentee has himself taken out a subsequent patent for an invention apparently essential to working his original machine (*Re Southby's Patent* (1891) 8 R. P. C. 433); but if the subsequent invention is of such a nature as to almost shut out the user of the original one, that circumstance is unfavourable though not absolutely fatal to the application (*Re Nussey's Patent* (1890) 7 R. P. C. at p. 25).

Lapse or Expiration of Foreign Patents.—The fact that foreign patents for the same invention have been allowed to lapse or have expired is a point unfavourable but not necessarily fatal to the petition (*Re Semet's Patent* (1895) 12 R. P. C. at p. 17; *Re Henderson's Patent* (1901) 18 R. P. C. at pp. 453, 454).

The Extension.

Imposition of Terms.—Where the petitioner is an assignee, terms are usually imposed in favour of the patentee. In *Whitehouse's Patent* ((1838) 1 W. P. C. at pp. 477, 478) an extension was granted upon the assignee securing an annuity of 500*l.* to the patentee. In *Re Hardy's Patent* ((1849) 6 Moore 441) prolongation was granted upon the conditions—(1) that the assignee should secure to the patentee half of his profits, and (2) that the assignee should sell the patented article to the public at a certain price.

The fact that an exclusive licence has been granted is not favourable to prolongation (*Re Darby's Patent* (1891) 8 R. P. C. at p. 384); and extension is usually only granted upon the licensee renouncing all his rights under the licence (*Re Shone's Patent* (1892) 9 R. P. C. 438; *Re Darby's Patent, supra*), or upon the condition that the petitioner grants a licence on the same terms to any other person desiring one (*Re Lyon's Patent* (1894) 11 R. P. C. at p. 540). In *Re Parsons' Patent* ((1898) 15 R. P. C. 349), however, where the patentee had granted an exclusive licence to a company in which he held a large number of shares, extension was unconditionally granted.

Where a patentee transferred two patents to a company, who mortgaged them to R. by assignment, and the company presented a petition for prolongation, the prayer was granted upon the petitioner's undertaking to give the mortgagee (who was not a party to the petition) the same security over the new patents that he had over the old (*Re Church's Patent* (1886) 3 R. P. C. 95).

Extension for a Part of the Invention.—Where merit is established in respect of a part only of an invention, an extension may be granted for that meritorious part (*Re Willacy's Patent* (1888) 5 R. P. C. at p. 695; *Re Church's Patent* (1886) 3 R. P. C. at p. 102).

Second Extension not Granted.—The power to recommend an extension is exhausted once an extension has been granted.

The Judicial Committee have no jurisdiction to entertain a petition for a further prolongation (*Re Goucher's Patent* (1865) 2 Moore (N. S.) 532).

Period of Extension.—The term of the patent may be extended for a term not exceeding seven, or in exceptional cases fourteen, years (s. 25 (5)). The period for which extension will be granted depends on the circumstances of the particular case. Patents have been extended for three (*Kay's Patent* (1839) 1 W. P. C. at p. 572), four (*Re Hardy's Patent* (1849) 6 Moore 441), five (*Re Parsons' Patent* (1898) 15 R. P. C. 349), six (*Whitehouse's Patent* (1838) 1 W. P. C. at p. 478), seven (*Re Thompson's Patent* (1902) 19 R. P. C. at p. 568), and ten (*Re Currie's Patent* (1898) 15 R. P. C. 63) years respectively.

Who may Petition.

A petition for extension may be presented by the patentee (s. 25 (1) of the Act of 1883) or by the person for the time being entitled to the benefit of the patent (s. 46, *ibid.*).

The Patentee.—The patentee may be the original inventor or an importer; but the "merit" of an importer is less than than that of an inventor. The fact that the invention was imported does not take away the merit, but it makes it much smaller (see p. 138, *supra*).

Personal Representatives.—The executors or administrators of a deceased patentee may petition (s. 46, *ibid.*; see *Doulton's Patent* (1839) 1 W. P. C. 565; *Heath's Patent* (1853) 2 W. P. C. 247); and the personal representative of the patentee ought always to be made a party when he possibly has any interest in the patent (*Re Willacy's Patent* (1888) 5 R. P. C. 690).

Assignees.—The assignee of a patent may petition for prolongation (*Re Hopkinson's Patent* (1896) 14 R. P. C. at p. 10); but he does not apply on the same favourable footing that the patentee does (*Re Hopkinson's Patent, supra*). The ground that the merits of the inventor ought to be properly rewarded does not exist in the case of an assignee, unless he has assisted the patentee with funds to bring out his invention (*Norton's Patent* (1863) 1 Moore (N. S.) at p. 344; *Re Hopkinson's Patent, supra*; *Re Barff's Patent* (1895) 12 R. P. C. at p. 386). Where the assignee has liberally supplied a patentee of small means with the funds requisite for carrying out the invention, the Committee view that with favour (*Whitehouse's Patent* (1838)

1 W. P. C. at p. 477). But where an extension is granted to an assignee, the Committee usually imposes terms on behalf of the patentee (but see *Re Porter's Patent* (1852) 2 W. P. C. 196; *Bodmer's Patent* (1849) 6 Moore 468; see p. 145, *supra*).

If the assignee did not assist the patentee to bring out his invention, or if the patentee has been adequately remunerated (*Re Hopkinson's Patent* (1896) 14 R. P. C. 5) or cannot derive any benefit from the extension (*Re Finch's Patent* (1898) 15 R. P. C. 674; *Re Barff's Patent* (1895) 12 R. P. C. 383), an extension will not be recommended.

Mortgagors.—The fact that the patent has been mortgaged does not prevent the mortgagor from applying for extension; but the mortgagee should be a party (*Re Church's Patent* (1886) 3 R. P. C. at p. 100).

The Procedure.

The Petition.—Application for prolongation of a patent is made by petition to His Majesty in Council (s. 25 (1)) of the Patents Act, 1883).

The petition must be presented at least six months before the time limited for the expiration of the patent (s. 25 (1) *ibid.*), and within one week from the publication of the last of the advertisements required to be published in the *London Gazette* (P. C. Rules, 1897, r. 2; see *infra*). If not presented within six months from the termination of the grant, the petition cannot be considered (*Re Adams's Patent* (1898) 16 R. P. C. 1). But it should not be presented prematurely; for the profits accruing at the close of the life of the patent may materially affect the question of extension (*Macintosh's Patent* (1836) 1 W. P. C. 739, *n.*).

The whole history of the patent, and anything bearing on the matter, must be stated in the petition (see p. 143, *supra*).

The petition must be printed (Rule 5, *ibid.*), and must be accompanied with an affidavit of advertisements having been published according to the requirements of Rule 1 (*infra*). The statements in such affidavit may be disputed upon the hearing (Rule 2, *ibid.*).

Advertising the Petition.—An intending petitioner must give public notice by advertising three times in the *London Gazette* and once at least in each of three London newspapers. If the petitioner's principal place of business is situated at a distance of fifteen miles or more from Charing Cross, he must also advertise once at least in some local newspaper published or circulating

in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from Charing Cross, he must advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no such manufacture, then, if he resides at a distance of fifty miles or more from Charing Cross, he must advertise once at least in some newspaper published or circulating in the town or district where he resides (Rule 1, *ibid.*).

The petitioner must in his advertisements state the object of his petition, and must give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day must not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He must also give notice that caveats must be entered at the Council Office on or before such day so named in the advertisements (Rule 1, *ibid.*).

Application to Fix a Time for Hearing.—The petitioner must apply to the Lords of the Committee to fix a time for hearing the petition; and when such time is fixed the petitioner must forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers (Rule 2, *ibid.*). No application to fix a time for hearing can be made without affidavit of service of copies of the petition on all parties entering caveats (Rule 4, *ibid.*).

Documents to be Lodged at Council Office.—The petitioner must lodge at the Council Office eight printed copies of the specification; but if the specification has not been printed and if the expense of making eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only is sufficient (Rule 3, *ibid.*).

The petitioner must also lodge at the Council Office eight copies of the balance-sheet of expenditure and receipts relating to the patent, which accounts must be proved on oath before the Lords of the Committee at the hearing. He must also furnish three copies of the balance-sheet for the use of the Solicitor to the Treasury, and must, upon receiving two days' notice, give the Solicitor to the Treasury, or any person deputed by him, reasonable facilities for inspecting and taking extracts from the books of accounts by reference to which he proposes to verify the

balance-sheet at the hearing, or from which the materials for making up the balance-sheet have been derived (Rule 3, *ibid.*). The balance-sheet must be printed in a form convenient for binding along with the petition (Rule 5, *ibid.*).

The copies of the specifications and accounts must be lodged and furnished not less than fourteen days before the day fixed for the hearing (Rule 3, *ibid.*).

Opposition to Extension.—Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension (s. 25 (2) of the Patents Act, 1883). The caveat must be entered before the day on which the petitioner applies for a time to be fixed for the hearing (Rule 4, *ibid.*); if it is not, special reasons must be shown for extending the time, and the fact that the would-be opponent did not see the advertisement in time is not sufficient (*Re Hopkinson's Patent* (1896) 13 R. P. C. 114).

Having entered a caveat, the opponent is entitled to have from the petitioner four weeks' notice of the time appointed for the hearing; and the petitioner must serve copies of his petition on all parties entering caveats (Rule 4, *ibid.*).

Opponents must, within three weeks after such copies are served on them respectively, lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the petition (Rule 4, *ibid.*). It is probably sufficient to state the *grounds* of the objections without stating the *particulars* of those objections (see *Re Ball's Patent* (1879) 4 A. C. 171; *Re Stewart's Patent* (1886) 3 R. P. C. 7).

Parties are entitled to have copies of all papers lodged in respect of any petition at their own expense (Rule 5, *ibid.*).

The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take, or of any evidence he may think fit to place before the Committee (Rule 8, *ibid.*).

The Hearing.—The Committee may, if they see fit, call in the aid of an assessor; the remuneration to be paid to an assessor is determined by the Committee (s. 28 (2) (3) of the Patents Act, 1883).

The petitioner and any persons opposing may appear at the hearing either personally or by counsel.

The Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition (Rule 8, *ibid.*). Whether the petition

is opposed or not, the Attorney-General appears to watch the progress of the case made for the petitioner (*Re Erard's Patent*, 1 W. P. C. 557, *n.*) ; his duty is as much to instruct the Lords of the Committee, and to assist them, as to oppose, and indeed, only to oppose where he considers that the case is not one where extension should be granted (*Re Stoney's Patent* (1888) 5 R. P. C. at p. 522).

The Committee adopt rules of evidence as nearly as possible resembling the rules of evidence in Courts of Law (*Erard's Patent* (1835) 1 W. P. C. 557, *n*).

The petitioner must strictly prove his title, whether notice of intention to dispute the title has been given by the objections or not (*Wright's Patent* (1837) 1 W. P. C. 561) ; and although there is no opposition, and counsel for the Crown admit that the invention is of great merit, the petitioner must formally prove his case (*Re Darby's Patent* (1891) 8 R. P. C. at p. 383 ; *Re Joy's Patent* (1893) 10 R. P. C. at p. 92).

In the absence of evidence as to merit, the Committee will refuse the petition (*Re Kelly's Patent* (1900) 17 R. P. C. 476).

Costs.—The costs of all parties of and incidental to the proceedings are in the discretion of the Committee ; and the orders of the Committee respecting costs are enforceable as if they were orders of a Division of the High Court (s. 25 (7) of the Patents Act, 1883).

A successful opponent is usually given costs (*Westrupp's Patent* (1836) 1 W. P. C. at p. 556) ; but if much expense has been occasioned by relying upon patents which were not anticipations, and unsatisfactory witnesses have been called, no costs will be allowed to the opponents (*Re Hanibal's Patent* (1855) 9 Moore at p. 394 ; and see *Muntz's Patent* (1846) 2 W. P. C. at p. 122). If the petition is abandoned, the opponents will be allowed their costs (*Re Brown's Patents* (1886) 3 R. P. C. 212 ; *Macintosh's Patent*, 1 W. P. C. 739, *n*).

Where there are two or more opponents, the Committee sometimes allows a lump sum to be divided between them (*Re Jones's Patent* (1854) 9 Moore 41 ; and see *Johnson's Patent*, 8 Moore (N. S.) 282 ; *Re Hopkinson's Patent* (1897) 14 R. P. C. at p. 10 ; *Re Dolbear's Patent* (1896) 13 R. P. C. at p. 205) ; *Re Ferranti's Patent* (1901) 18 R. P. C. at p. 520).

If there is no ground for the opposition, costs will be given to the petitioner (*Re Dunton's Patent* (1839) 1 W. P. C. at p. 567). Where the petitioner was successful, but the case was a difficult

and doubtful one, no costs were given to the petitioner (*Re Church's Patent* (1886) 3 R. P. C. 95).

Costs incurred in connection with any petition are taxed by the Registrar of the Privy Council, or other officer deputed by the Committee, who has authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses (Rule 6, *ibid.*).

Excuse from Compliance with Rules. — The Committee cannot excuse any party from compliance with the Act of Parliament (*Re Adams' Patent* (1899) 16 R. P. C. 1). But the Committee may excuse petitioners and opponents from compliance with any of the rules (Rule 7, *ibid.*; *Re Adams' Patent*, *supra*), and may give such directions in matters of proceedure and practice under s. 25 as they shall consider to be just and expedient (Rule 7, *ibid.*).

CHAPTER IX.

Infringement of Letters Patent.

WHO ARE LIABLE AS INFRINGERS — HOW A PATENT MAY BE INFRINGED—THE ACTION—PARTIES—PLEADINGS—PARTICULARS —INTERLOCUTORY INJUNCTION—ORDER FOR INSPECTION—DISCOVERY—EXPEDITING THE TRIAL—EVIDENCE—REMEDIES—COSTS—STAY PENDING APPEAL—APPEALS.

The grant of letters patent gives to the patentee "especial licence, full power, sole privilege, and authority that the said patentee, by himself, his agents, or licensees, and *no others* may at all times hereafter," during the term of fourteen years, "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."

The grant is followed by a prohibitory clause in these terms: "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 the United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years *either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in any wise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom whereby to pretend themselves the inventors thereof,* without the consent, 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."

The prohibitory part of the patent is to be regarded as well as the granting part (*British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. at pp. 193, 723).

Anyone, therefore, who makes, uses, exercises, vends, or puts in practice within the United Kingdom or the Isle of Man, without the sanction of the patentee, the invention patented, commits an act of infringement, provided, of course, that the patent be a valid one.

The words "use" or "make use of" contained in the grant have a wider application than the words "exercise" or "put in practice" (*British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. at pp. 194, 729; and see *Sykes* v. *Howarth* (1879) 12 C. D. at pp. 832, 833). "Exercise" has no wider meaning than "put in practice" (*per* Cozens-Hardy, J., in *Saccharin Corpn.* v. *Reitmeyer* (1900) 17 R. P. C. at p. 611).

Intention of Infringer not Material.—The question of infringement depends not on what the defendant intends, but on what he does (*Stead* v. *Anderson* (1847) 2 W. P. C. at p. 156). 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 (*per* Parke, B., in *Unwin* v. *Heath* (1854) 25 L. J. (N. S.) C. P. at p. 19). Evidence of intention to infringe may be material for the consideration of the jury: but if the invention be in point of fact adopted or imitated, whether in ignorance or with intention, the infringement is just the same (2 W. P. C. 227, *n.*: and see *Nobel's Co.* v. *Jones* (1882) 8 A. C. 5: *Proctor* v. *Bennis* (1887) 4 R. P. C. at p. 356: *Proctor* v. *Bayley* (1888) 6 R. P. C. 106; *Young* v. *Rosenthal* (1884) 1 R. P. C. at p. 39: *Dunlop Co.* v. *Wood* (1902) 19 R. P. C. at p. 407).

Mere intention, on the other hand, cannot make any act done an infringement, which, without the intention, would not be an infringement (see *Newall* v. *Elliot* (1864) 13 W. R. at p. 18; *Saccharin Corpn.* v. *Reitmeyer* (1900) 17 R. P. C. at 612).

Who are Liable as Infringers.

Foreigners.—Foreigners are subject to an action for infringement if they use, in this country, a patented invention without the sanction of the patentee (*Caldwell* v. *Van Vlissengen* (1852) 21 L. J. (N. S.) Ch. at p. 102; *Badische* v. *Johnson* (1897) 14 R. P. C. at p. 415): and if a party in England is doing that which is an infringement of a patent, he cannot justify his act by saying that he has been authorised by a foreign Sovereign to do it (*Varrasseur* v. *Krupp* (1878) 9 C. D. at p. 350). The Court has no jurisdiction, however, to prevent a foreign Sovereign from

removing his property in this country; and there is a right of property in an infringing article, although the Court would order the article to be destroyed (*Varasseur* v. *Krupp*, *supra*, at p. 360).

Employers—A master is responsible for all the acts of his servant which are done in the execution of his duty; and he is bound to take care that his orders are obeyed, and if they are violated, whether openly or secretly, he is liable for the consequences (see *per* Lord Chelmsford, L.C., in *Betts* v. *Vitrie* (1868) 3 Ch. at p. 442).

A master is therefore liable for infringements committed by his servants (*Sykes* v. *Howarth* (1879) 12 C. D. at pp. 832, 833); and directors of a company are personally liable for infringement by their workmen, although the infringement may be in disobedience to express commands (*Betts* v. *De Vitrie*, *supra*). But if an action is brought against a company, and its directors are made co-defendants, the action will be dismissed as against the directors if no evidence of infringement by them is given (*Leeds Forge Co.* v. *Deighton's Co.* (1901) 18 R. P. C. at p. 240).

Persons Licensing use of Third Party's Patent are not Infringers.—In *Montgomerie* v. *Paterson* ((1894) 11 R. P. C. at p. 237), Lord Kyllachy said that he was unable to hold that a patent is infringed by the mere granting of licences authorising third parties to use a patented process, or some equivalent.

Custom House Agents are not Infringers.—Custom House agents, who have neither possession of nor control over the infringing article, are not liable as infringers (*Nobel's Co.* v. *Jones* (1882) 8 A. C. 5).

Persons Buying with Notice of Limited Licence.—If a person buys a patented article with notice that the article is sold by the patentee upon special conditions as to user, and he disregards those conditions, he is liable (*Incandescent Co.* v. *Brogden* (1899) 16 R. P. C. 179); but not if he buys without notice (*Incandescent Co.* v. *Cantelo* (1895) 12 R. P. C. 262; see pp. 167, 168, *infra*).

Carriers.—Mere carriers of infringing articles into (*Washburn Co.* v. *Canard Co.* (1889) 6 R. P. C. 398) or within (see *British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. 189, 723) this country, may be sued for infringement (and see pp. 165, 166, *infra*).

Partners.—Where a licence to manufacture a patented article is granted, not to the firm itself, but to one member of

the firm *personally*, no other member of the firm can manufacture the article (see *Howard* v. *Tweedales* (1895) 12 R. P. C. 519).

The Crown.—A patent has to all intents the like effect against the King as it has against a subject (s. 27 (1) of the Patents Act, 1883). But the 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 agreed on, with the approval of the Treasury, between the authorities and the patentee, or, in default of agreement, on such terms as may be settled by the Treasury after hearing all parties interested (s. 27 (2), *ibid.*).

How a Patent may be Infringed.

Where infringement depends merely on the construction of the specification, it is a pure question of law for the Judge: the question, how far one machine imitates or resembles the other, is generally a mixed one of law and fact, and one which must be left to the jury (see *per* Lord Campbell, L.C., in *Seed* v. *Higgins* (1860) 8 H. L. C. at p. 561). In determining the question of infringement, all the circumstances of the case must be regarded. The fact that the alleged infringer was previously employed by the patentee, and suddenly leaves that employment and starts making similar articles on his own account, is one, it seems, to be taken into serious consideration (see *per* Lord Esher, M.R., in *Crampton* v. *Patents Co.* (1889) 6 R. P. C. at p. 294). But mere intention cannot make an act done an infringement which, without the intention, would not be an infringement (see p. 153, *supra*). If the defendant has taken the whole invention, no difficulty, so far as the question of infringement is concerned, arises. But "no infringer of patents is such a blunderer at the work of infringing as to go and make a thing exactly like the patent" (*per* Lord Esher, M.R., in *Peckover* v. *Rowland* (1893) 10 R. P. C. at p. 238). Additions, omissions, or variations generally exist; and the question then arises, whether what the defendant has done is, or is not, within the patentee's claim.

Three Questions to be Considered.—Upon the issue of infringement, three questions have, as a general rule, to be asked: (1) What was known at the date of the patent

alleged to be infringed? (2) What, having regard to what was known, is the area of the patentee's monopoly? and (3) What has the defendant done?

(1) Common Knowledge.—The specification must be construed in the light of the common knowledge existing at the date of the patent (*Consolidated Car Co.* v. *Came* (1903) 20 R. P. C. at pp. 766, 767; and see p. 78, *supra*). It is always necessary, therefore, to ascertain, at the outset, what was known before (see Kay, L.J.'s, judgment in *Incandescent Co.* v. *De Mare System* (1896) 13 R. P. C. at pp. 572—579; *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 340; *Presto Gear Co.* v. *Orme* (1901) 18 R. P. C. at p. 23)

If the invention achieves a totally new result, the patent is considered a "master" or "pioneer" patent (see *per* Cozens-Hardy, L.J., in *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 345), and the extent of the patentee's monopoly will be far wider than in the case of an invention which consists in an improvement upon a known machine or which produces a known though better result. In the former case, the Court 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 the monopoly (see *per* Wood, V.-C., in *Curtis* v. *Platt* (1863) 3 C. D. at p. 136, *n.*; *Proctor* v. *Bennis* (1887) 4 R. P. C. at pp. 361, 362; *Gosnell* v. *Bishop* (1888) 5 R. P. C. at p. 156; *Automatic Weighing Co.* v. *Knight* (1889) 6 R. P. C. at p. 304; *Nobel's Co.* v. *Anderson* (1894) 11 R. P. C. at pp. 527, 534; *Incandescent Co.* v. *De Mare System* (1896) 13 R. P. C. at pp. 572—574). In the latter case, the patentee is tied down strictly to the invention claimed and the mode described of carrying it into effect (*Curtis* v. *Platt*, *supra*, at p. 137; *Gosnell* v. *Bishop*, *supra*; and see the other case quoted above).

(2) Area of the Monopoly.—Having arrived at the previous state of knowledge, you must then construe the specification with reference to that, and ascertain the area of the claims (see *per* Lord Alverstone, C.J., in *Presto Gear Co.* v. *Orme* (1901) 18 R. P. C. at p. 23). "It is no use talking about law, or anything else, until you have studied the specification and seen what the invention really is" (*per* Lindley, L.J., in *Automatic Weighing Co.* v. *Knight* (1889) 6 R. P. C. at p. 307). What the invention really is must be gathered from the complete specification, and from that document alone (see p. 77, *supra*; but see *Incandescent Co.* v. *De Mare System* (1896) 13 R. P. C. at p. 330; and

the ambit or area of the invention will depend to a large extent, as has been mentioned, upon the state of common knowledge at the date of the patent.

The exact meaning of the *specification* is the most important matter for consideration in actions for infringement; and the matter is often one of great difficulty. As to the rules of construction, see p. 77, *supra*.

It must be remembered that nothing is protected which is not claimed (see *per* Lord Herschell, in *Parkinson* v. *Simon* (1895) 12 R. P. C. at p. 406); the alleged infringer must, therefore, be shown to have taken the invention which is in fact claimed, and not the invention which the patentee *might* have claimed if he had been well advised or bolder (see *per* Romer, J., in *Nobel's Co.* v. *Anderson* (1894) 11 R. P. C. at p. 128; *Presto Gear Co.* v. *Orme* (1901) 18 R. P. C. at p. 23; *Welsbach Co.* v. *Daylight Co.* (1900) 17 R. P. C. at p. 146).

(3) Acts done by the Alleged Infringer.—When the area of the monopoly has been ascertained, it is possible, though often by no means easy, to say whether the acts done by the defendant amount to an infringement or not. It is now proposed to consider the different ways in which a patent may be infringed.

Colourable Imitation.—If the substance or the pith and marrow or the characteristic feature of the invention are taken, no matter how disguised, hidden, or concealed, an infringement has been committed (see *per* Lord Cairns, L.C. in *Dudgeon* v. *Thomson* (1877) 3 A. C. at pp. 43—45). What you have to look at is, not simply whether in form or in circumstances that which has been done by the defendant varies from the plaintiff's specification, but whether in reality, in substance, and in effect, the defendant has availed himself of the plaintiff's invention (see *per* Tindal, C.J., in *Walton* v. *Potter* (1841) 1 W. P. C. at p. 587). "A mere addition to the original machine will not prevent the new machine from being an infringement; nor will diminishing or subtracting this or that part of the original machine necessarily prevent an infringement of it from taking place. You must recall yourself, after making allowance for the subtraction, to the question whether in substance the invention has been borrowed" (*per* Bowen, L.J., in *Hocking* v. *Hocking* (1887) 4 R. P. C. at p. 442: and see *per* Lord Watson, *ibid.* (1889) 6 R. P. C. at p. 78: *Incandescent Co.* v. *De Mare System* (1896) 13 R. P. C. at pp. 330, 331, 559: *Osmond* v. *Hirst* (1885) 2 R. P. C. 265; *Proctor* v. *Bennis* (1887) 4 R. P. C. at p. 352; *Presto Gear*

Co. v. *Orme* (1900) 18 R. P. C. at p. 23). If the substance has been taken, the defendant infringes although he may have added to the plaintiff's invention something that may be an improvement (*Ehrlich* v. *Ihlee* (1888) 5 R. P. C. at p. 454; *Wenham Gas Co.* v. *Champion Gas Co.* (1892) 9 R. P. C. at p. 56; *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 343; and see p. 160, *infra*).

Where the substance or essence of the invention has not been adopted by the defendant, there is no infringement, although the result may be the same (*British Tanning Co.* v. *Groth* (1891) 8 R. P. C. at pp. 124, 125; *Sandow* v. *Szalay* (1904) 21 R. P. C. 333; *Dudgeon* v. *Thomson* (1877) 3 A. C. at pp. 44, 45; *Ticket Punch Co.* v. *Colley's Patents* (1895) 12 R. P. C. at p. 185; *Garrard* v. *Edge* (1889) 6 R. P. C. at p. 569).

When the patentee's machine has been altered for the worse, for no good reason, the inference naturally is that the alteration was made for the purpose of concealing a piracy (see *Moore* v. *Thomson* (1890) 7 R. P. C. at pp. 334, 335; *Cheetham* v. *Nuthall* (1893) 10 R. P. C. at pp. 332, 333; *Bunge* v. *Higginbottom* (1902) 19 R. P. C. at p. 196).

Where, to the eye, the two things are so similar that it is necessary to search carefully for differences, a strong *prima facie* case of infringement is at once made out. But such *prima facie* case may, on further examination, be rebutted by the discovery of some essential difference (see *per* Jessel, M.R., in *Thorn* v. *Worthing Skating Rink* (1876) 6 C. D. at p. 417, *n.*; *Sandow* v. *Szalay* (1904) 21 R. P. C. 333). On the other hand, at first sight the two things may appear considerably different, but on minute examination may be found to be substantially the same (*Neil* v. *Macdonald* (1903) 20 R. P. C. at p. 224).

See the several attempts—some of which were successful—to get outside of the specification of Welch's Patent, which are noted and explained by Collins, M.R., in *Dunlop Co.* v. *Clifton Co.* (1903) 20 R. P. C. at pp. 402, 403).

Substitution of Mechanical Equivalents.—Where a person takes the essence or substance of the patented machine or process, and substitutes a *mere* mechanical, chemical, or manufacturing equivalent, he infringes the patent (*Benno Jaffé* v. *Richardson* (1894) 11 R. P. C. at pp. 273, 274; *Proctor* v. *Bennis* (1887) 4 R. P. C. at p. 352; *Automatic Weighing Co.* v. *National Exhibitions* (1891) 9 R. P. C. at pp. 44, 46; *Automatic Weighing Co.* v. *International Society* (1889) 6 R. P. C. at pp. 479, 480; *Thomson* v. *Moore* (1889) 6 R. P. C. at pp. 447, 448).

It is not easy to say what constitutes a mechanical equivalent. Generally, it may be said that the substitution of a known substitute to achieve a step in the patentee's invention will be merely the substitution of a known equivalent for another if it involves no invention or ingenuity (*per* Vaughan Williams, L.J., in *Bunge* v. *Higginbottom* (1902) 19 R. P. C. at p. 196; *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 343).

The test which has been applied by Vaughan Williams, L.J., is—Is the nature of the thing substituted of such a character that it would not be present to the mind of a workman or other person conversant with the subject-matter that he could substitute the one for the other? (*Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 343).

The mere fact, however, that the thing substituted constitutes an improvement will not relieve the defendant from liability (see *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 343; *Ehrlich* v. *Ihlee* (1888) 5 R. P. C. at p. 454: and see p. 160, *infra*).

When the Doctrine of Mechanical Equivalents does not Apply.—The doctrine of mechanical equivalents has no application where the invention is only one for a new mode of attaining an old result (*Tweedale* v. *Ashworth* (1892) 9 R. P. C. at p. 128; *Tweedale* v. *Ashworth* (2) (1900) 17 R. P. C. at p. 625; *Gosnell* v. *Bishop* (1888) 5 R. P. C. at p. 159; *Nettlefolds* v. *Reynolds* (1892) 9 R. P. C. at p. 289; *Ticket Punch Co.* v. *Colley's Patents* (1895) 12 R. P. C. at p. 185); the patentee, in this case, cannot bring within the scope of his invention any mechanical equivalent which he has not specifically described and claimed (*per* Lord Watson, in *Tweedale* v. *Ashworth*, *supra*; *Brown* v. *Jackson* (1895) 12 R. P. C. at p. 324: and see *per* Lord Halsbury, L.C., in *Brooks* v. *Lamplugh* (1899) 16 R. P. C. at p. 48). But it is not a true proposition of law to say that in *no case*, where the invention relates to the production of an old result, can the achievement of the same result, by the use of well-known equivalents, be an infringement. "No one would say that the substitution of a hinge for a slide would constitute such a difference in the combination as that the substitution would negative an infringement" (*per* Vaughan Williams, L.J., in *Bunge* v. *Higginbottom* (1902) 19 R. P. C. at p. 196; and see *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 343).

