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THE

LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

BY

THOMAS TERRELL, K.C.

FIFTH EDITION

BY

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PREFACE

TO THE FIFTH EDITION.

THE appearance of a Fifth Edition of this work within four years of the Fourth, may be justified on the ground that the Act of 1907 has come into operation.

The Editor has taken the opportunity of correcting many errors for which he was responsible in the Fourth Edition, and every reference to the reported cases has been carefully checked. Mistakes doubtless remain, but no effort has been spared to attain accuracy in this respect.

The new provisions of the Act of 1907 have required special treatment. Speculation as to the effect of section 27 has been rendered easier by the judgment of Mr. Justice Parker in the case of *Hatschek's Patents*, the full report of which (as appearing in the Reports of Patent Cases) is printed at the end of the Appendix. The legal policy involved in sections 24 and 27 is discussed in Chapter XII. Blank pages are inserted at the end of this chapter, and at those parts of the book dealing with Patent Office practice, in order that the reader may conveniently keep up to date or qualify statements of law which may possibly be affected by new decisions. A corresponding blank has been left opposite to the heading "Notes" in the Index.

The numerous defences available in an action for Infringement are set forth at p. 329, and the precedents of pleading have been revised to meet modern views and requirements.

In the Appendix, at p. 651, will be found a few "Hints" for the preparation of the commoner Agreements and Deeds used in Patent Conveyancing.

A considerable portion of the book has been re-written, and the Editor has ventured to substitute a new chapter on "Subject-matter." He has felt for some time past that a fresh survey was required of this vaguely defined legal territory, but he is far from satisfied with the result of his effort. The writing of Chapter III. has involved a corresponding modification of the views expressed in the chapters on "Novelty" and "Infringement" in the last edition; the three topics are inseparably connected.

The text of the Act of 1907 in the Appendix has been furnished with references to the repealed Acts, and to the text in the book.

The Index has been revised and enlarged.

NEW COURT, TEMPLE,
September 1*st*, 1909.

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THE LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

LETTERS PATENT.

"LETTERS PATENT" is the name given to the document in which the sovereign signifies his will to confer special rights or privileges upon a subject. The privileges granted to a subject when created a peer of the realm or the monopoly of a trade or manufacture are alike conferred by the issue to the subject of letters patent.

Letters patent a franchise.

Letters patent confer a franchise, that is to say, a branch of the royal prerogative vested in the hands of a subject. In *Reg.* v. *County Court Judge of Halifax* (L. R. 1891, 1 Q. B. 797 (*a*)), Baron Pollock, in giving the judgment of the Court, said: "It was contended on behalf of the defendant that 'franchise' includes the right or privilege which is granted by a patent for a new invention. The primary meaning of the word 'franchise,' as its origin denotes, is a freedom; but it has been used in the language of the law in a wider sense as including a liberty or privilege. In Termes de la Ley, tit. 'Franchise,' the only meaning given to it is 'an immunity or exemption from ordinary jurisdiction.' The various rights, however, which it aptly describes are dwelt upon at great length in the Digests of Viner and Comyn, and in Bacon's Abridgement; and in Blackstone's Commentaries, Vol. II., p. 7, it is said: 'Franchise and liberty are used as synonymous terms, and their definition

(*a*) And see *British Mutoscope Co.* v. *Homer*, 1901, 18 R. P. C. 179.

is, a royal privilege, or branch of the king's prerogative, subsisting in the hands of a subject. Being, therefore, derived from the Crown, they must arise from the king's grant; or in some cases may be held by prescription, which, as has been frequently said, pre-supposes a grant. The kinds of them are various and almost infinite.' In Chitty's Prerogative of the Crown, p. 119, a franchise is defined to be a royal privilege, or branch of the royal prerogative, subsisting in the hands of a subject by a grant from the king; and for this he refers to Finch's Law, p. 164. In Comyn's Digest, tit. 'Prerogative,' D. 33, it is said: 'The king may grant to another to have any franchise or liberty as privileges of trade'; and under the head of 'Trade' (B), instances are given of grants by the king's patent for the sole printing of certain books. The right of the Crown to grant monopolies of new trades or manufactures to inventors, *i.e.*, persons introducing them into the realm, as a reward for the benefit thereby given to the community, was always recognised as part of the Common Law Prerogative (*b*). In *Darcy* v. *Allen* (*c*), the Court said, in dealing with the first question—viz., whether the said grant to the plaintiff of the sole making of cards within the realm was good or not—'Also such charter of a monopoly, against the freedom of trade and traffic, is against divers Acts of Parliament, as 9 Edw. III. cc. 1 and 2, which for the advancement of trade and traffic extends to all things vendible, notwithstanding any charter of franchise granted to the contrary, or usage or custom, or judgment given upon such charters, which charters are adjudged by the same Parliament to be of no force or effect.' These words are inapplicable to the 'first question,' unless the Court intended to assume that the grant of the sole making of cards within the realm was a 'charter of franchise'; and, although the charter of franchise mentioned in the statute cited apparently referred

(*b*) *Darcy* v. *Allen*, 1602, Noy, 182; *Case of Monopolies*, Noy, 182; *The Clothworkers of Ipswich Case*, 1615, Godb. 252, 253; *Edgbury* v. *Stevens*, 1691, 2 Salk. 447; 1 Web. P. C. 35; Shephard's Abridgment, Part III., tit. "Prerogative," p. 61; Serjeant Hawkins in Hawkins's Pleas of the Crown, Part I., c. 79, s. 20.

(*c*) 1602, 11 Rep. 84. The most interesting account of this famous trial is to be found in Mr. J. W. Gordon's book, "Monopolies by Patent."

to charters which had been granted to corporations or towns, it seems to be a fair inference that the Court considered such charter of a monopoly as a charter of franchise; and that they would be none the less true when the monopoly answered to the description which the Court declared to be lawful, *i.e.*, 'where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm.' The result of these authorities is, in our opinion, that 'franchise' does include such a right as was put in issue by the proceedings in the county court."

Granted as a reward.

By the creation of monopolies to first and true inventors in the right of using their inventions, a species of property is created in favour of inventors, as a reward for the benefits which they have conferred on humanity, by the exercise of their thought, knowledge and industry. It is to the interests of the community that persons should be induced to devote their time, energies and resources in furtherance of the development of arts and manufactures, and this was recognised in England from very early periods.

It was to the advantage of the whole community that inventors should be rewarded, and no measure of reward can be conceived more just or equitable, and bearing a closer relation to the benefit conferred by the particular inventor, than to grant him the sole right of making, using and vending his invention for a limited period of time.

In the corrupt ages of the Tudors it is not to be wondered at that the prerogative of the Crown to grant monopoly rights to first and true inventors should have been made a lever for assuming a prerogative to grant monopoly rights in trade generally. In the reign of James the First, to such an extent had this abuse been carried, that it was deemed advisable by the legislature that the rights of the Crown in respect of letters patent should be declared by legislative enactment—this was the origin of the Statute of Monopolies (*d*).

The Statute of Monopolies.

(*d*) 1623, 21 Jac. I. c. 3.

It has been supposed that the prerogative of the Crown to grant letters patent for inventions was created by this statute, but the most cursory perusal of its enactments, and of the authorities which preceded it, shows clearly that, so far from the statute giving to the Crown any right which it did not possess before it was passed, it has as its intention the limiting the right of the Crown, and the declaring that which had always been the common law upon the subject. In the first section of this Act, for instance, we find it recited "that all grants of monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm. . . . That all monopolies, and all commissions, grants, licenses, charters and letters patent heretofore made or granted or hereafter to be made or granted . . . are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution."

Merely declares common law.

Sect. 6 saved the granting of letters patent to inventors in the following words:—

Words of the statute.

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

It will thus be seen that the Statute of Monopolies creates

no statutory rights, but merely saves the common law rights of the Crown; and by sect. 97 of the Patents and Designs Act, 1907 (*e*), it is enacted: "*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 the grant thereof.*" By sect. 93 (*f*) of the same Act the word "*invention*" is defined as meaning "*any manner of new manufacture the subject of letters patent and grant of privilege within section twenty-six* (*sic*, really sect. 6) *of the Statute of Monopolies . . . and includes an alleged invention.*"

Definition of "invention" still retained.

So it is that in the present day, notwithstanding the various statutes which have been passed in relation to letters patent for inventions, these monopolies are still granted upon the mere motion of the sovereign, in the exercise of his royal prerogative, and that all that has been done has been declaratory of the limits within which that prerogative should be exercised, and of the method of procedure to be adopted in obtaining letters patent for inventions.

For the purpose of supporting the validity of the letters patent it is necessary that the patentee should conform to certain requisites, and these requisites are indicated in the 6th section of the Statute of Monopolies.

Firstly, he must be the true and first inventor of—

Secondly, a new manufacture;

Thirdly, the new manufacture must not be contrary to law, nor must it be mischievous to the State, by raising the prices of commodities at home; it must not be hurtful to trade, nor generally inconvenient.

Contrary to law
X L R.P.C. X L
No

The Acts of 1883 and 1907 adopted this definition of an invention, and anything that does not conform with all these requisites is not entitled to be called an invention. The host of important decided cases as to the construction of the 6th section of the Statute of Monopolies, and the enormous expense, and labour and learning, which have been devoted to obtaining these decisions, no doubt induced the legislature to adopt a definition which had in some respects obtained a

(*e*) Sect. 116 of the Act of 1883. (*f*) Sect. 46 of the Act of 1883.

correct judicial meaning; but it is doubtful whether it was wise to re-enact it in a form which had, we may say, centuries ago, already become to some extent obsolete.

In the case of *The Badische Anilin und Soda Fabrik* v. *Thompson* (1904, 21 R. P. C. 473) it was argued that the patent should be declared void, because it had never been the intention of the patentee to manufacture in this country, and by means of his patent he maintained a very high price in this country for the article which he manufactured in Belgium. It was urged that this was contrary to sect. 6 of the Statute of Monopolies and to the condition recited in the letters patent. It was held that no condition was imposed by law that the manufacture should be carried on in this country.

The Act of 1907 has, however, imposed obligations of this kind, which will be considered in Chap. XII.

The definition of "new manufacture," and the construction which is to be placed upon the word "*invention*," will have to be dealt with hereafter, when we consider the cases which have been decided upon "Subject-matter."

Thus we see that the same essentials must be proved to-day by an applicant for the grant of letters patent as were necessary at the date of the Statute of Monopolies; he must be the first to introduce into this realm the manufacture for which he seeks a patent, whether by enterprise in importing it from abroad, or by the exercise of his own inventive faculty. The Patents and Designs Act, 1907, adopts the definition of an invention contained in the 26th section of the Statute of Monopolies, and consolidates all the previous enactments together with certain innovations introduced by an amending Act passed earlier in the same year, the effect of which will be dealt with in detail in the course of the consideration of the various branches of the subject as they arise.

The Patents Act of 1907 consolidates the law.

Prior to the Act of 1883 letters patent were issued under the great seal of England, and, consequently, by the Lord Chancellor as keeper of the great seal. The process of sealing a patent was surrounded with all the formalities and expense which surrounds an important act of State. Letters patent derived their authority from the fact that the great seal was

attached to them, "for all the king's subjects are bound to take notice of the king's great seal" (*g*). Sect. 14 of the Act of 1907 (*h*) enacts: "*A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the great seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man.*" And sect. 64 (*i*), "*Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.*"

The seal of the Patent Office.

THE LETTERS PATENT.

Form D in the first schedule to the Act of 1883 gave the form in which letters patent were to be issued, which has since been modified (*k*). By sect. 14, sub-sect. 2, it is enacted, "*Every patent may be in the prescribed form . . .*"

The form of a patent.

Letters patent, as issued at the present time, consist of six material parts:—

1st. The address.
2nd. The recitals.
3rd. The grant.
4th. The prohibition.
5th. The provisoes.
6th. The construction of the grant.

THE ADDRESS.

The address is a public address from the sovereign to "all to whom these presents shall come." Mr. Hindmarch gives the reason for this as being, that it contains bargains made between the public and patentee.

THE RECITALS.

The recitals are four in number. The first recites the patentee's name and address, that he has made a declaration that he is in possession of an invention and is followed by the title of the invention. That he has declared that he is the true and first inventor of the invention, and that the same is

Recitals contain suggestions

(*g*) *East India Co.* v. *Sandys*, Skin. 225.
(*h*) Sect. 12, sub-sects. 1 and 2, of the Act of 1883.
(*i*) Sect. 84 of the Act of 1883.
(*k*) See Appendix.

not in use by any other person to the best of his knowledge and belief.

which must be true.

This recital contains "**suggestions**" which have been made to the sovereign prior to the patent being granted and the representations upon which it has been granted. If either of these suggestions or representations be untrue the patent is void. We cannot do better to illustrate the exact meaning of **a false suggestion** than to quote the language of Parke, B., in *Morgan* v. *Seaward* (*l*). In that case the false suggestion complained of was in the title of the specification, which it was alleged did not disclose the true nature of the invention. "This brings me to the question," said the learned judge, "whether this patent, which suggests that certain inventions are improvements, is avoided if there be one which is not so; and upon the authorities we feel obliged to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person (*m*). It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as in *Hill* v. *Thompson* (1818, 8 Taunt. 375; 1 W. P. C. 244); *Brunton* v. *Hawkes* (1821, 4 B. & Ald. 558); for, although the statute invalidates a patent for want of novelty, and, consequently, by force of the statute the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or in other words the Crown being deceived in its grant, the patent is void, and no action maintainable upon it. We cannot help seeing on the face of this

(*l*) 1837, 2 M. & W. 561; 1 W. P. C. 196; 6 L. J. Ex. 153.

(*m*) *Travell* v. *Carteret*, 3 Levinz, 135; *Alcock* v. *Cooke*, 5 Bing. 340.

patent, as set out in the record, that an *improvement* in steam engines is suggested by the patentee, and is part of the consideration for the grant, and we must reluctantly hold that the patent is void for the falsity of that suggestion. In the case of *Lewis* v. *Marling* (1829, 10 B. & C. 22), this view of the case, that the patent was void for a false suggestion, does not appear by the report to have been pressed on the attention of the Court or been considered by it. The decision went upon the ground that the brush was not an essential part of the machine, and that want of utility did not vitiate the patent, and besides, the improvement by the introduction of the brush is not recited in the patent itself, as one of the subjects of it which may make a difference."

The **second recital** deals with the prayer of the application for the grant.

The **third recital** recites that a complete specification has been filed, particularly describing the nature of the invention. Here, again, a **false suggestion** will avoid the patent, so that if the complete specification is imperfect, the patent will be void upon two grounds, the one being the failure of consideration, and the other false suggestion; and a false suggestion is equally fatal whether it is wilfully false or otherwise.

The **fourth recital** gives the common law motive for the grant, which is the encouragement of inventions for the public good. There will be something analogous to a false suggestion if the subject-matter of the patent be immoral or illegal, and hence the patent will at common law be void. By sect. 75 of the Act the comptroller may refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or morality.

The requirements as to novelty, utility, subject-matter, and disclosure of the invention in the specifications will be considered in detail in subsequent chapters, but they are all based on the "suggestions" contained in these recitals.

THE GRANT.

The monopoly grant.

"Know ye, therefore, that We of our especial grace, certain knowledge, and mere motion do by these presents, for us, &c.,

give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise and vend the said invention . . . in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents."

This language is intended to preserve intact the royal prerogative to grant or withhold a patent—which right was by the common law absolute and undoubted. We have seen that this prerogative is carefully preserved by sect. 97 of the Act.

Nature of patent right

It is the granting portion of the letters patent which creates the property in the invention. We have seen that this species of property is purely artificial in its nature; it is the most equitable and natural method which the State can devise for the reward and encouragement of inventors; it is merely a right yielding nothing until the invention is made practically useful to humanity.

differs from trade mark.

A trade mark is also an exclusive right, but it differs from a patent, insomuch that it has not merit and the benefit of mankind as its consideration. Its object is to indicate the source from which an article comes; not to restrain others from manufacturing such articles. It merely prevents them from using the mark in connection with particular goods. A patent prevents the public from making the article or using the invention.

No property in mere secret.

There is no property which partakes of the nature of an exclusive right save that of a patent, copyright or trade mark. There is no exclusive right in a secret. A man may only use a secret to his own profit so long as no one is in a position, by reason of knowing the secret, to use it. But the original possessor of a secret of manufacture cannot, apart from contract express or implied (*n*), by any process of law, prevent a person from acquiring the knowledge of his secret, or, having acquired it, from making such use of it, by publication

(*n*) See p. 26 *et seq.*

or otherwise, as he may think proper (*o*). In *Newbury* v. *James* (2 Mer. 446), although an agreement had been made to preserve a secret, the Court refused to grant an injunction on the ground that there was no means of enforcing it. Lord Eldon, L.C., said in *Williams* v. *Williams* (3 Mer. 157): "So far as the injunction goes to restrain the defendant from communicating the secret upon general principles, I do not think that the Court ought to struggle to protect this sort of secret in medicine. The Court is bound indeed to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public."

If the plaintiff's secret, however, be one which he intends to patent, and the defendant has acquired the information during the progress of experiments, or from the confidence of the plaintiff, he will not be allowed to make such use of the knowledge so acquired as subsequently to invalidate the plaintiff's patent, or to take out a patent for the invention himself (*p*), and if he does so, he will be liable in damages to the plaintiff (*q*). It will be observed that the word "patentee" is used in the grant; the old form was, "to the said John Smith, his executors, administrators or assigns;" a "patentee" is, under the 93rd section, construed as being "*the person for the time being entitled to the benefit of a patent;*" we shall see presently that this includes assignees, executors and administrators, together with receivers and trustees in bankruptcy, but the subject of the devolution of patent rights is too extensive and important to be dealt with under this head.

THE PROHIBITION.

The prohibition.

The prohibition in the patent commands "all our subjects, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any

(*o*) *Canham* v. *Jones*, 2 Ves. & B. 218.

(*p*) See sect. 15 of the Act of 1907, and p. 28.

(*q*) *Smith* v. *Dickenson*, 1804, 3 B. & P. 630.

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."

It is very difficult to understand the form of letters patent which was appended to the Act of 1883. It is presumed that the Act was intended to amend, simplify and codify the law of patents. The form above quoted is an imitation of forms previously in use. It is not easy to understand what the "penalties" referred to in the prohibition are, and how they are to be put in force or recovered. The Act certainly does not mention penalties as a form of punishment for infringers.

THE PROVISOES.

Proviso for revocation.

"Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by us and the same may be revoked and made void accordingly" (see Chap. XII).

The next proviso is one for the determination of the patent in the event of the prescribed **fees not being paid** (*r*), and the last provides for the supply of the patented article for the use of the public service on reasonable terms. This proviso in no way binds the Crown if the patented article should be required for the public service to purchase it from the patentee.

Proviso for use by Crown.

Prior to the Act of 1883 letters patent did not operate as against the Crown. The Crown might make use of the invention without in any way recognising any rights of the inventor or patentee (*s*). But should the Crown have employed a **contractor**, as distinguished from a servant, to manufacture the patented article, the usual proceedings for infringement might be brought against the contractor, since he is the person using the patent, and not the Crown. There are two methods of infringing—first, making and vending; and secondly, using;

(*r*) See the Act of 1907, s. 20.

(*s*) *Feather* v. *R.*, 1865, 6 B. & S. 257.

consequently the contractor infringes by doing the first, and it makes no difference that the Crown also infringes by using the invention (*t*).

This case was subsequently affirmed in the House of Lords. Lord Hatherley said, "The Crown has no right to authorise others who are not their officers, servants, or agents, to use a patented invention without a license from the patentee;" and Lord Selborne added, "I agree with the Court of Queen's Bench that this decision (*Feather* v. *R.*) is not to be extended by any reasoning from the convenience of the Crown, or of the public service, or from any idea that it practically comes to the same thing, whether the Crown manufactures itself or gives orders to other manufacturers."