And before any question of mechanical equivalents can arise the conclusion must be arrived at that the *substance* of the invention has been taken (*per* Lindley, L.J., in *Ticket Punch Co.* v. *Colley's Patents* (1895) 12 R. P. C. at p. 184). If the substance has not

been taken (*Ticket Punch Co.* v. *Colley's Patents, supra*, at pp. 185, 186; *Pneumatic Tyre Co.* v. *Tubeless Tyre* (1898) 16 R. P. C. 77), or if the essential part of the invention has been omitted altogether (*Allen* v. *Abraham* (1899) 16 R. P. C. 135; *Cooper* v. *Baedeker* (1899) 16 R. P. C. at p. 369; *Griffiths* v. *Birmingham Stopper Co.* (1899) 16 R. P. C. at p. 390), there is no infringement.

Moreover, an equivalent, to constitute infringement, must have been *known*, at the date of the patent, to be an equivalent (see *per* Williams, J., in *Unwin* v. *Heath* (1855) 2 W. P. C. at p. 302; *per* Pollock, C.B., *ibid.*, at p. 316; *Badische* v. *Levinstein* (1885) 2 R. P. C. at pp. 90–92, 110; (1887) 4 R. P. C. 449; *Nobel's Co.* v. *Anderson* (1895) 12 R. P. C. at pp. 167, 168); and it must have been known as an equivalent which could have been used for the *very purpose* (*Saudow* v. *Szalay* (1904) 21 R. P. C. at p. 343).

The Term is Apt to Mislead.—The term "mechanical equivalent" is not altogether a happy one, and is often apt to mislead. "It is very easy to say that one machine by which a common object is achieved is merely a mechanical equivalent of another machine by which the same object is arrived at, because, if the same object is to be arrived at by different ways, in a kind of way each of them may be said to be a mechanical equivalent of the other. . . . What you have to do is this—to look at the object that was intended to be arrived at, and see whether or not the defendant's machine is colourably and plainly an adaption of the plaintiff's work" (*per* Hall, V.-C., in *White* v. *Hartley* (1903) 20 R. P. C. at pp. 274, 275; and see *per* Romer, J., in *Nettlefolds* v. *Reynolds* (1892) 9 R. P. C. at p. 289).

Improvements.—Although an improvement upon a patented machine or process may form the subject of valid letters patent (see p. 2), the use of the improvement during the existence of the former patent, and without licence of the prior patentee, amounts to an infringement (see *per* Lord Campbell, C.J., in *Lister* v. *Leather* (1858) 8 El. & B. at p. 1017; *Needham* v. *Johnson* (1884) 1 R. P. C. at p. 53; and see p. 3, *supra*). It is not enough, therefore, for the defendant to show that his invention is an improvement upon the plaintiff's; it must be shown that the two inventions are substantially different (see *Saudow* v. *Szalay* (1904) 21 R. P. C. at p. 343; *Birmingham Tyre Syndicate* v. *Reliance Tyre Co.* (1902) 19 R. P. C. at p. 316; *Pilkington* v. *Massey* (1904) 21 R. P. C. at p. 437).

If the patentee of an improvement upon a prior patent

cannot obtain a licence from the prior patentee to use his invention, it is competent for him to petition for a compulsory licence (see p. 102, *supra*).

Incorporation of Patented Article in Another Article.—It follows that, as an improvement upon a patented article cannot be used otherwise than independently without the sanction of the patentee, the making or user of an article in the manufacture of which a patented machine or product is incorporated, amounts to an infringement (*Saccharin Corpn.* v. *Anglo-Continental Works* (1900) 17 R. P. C. at p. 319).

Infringement of a Combination Patent.—A combination is the use of certain things in connection with others to produce a machine (*per* Cotton, L.J., in *Proctor* v. *Bennis* (1887) 4 R. P. C. at p. 352) or a certain result. By far the largest proportion of patents taken out are for new combinations or arrangements; and the majority of actions for infringement brought are in respect of combination patents.

THE PRINCIPLES OF *Curtis* v. *Platt* AND *Proctor* v. *Bennis*.—In determining whether a combination patent has been infringed, it must first be ascertained to what class the patented combination belongs. Does the combination consist in the putting together of well-known things to produce a known result, or does the combination produce a result never before achieved? The answer depends, of course, upon the evidence as to what was the state of knowledge at the date of the patent, and it materially affects the question of infringement.

If the combination produces no new result, the principles laid down in *Curtis* v. *Platt* ((1863) 3 C. D. 135, *n.*) apply: the patentee is tied down strictly to that which he has described and claimed (*Curtis* v. *Platt*, *supra*; *Gosnell* v. *Bishop* (1888) 5 R. P. C. at p. 156; *Dunlop Co.* v. *New Lamb Tyre Co.* (1902) 19 R. P. C. at p. 389; *Sutcliffe* v. *Abbott* (1902) 20 R. P. C. at p. 58); his monopoly cannot be permitted to exceed the exact terms of his specification (*Brown* v. *Jackson* (1895) 12 R. P. C. at p. 324; *Tweedale* v. *Ashworth* (1892) 9 R. P. C. at p. 128); and the doctrine of mechanical equivalents does not apply (*Curtis* v. *Platt*, *supra*; *Tweedale* v. *Ashworth*, *supra*; *Gosnell* v. *Bishop*, *supra*; *Ticket Punch Co.* v. *Colley's Patents* (1895) 12 R. P. C. at 185; *Brown* v. *Jackson*, *supra*; *Chamberlain* v. *Mayor of Bradford* (1900) 17 R. P. C. at p. 508; (1903) 20 R. P. C. 673). But it is not a true proposition of law to say that the doctrine of mechanical equivalents can *never* apply in the case of combinations

producing old results (see *per* Vaughan Williams, L.J., in *Bunge* v. *Higginbottom* (1902) 19 R. P. C. at p. 196). For instance, if the invention consists of a dumb-bell made resilient by means of *metal* springs, another person would not be permitted to use a dumb-bell made resilient by means of *whalebone* springs (see *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 343). And the substitution of a hinge for a slide would not constitute such a difference in a combination of this type as that the substitution would negative infringement (see *Bunge* v. *Higginbottom* (1902) 19 R. P. C. at p. 196). The variations must be *bonâ fide* ones (*Curtis* v. *Platt* (1863) 3 C. D. at p. 137, *n.*).

If the combination provides a new result, the case of *Proctor* v. *Bennis* ((1887) 4 R. P. C. 333) applies; the patentee is not tied down to the exact terms of his specification, and a person who attains the same result by the use of mechanical or chemical equivalents infringes (*Proctor* v. *Bennis*, *supra*; *Gosnell* v. *Bishop* (1888) 5 R. P. C. at p. 156; *Sutcliffe* v. *Abbott* (1903) 20 R. P. C. at p. 58; *Automatic Weighing Co.* v. *Knight* (1889) 6 R. P. C. at 304; *Automatic Weighing Co.* v. *National Exhibitions* (1892) 9 R. P. C. at pp. 44, 46; *Thomson* v. *Moore* (1889) 6 R. P. C. at pp. 447, 448; *Chamberlain* v. *Mayor of Bradford* (1900) 17 R. P. C. at p. 508).

Whether Taking Part of a Combination is an Infringement.—Where a patent is taken out for a combination merely, nothing is protected by it, and consequently nothing can be an infringement, but the use of the entire combination (see *per* Lord Chelmsford in *Harrison* v. *Anderston Foundry Co.* (1876) 1 A. C. at p. 581; *Gwynne* v. *Drysdale* (1886) 3 R. P. C. at pp. 67, 68; *Dunlop Co.* v. *New Lamb Tyre Co.* (1902) 19 R. P. C. at p. 389); and it is therefore no infringement to take one or some of the component parts unless that part forms the subject of a separate claim (*Davies* v. *Townsend* (1899) 16 R. P. C. 497; and see *Wardroper* v. *Gibbs* (1903) 20 R. P. C. at p. 360). But a person will not be permitted to merely omit some immaterial part, or substitute a known equivalent for some immaterial part, if he appropriates all the *essential and characteristic* features of the combination (*Gwynne* v. *Drysdale*, *supra*). "The essential nature of the invention will be regarded; and . . . there may be cases in which, though the patent is for an entire combination of numerous parts, a colusive 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" (*per* Lord Penzance in *Harrison* v. *Anderston Foundry Co.*,

supra, at p. 593). "If the instrument patented consisted of twelve different steps . . . an infringer who took eight, or nine, or ten of those steps might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four, or five steps which he might not actually have taken" (*per* Lord Cairns in *Clark* v. *Adie* (1877) 2 A. C. at p. 320).

On the question whether a defendant has taken the substance of a combination, although omitting an element of it, it is not necessary that he should show that the omitted part was an essential element in the sense that the machine could not work without it, but it must be a material element for the successful working of the machine (*Consolidated Car Co.* v. *Came* (1903) 20 R. P. C. 745).

Where, however, the patentee claims not only the combination as a whole, but also the parts or integers, or some of the parts or integers, which enter into the whole combination, the use of one of those parts or integers may be an infringement of the patent. For instance, the patentee's invention may be for a combination of parts A. B. C. and D. He may claim that combination as a whole and then proceed to claim, as a separate invention, part D. In such a case, provided that D. is itself a matter which ought properly to form the subject of a patent (see Chapter I., *supra*), its appropriation, *per se*, will be an invasion of the patentee's monopoly (see *per* Lord Cairns in *Clark* v. *Adie*, *supra*, at pp. 321; and see, further, pp. 75, 76, *supra*).

Infringement of a Patent Involving a New Principle.—A principle, *per se*, cannot be the subject of valid letters patent (see p. 6, *supra*); but there may be a valid patent for a principle *coupled with* a mode of carrying the principle into effect (see p. 6, *supra*).

In *Jupe* v. *Pratt* ((1837) 1 W. P. C. at p. 146), Alderson, B., said that when you have invented a mode of carrying a principle into effect, you are entitled to protect yourself from *all other* modes of carrying the same principle into effect. But, as was pointed out by Cotton, L.J., in *Automatic Weighing Co.* v. *Knight* ((1889) 6 R. P. C. at p. 304), this expression was used by Baron Alderson during the discussion, and probably did not express his full opinion. "You can," said Cotton, L.J., in the same case, "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"; but you cannot prevent anyone from carrying the principle into effect by

substantially different means. In *Pneumatic Tyre Co.* v. *Tubeless Tyre Co.* ((1899) 16 R. P. C. at pp. 79, 80), Lord Halsbury said: "That a principle which was applied in the former case exists here I do not deny—I think that is true; but that there is any principle which can be claimed as a principle, as distinct from the application of it to the particular machine, is of course quite outside the region of Patent Law. You cannot appropriate to yourself a mere principle; you can only appropriate the application of the principle. . . . Although the same principle is made use of here it is not made use of in the same way, nor is it, nor could it be, gravely represented as being the same application of the same principle—although I admit the principle to be the same." And see *Tweedale* v. *Ashworth* (1892) 9 R. P. C. at p. 126; *cf. Chamberlain* v. *Mayor of Bradford* (1903) 20 R. P. C. at p. 684; *Edison-Bell* v. *Smith* (1894) 11 R. P. C. at pp. 397, 398.

But "where there is a principle first applied in a machine capable of carrying it into effect, the Court looks very 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" (*per* Cotton, L.J., in *Automatic Weighing Co.* v. *Knight* (1889) 6 R. P. C. at p. 304; and see *Tweedale* v. *Ashworth* (1892) 9 R. P. C. at p. 126; *Consolidated Car Co.* v. *Came* (1903) 20 R. P. C. at p. 767). And the consideration of the principle sought to be applied is material in determining the essence of the invention (*per* Palles, C.B., in *Thomson* v. *Moore* (1889) 6 R. P. C. at p. 450; affirmed (1890) 7 R. P. C. 325).

Manufacture.—A person who manufactures (*Muntz* v. *Foster* (1844) 2 W. P. C. at pp. 100, 101), or procures to be manufactured by others (see *per* Tindal, C.J., in *Gibson* v. *Brand* (1842) 1 W. P. C. at p. 631; *Incandescent Co.* v. *Brogden* (1899) 16 R. P. C. at p. 184), a patented article, without the sanction of the patentee, commits an act of infringement. But a person who manufactures an article, which is an infringement, at the instance of the patentee's agent, is not liable (*Kelly* v. *Batchelor* (1893) 10 R. P. C. 289; *cf. Dunlop Co.* v. *Neal* (1899) 16 R. P. C. 247). And if a patented article is made merely by way of *bonâ fide* experiment, there is no infringement (see *per* Jessel, M.R., in *Frearson* v. *Loe* (1878) 9 C. D. at pp. 66, 67; *Muntz* v. *Foster*, *supra*).

User.—The mere use in this country of a patented article, without licence, constitutes infringement (see *Betts* v. *Neilson*

(1868) 3 Ch. at p. 439). It is no answer to an action for infringement to show that the user was only *in itinere* (*Betts* v. *Neilson*, *supra*, at p. 437) or consisted merely in transportation (*British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. at pp. 193, 194, 723; and see *Washburn Co.* v. *Cunard Co.* (1889) 6 R. P. C. 398). But if any person who, directly or indirectly, had anything to do with the means by which goods get from one place to another, were to be held liable as an infringer, it would injuriously encourage idle and vexatious litigation (see *per* James, L.J., in *Nobel's Co.* v. *Jones* (1881) 17 C. D. at p. 743). Hence, Custom House agents, as such, are not liable in an action for infringement (*Nobel's Co.* v. *Jones*, *supra*; (1882) 8 A. C. 5).

It is no defence to show that the patented article was used for a different purpose (see *per* Stirling, J., in *British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. at p. 194). "A man who finds that a patented invention can be used for a new purpose cannot justify his user of the invention for that purpose without paying for it, merely because the patentee had not contemplated originally that his invention could be so applied" (*per* Romer, J., in *Pneumatic Tyre Co.* v. *East London Co.* (1896) 14 R. P. C. at p. 103; and see *per* Lord Westbury in *Cammington* v. *Nuttall* (1871) L. R. 5 H. L. at p. 230; *cf. Fletcher* v. *Glasgow Commissioners* (1887) 4 R. P. C. 386; *Edison* v. *Holland* (1888) 5 R. P. C. at p. 482; *Re Cutler's Patent* (1839) 1 W. P. C. at p. 427).

It is immaterial, it seems, whether the user is active or passive (see *Betts* v. *Neilson* (1868) 3 Ch. at p. 439).

User by way of *bonâ fide* experiment does not constitute infringement (see *per* Jessel, M.R., in *Frearson* v. *Loe* (1878) 9 C. D. at pp. 66, 67; *Muntz* v. *Foster* (1844) 2 W. P. C. at p. 101). *Secus*, where the use results in a pecuniary advantage, however indirectly, to the user, or where it prejudicially affects the patentee (see *Frearson* v. *Loe* (1878) 9 C. D. at pp. 66, 67). Thus, if a man uses an infringing article for the purpose of instructing his pupils (*United Telephone Co.* v. *Sharples* (1885) 29 C. D. 164), or for the purpose of reducing the cost of manual labour at his works (*Proctor* v. *Bailey* (1889) 6 R. P. C. at p. 109), the plea of experimental user is not available.

Importation.—The importation of an infringing article, made abroad, for sale or use in this country (*Elmslie* v. *Boursier* (1869) 9 Eq. 217; *Von Heyden* v. *Neustadt* (1878) 14 C. D. 230; *Saccharin Corpn.* v. *Anglo-Continental Works* (1900) 17 R. P. C. 307), or merely for transhipment here for exportation (*Nobel's*

Co. v. *Jones* (1879) 17 C. D. at p. 724; *United Telephone Co.* v. *Sharples* (1885) 29 C. D. 164; and see *British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. at pp. 193, 194, 723), amounts to an infringement. But an English merchant who contracts, in this country, for the sale of an infringing article to an English firm, the infringing article being made abroad and delivered to the purchasers at a foreign port, is not an importer and does not infringe, although he is well aware that the article will find its way into this country (*Saccharin Corpn.* v. *Reitmeyer* (1900) 17 R. P. C. 606).

A foreigner, who, by himself or his agent, imports an infringing article into this country is liable as an infringer (*Badische* v. *Johnson* (1897) 14 R. P. C. at p. 415). But he is not liable if he sells the article outside the United Kingdom to an English importer, or his agent (*Badische* v. *Johnson*, *supra*, at p. 414). In this case, B., living in England, wrote to A., domiciled abroad, ordering five pounds of dye to be sent to him by post. A. wrote back, enclosing an invoice, and on the same day sent the dye to N., who forwarded it by post to B. in London. It was held, although the dye was admitted to be an infringement, that A. was not liable, as he had not by himself or by his agent imported the dye into England. And see *Saccharin Corpn.* v. *Reitmeyer* (1900) 17 R. P. C. 606.

Use of Patented Article on Foreign Vessel in British Waters.—A patent does not prevent the use of an invention for the purposes of the navigation of a foreign vessel within British waters, nor the use of an invention in a foreign vessel within British waters, provided the invention is not used in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or the Isle of Man. But this privilege does not extend to vessels of foreign States where like privileges are not afforded to British vessels (s. 43 of the Patents Act, 1883).

Sale.—The grant of letters patent includes a monopoly of the sale in this country of articles made according to the specification, whether the articles be made in the realm or elsewhere (see *per* James, L.J., in *Von Heyden* v. *Neustadt* (1880) 14 C. D. at p. 233; *Elmslie* v. *Boursier* (1869) 9 Eq. 217).

Hence, the sale of infringing articles affords good ground for an action for infringement, however small the sale, and however trivial the value of the articles sold (see *Cole* v. *Saqui* (1888) 5 R. P. C. at p. 493; *Badische* v. *Dawson* (1889) 6 R. P. C. 387).

The mere offering or exposure for sale of an article made in accordance with the patentee's specification is an invasion of the patentee's rights; for, although it may not be considered "vending" (see *Minter* v. *Williams* (1835) 1 W. P. C. 135), it is a "user" which is prohibited (*Oxley* v. *Holden* (1860) 8 C. B. (N. S.) 666; *Dunlop Co.* v. *British Car Co.* (1901) 18 R. P. C. 313; *British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. at p. 729).

SALE OF COMPONENT PARTS.—It is no infringement to sell some of the component parts which go to make up a patented combination, even though the seller knows that the parts are intended to be used in infringement of the patent (*Dunlop Co.* v. *Moseley* (1904) 21 R. P. C. 274; *Townsend* v. *Haworth* (1875) 12 C. D. at p. 831, *n.*; *Sykes* v. *Howarth* (1879) 12 C. D. at p. 833; and see *Savage* v. *Brindle* (1896) 13 R. P. C. 266). But a person infringes if he sells *all* the parts manufactured so as to be adapted for putting together (see *per* Vaughan Williams, L.J., in *Dunlop Co.* v. *Moseley*, *supra*, at p. 280; *per* Pearson, J., in *United Telephone Co.* v. *Dale* (1884) 25 C. D. at pp. 782, 783), or some of the parts *in conjunction* with some other person who sells the remaining parts (*Incandescent Co.* v. *New Incandescent Co.* (1898) 15 R. P. C. 81; *Dunlop Co.* v. *Moseley*, *supra*). And a person is liable if he invites his customers to use articles sold by him in an infringing manner (*Innes* v. *Short* (1898) 14 T. L. R. 492).

In *Dunlop Co.* v. *Cresswell* ((1901) 18 R. P. C. 473) the owners of a patent for improvements in cycle tyres granted a licence to a company to make the tyres in accordance with a deposited tyre. C. sold to the company canvas strips to which the company affixed wires (in accordance with those in the deposited tyre) and re-sold the strips and wires to C., who then added the outer rubber and sold the tyre. Held; C. had not infringed.

INFRINGEMENT BY PURCHASERS.—If a patentee has licensed the manufacture of articles under his patent, purchasers from the licensee, or from his vendees, may use or resell the articles without the patentee's consent (*Thomas* v. *Hunt* (1864) 17 C. B. (N. S.) 183). But this implied licence to the purchaser may be limited by terms imposed on the sale. Thus, in *Incandescent Co.* v. *Brogden* ((1899) 16 R. P. C. 179), the plaintiffs had printed on every box containing the patented article words to the effect that neither the purchaser nor any person into whose hands the patented article should come should use or sell the article except in connection with another article supplied by the plaintiffs. It

was held that any person buying with notice of the condition was bound by it, and if he disregarded it he was liable as an infringer. If, however, a person buys *without* notice of such a condition, he will not be bound by and may disregard it, although he becomes aware of it shortly after the purchase (*Incandescent Co.* v. *Cantelo* (1895) 12 R. P. C. 262).

On the sale of an infringing article there is no implied warranty that the purchaser will be able to make use of it; the purchaser may be sued for infringement by the patentee and yet be liable to the vendor of the article for the price of it (*Monforts* v. *Marsden* (1895) 12 R. P. C. 266).

Repairs.—Any simple repairs may be done by a person without any licence from the patentee (see *per* North, J., in *Dunlop Co.* v. *Neal* (1899) 16 R. P. C. at p. 250; and see *Savage* v. *Brindle* (1896) 13 R. P. C. 266). But infringing articles will not be allowed to be made under guise of repairs; if the result of the repairs is, in effect, a new article, the repairer is liable as an infringer (*Dunlop Co.* v. *Neal, supra*; and see *United Telephone Co.* v. *Nelson* W. N. (1887) 193; *Dunlop Co.* v. *Excelsior Co.* (1901) 18 R. P. C. 209; *Dunlop Co.* v. *Holborn Co.* (1901) 18 R. P. C. at p. 226; but see *per* Cozens-Hardy, L.J., in *Dunlop Co.* v. *Moseley* (1904) 21 R. P. C. at p. 282).

Possession.—The mere possession of an infringing article is sufficient ground for granting an injunction; actual user or sale need not be proved (*United Telephone Co.* v. *London & Globe Co.* (1884) 1 R. P. C. at p. 119; and see *Adair* v. *Young* (1879) 12 C. D. 13; *British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. 189, 723; *Dowling* v. *Billington* (1890) 7 R. P. C. at p. 201; *Dunlop* v. *British Car Co.* (1901) 18 R. P. C. 313). Where a person is in possession of a thing it cannot be assumed that he is in possession of it for no purpose at all (see *Proctor* v. *Bailey* (1889) 6 R. P. C. at p. 112; but see p. 538); and if it is not his intention to use the thing, then an injunction can do him no harm (*per* Bacon, V.-C., in *United Telephone Co.* v. *London & Globe Co.*, *supra*; but see *Proctor* v. *Bailey* (1889) 6 R. P. C. 538).

The fact that the article has only been lent to the possessor would, it is submitted, be no defence; but whether there would be any infringement in merely testing an article sent on approval only, is not, having regard to the decision in *United Telephone Co.* v. *Henry* ((1885) 2 R. P. C. 11), quite clear.

Threatened Infringements.—A patentee need not wait until infringement has actually been committed. If he has reasonable

ground to apprehend that a man will infringe his rights he can go to the Court and obtain an injunction to restrain him from carrying out his intention, provided that it is made clear that the act, if carried out, would be an infringement (*Dowling* v. *Billington* (1890) 7 R. P. C. at p. 201; *Frearson* v. *Loe* (1878) 9 C. D. at p. 65).

Offer to Make Similar Articles.—If a person merely offers to make an article of the same class as the article patented, and no actual infringement is proved, the assumption is that the offer related to articles which would not be infringements; "the presumption is always in favour of innocence" (*per* Lord Maclaren in *Gwynne* v. *Drysdale* (1885) 2 R. P. C. at p. 164; affirmed (1886) 3 R. P. C. 65).

THE ACTION FOR INFRINGEMENT.

When a patentee considers that his monopoly has been invaded, he may bring an action for infringement wherein he can, if successful, obtain—(1) an injunction, (2) damages *or* an account of profits, and (3) delivery up or destruction of the infringing articles. Proceedings for infringement cannot be instituted until the patent has been granted (s. 15 of the Patents Act, 1883); and if proceedings are taken after failure to make any renewal payment within the prescribed time, and before enlargement thereof, the Court may refuse to award any damages (s. 17 (4), *ibid.*).

Course to Pursue where Several Infringers.—It often happens that a patent is being infringed by several persons at the same time, and the question then arises as to what course to adopt. To take action against one only is not sufficient; for the others are not bound by the result, and, when themselves sued, may charge the plaintiff with laches (see the curious position of the plaintiffs in *Acetylene Co.* v. *Giffre* (1903) 20 R. P. C. 286). In these circumstances the proper course is to proceed to obtain an interlocutory injunction against one infringer and to write to the others and say: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you do not object on the ground of delay, I do not mean to (issue writs) against all of you at once" (*per* Wood, V.-C., in *Borill* v. *Crate* (1865) 1 Eq. at p. 391). If there are no answers, and if the infringers are all desirous of throwing obstacles in the patentee's way, the patentee must issue as many writs as there are infringers (*North British Co.* v. *Gormully* (1894) 12 R. P. C. at p. 21).

Notice of Intention to Commence Action.—The patentee is not bound to give the alleged infringer any notice before commencing action; nor is he bound to discontinue upon the defendant admitting the infringement and promising not to repeat it (see *Losh* v. *Hague* (1837) 1 W. P. C. 200; *cf. Proctor* v. *Bailey* (1889) 6 R. P. C. at pp. 543—545). But if the defendant admits infringement, and offers to submit to an injunction, he will not be ordered to pay the costs where the value of the infringing articles is trifling (*American Tobacco Co.* v. *Guest* (1892) 9 R. P. C. 218; *cf. Upmann* v. *Forester* (1883) 24 C. D. 231). Where only one infringing article was in the possession of the defendant, and he offered, before action brought, to give an undertaking not to use it during the existence of the patent, a motion for an interlocutory injunction was dismissed with costs (*Lyon* v. *Mayor of Newcastle* (1894) 11 R. P. C. 218; see also p. 212, *infra*).

Actions Against Small Retailers.—These are not encouraged: an endeavour ought to be made to sue those who set the articles upon the market. Although the plaintiff is entitled to an injunction, the defendant will not, as a general rule, be fixed with the costs of the action, provided he has acted innocently and does not deny the infringement (see *American Tobacco Co.* v. *Guest* (1892) 9 R. P. C. at p. 220).

Action for Infringement of Several Patents.—It is essential, in some cases, to sue on several patents. In *Saccharin Corpn.* v. *Quincey* ((1900) 17 R. P. C. 337) several patents were sued upon and infringement was found, although it was impossible to say which particular patent had been infringed; had the plaintiffs brought separate actions in respect of each patent they must have failed in each action (see *per* Cozens-Hardy, J., at p. 339).

But it is a mistake and highly inconvenient, as a general rule, to sue the defendant in one action for infringement of several patents (see *per* Smith, L.J., in *Brooks* v. *Lamplugh* (1898) 15 R. P. C. at p. 47). If any of the patents are not relied upon at the trial (see p. 219, *infra*), or if infringement of all of them is not proved (*British Motor Syndicate* v. *Universal Motor Co.* (1899) 16 R. P. C. at pp. 134, 135; *cf. Saccharin Corpn.* v. *Jackson* (1903) 20 R. P. C. 611; *Saccharin Corpn.* v. *Quincey, supra*), the question of costs will be materially affected (see *Brooks* v. *Lamplugh, supra*: and see p. 219, *infra*). Moreover, the defendant may apply to have the action limited to only one or two of the patents. In *Saccharin Corpn.* v. *Wild* ((1903) 20 R. P. C. 243), where the

plaintiffs sued upon twenty-three patents, the Court of Appeal ordered that the action should be confined to three. In *Saccharin Corpn.* v. *White* ((1903) 20 R. P. C. 454), the plaintiffs were allowed to sue on seven patents, but on special terms as to costs. Whether the plaintiff would be limited as to the number of patents alleged to be infringed where the defendant does not deny their validity, *quære* (see *Saccharin Corpn.* v. *Jackson* (1903) 20 R. P. C. at p. 616).

The Court.—The action may be brought either in the King's Bench Division or in the Chancery Division; but it is now almost invariably brought in the latter Division. If trial with a jury is desired, the action must, of course, be brought in the King's Bench Division; but the action must be tried *without* a jury unless the Court otherwise directs (s. 28 (1) of the Patents Act, 1883).

The Palatine Court of Lancaster has jurisdiction to try patent actions (the Chancery of Lancaster Act, 1890 (53 & 54 Vict. c. 23)). The County Courts have no jurisdiction to try actions for infringement where the validity of the patent is in issue (*R.* v. *County Court Judge of Halifax* [1891] 2 Q. B. 263).

The Court may, and must on the request of either of the parties, try and hear the case with the assistance of an assessor (s. 28 of the Patents Act, 1883).

The Parties.

Plaintiffs.—All persons claiming any interest in the patent should be made plaintiffs (see *Bergmann* v. *Macmillan* (1881) 17 C. D. 423). But one of several co-owners may sue alone for an injunction, delivery up or destruction of the infringing articles, and an account of profits (*Sheehan* v. *G. E. R. Co.* (1880) 16 C. D. at p. 63; *Dent* v. *Turpin* (1861) 30 L. J. (N. S.) Ch. 495; *Anderson* v. *Patent Oxonite Co.* (1886) 3 R. P. C. 279; but as to an account, see *Bergmann* v. *Macmillan*, *supra*). And the owner of a separate and distinct part of a patent may sue alone for damages in respect of an infringement of that part (*Dunnicliff* v. *Mallet* (1859) 7 C. B. (N. S.) at p. 227).

A mortgagor may sue alone for infringement: he need not join his mortgagee (*Van Gelder* v. *Sowerby Bridge Society* (1890) 7 R. P. C. 208).

A legal assignee may sue for infringement of the patent assigned (*Walton* v. *Lavater* (1860) 8 C. B. (N. S.) 162); but the assignment should first be registered (see *Chollet* v. *Hoffman*

(1857) 26 L. J. (N. S.) Q. B. 249; *Bowden's Patents* v. *Smith* (1904) 21 R. P. C. 438; *cf. Hassall* v. *Wright* (1870) 40 L. J. (N. S.) Ch. 145).

An equitable assignee cannot sue alone (*Bowden's Patents* v. *Smith*, *supra*); but the assignee or trustee of a bankrupt patentee may (*Bloxam* v. *Elsee* (1827) 6 B. & C. 169).

A mere licensee cannot sue for infringement in his sole name, whether the licence be exclusive or not; he must join the patentee (*Heap* v. *Hartley* (1889) 6 R. P. C. 495; *Derosne* v. *Fairie* (1835) 1 W. P. C. at p. 155). But where the licence is coupled with a grant, the licensee can probably sue alone (see *Heap* v. *Hartley* (1889) 6 R. P. C. at p. 501).

A mere agent for the sale of a patented article cannot sue infringers (*Adams* v. *N. B. Rail. Co.* (1873) 29 L. T. (N. S.) 367).

Where a patent is assigned to two persons as tenants in common, and one dies, the right of action in respect of infringements committed after the assignment and before the death of the deceased assignee survives to the other, who may recover the whole amount of the damages sustained by him and his late co-assignee (*Smith* v. *L. & N.-W. Rail. Co.* (1853) Macr. P. C. 203). Where a patent, by virtue of the grant or otherwise, is vested in two persons jointly, and one dies, the interest passes by survivorship to the other (*National Co.* v. *Gibbs* (1899) 16 R. P. C. 339; reversed on appeal on other grounds, 17 R. P. C. 302).

If the Judge thinks that an action is defective for want of parties, it is his duty to join the necessary parties himself in order to cure the defect (*Van Gelder* v. *Sowerby Bridge Society* (1890) 7 R. P. C. 208).

Defendants.—As to what persons are liable as infringers, and may be made defendants, see p. 153, *supra*. The manufacturer or importer should be sued in preference to the retailer (see *American Tobacco Co.* v. *Guest* (1892) 9 R. P. C. at p. 220), although, of course, both are equally liable to be restrained by injunction.

The manufacturer of an infringing article and the purchasers from him may be made defendants in the same action (*Proctor* v. *Bennis* (1887) 4 R. P. C. 334). The plaintiff may have an account against the manufacturer and damages against the purchasers (*Penn* v. *Bibby* (1866) 3 Eq. 308). An account against the manufacturer does not licence the use of the infringing articles in the hands of all the purchasers; the article may be followed into every man's hand until the infringement is

got rid of (see *per* Wood, V.-C., in *Penn* v. *Bibby*, *supra*, at p. 311; *Dunlop Co.* v. *Rimington* (1900) 17 R. P. C. at p. 668; *cf.* *Pneumatic Tyre Co.* v. *Goodman* (1896) 13 R. P. C. 723).

If the infringer has sold his business to a company after action brought, leave to add the company as a defendant will not be granted (*Briggs* v. *Lardeur* (1885) 2 R. P. C. 13).

The directors of a company should not be made co-defendants unless it can be proved that they are personally liable (see *Leeds Forge Co.* v. *Deighton's Co.* (1901) 18 R. P. C. at p. 240).

Where the plaintiff sued the user of a certain machine, and the manufacturer of the machine applied to be made a defendant under R. S. C. Ord. 16, r. 11, alleging that his presence before the Court was necessary, the application was refused (*Moser* v. *Marsden* (1892) 9 R. P. C. 214).

The Writ.

The writ is usually endorsed for an injunction (see p. 203, *infra*); an account or damages (see p. 206, *infra*); and delivery up or destruction of the infringing articles (see p. 206, *infra*). A claim for passing off is sometimes included (see *Hewitt* v. *Nurse* (1900) 17 R. P. C. 264; *Poulton* v. *Kelley* (1904) 21 R. P. C. 392).

If an interlocutory injunction is desired, leave to serve notice of motion with the writ is granted almost as a matter of course. Interlocutory injunctions are dealt with later (see pp. 184—192).

Service out of the Jurisdiction.—Service out of the jurisdiction may be directed (R. S. C. Ord. 11). Order 11 does not enable the Court to direct service out of the jurisdiction of a writ claiming damages for infringement of a patent which has expired, although an injunction is also sought in respect of another patent (*Badische* v. *Chemische* (1904) 21 R. P. C. 345). As to the evidence necessary to obtain leave or to discharge the order granting leave, see *Badische* v. *Thompson* (1903) 20 R. P. C. 422; *Badische* v. *Chemische* (1903) 20 R. P. C. 413.

Where a foreign company exhibited motors at the Crystal Palace, and had a stand but no office there, service of a writ on a person in charge of the stand was held good service (*Dunlop Co.* v. *Actien Gesellschaft* (1902) 19 R. P. C. 46).

The Pleadings.

Statement of Claim.—In the statement of claim the grant of the patent should be set out, and if the plaintiff is not himself the patentee the derivation of his title should be shown.

The infringement need only be alleged in general terms, as

particulars thereof must be set out in the particulars of breaches (see pp. 175—177, *infra*).

Where the action is based, not on actual but on *threatened* infringement, the pleadings should be so framed; the two actions are distinct in themselves, though they may be combined in one. If threatened infringement is alone relied upon, of necessity there can be no particulars of breaches; but care is always taken that the defendant shall have fair notice as to the nature and particulars of the special infringement he is alleged to be contemplating (*Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at pp. 357, 358; *cf. Dowling* v. *Billington* (1890) 7 R. P. C. 191). The only remedy where no actual infringement has been committed is an injunction (*Dowling* v. *Billington*, *supra*).

Costs need not be claimed; but if in a previous action a certificate that the validity of the patent came into question has been granted, that fact should be pleaded and costs as between solicitor and client should be claimed (see *Pneumatic Tyre Co.* v. *Chisholm* (1896) 13 R. P. C. 488).

It is not necessary to allege that the patent is valid or subsisting (see Form 6, Appendix C., R. S. C.) or that the invention was new (*Amory* v. *Brown* (1869) 8 Eq. 663).

No part of the specification need be set out (see *Kay* v. *Marshall* (1836) 2 W. P. C. 39; Form 6, *ibid.*).

If the specification has been amended, this fact, with the date, should be stated; and the plaintiff should plead that the original claim was framed in good faith and with reasonable skill and knowledge, if he seeks to recover damages in respect of infringements committed before the amendment (see *Kane* v. *Boyle* (1901) 18 R. P. C. at pp. 337, 338).

The statement of claim must not, of course, introduce a cause of action different from that disclosed by the writ (see *United Telephone Co.* v. *Tasker* (1888) 6 R. P. C. 38).

Motion for Judgment in Default of Pleading.—If the defendant makes default in delivering a defence, the plaintiff may set down the action on motion for judgment (R. S. C. Ord. 27, r. 11). But where there are several defendants, some of whom deliver a defence and some do not, the Court will refuse to order judgment to be entered against those in default, as the others might upset the patent at the trial (*Actien Gesellschaft* v. *Remus* (1895) 12 R. P. C. 94). If, however, there are only two defendants, and one delivers a defence but does not set up validity of the patent and the other defendant does not deliver a defence, judgment will

be ordered to be entered against the one in default (*Dunlop Co.* v. *Fulton* (1902) 19 R. P. C. at p. 319).

Defence.—The defendant may deny infringement, or he may allege that the patent is not valid, or he may avail himself of both grounds of defence. He may also plead that the plaintiff has no title to the patent sued upon; or that the patent has ceased through failure to make the prescribed payments within the prescribed times (s. 17(2) of the Act of 1883; see p. 38, *supra*); or that the infringement was committed prior to the grant of the patent (s. 13, *ibid.*; see p. 36, *supra*); or that the infringement was committed prior to amendment of the specification and that the original claim was not framed in good faith or with reasonable skill and knowledge (s. 20, *ibid*; see p. 89, *supra*). Every ground on which a patent might, at the commencement of the Act of 1883, be repealed by *scire facias*, is available by way of defence to an action for infringement (s. 26 (3), *ibid.*; see pp. 114, 115, *supra*, and p. 178 *infra*).

If the defendant pleads that the patentee was not the true and first inventor, the plaintiff is probably not entitled to particulars as to who the first inventor was (see *Russell* v. *Ledsam* (1843) 11 M. & W. 647; but see *Morgan* v. *Windover* (1890) 7 R. P. C. at p. 449). The plea is distinct from the issue as to novelty (*Household* v. *Neilson* (1843) 1 W. P. C. at p. 689; *Thomson* v. *Macdonald* (1891) 8 R. P. C. at p. 9), or invention (*Thomson* v. *Macdonald, supra*); and it should never be pleaded unless the defendant is prepared to bring evidence to show that the patentee was not really the inventor (*Thomson* v. *Macdonald, supra*; *Morgan* v. *Windover* (1890) 7 R. P. C. at p. 449).

Where the defendant decides to dispute the validity of the plaintiff's patent, the usual practice is, now, simply to state: "The plaintiff's patent is not valid for the reasons given in the particulars of objections delivered herewith" (see *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 336).

A plaintiff *may* be ordered to give discovery before delivery of the defence; but the defendant must make out a very special case before such an order will be made (see *Woolfe* v. *Automatic Picture Gallery* (1902) 19 R. P. C. 161).

Particulars of Breaches.

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 (s. 29 (1) of the Act of

1883); and at the hearing no evidence can, except by leave of the Court or a Judge, be admitted in proof of any alleged infringement of which particulars are not so delivered (s. 29 (4), *ibid.*). On taxation of costs, regard is had to the particulars delivered; and no costs are allowed in respect of any particular unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper (s. 29 (6), *ibid.*; see p. 214, *infra*).

The object of particulars of breaches is to tell the defendant what the plaintiff says he has done in infringement of the patent; their office is not to answer an interrogatory (*Wenham* v. *Champion Gas Co.* (1891) 8 R. P. C. 22; and see *Cassella* v. *Levinstein* (1891) 8 R. P. C. 473) or to disclose evidence (*Mandleberg* v. *Morley* (1893) 10 R. P. C. at p. 260).

The particulars are sufficient if, taken together with the pleadings, they give the defendant full and fair notice of the case to be made against him (*Needham* v. *Oxley* (1863) 1 H. & M. 248; and see *Petman* v. *Bull* (1886) 3 R. P. C. 391; *Church Co.* v. *Wilson* (1886) 3 R. P. C. at p. 127).

A person who merely sells infringing articles is entitled to more detailed particulars than a person who infringes by manufacturing (*Mandleberg* v. *Morley* (1893) 10 R. P. C. 256).

The particulars should state specifically how the patent has been infringed; if infringement by use is alone complained of the Court will not consider whether there has been an infringement by manufacture (*Henser* v. *Hardie* (1894) 11 R. P. C. at p. 427).

If two distinct processes are described in the specification, and the defendant's process may be an infringement of one but not of the other, the defendant is entitled to know which he is alleged to have infringed (see *per* Jervis, C.J., in *Talbot* v. *La Roche* (1854) 15 C. B. at p. 320; *cf. Moseley* v. *Victoria Rubber Co.* (1886) 3 R. P. C. at p. 357).

Where there is more than one claim, the particulars should state whether all or only some and which of them are relied upon (*Haslam* v. *Hall* (1887) 4 R. P. C. at p. 206) unless the particulars refer to pages and lines of the specification (*Elsey* v. *Butler* (1884) 1 R. P. C. 187).

If certain claims are referred to, and certain articles are referred to as infringing those claims, the particulars need not, as a general rule, state what portions of the specification are alleged to be infringed by reference to pages and lines of the specification (*Church Co.* v. *Wilson* (1886) 3 R. P. C. 123: *Cheetham* v. *Oldham* (1888) 5 R. P. C. 624).

Where the specification described thirteen different kinds of pens, referring to them by numbers, the Court ordered the plaintiff to give particulars, by the number of the pens, on which the infringement was based (*Perry* v. *Mitchell* (1840) 1 W. P. C. 269).

If the defendant is alleged to have made certain machines with the plaintiff's invention applied, particulars should be given as to the portions of the machines to which the invention has been applied; and inspection of the machines for this purpose may be ordered (*Jones* v. *Lees* (1856) 25 L. J. (N. S.) Ex. 241).

Instances of Infringement.—Specific instances of the infringements complained of must be given (*Tilghman's Co.* v. *Wright* (1884) 1 R. P. C. 103); if infringement by sale is complained of, the names and addresses of the purchasers should be specified (*Murray* v. *Clayton* (1872) 15 Eq. 115).

But the plaintiff has in some cases been allowed to add general words so as not to be confined at the trial to the instances given (*Tilghman's Co.* v. *Wright, supra*; *Haslam* v. *Hall* (1887) 4 R. P. C. 203). The instances given must, however, be specific. The plaintiff will not be allowed to mention them "by way of example only" (*Patent Type-Founding Co.* v. *Richards* (1860) 2 L. T. (N. S.) 359; *cf. Talbot* v. *La Roche* (1854) 15 C. B. 310), or "in particular by way of illustration" (*Church Co.* v. *Wilson* (1886) 3 R. P. C. 123; *Haslam* v. *Hall, supra*).

Where the plaintiff is unaware at the time of the names of the persons to whom the alleged infringing articles have been sold, he may, it seems, state that he is unable to give further particulars until he has obtained discovery (see *Russell* v. *Hatfield* (1885) 2 R. P. C. 144; and see *Woolfe* v. *Automatic Picture Gallery* (1902) 19 R. P. C. 161).

Application for Further and Better Particulars.—If the defendant considers that the particulars furnished by the plaintiff are not sufficiently full, he should apply for further and better particulars.

The plaintiff may be ordered to give better particulars although the action has been set down for trial (*Mandleberg* v. *Morley* (1893) 10 R. P. C. 256).

Where the plaintiff alleged that he was unable to give better particulars until he had interrogated the defendant, no order was made, but the defendant was given leave to apply again at a later stage (*Russell* v. *Hatfield* (1885) 2 R. P. C. 144).

Particulars of Objections.

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 intends to rely (s. 29 (2) of the Patents Act, 1883). On taxation of costs regard is had to the particulars delivered; and no costs are allowed in respect of any particular unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper (s. 29 (6), *ibid.*; see p 213., *infra*). At the hearing no evidence can, except by leave of the Court or a Judge, be admitted in proof of any objection of which particulars are not so delivered (s. 29 (4), *ibid.*). But the objections delivered by one defendant may be relied upon by another in the same interest (*Smith* v. *Cropper* (1885) 10 A.C. 249).

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, the *time and place* of the alleged previous publication or user must be stated (s. 29 (3), *ibid.*).

The object of particulars is to prevent surprise (see *per* Lindley, L.J., in *Holliday* v. *Heppenstall* (1889) 6 R. P. C. at p. 328), to limit the scope of the inquiry, and to prevent expense (*Nettlefolds* v. *Reynolds* (1891) 8 R. P. C. at p. 417).

An objection should not be raised unless it is intended to be relied upon at the trial (*Allen* v. *Oates* (1898) 15 R. P. C. 303; *Phillips* v. *Ivel Cycle Co.* (1890) 7 R. P. C. at p. 85; *Hattersley* v. *Hodgson* (1903) 20 R. P. C. at p. 598); and a long list of anticipations, of which only two or three will be mentioned at the trial, should not be put forward (*Thomson* v. *Batty* (1889) 6 R. P. C. at p. 97).

The defendant may rely upon any ground on which a patent might, at the commencement of the Patents Act, 1883, be repealed by *scire facias* (s. 26 (3); see pp. 114, 115, *supra*). The grounds most commonly raised are:—

(*a*) That the patentee was not the true and first inventor.

(*b*) That the invention was not new.

(*c*) That the thing patented involved no invention or ingenuity.

(*d*) That the invention is not useful.

(*e*) That the complete specification claims an invention different from that disclosed by the provisional specification.

(*f*) That the specification is insufficient.

(*g*) That a prior patent for the same invention has been granted.

(*a*) **Objection that Patentee was not the True and First Inventor.**—This objection does not raise the issue of novelty or invention (*Thomson* v. *Macdonald* (1890) 8 R. P. C. at p. 9; *Pneumatic Tyre Co.* v. *Casswell* (1896) 13 R. P. C. at p. 187), but only whether the patentee or someone else invented the patented article (*Thomson* v. *Macdonald, supra*); and the objection should never be taken unless the defendant intends to rely upon it at the trial (*Morgan* v. *Windover* (1890) 7 R. P. C. at p. 449; *Thomson* v. *Macdonald, supra*). When the objection is raised, the defendant need not state who the first inventor was (*Russell* v. *Ledsam* (1843) 11 M. & W. 647; but see *Morgan* v. *Windover* (1890) 7 R. P. C. at p. 449).

(*b*) **Objection that Invention was not New.**—If one of the grounds of objection to the patent is want of novelty, the time and place of the alleged previous publication or user must be specified (s. 29 (3) of the Act of 1883). An invention may be lacking in novelty by reason of (1) prior publication (see p. 8, *supra*); (2) prior user (see p. 14, *supra*); or (3) the state of common knowledge at the date of the patent.

(1) Prior Publication.—The particular specifications, books, or documents relied upon must be specified; the defendant should state what the alleged anticipation is, and where it is to be found (*Holliday* v. *Heppenstall* (1889) 6 R. P. C. at p. 327).

In the case of a book, the defendant must not refer generally to the book, but must specify what part he relies upon (*Harris* v. *Rothwell* (1886) 3 R. P. C. at p. 246; *cf. Holliday* v. *Heppenstall, supra*).

In the case of specifications, if these are simple, or the whole of the specifications are *bonâ fide* relied upon, the defendant need not specify what parts he relies upon (*Siemens* v. *Karo* (1891) 8 R. P. C. 376; *Edison-Bell* v. *Columbia Co.* (1900) 18 R. P. C. 4; *Sidebottom* v. *Fielden* (1891) 8 R. P. C. at pp. 270, 272; *Holliday* v. *Heppenstall, supra*; *Nettlefolds* v. *Reynolds* (1891) 8 R. P. C. 410, 417). But if the specifications are very numerous (see *Sidebottom* v. *Fielden, supra*, at p. 272; *cf. Nettlefolds* v. *Reynolds, supra*), or are intricate (*Heathfield* v. *Greenway* (1894) 11 R. P. C. at p. 19; and see *Fowler* v. *Gaul* (1886) 3 R. P. C. at p. 250; *Harris* v. *Rothwell* (1886) 3 R. P. C. 243), or the whole are not *bonâ fide* relied upon (*Heathfield* v. *Greenway, supra*; *Nettlefolds* v. *Reynolds* (1891) 8 R. P. C. at pp. 417, 418; *Harris* v. *Rothwell, supra*), the defendant *may* be ordered to state, by reference to pages and lines, the parts of the specifications he relies upon.

Where the plaintiff's specification is a complicated one, and contains several claims, the defendant should state by reference to the claims which part of the plaintiff's invention is anticipated by the respective specifications referred to in the particulars as anticipations (*Boyd* v. *Farrar* (1888) 5 R. P. C. 33; *Harris* v. *Rothwell* (1886) 3 R. P. C. 243; and see *Fowler* v. *Gaul* (1886) 3 R. P. C. 247).

(2) Prior User.—The particulars must state the time and place of the alleged prior user (s. 29 (3); *Smith* v. *Lang* (1890) 7 R. P. C. 148), and the names and addresses of the users (*Birch* v. *Mather* (1883) 22 C. D. 629; *Alliance Syndicate* v. *MacIvor's Patents* (1891) 8 R. P. C. 321). If the names and addresses of the alleged users are not given, the plaintiff may apply for better particulars; or he may interrogate the defendant as to names and addresses, and the defendant will be bound to answer the interrogatory (*Alliance Syndicate* v. *MacIvor's Patents, supra*: *General Electric Co.* v. *Safety Co.* (1903) 21 R. P. C. 109). If the defendant, before obtaining discovery, does not know, but believes the plaintiff's books show the time and place of the prior user, he may say that the time at which and the place in which the prior user took place are to be found in the plaintiff's books (see *Woolfe* v. *Automatic Picture Gallery* (1902) 19 R. P. C. at pp. 162, 163); but he should amend when he has obtained discovery.

A statement that the invention was published by manufacture by W. "from 1832 to 1862" is not a sufficient statement as to the time of the user (*Smith* v. *Lang* (1890) 7 R. P. C. 149).

The particular article relied upon as an anticipation should be so described as to enable the defendant to identify it (see *Scott* v. *Hull Steam Co.* (1896) 13 R. P. C. 206). It is not enough to say that an article made according to the supposed invention was used "at the works of H." in a certain year; for that might mean any article used at H.'s works in that year (*Boyd* v. *Farrar* (1888) 5 R. P. C. at p. 35).

But the defendant need not state what part of the invention the article relied upon anticipates; once the article is pointed out the patentee must understand his own specification well enough to be able to judge how far it is or is not an anticipation (*Boyd* v. *Farrar, supra*).

(3) State of Common Knowledge.—If the defendant intends to rely upon general public knowledge as distinguished from

anticipation, he should raise that objection distinctly (*Phillips* v. *Ivel Cycle Co.* (1890) 7 R. P. C. 77).

When this ground is relied upon, it is neither necessary nor proper to give particulars of the documents or publications by which the general knowledge is intended to be proved. All the defendant need do is to say that the state of knowledge was such that there is no novelty in the patent; having said that he need not go on, in support of that, to give the evidence he intends to adduce to prove it (*per* Lindley, L.J., in *Holliday* v. *Heppenstall* (1889) 6 R. P. C. at p. 326; and see *English Machinery Co.* v. *Union Boot Co.* (1894) 11 R. P. C. at p. 374; *Siemens* v. *Karo* (1891) 8 R. P. C. at p. 377). But of course, if the defendant relies on publications as *anticipations*, he must state what those publications are; and he must indicate that he relies upon them as anticipations, and not as showing the state of general public knowledge (see *per* Cotton, L.J., in *Holliday* v. *Heppenstall*, *supra*; *per* Wills, J., in *Solio Laundry* v. *Mackie* (1893) 10 R. P. C. at p. 70; see p. 179, *supra*).

Where, however, the defendant intends to refer to a single specification as evidence of common knowledge, it should be mentioned in the particulars (see *per* Lindley, L.J., in *English Machinery Co.* v. *Union Boot Co.* (1894) 11 R. P. C. at p. 374).

In *Solio Laundry* v. *Mackie* ((1893) 10 R. P. C. at p. 70), Wills, J., said that specifications do not show common knowledge, and he rejected them as evidence thereof. But in *Sutcliffe* v. *Abbott* ((1903) 20 R. P. C. at p. 55), Buckley, J., permitted specifications to be referred to as evidence of common knowledge (and see *Castner-Kellner Co.* v. *Commercial Corpn.* (1899) 16 R. P. C. at p. 276; *English Machinery Co.* v. *Union Boot Co.*, *supra*; *Holliday* v. *Heppenstall*, *supra*).

(*c*) **Objection that the Thing Patented Involved no Invention or Ingenuity.**—No further particulars are necessary (see *Morris* v. *Young* (1895) 12 R. P. C. at p. 460); and it may be that the objection of want of novelty is sufficient to cover the objection of want of invention (see *Electrolytic Co.* v. *Holland* (1901) 18 R. P. C. 521).

(*d*) **Objection that Invention is not Useful.**—Further particulars are unnecessary (see *Morris* v. *Young*, *supra*).

(*e*) **Objection of Disconformity.**—Particulars must be given as to how and in what respect the invention described in the complete specification differs from the invention described in

the provisional specification (*Anglo-American Brush Co.* v. *Crompton* (1886) 4 R. P. C. at p. 28; *Heathfield* v. *Greenway* (1894) 11 R. P. C. 17).

(*f*) **Objection that Specification is Insufficient.**—How the specification is insufficient must be detailed. For instance, it is not enough to say: "The specification does not sufficiently describe and ascertain the nature of the invention and the manner in which the same is to be formed"; the plaintiff is entitled to know in what respect the specification fails to sufficiently describe the nature of the invention or the mode of performing it (*Heathfield* v. *Greenway* (1894) 11 R. P. C. at p. 20; *Crompton* v. *Anglo-American Brush Corpn.* (1887) 4 R. P. C. 197). Nor is it sufficient to say merely: "The specification is ambiguous and framed in a manner calculated to mislead"; the defendant must show in what respect it is ambiguous or misleading (*Heathfield* v. *Greenway*, *supra*).

In *Crompton* v. *Anglo-American Brush Corpn.* (*supra*) the defendant stated that the specification was insufficient, "inasmuch as it does not contain a sufficient direction to enable a workman skilled in the manufacture of electrical machinery to make" the invention; Held, that the defendant must, if possible, give further particulars.

Although the defendant must particularly state how the specification is defective, he need not point how it is to be put right (*Crompton* v. *Anglo-American Brush Corpn.*, *supra*, at p. 200).

(*g*) **Objection of Prior Grant.**—The plea of prior grant has only recently been raised in patent cases. The issue raised by it is want of validity, but not of novelty. Hence, the particulars need not be as full as where the patent is attacked on the ground of prior publication (see *Birmingham Tyre Co.* v. *Reliance Co.* (1900) 17 R. P. C. 278).

Application for Further and Better Particulars of Objections.—If the plaintiff is not satified with the particulars delivered by the defendant he may apply for further and better particulars; or he may acquire the further information he desires by means of interrogatories (see *Alliance Syndicate* v. *MacIvor's Patents* (1891) 8 R. P. C. 321; *General Electric Co.* v. *Safety Co.* (1904) 21 R. P. C. 109).

The plaintiff should always obtain better particulars where the particulars delivered are vague; for he cannot, at the trial,

resist the admission of evidence which is within the literal meaning of the particulars, on the ground that the statement is too general (*Hull* v. *Bollard* (1856) 1 H. & N. 134; *Sugg* v. *Silber* (1877) 2 Q. B. D. 493). But s. 29 (4) (see p. 178, *supra*) has probably made a difference in this respect.

Amendment of Particulars.

Particulars of breaches and of objections may be from time to time amended by leave of the Court or a Judge (s. 29 (5) of the Patents Act, 1883). Application for leave to amend may be made by summons at chambers or by motion; if made pending an appeal it should be made by motion in the Court of Appeal.

The application may be made at any time; leave has been granted to amend particulars of objections on the eve of the trial (*Otto* v. *Sterne* (1885) 2 R. P. C. 139; *Parker* v. *Maignen's Co.* (1888) 5 R. P. C. 207), and even at the trial itself (*Blakey* v. *Latham* (1889) 6 R. P. C. at p. 36; *Allen* v. *Horton* (1893) 10 R. P. C. at p. 413; *Westley* v. *Perkes* (1893) 10 R. P. C. at p. 186; *Badische* v. *La Société Chimique* (1897) 14 R. P. C. at p. 881). And leave to amend may be given by the Court of Appeal after the hearing and pending an appeal; but the Court of Appeal will exercise its jurisdiction, with regard to particulars of objections, with considerable caution, and leave will not be granted unless some very special case is made out (*Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at p. 534).

Leave to amend at the trial will not generally be granted unless it is shown that the new matter has only been recently discovered and could not, with reasonable diligence, have been discovered before (see *per* North, J., in *Moss* v. *Malings* (1886) 3 R. P. C. at p. 375; *Shrewsbury* v. *Morgan* (1896) 13 R. P. C. at p. 76); but where the matter has only recently been discovered, leave will usually be granted (*Pirrie* v. *York Street Co.* (1894) 11 R. P. C. at p. 431; *Parker* v. *Maignen's Co.* (1888) 5 R. P. C. 207).

Terms on Allowing Amendment.—As a general rule leave to amend is granted only on terms.

The party applying for leave will usually be required to pay the costs of and consequent on the amendment (*Otto* v. *Sterne* (1885) 2 R. P. C. 139; *Parker* v. *Maignen's Co.* (1888) 5 R. P. C. at p. 208; *Ehrlich* v. *Ihlee* (1887) 4 R. P. C. 115). But there is no settled rule as to this; and the writer is aware of cases recently decided in chambers where the costs have been made costs in the action.

An amendment of particulars of objections will generally only be allowed upon the terms that the plaintiff shall be at liberty within a certain period to elect to discontinue the action, and that if he so elects all costs incurred after delivery of the original particulars shall be paid by the defendant (*Edison* v. *India-Rubber Co.* (1881) 17 C. D. 137, following the order made in *Baird* v. *Moule's Co.* (1876) 17 C. D. 139, *n.*; *Ehrlich* v. *Ihlee* (1887) 4 R. P. C. 115; *Solco Laundry* v. *Mackie* (1893) 10 R. P. C. 68; and see *Badische* v. *La Société Chimique* (1897) 14 R. P. C. at p. 881). But the Judge has an absolute discretion in the matter which cannot be fettered by any rule of practice; and leave to amend may be given unconditionally (*Woolley* v. *Broad* (1892) 9 R. P. C. 429; *Pascall* v. *Toope* (1890) 7 R. P. C. 125; and see *Wilson* v. *Wilson* (1899) 16 R. P. C. 315; *Allen* v. *Horton* (1893) 10 R. P. C. at pp. 413, 416).

Interlocutory Injunction.

The plaintiff commonly applies to the Court for an injunction to restrain the defendant committing further acts of infringement until the trial or further order.

Application for an interlocutory injunction is made, in the Chancery Division, by motion in Court. An appeal against the refusal to grant an interlocutory injunction lies direct to the Court of Appeal (*McHarg* v. *Universal Stock Exchange* [1895] 2 Q. B. 81).

An *ex parte* injunction will only be granted in special circumstances and on special terms (see *Moser* v. *Jones* (1893) 10 R. P. C. 368), and the application must be made at the earliest possible period (*Greer* v. *Bristol Tanning Co.* (1885) 2 R. P. C. 268). It is incumbent on the party making an application for an injunction, *ex parte*, to swear as to his belief that he, or the patentee, is the original inventor (see *per* Lord Eldon, L.C., in *Hill* v. *Thompson* (1817) 1 W. P. C. at p. 231), and that the patent is valid (*Gardner* v. *Broadbent* (1856) 4 W. R. 767); and he must exercise perfect good faith, and put the Court in possession of all material facts (see notes to Order 50, rule 6, in the Annual Practice).