The right of the Crown to use a patented invention for the public service without being under any obligation to remunerate the inventor was abolished by sect. 27 of the Act of 1883, re-enacted by sect. 29 of the Act of 1907 as follows:—

"*A patent shall have to all intents the like effect as against His Majesty the King as it has against the subject: Provided that any government department may by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.*"

Procedure when Crown uses invention.

Sect. 30 (*u*) deals with the acquisition by the Secretary of State for War or by the Admiralty of any inventions dealing with instruments or munitions of war, and with the non-publication of specifications describing such inventions, and generally with the preservation for the public benefit of the secret of them.

The practice when a dispute arises between the patentee and the government department is for the matter to be referred to a tribunal consisting of the Chancellor of the Exchequer and two

(*t*) *Dixon* v. *The London Small Arms Co.*, 1875, L. R. 10 Q. B. 130; L. R. 1 App. Cas. 632.

(*u*) Sect. 44 of the Act of 1883.

lords of the Treasury, advised by a permanent official, who hear counsel on both sides and in some cases take evidence, although they have no power to administer an oath, and there is no appeal from their decision. The tribunal sits privately.

THE CONSTRUCTION.

Construction of patent.

"And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee." These words are inserted in the patent for the purpose of ousting the common rule of construction of grants of the Crown (*x*) that they shall be read most strongly against the grantee. This favourable construction applies only to the letters patent and not to the specification. The form of a "Patent of Addition," created by the Act of 1907, resembles that of an ordinary patent in all particulars material to the questions hitherto discussed (*y*).

Form of patent of addition.

(*x*) See *Feather* v. *R.*, 1865, 6 B. & S. at p. 283.

(*y*) See Appendix.

CHAPTER II.

"THE PATENTEE."

Who may apply.

By sect. 1, sub-sect. 1, of the Act of 1907 (*a*), "*An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with another person.*"

It will be observed that there is no limitation whatever preventing a person under incapacity, either by reason of infancy or otherwise, from obtaining a patent.

Persons under disability.

There does not appear to have ever been a question as to whether an **infant** or a **married woman** might under the old law have become a grantee of letters patent. The words "any person" and the Married Women's Property Act, 1882, however, sweep away any doubt that might have been entertained on the subject. By sect. 83 (*b*), which deals with persons under disability of lunacy or infancy, it is enacted that the necessary declarations and other acts may be made and performed by the committee or by a guardian appointed by the Court.

Sect. 43, sub-sect. 1 (*c*), enacts: "*If the person claiming to be an inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.*"

It was always competent for an alien to obtain a patent; Lord Cairns in *Wirth's Patent* (*d*) went even further than this: "I am quite clear that letters patent may be granted to a foreigner who is resident abroad for an invention communicated to him by another resident abroad" (*e*).

(*a*) Sects. 4 and 5 of the Act of 1883.

(*b*) Sect. 99 of the Act of 1883.

(*c*) Sect. 34 of the Act of 1883.

(*d*) *Wirth's Patent*, 1879, L. R. 12 Ch. D. 303; 28 W. R. 329.

(*e*) See also *Chappell* v. *Purday*, 1845, 14 M. & W. 318.

But *quære* if letters patent could be obtained by an alien enemy (*f*).

In *Patterson* v. *Gas Light and Coke Co.* (1875, L. R. 2 Ch. D. 832), James, L.J., in the Court of Appeal, said: "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say that we think it at the least very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject-matter of their official investigation."

It has been thought doubtful whether a beneficed clergyman could become the grantee of letters patent, since the exercise of an invention would probably amount to trading within the meaning of 57 Geo. III. c. 99 (*g*).

Under sect. 1 of the Act of 1907, quoted above, it is clear that a patent may be granted to a corporation, together with the true and first inventor. But a grant to a corporation alone could only be made in the case of a new manufacture introduced from abroad (*h*), since a corporation could not be said to invent in the modern sense of the word (*i*).

The enactment that the true and first inventor may receive a grant of letters patent jointly with another person is for the purpose of enabling an impecunious inventor to associate himself with a financier and so to give the latter an interest in the invention from the beginning.

As to the rights of co-grantees and co-owners *inter se*, see Chap. X.

The declaration.

The law requires that each application shall be accompanied by a declaration to the effect that the applicant, or in the case of joint applicants, one at least is the "the true and first inventor;" and in the case of an application by the representative of a deceased inventor a declaration is required that the applicant believes the deceased to have been the "true and first inventor."

(*f*) *Bloxam* v. *Elsee*, 1827, 1 C. & P. 558.

(*g*) Hindmarch on Patents, p. 35; see *Hall* v. *Franklin*, 1838, 3 M. & W. 259.

(*h*) See *In re The Société Anonyme du Générateur du Temple*, 1896, 13 R. P. C. 54.

(*i*) Hindmarch on Patents, p. 34.

We have now to deal with the construction of the words "true and first inventor."

TRUE AND FIRST INVENTOR.

True and first inventor.

By the common law the Crown had power to grant letters patent, giving monopolies for manufactures newly introduced into the realm, whether newly invented or newly imported. There is no doubt, therefore, that the words "true and first inventor" in the Statute of Monopolies included both—

(1) True and first inventor (in the strict modern sense), and

(2) True and first importer.

Jessel, M.R., on importers.

The effect of numerous earlier decisions was summed up by Jessel, M.R., in the important case of *Plimpton* v. *Malcolmson* (1876, L. R. 3 Ch. D. at p. 555): "The Act of Parliament (21 Jac. I. c. 3) on which all these patents are founded, tells us this: that to come within the exception of the Statute of Monopolies a man who has the patent must be the first and true inventor, and he must describe something in his specification which is not already known and used. What is the meaning of a first and true inventor? To ascertain its meaning you must have recourse, no doubt, to various decisions given on the statute, which is very nearly three hundred years old. . . . In order that those who may have to consider my judgment hereafter may know the view that I take of the statute, combined with decisions, I will state the result at which I have arrived. As I understand, shortly after the passing of the statute, the question arose whether a man could be called a first and true inventor who, in the popular sense, had never invented anything, but who having learned abroad (that is out of the realm, in a foreign country, because it has been decided that Scotland is within the realm for this purpose) that somebody else had invented something, quietly copied the invention, and brought it over to this country, and then took out a patent. As I said before, in the popular sense he had invented nothing. But it was decided, and now, therefore, is the legal sense and meaning of the statute, that he was a first and true inventor within the statute, if the invention being in other respects novel and useful, was not previously

known in this country—'known' being used in that particular sense as being part of what had been called the common or public knowledge of the country" (*k*).

Declarations distinguish inventors into classes.

Long before the Act of 1852 (*l*), however, there had been a custom or practice for the applicant to distinctly state in his declaration, by virtue of which qualification he prayed for a patent; and the form in which the declaration was made was considered material, because the Crown must not be deceived. Consequently, in *Milligan* v. *Marsh* (1856, 2 Jur. N. S. 1083), it was held by Vice-Chancellor Page Wood that a person taking out a patent and making a declaration that he is a first inventor, when, in truth, he is only an importer of a communicated invention, makes a false suggestion, and the patent is void. By sect. 5, sub-sect. 2, of the Act of 1883 it was enacted for the first time that "*every application must contain a declaration that the applicant . . . claims to be the true and first inventor.*" The Rules, however, continued the old practice of using distinct forms for original inventions and those communicated from abroad, but required the applicant on a communicated invention to state that he claimed to be the true and first inventor. Consequently the *ratio decidendi* of *Milligan* v. *Marsh* no longer exists.

Legal effect of this.

In *Avery's Patent* (1887, L. R. 36 Ch. D. 316), Stirling, J. (subsequently affirmed by the Court of Appeal), in giving judgment, said: "The rules which have been framed by the Board of Trade under the power conferred upon them by sect. 101 of the statute contain provisions which the statute itself does not contain, in reference to an application for a grant for an invention which has been communicated from abroad. Rule 27 provides that the application for such a grant shall be in the form 'A' in the 2nd schedule, and that form is different from that which is prescribed by the statute and from the terms in which Lindsay made his application." (His lordship read the form and continued:) "That form has been framed so as to fit in with sect. 5, sub-sect. 2, of the statute, which enacts that an application must contain a declaration . . . that the

(*k*) And see Jessel, M.R., in *Marsden* v. *Saville Street Co.*, 1878, L. R. 3 Ex. D. 203.

(*l*) See Hindmarch, pp. 509, 510.

applicant is in possession of an invention, whereof, he . . . claims to be the true and first inventor. That form has not been followed in this case. There is no decision that a patent taken out as for an original invention, when in fact the invention patented was communicated from abroad, is void, though there is in the case of *Milligan* v. *Marsh* (supra) what appears to be a dictum of Vice-Chancellor Sir Page Wood to that effect; nor is there any decision that where an invention is partly original and partly communicated from abroad, the part communicated from abroad ought to be distinguished in the specification; but in the case of *Renard* v. *Levenstein* (10 L. T. N. S. 177), the Lord Justice Knight Bruce expressed great doubt upon the point." . . . (And at p. 318:) "That being so notwithstanding that the invention was founded on a communication received from abroad, it appears to me that it well might be held that the statutory declaration made by the applicant was true in point of law."

And Lindley, L.J., in the case of *Moser* v. *Marsden* (1893, 10 R. P. C. 359), said: "Then it was suggested that as the English patentee had himself approved *Grosselin's* invention, the specification ought to have shown this on its face; and that as the whole invention was not communicated to the plaintiff by *Grosselin*, as stated by the plaintiff, the patent is bad. This point has been raised before, but as yet it has not found favour in any Court. Nor ought it; there is no substance in it. The patentee is the true and first inventor within the meaning of the patent laws, whether he invents himself or whether he simply imports a foreign invention. I cannot see how he is anything but a true and first inventor if he does both; that is, if he both imports a foreign invention and improves it himself."

Hence the applicant is not bound to observe the rule requiring him to state that the invention has been so communicated, but the rule affords facilities to foreign inventors, saving them the trouble of making declarations; the invention is communicated to the patent agent who holds the patent as a trustee for his foreign client (*m*).

(*m*) See Chap. VII.

The foreign inventor, it would appear, is the person who is responsible for exercising good faith (*n*). But the agent is the patentee, and, save in so far as his relations with his client are concerned, there is no reason why he should not derive the entire advantage of the patent (*o*).

The actual inventor.

A. **An Actual Inventor.**—An actual inventor is a person who, either by accident or design, produces or discovers an art or manufacture. The operation of the mind in which the invention originates must be that of the mind of the inventor. The carrying out of the results of the operation of the mind may be done by the hands of the inventor or by those of anyone else whom he may employ for the purpose. What amount, if any, of labour of the mind is required is another question, and will be dealt with more fully under the head of "Subject-matter." But it may be broadly stated here that provided the invention has originated in the mind of the patentee, the Court will not inquire further, but will judge in the main from the results produced as shown in the invention itself.

It must be remembered that the question "Is the patentee true and first inventor?" is entirely separate and distinct from one which we shall have to consider later, in the Chapter on Novelty, viz., "Is the invention itself new?" In the former case we are dealing with the history of an idea in the mind of a particular man; in the latter with the history of a manufacture.

True inventor and novelty distinguished.

This difference was pointed out by Tindal, C.J., in *Gibson and Campbell* v. *Brand* (1841, 1 W. P. C. at p. 628): "The defendant next says that these letters patent have not been granted to the true and first inventors, which you are aware is a condition required by the statute. Now a man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some

(*n*) *Kane and Pattison* v. *J. Boyle & Co.*, 1901, 18 R. P. C. 338; *British United Shoe Machinery Co., Ltd.* v. *A. Russell & Sons, Ltd.*, 1908, 25 R. P. C. at p. 386.

(*o*) *Beard* v. *Egerton*, 1846, 3 C. B. 129; 15 L. J. C. P. 274.

other person, he may have taken it from a book, he may have learnt it from a specification; and then the legislature never intended that a person who had taken all his knowledge from the act of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill. There is some distinction, although perhaps not a very broad one, between the plea which alleges the plaintiffs were not the first and true inventors and that on which I conceive the principal question between the parties will turn . . . whether the subject-matter of this patent was known in England at the time the letters patent were granted?" (*p*).

In *Tennant's Case* (1795, 1 W. P. C. 125) a material portion of the invention claimed was found to have been suggested to the patentee by a chemist at Glasgow. Lord Ellenborough held, that the patent was bad because the plaintiff was not the inventor. It will be observed in this case, that although it is possible that the plaintiff was the first person to use the particular method for making bleaching liquor, still, inasmuch as that method of producing this bleaching liquor was thought out by someone else and communicated to the plaintiff, he was held not to be an inventor.

In *Cornish* v. *Keene* (1835—1837, 1 W. P. C. 507), Tindal, C.J., said: "Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not; because these patents are granted as a reward, not only for the benefit conferred upon the public by the discovery, but also to the **ingenuity of the first inventor**; and although it is proved that it is a new discovery, so far as the world is concerned, yet if anybody is able to show that although that (*q*) was new—that the party who got the patent was not the man whose ingenuity first discovered it, that he borrowed it from A. or B., or had taken it from a book that was printed in England, and which was open to all the world —then, although the public had the benefit of it, it would be

(*p*) And see *Household Co.* v. *Neilson*, 1843, 1 W. P. C. 689; *Cornish* v. *Keene*, 1835, 1 W. P. C. 507.

(*q*) *I.e.*, the publication to the world.

an important question whether he was the first and original inventor of it." There is no doubt that, under the circumstances stated by the Chief Justice, the patentee would not be the original inventor.

We do not propose to deal at length with the cases that have followed *Cornish* v. *Keene*. The principle laid down in those cases we have cited has invariably been followed.

In *R.* v. *Wheeler* (1819, 9 B. & Ald. 345), Abbott, C.J., delivering the judgment of the Court, said: "If the patentee has not invented the matter or thing of which he represents himself to be the inventor, the consideration of the royal grant fails, and the grant consequently becomes void."

A. may have invented something, it may have pleased him to try a few experiments with his invention, and then to abandon it without publication. B. may subsequently have invented the same thing altogether **independently** of A. If B. applies for letters patent he is at law the first inventor; but should it be shown that the process of invention was not carried on in B.'s mind at all, but that A. communicated his ideas to B., although with the full intention of abandoning them, B. will not be the first inventor. Take, for instance, the case of *Dolland's Patent* (1776, 1 W. P. C. 43): this was an improvement in the manufacture of object-glasses for telescopes. Dr. K. had made and used identically similar object-glasses for his own purposes, but he had in no way published his invention. Dolland, without any communication from Dr. K., had re-invented these object-glasses; held, that Dolland's patent was good.

Dolland's Case.

In *Lewis* v. *Marling* (1829, 10 B. & C. 27; 1 W. P. C. 496; 4 C. & P. 52) Mr. Justice Bailey said: "If I discover a thing for myself, it is no objection to my claim to a patent that another also has made the discovery, provided I first introduce it into public use." The suggestion in that case having been that the patentee had acquired his invention by seeing a model of a similar machine which had been brought from America, it was disproved that he had seen the model, and consequently he was held to be the first and true inventor.

Master and servant.

The extent to which science has developed in modern times,

and the immense labour and time required to work out the details of construction of a complicated machine, frequently make it impossible for one man to perfect his invention by himself. And it is the practice of inventors to suggest the main idea to subordinates, together with rough plans and sketches, and to leave the practical working out of the details to the latter, a task often requiring great skill, and occasionally even inventive ability. But this skill, while exercised in the employment of the master, and under his general directions, does not entitle the servant or workman to claim an interest in the invention, although the claim by the master to the ingenuity of the servant does not extend beyond mere improvements in mechanical details. Exactly to what extent the man who conceives an idea is entitled to improvements suggested by the person he employs to work out that idea is difficult to define, and must depend upon the facts of each case in which the question may arise; but the guiding principle is involved in the question, "Is it the idea itself, or is it merely the method of carrying the idea into effect, that constitutes the pith of the invention?"

The rights of the master.

In *Bloxam* v. *Elsee* (1 C. & P. 558; 1 W. P. C. 132, n.), the patentee had worked out the principle of his invention in his own mind; the mechanical details and arrangements requisite for carrying the principle into practice, so as to realize the idea, were extremely numerous and complicated, and Mr. D. was employed professionally to assist in these arrangements. Mr. D. had suggested several parts of the machine to the patentee. An objection was taken that the patentee was not the inventor. The objection was overruled. It will be seen in this case that the patentee's mind conceived the invention, and that Mr. D. was only, so to speak, the intellectual hands employed by the patentee to carry out that which he had previously conceived in his mind. The summing-up of Baron Alderson, in the case of *Minter* v. *Wells* (1834, 1 W. P. C. p. 129), is instructive on this point: "The patentee," said the learned judge, "claims under the patent, stating, in his petition to the Crown, that he is the true inventor of the machine in question; and if it could be shown that he was not the true

Cases to illustrate.

inventor, but that some one else had invented it, the Crown is deceived in that suggestion, which was the foundation on which it granted the patent; and then the law is, that the patent obtained under such circumstances would be void, and no action could be maintained against the party for the infringement of the patent. . . . If Sutton suggested the principle to Minter, then he, Sutton, would be the inventor; if, on the other hand, Minter suggested the principle to Sutton, and Sutton was assisting him, then Minter would be the first and true inventor, and Sutton would be a machine, so to speak, which Minter uses for the purpose of enabling him to carry his original conception into effect."

In *Allen* v. *Rawson* (1845, 1 C. B. 567), Erle, J., directed the jury thus: "I take the law to be that, if a person has discovered an improved principle, and employs engineers, agents, or other persons to assist him in carrying out that principle, and they in the course of experiments arising from that employment make valuable discoveries accessory to the main principle, and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle, and may be embodied in his patent; and if so embodied the patent is not avoided by evidence that the servant or agent made the suggestion of the subordinate improvement of the primary and improved principle." This was confirmed by Tindal, C.J., who said (p. 574): "It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend on its own merits. But when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." This case was followed by Buckley, J., in *In re Smith's Patent* (1905, 22 R. P. C. 57).

In *Elias* v. *Grovesend Tinplate Co.* (1890, 7 R. P. C. 455), the facts were as follows: In the year 1867, and subsequently,

one Morewood took out patents for machines for removing the superfluous tin from tinplates; this he effected by the immersion of the tinplate in a grease-pot by means of a cradle, with an adjustable guide at each end, so that the plate, upon immersion, was sent down into the grease-pot in a perpendicular position, and so brought under the rollers therein; these rollers raised the plate to the surface in a like perpendicular position, having in the meantime squeezed or compressed from the plate any superfluous tin adhering to it; by means of what was practically a duplicated machine of this description Morewood was able to treat two plates at a time, but when the "double Morewood" was at work it brought up the plates alternately and not simultaneously. In 1885 it occurred to the plaintiff that saving in time and labour would be effected if a similar machine were constructed to bring up the two plates simultaneously. In 1886 he communicated his idea to Mr. Glyn Thomas, of whose works he was the manager, describing it "to work two sheets at a time, side by side, on the Morewood principle, with rollers lengthened." The patent was held invalid for want of subject-matter, but the Master of the Rolls in the Court of Appeal said (*r*): "Supposing there is an invention in that which is claimed—the carrying out of an idea in a machine—was the whole of that invention Mr. Elias', the plaintiff's, or was not part of it the invention of Karrop the machinist? Upon the assumption that there must be more than the idea, and that the machine is part of the invention—I mean the mechanism is part of the invention—was the whole of that done by Elias? The evidence seems to me to be clear as to this, that he had the idea in his mind of doubling Morewood's pot lengthways, that is, of making a pot of Morewood's twice the size of Morewood's, so that the two plates might be put in side by side. That was his idea. If that was all, it was *not* patentable; but it is to be done in a machine. Did he have anything in the world to do with the construction of the machine which upon the assumption is part of the invention? . . . If it is an invention, Karrop has invented part of it."