Leave to serve notice of motion for an injunction with the writ is granted almost as a matter of course; but where leave to serve short notice is required special reasons must be stated.

When Interlocutory Injunction will be Granted.—When a *primâ facie* case of infringement is made out, and there is a

presumption in favour of the validity of the patent, an interim injunction will be granted; but however clear the infringement may appear, an injunction will not be granted unless the plaintiff's patent must be assumed to be valid (*Jackson* v. *Needle* (1884) 1 R. P. C. at pp. 176, 177), or the defendant is estopped from denying its validity (see p. 187, *infra*) or does not in fact do so.

A presumption in favour of the validity of the patent arises (1) where the validity of the patent has been supported in previous litigation, or (2) where the patentee has been in long and undisturbed enjoyment of it (see *per* Jessel, M.R., in *Dudgeon* v. *Thomson* (1874) 30 L. T. (N. S.) at p. 244).

(1) Where Validity of Patent has already been Supported.—If the plaintiff's patent has been upheld in previous litigation, the plaintiff is entitled to an interlocutory injunction once a *primâ facie* case of infringement is made out (see *per* Lord Romilly, M.R., in *Borill* v. *Goodier* (1866) 35 L. J. (N. S.) Ch. at p. 435; *Edison-Bell* v. *Bernstein* (1897) 14 R. P. C. at p. 158; *Brooks* v. *Lycett's Saddle Co.* (1903) 20 R. P. C. at p. 577; *cf. Welsbach Co.* v. *General Co.* (1901) 18 R. P. C. 533). And the fact that an appeal against the decision in favour of the validity of the patent is pending (*Moser* v. *Sewell* (1893) 10 R. P. C. 365; but in this case the *bona fides* of the defendant in the second action was questionable), or that a fresh fact is brought forward by the defendant tending to impeach the novelty of the invention (*Heine Solly* v. *Norden* (1904), not yet reported; *Newall* v. *Wilson* (1852) 2 De G. M. & G. 282; *Pneumatic Tyre Co.* v. *Marwood* (1896) 13 R. P. C. 347), or that in the former action the services of an eminent expert could not be obtained (*Pneumatic Tyre Co.* v. *Marwood*, *supra*), makes no difference.

Where the defendant in the second action was really the defendant, or indemnified the defendant, in the former action, the reason for granting an injunction is all the stronger (*Farbenfabriken* v. *Dawson* (1891) 8 R. P. C. 397; *Moser* v. *Sewell* (1893) 10 R. P. C. at pp. 367, 368).

A certificate that the validity of the patent came in question is not of the same force and effect where judgment is given for the plaintiff in default of appearance (see *per* Chitty, J., in *Edison-Bell* v. *Bernstein* (1897) 14 R. P. C. at p. 158, *cf. Welsbach Co.* v. *Vulcan Co.* (1901) 18 R. P. C. 279); but where two actions have been brought and in each the defendant has not appeared, the presumption is in favour of the validity of the patent (*Edison-Bell* v. *Bernstein*, *supra*).

The fact that the patent has been upheld by the Scotch Courts is sufficient *primâ facie* evidence of the validity of the patent (*Dudgeon* v. *Thomson* (1874) 30 L. T. (N. S.) 244; *United Telephone Co.* v. *St. George* (1886) 3 R. P. C. at p. 37); and the award of an arbitrator in favour of the plaintiff's patent has been held sufficient proof (*Lister* v. *Eastwood* (1855) 26 L. T. 4).

(2) WHERE PATENTEE HAS BEEN IN LONG AND UNINTERRUPTED ENJOYMENT OF THE PATENT.—In the case of a new patent, the validity of which has not been established in prior litigation, an injunction will not be granted (*Spencer* v. *Holt* (1903) 20 R. P. C. at p. 144; *Wapshire Tube Co.* v. *Hyde Co.* (1901) 18 R. P. C. at p. 379), unless the validity is not in dispute, or the defendant is estopped from denying the validity, or the Court is not satisfied that the defendant honestly intends to try the question of validity (*Holophane* v. *Berend* (1897) 15 R. P. C. at p. 19). But where there has been long enjoyment under a patent (the enjoyment, of course, including use), the public have had ample opportunity of contesting its validity; and the fact of their not having done so affords, at least *primâ facie*, evidence that the title of the patentee is good (*Caldwell* v. *Vanlissengen* (1851) 9 Hare at p. 424; *Hill* v. *Thompson* (1817) 1 W. P. C. at p. 231; *Stevens* v. *Keating* (1847) 2 W. P. C. at pp. 177, 178; *Muntz* v. *Foster* (1843) 2 W. P. C. at p. 95; *Holophane* v. *Berend* (1897) 15 R. P. C. at p. 19). In this case an interlocutory injunction will be granted, on a *primâ facie* case of infringement being made out, unless the invention has only been put into practice at a recent date (*Plimpton* v. *Malcolmson* (1875) 20 Eq. 37; *Caldwell* v. *Vanlissengen*, *supra*), or the patentee's enjoyment has been disturbed or non-exclusive and he has done nothing to vindicate his rights (*Rothwell* v. *King* (1886) 3 R. P. C. at p. 380).

Where the patent is for an improvement upon the subject of a prior patent, the undisturbed possession does not commence until after the expiration of the prior patent (*Hough* v. *Magill*, W. N. (1877) 62).

Six years' undisturbed and active enjoyment is considered sufficient to justify the Court in assuming the validity of the patent (*Rothwell* v. *King* (1886) 3 R. P. C. 379; *Bickford* v. *Skewes* (1837) 1 W. P. C. at p. 213); and, under special circumstances, three years (*Wheatstone* v. *Wilde* (1861) Griff. P. C. 247), or even eighteen months' (*Coles* v. *Baylis* (1886) 3 R. P. C. 178) possession may be enough. But, in the absence of special circumstances,

e.g., where the defendant by his conduct practically admits that the invention is new (*Coles* v. *Baylis* (1886) 3 R. P. C. at p. 182), possession of a patent for only three years is probably not sufficient (*Lister* v. *Norton* (1884) 1 R. P. C. at p. 115; and see *British Tanning Co.* v. *Groth* (1890) 7 R. P. C. 1). In *Jackson* v. *Needle* ((1884) 1 R. P. C. 174) the Court of Appeal dissolved an injunction granted in respect of a patent only eight months old. In *Holophane* v. *Berend* ((1897) 15 R. P. C. 18), Kekewich, J., refused to grant an injunction, although the patent was five years old.

The question of validity will not be considered on the motion (see *Holophane* v. *Berend*, *supra*; *Shillito* v. *Larmuth* (1885) 2 R. P. C. 1), unless the patent on the face of it is so irretrievably and hopelessly bad that it is absolutely impossible that it could be supported (*Briggs* v. *Lardeur* (1884) 1 R. P. C. at p. 128; *Shillito* v. *Larmuth*, *supra*, at p. 2).

Where the patent is of recent date, and the Court, by reason thereof, refuses to grant an injunction, the defendant is usually required to give an undertaking to keep an account until the hearing (*Jackson* v. *Needle* (1884) 1 R. P. C. 174; *Holophane* v. *Berend* (1897) 15 R. P. C. 18; *Actien Gesellschaft* v. *Temler* (1899) 16 R. P. C. 447; *Pneumatic Tyre Co.* v. *Frisvell* (1895) 13 R. P. C. 15).

Even though the patent be a new one, an injunction will be granted if the defendant does not appear, upon the plaintiff producing an affidavit that he believes the patent to be valid and knows of nothing that anticipates it (*Clarke* v. *Nichols* (1895) 12 R. P. C. 310).

In *British Tanning Co.* v. *Groth* ((1889) 7 R. P. C. 1), where the patent was of recent date, no injunction was granted, although the defendant refused to give an undertaking to keep an account; but in this case the evidence as to infringement was not strong, and it appeared that the patentees of the plaintiff's process had entered into an agreement with the defendant which went towards negativing the right to an injunction.

(3) Where the Defendant does not Dispute or is Estopped from Disputing the Validity of the Patent.—In either of these cases an injunction will be granted if a *prima facie* case of infringement is made out; the age of the patent is immaterial.

The defendant's conduct may have been such as to estop him, on motion for an interlocutory injunction, from disputing the validity of the plaintiff's patent (see *per* Jessel, M. R., in *Daigeon* v. *Thomson* (1877) 30 L. T. (N. S.) 244; *Clarke* v. *Ferguson*

(1859) 1 Giff. 184; *Neilson* v. *Fothergill* (1841) 1 W. P. C. 287); or the defendant may by his conduct practically admit that the invention is new (*Coles* v *Baylis* (1886) 3 R. P. C. at p. 182).

A licensee, during the term of the licence, is estopped from disputing the validity of the patent (see p. 99, *supra*); and the assignor of a patent is also estopped from raising the question of validity as against the assignee (see p. 91, *supra*).

Where the patent has been worked by the plaintiff and defendant as partners, under circumstances affording a presumption that the defendant did not, during the existence of the partnership, dispute the validity of the patent, the Court will, upon an interlocutory application for an injunction, assume that the patent is valid (see *per* Knight Bruce, V.-C., in *Muntz* v. *Grenfell* (1842) 2 Coop. 61, *n.*; *cf. Axmann* v. *Lund* (1874) 18 Eq. 330).

When Interlocutory Injunction will be Refused.—An injunction will not be granted—(1) where a *primâ facie* case of infringement is not made out; or (2) where the patent sued upon is of recent date and its validity has not been supported in previous litigation (see p. 185, *supra*), unless the validity of the patent is not in issue; or (3) where the plaintiff is guilty of laches; or (4) if the plaintiff has acquiesced in the acts complained of; or (5) if the balance of convenience is against granting an injunction; or (6) if there is no probability of the infringement being continued.

The Case of Infringement.—If a *primâ facie* case of infringement is not made out an application for an injunction will be refused (see *Lister* v. *Norton* (1884) 1 R. P. C. at p. 116; *Morgan* v. *Seward* (1835) 1 W. P. C. at p. 168; *Muntz* v. *Virian* (1840) 2 W. P. C. at p. 88; *British Tanning Co.* v. *Groth* (1890) 7 R. P. C. 1). But an injunction is obtainable without proving actual infringement where there is a deliberate intention to infringe and the plaintiff shows that what is threatened to be done would, if carried out, amount to infringement (see *per* Jessel, M.R., in *Pearson* v. *Loe* (1878) 9 C. D. at p. 65; *Dowling* v. *Billington* (1890) 7 R. P. C. at p. 201; *Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at p. 357).

Laches.—The plaintiff must make his application for an interlocutory injunction at an early period; laches is a bar to interlocutory relief (*Bridson* v. *Benecke* (1849) 12 Beav. 1; *Borill* v. *Crate* (1865) 1 Eq. 388; *North British Co.* v. *Gormully* (1894) 12 R. P. C. at p. 21; *Leonhardt* v. *Kallé* (1894) 11 R. P. C. 534). A delay, after *knowledge* of the infringement (*Crossley* v. *Derby Gas Co.* (1829) 1 W. P. C. at p. 120; *Osmond* v. *Hirst* (1885) 2 R. P. C. at p. 267), of ten months (*Leonhardt* v. *Kallé* (1894) 11

R. P. C. 534), nine months (*Actien Gesellschaft* v. *Temler* (1899) 16 R. P. C. at 447), six months (*Edison-Bell* v. *Hough* (1894) 11 R. P. C. 594), or even three months (*Dunlop Co.* v. *Stone* (1897) 14 R. P. C. at p. 264), may disentitle the plaintiff to an interlocutory injunction.

Where, however, the delay is satisfactorily explained, it is no bar to the relief claimed (*United Telephone Co.* v. *Equitable Telephone Assocn.* (1888) 5 R. P. C. 233). The plaintiff may wait until a limited company has come into a state in which it is worth his while to institute proceedings against it (*United Telephone Co.* v. *Equitable Telephone Assocn.*, *supra*, at p. 237). And some time may be spent in making inquiries (*Losh* v. *Hague* (1837) 1 W. P. C. at p. 201), or obtaining the necessary evidence (*United Telephone Co.* v. *Equitable Telephone Assocn.*, *supra*), as to the alleged infringement.

The fact that the plaintiff has been guilty of laches against some person who is not a defendant is not a ground for refusing to grant an interlocutory injunction (*Pneumatic Tyre Co.* v. *Warrilow*, (1896) 13 R. P. C. at pp. 287, 288).

Acquiescence.—Acquiescence in the defendant's acts is also a bar to interlocutory relief. For instance, where the plaintiff was aware that the defendants were at considerable expense in erecting machinery for the purpose of using the invention, and he never interfered to stop them, but permitted them to go on under the expectation that they would pay him a royalty, an interlocutory injunction was refused (*Neilson* v. *Thompson* (1841) 1 W. P. C. at pp. 285, 286). But a patentee does not acquiesce in the infringement of his patent by omitting to take proceedings to revoke a subsequent patent extending to his invention, unless the subsequent patent is put in practice (*Newall* v. *Wilson* (1852) 2 De G. M. & G. 282; and see *per* Bacon, V.-C., in *Osmond* v. *Hirst* (1885) 2 R. P. C. at p. 267). And there is no acquiescence in asking the defendant to use the plaintiff's machine in preference to the infringing machine; for it is not the duty of a patentee to warn persons that what they are doing is an infringement (*Proctor* v. *Bennis* (1887) 36 C. D. 740).

Balance of Convenience.—In determining whether to grant or refuse an interlocutory injunction, the convenience or inconvenience to the parties will be considered (see *Thomson* v. *Hughes* (1890) 7 R. P. C. 71; *Bracher* v. *Bracher* (1890) 7 R. P. C. 420; *Moser* v. *Sewell* (1893) 10 R. P. C. at p. 367).

An injunction will not be granted if it would cause serious

injury to the defendant, and no direct benefit to the plaintiff (*Neilson* v. *Thompson* (1841) 1 W. P. C. at p. 286; *Morgan* v. *Seaward* (1835) 1 W. P. C. at p. 168; *Thomson* v. *Hughes* (1890) 7 R. P. C. at p. 76; *Moser* v. *Sewell* (1893) 10 R. P. C. at p. 367; *cf. Muntz* v. *Foster* (1843) 2 W. P. C. 93). But the Court will require the defendant to give an undertaking to keep an account (*Thomson* v. *Hughes, supra; Neilson* v. *Thompson* (1841), *supra*; *Jones* v. *Pearce* (1831) 1 W. P. C. 121). It is no answer, however, to a motion for an interlocutory injunction that the defendant has volunteered to keep an account (*Read* v. *Andrew* (1885) 2 R. P. C. at p. 122).

"If the trade of a defendant be an old and an established trade, the hardship upon him would be too great if an injunction were granted. But when the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people," it is "less inconvenient, and less likely to produce irreparable damage, to stop him from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers" (*per* Brett, L.J., in *Plimpton* v. *Spiller* (1876) 4 C. D. at p. 292).

Where the defendants are a new company, and the patent has been supported in previous litigation, or has been actively enjoyed for a considerable period, the Court will grant an injunction (*Bracher* v. *Bracher* (1890) 7 R. P. C. at p. 422, 423; *Brooks* v. *Lycett's Saddle Co.* (1903) 20 R. P. C. at p. 577).

In some cases an injunction will be refused upon the defendant paying a sum of money into Court as security (*Edison-Bell* v. *Hough* (1894) 11 R. P. C. 594; *North British Co.* v. *Gormully* (1895) 12 R. P. C. 17); and an injunction may be granted only on the plaintiff's undertaking to supply the defendant with articles in the place of any the injunction prevents him from using (*United Telephone Co.* v. *Tasker* (1888) 5 R. P. C. 628).

NO INJUNCTION WHERE NO PROBABILITY OF INFRINGEMENT BEING CONTINUED.—Whenever a person has committed an act of infringement, *primâ facie* that is ground for granting an injunction, because when a man has done a wrongful act the probability (unless there is anything which prevents that probability from arising) is that he will continue it (*per* Cotton, L.J., in *Proctor* v. *Bailey* (1889) 6 R. P. C. at p. 542). But the Court will not grant an injunction where there is no probability of the act being continued (*Proctor* v. *Bailey, supra*). In this case the infringement had been discontinued for five years, and there had been

no threat of any repetition of the infringement, and there was no evidence of any intention to repeat it.

Undertaking as to Damages.—The plaintiff is usually required to give an undertaking to abide by such order as the Court may make as to damages should it turn out that an injunction should not have been granted; and this undertaking is required on granting injunctions on notice (*Heine Solly & Co.* v. *Norden* (1904), not yet reported; *Fenner* v. *Wilson* (1893) 10 R. P. C. at p. 287) as well as on *ex parte* applications (*Moser* v. *Jones* (1893) 10 R. P. C. at p. 369).

Evidence on the Motion.—A *primâ facie* case, at all events, of actual infringement must be made out (*Briggs* v. *Lardeur* (1884) 1 R. P. C. at p. 128; *Lister* v. *Norton* (1884) 1 R. P. C. at p. 116); or the plaintiff must show a deliberate intention to infringe, and that what is threatened would amount to infringement (*Frearson* v. *Loe* (1878) 9 C. D. at p. 65; *Dowling* v. *Billington* (1890) 7 R. P. C. at p. 201; *Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at p. 357).

If an infringing article has been purchased from the defendant, it should, where possible, be made an exhibit to the plaintiff's affidavit.

If the patent has been upheld in a previous suit, that fact should be set out, and a copy of the order made should be exhibited. If the patent has not been previously supported, the plaintiff should state, whether the application be made *ex parte* (*Hill* v. *Thompson* (1817) 1 W. P. C. at p. 231) or on notice (*Sturtz* v. *De La Rue* (1828) 5 Russ. at p. 329), that he, or the patentee, is the true and first inventor, and that he believes the patent to be valid (*Gardner* v. *Broadbent* (1856) 4 W. R. 767; *Sturtz* v. *De La Rue, supra*; *Clarke* v. *Nichols* (1895) 12 R. P. C. 310).

Where the plaintiff is not the patentee, how his title is derived should be clearly shown.

The plaintiff should distinctly swear that the article complained of was made neither by him nor his agents (*Betts* v. *Wilmot*, 6 Ch. at p. 243; and see *Dunlop Co.* v. *Hubbard Patents* (1902) 19 R. P. C. at pp. 548, 549).

Where an affidavit is made upon "information and belief," the deponent should state what are the sources of his information and belief (*Saccharin Corpn.* v. *Chemical Co.* (1898) 15 R. P. C. 53; *Read* v. *Andrew* (1885) 2 R. P. C. at p. 122; *cf.*

Badische v. *Thompson* (1902) 19 R. P. C. 502). "I believe," without any grounds, is only "I suspect" (*per* Kay, J., in *Germ Milling Co.* v. *Robinson* (1884) 1 R. P. C. at p. 219).

Costs.—The costs are usually made costs in the action (see *per* Chitty, J., in *Lister* v. *Norton* (1884) 1 R. P. C. at p. 116; *Brooks* v. *Lycett's Saddle Co.*, 20 R. P. C. at p. 577). In some cases, *e.g.*, where the defendant is a small and innocent retailer, an injunction will be granted, but no order made as to costs (*American Tobacco Co.* v. *Guest* (1892) 9 R. P. C. 218; and see p. 213, *infra*). If there is an independent case against the motion, *e.g.*, delay on the plaintiff's part, it is better to order the motion to stand till the trial (see *per* Chitty, J., in *Lister* v. *Norton* (1884) 1 R. P. C. at p. 116).

Order for Inspection.

In an action for infringement, the Court or a Judge may on the application of either party make such order for inspection, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a Judge may see fit (s. 30 of the Patents Act, 1883); and the Court may order samples to be taken (*Germ Milling Co.* v. *Robinson* (1885) 3 R. P. C. 11; *Russell* v. *Conley* (1833) 1 W. P. C. at p. 459), observations to be made, or experiments to be tried (R. S. C. Ord. 50, r. 3).

The application for an order for inspection may be made by motion or by summons in chambers; in a special case the order may be granted on an *ex parte* application (*Hennessy* v. *Bohmann*, W. N. (1877) 14). The application may be made at any time; even before the statement of claim is delivered (*Drake* v. *Muntz's Co.* (1886) 3 R. P. C. 43). And the Court may of its own accord, at the trial, order inspection and experiments to be made by an expert (see *North British Co.* v. *Macintosh* (1894) 11 R. P. C. at p. 487). Application may be made either by the plaintiffs (*Drake* v. *Muntz's Co.*, *supra*) or the defendants (*Germ Milling Co.* v. *Robinson* (1885) 3 R. P. C. 11); and the Court may require inspection to be given by both parties (*Germ Milling Co.* v. *Robinson*, *supra*; and see *Rylands* v. *Ashley's Patent Co.* (1890) 7 R. P. C. 175).

The application must be supported by affidavit setting forth a *primâ facie* case of infringement (*Cheetham* v. *Oldham* (1888) 5 R. P. C. 617), the grounds upon which an order is necessary (*Piggott* v. *Anglo-American Co.* (1868) 19 L. T. (N. S.) 46), and

the nature of the invention (see *Meadows* v. *Kirkman* (1860) 29 L. J. (N. S.) Ex. 205).

No order will be made unless the party seeking it satisfies the Court that there is really a case to be tried, and that inspection is material (*Piggott* v. *Anglo-American Co.*, *supra*); and the Court is always reluctant to grant inspection where it may be injurious to one side, and where the right depends on a question which has yet to be determined (*McDougall* v. *Partington* (1890) 7 R. P. C. at p. 473).

Inspection will not be ordered where the articles are not the property or under the control of the other party (see *Garrard* v. *Edge* (1889) 6 R. P. C. 372; *Sidebottom* v. *Fielden* (1891) 8 R. P. C. 266; but see *Rylands* v. *Ashley's Patent Co.* (1890) 7 R. P. C. 175). And no order can be made as against the licensee of either party (*Germ Milling Co.* v. *Robinson* (1885) 3 R. P. C. at p. 14), or for inspection of articles in a foreign manufactory (*Neilson* v. *Betts*, L. R. 5 H. L. at pp. 11, 12).

The fact that it is alleged that inspection would expose a trade secret is no ground for refusing an order (*Bovill* v. *Moore* (1815) 2 Coop. 56, *n.*; and see *Ashworth* v. *Roberts*, 7 R. P. C. at p. 455). But the Court will sometimes appoint an independent expert to make the inspection and order that he shall not disclose anything arrived at by him without leave of the Court (*Plating Co.* v. *Farquharson* (1879) Griff. P. C. 187; and see *Flower* v. *Lloyd*, W. N. (1876) at pp. 169, 230), and that the evidence be taken *in camera* (*Badische* v. *Levinstein* (1885) 2 R. P. C. at p. 81).

In *Swain* v. *Edlin-Sinclair* ((1903) 20 R. P. C. 435), the Court made an order for inspection by two experts and refused to allow inspection by the patentees.

Sometimes the Court will order that one party shall allow the other to see their process or machine at work (*Rylands* v. *Ashley's Patent Co.* (1890) 7 R. P. C. at p. 181; *Russell* v. *Cowley* (1833) 1 W. P. C. at p. 458). But such an order will only be made in a special case (see *Sidebottom* v. *Fielden* (1891) 8 R. P. C. at p. 269).

The order will be limited to such of the defendant's processes as to which a *primâ facie* case of infringement is made out (*Cheetham* v. *Oldham* (1888) 5 R. P. C. 617).

Where the defendant has a large stock of alleged infringing machines, inspection of *all* his machines will not be ordered; but he may be directed to verify on affidavit the several kinds of machines that he has sold and to produce one machine of each

class for inspection (*Singer Co.* v. *Wilson* (1865) 13 W. R. 560; but see *Drake* v. *Muntz's Co.* (1886) 3 R. P. C. at p. 44, where Bacon, V.-C., said he had no power to order a defendant to make an affidavit).

Laches sufficient to defeat the plaintiff's right to an interlocutory injunction is no bar to an order on the same motion for inspection (*Patent Type Co.* v. *Walter* (1860) Johnson, 727).

Discovery.

Interrogatories.—The Court has jurisdiction to order interrogatories to be answered notwithstanding the provisions of the Patents Act, 1883, as to the delivery of particulars; and if the interrogatories are properly worded, they may refer to the very matters which ought to have been covered by the particulars (*Birch* v. *Mather* (1882) 22 C. D. 629; *Alliance Syndicate* v. *MacIvor's Patents* (1891) 8 R. P. C. 321; *General Electric Co.* v. *Safety Co.* (1904) 21 R. P. C. at p. 109). As to the rules and practice governing interrogatories generally, the reader is referred to the Rules of the Supreme Court, Ord. 31, and the notes thereon contained in the Annual Practice.

The defendant may ask any question fairly tending to show that the patent is bad (*Hoffmann* v. *Postill* (1869) 4 Ch. 673).

Where the defendants alleged that the plaintiffs' invention had been anticipated by the manufacture and sale "by white lead manufacturers generally in London and the vicinity thereof continuously from the year 1836 up to the date of" the patent of white lead made according to the alleged invention, the defendants were ordered to answer an interrogatory as to the names of the white lead manufacturers, and the places and dates of manufacture (*Alliance Syndicate* v. *MacIvor's Patents* (1891) 8 R. P. C. 321).

If infringement is admitted, and the only issue is as to the validity of the patent, interrogatories as to the names of the defendant's customers need not be answered before the trial (*Lister* v. *Norton* (1885) 2 R. P. C. 68).

Interrogatories are not admissible if their relevancy depends upon the construction of the specification (*Delta Co.* v. *Maxim Co.* (1891) 8 R. P. C. at p. 171; *Moseley* v. *Victoria Rubber Co.* (1886) 3 R. P. C. at p. 357). But the defendant may interrogate the plaintiff as to what claims he is alleged to have infringed (see p. 176, *supra*); and the plaintiff may take the defendant step by step through the specification and ask if he has ever used, and if so in what manner, any of the

processes, combinations, or component parts therein referred to (see *Ashworth* v. *Roberts* (1890) 7 R. P. C. at pp. 452, 453; *Benno Jaffé* v. *Richardson* (1893) 10 R. P. C. 136).

The plaintiff cannot ask the defendant what an alleged anticipation did (*Delta Co.* v. *Maxim Co.* (1891) 8 R. P. C. 169). But a defendant may ask in what respects a previous invention differs from the plaintiff's (*Hoffman* v. *Postill* (1869) 4 Ch. 673).

When infringement is not denied by a defendant, it is no ground for refusing to answer an interrogatory that the answer would expose persons to whom he had sold the infringing article to actions for infringement (*Tetley* v. *Easton* (1856) 18 C. B. 643). And a mere plea that the process is a secret one is not sufficient to defeat discovery (*per* Kekewich, J., in *Ashworth* v. *Roberts* (1890) 7 R. P. C. at p. 455).

Ord. 31, r. 20, is only enabling (*Rawes* v. *Chance* (1890) 7 R. P. C. 275), and a defendant cannot refuse to answer interrogatories merely on the ground that the discovery sought depends on the determination of the question as to the validity of the patent (*Benno Jaffé* v. *Richardson* (1893) 10 R. P. C. 136).

As to the proper persons to answer interrogatories and the sufficiency of answers in the case of a company, see *Welsbach Co.* v. *New Sunlight Co.* (1900) 17 R. P. C. 401).

Discovery of Documents.—As to discovery generally, see Ord. 31, rr. 12 to 29, and the notes thereunder contained in the Annual Practice.

One litigant is not entitled to see books or laboratory notes containing the processes of the other litigant unless he wants to see them—and until the time comes in the litigation when he wants to see them—for the purposes of justice.

"What would be the opposite result? Why, that any patentee who is not working himself, might, by bringing an action for infringement against a working competitor, see laboratory processes in the books under the plea that he wanted it to prove infringement" (per Bowen, L.J., in *Rawes* v. *Chance* (1890) 7 R. P. C. at p. 282).

A defendant, who disputes the validity of the patent, is entitled to discovery of all documents relating to former proceedings in which the validity was attacked, except such as "have 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 or consideration" (*Haslam* v. *Hall* (1888) 5 R. P. C. 1; and see *Bourn* v. *Sansom*

(1888) 5 R. P. C. 510; *Thomson* v. *Hughes* (1890) 7 R. P. C. 187).

A mere plea of secret process is not sufficient to defeat discovery; but the Court will not unnecessarily oblige a defendant to disclose his own secret process (*Ashworth* v. *Roberts* (1890) 7 R. P. C. at p. 455), and will endeavour to protect him (see *Badische* v. *Levinstein* (1885) 2 R. P. C. at p. 81; *Plating Co.* v. *Farquharson* (1879) Griff. P. C. 187).

Communications between a litigant and a patent agent are not privileged; and where a solicitor is also a patent agent, communications are privileged only so far as they were made to him in his capacity of solicitor (*Moseley* v. *Victoria Rubber Co.* (1886) 3 R. P. C. at pp. 355, 356).

Affidavits and notes of evidence in former proceedings may be required to be produced (*Born* v. *Sansom* (1888) 5 R. P. C. 510; *Thomson* v. *Hughes* (1890) 7 R. P. C. 187).

Expediting the Trial.

Actions in the Chancery Division entered for trial may be taken out of their turn by order of the Court, on the plaintiff's application, and without the defendant's consent, on a proper ground being stated, *e.g.*, on the ground that the object of the suit will be lost by delay, or to enable a certain witness to attend (see note to Ord. 36, r. 16, in the Annual Practice). The application is usually made by motion (see *Farbenfabriken* v. *Bowker* (1891) 8 R. P. C. 136).

Where an interlocutory injunction has been granted an application to advance the trial will rarely be granted; and where no injunction has been granted a special case must be made out (see *per* Stirling, J., in *Farbenfabriken* v. *Bowker*, *supra*, at p. 137).

The fact that owing to fluctuations and changes in taste the market for the patented article may expire in a few months is no ground for expediting the hearing (*Farbenfabriken* v. *Bowker*, *supra*; *cf. Heine Solly* v. *Conico Co.* (1904) 21 R. P. C. 201).

When leave is given to the plaintiff to apply to advance, the application to advance will be refused if delay is made in making the application (*Heine Solly* v. *Conico Co.*, *supra*).

Leave to Discontinue.

If, after receipt of the defence, the plaintiff has proceeded in the action, he cannot discontinue without leave of the Court or a

Judge: and in granting leave the Court may impose such terms as to costs, and as to any other actions, or otherwise, as may be just (R. S. C. Ord. 26, r. 1). The plaintiff is usually required to pay all the costs, including the costs of the defendant's particulars, as if the same had been certified (*Boake* v. *Stevenson* (1895) 12 R. P. C. 228; and see *Bethell* v. *Gage* (1897) 14 R. P. C. 699). And the Court sometimes grants leave only upon the conditions that the plaintiff undertakes not to bring any other action against the defendant in respect of the same alleged infringement (*Chamberlain* v. *Mayor of Huddersfield* (1901) 18 R. P. C. 454), and, if the defendant is a person acting in exercise of statutory or public duties (see Public Authorities Protection Act, 1893), that the plaintiff pays the costs as between solicitor and client (*Chamberlain* v. *Mayor of Huddersfield*, *supra*).

The Trial.

The action must be tried without a jury, unless the Court otherwise directs (s. 28 (1) of the Patents Act, 1883); it is, now, almost invariably tried without a jury, and in the Chancery Division. The Court may, if it thinks fit, and must, 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 partly with his assistance (s. 28 (1), *ibid.*).

The Court will not, under Ord. 36, r. 8, try the question of infringement separately from the question of validity of the patent where the issues of infringement and invalidity are set up (*United Telephone Co.* v. *Mottishead* (1886) 3 R. P. C. 213). But where the defendants denied infringement and alleged invalidity of the patent by reason of prior use by several persons, the Judge at the trial decided to dispose of the alleged evidence of one user before going into the others (*Richardson* v. *Castrey* (1887) 4 R. P. C. 265; and see *Badham* v. *Bird* (1888) 5 R. P. C. at p. 240). And where several patents were sued upon, and the only issue was as to validity, the case as to each was heard separately and treated as a separate action (*British Motor Co.* v. *Sherrin* (1901) 18 R. P. C. 265).

The burden of proof being generally on the plaintiff, he has the right to begin and to reply. But the proof of the issue as to the plaintiff being the true and first inventor is on the defendant (*Ward* v. *Hill* (1901) 18 R. P. C. 481); and where this is the only issue the defendant must begin (*Pilkington* v. *Yeakley* (1901) 18 R. P. C. at p. 460).

Evidence.—If the defendant does not appear, the plaintiff is not entitled to judgment without any proof of his case; but it will generally be sufficient to put in the patent and prove the specification and the infringement (*Peroni* v. *Hudson* (1884) 1 R. P. C. 261). If, however, the specification has been amended, evidence that it was originally drawn with reasonable skill and knowledge must be given (*Brooks* v. *Lycett* (1903) 20 R. P. C. 390); and if the validity of the patent has not been established before, evidence that the invention is new and useful should be given (*Acetylene Co.* v. *Midand Syndicate* (1900) 17 R. P. C. at p. 535).

The plaintiff's title must be strictly proved (see *Jandus* v. *Johnson* (1900) 17 R. P. C. at p. 370). If he is the original patentee, this may be done by production of the letters patent sealed with the seal of the Patent Office (see ss. 12 (2) and 84 of the Patents Act, 1883). If he is an assignee, a certified copy of the entry in the Register of Patents should be produced (ss. 23 (2), and 89, *ibid.*; and see *Jandus* v. *Johnson*, *supra*).

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, are admitted in evidence in all Courts, and in all proceedings, without further proof or production of the originals (s. 89, *ibid.*; and see s. 96, *ibid.*, and *Jandus* v. *Johnson*, *supra*).

The construction of the specification is for the Court alone: but evidence may be given to explain the meaning of technical or commercial expressions or terms of art (*Hills* v. *Evans* (1863) 31 L. J. (N. S.) Ch. 457; *Neilson* v. *Harford* (1841) 1 W. P. C. at p. 370; *United Telephone Co.* v. *Bassano* (1886) 3 R. P. C. at p. 315), or to explain the state of knowledge at the date of the patent (see *Badische* v. *Levinstein* (1887) 4 R. P. C. at p. 465; *Sandow* v. *Szalay* (1904) 21 R. P. C. 333; and see pp. 77, 156, *supra*), or to show that any workman of ordinary skill in the trade would be able to understand and to carry out the invention from the description given (*Edison-Bell* v. *Smith* (1894) 11 R. P. C. at p. 396; *Badische* v. *Levinstein* (1885) 2 R. P. C. at p. 112), or to assist the Court in ascertaining what in fact the patentee's invention is (*Badische* v. *Levinstein*, *supra*, at pp. 112, 113; (1887) 4 R. P. C. at p. 465).

Although it is not for a witness to construe the specification, he may be asked what he understands by it (see *per* Lord Halsbury, L.C., in *Kaye* v. *Chubb* (1888) 5 R. P. C. at p. 650), or whether

the invention described involved ingenuity or was obvious (*Fletcher* v. *Glasgow Commissioners* (1887) 4 R. P. C. at p. 388). But the patentee will not be allowed, where no technical terms are used, to say what he meant by the words he has employed (see *Parker* v. *Powell* (1902) 19 R. P. C. at p. 375).

If it is alleged that the invention was not proper subject-matter, evidence may be given of experiments leading up to the invention, in order to show that a difficulty had to be overcome (*Thierry* v. *Rickmann* (1895) 12 R. P. C. at p. 417).

It is not permissible to ask a witness whether he considers the defendant's article is an infringement of the plaintiff's; that is a question for the Court alone (*Parkinson* v. *Simon* (1894) 11 R. P. C. at p. 506); but he may be asked whether the one device is not a mere mechanical equivalent of the other (*Ticket Punch Co.* v. *Colley's Patents* (1895) 12 R. P. C. at p. 186).

The opinion of the Law Officer concerning a patent should not be read at the trial (see *per* Cotton, L.J., in *Siddell* v. *Vickers* (1888) 5 R. P. C. at p. 436).

Models should be properly proved and put in evidence (see *Automatic Weighing Co.* v. *Combined Weighing Co.* (1889) 6 R. P. C. at p. 125).

If one party is taken by surprise at the trial, or evidence not within the particulars is given, he should ask for an adjournment; for if he does not do so, and judgment is given against him, the Court of Appeal will not grant leave to adduce further evidence on appeal (*Barcroft* v. *Smith* (1897) 14 R. P. C. 172).

Expert Evidence.—The Judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. Expert evidence is also admissible, and is often required to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff's invention and whatever is done by the defendant. But the nature of the invention must be ascertained from the specification, and has to be determined by the Judge and not by any expert or other witness; this is familiar law, although often disregarded when witnesses are being examined (see *per* Lindley, L.J., in *Brooks* v. *Steele* (1897) 14 R. P. C. at p. 73).

The evidence of skilled persons is much the same as that of handwriting experts; they call attention to particular things, and

then the Court has to consider them itself (*per* Lord Herschell in *Boyd* v. *Horrocks* (1892) 9 R. P. C. at p. 81), but being in no way bound by the witnesses' opinions (*Leadbeater* v. *Kitchin* (1890) 7 R. P. C. at p. 247).

The evidence of scientific witnesses as to whether there has or not been an infringement ought not to be received (see *per* Lord Wensleydale in *Seed* v. *Higgins* (1860) 8 H. L. C. 550; *Parkinson* v. *Simon* (1894) 11 R. P. C. at p. 506); but an expert witness may be asked whether the defendant's variations are not merely mechanical equivalents (*Ticket Punch Co.* v. *Colley's Patents* (1895) 12 R. P. C. at p. 186).

Evidence of Infringement.—If the action as originally brought is in respect of *threatened* infringement, and, after action brought, the defendant commits actual infringement, evidence of it can be given, as it is evidence to show that the plaintiff was right in his allegation that the defendant was threatening and intending to infringe (see *per* Romer, J., in *Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at pp. 357, 358; *cf. Dowling* v. *Billington* (1890) 7 R. P. C. at p. 201). But if the action is based on actual infringement *only*, evidence of acts of infringement subsequent to the date of the writ is inadmissible (*Shoe Co.* v. *Cutlan*, *supra*; *Welsbach Co.* v. *Doyle* (1899) 16 R. P. C. 391; and see *Dowling* v. *Billington*, *supra*).

In the case of threatened infringement, the plaintiff must prove that the act threatened, when carried out, will amount to an infringement (*Frearson* v. *Loe* (1878) 9 C. D. at p. 65; *Dowling* v. *Billington* (1890) 7 R. P. C. at p. 201).

When it is shown that the defendant's article contains all the qualities of and it appears to the eye similar to the plaintiff's patented article, that is *prima facie* evidence, till the contrary is shown, that it was made according to the patentee's method (see *Huddart* v. *Grimshaw* (1803) 1 W. P. C. at p. 91; *Hall* v. *Jarris* (1822) 1 W. P. C. 100; *Saccharin Corpn.* v. *Quincey* (1900) 17 R. P. C. at pp. 339, 340; *Saccharin Corpn.* v. *Jackson* (1903) 20 R. P. C. at pp. 615, 616) *Saccharin Corpn.* v. *Dowson* (1902) 19 R. P. C. at pp. 171, 172); and this is especially so when the article was made abroad, as the plaintiff, in that case, cannot obtain an order for inspection of the defendant's manufactory and thus obtain direct proof (*Neilson* v. *Betts* (1871) 5 H. L. C. 11). But if the defendant's article might have been made by another method which involved no infringement, the plaintiff must prove that it was actually made according to his method, even where the

article was made abroad (*Cartsburn Co.* v. *Sharp* (1884) 1 R. P. C. at p. 186).

The defendant's answers to interrogatories may afford sufficient proof of infringement (*Welsbach Co.* v. *New Incandescent Co.* (1900) 17 R. P. C. at pp. 243, 247, 248; *cf. Ashworth* v. *English Card Co.* (1903) 20 R. P. C. at pp. 796, 797).

Effect of Previous Decision on Same Patent.—The fact that a patent has been supported in a former action does not estop a *new defendant* questioning its validity in a subsequent action (see *Patents Exploitation* v. *American Novelty Co.* (1903) 20 R. P. C. 689); and the fact that the plaintiff has failed in supporting his patent in a former action cannot be pleaded by a new defendant as a bar to a subsequent action for infringement (*Arkwright* v. *Nightingale* (1785) 1 W. P. C. at p. 61; and see *Dunlop Co.* v. *Rimington* (1900) 17 R. P. C. 665). The evidence in the second action may be altogether different to that in the first; a prior user relied on as an anticipation may defeat the patent in the second action, although it failed to do so in the first for want of sufficient evidence (see *Shaw* v. *Day* (1894) 11 R. P. C. 185; *Patents Exploitation Co.* v. *American Novelty Co.*, *supra*).

But although there is no estoppel when the parties are different, a Court of equal or inferior jurisdiction ought to be bound by the former decision with regard to the construction of the specification (*Edison* v. *Holland* (1888) 6 R. P. C. at p. 276; *Dunlop Co.* v. *Wapshare Co.* (1900) 17 R. P. C. at p. 448); in fact, if disconformity is set up in the second action, the defendant ought not to be permitted to go into the question at all unless he brings forward new facts—not new arguments—which may lead to the conclusion that the former construction was not the true construction (see *per* Smith, L.J., in *Pneumatic Tyre Co.* v. *Leicester Tyre Co.* (1899) 16 R. P. C. at p. 55). And a Judge should not vary the decision of another Judge of equal authority on the question of sufficiency of invention or utility (see *per* Cotton, L.J., in *Slazenger* v. *Feltham* (1889) 6 R. P. C. at p. 234; *National Brick Co.* v. *Grand Hotel* (1901) 18 R. P. C. 249; *Saccharin Corpn.* v. *Anglo-Continental Works* (1900) 17 R. P. C. at p. 315).

Estoppel.—Where the second action is against the same defendant, and in the first action the issue of validity was decided in the plaintiff's favour, the defendant is estopped from contesting the validity again, even though he may have discovered

fresh evidence for impeachment; the question of validity is *res judicata* between the parties (*Shoe Co.* v. *Cutlan* (1896) 13 R. P. C. 141). And where the parties are the same in both actions and the patent was held void in the first, the subject of the second is *res judicata*, and that action may be dismissed with costs (*Horrocks* v. *Stubbs* (1895) 12 R. P. C. 540). If the defendant in the second action, though not a defendant in the first action, was bound by the judgment given in the first—if he was a party or privy to the estoppel—the second action may be dismissed or stayed (see *Dunlop Co.* v. *Rimington* (1900) 17 R. P. C. 665).

Amendment of the Specification.—The Court may at any time order that the patentee shall 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 shall be postponed (see p. 86, *supra*).

Certificate as to Validity.—In an action for infringement the Court or a Judge may certify that the validity of the patent came in question; and if the Court or Judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, is entitled to 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 (s. 31 of the Patents Act, 1883; see p. 216, *infra*).

The certificate may be granted by the Court of Appeal (*Birch* v. *Harrap* (1896) 13 R. P. C. at p. 627); but no appeal lies respecting its grant or refusal (*Haslam* v. *Hall* (1888) 5 R. P. C. 144).

The Court will not grant a certificate if one has already been granted in a previous action (*Edison* v. *Holland* (1889) 6 R. P. C. at p. 287; *cf. Otto* v. *Steel* (1886) 3 R. P. C. at p. 120).

A certificate may be granted, notwithstanding that the patent is declared invalid (*Haslam* v. *Hall* (1888) 5 R. P. C. at pp. 27, 28; *Badische* v. *La Société Chimique* (1897) 14 R. P. C. at p. 892), or has expired (*Kane* v. *Boyle* (1901) 18 R. P. C. at p. 337). But the fact of a certificate having been obtained in respect of a patent held bad would, of course, induce no Judge to allow solicitor and client costs in a subsequent action, even though the defect in the specification were cured by amendment. In a recent case, Buckley, J., refused to certify in respect of a patent which he declared invalid (*Acetylene Co.* v. *United Alkali Co.* (1902) 19 R. P. C. at p. 234).

Whether the Court should grant a certificate where the defendant does not appear at the trial, or submits to judgment, or where the question of validity is not fought out, is not altogether settled. In *Peroni* v. *Hudson* ((1884) 1 R. P. C. at p. 263), Kay, J., held that s. 31 only applies where the patent is established in a case contested in Court. And in *Stocker* v. *Rodgers* (1846) 1 C. & K. 99, *Claughton* v. *Foster* (1904) 21 R. P. C. at p. 18, and *Webb* v. *Atkinson* (1902) 19 R. P. C. at p. 600, where there had been no contests, certificates were refused. On the other hand, certificates have been granted where the defendant has not appeared at the trial (*Haydock* v. *Bradbury* (1887) 4 R. P. C. 74; *Acetylene Co.* v. *Midland Syndicate* (1900) 17 R. P. C. at p. 536; *Brooks* v. *Lycett* (1903) 20 R. P. C. 390), where the parties consented to an order (*Delta Co.* v. *Maxim* (1891) 8 R. P. C. 247), and where the question of validity was not fought out (*Tweedale* v. *Ashworth* (1890) 7 R. P. C. at p. 436; *Leeds Forge Co.* v. *Deighton's Co.* (1901) 18 R. P. C. at p. 240; and see *Field* v. *Wagel* (1900) 17 R. P. C. at pp. 275, 276).

Remedies.

The plaintiff, if successful, is entitled to—(1) a perpetual injunction; (2) delivery up or destruction of the infringing articles; and (3) damages or an account of profit.

The Injunction.

An injunction, it seems, ought not to be allowed to go by consent, but the order should be "the defendant appearing and undertaking, etc."; for sometimes injunctions are taken by consent, and then the injunctions are advertised as if granted in an opposed case, and that ought not to be (see *per* Buckley, J., in *Dover* v. *New Tournend Co.* (1904) 21 R. P. C. at p. 136).

If the case has been contested and the infringement complained of has been made out, the plaintiff is *primâ facie* entitled to an injunction; for when a man has done a wrongful act the probability is that he will continue it (*Proctor* v. *Bailey* (1889) 6 R. P. C. at p. 542; and see *Shelfer* v. *City of London Co.* [1895] 1 Ch. at p. 316). The plaintiff is also entitled to an injunction to prevent a case of threatened infringement (see *Proctor* v. *Bailey*, *supra*; *Dowling* v. *Billington* (1890) 7 R. P. C. 191; *Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at pp. 357, 358).

But there may be special circumstances depriving the plaintiff of his *primâ facie* right (*per* Lindley, L.J., in *Shelfer* v. *City of London Co.*, *supra*, at p. 316). For instance, no injunction will

be granted where there is no probability of the act of infringement being continued or repeated (*Proctor* v. *Bailey*, *supra*; *Hudson* v. *Chatteris* (1898) 15 R. P. C. at p. 440); and the plaintiff may by his acts or laches disentitle himself to an injunction (see *per* Smith, L.J., in *Shelfer* v. *City of London Co.*, *supra*, at p. 322). Moreover, damages may be substituted for an injunction if "(1) the injury to the plaintiff's legal rights is small, and (2) is one which is capable of being estimated in money, and (3) is one which can be adequately compensated by a small money payment, and (4) the case is one in which it would be oppressive to the defendant to grant an injunction. . . . There may also be cases in which, though the four above-mentioned requirements exist, the defendant by his conduct . . . has disentitled himself from asking that damages may be assessed in substitution for an injunction" (*per* Smith, L.J., in *Shelfer* v. *City of London Co.*, *supra*, at pp. 322, 323).

But delay or acquiescence which would be fatal to an application for an interlocutory injunction (see pp. 188, 189, *supra*) will not debar a plaintiff from obtaining a perpetual injunction at the trial (see *Fullwood* v. *Fullwood* (1878) 9 C. D. 176; *per* Cotton, L.J., in *Proctor* v. *Bennis* (1887) 36 C. D. at p. 758).

Where the defendant has acted in ignorance of the plaintiff's patent rights, and has admitted infringement, an injunction may be refused (*Hudson* v. *Chatteris* (1898) 15 R. P. C. 438); more especially where the infringement is a trifling one (*Jenkins* v. *Hope* (1896) 13 R. P. C. 57).

But where a patented article is sold under a limited licence, a purchaser who buys with notice of the terms of the licence, and disregards them, will be restrained by injunction, however trivial the infringement (see *Incandescent Co.* v. *Brogden* (1899) 16 R. P. C. 179).

An injunction will not be granted against third parties (*Edison* v. *Holland* (1889) 6 R. P. C. at pp. 285, 286); but it may be granted against the secretary of a company, although he has taken no part in the acts of infringement, if he is made a defendant and adopts the defence of the company and appears by the same counsel and solicitors (*Welsbach Co.* v. *Daylight Co.* (1899) 16 R. P. C. at p. 356).

As a general rule, an injunction will not be granted where the patent has already expired or is about to expire (*British Motor Syndicate* v. *Universal Motor Co* (1899) 16 R. P. C. 113; *British Insulated Co.* v. *Dublin Tramway Co.* (1900) 17 R. P. C. at p. 22; *Ward* v. *Hill* (1901) 18 R. P. C. 493; *Kane* v. *Boyle* (1901) 18

R. P. C. 325; *Betts* v. *Gallais* (1870) 10 Eq. 392). But where infringing articles had been manufactured just before the expiration of the patent, with a view of throwing them upon the market after the expiration of the grant, an injunction was granted (*Crossley* v. *Beverley* (1829) 1 W. P. C. 119).

If numerous patents are sued upon, the injunction will be granted until the expiring of the patent which expires first (*Saccharin Corpn.* v. *Dowson* (1902) 19 R. P. C. at p. 172; *Saccharin Corpn.* v. *Jackson* (1903) 20 R. P. C. at p. 616). If one of them has already expired no injunction will be granted (*Saccharin Corpn.* v. *Quincey* (1900) 17 R. P. C. at p. 339).

Where an action is brought against two persons, and one contests the validity of the patent and the other does not appear at the trial but consents, an injunction will be granted against the other notwithstanding that the patent is declared void (*Savage* v. *Brindle* (1900) 17 R. P. C. at p. 233).

If the defendant repeats his infringement in a new form, the patentee should not commence another action against him, but should move to attach him for contempt (*Thomson* v. *Moore* (1889) 6 R. P. C. 426).

Motion to Commit for Disobeying Injunction.—If the defendant continues his infringement after injunction granted, or after an undertaking by order (see *Schermuly* v. *Paine* (1901) 18 R. P. C. 529), and whilst the order against him remains in operation, the plaintiff may move to commit the defendant for contempt (see *Bowden's Patents* v. *Wilson* (1903) 20 R. P. C. 644).

It is no answer to a motion to commit that the injunction was not served on the defendant, if the defendant was fully aware that the order had been made and was intended to be enforced (see *per* Pearson, J., in *United Telephone Co.* v. *Dale* (1884) 25 C. D. at pp. 784, 785; *cf. Incandescent Co.* v. *Riemer* (1900) 17 R. P. C. 379). Nor is it any answer that the defendant believed he was not infringing (see *Thomson* v. *Moore* (1889) 6 R. P. C. 426), or has acted innocently (*Lyon* v. *Goddard* (1894) 11 R. P. C. 113); but where the defendant has clearly acted in ignorance, an order for committal will not readily be granted (see *Spencer* v. *Ancoats Co.* (1889) 6 R. P. C. 46; *Incandescent Co.* v. *Sluce* (1900) 17 R. P. C. 173), or, if granted, the order will usually be required to lie in the office for fourteen days, and not to issue if the defendant in the meantime delivers up all infringing machines and pays the costs of the motion (*Lyon* v. *Goddard* (1894) 11 R. P. C. 113).

As to the evidence on a motion to commit, see *Ripley* v. *Arthur* (1902) 19 R. P. C. 443).

Where a person, with knowledge of an injunction, chooses to help the defendant by committing acts of infringement for him, he is liable to be himself committed for contempt (see *per* Smith, L.J., in *Incandescent Co.* v. *Sluce* (1900) 17 R. P. C. at p. 175); but it must be strictly proved that the person sought to be committed is a servant or agent of or has aided or abetted the defendant (*Incandescent Co.* v. *Sluce*, *supra*).

Upon a motion to commit, it is open to the defendant to show that the patent has been determined (*Daw* v. *Eley* (1867) 3 Eq. 496), or that he has not infringed (*Schermuly* v. *Pain* (1901) 18 R. P. C. 529).

Delivery Up or Destruction.

The plaintiff is entitled to an order that the defendant shall either destroy (*Betts* v. *De Vitrie* (1864) 34 L. J. Ch. at p. 291; *Howes* v. *Webber* (1895) 12 R. P. C. at p. 470) or deliver up to the plaintiff (*Washburn Co.* v. *Patterson* (1884) 1 R. P. C. 191), within a certain period (see *Otto* v. *Steel* (1886) 3 R. P. C. at p. 120; *Washburn Co.* v. *Patterson*, *supra*), all infringing articles in his possession. Sometimes the plaintiffs are given leave to inspect and mark all infringing articles in the possession or power of the defendant for the purpose of identification (*Westinghouse* v. *Lancashire, etc. Co.* (1884) 1 R. P. C. at p. 253).

In some cases an order for destruction or delivery up will not be made, by reason of the nature of the invention (*Siddell* v. *Vickers* (1888) 5 R. P. C. at p. 101; *Lancashire Explosives Co.* v. *Roburite Co.* (1895) 12 R. P. C. at p. 483).

The order for delivery up will usually be limited to the infringing parts of the defendant's machines (*Edison-Bell* v. *Smith* (1894) 11 R. P. C. at p. 406; *Automatic Weighing Co.* v *Pearby* (1893) 10 R. P. C. 442; *Sluce Co.* v. *Cutlan* (1895) 12 R. P. C. at p. 359; *cf. Moser* v. *Marsden* (1893) 10 R. P. C. at p. 364).

The defendant is sometimes required to file an affidavit stating what infringing articles are in his possession or control (*Westinghouse* v. *Lancashire, etc. Co.* (1884) 1 R. P C. at p. 253; *Edison-Bell* v. *Smith* (1894) 11 R. P. C. at p. 406).

Damages or an Account.

The plaintiff may have either damages or an account of profits. But he cannot have both as against the same defendant; he must elect between the two remedies (*American Braided Co.* v.

Thomson (1890) 7 R. P. C. at p. 158; *United Horse Shoe Co.* v. *Stewart* (1888) 5 R. P. C. at p. 266). He may, however, have damages against one defendant and an account against another (*Penn* v. *Bibby* (1866) 3 Eq. 308; and see *United Telephone Co.* v. *Walker* (1887) 4 R. P. C. at p. 67; *Boyd* v. *Tootal* (1894) 11 R. P. C. at p. 179). Speaking generally, an inquiry as to damages is of more benefit to the plaintiff than an account. A patentee who elects to take profits stands in the shoes of the infringer, and condones, so to speak, his wrong, and he is entitled only to those profits (*per* Lord Alverstone, M.R., in *Saccharin Corpn.* v. *Chemicals Co.* (1900) 17 R. P. C. at p. 615). But an account may sometimes prove to be of more benefit than an inquiry as to damages (see *English Machinery Co.* v. *Union Boot Co.* (1896) 13 R. P. C. at p. 67.)

Damages.—It is submitted that the following statements are established from the reported cases:—

(1) The innocence of an infringer will not save him from a claim for damages (see *Boyd* v. *Tootal* (1894) 11 R. P. C. at p. 185; and see p. 153, *supra*).

(2) The loss recoverable as damages must be such as is the natural and direct consequence of the defendant's acts (see *per* Lord Macnaghten in *United Horse Shoe Co.* v. *Stewart* (1888) 5 R. P. C. at p. 268; and see *Boyd* v. *Tootal* (1894) 11 R. P. C. at pp. 182, 184).

(3) A patentee is not bound to accept the same damages from a litigant that he accepts from others (*per* Robinson, V.-C., in *Boyd* v. *Tootal*, *supra*, at p. 179).

(4) In considering what amount of damages should be awarded, the test is: "What would have been the position of the plaintiffs if the defendants had acted properly instead of improperly?" (*per* Robinson, V.-C., in *Boyd* v. *Tootal*, *supra*, at p. 181; *Penn* v. *Jack* (1867) 5 Eq. at p. 84; and see *United Horse Shoe Co.* v. *Stewart* (1888) 5 R. P. C. at p. 267; *American Braided Co.* v. *Thomson* (1890) 7 R. P. C. at p. 162; *British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. at p. 731).

(5) The profits made by the infringer are not the measure of damages (see *per* Lord Watson in *United Horse Shoe Co.* v. *Stewart*, *supra*, at p. 267; *Alexander* v. *Henry* (1895) 12 R. P. C. at p. 366; *cf. American Braided Co.* v. *Thomson* (1890) 7 R. P. C. 152).

(6) Where the patentee has reduced his prices merely as a

matter of policy, the reduction—*i.e.*, the difference between the original price and the reduced price—is not recoverable as damages (*Alexander* v. *Henry* (1895) 12 R. P. C. at p. 367; *United Horse Shoe Co.* v. *Stewart* (1888) 5 R. P. C. 260; *American Braided Co.* v. *Thomson* (1890) 7 R. P. C. 152).

(7) Where the patentee has reduced his prices in consequence of the infringer's competition, the reduction in price is the natural consequence of the infringement, and may be visited on the head of the infringer (*Alexander* v. *Henry*, *supra*; *American Braided Co.* v. *Thomson*, *supra*; *cf. Boyd* v. *Tootal* (1894) 11 R. P. C. at p. 184).

(8) Where the plaintiffs have not been in the habit of selling, but more usually of letting out the patented article at a royalty, the measure of damages is the profit rent of the article during the entire period from the time when it came into possession of the infringer until the assessment of damage or the date of the delivery up; and it is immaterial for the purposes of assessment whether the article has or has not been in actual use during any portion of that period (*United Telephone Co.* v. *Walker* (1887) 4 R. P. C. 63; *English Machinery Co.* v. *Union Boot Co.* (1896) 13 R. P. C. at p. 67; *Penn* v. *Jack* (1867) 5 Eq. 81; but see *Pneumatic Tyre Co.* v. *Puncture Proof Co.* (1899) 16 R. P. C. 209; *British Motor Syndicate* v. *Taylor* (1900) 17 R. P. C. at pp. 194, 730, 731).

(9) The plaintiff is entitled to full compensation for the injury which the defendant's competition may have occasioned; it is therefore not material where damages are claimed to consider how much of the invention was actually appropriated (see *per* Lord Watson in *United Horse Shoe Co.* v. *Stewart* (1888) 5 R. P. C. at pp. 266, 267; *cf. United Telephone Co.* v. *Walker* (1887) 4 R. P. C. 63).

(10) A claim for damages on the ground that, had it not been for the infringement, the plaintiff would have been able to produce his machine at a lower cost, is probably too remote (*Boyd* v. *Tootal* (1894) 11 R. P. C. at pp. 184, 185).

(11) The fact that the plaintiff has recovered damages against the manufacturer does not preclude him from recovering damages against the purchasers. The article may be followed in every man's hand, until the infringement is got rid of; so long as the article is used there is continuing damage (see *per* Wood, V.-C., in *Penn* v. *Bibby* (1866) 3 Eq. at p. 311; *United Telephone Co.* v. *Walker* (1887) 4 R. P. C. at p. 67; *Boyd* v. *Tootal* (1894) 11 R. P. C. at p. 184).

(12) The amount of damages recoverable against users is not merely nominal (*Boyd* v. *Tootal* (1894) 11 R. P. C. 175); but the plaintiff cannot recover more than the damage sustained (*Boyd* v. *Tootal*, *supra*, at p. 184; *Garioli* v. *Shepherd* (1900) 17 R. P. C. 157).

(13) The amount which the plaintiff has accepted from another infringer in settlement of his claim is not to be taken finally as the complete measure of damages; for it is always worth a litigant's while to take off something from his claim for the sake of peace (*Boyd* v. *Tootal* (1894) 11 R. P. C. at p. 184).