(*r*) Pp. 465, 466.

But where the idea of the invention has not been suggested by the employer, there is nothing to prevent the servant having a patent. The Solicitor-General, in *In re Heald's Patent* (1891, 8 R. P. C. 430), said: "I am not aware of any authority which lays it down that the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer, so as to prevent the person employed from taking out a patent for it," particularly where the servant has been **requested to invent,** as in *Marshall and Naylor's Patents* (1900, 17 R. P. C. 553). Here again, however, there must be invention on the part of the servant, who is not on general principles (*s*) otherwise entitled to make use of information obtained by him when serving in a confidential capacity, and the circumstances must be considered in each case (*t*).

Where servant requested to invent.

The cases all seem to show that the man who conceives the idea has no right to the inventions of the man he employs to carry it out **other than** mere improvements in mechanical details, whether that man be his immediate servant or an independent mechanic, and the relationship of **master and servant** gives to the master no rights to the invention of his servant.

Where relations confidential.

It may be, however, that the **relations** between master and servant may be of such a **close and confidential character** that it may be inequitable to allow the servant to retain the benefit of a patent. In *The Worthington Pumping Engine Co.* v. *Moore* (1902, 20 R. P. C. 41), the plaintiffs employed the defendant as their agent and manager in England, and communications constantly passed between them as to improvements and alterations in the machines sold to suit the English market. The defendant was employed at a high rate of remuneration and a commission. There was no express stipulation as to inventions or original suggestions which might be made by the defendant. The defendant took out three patents for inventions which he

Cases.

(*s*) See *Lamb* v. *Evans*, 1893, L. R. 1 Ch. 218; *Robb* v. *Green*, 1895, L. R. 2 Q. B. 315.

(*t*) See also *R.* v. *Arkwright*, 1785, Dav. P. C. 61; *Kurtz* v. *Spence*, 1885, 5 R. P. C. at p. 180.

employed in the business of the plaintiffs. He was subsequently dismissed, and sought to restrain the plaintiffs from using the patented inventions. This action was to obtain a declaration that the defendant should be declared a trustee for the said patents on behalf of the plaintiffs. Byrne, J., said (p. 46): "I think he (the defendant) would not have been acting in accordance with the good faith implied in his contract had he kept back new ideas or details of construction suggested or carried out in the ordinary course of business between the parties (even though such ideas or details might have been in the hands of a third person properly subject-matter for a patent) with a view to his personal profit at the expense of the plaintiff corporation. It appears to me that the degree of good faith due from the defendant to the plaintiff company was little, if at all, less than that required from a partner towards the firm of which he was a member . . . (p. 48). I propose now to deal with the principles of law applicable to the case; and first I desire to say that I recognise and quite appreciate the principle of those cases which have established that 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 to his employers in their business, and that, even though the servant may have made use of his employers' time and servants and materials in bringing his invention to completion, and may have allowed his employers to use the invention while in their employment; but, on the other hand, without repeating what has been so fully and admirably expressed by the Court of Appeal in the two cases of *Lamb* v. *Evans* and *Robb* v. *Green* (*u*), it is clear that all the circumstances must be considered in each case. I consider that, bearing in mind the principles laid down in the authorities to which I have referred, it is impossible to say in the present case that the defendant has established the right he claims, having regard to the obligations to be implied arising from his

(*u*) See *Lamb* v. *Evans*, 1893, L. R. 1 Ch. 218; *Robb* v. *Green*, 1895, L. R. 2 Q. B. 315.

contract of service, and I am of opinion that his case is inconsistent with an observance of that good faith which ought properly to be inferred or implied as an obligation arising from his contract" (*v*).

Applications in fraud of inventor.

By sect. 15 of the Act of 1907 (*x*), "(1) *A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.*

"(2) *Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked:*

"*Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.*"

This is in substance the same as sect. 35 of the Act of 1883, which was only a re-enactment of that which had been decided to be the law previous to the Act. In *Ex parte Scott and Young* (1871, L. R. 6 Ch. 274), the servant had filed a provisional specification of an invention; after which the master filed a specification for a similar invention, and subsequently filed a complete specification, and obtained letters patent. It was held that, under the circumstances, the great seal might be affixed to the letters patent of the servant's invention, and that the patent might bear the date of his provisional specification.

Provisional protection.

By sect. 4 of the Act of 1907 (*y*), "*Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the invention. And such protection from the consequences of use and publication is in this Act referred to as provisional protection.*"

(*v*) And see *Richmond & Co.* v. *Wrightson*, 1905, 22 R. P. C. 25; and *Edisonia, Ltd.* v. *Forse*, 1908, 25 R. P. C. 546.

(*x*) Sect. 35 of the Act of 1883.

(*y*) Sect. 14 of the Act of 1883.

The decision of Hatherley, L.C., in *Ex parte Bates and Redgate* (1869, L. R. 4 Ch. 577), cited in the case of *Ex parte Scott and Young* (supra), was in consequence of the discretion given to the Lord Chancellor by the Act of 1852, s. 23, as to the date of the patent. This discretion no longer exists. The Act of 1883, s. 13, fixed the date of application as the date of the patent. The decision was, moreover, doubted in *Dering's Patent* (L. R. 13 Ch. D. 395) by Lord Cairns.

In *Richmond & Co., Ltd.* v. *Wrightson* (1904, 22 R. P. C. 25), the defendant Wrightson had applied for certain patents (including foreign patents), having obtained the invention either from A. or from B. (but from which of them was not decided). Buckley, J., made a declaration that the defendant was trustee of all the patents for A. and B. jointly. Subsequently (*unreported*), when the time came for sealing the patents, it was found by Sir E. Carson, S.-G., that as Wrightson was expressly declared by the judgment not to be the true and first inventor, no patent could be sealed. But A. and B. were able to apply for a patent under sect. 35 of the Act of 1883.

The general question of concurrent applications, where there is no fraud, that is, where each applicant is in a position to offer the consideration of invention, will be considered in a subsequent chapter. It is only material here so far as concurrent application is brought about by reason of one man fraudulently appropriating the invention of another.

Patents granted to importers.

B. **True and First Importer.**—The right of the Crown to grant letters patent to true and first importers of inventions appears to have been a common law right. In the early days of manufacturing enterprise, when true inventors were so exceedingly rare as scarcely ever to be heard of, the word "inventor" had not acquired the meaning which it has at present, and seems to have been used to designate a first introducer rather than a first inventor. In the early reports shortly succeeding the Statute of Monopolies we do not find the judges in any difficulty in dealing with the words "true and first inventor," showing that the word "inventor" had not

the precise meaning which it has since acquired. We find that so far back as 1567 a patent had been granted to one *Hastings* (*z*) for the making of frisadoes in consideration of his having *imported the skill of manufacturing them from abroad.*

Inventions new to the realm.

So in *Mathey's Case*, "It was granted unto him the sole making of knives with bone hafts and plates of lattice, because, as the patent suggested, he brought the first use thereof from beyond the seas." This was in the reign of Elizabeth. In *The Cloth-workers of Ipswich* (1615, 1 W. P. C. 6; 1 Godb. 252) we have this said: "The king granted unto B. that none besides himself should make ordnances for battery in the time of war: such grant was adjudged void. But if a man hath brought in a new invention and a new trade in the kingdom in peril of his life and consumption of his estate or stock, &c., or if a man hath made a new discovery of anything, in such cases the king, of his grace and favour in recompense of his costs and travail, may grant by charter unto him that he only shall use such a trade or trafique for a certain time; because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired the king cannot make a new grant thereof."

Then came the Statute of Monopolies, and we have seen that the 6th section of that Act carefully excepted "the sole working or making of any manner of new manufacture **within this realm,** to the true and first inventor or inventors of such manufactures, which others at the time of making such letters patents and grants shall not use."

Afterwards came the decision of *Edgebury* v. *Stevens* (1691, 1 W. P. C. 35; 2 Salk. 447), where it is said, "for the statute speaks of new manufactures **within this realm,** so that if it be new here it is within the statute, for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing." See the remarks of Eyre, C.J., in *Boulton* v. *Bull* (1795, 2 H. Bl. 491; Dav. P. C. 162).

Importer need have no merit.

The person who takes out the patent need not be a meritorious

(*z*) See "Monopolies by Patents," by J. W. Gordon, at p. 220.

importer; he may be merely the clerk or agent to whom the communication was made for any special purpose by the foreign inventor, and as trustee for him for the purpose of enabling him to take out the patent for the benefit of such foreigner (*a*). Communications.

As to the duty of the grantee of a patent for an invention communicated from abroad with regard to disclosure in the specification, see Chap. VI., *Plimpton* v. *Malcolmson* (1876, L. R. 3 Ch. D. at p. 582) and *Weymann* v. *Corcoran* (1878, L. R. 13 Ch. D. at p. 77).

The importer of a new manufacture or invention will be considered the true and first inventor, even though he is not the assignee of the foreign inventor, and he may be the foreigner himself, if the Crown chooses to grant him a patent (*b*).

The importer of an invention need not have acquired the information from a foreigner resident abroad, but may have done so from a British subject abroad (*c*).

But a communication made in England by one British subject to another, of an invention, does not make the person to whom the communication is made the first and true inventor within the meaning of 21 Jac. I. c. 3, so as to enable him to take out letters patent for the invention (*d*). Circumstances might render it necessary to send over from abroad some person who understands the invention, in order that the intended grantee may be able to understand it and properly describe it in the specification. It is submitted that this would not prevent the communication from being a genuine "communication from abroad." This point was raised, but not decided, in *Pilkington* v. *Yeakley Vacuum Hammer Co.* (1901, 18 R. P. C. at p. 461).

It was decided in *In re Wirth's Patent* (1879, L. R. 12 Ch. D. 303; 23 W. R. 329) that a patent could be granted to a foreigner resident abroad for an invention communicated to him by another foreigner also resident abroad. This, however,

(*a*) *Beard* v. *Egerton*, 1846, 3 C. B. 129; 15 L. J. C. P. 274.

(*b*) See remarks of Pollock, C.B., in *Chappell* v. *Purday*, 1845, 14 M. & W. 318; see also *Beard* v. *Egerton*, 1846, 3 C. B. 130.

(*c*) *Nickels* v. *Ross*, 1849, 8 C. B. at p. 710, per Wilde, C.J.

(*d*) *Marsden* v. *Saville Street Co.*, 1878, C. A., L. R. 3 Ex. D. 203.

as a matter of practice, is no longer possible, a direction having been made that only persons resident in the United Kingdom may apply for a grant of letters patent in Form A 1, this regulation being expressly intended to prohibit agents living abroad from making the declaration in Form A 1 (*e*).

In an application for a patent in respect of an invention communicated from abroad, the circumstances under which the invention was obtained by the importer will not be inquired into (*f*).

Applications under International Convention.

It was provided by sect. 103 of the Act of 1883, as amended by sect. 6 of the Act of 1885, and re-enacted by sect. 91 of the Act of 1907, that any person who has applied for protection for any patent in any foreign State with whom we have entered into **international arrangements** for mutual protection of inventions, shall be entitled to a patent for his invention in this country in priority to other applicants, and such patent, on registration, shall have the same date as the date of the protection obtained 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 section also applies to such British Colonies as have made arrangements for the protection of inventions patented in this country.

The object of the section is to preserve to the foreign inventor a priority for a certain period over persons who might otherwise have anticipated him by filing an application for a patent for his invention without authority to do so.

The rights under this section are purely personal to the applicant in the foreign country himself, and cannot be enjoyed by the agent of such applicant or by any person to whom he has communicated his invention (*g*).

Foreigner has double right.

A **foreign patentee** thus has a **double right**: he may either take advantage of the Act and apply for a patent, antedated to

(*e*) P. O. J., 9th May, 1884.

(*f*) *Edmund's Patent*, 1886, Griff. P. C. 283; *Lake's Patent*, 1888, 5 R. P. C. 415; *Bairstow's Patent*, 1888, 5 R. P. C. 288; and see also *Pilkington* v. *Yeakley Vacuum Hammer Co.*, 1901, 18 R. P. C. 459.

(*g*) *Shallenberger's Application*, 1889, 6 R. P. C. 550; *Carez's Application*, 6 R. P. C. 552.

the date of his foreign application, and thereby shorten the period of protection to that extent, or he may obtain a patent for the full period in the ordinary way, the date of the patent being conclusive to show which course he has pursued; he may also obtain a patent for the full period by instructing his British agent to apply on a communication from abroad, the patent when obtained to be conveyed to the foreigner; but after having obtained a patent for the full period in the ordinary way, he may not avail himself of the provisions of sect. 91 to escape the result of a publication of his invention during the period that elapsed between his foreign application and his application in this country (*h*).

The fact of an invention having been practised previously in a **British Colony** will not affect the power of the Crown to grant letters patent for its exercise in this country (*i*).

Where the foreign inventor had made two applications in his own country, the first of which applications was abortive, and further, the foreign patentee made a declaration that the proceedings under the second application were in all respects the same as if no prior application had been made, it was held by the Law Officer that the seven months mentioned in sect. 103 should run from the date of protection obtained upon the second application, and he directed that the English patent should be sealed as of that date (*k*).

Where a foreign inventor was resident in a country with which international arrangements for the mutual protection of inventions was made after an application had already been lodged in this country by another person for letters patent in respect of a similar invention, it was held by the Law Officer that such foreign inventor was entitled to apply in priority over other applicants for so much of the seven months as remained after the Order in Council declaring such foreign country to be "one of the contracting States" (*l*).

(*h*) *The British Tanning Co.* v. *Groth*, 1891, 8 R. P. C. 113; *Acetylene Illuminating Co.* v. *United Alkali Co.*, 1902, 19 R. P. C. 222.

(*i*) *Rolls* v. *Isaacs*, 1881, L. R. 19 Ch. D. 268.

(*k*) *Re Van de Poele*, 1890, 7 R. P. C. 69.

(*l*) *In re Main's Patent*, 1890, 7 R. P. C. 13.

See also Lee Patent [illegible] F. xxxvii R.P.C. 112
Wilson v Chalco xxxix R.P.C. 252.
British Oxygen Co v Acme Lighting xli R.P.C. 604

CHAPTER III.

SUBJECT-MATTER.

Defined by Statute of Monopolies.

The Statute of Monopolies declared all grants of monopoly rights to be void at common law. "*Provided* (sect. 6) *that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventors of such manufactures which others at the time of making such letters patent and grants shall not use.*" This definition of the subject-matter of a valid grant has been followed in all subsequent enactments; by sect. 93 of the Act of 1907, "'*Invention*' *means any manner of new manufacture the subject of letters patent and grant of privilege within section twenty-six* (*sic*, but *section six* is meant) *of the Statute of Monopolies.*"

Letters patent can only be granted, therefore, in respect of *manufactures*. Unfortunately the term "subject-matter" has been very loosely applied in practice, and under the plea that "the alleged invention is not proper subject-matter," there have been discussed not only the issue of whether the invention is a manufacture, but also whether its production has required ingenuity, and whether there has been substantial novelty in view of prior common knowledge. It is not easy to get rid entirely of the question of novelty; the evolution of arts and sciences has caused inventive genius to proceed by steady development rather than by abrupt changes, and consequently the substantial novelty of a new invention must be judged rather by its ultimate results than by its inherent characteristics.

Confusion with novelty.

The line between manufacture and mere commercial enterprise is often hard though usually possible to draw. Commercial enterprise is usually novel in character if successful, but in spite of novelty it is not always embodied in

a manufacture, and consequently fails as subject-matter for a patent; and, on the other hand, an alleged invention may be of an undoubted manufacture, but it may lack substantial novelty. It will be found that in most of the cases where the patent has been held to fail for want of subject-matter, as opposed to want of novelty, that the invention lacks the characteristics of a manufacture and is shown to consist in commercial acumen or in mere discovery alone. A useful illustration is to be found in *The Haskell Golf Ball Co.* v. *Hutchinson*, which turned upon the validity of the patent for the Haskell golf-ball. This patent was held invalid by Mr. Justice Buckley and by the Court of Appeal and the House of Lords. The patented invention consisted of a ball of which the cover was made of gutta-percha, and the core of rubber thread wound under tension into a ball. It had been well known to use gutta-percha as a cover for golf balls, and it was well known that this material was the only suitable one for such covers. Balls had also been used for other purposes than golf composed of rubber thread wound under tension, and such balls were usually covered with leather. The purpose of the rubber thread core was to impart elasticity; the purpose of the gutta-percha cover was to protect the core and to muffle that elasticity when the ball was given a slight blow, as when on the putting-green, where elasticity is a disadvantage. Balls having elasticity were at first regarded with great disfavour by golfers, but ultimately—some four years or so after the grant of the patent—the majority of players came to the conclusion that their use was advantageous. As soon as this change of opinion took place the Haskell ball became a great commercial success, *i.e.*, **the success of a particular point of view rather than that of a manufacture.** The judgment of the Master of the Rolls (now Lord Collins) demonstrates this aspect of the matter. He said (23 R. P. C. at p. 313): "Now there being that right in every person to play the game with any ball that he found if he chose to do so, what was there open to this gentleman to patent in this case? . . . All that he has done is really, when you come to sift it, that he has substituted for the leather cover, which was the common cover of the balls composed of rubber wound in

Subject-matter means a manufacture.

The "Golf-ball Case."

tension then in use, for the purpose of golf, a cover of gutta-percha. That is the invention. What room was there for invention in taking that step into the unknown?—a step from a cover of leather to a cover of gutta-percha for the purpose of making a ball, fit for other purposes, fit for golf. What did he find to his hand? He found that every ball in the market was a ball made either in whole or in part of gutta-percha. Certainly the external part of it was gutta-percha. It was well known that if you wanted to strike a ball with an iron club probably gutta-percha was one of the best substances you could choose to admit of that impact. It was well known that gutta-percha was a common, or at least a well-known, cover for balls which required a considerable impact from the conditions in which they were used. Under those circumstances, it seems to me that that step, when you have once made up your mind that there was a certain degree of originality in playing golf with an elastic ball, was not the subject of a patent. The idea of putting a cover on strong enough to stand the impact of an iron club, and substituting, therefore, gutta-percha for leather, seems to me not to be one which can be the subject-matter of a patent."

Abbott. C J. The nature of a "manufacture" was admirably defined by Abbott, C.J., in *R.* v. *Wheeler* (1819, 2 B. & Ald. at p. 349). He said: "Now the word 'manufactures' has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument, or some part of an engine or instrument, to be employed, either in the making of some previously known article, or in some other useful purpose, as a stocking-frame or a steam engine for raising water from mines. Or it may perhaps extend also to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind. But no merely philosophical or abstract principle can answer to the word 'manufactures.' Something of a corporeal and substantial nature, something that can be made by

man from the matters subjected to his art or skill, or at least some new mode of employing practically his art or skill, is requisite to satisfy this word."

The confusion which has arisen over the interpretation of the term "subject-matter" has been mainly due to the small degree of precision required in pleading objections to the validity of a patent. It has long been considered that the nature of an invention must be such as would have normally required **an inventive act of the mind** to have produced it, although such inventive act *in fact* may never have taken place. The merits of this legal theory will be discussed later (p. 50), but it is necessary to note here that the requirement has been discussed under the head of "subject-matter," whereas in fact it **is only relevant to the issue of novelty.**

Case to illustrate confusion.