(14) No damages will be awarded where the plaintiff has sustained no pecuniary loss (*Garioli* v. *Shepherd* (1900) 17 R. P. C. 157; in this case the defendants filed evidence to show that their means would not have allowed them to purchase one of the plaintiff's articles), or in respect of infringements committed after the expiration of the patent (*British Insulated Co.* v. *Dublin Tramway Co.* (1900) 17 R. P. C. at pp. 21, 22).

No damages can be recovered—(1) for infringements committed before the publication of the complete specification (s. 13 of the Patents Act, 1883); (2) for infringements committed prior to amendment of the specification, unless the Court is satisfied that the original claim was framed in good faith and with reasonable skill and knowledge (s. 20, *ibid.*; see *Kane* v. *Boyle* (1901) 18 R. P. C. at p. 337; *Hopkinson* v. *St. James' Co.* (1893) 10 R. P. C. at p. 62; *Wenham* v. *Carpenter* (1888) 5 R. P. C. 68); or (3) for infringements committed after failure to pay any renewal fee within the prescribed time, and before the enlargement thereof, if the Court thinks fit not to award damages (s. 17 (4) (*b*), *ibid.*).

Mitigation of Damages.—It is open to a defendant, by way of mitigating damages, to show that the patent has been declared bad in a previous action, and that persons have acted upon the faith of the former verdict (see *per* Lord Loughborough in *Arkwright* v. *Nightingale* (1785) 1 W. P. C. at p. 61). And if the plaintiff allows the defendant to openly use the invention and does not take any steps to prevent him for a considerable time, that may seriously affect the amount of damages recoverable (*Smith* v. *L. & N. W. Rail. Co.* (1853) Macr. P. C. at p. 202).

Set-Off. — The defendant cannot set-off, as against the damages claimed, the value of the articles delivered up under the judgment; the plaintiffs are not liable to pay for the articles given up in any form. Nor is the defendant entitled to set-off

any portion of an agreed sum for damages for infringement recovered by the plaintiffs in a previous action against the manufacturer, from whom the defendant bought the article, although the period in respect of the rent payable by the defendant as damages commenced at a date antecedent to the commencement of the action against the manufacturer. If, however, the damages recovered by the plaintiffs from the manufacturer were not an agreed sum, but a sum representing the full rent or royalty, the defendant is entitled to a set-off (*United Telephone Co.* v. *Walker* (1887) 4 R. P. C. 63).

Inquiry as to Damages.—The amount of damage sustained can rarely be made the subject of exact arithmetical calculation (see *per* Lord Halsbury in *United Horse Shoe Co.* v. *Stewart* (1888) 5 R. P. C. at p. 264).

Where the assessment cannot be conveniently dealt with by the Judge at the trial, the assessment will be referred to an Official Referee or the Chief Clerk; a Judge of the Chancery Division has no power to direct the assessment to be made by a jury (*American Braided Co.* v. *Thompson* (1888) 5 R. P. C. 538).

If the amount of the damages must be purely a matter of guess-work, the Judge should decide the question at the trial and not refer it (*Ungar* v. *Sugg* (1892) 9 R. P. C. 113; but this was an action for threats). And where the infringement is a trivial one, no inquiry will be directed (*Cole* v. *Saqui* (1888) 5 R. P. C. 489, where Kekewich, J., assessed the damages at 40s.), or, if directed, it will be at the plaintiffs' peril as to costs (*Incandescent Co.* v. *Brogden* (1899) 16 R. P. C. at p. 183).

The proper form of order is "what damage," and not, as in the case of a trade-mark, "what damage, *if any*," has been sustained (*per* Wood, V.-C., in *Davenport* v. *Rylands* (1865) 1 Eq. at p. 308).

The damages are assessed down to the time of the assessment (R. S. C. Ord. 36, r. 58), or, if the patent has expired, the expiration of the patent (*British Insulated Co.* v. *Dublin Tramway Co.* (1900) 17 R. P. C. 14).

The costs of the inquiry will generally be reserved (*United Telephone Co.* v. *Fleming* (1886) 3 R. P. C. 282; *United Telephone Co.* v. *Patterson* (1889) 6 R. P. C. 140; *Aktiebolaget Separator* v. *Dairy Co.* (1898) 15 R. P. C. at p. 338; *Incandescent Gas Co.* v. *Brogden* (1899) 16 R. P. C. at p. 183).

In prosecuting the inquiry the plaintiff is entitled to the fullest possible discovery (see *per* Bacon, V.-C., in *Murray* v. *Clayton* (1872) 15 Eq. at p. 118). The defendant may be

required to state the names of the persons to whom and the prices at which he has sold infringing articles (*American Braided Co.* v. *Thompson* (1888) 5 R. P. C. 375; *Murray* v. *Clayton*, *supra*; and see *Powell* v. *Birmingham Vinegar Co.* (1896) 14 R. P. C. 1), notwithstanding that such disclosure would expose such persons to actions for infringement (*Murray* v. *Clayton*, *supra*), and that an appeal is pending (*American Braided Co.* v. *Thompson*, *supra*, at p. 378).

If either party is dissatisfied with the finding at the inquiry, he may move to vary the certificate (see *Alexander* v. *Henry* (1895) 12 R. P. C. 360). When the Chief Clerk or Official Referee has had before him the whole case and much oral evidence, the Court ought to be unwilling to differ from him with regard to conclusions of fact; where the evidence is all in writing, then the Court is in a very different position (see *per* Kekewich, J., in *Alexander* v. *Henry*, *supra*, at p. 366). The Judge may require further evidence than that which was before the Chief Clerk (*English Machinery Co.* v. *Union Boot Co.* (1896) 13 R. P. C. 64). The question of varying the certificate is very much as if it were a question on motion for a new trial after a verdict given by a jury, where the question would be, not whether the verdict given is that which the Judge would have given, but whether there is evidence upon which a jury could reasonably act in arriving at the conclusion at which they did arrive (see *per* Lord Russell, C.J., in *Pneumatic Tyre Co.* v. *Puncture Proof Tyre Co.* (1899) 16 R. P. C. at p. 214).

Account of Profits—The plaintiff is entitled to elect whether he will take damages or an account of profits (*Siddell* v. *Vickers* (1892) 9 R. P. C. at p. 162). But there is no form of account which is more difficult to work out than an account of profits; and the expense is great, and the time consumed is out of all proportion to the advantage ultimately attained. Therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he is generally inclined to take an inquiry as to damages, rather than launch upon an inquiry as to profits (see *per* Lindley, L.J., in *Siddell* v. *Vickers*, *supra*, at pp. 162, 163). If he elects to take an account, and the result is a waste of time and expense (*Automatic Coal Co.* v. *Mayor of Salford* (1897) 14 R. P. C. at p. 471), or the result shows less profits than those admitted (*Jenkins* v. *Hope* (1896) 13 R. P. C. at p. 60), he may have to pay the costs.

Where the taking of an account was likely to cause great

expense, delay, and difficulty in chambers, an order was made, by consent, that, in lieu of damages, an inquiry should be taken of what would be a proper sum for the defendants to pay by way of royalty (*Automatic Coal Co.* v. *Mayor of Salford, supra*).

On taking an account it is often material to inquire what profits were made both before and after the adoption of the plaintiff's invention, and also what was the cost of production both prior and subsequently to that adoption (*Siddell* v. *Vickers* (1889) 6 R. P. C. at p. 467; (1892) 9 R. P. C. 152). It is necessary to ascertain how much of the invention was actually appropriated, in order to determine what proportion of the net profits was attributable to its use (see *per* Lord Watson in *United Horse Shoe Co.* v. *Stewart* (1888) 5 R. P. C. at p. 266).

An account will not be directed where it appears that no profits have been made (*Bergmann* v. *Macmillan* (1881) 17 C. D. 423) or that the sales have been insufficient to make it worth while (see *Sanitas Co.* v. *Condy* (1887) 4 R. P. C. at p. 533). And the right to an account may be barred by laches or acquiescence (*Crossley* v. *Derby Gas Co.* (1834) 1 W. P. C. 120).

The plaintiff is *primâ facie* entitled to the fullest discovery in aid of the account; he can inspect the defendant's books, and the defendant cannot resist inspection on the ground that it would disclose the names and addresses of his customers (*Saccharin Corpn.* v. *Chemicals Co.* (1900) 17 R. P. C. 612).

Costs.

When the action is tried with a jury, the costs follow the event unless the Judge for good cause otherwise orders; in other cases the costs are in the discretion of the Judge (R. S. C. Ord. 65, r. 1).

As a general rule the successful party is awarded the costs of the action.

With regard to costs generally, the reader is referred to the notes to Ord. 65 contained in the Annual Practice; the following observations have reference to matters peculiar to patent actions:—

Costs where Defendant Acknowledges Infringement and Submits.—Although the defendant acknowledges infringement and offers to give an undertaking not to commit future acts of infringement, the plaintiff is entitled to proceed to obtain an injunction (*American Tobacco Co.* v. *Guest* (1892) 9 R. P. C. at p. 220; *cf. Lyon* v. *Mayor of Newcastle* (1894) 11 R. P. C. 218); but he will not in every case be awarded the costs, notwithstanding all that was said by Jessel, M.R., in *Cooper* v.

Whittingham ((1880) 15 C. D. at p. 504), as to depriving the plaintiff of his right to costs.

The following propositions appear to be established from the reported cases:—

(1) Actions against innocent retailers are not looked upon with favour, and if brought, and the defendant submits, the plaintiff will not be awarded any costs (*American Tobacco Co.* v. *Guest* (1892) 9 R. P. C. at p. 220; and see *Betts* v. *Willmot* (1870) 18 W. R. 946; 19 W. R. 369).

(2) Where the defendant is in possession of a large number of infringing articles, the plaintiff need not be content with an undertaking not to sell, and will be awarded the costs of an action for infringement (*Upmann* v. *Forester* (1883) 24 C. D. 231).

Where the infringement is a trifling one, the plaintiff should accept an undertaking not to infringe, and if he does not he will be given no costs (*American Tobacco Co.* v. *Guest* (1892) 9 R. P. C. at p. 220; *cf. Edison-Bell* v. *Waterfield* (1902) 19 R. P. C. at p. 330), or may even be ordered to pay the costs (*Lyon* v. *Mayor of Newcastle* (1894) 11 R. P. C. 218).

Costs of Particulars.—On taxation of costs, regard is to be had to the particulars delivered by the plaintiff and defendant; and they respectively are not to 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 (s. 29 (6) of the Patents Act, 1883).

A certificate as to particulars may be granted by the Court of Appeal (*Cole* v. *Saqui* (1889) 6 R. P. C. at p. 45; *Sandow* v. *Szalay* (1904) 21 R. P. C. at p. 345), and by the House of Lords (*Morris* v. *Young* (1895) 12 R. P. C. at p. 465). But if an appeal is dismissed, it is doubtful whether the Court above can vary the certificate (see *per* Lindley, L.J., in *Cassell Co.* v. *Cyanide Syndicate* (1895) 12 R. P. C. at p. 305); for a certificate is not a "judgment or order" within s. 19 of the Judicature Act, and no appeal lies in respect of it (*Haslam* v. *Hall* (1888) 5 R. P. C. 144).

The application for a certificate should be made at the trial (*Duckett* v. *Sankey* (1899) 16 R. P. C. at p. 360). It may, however, be made within a reasonable time afterwards; but no costs of the application will be allowed (*Rowcliffe* v. *Morris* (1886) 3 R. P. C. 145; *Duckett* v. *Sankey*, *supra*).

It is not necessary for the Judge to initial the particulars (*Dunlop Co.* v. *Hyde Co.* (1904) 21 R. P. C. at p. 210.

Where no certificate is given, the Taxing Master cannot allow the costs of the particulars; if one party, in such a case, thinks that in consequence of improper or vexatious particulars he has been put to unnecessary and improper costs, he should ask the Court to direct the Taxing Master to see whether any proceedings have been taken improperly, and to direct that he shall get the costs occasioned by the improper proceedings (*Garrard* v. *Edge* (1890) 7 R. P. C. 139).

A certificate may be granted to the unsuccessful party where the successful party has raised unnecessary or improper issues (*Kane* v. *Guest* (1899) 16 R. P. C. 433; and see *Badische* v. *Levinstein* (1885) 2 R. P. C. at p. 118).

Particulars of Breaches.—In *Kane* v. *Guest* ((1899) 16 R. P. C. at p. 443) it was contended that the section was not meant to apply to particulars of breaches; but Stirling, J., held that the section extended to particulars delivered by the plaintiff as well as by the defendant, and he certified that the plaintiff's particulars of breaches had been proven, although the plaintiff was unsuccessful in the action. And see *Young* v. *Rosenthal* (1884) 1 R. P. C. at p. 41; *Pneumatic Tyre Co.* v. *Chisholm* (1896) 13 R. P. C. at p. 489; *Birmingham Tyre Syndicate* v. *Reliance Tyre Co.* (1902) 19 R. P. C. at p. 317.

A certificate that the plaintiff's particulars have been proven will be granted, although no evidence as to infringement is given, if infringement is admitted (*British Motor Co.* v. *Sherrin* (1901) 18 R. P. C. at p. 275; and see *Brooks* v. *Hall* (1904) 21 R. P. C. at p. 30; *Saccharin Corpn.* v. *Skidmore* (1904) 21 R. P. C. 31).

Particulars of Objections.—The objections need not be proved; if the Court is satisfied that they were reasonable and proper a certificate will be granted (*Phillips* v. *Ivel Cycle Co.* (1890) 7 R. P. C. 77; *Sandow* v. *Szalay* (1904) 21 R. P. C. 333).

The Court will not go through a case, when it has been decided on one short point at once, merely for the purpose of ascertaining whether the defendant's particulars are reasonable (*Longbottom* v. *Shaw* (1889) 6 R. P. C. at p. 147; but see *Pegamoid* v. *British Leather Co.* (1901) 18 R. P. C. at p. 319, where Joyce, J., allowed the examination of a witness to be continued to ascertain whether the particulars were reasonable). Hence, a successful defendant often fails to get the costs of his particulars although they could have been proved (*Longbottom*

v. *Shaw*, *supra*; (1889) 6 R. P. C. 510; *Neuraum* v. *Mann* (1890) 7 R. P. C. at p. 310; *Badham* v. *Bird* (1888) 5 R. P. C. 238; *Middleton* v. *Bradley* (1895) 12 R. P. C. at p. 393).

It follows, that where the plaintiff discontinues his action or submits at the trial no certificate can be granted (*Wilcox* v. *Janes* (1897) 14 R. P. C. at p. 524; *Middleton* v. *Bradley*, *supra*; *Mandlebery* v. *Morley* (1895) 12 R. P. C. 35; *Acetylene Co.* v. *United Alkali Co.* (1902) 19 R. P. C. at p. 239; *cf. Boake* v. *Stevenson* (1895) 12 R. P. C. 228; *Kerr* v. *Crompton* (1901) 19 R. P. C. 9), unless there has been some interlocutory application with reference to the particulars in which the Court has had an opportunity of being satisfied as to their reasonableness (see *per* Stirling, J., in *Middleton* v. *Bradley* (1895) 12 R. P. C. at pp. 392, 393; *Wilcox* v. *Janes* (1897) 14 R. P. C. at p. 524; *Ashworth* v. *Horsfall* (1904) 21 R. P. C. at p. 48.) And evidence will not be admitted to show that the objections raised in a former action, and certified to be reasonable, were similar to those raised in the subsequent action (*Ashworth* v. *Horsfall*, *supra*).

But where the whole of the plaintiff's evidence has been heard, and there are materials arising from the evidence adduced by the plaintiff which enables the Judge to come to the conclusion that the particulars are reasonable and proper, a certificate will be granted, although the defendant is not called upon (see *per* Stirling, J., in *Mandlebery* v. *Morley* (1895) 12 R. P. C. at p. 39; *Germ Milling Co.* v. *Robinson* (1886) 3 R. P. C. 254; *Nuttall* v. *Hargreaves* (1891) 8 R. P. C. at p. 276; *Lees* v. *West London Cycle Stores* (1892) 9 R. P. C. at p. 301). Where the defendant is stopped asking questions on the particulars a certificate should be granted (*Birmingham Tyre Syndicate* v. *Reliance Tyre Co.* (1902) 19 R. P. C. at p. 317). And the Court will sometimes give leave to discontinue only on the terms of the plaintiff paying the costs of the defendant's particulars as if the same had been certified (*Boake* v. *Stevenson* (1895) 12 R. P. C. 228; *Chamberlain* v. *Mayor of Huddersfield* (1901) 18 R. P. C. at pp. 456, 457; and see *Bethell* v. *Gage* (1897) 14 R. P. C. 699—a threats action), or the costs of such of the particulars as the Taxing Master shall certify to be reasonable and proper (*Kerr* v. *Crompton* (1902) 19 R. P. C. at p. 11).

Certificates are always granted so as to secure to the party delivering the particulars the costs of everything reasonably and properly inserted in them, although he may fail to prove the specific objection under which the detailed particulars may

be ranged (see *per* Lindley, M.R., in *Castner-Kellner Co.* v. *Commercial Corpn.* (1899) 16 R. P. C. at p. 276; *cf. Dunlop Co.* v. *Wapshare Co.* (1900) 17 R. P. C. at pp. 458, 459).

Costs Where Certificate as to Validity Granted in Prior Action.—If in a prior action the Court or a Judge has certified that the validity of the patent came in question, then the plaintiff, on obtaining a final order or judgment in his favour, has his full costs, charges, and expenses, as between *solicitor and client*, unless the Court certifies that he ought not to have them (s. 31 of the Patents Act, 1883; see p. 202, *supra*).

If the second action is commenced prior to the date of the certificate given in the first action, s. 31 does not apply (*Automatic Weighing Co.* v. *International Society* (1889) 6 R. P. C. 475; *Saccharin Corpn.* v. *Anglo-Continental Works* (1900) 17 R. P. C. at p. 320; *Automatic Weighing Co.* v. *Combined Weighing Co.* (1889) 6 R. P. C. 120).

The certificate should always be pleaded; but if the statement of claim asks for solicitor and client costs, that is probably sufficient (*Pneumatic Tyre Co.* v. *Chisholm* (1896) 13 R. P. C. at p. 489).

The fact that the defendant in the second action does not dispute the validity of the patent is no ground for refusing to give the plaintiff costs as between solicitor and client (*United Telephone Co.* v. *Townshend* (1886) 3 R. P. C. 10; *Dunlop Co.* v. *Holborn Co.* (1901) 18 R. P. C. at p. 228; *United Telephone Co.* v. *St. George* (1886) 3 R. P. C. at pp. 339, 340; *Welsbach Co.* v. *Daylight Co.* (1899) 16 R. P. C. at pp. 353, 354; *Dunlop Tyre Co.* v. *Excelsior Tyre Co.* (1901) 18 R. P. C. at p. 210; but see *Automatic Weighing Co.* v. *International Society* (1889) 6 R. P. C. at pp. 480, 481; *Boyd* v. *Tootal* (1894) 11 R. P. C. at p. 185; *Saccharin Corpn.* v. *Dowson* (1902) 19 R. P. C. at pp. 172, 173; *Edison-Bell* v. *Waterfield* (1902) 19 R. P. C. at p. 330).

Solicitor and client costs may be refused where the patent was impeached in the first action on different grounds to those on which it is impeached in the second (*Otto* v. *Steel* (1886) 3 R. P. C. at p. 120; *cf. Fabriques de Produits Chimiques* v. *Lafitte* (1899) 16 R. P. C. at p. 68; *Welsbach Co.* v. *Daylight Co.* (1899) 16 R. P. C. at pp. 354, 355); where the specification has been drawn in a lax manner (*Automatic Weighing Co.* v. *National Exhibitions* (1891) 8 R. P. C. at p. 352); where the defendant has acted innocently (*Boyd* v. *Tootal* (1894) 11 R. P. C. at p. 185); or where the action is vexatious (*Proctor* v. *Sutton* (1888) 5 R. P. C. 184).

Primâ facie, however, the plaintiff is entitled to solicitor and client costs (*Fabriques de Produits Chimiques* v. *Lafitte*, *supra*); and the Court will not certify against such costs unless it sees good reason for so doing (*Welsbach Co.* v. *Daylight Co.*, *supra*).

If several patents are sued upon, and it is impossible to say which particular patent has been infringed, and in respect of one of them a certificate as to validity has been granted in a former action, the plaintiffs will be entitled to solicitor and client costs (*Saccharin Corpn.* v. *Hopkinson* (1904) 21 R. P. C. 272).

As to *obtaining* a certificate as to validity, see p. 202, *supra*).

Costs on the Higher Scale.—Costs on the higher scale may be allowed if, on special grounds arising out of the nature and importance, or the difficulty, or urgency of the case, the Court or a Judge shall so order (R. S. C. Ord. 65, r. 9). As to such costs, generally, see the notes to Ord. 65, r. 9, contained in the Annual Practice.

Costs on the higher scale have been allowed where the case has involved a long examination, preparation of models, and the calling of expert evidence (*Wenham Co.* v. *May* (1887) 4 R. P. C. at p. 310); where "difficulty" has been removed by the expenditure of time, money, and learned industry (*Fraser* v. *Province of Brescia* (1887) 56 L. T. 771); where the case was a difficult one, and the solicitors and persons engaged in it had been put to a great deal of trouble (*Farbenfabriken* v. *Bowker* (1891) 8 R. P. C. at p. 397); where the case involved questions of a highly scientific character (*Muirhead* v. *Commercial Cable Co.* (1895) 12 R. P. C. at p. 64; and see *Moseley* v. *Victoria Rubber Co.* (1887) 4 R. P. C. at p. 255); where the case required witnesses of a special class (*Hopkinson* v. *St. James' Co.* (1893) 10 R. P. C. at p. 62; *Edison* v. *Holland* (1888) 5 R. P. C. at p. 483; *Dunlop Co.* v. *Wapshare Co.* (1900) 17 R. P. C. at 460).

The mere fact, however, that scientific witnesses were necessary is not a reason for allowing costs on the higher scale (*Tweedale* v. *Howard* (1896) 13 R. P. C. at pp. 536, 537; *Patents Exploitation* v. *American Novelty Co.* (1903) 20 R. P. C. 689). "Costs on the higher scale ought only to be given where there are cases of very unusual difficulty and skill—antiquarian research, and things of that kind. The idea of giving costs on the higher scale in all patent cases is one that I will not sanction" (*per* Lindley, L.J., in *Gadd* v. *Mayor of Manchester* (1892) 9 R. P. C. at p. 535).

If the necessity for scientific evidence was largely due to the unfortunate wording of the specification—if the specification

might have been so worded as to need no scientific evidence at all —costs on the higher scale will not be given to a successful plaintiff (*Wenham Co.* v. *Champion Co.* (1891) 8 R. P. C. at p. 320). And where the evidence is not scientific, but only evidence of fact, such costs will not usually be allowed (*American Braided Co.* v. *Thomson* (1890) 7 R. P. C. at p. 163). If, however, the plaintiffs bring scientific witnesses and so compel the defendants to do the same, the defendants may be given costs on the higher scale (*Ellington* v. *Clark* (1888) 5 R. P. C. at p. 328).

Where the defendant does not appear at the trial, costs on the higher scale will probably not be awarded (see *Perani* v. *Hudson* (1884) 1 R. P. C. at p. 263).

The Court of Appeal may allow costs on the higher scale, although such costs were refused by the Judge at the trial (*Ellington* v. *Clark* (1888) 5 R. P. C. at p. 328). But where higher scale costs are allowed at the trial, and the appeal is dismissed, the costs of the appeal will not be allowed on the higher scale (*Chamberlain* v. *Mayor of Bradford* (1902) 19 R. P. C. at p. 92).

Application that the costs be on the higher scale should be made at the hearing; but where a successful appellant at the hearing of the appeal did not ask, but subsequently moved, for such costs, they were allowed, but no order was made as to the costs of the motion (*Automatic Weighing Co.* v. *Combined Weighing Co.* (1889) 6 R. P. C. at p. 372).

Apportionment of Costs of Separate Issues.—When issues in fact and law are raised upon a claim or counter-claim, the costs of the several issues respectively, both in law and fact, unless otherwise ordered, follow the event. And an order giving a party costs except so far as they have been occasioned by some particular issue is to be construed as excluding only the amount by which the costs have been increased by such issue; but the Court, if the whole costs are not intended to be given, may direct taxation of the whole costs and payment of such proportion thereof as the Court shall determine (R. S. C. Ord. 65, r. 2, as amended by R. S. C. January, 1902, and July, 1902). As to apportionment of costs generally, see the notes to this rule contained in the Annual Practice.

The principle upon which the Court acts is that parties ought not, even if right in the action, to add to the expense of the action by fighting issues in which they are in the wrong (see *per* Bowen, L.J., in *Badische* v. *Levinstein* (1885) 2 R. P. C. at p. 118; and see *Findlater* v. *Newman* (1902) 19 R. P. C. at p. 245).

This principle has been applied where the defendant has succeeded on the issue of validity but failed on the issue of infringement (see *Badische* v. *Levinstein*, *supra*; *Hocking* v. *Fraser* (1886) 3 R. P. C. at p. 7; *Young* v. *Rosenthal* (1884) 1 R. P. C. at p. 41; *Pooley* v. *Pointon* (1885) 2 R. P. C. at p. 173; *Dunlop Co.* v. *Wapshare Co.* (1900) 17 R. P. C. at p. 458; *Lister* v. *Norton* (1886) 3 R. P. C. at p. 211; *Kane* v. *Guest* (1899) 16 R. P. C. at p. 443; *Haslam* v. *Hall* (1888) 5 R. P. C. at p. 25); and where the plaintiff has succeeded on the issue of validity but failed on the issue of infringement (see *Nordenfelt* v. *Gardner* (1884) 1 R. P. C. 61; *White* v. *Hartley* (1903) 20 R. P. C. at p. 275; *Needham* v. *Johnson* (1884) 1 R. P. C. at p. 59; *Westinghouse* v. *Lancashire, etc. Co.* (1884) 1 R. P. C. at p. 254). Also, where the plaintiff has succeeded as to an issue of threats, and failed as to the issue of infringement (*Montain* v. *Parker* (1903) 20 R. P. C. 769); and where he has succeeded on one patent and failed on another (*Brooks* v. *Lamplugh* (1898) 15 R. P. C. at p. 52; *cf. Lucas* v. *Miller* (1900) 17 R. P. C. 165).

In cases, however, where there has been a genuine contest as to infringement, a successful defendant will not usually be ordered to pay the costs of the issue of infringement (see *Kaye* v. *Chubb* (1887) 4 R. P. C. at p. 300; *Westley* v. *Perkes* (1893) 10 R. P. C. at p. 194; *Guilbert-Machin* v. *Kerr* (1887) 4 R. P. C. at p. 23; *Stohrasser* v. *Humphreys* (1900) 18 R. P. C. at p. 128).

The cost of issues raised by either party, but abandoned at the trial or on appeal, will be ordered to be paid by the party who raised them (*Thomson* v. *American Braided Co.* (1889) 6 R. P. C. 518; *Marshalls'* v. *Chameleon Patents* (1901) 18 R. P. C. 400; but see *Worthington Co.* v. *Moore* (1903) 20 R. P. C. at pp. 49, 50; *Re Scott's Patent* (1903) 20 R. P. C. at p. 264).

Where two or more patents are sued upon, and the case as to one is abandoned at the trial, the proper order is that the defendant (if unsuccessful in the action) shall pay the costs, except so far as increased by the plaintiffs' claim to the patent not relied upon, the plaintiffs to pay the increase; the action will not be dismissed with costs in so far as it is based on the patent not relied upon (*Worthington Co.* v. *Moore* (1902) 20 R. P. C. at pp. 49, 50; *Sutcliffe* v. *Abbott* (1902) 20 R. P. C. at p. 60; *cf. Brooks* v. *Lamplugh* (1898) 15 R. P. C. at p. 52; and see Ord. 65, r. 2).

Costs of Shorthand Notes.—The costs of shorthand notes of the evidence are very seldom allowed; but the costs of the notes of the judgment are frequently given (see *Morris* v. *Young* (1895)

12 R. P. C. at p. 464). Where, however, the notes of the evidence were referred to day by day in the Court below, and copies were really necessary to enable the Court to follow the arguments, the costs of all copies reasonably required were allowed by the Court of Appeal (*Castner-Kellner Co.* v. *Commercial Corpn.* (1899) 16 R. P. C. at pp. 275, 276). And where the shorthand notes enabled the Court to try the case in far less time than it might otherwise have occupied, the costs were allowed (*Palmer Tyre Co.* v. *Pneumatic Tyre Co.* (1899) 16 R. P. C. at p. 496).

Miscellaneous Costs.—The costs of a view by counsel of the works of the other party after the trial, and before the hearing of the appeal, have been allowed (*Leeds Forge Co.* v. *Deighton's Co.* (1903) 20 R. P. C. 185).

Where the Court of Appeal has not given special leave to give fresh evidence on the appeal, the costs of a witness who attends to give the evidence will not be allowed (*Leeds Forge Co.* v. *Deighton's Co., supra*).

If the defendant is a person acting in exercise of statutory or public duties, he is entitled, by virtue of the Public Authorities Protection Act, 1893, if successful, to costs as between solicitor and client (*British Thomson-Houston Co.* v. *Mayor of Manchester* (1903) 20 R. P. C. at p. 471; *Chamberlain* v. *Mayor of Huddersfield* (1901) 18 R. P. C. at p. 456). As to the class of persons who are within the Act, see *Chamberlain* v. *Mayor of Bradford* (1900) 17 R. P. C. 762; *New Conveyor Co.* v. *Edinburgh Commissioners* (1904) 21 R. P. C. 147.

As to when the costs of three counsel will be allowed, see *Dunlop Co.* v. *Wapshare Co.* (1900) 17 R. P. C. at pp. 459, 460. As to costs of obtaining expert evidence, see *Bradford Dyers* v. *Bury* (1902) 19 R. P. C. 125. As to costs of inspection and of erecting machinery at the time of the trial, see *Ashworth* v. *English Card Co.* (1904) 21 R. P. C. 353.

Stay Pending Appeal.

An appeal does not operate as a stay of execution, or of proceedings under the decision appealed from, except so far as the Court appealed from, or any Judge thereof, or the Court of Appeal, may order (R. S. C. Ord. 58, r. 16). The application to stay should be made to the Court below in the first instance (Ord. 58, r. 17).

Neither an injunction nor an account will be stayed as a rule (*Otto* v. *Steel* (1886) 3 R. P. C. at p. 121; *Chadburn* v. *Meehan*

(1895) 12 R. P. C. at p. 135; *Edison* v. *Woodhouse* (1886) 3 R. P. C. at p. 178; *Proctor* v. *Bennis* (1887) 4 R. P. C. at p. 363; *Pilkington* v. *Teakley* (1901) 18 R. P. C. at pp. 463, 464; *Hicks* v. *Simmons* (1904) 21 R. P. C. at p. 420). But an injunction and an account will sometimes be stayed on the defendant undertaking to keep an account and to prosecute the appeal with due diligence (*Kaye* v. *Chubb* (1887) 4 R. P. C. at p. 27 (injunction and account stayed); *Woodward* v. *Sansum* (1886) 3 R. P. C. at p. 366 (account stayed); *Humpherson* v. *Syer* (1887) 4 R. P. C. at p. 189 (account stayed, but stay of injunction refused); *Hocking* v. *Fraser* (1886) 3 R. P. C. at p. 7; *Duckett* v. *Whitehead* (1895) 12 R. P. C. at p. 191; *North British Co.* v. *Macintosh* (1894) 11 R. P. C. at p. 489 (injunctions stayed)).

In *Kopp* v. *Rosenwald* ((1902) 19 R. P. C. at p. 212) an inquiry as to damages was stayed. In *Howes* v. *Webber* ((1895) 12 R. P. C. at p. 470) an order for destruction was stayed. In *Washburn Co.* v. *Patterson* ((1884) 1 R. P. C. 191) an order for delivery up was stayed on the defendant undertaking that the infringing articles should not be removed out of this country pending the appeal.

A stay as to costs is very seldom granted (see *Castner-Kellner Co.* v. *Commercial Corpn.* (1898) 15 R. P. C. at p. 662; *Dick* v. *Ellam's Co.* (1899) 16 R. P. C. at p. 424; *Wolf* v. *Nopitsch* (1900) 17 R. P. C. at p. 331); the successful party's solicitor usually gives an undertaking to repay the costs if the judgment is reversed on appeal (see *Easterbrook* v. *G. W. R. Co.* (1885) 2 R. P. C. at p. 212; *Ticket Punch Co.* v. *Colley's Patents* (1895) 12 R. P. C. at p. 10). But if the solicitor refuses to give an undertaking the payment of the costs may be stayed (*Ackroyd* v. *Thomas* (1904) 21 R. P. C. at p. 412).

Appeals.

Appeals to the Court of Appeal are by way of re-hearing, and must be brought by notice of motion in a summary way. The appellant may appeal from the whole or any part of any judgment or order, and the notice of motion must state whether the whole or part only of the judgment or order is complained of, and in the latter case must specify such part (R. S. C. Ord. 58, r. 1). Where the plaintiffs appealed, and the defendants served notice that on the hearing, in the event of the Court of Appeal reversing the judgment upon a certain claim, the defendants would ask that the judgment upon a counter-claim might be reversed, the Court

of Appeal refused to set aside the notice as irregular and embarrassing (*Dunlop Co.* v. *North British Co.* (1904) 21 R. P. C. at pp. 179, 180).

No appeal lies in respect of the grant or refusal of a certificate that the validity of the patent came in question in the action (*Haslam* v. *Hall* (1888) 5 R. P. C. 144), or, without leave, in respect of costs (s. 49 of the Judicature Act, 1873). But an appeal lies from a decision as to the taxation of costs on the higher or lower scale (*Paine* v. *Chisholm* [1891] 1 Q. B. 531).

Security for Costs.—Such deposit or other security for the costs to be occasioned by any appeal must be made or given as may be directed under special circumstances by the Court of Appeal (R. S. C. Ord. 58, r. 15).

Application for security should be made promptly (*Pooley* v. *Whetham* (1886) 33 C. D. 76; *cf. Garrard* v. *Edge* (1890) 7 R. P. C. at p. 144); and application ought to be made to the appellant before moving (*Garrard* v. *Edge*, *supra*).

The order now usually made is that if the appellant does not give the required security within a fixed time the appeal shall stand dismissed. The amount of security to be given must depend upon the circumstances of each particular case; but the present practice is not to require a large amount of security. In an unreported case decided this year (*Sandow* v. *Szalay*), 20*l.* only was ordered, although the respondent's costs had already amounted to over 300*l.*, and the appellant was admittedly without means. The appeal was eventually allowed (*Sandow* v. *Szalay* (1904) 21 R. P. C. 333). 20*l.* was also ordered in the case of *Garrard* v. *Edge*, *supra*.

The insolvency of an appellant is *prima facie* a sufficient reason for ordering him to give security for costs (*per* Cotton, L.J., in *Re Ivory* (1878) 10 C. D. at p. 377; *Farrer* v. *Lacy* (1885) 28 C. D. 482). As to other grounds upon which security for costs will be required, see the notes to Ord. 58, r. 15 in the Annual Practice.

Judge's Notes.—When oral evidence taken in the Court below has to be considered on appeal, the appellant must apply for a copy of the Judge's notes, and if he does not the appeal will be ordered to stand over at the expense of the appellant (*Ellington* v. *Clark* (1889) 38 C. D. 332).

Evidence.—The Court of Appeal *may* admit evidence not given in the Court below (*Hinde* v. *Osborne* (1885) 2 R. P. C. at

p. 47) and has power to allow an amendment of the particulars for this purpose (*Shoe Co.* v. *Cutlan* (1895) 12 R. P. C. at p. 531). But the Court of Appeal is always very reluctant to allow fresh evidence (*Walker* v. *Hydro-Carbon Syndicate* (1886) 3 R. P. C. at p. 254; *Shoe Co.* v. *Cutlan, supra*; *Hinde* v. *Osborne, supra*; *Nadel* v. *Martin* (1903) 20 R. P. C. 721).

Where the defendant at the trial gives evidence of anticipations not within the particulars, and the plaintiff does not ask for an adjournment, the Court of Appeal will not allow the plaintiff to adduce fresh evidence as to such anticipations (*Barcroft* v. *Smith* (1897) 14 R. P. C. 172).

If an issue is abandoned at the trial, the Court of Appeal will not allow it to be raised on appeal (*Westley* v. *Perkes* (1893) 10 R. P. C. 382; *Hinde* v. *Osborne* (1885) 2 R. P. C. 45).

Where a model has been put in evidence at the trial, it should be produced in the Court of Appeal in the same condition as it was in at the trial; it is very improper to make any alteration whatever in its appearance or working power (*Hinby* v. *Manchester Tramways* (1891) 8 R. P. C. at p. 63).

Appeal to the House of Lords.—An appeal lies to the House of Lords from any order or judgment of the Court of Appeal.

In the absence of special circumstances a stay of execution will not be granted pending appeal to the House of Lords (see *supra*).

If persons intending to appeal to the House of Lords desire to have security for repayment of the sum they have been ordered to pay as damages, they must make out a *primâ facie* case; it must be shown that the appellant will probably not have the means of getting back the money if the House of Lords make a different order (*American Braided Co.* v. *Thomson* (1890) 7 R. P. C. at p. 163).

CHAPTER X.

Appeals to the Law Officers.

When appeals lie—Law Officers' Rules—General.

It has already been stated that from the decision of the Comptroller (1) refusing an application (see p. 33, *supra*), or (2) requiring an amendment of the application or specifications (see p. 33, *supra*), or (3) refusing leave to amend or on opposition to the amendment of the specification (see p. 85, *supra*), or (4) an opposition to the grant of a patent (see p. 54, *supra*), an appeal lies to the Law Officer.

The procedure on such appeals is governed by the Law Officers' Rules, which are as follows :—

Law Officers' Rules.

I. When any person intends to appeal to the Law Officer from a decision of the Comptroller in any case in which such appeal is given by the Acts, he shall within fourteen days from the date of the decision appealed against (*a*) 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 (*b*).

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the Law Officers' 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

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(*a*) Where the Comptroller requires an amendment, and does not in his decision settle the specific words of the amendment, the time for appealing is regarded as dating from the day of *forwarding* to the opponent a copy of the amendment approved by him (*Chandler's Patent* (1886) Griff. P. C. at p. 273).

(*b*) The effect of rules 1 and 2 is to limit the hearing before the Law Officers to points specifically raised by the notice of appeal : and where a notice of appeal is given as to part only of the Comptroller's decision, the person receiving such notice and desiring to question other parts of the decision, must give a counter-notice. If the original notice is only given just before the expiration of the fourteen days, the time for giving a counter-notice may be extended under rule 5 (*Re Bairstow's Patent* (1888) 5 R. P. C. at p. 289).

ground that a previous application for a patent for the same invention is pending, to the prior applicant (*c*).

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

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

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the Law Officers' 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 (*d*).

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 (*e*).

X. Any person requiring the attendance of a witness for

(*c*) Notice should be given to the respondent, even if he was the applicant before the Comptroller (*Re Hill's Application* (1888) 5 R. P. C. at pp. 601, 602; but see *Re Ryland's Patent* (1888) 5 R. P. C. at p. 668).

(*d*) The exception does not entitle a party to raise an additional ground of objection (*Bailey's Patent* (1884) Griff. P. C. at p. 270).

In *Re Thwaite's Patent* ((1892) 9 R. P. C. 515) leave was given to call as witnesses persons who had not made declarations when the matter was before the Comptroller. In *Huth's Patent* ((1884) Griff. P. C. 292) leave to adduce new evidence of fraud was refused.

(*e*) When it is desired to obtain an order for the attendance of declarants for cross-examination, a list of such persons should be left with the Law Officers' clerk, with a request for an order for their attendance; copies of the request and list should be sent to the other side. The Law Officer then requests the attendance of both parties before him with reference to the application, and if satisfied that an order should go, directs that summonses should be issued, which the Law Officers' clerk issues in due course (see Griff. P. C. at p. 319).

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 (*f*).

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the Law Officer, the party to whom such costs are to be paid may apply to the Law Officer for an order for payment, under the provisions of s. 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 Officers' clerk, under these Rules, may be sent by a prepaid letter through the post.

General.—After the decision of the Law Officer has been given, the matter will not be re-opened except under special circumstances, *e.g.*, in the case of fraud, a serious mistake, or miscarriage (*Re Thomas and Provost's Application* (1898) 15 R. P. C. 258).

The Law Officer may, if he thinks fit, obtain the assistance of an expert (s. 11 (4) of the Act of 1883); but it is not the practice to exercise this power (see *Re Lake's Patent* (1889) 6 R. P. C. at p. 550).

(*f*) Where there is no fresh evidence, or where there are no special circumstances, the costs generally follow the event (*Stubbs' Patent* (1884) Griff. P. C. 298; *Re Mills' Application* (1901) 18 R. P. C. at p. 324). It is not the custom of the Law Officers to give costs to such an amount as will completely indemnify the parties (*Re Stuart's Application* (1892) 9 R. P. C. at p. 453).

CHAPTER XI.

International and Colonial Arrangements.

INTERNATIONAL ARRANGEMENTS — COLONIAL ARRANGEMENTS — THE CONVENTION—THE APPLICATION.

International Arrangements.—S. 103 (1) of the Patents Act, 1883, as amended by s. 6 of the Patents Act, 1885, and s. 1 (1) of the Patents Act, 1901, provides that if (His) Majesty is pleased to make any arrangement with the Governments of any foreign 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 in priority to other applicants, and such patent shall have the *same date* as the date of the application in such foreign State: Provided that his application is made within *twelve months* from his applying for protection in the foreign State with which the arrangement is in force.

The publication in this country, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, does not invalidate the patent which may be granted for the invention (s. 103 (2)). But the patentee is not entitled to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification (s. 103 (1)).

The provisions of s. 103 apply only in the case of those foreign States in respect to which His Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State (s. 103 (4)).

Colonial Arrangements.—Where the Legislature of any British Possession has made satisfactory provision for the protection of inventions patented in this country, His Majesty may from time to time by Order in Council apply the provisions of s. 103, with such variations or additions as to His Majesty in Council may seem fit, to such British Possession (s. 104 (1), *ibid.*). The Order in Council takes effect as if the provisions had been contained in

the Act; but it may be revoked by His Majesty in Council (s. 104 (2), *ibid.*).

The Convention.—By Order in Council dated the 26th June, 1884, the provisions of s. 103 were applied to the countries then signatories to the Convention. The Convention was amended at a conference on the 14th December, 1900. A copy of the Convention (published by Messrs. Eyre & Spottiswoode) may be purchased for 2*d.* The following are the most important points:—

(1) The subjects of each of the contracting States enjoy in all other States the same advantages that their respective laws grant to their own subjects (Art. 2).

(2) Any person who has applied for a patent in one of the contracting States enjoys, as regards registration in the other States, a right of priority for a term of twelve months. Consequently, subsequent registration in any of the other States before expiry of this period is not invalidated through another registration, or by publication or user of the invention during the interval (Art. 4).

(3) The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States does not entail forfeiture; but the patentee remains bound to work his patent in conformity with the laws of the country into which he introduces the patented objects (Art. 5).

An International Office in connection with the Convention has been established at Berne, Switzerland, which publishes a monthly periodical, entitled "La Propriété Industrielle."

The States now parties to the Convention are set out in a circular ("Instructions to Applicants for Patents") published by the Patent Office and issued gratis.

The Application.—Every Convention application must be made within twelve months from the date of the first foreign application (Patents Rules, 1903, Rule 13; s. 1 (1) of the Patents Act, 1901).

The application must be on Form A. 2, and it must—

(*a*) Be accompanied by a complete specification (Rule 13, *ibid.*; s. 1 (2), *ibid.*).

(*b*) Be accompanied by a copy or copies of the specification, and drawings or documents filed or deposited by the applicant in the Paten Office of the foreign State or British Possession in respect of the first foreign application, duly certified by the official chief or

head of the Patent Office of such foreign State or British Possession, or otherwise verified to the satisfaction of the Comptroller (Rule 14, *ibid.*); and

(c) Be signed by the person or persons by whom the first foreign application was made, or, if such person or any of such persons be dead, by the legal representative of the deceased, as well as by the other applicants, if any (Rule 13, *ibid.*).

If any specification or other document relating to the application is in a foreign language, a translation must be annexed and verified by statutory declaration or otherwise to the satisfaction of the Comptroller (Rule 14, *ibid.*).

If the complete specification left with the application is not accepted within twelve months from the date of the first foreign application, it is open to public inspection at the expiration of that period (Rule 15, *ibid.*; s. 1 (2) of the Act of 1901).

Except as above mentioned, and as to dating (see p. 37, *supra*), and to the payment of renewal fees (see p. 38, *supra*), all proceedings in connection with a Convention application are taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications (Rule 16, *ibid.*).

A corporation can apply under s. 103 (*Re Carez's Application* (1889) 6 R. P. C. 552; "Instructions to Applicants for Patents," issued by the Patent Office).

If a foreign patentee obtains a patent here in the ordinary way and not on Form A. 2, *i.e.*, not under s. 103, he cannot have his patent ante-dated (*British Tanning Co.* v. *Groth* (1891) 8 R. P. C. at pp. 121, 122; and see *Acetylene Co.* v. *United Alkali Co.* (1903) 20 R. P. C. at p. 167).

A patent under the Convention can only be granted to the person who has made the foreign application; an application for an invention communicated from abroad cannot be made under s. 103; it must be on Form A. 1, and cannot be dated back (*Re Shallenberger's Application* (1889) 6 R. P. C. 550; *Re Carez's Application*, *supra*).

CHAPTER XII.

Patent Agents.

WHAT THINGS MAY BE DONE THROUGH AGENTS—WHO MAY BE REGISTERED—PENALTIES—PATENT AGENTS RULES.

With the exception of the signing of the following documents, namely:

(1) Applications for patents;
(2) Requests for leave to amend applications, specifications, or letters patent;
(3) Authorizations of agents;
(4) Notices of oppositions;
(5) Requests for issue of duplicate letters patent; and
(6) Notices of abandonment of or of intention not to proceed with applications, surrenders of letters patent, and petitions for compulsory licences and revocation of letters patent—

all communications to the Comptroller under the Acts and Rules may be signed by, and all attendances on the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so requires, resident in the United Kingdom or the Isle of Man (Patents Rules, 1903, Rule 81).

The Comptroller is not bound to recognise as an agent or to receive further communications from any person whose name, by reason of disgraceful professional conduct, has been erased from the Register of Patent Agents, and not since restored. And in any particular case, the Comptroller may require the personal signature or presence of an applicant, opponent, or other person (Rule 81, *ibid.*).

Who is Entitled to be Registered as a Patent Agent.—A person is not 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 pursuant to the Act of 1888 (s. 1 (1) of the Patents Act, 1888).

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, is entitled to be registered (s. 1 (3), *ibid.*). No other person is entitled to be registered unless 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 of Patent Agents from time to time prescribe.

Penalty for Practising when not Registered.—If any person knowingly describes himself as a patent agent in contravention of the section, he is liable, on summary conviction, to a fine not exceeding 20*l.* (s. 1 (4), *ibid.*).

An unregistered person may describe himself as a "patent expert" without committing any offence (*Graham* v. *Eli* (1898) 15 R. P. C. 259).

If a person who has *bonâ fide* practised as a patent agent prior to the passing of the Act continues to describe himself as a patent agent without being *actually* registered, he commits an offence (*Starey* v. *Graham* (1899) 16 R. P. C. 106).

A person who fails to pay the registration fee or his annual fee can be struck off the register; and if he continues to practise may be convicted under the section (*Chartered Institute of Patent Agents* v. *Lockwood* (1894) 11 R. P. C. 374).

Register of Patent Agents Rules.—The Board of Trade may from time to time make such general rules as are, in their opinion, required for giving effect to the section (s. 1 (2), *ibid.*), and the rules so made are as effectual as if they were contained in an Act of Parliament (see *Chartered Institute of Patent Agents* v. *Lockwood* (1894) 11 R. P. C. 374).

The Register of Patent Agents Rules, 1889, as amended by the Register of Patent Agents Rules, 1891, are the Rules now in force and are as follows:—

1. A Register shall be kept by the **Chartered Institute of Patent Agents** (*a*) 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.

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

(*a*) The words in heavy type are alterations effected by the Rules of 1891.

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.

3. **In the month of February in each year, and at such other times as the Chartered Institute of Patent Agents may think desirable, the said Chartered Institute shall cause a correct copy of the Register to be printed under their direction, and placed on sale.** A copy of the Register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the Register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act.

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.

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.

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.

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.

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.

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.

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.

11. The Registrar shall erase from the Register the name of any registered person who is dead.

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 purpose of this Rule, be deemed to have ceased to practise, and his name may be erased accordingly.

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.

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.

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.

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 opportunity of defending himself from, any charge brought against him.

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 such 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.

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.

19. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board of Trade.

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.

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.

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.

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.

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.

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.

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.

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.

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.

29. In these Rules, unless the context otherwise requires—

"The Act" means the Patents, Designs, and Trade Marks Act, 1883.

"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.

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 Acts, 1835.

Declared at

APPENDIX B (*a*).

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 first public examination before Moderators at Oxford.

(*a*) As altered by the Rules of 1891.

4. The previous examination at Cambridge.

5. The examination in Arts for the second year at Durham.

6. The examination for first-class certificate of the College of Preceptors (40 & 41 Vict. c. 25, s. 10).

7. The examination resulting in the obtaining of a Whitworth Scholarship.

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

APPENDIX.

FEES PAYABLE IN CONNECTION WITH PATENTS.

	£	s.	d.	£	s.	d.
On application for provisional protection .	1	0	0			
On filing complete specification . .	3	0	0			
				4	0	0
or						
On filing complete specification with first application .				4	0	0
On appeal from Comptroller to Law Officer. By appellant				3	0	0
On notice of opposition to grant of patent. By opponent				0	10	0
On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
On application to amend specification :—						
Up to sealing. By applicant				1	10	0
After sealing. By patentee				3	0	0
On notice of opposition to amendment. By opponent				0	10	0
On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
On application to amend specification during action or proceeding. By patentee				3	0	0
On application to the Board of Trade for a compulsory licence. By person applying				1	0	0
On opposition to grant of compulsory licence. By opponent				1	0	0
On certificate of renewal :—						
Before the expiration of the 4th year from the date of the patent and in respect of the 5th year . .				5	0	0
Before the expiration of the 5th year from the date of the patent and in respect of the 6th year . .				6	0	0
Before the expiration of the 6th year from the date of the patent and in respect of the 7th year . .				7	0	0

	£	s.	d.
Before the expiration of the 7th year from the date of the patent and in respect of the 8th year . .	8	0	0
Before the expiration of the 8th year from the date of the patent and in respect of the 9th year . .	9	0	0
Before the expiration of the 9th year from the date of the patent and in respect of the 10th year . .	10	0	0
Before the expiration of the 10th year from the date of the patent and in respect of the 11th year . .	11	0	0
Before the expiration of the 11th year from the date of the patent and in respect of the 12th year . .	12	0	0
Before the expiration of the 12th year from the date of the patent and in respect of the 13th year . .	13	0	0
Before the expiration of the 13th year from the date of the patent and in respect of the 14th year . .	14	0	0
On enlargement of time for payment of renewal fees:—			
Not exceeding one month	1	0	0
,, two months	3	0	0
,, three months	5	0	0
For every entry of an assignment, transmission, agreement, licence, or extension of patent . . .	0	10	0
For duplicate of letters patent . . . . each	2	0	0
On notice to Comptroller of intended exhibition of a patent under section 39	0	10	0
Search or inspection fee . . . . each	0	1	0
For office copies . . . . every 100 words (but never less than one shilling)	0	0	4
For office copies of drawings, cost according to agreement			
For certifying office copies, MSS. or printed . each	0	1	0
On postal request for printed specification . . .	0	0	8
On request to Comptroller to correct a clerical error:—			
Up to sealing	0	5	0
After sealing.	1	0	0
For certificate of Comptroller under section 96 . .	0	5	0
For altering address in register	0	5	0
For enlargement of time for filing complete specification, not exceeding one month	2	0	0
For enlargement of time for acceptance of complete specification:—			
Not exceeding one month	2	0	0
,, two months	4	0	0
,, three months	6	0	0

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

[NOTE.—*The parts of the Act which have been repealed are here omitted; amendments made by subsequent Acts are printed in heavier type. The Act of* 1902 *is printed separately, and the parts of that Act which have not yet come into operation are not noted here.*]

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.

BE IT ENACTED, etc.:

PART I.

PRELIMINARY.

1. This Act may be cited as "The Patents, Designs, and Trade Marks Act, 1883."

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.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the 31st day of December, 1883.

PART II.

PATENTS.

Application for and Grant of Patent.

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

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

Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of them 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. [*Act of* 1885, *s.* 5.]

5. (1) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(2) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed. [*Act of* 1885, *s.* 2.]

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

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

The requirement of (this sub-section) as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification. [*Act of* 1886, *s.* 2.]

(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.

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.

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

invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

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

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

"(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

"(5) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon." [*Act of* 1888, s. 2.]

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.

A complete specification may be left within such extended time, not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow. [*Act of* 1885, s. 3.]

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

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

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

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

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

A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the comptroller may on payment of the prescribed fee allow. [*Act of* 1885, *s.* 3.]

(5) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding [*see Act of* 1888, *s.* 3], 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.

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.

11. (1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, **or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification** [*Act of* 1888, *s.* 4], 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.

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

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

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

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

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. [*Act of* 1885, *s.* 3.]

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.

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. [*Act of* 1885, *s.* 4.]

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.

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

Patent.

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

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.

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) 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. [*S. 5 of the Patents Act*, 1888.]

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.

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.

21. Every amendment of a specification shall be advertised in the prescribed manner.

Compulsory Licences.

22. [*Repealed by s. 3 of the Act of* 1902.]

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 authorized 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.

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.

25. (1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to Her Majesty in Council, praying that his patent may be extended for a further term: but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2) Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension.

(3) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

(4) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for Her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6) It shall be lawful for Her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

Revocation.

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 authorized 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.

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.

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.

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.

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.

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 a judge trying the action certifies that he ought not to have the same.

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.

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.

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.

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.

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.

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.

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.

39. [*Set out in full on p.* 13, *supra.*]

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. [*Act of 1886, s. 3.*]

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.

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.

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.

43. (1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connexion 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 authorize 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.

44. [*Set out in full on pp.* 95–96, *supra.*]

Existing Patents.

45. [*Provisions respecting patents granted before the commencement of the Act of* 1883.]

Definitions.

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."

PART III.

[DESIGNS.—*Ss.* 47–61.]

PART IV.

[TRADE MARKS.—*Ss.* 62–81.]

PART V.

GENERAL.

Patent Office and Proceedings thereat.

82. (1) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(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 [*see Act of* 1902, *s.* 4] be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

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.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

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.

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.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design, or trade mark as the case may be, shall, subject to **the provisions of this Act and to** [*Act of* 1888, *s.* 21] any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to **the provisions of this Act and to** [*Act of* 1888, *s.* 22] 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.

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.

90. (1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person **or of any other particulars** [*Act of* 1888, *s.* 23] 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.

91. The comptroller may, on request in writing accompanied by the prescribed fee—

(*a*) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or,

(*b*) Correct any clerical error in the name, style or address of the registered proprietor of a patent, design or trade mark. (*a*)

92. [*This section, and s.-s.* (*c*) *of s.* 91, *refer to trade marks.*]

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the

applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

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.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized 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.

97. (1) Any application, notice, or other document authorized or required to be left, made or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

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.

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 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.

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.

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

(*a*) For regulating the practice of registration under this Act;

(*b*) For classifying goods for the purposes of designs and trade marks;

(*c*) For making or requiring duplicates of specifications, amendments, drawings, 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.

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.

102a. (1) All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized 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. [*Act of* 1888, *s.* 25.]

International and Colonial Arrangements.

103. (1) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for

protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the **date of the application** [*Act of* 1885, *s.* 6] in such foreign state.

Provided that his application is made, in the case of a patent within **twelve** [*Act of* 1901, *s.* 1 (1)] months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

An application under this section shall be accompanied by a complete specification, which, if it be not accepted within the period of twelve months, shall, with the drawings (if any), be open to public inspection at the expiration of that period [*s.* 1 (2) *of the Act of* 1901].

(2) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark:

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

104. (1) Where it is made to appear to Her Majesty that the

legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

105. (1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

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 connexion 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; etc.

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.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

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.

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.

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.

112. This Act shall extend to the Isle of Man, and—

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts;

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or

without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal; Transitional Provisions; Savings.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*a*) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(*b*) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(*c*) Take away or abridge any protection or benefit in relation to any such action or proceeding.

114. (1) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

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.

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

General Definitions.

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 possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, ETC.

Form A. Form of Application for Patent [see p. 292, *infra*].
Form B. Form of Provisional Specification [see p. 294, *infra*].
Form C. Form of Complete Specification [see p. 294, *infra*].
Form D. Form of Patent.

THE SECOND SCHEDULE.

[*Scale of Fees; but see now the Fees prescribed by the Board of Trade*, p. 239, *supra*.]

THE THIRD SCHEDULE.

[*Enactments Repealed.*]

PATENTS, DESIGNS, AND TRADE MARKS (AMENDMENT) ACT, 1885.

48 & 49 VICT. c. 63.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

BE IT ENACTED, etc.:

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.

2. Whereas sub-section 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 sub-section 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 sub-section 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.

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.

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 connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

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.

6. In sub-section 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 & 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.*

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, etc.:

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.

2. The requirement of sub-section 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.

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, DESIGNS, AND TRADE MARKS ACT, 1888.

51 & 52 VICT. c. 50.

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:

BE IT THEREFORE ENACTED, etc.—

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.

2. For section seven of the principal Act the following section shall be substituted, namely—[*The section is set out on pp.* 242, 243, *supra.*]

3. In sub-section five of section nine of the principal Act the words "other than an appeal to the law officer under this Act" shall be omitted.

4. In sub-section 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 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."

5. For sub-section ten of section eighteen of the principal Act the following sub-section 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."

6—20. [*These sections relate to designs and trade marks.*]

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."

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."

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."

24. To section ninety-one of the principal Act the following sub-section shall be added; namely—

"(*d*) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered."

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 authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

"(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized 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."

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely—

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

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.

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.

PATENTS ACT, 1901.

1 Ed. VII. c. 18.

An Act to amend the law with reference to International Arrangements for Patents.

Be it Enacted, etc.:

1. (1) In the first proviso to sub-section one of section 103 of the Patents, Designs, and Trade Marks Act, 1883 (which section relates to the time for making applications for protection under international arrangements), the words "twelve months" shall be substituted for the words "seven months."

(2) An application under that section shall be accompanied by a complete specification, which, if it be not accepted within the period of twelve months, shall, with the drawings (if any), be open to public inspection at the expiration of that period.

2. (1) This Act may be cited as the Patents Act, 1901, and may be cited and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

(2) This Act shall come into operation on the first day of January, 1902.

PATENTS ACT, 1902.

2 EDW. VII. c. 34.

An Act to amend the law with reference to Applications for patents and compulsory licences, and other matters connected therewith.

BE IT ENACTED, etc.

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

S. 1 of the Act is only to come into operation at such date as the Board of Trade may by order direct (see sub-s. 11). At the present time, no search is made as to novelty (see p. 34, *supra*).

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

As to amendments generally, see p. 79, *supra*.

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

(4) The provisions of sub-section 5 of section 9 of the principal

Act, as amended by any subsequent enactment, shall apply to reports under this section.

Sub-s. 5 provides that reports of examiners shall not be published unless the Court certifies that their production or inspection is desirable in the interests of justice (see p. 244, *supra*).

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

"PREVIOUS SPECIFICATION AS BEFORE MENTIONED."—This means any specification (other than a provisional not followed by a complete) published before the date of the application, and deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

"ANY OTHER LAWFUL GROUND."—As to the other grounds upon which the Comptroller may refuse to accept a specification, see pp. 32, 33, *supra*.