The confusion of ideas was pointed out and ridiculed by Lord Esher in *The Edison Bell Phonograph Co.* v. *Smith and Young* (1894, 11 R. P. C. at p. 398): "Now, whenever I hear the objection taken to a patent which has been used, which has been bought and sold, which has been therefore treated by men of business, as a useful thing, that it is wanting in subject-matter, I look upon it, I confess, with an amused contempt. What is the meaning of want of subject-matter? It is not the same thing as want of invention, or rather I should say (*a*) want of novelty; it is not the same thing as want of utility, but, where you cannot maintain either of these propositions which would be sufficient to destroy the patent, it is something else which someone or other at some time has invented as an idea for destroying patents. And what is it? It really comes to this, that, although the invention is new—that is, that nobody has thought of it before—although it is useful, yet when you consider it you come to the conclusion that it is so easy, so palpable, that everybody who thought for a moment would come to the same conclusion; or, in more homely language, hardly judicial, but rather business-like, it comes to this, it is so easy that any fool could do it. Well, I look, as I say, upon that objection, when all others have failed, generally with amused contempt. It can be made out, but hardly

(*a*) N.B.—This correction is most important.

ever, when you find that which I have stated, it is hard to think that people would be buying and selling a thing—and that has been sometimes the whole thing—and yet the objection should be taken that it is wanting in subject-matter." It is clear that the Court considered that in this case subject-matter was argued by the defendant to mean the same thing as ingenuity, whereas novelty and ingenuity can co-exist without subject-matter (see p. 39); and under such an interpretation Lord Esher, with characteristic directness, ridiculed the objection.

The word "invention" ambiguous.

The many meanings which the word "**invention**" has been made to bear (*b*) is largely responsible for the confusion in the interpretation of "subject-matter." Sometimes it is used to express a step forward in an art, *i.e.*, a new manufacture; sometimes as synonymous with ingenuity; sometimes as meaning the monopoly claimed. In the first sense invention is always necessary. For example, the mere adaptation of an old principle to a new purpose is not a manufacture; but where there is a mode, process, or mechanism as the means by which the adaptation is accomplished, then that mode, process, or mechanism is subject-matter, and if it contain the qualifications of novelty and utility a patent can be obtained. This will be found to explain the meaning of several decisions in which it has been said that "the mere adaptation of an old "contrivance" to a new purpose without invention is not subject-matter (*c*).

Novelty distinguished from subject-matter.

The difference between novelty and subject-matter was illustrated by Lindley, L.J., in *Gadd* v. *The Mayor, &c. of Manchester* (1892, 9 R. P. C. at p. 525): "In considering subject-matter, novelty is assumed; the question is whether, assuming the invention to be new, it is one for which a patent can be granted. In considering novelty, the invention is assumed to be one for which a patent can be granted if new, and the question is whether on that assumption it is new. Has it been disclosed before? If there is an earlier specification for the very same thing, the second invention is not new;

(*b*) See on this point the judgment of Fletcher Moulton, L.J., in *The British United Shoe Machinery Co.* v. *Fussell, Ltd.*, 1908, 25 R. P. C. at p. 651.

(*c*) See p. 42, below.

but if the two things are different the nature and extent of the difference have to be considered. The question then becomes one of degree. But unless it can be said that the differences are practically immaterial: that there is no ingenuity in the second invention, no experiment necessary to show whether it can be usefully carried out or not, the second cannot be said to have been anticipated by the first." In this case the arguments were directed against subject-matter. The Court, however, dealt with the question as one of novelty. In many of the cases argued on subject-matter, this distinction has been lost sight of and the decision is in fact based on novelty; for, strictly speaking, **subject-matter is a question of law, while novelty is a question of fact.**

The meaning of subject-matter as manufacture is illustrated by the fact that a business scheme which involves ingenuity, novelty, and utility in its production is nevertheless not subject-matter, such, for example, as a new method of filing correspondence, or a method of keeping books (*d*).

No subject-matter in a principle.

No man can claim the monopoly of a **principle**, for that would be to claim the laws of nature, which have always existed. Man merely discovers the principle; but if, when he discovers a principle, he can discover a method of utilizing the principle so as to make it applicable to the production of a new manufacture, he can obtain a patent for the method, and to a large extent will be protected in the application of the principle itself (but see p. 42).

Cases on alleged claims to principle.

Lord Justice Clark Hope, in directing the jury in the case of *The Household Co.* v. *Neilson* (1843, 1 W. P. C. at p. 685), said: "I state to you the law to be that you may obtain a patent for a mode of carrying a principle into effect; and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and show that you are aware that no particular sort or modification, or form of the apparatus, is essential in order to obtain benefit from the principle; then you may take out your patent for the mode of carrying it into effect, and are not under the necessity of

(*d*) *E.g.*, as in *Johnson's Application*, 1902, 14 R. P. C. at p. 56.

describing and confining yourself to one form of apparatus. If that were necessary you see what would be the result? Why, that a patent could hardly ever be obtained for any mode of carrying a newly discovered principle into practical results though the most valuable of all discoveries. For the best form and shape or modification of apparatus cannot, in matters of such vast range, and requiring observation on such a great scale, be attained at once; and so the thing would become known, and so the right lost, long before all the various kinds of apparatus could be tried. Hence you may generally claim the mode of carrying the principle into effect by mechanical contrivance, so that any sort of apparatus applied in the way stated will more or less produce the benefit, and you are not tied down to any form."

In the above case, as in the case of *Neilson* v. *Harford* (1841, 1 W. P. C. 295), the patent was for producing heat in furnaces, by blowing the air for the furnace through a vessel which was heated. It was stated in the specification that the size of the vessel was to depend on the circumstances, and there was no claim. The Court held that the method suggested for carrying the principle into effect was sufficient to support a patent.

In *Otto* v. *Linford* (1881, 46 L. T. N. S. 35), claim 1 of the plaintiff's specification ran as follows: "Admitting to the cylinder a mixture of combustible gas or vapour with air, separate from a charge of air or incombustible gas, so that the development of heat and the expansion or increase of pressure produced by the combustion *are rendered gradual* substantially as and for the purposes set forth."

Jessel, M.R., in the Court of Appeal, said (p. 39): "It is said that what is claimed is a principle . . . or, as is sometimes termed, the 'idea' of putting a cushion of air between the explosive mixture and the piston of the gas motor engine, so as to regulate, detain, or make gradual, what would otherwise be a sudden explosion. Of course that could not be patented. I do not read the patent so; I read the patent as being to the effect that the patentee tells us that there is the idea which he wishes to carry out; but he also describes other kinds of machines which will carry it out; and he claims to carry it

out substantially by one or other of these machines. That is the subject of a patent." The Master of the Rolls then instanced the case of *Neilson* v. *Harford* (supra).

In *The British Vacuum Cleaner Co.* v. *Suction Cleaners, Ltd.* (1904, 21 R. P. C. 303), the invention consisted in an apparatus involving a new principle applied to the cleaning of carpets by vacuum. The inventor discovered that it was essential to success to so drive the pump and apply the pipes, that a strong vacuum might be maintained at the carpet and at the filter. Other suction apparatus had been used before the date of the patent, but no one had appreciated the importance of maintaining a high vacuum. It was argued for the defendants that this was merely a patent on a question of the degree of the vacuum. Farwell, J., said: "The whole point of it is as is stated there: that it is essential to practical success to drive the pump by power, and to maintain a vacuum of at least 5 lb. per square inch at the filter. That appears to me to be a perfectly good process and well and sufficiently stated, and I do not feel myself at liberty, with regard to an invention or process of this sort, to tie down the inventor to the particular figures which are set forth in these drawings. If he were tied to these drawings, as to which I had some little hesitation at first, it is probable that the defendants might be able to say then with success that they did not infringe."

Arrangement of parts on new principle.

An invention which consists in a particular arrangement of old parts on a new principle, although not quite the same thing as a method of carrying out a new principle, is treated in much the same way by the Courts.

So in *The Edison Bell Phonograph Co.* v. *Smith* (1894, 11 R. P. C. 148), where the plaintiffs claimed in their specification:—"In a phonograph, attaching both the recording point and the reproducing point to the same diaphragm, means being provided whereby either of the points may be brought into operative position on the surface of the phonogram." It was pleaded by the defendants that this was a claim for the principle of attaching both the points to the same diaphragm. Wright, J., held that it was not so, deciding it to be "a claim for a particular arrangement of essential parts of a machine, which

arrangement has obvious advantages, but has never before been made practicable, and which has now been found practicable in a way disclosed by the specification. Such a claim ought probably to be construed as a claim of monopoly for that arrangement carried out by any means substantially similar to those disclosed in the specification."

Claim to universal application void.

A claim to **every method of application** of a principle is a claim to the principle itself, and not being a manufacture is not subject-matter (*e*).

Claims to applications of new principles have wide scope.

Where a new principle has been shown newly applied to some new object, the method of application shown will be given a very wide construction by the Courts, and as Wright, J., said: "Such a claim ought probably to be construed as a claim of monopoly for that arrangement carried out by any means substantially similar to those disclosed in the specification" (*f*). In the Court of Appeal, Cotton, L.J., speaking on this subject, said: "Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle, and say they do it by a different mode, and looks to see whether in effect, although the mode is not exactly the same, it is only a colourable difference, a mechanical equivalent for a substantial part of the patentee's invention being looked upon as a mere colourable difference" (*g*).

The construction of the claim in relation to its ambit will be more fully discussed in Chap. XIV. on Infringement.

Novel application of old principle.

Cases to illustrate and explain.

The novel application of an old principle is subject-matter if it constitutes a useful manufacture, but the patentee is strictly tied down to the application which constitutes his invention, and valid patents may be obtained by others for different methods of carrying the same principle into effect. Some difficulty

(*e*) *Neilson* v. *Harford*, 1841, 1 W. P. C. at p. 355; *Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 R. P. C. at p. 308; *The British United Shoe Machinery Co., Ltd.* v. *Simon Collier, Ltd.*, 1908, 26 R. P. C. at p. 49.

(*f*) *Edison Bell Phonograph Co.* v. *Smith*, 1894, 11 R. P. C. at p. 148 (quoted supra).

(*g*) *The Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 R. P. C at p. 304; and see *Ashworth* v. *English Card Clothing Co.*, 1903, 20 R. P. C. 790.

cp Hickin Pickett 1909 R.P.C. p 346

is usually experienced in ascertaining whether the method of application of the old principle is **really novel.** It must be remembered that an **anticipation** must be such as to enable any competent person to carry out the invention claimed without any particular difficulty, and in cases where the patent has been held valid the *ratio decidendi* has usually been that the former applications of the old principle would not have led a competent person to the discovery of the new application, and consequently were not anticipations. As has been pointed out above in cases such as *Gadd* v. *The Mayor, &c. of Manchester*, the argument against the patent usually proceeds upon the assumption that the invention claimed is for "the old *machine* applied to a new purpose," whereas it is not the old *machine* applied to a new purpose, but an old *principle* newly applied to a new purpose, and what are cited as "previous applications of the old machine" are shown to be applications of an old principle which do not *anticipate* the present application, as the application to the new purpose involves special difficulties. Of course, if the old machine (same in fact as the new machine) is merely applied to a new purpose, there is no manufacture, and the invention, although novel and useful, fails for want of subject-matter. "On the one hand, the discovery that a known thing—such, for example, as a Planté battery—can be employed 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 a 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. It is often extremely difficult to draw the line between patentable inventions and non-patentable discoveries, but I have endeavoured to state the distinction as I understand it, and so far as is necessary for the purposes of the present case" (*h*). The following cases will illustrate the principle of law involved.

Contrivance and principle distinguished.

The "Lane-Fox Case."

(*h*) Lindley, L.J., in *Lane-Fox v. Kensington and Knightsbridge Electric Lighting Co.*, 1892, 3 Ch. at p. 429; 9 R. P. C. at p. 416.

Cases on novel application of old principle.

In *Penn* v. *Bibby* (1866, L. R. 2 Ch. 127) the invention related to bearings for screw propeller shafts of vessels. The specification described the inner surfaces of the bearings as having grooves to receive fillets of wood which projected to some extent beyond the inner surfaces of the metal bearings, so as to prevent the shaft coming into contact with the metal of the bearings, the spaces permitting water to flow freely between the shaft and the inner surfaces of the metal bearings. Great utility was proved. The nature of the alleged anticipations is shown in the judgment of Lord Chelmsford, L.C., who said: "In every case of this description one main consideration seems to be whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study. Now, strictly applying this test, which cannot be considered an unfair one, to the present case, it appears to me impossible to say that the patented invention is merely an application of an old thing to a new purpose. The only examples of old use alleged by the defendant were in grindstones and water-wheels. No doubt these have what may be called bearings, but they are of a totally different character and for a totally different object, from the bearings patented. In neither water-wheel nor grindstone is there a wooden bearing in which the wheel revolves, but the wheel is merely supported on wood, not encased or submerged, nor constructed for the purpose of admitting the water to flow freely within the bearing, and the revolutions of each of them are at a very slow pace. It is difficult to believe that bearings of this description could ever have suggested the application of wood to the bearings of screw propellers in the way described in the patent."

In *Gadd* v. *The Mayor, &c. of Manchester* (1892, 9 R. P. C. 516) the object of the plaintiff's patent was to keep gasometers vertical without having recourse to the external guiding frames generally used; this object was not in itself new, but had never been attained by any method resembling that employed by the patentees. The principle employed by them was one which had previously been described in specifications of inventions for keeping flouting docks and pontoons in a horizontal position.

It was held by the Court of Appeal, reversing the decision of the Court below, that in the application of that principle to gasometers there were practical difficulties to be overcome which required a considerable degree of ingenuity, and was good subject-matter for a patent. Lord Justice Lindley (at p. 524), after an elaborate review of the authorities, expressed the law upon this subject by the two following propositions: "1. A patent for the mere use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties, is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention: no manner of new manufacture within the meaning of the statute of James. 2. On the other hand, a patent for a new use of a known contrivance is good, and can be supported if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own. 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."

In the second example the learned Lord Justice was employing the term "contrivance" in a wide sense, or as synonymous with "principle." This is shown by the passage on p. 523, in which he prefaced his discussion of the law with a statement of the facts. "The plaintiffs have used, for keeping gasometers upright, principles previously described by *Wild* and *Stansfield* for keeping floating docks and pontoons horizontal. Under these circumstances, can the plaintiffs' patent be supported?" Later on, after enunciating the above quoted proposition of law and discussing the authorities, he said, at p. 525: "A specification which discloses a principle and applies it to one thing will not necessarily invalidate a subsequent patent for the application of the same principle to another thing." He then proceeds to distinguish between novelty and subject-matter in the passage quoted at p. 38, and decides on the validity of the plaintiffs' patent as a question of *novelty, i.e., fact*, in the following passage (p. 526): "Applying this test to the present case, I cannot regard *Wild's* or *Stansfield's* specifications as anticipations

of the plaintiffs' patent. Their invention involved more than *Wild's* or *Stansfield's* has described. They showed the principle, but their attention was not turned to gasometers, and they did not show how to apply the principle to them. I am convinced that this was by no means so easy and obvious as the defendants contend."

In *Brooks* v. *Lamplugh* (1898, 15 R. P. C. 33) the patent was for improvements in bicycle saddles, and consisted in the application of the old principle of the "trussed beam" for supporting the saddle-frame. The improvement was very great. No one could deny that the principle utilised by Brooks was well known, but it had never before been applied to saddles. The old saddles had given great trouble by continually breaking. The Court of Appeal held that the novel application, coupled with the resultant improvement, constituted subject-matter. Lord Justice A. L. Smith stated the law in much the same terms as were used by Lord Justice Lindley quoted above. Care must, however, be used to realise clearly the signification with which the word "contrivance" is used. Sometimes Lord Justice Smith uses it in a wide and sometimes in a narrow sense.

In *The Cassel Gold Extracting Co.* v. *The Cyanide Gold Recovery Syndicate* (1895, 12 R. P. C. 232), the patent related to the recovery of gold from ore and base metal by means of a solution of cyanide of potassium. It was proved that it was well known, prior to the patent, that a solution of cyanide of potassium used together with other materials would dissolve gold out of its ore. The patentee discovered that if the solution was applied in a dilute form a new selective action took place and the gold was separated from the ore and the baser metals without the necessity of using any other substance. The Court of Appeal (Halsbury, L.C., Lindley and Smith, L.JJ.) held that there was good subject-matter (*i*).

Method of application of old principle must be novel.

The following cases illustrate the rule that when the method of application of the old principle to the new purpose is not

(*i*) And see *Thomson* v. *American Braided Wire Co.* (*The "Bustle" Case*), 1889, 6 R. P. C. at p. 523.

novel there is no new manufacture and the patent is invalid, although the ultimate result obtained be novel and useful. Here, again, it is necessary to remember that in considering novelty the Court inquires, as a question of fact, whether the alleged anticipation would have led without special difficulty to the patented invention. Test of novelty.

In *Bush* v. *Fox* (1856, Macr. P. C. at p. 164) Chief Baron Pollock graphically illustrated the point we are now discussing. He said: "I think if one man invents a new mode of looking at the moon, somebody else cannot take out a new patent for looking at the sun. If a man were to take out a patent for a telescope to be used to make observations on land, I do not think anyone could say, 'I will take out another patent for another telescope to be used for taking observations on the sea.'" That case was ultimately confirmed in the House of Lords.

In *Harwood* v. *G. N. R.* (1865, 35 L. J. Q. B. 27) (a case very frequently cited), the patentee used a "fish plate" for joining together the ends of rails. The evidence showed that this particular form of joint had been applied in various mechanical contrivances, and notably in the joining together of pieces of timber used in bridge building, with pieces of channelled iron. It was more or less agreed, however, that exactly the same kind of strains were not involved, where the earlier applications were made. But Lord Chelmsford, L.C., said (at p. 38): "Then the question is whether there can be any invention of the plaintiff in having taken that thing, which was a fish for a bridge, and having applied it as a fish for a railway. Upon that I think that the law is well and rightly settled, for there would be no end to the interferences with trades, and with the liberty of any mechanical contrivance being adopted, if every slight difference in the application of a well-known thing were held to constitute a patent. . . . No sounder or more wholesome doctrine, I think, was ever established by the decisions which are referred to in the opinions of the four learned judges, who concur in the second opinion delivered to your lordships, namely, that you cannot have a patent for a well-known mechanical contrivance, merely because it is applied in a manner, or to a purpose which is analogous to the

manner, or to the purpose in or to which it has been hitherto notoriously used. The channelled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well-known contrivance, to a purpose exactly analogous, or corresponding to the purpose, to which it had been previously applied."

In *Morgan* v. *Windover* (1890, 7 R. P. C. 131) the patent consisted in the application of C springs, which previously had only been employed on the back of a carriage, to the fore part, and arranged so as not to interfere with the fore wheels and their motion in turning the carriage. This contrivance was new, and was admitted to give greater ease and comfort in the motion of the carriage to which it was attached. The patent was upheld in the lower Courts, but these decisions were reversed by the House of Lords, where it was held *nem. con.* that there was not sufficient ingenuity disclosed to support a grant of letters patent. Lord Herschell, in his judgment, said (at p. 137): "Now, my lords, if it had required mechanical ingenuity and skill to adapt the composite springs which had hitherto been used in the hind part of a carriage to the fore part of a carriage, so that it was not the mere substitution in front in substantially the same way as the substitution had taken place at the back, but that it needed some skill and ingenuity to adapt to the front part of the carriage that which had been applied to the back, I should have thought that there was sufficient subject-matter, and that the patent could have stood. But when once it is admitted that all that can be claimed as new is the idea of putting it in the front instead of at the back, *and that when once that idea was entertained, any workman told to do it would, without any instructions or any special mechanical skill, be able at once to do it,* it seems to me that that really concludes the case against the respondents" (*k*). *Blakey* v. *Latham* (1889, 6 R. P. C. 184 (*The "Shoe Heel-plate" Case*)) is another useful example of want of subject-matter of this kind.

(*k*) And see the judgment of Lord Davey in *The Acetylene Illuminating Co., Ltd.* v. *United Alkali Co.*, 1905, 22 R. P. C. at p. 155.

Mere skill is not subject-matter.

It must be remembered that although it is true to say that the alleged anticipation must lead without special difficulty to the invention patented, yet the person who uses tools to produce some new result **cannot take out a patent for the mere care and skill** which it may require to adapt his tools to the particular result which he seeks. Skill is not a new manufacture, and an arrangement which, when examined, proves to be what any skilful person would adopt to effect the new purpose, if using the old tool or instrument, is not subject-matter. For instance, in *Dredge* v. *Parnell* (1899, 16 R. P. C. 625) the patent was for a method of cutting out necktie linings. The material to be used was exceedingly soft and fluffy. The patentee placed many layers of the material between a pair of templets of the required shape, which templets he screwed tightly together to get sufficient resistance in the material thus compressed, which he then cut through with a band knife, using the templets as guides. The use of one templet and a band knife was old, and veneers had been cut in this way. Lord Halsbury, L.C., said (at p. 629): "I should say it would be more true to say that the skilled workman found out in the arrangement of his tools that he ought to do what has been done here than to say that he had made an invention, because this is only an arrangement of his tools, and they are applied practically in the same way, though, I admit, requiring additional strength to the bottom part of the material, as well as to *the top*, and *the application of a templet to the* material, which is intended to be cut out, adapted to that particular material. When I come to analyse these elements of the supposed invention, I confess I am unable to see that there is anything in them which amounts to invention. What I should say is, that it is a rather more skilled and experienced application of the same old and well-known tools to the same sort of process that is applicable to fabrics of a firmer texture."

But where the use of the old tool requires more than mere skill in the method of its employment to produce the new result:—where the ordinary degree of skill in the use of the tool would not have sufficed, but an **entirely new method of use has to be employed**, then such new use amounts to a new

manufacture and is subject-matter for a patent. Before the industrial revolution which took place in the eighteenth century, the judges seemed to be in doubt as to whether the term "manufacture" could include method, and were inclined to limit it to tangible articles only. These views were finally swept away by the judgment of the Court of King's Bench in *Boulton* v. *Bull.* The arguments and the judgment are fully and clearly reported in Dav. P. C. p. 162.

Explanation of requirement of ingenuity.

Concerns novelty only.

It will have been observed that in decisions upon the new application of an old principle much use has been made of the word "**invention.**" It must not be imagined that the State attaches the slightest importance to what has actually occurred in the mind of an inventor (*l*). Patents have been held valid for inventions that have been the result of the merest accident (*m*), and for inventions imported from abroad. But in considering whether any given application can be considered **novel** or not in the light of prior applications of the same principle it is necessary to inquire whether in fact the new application would be indicated by an examination of the old application. In considering this question regard must be had to the class of persons to whom the specification is addressed and who are concerned in the act with which the invention deals. If it can be shown that the new result was long sought for:—if it be shown that persons of this kind had been working without success to attain it, and had long regarded it in the light of a problem, and that the invention of the patentee successfully solved the problem,—then such a state of affairs constitutes evidence of the strongest kind that the prior applications did not in fact give a clear clue to the solution and ought not to be considered as anticipations. Therefore "ingenuity" has nothing to do with subject-matter. What occurred in the mind of the inventor would be utterly immaterial even if it were discoverable. But the fact that the problem was not and could not clearly be solved with the materials available is evidence that the solution offered by the

(*l*) See Tindal, C.J., in *Crane* v. *Price*, 1842, 1 W. P. C. at p. 411.

(*m*) See *Liardet* v. *Johnson*, 1 W. P C. at p. 54.

inventor is novel *in fact;* and it is with this meaning that judges have used the term "evidence of invention."

The attention of the reader is recalled to the words of Lord Esher quoted at p. 37, supra, and the following quotations are offered in support of this view.

Evidence of novelty further discussed.

In *Lyon* v. *Goddard* (1893, 10 R. P. C. 334) Lord Esher, at p. 343, used much the same expressions as he did in the case cited at p. 37, supra, and Bowen, L.J., said: "When you see that the point of this invention is that it enables a process which has been discovered since, to be carried out in a machine which alone is adapted for that purpose and process, and when you observe the marked and beneficial effect, and the **commercial** and the scientific **success** of the new machine, you can only answer the question whether there has been ingenuity in one way. I think, not only that there has been ingenuity, but I think myself that there has been very great ingenuity in it, and none the less because it is easy afterwards, as has been pointed out, to say other people might have seen the result."

Unsatisfied demand.

In *Gosnell* v. *Bishop* (1888, 5 R. P. C. at p. 158) Bowen, L.J., said: "Where there has been for some time a long **unsatisfied demand**, and then suddenly an article springs into existence and satisfies it, the length of time during which the demand has remained uncomplied with is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle that otherwise would seem, from the mere existence of the long unsatisfied demand, to have existed somewhere or in some shape."

And in *Hinks* v. *Safety Lighting Co.* (1876, L. R. 4 Ch. D. at p. 615) Jessel, M.R., said: "Where a **slight alteration** in a combination turns that which was practically useless before into that which is very useful and very important, judges have considered that, though the invention was small, yet the result was so great as fairly to be the subject of a patent; and, as far as a rough test goes, I know of no better."

But commercial success **alone**, without the solution of a previous difficulty, **will not establish novelty** or that the invention is a manufacture. For commercial success is often due merely

to commercial enterprise, or the awakening of a new demand. The case of *The Haskell Golf Ball* v. *Hutchinson* (cited at p. 35) is an instance in point.

In the case of *Longbottom* v. *Shaw* (1891, 8 R. P. C. at p. 336) Lord Herschell said: "Great reliance is placed upon the fact that when this patent was taken out and frames were made in accordance with it, there was a larger demand for them. . . . I do not dispute that that is a matter to be taken into consideration; but, again, it is obvious that it cannot be regarded in any sense as conclusive. I think that its value depends very much upon certain other circumstances. If nothing be shown beyond the fact that the new arrangement results in an improvement, and that this improvement causes a demand for an apparatus made in accordance with the patent, I think that it is of very little importance."

In *Thierry* v. *Rickman* (1897, 14 R. P. C. at p. 115) Halsbury, L.C., said: "Whether there is or is not invention such as will support a patent is a question of fact and degree, and the state of facts and degree in one case can never be any guide in another. It is certainly quite true that mere simplicity will not prevent there being invention." He then referred to *Hinks* v. *Safety Lighting Co.* (1876, L. R. 4 Ch. D. 607) and *Brook* v. *Aston* (1859, 8 E. & B. 478), and continued: "I refer to these two cases only as illustrative of the proposition that no smallness or simplicity will prevent a patent being good, while mere novelty of manufacture or usefulness in the application of known materials to analogous uses will not necessarily establish invention within the meaning of the patent laws" (*n*).

Patentability of new product discussed.

Doubts have been expressed as to whether a patent can be granted for a new product irrespective of the manner in which it has been brought into existence. It is submitted that such a grant would be wholly invalid since it would not be for a manufacture at all. For example, a new metal might be smelted from some well-known mineral, which metal might possess extraordinary qualities, and become indispensable. A valid

(*n*) And see A. L. Smith, J., in *Elias* v. *Grovesend Tinplate Co.*, 1890, 7 R. P. C. at p. 461

patent could be obtained for the process of smelting, if novel in itself (*o*), which would probably receive a wide construction so as to cover any substantially similar process. But if someone discovered a vein of the metal in a pure state requiring no smelting, the person who had actually first discovered the metal, and patented the process of smelting, could not have a patent to prevent the owner of the vein from selling the produce of his mine. The same remarks apply to a chemical product. Of course the use of the product in manufactures could be patented if the patentee described some particular method of using it. In other words, a discovery of properties is not a manufacture.

The judgment of Lord Davey in *The Acetylene Illuminating Co.* v. *United Alkali Co.* (1905, 22 R. P. C. at p. 153) contains some observations which would seem to indicate a contrary view, but it is respectfully submitted that the remarks are *obiter dicta* and were clearly not necessary to a decision on the facts of that particular case; moreover, the point was not argued. His lordship said: "The title of the patent, which is still retained, is 'Improved metallic carbides applicable for use in the production of acetylene, and means for producing the same.' I need scarcely say that if the patentee had discovered a new material of the character which he mentions, a material having the very valuable commercial properties which he ascribes to it, that would have been a good subject-matter for a patent, and there would have been no question, supposing that he had done so, that his patent was a good one. He would be bound, of course, to state the means by which he produced that material; but the novelty of the means or the process by which the material was produced would have been immaterial, because the merit and the novelty of the invention would consist in the substance produced itself." This case was decided upon the ground that neither the substance nor the method of manufacture were novel. The remarks of Cotton, L.J., in *Worwerk* v. *Evans* (1890, 7 R. P. C. at p. 271) are open to the same comment (*p*).

(*o*) See p. 57, infra.

(*p*) See also the remarks of Eyre, C.J., in *Boulton* v. *Bull*, 1795, Dav. P. C. at p. 208.

Equally *obiter* were the observations of Buckley, J., in *Kopp* v. *Rosenwald* (1902, 19 R. P. C. at p. 211), expressing the contrary view. The "invention" there consisted in an entirely new article (strips of whalebone braided together with a selvedge for sewing) by the use of a machine which was old. The claim was for "The manufacture of the new material, strips of natural whalebone covered or braided with threads of fibrous material applied substantially in the manner and by the means hereinbefore described with reference to and shown in the drawings." It was not denied during the case that the article produced was quite new and useful. Buckley, J., said: "The subject-matter of this invention, Mr. Terrell tells me, is that the patentee says there is a well-known thing known as a braiding machine, and that he tells you, 'Select a particular type of that well-known machine, namely, one with four heads and thirteen spindles. Use it in the way indicated in my specification, and the result is you will produce an article which is new,' and that is patentable. Now I doubt myself whether, in the strict sense of the word, an article can ever be treated as being in itself the subject of a patent. In saying that, I am not for a moment forgetting *Thompson* v. *American Braided Wire Co.* in the House of Lords. What I mean is that, assuming that an article is produced by a particular process, and that that article is new, you may say that you take out a patent for the article in the sense that it is a new thing, and it is got out in a way which was not known before, but I do not think it has ever been laid down that it would be an infringement of a patent for that article if someone ascertained a totally different path by which you would arrive at the same completed thing." The patent was held invalid by the learned judge on the ground that the claim was for a process, and that the process itself was old—its new application requiring no invention. It is submitted that the reasoning of Buckley, J., was correct. The invention must be of "a new manufacture," and protection will be granted against any method of manufacture of the new product which is substantially similar to that of the patentee. In other words, the construction will be wide, as is usual where a new process is applied to effect a new result.

It is respectfully submitted that upon the cases, the decision of Sir R. Finlay, A.-G., in *Cooper's Application* (1902, 19 R. P. C. 54) was erroneous, although the object of the invention was new. In that case the patentee claimed the method of printing a newspaper in such a manner as to leave narrow blank spaces along the lines on which the newspaper would be folded. The Attorney-General decided that this was a new manufacture. But when examined such a claim seems merely for a newspaper printed in a particular way and not for a process for the arranging of the type.

Old material applied to new purpose.

The application of an **old material for a new purpose, or the discovery of a use for an old material formerly thought useless,** may be the subject of a patent; for instance, *Muntz* v. *Foster* (1844, 2 W. P. C. 103) was an action for an infringement of a patent for the manufacture of metal plates to be used for sheathing the bottoms of ships. The improvement consisted of using an alloy of zinc and copper in certain proportions for the manufacture of the plates, and for this purpose copper alone had hitherto been used. The alloy of zinc and copper was to produce an old and well-known material; still, the application of that old material to sheathing of ships had not before been discovered, and upon its being shown that such an application was a great improvement on the old method of sheathing with copper, it was held that the patent could be sustained.

In the case of *Steiner* v. *Heald* (1851, 20 L. J. Ex. 410), in the Exchequer Chamber, the head-note is inexplicable and erroneous. If the case itself is read, it will be found to be in accordance with the other decided cases on this subject: In the ordinary process of dyeing, by means of madder, the colouring matter was obtained from fresh madder by the application of hot water; the refuse, after boiling, was called spent madder. It had long been known to dyers that a portion of the colouring remained in the spent madder, but it was not known how to extract it, as it remained in combination with the plant; recently it was discovered that by means of acid and hot water the pure colouring matter of madder, called garancine, could be obtained from fresh madder, and that

this process extracted the colouring matter of the plant. The plaintiff obtained a patent for the new manufacture of garancine, by applying the same process of acid and hot water to the spent madder; since his invention the spent madder, which was previously worthless, became valuable.

At the trial Chief Baron Pollock directed the jury to find a verdict for the defendant, upon the ground apparently that there was no subject for a patent; in reversing this decision, Mr. Justice Pearson said: "Now spent madder might be a very different thing from fresh madder in its properties, or it might be in effect the same thing as fresh madder in its properties, chemical and otherwise, with the difference only that part of its colouring matter had been already extracted. Again, the properties, chemical and otherwise, might or might not have been known to chemists and other scientific persons, so that they could find out whether fresh madder and spent madder were different or substantially the same things. The points appear to us to be questions of fact, and materially to affect the validity or invalidity of a patent." It will appear, therefore, that the Court were of opinion that it was a question of fact whether spent madder and fresh madder were the same thing in their chemical properties; if they were, no patent; if they were not, the validity of the patent would be sustained, but the fact must be decided by the jury.

New use for old produot.

But it is necessary to establish novelty in the patented use of the old material. In *The Albo-Carbon Light Co.* v. *Kidd* (1887, 4 R. P. C. 535) the disputed claim was "The use of solid naphthaline prepared in the form of sticks, rods, or pellets for the enrichment of combustible gas, substantially as herein described." It was shown that the use of naphthaline (though not in solid form) was known for enriching gas, and the existence of solid naphthaline was also old. The method of application described involved no novelty and the patent was declared invalid.

In *McLay* v. *Lawes & Co.* (1905, 22 R. P. C. 199) the invention consisted in utilising the calcium sulphate obtained as a waste product in the manufacture of tartaric acid, in conjunction with agglutinating materials to form a non-conducting "cagging" for boilers. It was proved that the

use of calcium sulphate, as obtained from other sources, was well-known for this purpose. The patent was declared invalid.

Processes.

The judges at first seemed to be inclined to limit the subject-matter of letters patent to new *articles* produced; but as the arts and manufactures of the country progressed and increased, it was seen that by far the most important inventions were inventions of **processes** for making old and well-known articles of commerce, and so it became evident that should the construction of the words "new manufactures" be entirely limited to the production of new articles, to the exclusion of the process of manufacturing old articles by cheaper, better and improved methods, the inducement which the common law intended to give to inventors would be curtailed to the narrowest possible limits. The judgment in *Boulton* v. *Bull* (1795, Dav. P. C. 191) confirmed the change of opinion, and in 1841, in the case of *Gibson* v. *Brand* (1 W. P. C. at p. 633), Tindal, C.J., said: "The patent is taken out 'for a new or improved process for the manufacture of silk, and silk in combination with certain other fibrous substances,' taken out therefore strictly for a process . . . undoubtedly there is a very strong reason to suppose if the specification is carefully and properly prepared, so as to point out with great distinctness and minuteness what the process is, that such a patent may be good in law. Such certainly was the opinion of Chief Justice Eyre in *Boulton* v. *Watt* (1795, 2 H. Bl. 468; Dav. P. C. 207), and such also appears to have been the opinion (carefully guarding against any abuse of that doctrine) of Lord Tenterden in the case of *The King* v. *Wheeler* (1819, 2 B. & Ald. 349), who said that 'the subject-matter of letters patent, *i.e.*, the word "manufacture," as used in the statute of James, is generally understood to denote either a thing made, which is useful for its own sake, and vendible, or to mean an engine or instrument, or some part of an engine or instrument, to be employed either in the making of some previously known article, or in some other useful purpose . . . or it may perhaps extend also to a new process to be carried out by known implements or elements acting upon known substances, and ultimately producing some other known substance,

but producing it in a cheaper or more expeditious manner or to a better or more useful account.'"

Modern instances of valid patents for processes are so numerous that it is not necessary to quote them.

Combinations. We have now to deal with that most important part of patent jurisprudence—that which concerns the validity of patents for **new combinations.** New combinations of new with old contrivances, or of old contrivances with other old contrivances, are principally to be met with in the field of labour-saving machinery. New principles are rarely met with. Fundamental departures from old methods of manufacture are not so common nowadays as are new arrangements in old machines of their various parts (which in themselves as mechanical appliances are seldom novel) to produce old effects in a better, cheaper, or more expeditious manner. Lord Justice (then Mr.) Fletcher Moulton, in his presidential address (1904) to the Junior Institution of Civil Engineers, in dealing with this fact, said: "It is here that the lawyers' difficulties are greatest. The benefits of the patent laws are confined to inventions, and it therefore becomes necessary, in deciding whether a new machine or a modification of an old machine is good subject-matter for letters patent, to put to oneself the question, 'Does it involve invention?' The decision is not difficult when it involves a new cycle, or a wholly new mechanism for accomplishing an old cycle. But when it consists of an improvement on old mechanism by the substitution of different but equivalent devices, the task is one of great nicety. It would seem to be necessary to fix upon some definition of invention, but this has never been done, and in my opinion no definition of invention can be found which is of the slightest assistance to anyone in a case of difficulty. . . . When you approach the dividing line it is so impossible to get a test that it becomes, more or less, a matter of personal opinion. Some of the elements of a combination are altered so as to improve, but not essentially change its working. Is that a new invention? If it is only the substitution of mechanical elements which are notoriously the equivalents of the old elements the law is clear, but in any other case it is

treated as being a question of fact for the judgment of whatever tribunal has the duty of deciding. Our Courts in this, as in many other questions, lean to the practical rather than the dogmatic. They impose no rigid test such as that to which the German Patent Office inclines, viz., that the new combination must produce a different technical result. To do the same thing better, or in a way so different that it gives to the public a useful choice of means, may with us be sufficient to support the claim to invention. And I have little doubt that if a case should arise in which a judicious selection out of the list of known and notorious mechanical equivalents gave an unforeseen and markedly superior result, the Courts would consider themselves free to hold it to be an invention, and in treating the decision as thus dependent on the resulting utility they would only be following the dictum of Lord Watson: 'There are many things which you cannot say are or are not inventions until you have tried them.'"

It is unnecessary to quote the cases which in the early history of patent law went to establish that patents for new combinations were valid. New combinations are such a feature of modern machinery and of modern patent practice that the principle hardly needs argument. But it is important to remember that the combination must in *fact* be a combination and not a mere juxtaposition—the parts must combine for some common result. As Buckley, L.J., said in *The British United Shoe Machinery Co.* v. *Fussell* (1908, 25 R. P. C. at p. 657), "For this purpose a combination, I think, means not every collocation of parts, but a collocation of inter-communicating parts so as to arrive at a desired result, and to this, I think, must be added that the result must be what, for the moment, I will call a simple and not a complex result. . . . It is not every combination of parts which is for this purpose a combination" (*q*).

Meaning of "combination."

The principle enunciated by Buckley, L.J., is illustrated by the well-known "*Sausage-machine Case*": *Williams* v. *Nye* (1890, 7 R. P. C. 62). The patent in that case was for

The "Sausage-machine Case."