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

(7) An appeal shall lie from the decision of the Comptroller under this section to the Law Officer.

As to the procedure on appeals to the Law Officer, see p. 224, *supra*.

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

S. 8 of the principal Act provides that a complete specification may be left at any time within nine months from the date of the application (see p. 243, *supra*). S. 3 of the Act of 1885 provides for extension of time for leaving and accepting the specification (see p. 267, *supra*). When s. 1 of the Act of 1902 comes into operation, the period of provisional protection will be reduced to six months.

(9) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade

The Board of Trade, in pursuance of sect. 1 (11) of the Patents Act, 1902, have fixed the 1st January, 1905, as the date for the coming into operation of sect. 1 of that Act. The note to sub-sect. 11 on p. 277 must, therefore, be read accordingly.

The Patents Rules, 1903, have been added to the work, and will be found after p. 308. They govern the procedure under sect. 1 of the Act of 1902, and substitute new rules for Rules 9, 17, and 18 to 24 of the Patents Rules, 1903. The new rules do not however come into operation until the 1st January, 1905.

or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon.

Notwithstanding the investigation by the Examiner, a patent will still be bad by reason of publication of the invention in a prior specification (except a specification deposited pursuant to an application made in the United Kingdom not less than fifty years before the date of the application; see s. 2), or by reason of any other prior publication (see p. 8, *supra*) or of prior user (see p. 14, *supra*).

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

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

No order has yet been made. It is probable, however, that the Patent Office will be in a position to undertake the great amount of extra work involved, and that the order will be made some time during next year.

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

3. Section 22 of the principal Act (relating to the grant of compulsory licences by the Board of Trade) is hereby repealed, and the following provisions shall be substituted therefor:—

(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

Under s. 22 the grounds were that: (1) The patent was not being worked in the United Kingdom; (2) the reasonable requirements of the public with respect to the invention could not be supplied; (3) some person was prevented from working or using to the best advantage an invention of which he was possessed. And the jurisdiction to order the grant of licences was vested in the Board of Trade. It is conceived that the decisions under that section will be of little or no value in proceedings under the new Act, and they are not, therefore, referred to in the text (see p. 102, *supra*).

For the Rules of the Board of Trade and of the Judicial Committee under this section, see pp. 103–107, *supra*; for Form of Petition, see p. 296, *infra*.

Revocation can only be prayed for *in the alternative;* if revocation solely is desired, proceedings must be taken in the High Court in the ordinary way. And a licence will not be ordered if the reasonable requirements of the public will not be satisfied by the grant of a licence.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves, the Board of Trade, if satisfied that a *primâ facie* case has been made out, shall refer the petition to the Judicial Committee of the Privy Council, and, if the Board are not so satisfied, they may dismiss the petition.

See the rules made hereunder by the Board of Trade, p. 103, *supra*.

(3) Where any such petition is referred by the Board of Trade to the Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licences on such terms as the said Committee may think just, or, if the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by Order in Council.

Provided that no order of revocation shall be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section, the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the Law Officer, or such other counsel as he may appoint, shall be entitled to appear and be heard.

(5) If it is proved to the satisfaction of the Judicial Committee that the patent is worked, or that the patented article is manufactured, exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public have been satisfied, the petitioner shall be entitled either to an order for a compulsory licence or, subject to the above proviso, to an order for the revocation of the patent.

(6) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied, if by reason of the default of the patentee to work his patent, or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, (*a*) any

existing industry or the establishment of any new industry is unfairly prejudiced, or (*b*) the demand for the patented article is not reasonably met.

(7) An Order in Council directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

(8) His Majesty in Council may make rules of procedure and practice for regulating proceedings before the Judicial Committee under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council, or any order made by the Judicial Committee under this Act, may be enforced by the High Court as if it were an order of the High Court.

For the Rules made hereunder, see p. 104, *supra*.

(9) The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but, in awarding costs on any application for the grant of a licence, the Judicial Committee may have regard to any previous request for, or offer of, a licence made either before or after the application to the Committee.

(10) For the purposes of this section, three members of the Judicial Committee shall constitute a quorum.

(11) This section shall apply to patents granted before, as well as after, the commencement of this Act.

4. In sub-section 4 of section 82 of the principal Act (which relates to the performance of the duties of the Comptroller by other officers under the direction of the Board of Trade) the words "in his absence" shall be repealed.

5. This Act may be cited as the Patents Act, 1902, and may be cited, and shall be construed, as one with the Patents, Designs, and Trade Marks Acts, 1883 to 1901.

PATENTS RULES, 1903.

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

Short Title.

1. These Rules may be cited as the Patents Rules, 1903.

Commencement.

2. These Rules shall come into operation from and immediately after the 12th day of January, 1903.

Interpretation.

3. In the construction of these Rules—

"United Kingdom" includes the Isle of Man;

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

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

Save as aforesaid any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

Fees.

4. The fees to be paid under the said Acts shall be those specified in the list of fees in the First Schedule to these Rules (see p. 239, *supra*).

Forms.

5. The Forms contained in the Second Schedule to these Rules (see pp. 292–302, *infra*) may, as far as they are applicable, be used in any proceedings under the said Acts or under these Rules and so far as they relate to the same subject-matter shall be substituted for the forms in the First Schedule to the Act of 1883.

Applications for Patents.

6. In the case of an application for a patent by the legal representative of a person who has died possessed of an invention (see p. 30), the probate of his will, or the letters of administration granted of his estate and effects, or an official copy of such probate or letters, shall be produced at the Patent Office in proof of the applicant's title as such legal representative and must be supported by such further evidence as the Comptroller may require.

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

8. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

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

9. Where a person making application for a patent includes in his specification by mistake, inadvertence, or otherwise, more than one invention (see p. 32), he may, with the consent of the Comptroller, at any time before the date allowed for the acceptance of his complete specification, amend the same so as to apply to one invention only, and may make application for a separate patent for each such invention accordingly. Every such application shall, if the applicant notify his desire to that effect to the Comptroller, bear the date of the first application and shall, together therewith, be proceeded with in the manner prescribed by the said Acts and by these Rules, as if every such application had been originally made on that date.

10. An application for extension of time for leaving or accepting a complete specification shall be made on Form U. (see p. 301) or on Form V. (see p. 302), as the case may require, and shall state in detail in what circumstances and upon what grounds such extension is applied for, and the Comptroller may require the

applicant to substantiate such allegations by such proof as the Comptroller may think necessary.

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

12. Upon such acceptance in the case of a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

Applications under the International Convention.

13. Every Convention application (see p. 226) shall contain a declaration that foreign application has been made for protection of the invention to which such Convention application relates, and shall specify all the foreign States or British Possessions in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a complete specification, and signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons be dead, the application must be signed by the legal representative of such dead person, as well as by the other applicants, if any.

14. Every Convention application, in addition to the specification left therewith, must be accompanied by a copy or copies of the specification, and drawings or documents filed or deposited by the applicant in the Patent Office of the foreign State or British Possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign State or British Possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

15. If the complete specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall, with the drawings, if any, be open to public inspection at the expiration of that period.

16. Save as aforesaid and as provided by Rule 52 all proceedings in connection with a Convention application shall be taken

within the times and in the manner prescribed by the said Acts or these Rules for ordinary applications.

Size, etc., of Documents.

17. All documents and copies of documents, except drawings, sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in the English language (unless otherwise directed) in large and legible characters upon strong paper and, except in the case of statutory declarations and affidavits, on one side only, of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signatures thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

Drawings Accompanying Specifications.

[*Rules* 18–24 *are set out in full on pp.* 65, 66, *supra*.]

25, 26, 27. [*These rules have been omitted in error, and are printed at the end of the work* (*see p.* 306, *infra*).]

Exercise of Discretionary Powers by the Comptroller.

28. Before exercising any discretionary power given to the Comptroller by the said Acts or these Rules adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.

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

30. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

31. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and to any other person who appears to him to be affected thereby.

Opposition to Grants of Patents (see p. 40).

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

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

34. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, the Comptroller may request or allow any person who has made a statutory declaration in the matter to which the opposition relates to attend before him at the hearing of the case and make oral explanations with respect to such matters as the Comptroller may require.

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

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

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

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

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

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

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

Amendment of Specification (see p. 79).

42. A request for leave to amend a specification must be signed by the applicant and shall contain an address for service in the United Kingdom. When not made in pursuance of an order of the Court or a Judge the request must, where a patent has been sealed, also contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. The request must be accompanied by a duly certified

copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.

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

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

45. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

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

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

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

49. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 17 to 23.

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

REGISTER OF PATENTS (see p. 107).

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

52. The patent granted on any Convention application (see p. 227) shall be entered in the Register as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

53. If a patentee send to the Comptroller on Form R. (see p. 300) notice of an alteration in his address, the Comptroller shall cause the Register to be altered accordingly, and may require the altered address to be in the United Kingdom.

54. Where a person becomes entitled to a patent or to any share or interest therein, by assignment, or by transmission, or other operation of law (see p. 108), a request for the entry of his name in the Register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

55. Such request shall be on Form L. (see p. 298) and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by its agent, authorised in like manner.

56. Every such request shall state the name, address, and calling of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be, and the particulars of the assignment, transmission, or other operation of law, by virtue of which he claims to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

57. Every assignment, and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the request, and such other proof 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.

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

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

60. Where an order has been made by His Majesty in Council for the extension of a patent for a further term or for the grant of a new patent (see p. 137), or where an order has been made for the revocation of a patent (see p. 114), or the rectification of the Register under section 90 of the Act of 1883 (see p. 111), 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.

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

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

63. An attested copy of every licence granted under a patent, or of any other document purporting to affect the proprietorship of a patent shall be left at the Patent Office with a request on Form M. (see p. 299), that a notification thereof may be entered in the Register. The accuracy of such copy shall be certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Patent Office if required for further verification.

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

(*a*) Christmas Day, Good Friday, the day observed as His Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

(*b*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(c) Times when the register is required for any purpose of official use.

65. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

Payment of Fees for Continuance of Patent.

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

The Form J. (see p. 298) in the Second Schedule, duly stamped, should be used for the purpose of this payment.

67. An application for an enlargement of the time for making a prescribed payment (see Form K., p. 298) 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.

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

Compulsory Licences and Revocation of Patents.

[*Rules* 69—75 *are set out in full on pp.* 103, 104, *supra.*]

General.

76. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

77. The times prescribed by these Rules for doing any act, or taking any proceeding thereunder, other than the times for lodging evidence referred to in Rule 33 or in the procedure in these Rules

relating to compulsory licences and revocation of patents, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

78. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

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

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

80. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Agency.

81. With the exception of the signing of the following documents, namely, applications for patents, requests for leave to amend applications, specifications, or letters patent, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, notices of abandonment of or of intention

not to proceed with applications, surrenders of letters patent, and petitions for compulsory licence and revocation of patent, all communications to the Comptroller under the said Acts and these Rules may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require it, resident in the United Kingdom. The Comptroller shall not be bound to recognise as such agent, or to receive further communications from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct has been erased from the register of patent agents, kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, and not since restored. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

Repeal.

82. All general Rules relative to patents heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1901, and in force on the 12th day of January, 1903, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application or other matter then pending.

Dated the 12th day of January, 1903.

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

THE FIRST SCHEDULE.

[*List of Fees payable in connection with Patents; see* p. 239, *supra.*]

THE SECOND SCHEDULE.

[*Forms; see pp.* 292-302, *infra.*]

THE OFFICIAL FORMS.

[*Prescribed by the Board of Trade and contained in the Second Schedule to the Patents Rules*, 1903.]

Form A. (see p. 28, *supra*).

Application for Patent for Original Invention.

[*To be accompanied by two copies of Form B. or of Form C.*]

I [*or* We] [*name, address, and calling of applicant or applicants, in full*] do hereby declare that I am [*or* we are] in possession of an invention the title of which is [*title*]; that [*in case of joint applicants state whether all, or, if not, who is or are the inventor or inventors*] claim to be true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my [*or* our] knowledge and belief; and I [*or* we] humbly pray that a Patent may be granted to me [*or* us] for the said invention.

Dated —— day of ——, 19—.

[*Signature of applicant or applicants.*]

Note.—One of the two next forms (which are printed on the back of the application), or a separate authorisation of agent, should be signed by the applicant or applicants.

(1) *Where Application is made through an Agent.*

I [*or* We] hereby appoint [*agent*], of ——, to act as my [*or* our] Agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

—— day of ——, 19—.

[*Signature of applicant or applicants.*]

(2) *Where application is made without an Agent.*

I [*or* We] hereby request that all notices, requisitions, and communications in respect of the within application may be sent to —— at ——.

—— day of ——, 19—.

[*Signature of applicant or applicants.*]

Form A1. (see p. 28, *supra*).

Application for Patent for Invention Communicated from Abroad.

[*To be accompanied by two copies of Form B. or of Form C.*]

I [*name, address, and calling of applicant, in full*] of ——, in the county of ——, do hereby declare that I am in possession of an invention, the title of which is [*title*], which invention has been communicated to me by [*name, address, and calling of communicator*]; that I claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my knowledge and belief; and I humbly pray that a Patent may be granted to me for the said invention.

Dated —— day of ——, 19—.

[*Signature of applicant or applicants.*]

NOTE.—One of the two forms printed on the back of the application (see p. 292, *supra*), or a separate authorisation of agent, should be signed by the applicant.

Form A2. (see p. 228, *supra*).

Application for Patent under International and Colonial Arrangements.

I [*or* We] [*name, address, and calling of applicant or applicants, in full*] do hereby declare that I [*or* we] have made applications for protection of my [*or* our] invention of [*title*] in the following foreign States, and on the following official dates, viz.: [*name of each State and official date of each application*]; and in the following British Possessions and on the following official dates, viz.: [*name of each British Possession and official date of each application*]: 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 [*official date of earliest foreign application*] to the best of my [*or* our] knowledge, information, and belief, and I [*or* we] humbly pray that a patent may be granted to me [*or* us] for the said invention in priority to other applicants, and that such patent shall have the date [*date of earliest foreign application*].

[*Signature of applicant or applicants.*]

NOTE.—If the application be made through an agent, a proper authorisation should be supplied; if not, an address for service to which communications may be sent should be furnished.

Form B. (see p. 56, *supra*).

Provisional Specification.

[*To be furnished in Duplicate, and issued with Form A. or A1.*]

[*Title; verbally agreeing with that in the Application Form.*]

I [*or* We] [*name, address, and calling of applicant or applicants as in application form*] do hereby declare the nature of this invention to be as follows:—[*nature of invention*].

Dated this —— day of ——.

[*Signature.*]

Form C. (see p. 58, *supra*).

Where Provisional Specification has been left quote No. and date.
No. ——.
Date ——.

Complete Specification.

[*To be furnished in Duplicate—one unstamped.*]

[*Title; verbally agreeing with that in the application form.*]

I [*or* We] [*name, address, and calling of applicant or applicants as in application form*] 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: [*nature of invention and mode of performing it*].

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:—[*claim or claims numbered consecutively*].

Dated this —— day of ——.

[*Signature.*]

Form C1.

Postal Request for Printed Specification.

To the Comptroller-General.

Please send one copy of Specification, No. —— Year —— to——.

[*Name (in full) and address.*]

Form D. (see p. 40, *supra*).

Form of Opposition to Grant of Patent.

I [*name and address, in full*] hereby give notice of my intention to oppose the grant of Letters Patent upon application No. —— of ——, applied for by —— upon the ground [*see pp.* 40–48, *supra*].

[*Signature of opponent.*]

My address for service in the United Kingdom is ——.

To the Comptroller.

Form E. (see pp. 53, 84, *supra*).

Form of Notice that Hearing before the Comptroller will be Attended.

[*Opposition to the Grant or to Amendments.*]

SIR,

I, of —— hereby give notice that the hearing in reference to —— will be attended by myself or by some person on my behalf.

Your obedient servant,

[*Signature.*]

To the Comptroller.

Form F. (see p. 79, *supra*).

Form of Application for Amendment of Specification.

I [*name and address of applicant or patentee, in full*] seek leave to amend the specification of Letters Patent No. —— of ——, as shown in red ink in the certified copy of the original specification hereunto annexed.

[*If the patent has been sealed and such is the case add:* I declare that no action for infringement or proceeding for revocation of the Letters Patent in question is pending.]

My reasons for making this amendment are as follows:—[*state reasons* (*see p.* 83, *supra*); *and if applicant is not the patentee, state his interest in the patent*].

[*Signature of applicant.*]

My address for service in the United Kingdom is ——.

To the Comptroller.

Form G. (see p. 83, *supra*).

Form of Opposition to Amendment of Specification.

[*To be accompanied by an unstamped copy.*]

I [*name and address of opponent, in full*] hereby give notice of objection to the proposed amendment of the specification of Letters Patent No. —— of —— for the following reason :—[*state reason ; see p.* 83, *supra*].

[*Signature of opponent.*]

My address for service within the United Kingdom is ——.

To the Comptroller.

Form H. (see p. 102, *supra*).

Form of Application for Grant of Compulsory Licence or Revocation.

[*To be accompanied by an unstamped copy.*]

I [*name and address of applicant, in full*] 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 [*name and address of patentee, and number and date of his patent*].

[*Signature of petitioner.*]

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.

Form H1. (see p. 102, *supra*).

Form of Petition for Grant of Compulsory Licence or Revocation.

To the Lords of the Committee of Privy Council for Trade.

THE PETITION of [*name, address, and calling of petitioner, in full*] 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 [*title of invention*].

2. The nature of my interest in the matter of this petition is as follows :—[*state nature of interest*].

3. [*Statement in detail of the circumstances of the case under s.* 3 *of the Act* (*see p.* 102, *supra*), *showing that it arises by reason of the default of the patentee, or as the case may be, of any other person claiming an interest in the patent as exclusive licensee, or otherwise, to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms. The statement should give the names and addresses of any persons who are alleged to have made default. Subsequent paragraphs should be numbered consecutively.*]

The evidence which I propose to leave at the Patent Office accompanying this petition is as follows :—[*state what affidavits or statutory declarations, together with any other documentary evidence, will be left ; see Rule* 70, *and p.* 103, *supra*].

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default the reasonable requirements of the public with respect to the invention patented as above stated have not been satisfied.

Your petitioner therefore prays that an order may be made granting to him a compulsory licence on the terms following, viz. : [*state the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief,*] or that the said patent may be revoked.

[*Signature.*]

Form I. (see p. 102, *supra*).

Form of Opposition to Petition for Grant of Compulsory Licence or Revocation.

I [*name and address, in full*] hereby give notice of opposition to the petition of —— for the grant of a compulsory licence under Patent No. —— of ——, or the revocation of the said patent. The grounds upon which I oppose the said application are as follows, viz. :—[*grounds of opposition*].

[*Signature.*]

NOTE.—In pursuance of the requirements of Rule 71, copies of the affidavits or statutory declarations in reply to the evidence left with the petition must be delivered to the petitioner.

To the Comptroller.

Form J. (see p. 38, *supra*).

Application for Certificate of Payment or Renewal.

[*When stamped this Form must be sent at once to the Patent Office.*]

I hereby transmit the fee prescribed for the continuation in force of [*name of patentee*] Patent No. —— of —— for a further period of —— .

[*Name and full address.*]

To the Comptroller.

* * * * *

Certificate of Payment or Renewal.

Letters Patent No. —— of ——.

This is to certify that —— did this —— day of —— make the prescribed payment of £ —— in respect of a period of —— from —— and that by virtue of such payment the rights of the patentee remain in force.

Seal.

Form K. (see p. 39, *supra*).

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 ——.

The circumstances in which the payment was omitted are as follows:— [*state circumstances in detail; see p. 39, supra*].

I am, Sir,

Your obedient servant,

[*Signature of Applicant and full address to which receipt is to be sent.*]

To the Comptroller.

Form L.

Request to Enter Name upon the Register.

I [*name, address, and description*] hereby request that you will enter my name in the Register of Patents:

I claim to be entitled [*nature of claim, e.g., as assignee*] of the

Patent No. —— of —— granted to [*name and address of patentee*] the title of which is [*title*] by virtue of [*particulars of document, giving its date, and the parties thereto, and showing how the claim is substantiated*].

And in proof whereof I transmit the accompanying [*document*] with an attested copy thereof.

I am, Sir,

Your obedient servant,

[*Signature.*]

To the Comptroller.

Form M. (see p. 110, *supra*).

Request to Enter Notification of Licence or Other Document in the Register.

SIR,

I hereby transmit an attested copy of [*description of nature of document*] under Patent No. —— of ——, as well as the original document of verification, and I have to request that a notification thereof may be entered in the Register.

I am, Sir,

Your obedient servant,

[*Signature and full address.*]

To the Comptroller.

Form N. (see p. 39, *supra*).

Application for Duplicate of Patent.

Date ——.

SIR,

I regret to have to inform you that the patent dated [*date, number, and full name and address of grantee*] for an invention the title of which is [*title*] has been destroyed [*or* lost] [*state the circumstances, which must be verified by statutory declaration*].

I beg therefore to apply for the issue of a duplicate of such Patent.

[*Here state interest of applicant in the patent.*]

[*Signature of applicant.*]

To the Comptroller.

Form O. (see p. 13, *supra*).

Notice of Intended Exhibition of an Unpatented Invention.

I [*name and address, in full*] hereby give notice of my intention to exhibit a —— of —— at the —— Exhibition, which opened [*or* is to open] on the —— day of ——, under the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1902.

I herewith enclose a brief description of my invention [*the description should be accompanied by drawings, if necessary*].

[*Signature of inventor.*]

To the Comptroller.

Form P. (see pp. 32, 110, *supra*).

Request for Correction of Clerical Error.

SIR,

I hereby request that the following clerical error [*or* errors] in the application [*or* specification *or* register] No. —— of ——, may be corrected in the manner shown in red ink in the certified copy of the original application [*or* specification *or* register] hereunto annexed.

[*Signature and full address.*]

Form Q.

Certificate of Comptroller-General.

The Patent Office,
London, 19—.

I ——, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify——.

To [*full name and address of person requiring certificate*].

Form R. (see p. 110, *supra*).

Notice for Alteration of an Address in Register.

SIR,

I [*name and address, in full*] hereby request that my address now upon the Register may be altered as follows :—[*full address*].

I am, Sir,
Your obedient servant,
[*Signature of applicant.*]

To the Comptroller.

Form S. (see p. 107, *supra*).

Application for Entry of Order of Privy Council in Register.

I [*name and address, in full*] hereby transmit an office copy of an Order in Council with reference to [*purport of the order*].

I am, Sir,

Your obedient servant,

[*Signature of applicant.*]

To the Comptroller.

Form T. (see p. 224, *supra*).

Form of Appeal to the Law Officer.

I [*name and address, in full*] hereby give notice of my intention to appeal to the Law Officer from the decision [*or* that part of the decision] of the Comptroller of the —— day of —— whereby he refused [*or* allowed] application for Patent [*or* application for leave to amend Patent *or as the case may be*] No. —— of ——

[*Signature and date.*]

N.B.—This notice must be sent to the Comptroller-General, and a copy to the Law Officers' Clerk (Room 549), Royal Courts of Justice, Strand, London.

Form U. (see p. 30, *supra*).

Application for Extension of Time for Leaving a Complete Specification.

SIR,

I hereby, in respect of application No. ——, dated ——, apply for one month's extension of time in which to leave a complete specification.

The circumstances in and grounds upon which this extension is applied for are as follows:—[*circumstances and grounds; see p.* 30, *supra*].

I am, Sir,

Your obedient servant,

[*Signature of applicant or his agent.*]

To the Comptroller.

Form V. (see p. 35, *supra*).

Application for Extension of Time for Acceptance of a Complete Specification.

SIR,

I hereby apply for —— months' extension of time for the acceptance of the complete specification upon application No. —— dated —— .

The circumstances in and grounds upon which the extension is applied for are as follows :— [*circumstances and grounds ; see p.* 35, *supra*].

I am, Sir,

Your obedient servant,

[*Signature of applicant or his agent.*]

To the Comptroller.

PRIVY COUNCIL RULES, 1897.

Rules to be observed in proceedings before the Judicial Committee of the Privy Council under the Patents, Designs, and Trade Marks Act, 1883, *Section* 25.

1. A PARTY intending to apply by petition under section 25 of the Act shall give public notice by advertising three times in the *London Gazette* and once at least in each of three London newspapers.

If the applicant's principal place of business is situate in the United Kingdom at a distance of 15 miles or more from Charing Cross he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of 15 miles or more from Charing Cross he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no such manufacture, then, if he resides at a distance of 50 miles or more from Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

The applicant shall in his advertisements state the object of his petition and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He shall also give notice that caveats must be entered at the Council Office on or before such day so named in the said advertisements.

2. A petition under section 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.

The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the first of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

The petitioner shall apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner shall forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers.

3. A party presenting a petition under section 25 of the Act must lodge at the Council Office eight printed copies of the specification; but if the specification has not been printed and if the expense of making eight copies of any drawing therein contained or referred to would be considerable the lodging of two copies only shall be deemed sufficient.

The petitioner shall also lodge at the Council Office eight copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. He shall also furnish three copies of the said balance sheet for the use of the Solicitor to the Treasury, and shall upon receiving two days' notice give to the Solicitor to the Treasury, or any person deputed by him for the purpose reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance sheet at the hearing or from which the materials for making up the said balance sheet have been derived.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for the hearing.

4. A party intending to oppose a petition under section 25 of the Act must enter a caveat at the Council Office before the day on which the petitioner applies for a time to be fixed for hearing the matter thereof, and having entered such caveat shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

The petitioner shall serve copies of his petition on all parties entering caveats in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service.

All parties intending to oppose a petition shall within three weeks after such copies are served on them respectively lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.

5. Parties shall be entitled to have copies of all papers lodged in respect of any petition under section 25 of the Act at their own expense.

All such petitions and all statements of grounds of objection

shall be printed in the form prescribed by the Rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance sheets of expenditure and receipts shall be printed in a form convenient for binding along with such petitions.

6. Costs incurred in the matter of any petition under section 25 of the Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any petition, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

7. The Lords of the Committee may excuse petitioners and opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under section 25 of the Act as they shall consider to be just and expedient.

8. The Lords of the Committee will hear the Attorney-General or other Counsel on behalf of the Crown on the question of granting the prayer of any petition under section 25 of the Act. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Lords of the Committee.

PRIVY COUNCIL RULES, 1903.

[*These are fully set out on pp.* 104—107, *supra*.]

REGISTER OF PATENT AGENTS RULES.

[*These are fully set out on pp.* 231—238, *supra*.]

Rules 25—27 *of the Patents Rules*, 1903 (*a*).

Statutory Declarations and Affidavits.

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

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

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

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

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

Industrial or International Exhibitions.

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

(*a*) These rules were omitted, in error, from p. 283, *supra*.

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THE END.

BRADBURY, AGNEW, & CO. LD., PRINTERS, LONDON AND TONBRIDGE.

SUPPLEMENT.

PATENTS RULES, 1905.

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

Short Title.

1. These Rules may be cited as the Patents Rules, 1905.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st day of December, 1904.

Interpretation.

3. In the construction of these Rules, any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

Applications for Patents.

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

5. For Rule 9 of the Patents Rules, 1903, the following Rule shall be substituted:—

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

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

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

Where the Comptroller has required or allowed any application, specification or drawings to be amended as aforesaid, such

application shall, if the Comptroller at any time so direct, bear such date, subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

PROCEDURE UNDER SECTION 1 OF THE PATENTS ACT, 1902.

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

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

If the provisional report of the Examiner made under this Rule be not reversed or altered, it shall be deemed a final report, and the application shall be dealt with as provided by sub-section 6. If, however, such provisional report be reversed or altered, the investigation prescribed by sub-section 1 shall be continued, and a further report shall be made to the Comptroller, and the specification shall be dealt with as provided in sub-section 5 or sub-section 6, as the case may require.

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

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

9. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provisions of sub-section 1, and the time allowed by Rule 8 for

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

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

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

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

Appeal.

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

Sealing of Patent and Payment of Fee.

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

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

Fees.

13. To the fees specified in the First Schedule to the Patents Rules, 1903, shall be added the Fee specified in the First Schedule hereto.

Forms.

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

Size, &c., of Documents.

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

All documents and copies of documents, except drawings, sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written, typewritten, lithographed or printed in the English language (unless otherwise directed) in large and legible characters with deep permanent ink upon strong white paper, and, except in the case of statutory declarations and affidavits, on one side only, of a size of approximately 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand part thereof, and the signatures thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

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

Drawings accompanying Specifications.

16. For Rules 18 to 24 of the Patents Rules, 1903, the following Rules shall be substituted.

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

17. Drawings, when furnished, should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 24. No drawing or sketch

such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed should appear in the specification itself.

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

19. Drawings must be on sheets which measure 13 inches from top to bottom and are either from 8 inches to 8¼ inches or from 16 inches to 16½ inches wide, the narrower sheets being preferable.

If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary, and the figures should be numbered consecutively throughout, and without regard to the number of sheets. The figures should not be more numerous than is absolutely necessary. They should be separated by a sufficient space to keep them distinct.

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

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

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

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

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

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

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

Reference letters and figures, and index numerals used in conjunction therewith, must be bold, distinct, and not less than one-eighth of an inch in height. The same letters should be used in different views of the same parts. Where the reference letters

are shown outside the figure, they must be connected with the parts referred to by fine lines.

21. Drawings must bear the name of the applicant (and, in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the left-hand top corner; the number of sheets of drawings sent, and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter should appear on the drawings.

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

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

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

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

Dated the 20th day of October, 1904.

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

THE FIRST SCHEDULE.

Fee payable on Sealing of Patent in respect of each application, £1.

THE SECOND SCHEDULE.

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

FORM X.

FORM OF NOTICE OF DESIRE TO HAVE PATENT SEALED.

I [*or* we] desire to have a patent sealed on my [*or* our] Application No. of 19 , and I [*or* we] hereby transmit the prescribed fee on sealing.

[*Name or names and address of applicant or applicants.*]

To the Comptroller.