(*q*) And see Lord Davey in *Klaber's Patent*, 1906, 23 R. P. C. at p. 469.

a machine for mincing meat and filling the minced meat into skins so as to make sausages. In fact it consisted of a well-known form of mincing machine which fed the meat to a well-known filling machine so as to combine in one apparatus two machines which had formerly been used separately. The mincing part performed no more than its already well-known functions, and the same remark is true of the filling part. The ultimate result was novel and useful, but there was no "manufacture" in the mode of combination as opposed to novelty of purpose. The Court of Appeal applied the same principle of law as has been illustrated in the case of the novel application of an old principle in which the mode of application cannot be considered as novel. The case of *Wood* v. *Raphael* (1896, 13 R. P. C. 730) (*The "Eye-glass Case"*) is another well-known illustration. There the patent was for a new combination of parts in a pince-nez. It was shown that pince-nez with a rigid bridge piece and a spring to cause the glasses to grip the nose were well known. It was also shown that in other forms of glasses the "plaquet" or pieces that come into contact with the side of the nose had been hinged to secure greater adjustability. The plaintiff's improvement consisted in combining the well-known feature of the adjustable plaquet with the well-known glasses with a rigid bridge. Romer, J., said: "It now appears that pivoted plaquets as applied to pince-nez with spring bridges were perfectly well known, their qualities were well known, their advantages and disadvantages; and all that the plaintiff's so-called invention comes to is this: that to a well-known article he has given an additional well-known feature; not to do anything new to the glass as a whole, in my opinion, but merely to give to the original well-known article the well-known qualities of the addition. In my opinion there was nothing novel in the application of that extra feature, or in the purpose for which it was applied; there was no difficulty in adding that additional feature if so desired. Certainly no invention was required to add it." This judgment was confirmed by the Court of Appeal (*r*).

The "Eye-glass Case."

(*r*) 1897, 14 R. P. C. 496.

There is one field of invention in which the Courts are loth to decide that a new arrangement of parts is not subject-matter, *i.e.*, in automatic labour-saving machinery, where a very small alteration may produce a profound result so far as ultimate success is concerned. In *The British United Shoe Machinery Co.* v. *Fussell* (1908, 25 R. P. C. 631) the patent was for a high speed machine for screwing the soles of boots to the welts. Dealing with this class of machine, Fletcher Moulton, L.J., said (at p. 646): "Its merit is that it does this operation at a high speed, and with unvarying accuracy, so that you can work these machines so as to yield a huge output without making wasters. That is the commercial definition of a high speed machine. . . . When you come to a machine of this type, you have to alter very seriously the canons which influence you in deciding such questions as novelty. In the case of operations which have to be done under normal circumstances, in the absence of any special difficulties arising from speed, small and trivial alterations in the apparatus are viewed with suspicion, as possibly being idle variants; but when you come to machines which with this demand upon them still give uniform success, I think any tribunal will be very careful before it applies its ordinary ideas of what are mere idle and trivial changes to those alterations which have resulted in a success so triumphant. So that I approach the consideration of novelty in this case, *i.e.*, of the importance of apparently slight variations in the combination, in a very humble spirit, willing to be taught by those who know the practical performance of the machine, and are able to judge of the means which render that practical performance so successful."

Labour-saving machinery.

The case of *The Anti-Vibration Incandescent Lighting Co.* v. *Crossley* (1905, 22 R. P. C. 441) is an interesting instance of the length to which the Courts will go in conceding subject-matter, where a new and useful result is attained. In the course of this case most of the "stock" cases were cited. The facts are sufficiently set forth in the judgment of Collins, M.R., who said: "The object of the invention in question is to protect the mantle used in incandescent gas

The "Anti-Vibration Case."

lamps from damage by vibration. The only question before us is one of subject-matter. The claim is for a combination, all the factors in which are old. I will read the provisional specification and the claim in the complete specification. 'The nature of this invention is as follows: An elastically (or spring) suspended frame (or holder) for use with the incandescent gas burners as a preventer or destroyer of vibration. As the incandescent gas burners cannot be used at present in mills and places where there is vibration (the vibration rattling the mantles to pieces) I have overcome this difficulty by making a wire (or metal) holder (or any other substance would do) and by suspending it with elastic (or strings could be used) the gas being conducted by a rubber pipe thus all vibration is overcome and the mantles do not get shaken to pieces. The frame may be made in any form.' Then follows the complete specification, and it concludes thus: 'Having now particularly described and ascertained the nature of this invention, and in what manner the same is to be performed, I declare that what I claim is: A gas burner fitting combined with a flexible connecting tube and suspended by one or more elastic cords or springs connected thereto, all arranged substantially in the manner as shown and described and for the purposes as hereinbefore set forth.' At the date of the patent a common means of mitigating vibration in the case of portable lamps was to suspend them by elastic cords or springs. The rendering gas lamps portable by attaching them by flexible tubes to the gas supply was also well known. It is not perhaps quite clear that incandescent gas lamps had been used in this manner, although I am inclined to think on the evidence that they had been. The object, however, of the flexible tube was merely to admit of the lamp being moved from place to place and not to mitigate or destroy vibration, for which special purpose, so far as it appears, it had never been utilised until the patentee introduced it into his combination. I confess I was much impressed by the point made by Mr. Moulton in his opening, that the effect of the patent was to prevent a person, who at this date possessed an elastic arrangement or frame for suspending lamps, and also possessed an incandescent gas

lamp made portable by a flexible tube, from hanging the lamp in the frame. I have, however, come to the conclusion that the combination was not so obvious at the date of the patent as to leave no room for invention. The efficacy of the flexible feeding tube as an anti-vibrator had not at that time been realised. All sorts of contrivances for breaking the rigid connection between the source of vibration and the mantle had been tried without success, and it was not until the patentee had combined a hanging arrangement at the top, with a gas supply through a flexible tube at the bottom, that the problem was solved. Thus the contrivance, which is said to be so obvious as to require no invention, occurred to no one, even under the stimulus of an urgent demand, until the patentee hit upon it, and so unpromising did it appear to users, that they could not be induced to try it without an undertaking to replace the mantles so often as they were shattered by vibration. Under these circumstances I am unable to hold that the learned judge was wrong in his view that subject-matter was established. The appeal must therefore be dismissed."

It is essential to remember that the **new combination is** what constitutes **the subject-matter** of the patent, whether the invention in *fact* be the addition of a new element or the subtraction of an old element theretofore considered necessary, and it is **the new combination which should be claimed as the subject of monopoly** (see Chap. VI.).

The combination must in *fact* be novel; the mere substitution of a well-known mechanical or chemical equivalent does not constitute novelty (*s*).

In *White and others* v. *Bailey and others* (1903, 20 R. P. C. 270) the invention related to the manufacture of pocket-handkerchiefs. Before the plaintiff's machine was invented, the use of two cylinders, one to effect the pattern of the body and the other the pattern of the border, had been common, but in order to effect the change from one cylinder to the other, so as to transfer the weaving from the body to the

(*s*) See, *e.g.*, *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 358; and *Winby* v. *Manchester Steam Tramways Co.*, 1891, 8 R. P. C. at p. 67.

border, there always had been some intermediate mechanism. The plaintiff's machine entirely did away with any intermediate mechanism, and substituted direct action of one cylinder on the other; moreover, an expensive part of the other machinery called a "nog card" was abolished and cheap and simple perforated cards" substituted. All the individual parts by which these simplifications were produced were old. Hall, V.-C., held the patent valid.

PATENTS OF ADDITION.

Patent of addition.

Sect. 19 of the Act of 1907 is as follows: (1) "*Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.*"

And by sub-sect. 4: "*The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject of a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.*"

Subject-matter limited.

The wording of sub-sect. 4 is important; it does *not* mean that the grant of a patent of addition is conclusive as to the existence of *subject-matter*, but only that the form of the patent cannot be attacked. The subject-matter of a patent of addition, therefore, like that of other patents, must be a new manufacture as defined by the Statute of Monopolies, but it is limited to improvements and modifications of the original invention—*i.e.*, to inventions which would be infringements of the first patent; and in effect the new legislation is merely a relief to inventors against the burden of taxation in respect of every new improvement they may make in their inventions. Hitherto an inventor has been forced either to take out fresh patents for each improvement or to run the risk that others who, having learnt the groundwork and principle from him, may

blackmail him by patenting some trifling but commercially important improvement.

The cases which we have cited to illustrate the law on "subject-matter" are those leading cases which are most frequently cited in the Courts. The cases which illustrate the application of the principles there laid down to particular facts are very numerous. Throughout the whole of them the law as laid down by the Statute of Monopolies has been held in view, and "subject-matter" is always seen to mean "a new manufacture." The constant use of the word "invention" is extremely likely to mislead, and care must be exercised to ascertain in each case in what sense it is used. The state of mind of the inventor for this purpose is immaterial, although, from other points of view, *e.g.*, fraud, it may be relevant. The introduction of a new art is everything.

P.L.O. Act 1114 Sec 38A

In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the spec. shall not include claims for the substance itself unless such substance is produced by the special methods or processes of manufacture described & claimed.

N.P.C. XLI

581 Appln in 90. Aluminium paste for
" " 25 Vegetable butter substitute. No
" " N.S Confectionery cream No
" " J.R. Bran food No
" " C.R. Effervescent medicine No
615 " " A.L. Navigation with phonic cables No
617 " " No.

Cf. Bowaud v L.G.C.C. XXXVIII R.P.C. [illegible]

Publication. Sec 11. 1.(b) Anderson Photo Co
XLI. R.P.C. 623.

Terrell Patents v Stenhouse
XLII R.P.C. 520

CHAPTER IV.

NOVELTY.

HAVING now considered the interpretation which has been placed by the Courts upon the word "manufacture," we next examine what has been held to be a "**new manufacture,**" that is to say, to what extent "prior user" or "prior publication" will invalidate a patent. It is evident that, if the alleged new manufacture can be shown to have been in the possession of the public before the application for the grant of letters patent, there is no consideration for the grant. The patentee offers to the public, in return for the monopoly privilege, his information and knowledge respecting a new manufacture; if the public is already possessed of the information or knowledge, the supposed inventor has nothing to give. We shall see, hereafter, when we discuss the practice of the Courts in actions for the infringement of patents, that the **burden of proof lies on the infringer** when he sets up a defence of want of novelty in the alleged manufacture at the date of the patent; and it is as well to keep this in mind in reading the cases which have been decided as to what amounts to prior user or publication.

We have seen that the Statute of Monopolies is a mere declaration of that which was the law before it was passed; it was always held by the Courts that the principle of a patent grant was not an arbitrary advantage granted by the Crown to one subject in detriment to the rest, but that it was an advantage granted by the Crown to persons who introduced a new manufacture, and that it was granted upon principle, not for the benefit of the patentee, but for the benefit of the public: it being considered to the benefit of the public that reasonable encouragement should be given to inventors to induce them to devote their time, energies and resources to the improvement

of the arts and manufactures of the realm. Consequently the defendant to an action for infringement has always been entitled to allege the invalidity of the plaintiff's patent on the ground of want of novelty.

At common law.

In the case of *Hasting's Patent* (1567, 1 W. P. C. 6) the patent was in consideration of the patentee having brought into the country the making of frisadoes as they were made in Haarlem, in Amsterdam, being not used in England. The infringers defended the patentee's bill in the Exchequer Chamber, on the ground "that they had made baies very like to Mr. Hasting's frisadoes, prior to the date of Mr. Hasting's patent; they were therefore not restrained from making baies like his frisadoes." A patent was granted to "one Humphrey, of the Tower, 'for the sole and only use of a sieve or instrument for melting of lead, supposing it was his own invention, and therefore prohibited all others to use the same for a time'; and because others used the like instrument in Derbyshire, contrary to the intent of his patent, therefore he did sue them in the Exchequer Chamber by English bill, in which Court the question was whether it was newly invented by him, whereby he might have the sole privilege, or else used before at Mendip, in West country, which if it were there before used then the Court were of opinion that he should not have the sole use thereof" (*a*).

The general question in disputed patents is whether the invention was known and in use before the patent? In *Rex* v. *Arkwright* (1785, 1 W. P. C. 64), Buller, J., gave a definition of "*novelty*" which now would be considered too wide. "Thus the case stands as to the several component parts of this machine, and if upon them you are satisfied that none of them were inventions unknown at the time this patent was granted, or that they were not invented by the defendant, upon either of these points the prosecutor is entitled to your verdict.

Novelty means so far as public is concerned.

When we speak of an invention being new, we mean that it must be new so far as the public is concerned, that is, so far as

(*a*) And see the account of the "*Case of Monopolies*," in Mr. Gordon's well-known work "Monopolies by Patent."

the means of information of the public goes, and the means by which the public become possessed is immaterial (*b*). The law on this point was laid down by Lord Blackburn, in *Patterson* v. *Gas Light and Coke Co.* (1875, L. R. 3 A. C. 244), in the words of Mr. Hindmarch (p. 33): "If the public once become possessed of an invention by any means whatever, no subsequent patent can be granted for it, either to the true and first inventor himself, or to any other person, for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give" (*c*).

Is question of fact.

Therefore, the question of whether the invention is new or not is one of fact and depends on the circumstances in every case (*d*).

Prior user.

Having stated the general principles upon which a patent may be attacked for want of novelty, we may now proceed to deal particularly with cases of "Prior User," in which it is alleged that the invention has been previously put into practice within the realm. (That the invention has been put into practice in a foreign country or in a colony will not invalidate the patent—for a patent may be obtained for importing an invention from abroad.) **The prior user must have been public,** and the question of the extent of publicity required gives rise to considerable difficulties.

The making of a machine by a person who kept it secret would not amount to such a publication as would anticipate the invention of the patentee; but if the first-made machine had been used in such a manner that other persons had been enabled to acquire the knowledge of its use and application, there would be a prior user to void the subsequent patent.

In *Carpenter* v. *Smith* (1842, 1 W. P. C. 540; 9 M. & W. 304), the patent sued on was for a lock. The defendant called

(*b*) Subject to the qualification introduced by sect. 41 of the Act of 1907; see p. 74.

(*c*) See also *Lister* v. *Norton*, 1886, 3 R. P C. at p. 211; *Westley*, *Richards & Co.* v. *Perkes*, 1893, 10 R. P. C. at p. 193; *Robertson* v. *Purdey*, 1907, 24 R. P. C. 299.

(*d*) *Pickard* v. *Prescott*, 1892, 9 R. P. C. at p. 200.

a witness who proved that a similar lock had been used on a gate adjoining a public road for sixteen years prior to the patent. It was held that this invalidated the patent. Lord Abinger, C.B., analysed the meaning of the words "**public use.**" "Public use does not mean a use or exercise by the public, but a use or exercise in a public manner." In *Taylor's Patent* (1896, 13 R. P. C. at p. 482) the patent was for a fire-grate. It was revoked on the ground that a similar grate had been used in a private house in the ordinary way and under no conditions of secrecy.

In *Stead* v. *Anderson* (1846, 2 W. P. C. 147) the alleged prior user consisted in the use on a private carriage drive, the principal approach to a private house, of the kind of paving for which the patent was granted, and Baron Parke placed some considerable limitation on the meaning of the words "public use" in saying, "If the mode of forming and laying blocks at Sir W. Worsley's had been precisely similar to the plaintiff's, that would have been sufficient user to destroy the plaintiff's patent, though put in practice in a spot to which the public had not free access" (*e*).

Whether the **mere manufacture** of an article will or will not amount to a "public user" depends upon the circumstances under which it was carried on.

In *Betts* v. *Neilson* (1868, L. R. 3 Ch. at p. 436) Lord Chelmsford said: "If the evidence which I am about to examine establishes the fact that lead coated with tin by mechanical pressure, and capable of useful application, has upon any occasion been manufactured openly, not by way of experiment, but in the course of business, although not a single piece of the material was actually sold, I should hold that Betts' patent was invalidated."

In *Morgan* v. *Windover* (1889, 5 R. P. C. at p. 302), Cotton, L.J., in his judgment in the Court of Appeal, said: "If, in truth, we were satisfied that a carriage, in accordance with that which is claimed by *Mr. Morgan* as his invention, was then made, and made in a practical working shape, it would

(*e*) And see *Humpherson* v. *Syer*, 1887, 4 R. P. C. 407.

not be material that it had ever been used from that time to this, because there would have been a prior use of that which is claimed by *Mr. Morgan* as his invention; but, as was pointed out by Lord Brougham in *The Househill Co.* v. *Neilson* (1843, 1 W. P. C. 673), although, if there is a complete anticipation by prior user, the abandonment of it is nothing, yet when it is a question of whether, really, there was a carriage perfected in accordance with the plans of *Mr. Morgan*, the fact that it had never been used for thirty-six years, or something of that sort, before he took out his patent, is most material, as leading to the conclusion that that which was made in the year 1848 was not a perfect carriage in accordance with the invention of *Mr. Morgan*."

Prior secret user no anticipation.

The remarks of Lord Bramwell, in *Hills* v. *London Gaslight Co.* (1858, 5 H. & N. 336), on this subject were as follows: "If a person has invented anything which is the subject of a patent, and has kept it to himself or communicated it privately to one or two, in fact has not made it public knowledge, if anyone else discovers that invention it is new, that is to say, new in the sense that the first invention has not been published."

Dollond's Case.

In *Dollond's Case* (1766, 1 W. P. C. 43) the objection to Dollond's patent was that he was not the inventor of the method of making new object-glasses, but that Dr. Hall had made the same discovery before him; but it was held that, inasmuch as Dr. Hall had confined it to his closet, and the public were not acquainted with it, Dollond was to be considered the inventor.

Secret profitable user by patentee.

It is probable that an inventor who manufactured an article by a secret process and sold it would be unable subsequently to obtain a patent for the process, since by that means he would be enabled to derive a larger advantage than the law allows him in a monopoly for fourteen years from the date of application. The point is not without difficulty and has never been definitely decided. It has, however, received the attention of judges. Baron Parke, in *Morgan* v. *Seaward* (1837, 2 M. & W. at p. 559; 1 W. P. C. 192), said: "For if the inventor could sell his invention, keeping the secret to himself, and, when it was likely to be discovered by another,

take out a patent, he might have practically a monopoly for a very much longer period than fourteen years." Romer, J., in *Miller's Patent* (1898, 15 R. P. C. at p. 213), said: "I think it might be said to be still open in some respects for further consideration by the Court whether a person who discovers a secret process and uses the benefit of that secret process to manufacture an article which he sells publicly and commercially, and obtains considerable benefit from it, and then seeks to obtain a patent for that very same process, is entitled to hold that patent under those circumstances." It may be said, perhaps, that the common law contemplated bona fides on the part of the inventor, and a bonâ fide discovery of the invention to the public within a reasonable time, and that the working of the invention in secret and subsequent application for the patent was strong evidence of mala fides, and consequently would avoid the patent on the ground of a constructive fraud upon the public.

Secret process and sale of product by others.

A greater difficulty arises in the case of secret use by someone other than the patentee. In *Robertson* v. *Purdey* (1907, 24 R. P. C. at p. 290) Mr. Justice Parker, dealing with an alleged prior user, found in fact that the article had been manufactured prior to the date of the plaintiff's patent, but had only been used privately, and that such prior private use was not such as to invalidate the plaintiff's patent, but went on to say: "It was, however, argued that on the words of the 6th section of the Statute of Monopolies, 'which others at the time of making such letters patent shall not use,' there may be a contemporaneous user not amounting to publication which will avoid letters patent. In my opinion this argument is well founded. Suppose A. invents a process for the manufacture of dyes, keeps the process secret, and continues to manufacture and publicly sells dyes manufactured according to the process, the sale of the dyes, which might be made by any process, may not amount to a publication of the invention, but I think that A. is using the invention in such a way as to preclude B., who subsequently makes the same invention, from obtaining valid letters patent in respect thereof. This, at any rate, would appear to be the effect of the judgments of Mr. Justice

Erle and Lord Justice Campbell in *Heath* v. *Unwin* (2 W. P. C. at pp. 227, 228; 3 E. & B. at pp. 272, 273), and *Tennant's Case* (1 W. P. C. 195)." The above quoted observations are of course *obiter dicta*, and against the view expressed by Mr. Justice Parker the argument may be urged that patents are granted as a reward for the instruction of the public in a new and useful art, and that until the public are in possession of the knowledge secretly made use of, it is open to anyone to reap the reward for communicating it to them. It may be fairly replied to this answer that more than one person may be carrying on the process secretly, and consequently, unless the word "others" is to be construed strictly to mean "any other person," a great difficulty in administering the law is involved, since it will be impossible to find any fixed line beyond which the *public* may be said to be in possession of an invention.

The question is really one of policy, but the opinion of Mr. Justice Parker certainly seems correct upon a strict construction of the words "which others at the time of making such letters patent shall not use."

Experimental user.

Where the anticipating machine was **incomplete** and practically useless for the purpose for which it was intended, or, though public, was merely experimental, and abandoned as being unsatisfactory (*f*), or what was nothing more than a **scientific curiosity** of no practical value, or was merely a laboratory experiment (*g*), it has been held that a subsequent patent for a workable and efficient machine is not vitiated thereby.

Mere **experiments** with a view to discovery have been frequently held not to invalidate a subsequent patent; few inventions could be made without trial, and there are some things of such magnitude that the trials cannot practically be conducted in private; hence it has been held that the mere making of experiments, with a view to invention, does not invalidate a

(*f*) *Jones* v. *Pearce*, 1832, 1 W. P. C. at p. 124; 2 Coop. Ch. Ca. 58; *Cornish* v. *Keene*, 1835, 1 W. P. C. at p. 508; *Galloway* v. *Bleaden*, 1839, 1 W. P. C. at p. 525; *Walton* v. *Bateman*, 1842, 1 W. P. C. at p. 619.

(*g*) *Young* v. *Fernie*, 4 Giff. 577, 611; see also *Benno Jaffé* v. *Richardson*, 11 R. P. C. at p. 111.

patent whether made by the inventor himself, or by others to whom he has lent his machine for that purpose (*h*), nor will the fact that pecuniary profit resulted from such experiments necessarily avoid a subsequent patent (*i*). But if a machine is erected in a place where other people may come who are not bound by any rule of secrecy or faith, in order to use it as a completed thing, the patent will be invalidated (*k*).

Whether the experiments may be fairly so regarded, or whether they amount to such an open use of the machine as to constitute a publication, is a question to be decided upon the facts of each particular case.

Lord Esher, M.R., speaking on this subject in *Elias* v. *Grovesend Tinplate Co.* (1890, 7 R. P. C. at p. 466), said: "The patent law about that is, that so long as you are experimenting upon the thing in the hands of people who ought not to disclose it, you must have people to assist you, and you cannot do everything yourself in your own private room, but so long as you are only doing it with people who are to assist you, and who ought not to tell, that is experimenting, and it is no publication; it does not make it public property. But if you go on with all that you have been in doubt about, to erect or make your patent—if it is a machine, to make your machine—if all that is over, and you put it up in a public workshop or in a place where other people would come who are not bound by any rule of secrecy or faith—who are not bound to keep the secret—if you put it up in a place which they are to frequent and where they can see it, you have published it, and if you have published it, it becomes public property—it becomes the property of all the world immediately."

The prior sale of an article, even though to one individual only, will nearly always be sufficient to invalidate the patent, **Prior sale.**

(*h*) *Bentley* v. *Fleming*, 1844, 1 Car. & K. 587; 1 C. B. 479; *Useful Patents Co.* v. *Rylands*, 1885, 2 R. P. C. at p. 262; *Elias* v. *Grovesend Tinplate Co.*, 1890, 7 R. P. C. 455.

(*i*) *Newall* v. *Elliot*, 1858, 4 C. B. N. S. at p. 295; *Morgan* v. *Seaward*, 1837, 2 M. & W. 544; 1 W. P. C. 195.

(*k*) *Elias* v. *Grovesend Tinplate Co.*, 1890, 7 R. P. C. 455; *Hoe* v. *Foster*, 1899, 16 R. P. C. 33; *Poulton's Patent*, 1906, 23 R. P. C. 183.

since it is strong evidence that the invention was put into use (*l*). But the question is one of fact for the jury, and still remains open (*m*). In order for the sale to constitute sufficient evidence, it should be open and in the ordinary way of business (*n*). The fact that there was no demand for the article will not affect the sale either in law or fact (*o*). It will be sufficient if only one article be sold (*p*), and, apparently, if merely for export (*q*). An offer to sell, even though no sale was effected, will also be evidence of prior publication (*r*).

Sending out of samples.

The manufacture and sending out of samples for the purpose of experimenting as to the satisfactory character of the invention has been held not to amount to a publication. And the number of the articles which will amount to a sample will depend on the circumstances of each case (*s*).

By sect. 41, sub-sect. 2, of the Act of 1907, the inventor has been protected against **fraudulent disclosure** of his inventions by persons with whom he might have confidential relations :—

Disclosure without consent of patentee.

(2) "*A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.*"

Formerly the law was such that although a confidential communication did not invalidate a subsequent patent, yet if the person to whom the confidential communication was made

(*l*) *Wood* v. *Zimmer*, 1815, Holt, N. P. 58; 1 W. P. C. 44.

(*m*) *Gibson* v. *Campbell*, 1841, 1 W. P. C. at p. 628.

(*n*) *Honiball* v. *Bloomer*, 1854, 2 W. P. C. 200; *Lister* v. *Norton*, 1886, 3 R. P. C. at p. 208.

(*o*) *Losh* v. *Hague*, 1837, 1 W. P. C. 205; and see *Lister* v. *Norton*, 1886, 3 R. P. C. at p. 208.

(*p*) *Honiball* v. *Bloomer*, 1854, 2 W. P. C. 200.

(*q*) *Carpenter* v. *Smith*, 1841, 1 W. P. C. at p. 536.

(*r*) *Oxley* v. *Holden*, 1860, 8 C. B. N. S. at p. 704; *Mullins* v. *Hart*, 1852, 3 C. & K. 297.

(*s*) *The Useful Patents Co.* v. *Rylands*, 1885, Griff. P. C. 234; 2 R. P. C. at p. 262; *Hudson, Scott and Sons, Ltd.* v. *Barringer and others*, 1906, 23 R. P. C. at p. 87.

published his information the patent was anticipated. It is to be observed that the onus of proving the relieving circumstances is cast entirely on the shoulders of the patentee.

Anticipation in writing.

Another description of anticipation which is capable of invalidating a patent is **prior publication in a document**, *i.e.*, the printing, writing, or publishing of some document to which the public have access, containing such a description of the invention as will enable the invention to be carried into effect from the description given. Vague hints or descriptions of experiments, incomplete or imperfect, are not sufficient to invalidate a subsequent patent. It is not necessary that that which is described in the book or publication should have been carried out in practice; it equally anticipates the patent. The question will always be one of fact, depending on the circumstances of each particular case (see also Chap. III., p. 50 *et seq.*).

Degree of disclosure requisite. Gadd v. Mayor of Manchester.

In *Gadd* v. *Mayor, &c. of Manchester* (1892, 9 R. P. C. at p. 525) Lindley, L.J., said: "In considering novelty the invention is assumed to be one for which a patent can be granted if new, and the question is whether, on that assumption, it is new. Has it been disclosed before? If there is an earlier specification for the very same thing, the second invention is not new; but if the two things are different, the nature and extent of the difference have to be considered. The question then becomes one of degree. But unless it can be said that the differences are practically immaterial, that there is no ingenuity in the second invention, no experiment necessary to show whether it can be usefully carried out or not, the second cannot be said to have been anticipated by the first."

In *Von Heyden* v. *Neustadt* (1881, 50 L. J. Ch. at p. 128) the defendants pleaded anticipation, and put in evidence a mass of paragraphs extracted from a large number of publications. James, L.J., in his judgment, said: "We are of opinion that if it requires this **mosaic of extracts**, from annals and treatises spread over a series of years, to prove the defendants' contention, that contention stands thereby self-condemned. . . . And even if it could be shown that a patentee made his discovery of a consecutive process by studying, collating and applying a number of facts discriminated in the pages of such

works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of nature would do."

Lord Westbury's dictum.

In *Hills* v. *Evans* (1862, 4 De G. F. & J. at p. 289; 31 L. J. Ch. 463) Lord Westbury said: "The antecedent statement must, in order to invalidate the subsequent patent, be such that a person of ordinary knowledge of the subject would at once perceive and understand and be able practically to apply the discovery without the necessity of making further experiments."

Effect modified by later judgment.

The effect of this statement has, however, been slightly modified by subsequent judgments.

In *Philpott* v. *Hanbury* (1885, 2 R. P. C. at p. 43) Grove, J., said: "What I am going to say now is an expression of opinion that is rather obiter. . . . As a matter of fact my opinion is . . . that 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, because in the latter case a description ought to be given which ought not to merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary people who are accustomed to work at the trade. Therefore I think that there is a distinction; but I am willing to rest my definition or description of what anticipates a patent on this, that there must be a publication which when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it, perhaps, to those in the trade who are most skilled—the higher class of skilled workmen), would enable them to understand it. If it be such it anticipates the patent. If it is a mere suggestion, if it is so erroneous in the description that they cannot, by reasonable application of the mind, find out what it means, it does not anticipate the patent."

And the same thing was better said by Lord Watson, in *King, Brown & Co.* v. *The Anglo-American Brush Light Co.* (1892, 9 R. P. C. at p. 320): "Every patentee, as a condition of his exclusive privilege, is bound to describe his invention in

such detail as to enable a workman of ordinary skill to practise it, and the penalty of non-compliance with that condition is forfeiture of his privilege. His patent right may be invalid by reason of non-compliance; but it certainly does not follow that his invention has not been published. His specification may, notwithstanding that defect, 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 that case, I cannot doubt that his invention is published as completely as if his description had been intelligible to a workman of ordinary skill." This statement was accepted by Lindley, L.J., in *Savage* v. *Harris*, 13 R. P. C. at pp. 368, 369, as modifying and correcting the view of Lord Westbury in *Hills* v. *Evans*. The view of the Court seems to be that the knowledge of "the ordinary workman" to whom a specification is addressed (see p. 103) is not necessarily the measure of public knowledge.

On the other hand, great caution must be exercised in coming to the conclusion that a given publication or prior user is an anticipation, and it must not be assumed that there is invalidity owing to prior publication merely because a person of great skill might turn the prior publication to practical account. Regard should be had to the observations of Lord Justice Moulton (cited at pp. 58 and 61, ante) concerning labour-saving machinery. Moreover, the distinction drawn by Grove, J., and Lord Watson has not invariably been made; for instance, in *Kaye* v. *Chubb* (1887, 4 R. P. C. at p. 298) Lord Esher, M.R., said: "I quite agree with what has been stated as to the law by Lord Westbury. If in the first patent which is thus alleged there is a general statement which gives no clear intimation either by its own construction or by that mode of putting construction upon patents—namely, by considering what would be the effect of it upon a hypothetical workman of ordinary skill—if it is so general that, neither by its own construction nor that adapted mode of construction, it would lead to any clear conclusion at all either as to the result or as to the means, and if some other person coming with great skill and great care should, out of

the general words, really produce something not inconsistent with them, but which is not disclosed by them, I quite agree that he can take out a patent, and he cannot be defeated, because that which is really his invention can be got within general words which describe nothing."

The reader is referred to the chapter on Subject-matter (ante, p. 43 *et seq.*) for consideration of the leading cases in greater detail; it is undesirable to repeat the arguments there set forth. It must be remembered that novelty is a question of *fact*, and a decision as to what may be a sufficient anticipation in any particular case cannot be any guide in deciding upon a different set of circumstances.

The cases which have been decided have generally been upon the subject of antecedent publication by means of a specification, but it is evident that the publication of a book or newspaper, or in any other form which gives the public a means of information, is equally potent as an anticipation of a subsequent patent.

Publication of the document.

It is not necessary that the book containing the description of the invention should be sold so as to constitute an anticipation. Mere exhibition in a bookseller's window for sale is sufficient publication, or sending it to a bookseller's in this country to be published (*t*). "There is no difference between a foreign inventor and an English one if, when the inventor is a foreigner, he publishes the book in a foreign language and sends it over to the booksellers in this country for the purpose of being sold" (*u*).

It is the practice for the Patent Office library to receive copies of foreign specifications from abroad and to bind them in volumes which are open to public inspection. An English patent may be invalidated by the fact that such a specification, or in fact any other publication containing the description, was on view prior to the date of the English application (*x*). Prior

(*t*) *Lang* v. *Gisborne*, 1862, 31 Beav. 133.

(*u*) Per Sir John Romilly, M.R., in *Lang* v. *Gisborne*, 1862, 31 Beav. at p. 136.

(*x*) *Harris* v. *Rothwell*, 1887, L. R. 35 Ch. D. 416; 56 L. J. Ch. 459; 56 L. T. 552; 3 R. P. C. 383; 4 R. P. C. 225; *Pickard* v. *Prescott*, 1893, 9 R. P. C. 195.

Prior publication. xxxvi RPC. 14
Stallard Book 1°

publication in a foreign journal and in a foreign language will invalidate an English patent if it can be shown that a single copy was deposited in England in a public place, and was open to public inspection.

In *Otto* v. *Steel* (1886, L. R. 31 Ch. D. 241), where a French treatise was placed in the British Museum library in 1863, it was held by Pearson, J., that having regard to the arrangements of the library there was no prior publication in England of matter contained in the treatise so as to avoid a patent taken out in 1876. The library arrangements were as follows: There was no access to the public to any part of the library of the British Museum beyond the reading room. The public had access to the general catalogue and to books of reference kept in the reading room. In the general catalogue of the British Museum the printed books were referred to under the names of their authors. The treatise in question was entered in the catalogue under the name of Beau de Rochas, and in no other place. It was itself kept in an inner room, and it could only be obtained by one of two means, either by some person knowing of the book and writing the name of the book on a piece of paper and requesting that the book might be furnished to him; or if a reader wanted to find something on a particular subject, and went to the superintendent and asked what books there were that he had better read. The superintendent, if not able to give the information, would direct one of the assistants to take him to that section of the library where such books were likely to be found, and would desire him to let the reader look over the titles of those books, and select what book he pleased out of that section of the library (*y*). Otto *v.* Steel.

In *Harris* v. *Rothwell* (1887, 4 R. P. C. at p. 232) Lord Justice Lindley, reading the judgment of Lord Justice Cotton and himself, after an elaborate review of the authorities, said: "The conclusion at which I have arrived, and which in my judgment is most in accordance with the authorities, and the principles which underlie them, may be thus expressed. Primâ

(*y*) See also *Plimpton* v. *Malcolmson*, 1876, L. R. 3 Ch. D. 531; 44 L. J. Ch. 257; 45 L. J. Ch. 505; *Plimpton* v. *Spiller*, 1877, L. R. 6 Ch. D. 412; 47 L. J. Ch. 211

facie, a patentee is not the first inventor of his patented invention if it be proved that before the date of his patent an intelligible description of his invention, whether in English or in any other language commonly known in this country, was known to exist in this country, either in the Patent Office or in any other library 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. But if, as in the Plimpton cases (*z*) and in *Otto* v. *Steel* (*a*), it be proved that the foreign publication although in a public library, was not in fact known to be there, the unknown existence of the publication in this country is not fatal to the patent."

Publication by drawing.

A patent for a machine may be anticipated by a drawing of it unaccompanied by explanatory letterpress if published in a book or elsewhere so that it could become generally known, provided that any machinist would understand it, and could make the machine from the drawing without any further information, and without the exercise of ingenuity (*b*).

The publication in a prior specification is conclusive against a subsequent patent, since the object of a specification is to publish to the world.

By sect. 7 of the Act of 1907 the Patent Office is directed to make a search as to the novelty of all applications. The search is only to extend to specifications published within fifty years next before the date of the application.

Rule as to fifty-year-old specifications.

By sect. 41, sub-sect. 1, it is enacted: "*An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five* (*c*) *shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.*"

(*z*) See note, (*y*), above.

(*a*) See p. 79, above.

(*b*) *Herrburger* v. *Squire*, 1889, 6 R. P. C. at p. 198; *Electric Construction Co.* v. *Imperial Tramways Co.*, 1900, 17 R. P. C. at p. 550.

(*c*) On account of the similar section (2) of the Act of 1902, which came into force on January 1st, 1905.

Therefore, as to inventions patented after the 1st of January, 1905, any anticipation may be alleged that would formerly have been available, save a provisional specification not followed by a complete specification (such have not been published since 1884), and a person who alleges invalidity may not rely solely upon a specification published fifty years before the application. But it is submitted that he could use the fifty-year-old specification as evidence to support an allegation of prior user (*d*). The effect merely seems to be to take away the conclusive nature of such a specification as prior publication. The Patent Office search does not preclude anyone from attacking the validity of the patent by means of a specification which the Office may have overlooked (sect. 1, sub-sect. 9). With regard to applications filed before the commencement of the Act, the old law applies.

Abandoned prior application.

A question has arisen as to whether the abandonment of a provisional specification would invalidate a subsequent application. It must be remembered that the Court has power to order the production of a provisional specification, filed on an abandoned application not as an anticipation, but as evidence to establish a prior user, and in the interests of justice. This was done by Mr. Justice Wills in *Pneumatic Tyre Co.* v. *The English Cycle and Tyre Co.* (1897, 14 R. P. C. at p. 852). In *Oxley* v. *Holden* (1860, 8 C. B. N. S. 666) it appeared that on the 17th March, 1858, the plaintiff obtained provisional protection for an invention of indiarubber pads to be applied to the windows of carriages. On the 10th April, 1858, he obtained a second provisional protection for three heads of invention, whereof one comprised the above-mentioned indiarubber pads. The first application was abandoned, and the specification filed in support of it was not published, and the second was carried to completion—*there was no evidence that between the date of the first application and the second the invention had in any way been put in practice or published:* held, that the first application did not invalidate the patent.

(*d*) See, on a somewhat similar principle, *The Pneumatic Tyre Co.* v. *The English Cycle and Tyre Co.*, 1897, 14 R. P. C. at p. 852.

Erle, C.J., in the course of his judgment (p. 708), said: "We are of opinion that a provisional specification abandoned does not become public by abandonment. . . . Furthermore, although the first provisional specification may afford an objection either to receiving a second patent for the same invention, or to granting a patent for the invention after the first specification has expired, there is no principle of law, and no enactment making the patent void if it is so granted."

But it will be noticed that in this case the argument against the patent was that the abandonment of the first application implied that the invention became dedicated to the public on the 17th September, by which date it would have been necessary to file a complete specification. The Court held that there was no such dedication.

In *Lister* v. *Norton* (1886, 3 R. P. C. 199) the same question arose, but there the patentee had publicly used the invention between the dates of the two provisional specifications. Chitty, J., held that the reasoning of *Oxley* v. *Holden* (supra, p. 81) applied to this case, and said: "But reverting to the point of law, I think that this user in public is covered by the grounds on which the Court of Common Pleas decided *Oxley* v. *Holden*. The Court held that the protection of the first provisional specification extended down to the grant of the patent, and made this one of the grounds of their decision. A provisional specification was the creature of the Act of 1852. That Act, after providing for the filing of such a specification which is to describe the nature of the invention, and for the grant of the certificate, proceeds in the 8th section to enact that 'Thereupon the invention therein referred to may during the term of six months from the date of the application for letters patent for the said invention be used and published without prejudice to any letters patent to be granted for the same.' The phrase 'to be granted for the same' obviously means in this section, and in the 9th section (which relates to the filing of a complete specification in the first instance), for the same invention, and cannot be construed as referring to the application or petition. . . . There is no express condition in the Act avoiding the protection conferred in reference to the first provisional

specification by the filing of a second provisional specification in relation to the same invention, and having regard to the decision in *Oxley* v. *Holden*, it is not open to me to say that there is any such implied condition."

Both of these decisions, however, depend upon sects. 8 and 9 of the Patents Act, 1852, and it may well be that the words "to be granted for the same" in those sections refer to the invention and not to the petition. This, however, would not be the case in construing sect. 4 of the Act of 1907 (sect. 14 of the Act of 1883), which is as follows: "*Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.*" Here "such patent" which is not to be invalidated, is the patent for which the particular application is made. Hence the abandonment of an application for provisional protection will not invalidate a subsequent application for the same invention (*Oxley* v. *Holden* (supra)); but if the invention is put into practice between the filing of the two provisional specifications, the second patent will be void on the ground of prior user merely.

Abandoned specifications not published.

By sect. 69, sub-sect. 1, it is enacted that specifications filed in pursuance of applications which are subsequently abandoned are **not to be published** save in the case of applications under the Convention.

If, however, a provisional specification, *i.e.*, one published prior to 1884, containing a sufficiently clear description of the nature of an invention be published, it will amount to an anticipation so as to avoid a subsequent patent granted for the same invention (*e*).

Want of novelty in part makes patent void,

The consideration for a grant of letters patent is entire and indivisible; consequently, where two or more mechanisms or processes are claimed in one specification, the want of novelty

(*e*) *E.g.*, see *Lawrence* v. *Perry*, 1885, 2 R. P. C. at p. 187; *Stoner* v. *Todd*, 1876, L. R. 4 Ch. D. 58.

save in case of subsidiary claim.

of one will avoid the whole (*f*); but where one of the claims is but subsidiary to the rest and does not in any way increase or enlarge the monopoly claimed by the remainder of the specification, the Courts have held want of novelty in such a claim to be no objection to the patent (*g*). As an illustration of this proposition we may instance the case of *True and the Variable Electric Lamp Syndicate* v. *Bryant Trading Syndicate* (1908, 25 R. P. C. 461). The patentee described and claimed a new form of incandescent electric lamp. It was essential to the particular nature of his invention that the lamp should be held firmly in the socket, and to ensure this he provided the wire projecting from the lamp to form a bayonet joint with the socket, with a small nut by means of which it was firmly clamped to the socket. There were only three claims, and the second was as follows: "A screwed nut *n* upon the end of the wire *f*, by which the said wire is held firm and prevented from coming out of the bayonet joint, substantially as described and illustrated." Mr. Justice Swinfen Eady said: "It was contended that the plaintiff's patent was invalid as claim 2 was an independent claim to the user of a screwed nut upon the end of a wire to fix the wire to the holder and to prevent it changing its position, and that the use of such a nut for such a purpose was one of the oldest devices in mechanics. In my opinion, the patentee . . . is merely describing a method of affixing his invention to the holder, as an advantageous method of using his invention, where special circumstances render it expedient, as, for instance, in any position where unusual vibration existed, so as to prevent the transverse wire from accidentally coming out of the notches of the bayonet joint, and claim 2 is not an independent claim or a claim in gross, but merely a subsidiary claim within the meaning of the phrase as used by Lord Cairns in *The British Dynamite Co.* v. *Krebs* (13 R. P. C. 193), applied by Farwell, J., in *Parker* v. *Satchwell* (18 R. P. C.

(*f*) *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 541; *Morgan* v. *Seaward*, 1837, 2 M. & W. 544; 1 W. P. C. 196; *Patterson* v. *Gas Light and Coke Co.*, 1876, L. R. 2 Ch. D. 812, 833.

(*g*) *Plimpton* v. *Spiller*, 1877, L. R. 6 Ch. D. 427; *British Dynamite Co.* v. *Krebs*, 1896, 13 R. P. C. at p. 193; *Parker and Smith* v. *Satchwell & Co.*, 1901, 18 R. P. C. at p. 307.

307). Claim 2 is only claimed in connection with and as appendant to the improved device shown in claim 1."

Mr. Justice Kekewich, in *Ehrlich* v. *Ihlee* (1888, 5 R. P. C. at p. 205), said: "If within a short time of the first manufacture and sale an article of commerce commands a ready and extensive sale, that fact, which is proof of utility, must be accepted as evidence, not conclusive, but cogent of novelty" (*h*).

Prior grant.

A patent will be invalidated if it can be shown that the invention has been the subject of a **prior grant**, although there may have been no prior publication. But only a valid prior grant would be sufficient for this purpose (*i*).

Industrial exhibitions.

By sect. 45 of the Act of 1907 (following sect. 39 of the Act of 1883) it is enacted: "*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 and consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—*

(a) "*the exhibitor, before exhibiting the invention, gives the comptroller the prescribed notice of his intention to do so; and*

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

(2) "*His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.*"

(*h*) See also *The American Braided Wire Co.* v. *Thomson*, 1888, 5 R. P. C. at p. 125.

(*i*) *The Mica Insulator Co.* v. *The Electrical Co.*, 1898, 15 R. P. C. 495; *Robertson* v. *Purdey*, 1907, 24 R. P. C. 273.

CHAPTER V.

UTILITY.

At common law.

We now come to the consideration of the question of utility, for not only must the invention be new, but it must be new and useful. The 6th section of the Statute of Monopolies does not refer to the necessity of utility in the invention, but saving, as it does, the common law prerogative of the Crown in respect of inventions, it refers us back to what had previously been held to be the necessary elements of an invention. In *Darcy* v. *Allin* (1602, Noy 182; see report in Gordon's "Monopolies by Patent") it was held that the invention must tend to the furtherance of trade, and be for the good of the realm, and that the monopoly was granted in consideration of the good that the inventor doth bring by his invention to the commonwealth, otherwise not. Consequently, an essential element of a valid grant is, that it should be for something which is for the good of the realm; that is, it must be useful (*a*).

In *Boulton* v. *Bull* (1795, 2 H. Bl. 478) Rooke, J., said: "The public have a right to receive a meritorious consideration in return for the protection granted." In the same case Buller, J., said: "The invention professes to lessen the consumption of steam, and to make the patent good the method must be capable of lessening the consumption to such an extent as to make the invention useful." And in the case of *R.* v. *Arkwright* (1691, 2 Salk. 447; 1 W. P. C. 72) the same judge, in leaving the matters to the jury, said: "There is another question, whether the stripe in it makes a material alteration, for if it appears, as some of the witnesses

(*a*) *R.* v. *Arkwright*, 1785, 1 W. P. C. at p. 73; *Morgan* v. *Seaward*, 1837, 2 M. & W. at p. 561; *Manton* v. *Parker*, Dav. P. C. 327; 1 W. P. C. 192, n.; *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 1887, 4 R. P. C. at p. 462; *Elias* v. *Grovesend Tinplate Co.*, 1890, 7 R. P. C. at p. 467; *Ward* v. *Hill*, 1903, 20 R. P. C. at p. 199.

say, to do as well without the stripes, and to answer the same purpose if you suppose the stripes never to have been used before, that is not such an invention as will support the patent."

It will always be a question of fact, whether the invention is useful; that is, whether that which is new is a sufficient meritorious advance or improvement upon what was already known by the public (*b*).

Each of the cases which have been decided upon the question of utility deal, and necessarily must deal, with an independent state of facts; and, consequently, no case can be said to be an authority for another case; but they go to show the general principle that "utility" means a substantial improvement, and not necessarily an extensive improvement; for instance, a man might invent a large and complicated machine for the manufacture of boots, which, when completed, would do nothing which was not done before, and would not make them any quicker or any cheaper than they were made before. Such a machine would not form the subject of a patent. On the other hand, a man might discover a new needle for stitching boots, which would economise half-an-hour in the manufacture of each boot; such a needle would be the subject of a patent, although the whole improvement might consist of a bend.

Substantial, not extensive, improvement needed.

In *Crane* v. *Price* (1842, 1 W. P. C. 411) Tindal, C.J., said: "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 by some sudden or lucky thought, or mere accident of discovery."

The test of utility of an invention is that, when put in practice by a competent man, it should really do what it assumes to do, and be practically useful at the time when the patent is granted for the purposes indicated by the patentee (*c*).

The test of utility.

(*b*) *Hill* v. *Thompson*, 1817, 1 W. P. C. at p. 237; *Bloxam* v. *Elsee*, 1827, 1 C. & P. at p. 565; *Cornish* v. *Keene*, 1835, 1 W. P. C. at p. 506.

(*c*) Per Lindley, L.J., in *Lane-Fox* v. *Kensington and Knightsbridge Electric Lighting Co.*, 1892, 9 R. P. C. at p. 417.

Commercial success not necessary.

In *The Badische Anilin und Soda Fabrik* v. *Levinstein* (1887, 4 R. P. C. at p. 462), in the House of Lords, Halsbury, L.C., said: "The element of commercial pecuniary success has, as it appears to me, no relation to the question of utility in patent law generally, though, of course, where the question is of improvement by reason of cheaper production, such a consideration is of the very essence of the patent itself, and the thing claimed has not really been invented unless that condition is fulfilled" (*d*).

In *The Sunlight Incandescent Gas Lamp Co.* v. *The Incandescent Gas Light Co.* (1897, 14 R. P. C. at p. 775) Wills, J., said: "I do not think commercial success is at all the test of utility in a patent. A great many very meritorious patents would go to the wall if it were so . . . it does not in the least follow, because better things have been done afterwards, that it was not a substantial contribution to the knowledge of the world at the time when the patent was taken out."

Nor putting in practice.

The fact that a patent was never put into practice is no proof of the uselessness of the invention. In *Edison* v. *Holland* (1889, 6 R. P. C. at p. 282) Lindley, L.J., said: "The utility of the patent must be judged by reference to the state of things at the date of the patent; if the invention was then useful, the fact that subsequent improvements have replaced the patented invention and rendered it obsolete and commercially of no value, does not invalidate the patent"; and Cotton, L.J., in the same case, said: "A patent is not to be defeated simply because subsequent inventions improved the patented article, or because, in consequence of subsequent improvements, no article was, in fact, made in accordance with the specification."

In *Otto* v. *Linford* (1881, 46 L. T. N. S. at p. 41) Jessel, M.R., said: "It is quite true that it has been said that it is primâ facie evidence of want of utility (*e*) if you do not make and vend your machine; but that is subject to this observation: that you may make and vend an improvement

(*d*) And see *Atkins and Applegarth* v. *Castner-Kellner Alkali Co.*, 1901, 18 R. P. C. at 297.

(*e*) *Morgan* v. *Seaward*, 1837, 1 W. P. C. 186; *Tetley* v. *Easton*, 1852, Macr. P. C. 63.

upon it, and if you have found out immediately after you have patented your invention that it can be improved, it does not by any means show that the first invention was useless."

Slight amount suffices.

A very slight **amount of utility** will be sufficient to support a patent. Alderson, B., in *Morgan* v. *Seaward* (1837, 1 W. P. C. 186) (*f*), said: "I think if it was of different construction from any other steam engine, and of *any use* to the public, then that is sufficient." Again, Jessel, M.R., in *Otto* v. *Linford* (1881, 46 L. T. N. S. at p. 41) (*g*), said: "And, as to this question of utility, very little will do."

"The law does not require any definite amount of utility, and a very slight amount of utility will be sufficient, provided it does not appear that the Crown has been deceived as to the extent of the utility of the invention" (*h*).

New choice must be useful.

If the patent is for an invention which purports to offer the public a **new choice** of means to accomplish what has previously been known, that choice **must be a useful choice.** In *Ward* v. *Hill* (1903, 20 R. P. C. at p. 199) Vaughan Williams, L.J., said: "I do not agree with Mr. Terrell's proposition and the wide way in which he puts it, that in every claim, if you secure the end which you profess by the letters patent to have in view, that is sufficient to constitute utility. He says that if you present to the public a new choice, or present to the public an alternative mode of procuring a result in a manufacture which is already well known, that in itself is sufficient to constitute utility. I do not think so. I do not conceive that I am saying anything new, or anything different from the decided cases, when I say that in my judgment the alternative, or the choice which is presented to the public, must be a useful alternative or a useful choice" (*i*).

In *Easterbrook* v. *The Great Western Ry. Co.* (1885, 2 R. P. C.

(*f*) See also Halsbury, L.C., in *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 1887, 4 R. P. C. at p. 462.

(*g*) See also *Philpott* v. *Hanbury* 2 R. P. C. at p. 37; *Ehrlich* v. *Ihlee*, 5 R. P. C. at p. 450.

(*h*) Per Chatterton, V.-C., in *Pirrie* v. *York Street Flax Spinning Co.*, 1893, 10 R. P. C. at p. 39.

(*i*) And see *Welsbach Incandescent Co.* v. *New Incandescent*, 1900, 17 R. P. C. at p. 252; 1900, 1 Ch. 850.

201), the patent was granted for machinery for actuating railway points. It was proved at the trial that the patented apparatus could be worked so as to give conflicting signals which might give rise to great danger. The patent was held invalid on this ground.

Utility alone is not sufficient.

Utility, however great it may be, cannot by itself support a grant of letters patent, and the application of an old contrivance to an analogous purpose, however useful the result may be, will not constitute a patentable invention (*k*).

Want of utility in part.

Utility, like novelty, is part of the consideration for a grant of letters patent, and if a material portion of the invention be useless, there is a **failure of consideration**, and the patent is altogether void (*l*).

In subsidiary part.

But want of utility in an immaterial part of a machine which is not claimed as essential will not vitiate a patent. Lord Tenterden, C.J., in *Lewis* v. *Marling* (1829, 10 B. & C. 25), said: "I agree that if the patentee mentioned that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that the patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful."

Tindal, C.J., in *Haworth* v. *Hardcastle* (1834, 1 Bing. N. C. at p. 190), said: "If the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold that patent void."

In that case part of the patentee's claim was for the application of the machinery described for drying calicoes, the said machinery being adapted for taking up and removing the said calicoes after being dried. At the trial it appeared

(*k*) Per Lord Watson in *Morgan* v. *Windover*, 1890, 7 R. P. C. at p. 136; and see Chap. III., on "Subject-matter," p. 39.

(*l*) *Simpson* v. *Holliday*, 1866, L. R. 1 H. L. 315, 322; *Turner* v. *Winter*, 1787, 1 W. P. C. 77; *Morgan* v. *Seaward*, 1837, 2 M. & W. at p. 561; *Bloxam* v. *Elsee*, 1827, 6 B. & C. 169; *The United Horsenail Co.* v. *Stewart*, 1885, 2 R. P. C. at p. 132; *United Horseshoe and Nail Co.* v. *Swedish Horsenail Co.*, 1889, 6 R. P. C. at p. 8.

that the machine failed in taking up certain cloths stiffened with clay.

Where an invention is as a whole useful, a very small amount of utility will be sufficient to support a second and subsidiary claim (*m*), and it does not show that the patent is bad because one of the methods claimed is preferred to the others (*n*). But the same rule as to falsity of suggestion applies in these cases (*o*).

Commercial success is strong evidence of utility (*p*), though, as has been pointed out above, its absence is no proof of want of utility (*q*).

Fact of infringement is evidence.

Kay, J., in *Lucas* v. *Miller* (1885, 2 R. P. C. at p. 160), said: "Better evidence of the utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it" (*r*).

(*m*) *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. at p. 455.

(*n*) *Miller* v. *Scarle*, 1893, 10 R. P. C. 106; *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. 437.

(*o*) *Owen's Patent*, 1900, 17 R. P. C. at pp. 78, 79.

(*p*) *Automatic Airtight Cover, Ltd.* v. *Stockford*, 1902, 19 R. P. C. at p. 460.

(*q*) See ante, p. 88.

(*r*) See also Bowen, L.J., in *Miller* v. *Scarle*, 1893, 10 R. P. C. at p. 111; *Ward* v. *Hill*, 1903, 20 R. P. C. at p. 200.

CHAPTER VI.

THE SPECIFICATION.

To publish the invention.

ONE of the conditions which support the consideration for a valid patent is that the patentee must publish his invention, that is to say, he must file a "specification" containing a description of the subject-matter of his patent. He must give such an account of the way of working it, and of what he particularly claims, as to enable an ordinary skilled person to carry out the invention without further assistance or discovery.

By sect. 1, sub-sect. 3, of the Act of 1907, "*the application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.*"

The functions of a provisional and those of a complete specification are defined by sect. 2, which has made no alteration in the law upon this point.

(1) "*A provisional specification must describe the nature of the invention.*

(2) "*A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.*"

If the applicant elects to file a provisional specification he must within six months file a complete specification, and a patent is not granted until the condition of filing a complete specification has been fulfilled.

History of specification.

In the early days of patent law the king granted a patent for an invention, naming it in the patent, and defining it merely by that name, and it was open to the patentee to allege that anything which fell within the name was covered by the

patent. As manufactures sprang up this method was found to lack preciseness of limitation, and accordingly in the reign of Anne a condition was inserted in all grants of letters patent, and that condition is the foundation of modern patent law. It was a proviso obliging the inventor "by an instrument under his hand and seal particularly to describe and ascertain the nature of the said invention, and in what manner the same is to be performed and to cause the same to be enrolled within six calendar months." The Crown continued, however, to grant patents on a mere title, the obligation to file a description being a mere subsequent condition. The reason for granting the patent on the title and giving the inventor a further six months was to ensure that he should not be forestalled before he could complete the invention and bring it to a practical form. It was, however, necessary that the specification should not be inconsistent with or wider than the title which still continued to form the basis of the grant, and numerous cases are recorded in which the patent was held to be invalid on the ground of variance between the title and the specification. For instance, a man who had invented a new street lamp, and described his invention in the title as being "a method or methods of more completely lighting cities, towns and villages," was held to have vitiated his patent by going too far in his title. His claim should have been for a new or improved street lamp (*a*).

The Title.

In *Campion* v. *Benyon* (1821, 6 B. Mo. 71) the title was "a new and improved method of making and manufacturing double canvas and sail cloth with hemp and flax, without any starch whatever"; the title, therefore, described an invention, the novelty and utility of which was to omit the use of starch, but upon reading the specification we find that the real invention was an improved mode of twisting the threads to be applied to the making of unstarched cloth; the patent was held bad. In the case of *Bloxam* v. *Elsee* (1827, 6 B. & C. 169) the title for the invention was for a machine for "making paper in single sheets without seam or joining from 1 to 12 feet and

(*a*) *Cochrane* v. *Smethurst*, 1816, Dav. P. C. 354; 2 Coop. Ch. Cas. 57; 1 Stark. R. 205; and see *R.* v. *Elsee*, 1785, 1 W. P. C. 76.

upwards wide, and from 1 to 45 feet and upwards in length." It was found that to vary the width of the paper it was necessary to have a different machine, and that consequently the title did not correspond with the invention, and the title was held bad. In *Felton* v. *Greaves* (1829, 3 C. & P. 611) the title was "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors and other cutting instruments." The machine would not sharpen scissors:—Held bad.

In *Croll* v. *Edge* (1850, 9 C. B. 479; 19 L. J. C. P. 261) the title was for "improvements in the manufacture of gas for the purpose of illumination, and in apparatus *used therein*, and when transmitting and measuring gas"; an important part of the patentee's claim consisted in a new mode of manufacturing clay retorts, an apparatus used in the manufacture, and not in the transmitting and measuring, of gas:—Held, that there was fatal inconsistency, the specification being substantially wider than the title.

These cases seem to have been decided upon the ground that an incorrect or too extensive title is evidence of fraud upon the Crown. For instance, in *Brunton* v. *Hawkes* (1821, 4 B. & Ald. 558) Best, J., said: "That the patent was taken out for more than the patentee was entitled to, that, in my opinion, avoids the patent *in toto*, for the king is deceived."

The provisional specification;

It was found that application for letters patent, being made merely upon the title of an invention, caused a great deal of inconvenience and uncertainty; therefore, by the Patent Law Amendment Act, 1852, **the provisional specification was created.** Whereas prior to the passing of that Act, applicants for letters patent, when they made their application, had merely deposited the title of their invention, by sect. 6 a provisional specification was required, which was intended to give more definite information as to the nature of the invention for which protection was sought than could possibly be given in a mere title. The provisional specification was thereafter to perform the function that was formerly that of the title, and since the Act of 1852 there is no reported case of a patent held to be invalid on the ground of variance between the title and the specification. It is true that the specification must commence

with a title (*b*), but **the function of the modern title is altogether different from that which it formerly fulfilled.** It is more for the purpose of identifying the invention for reference and indexing, and its accuracy is in these times a matter for the examiners at the Patent Office.

function of modern title quite different.

Sect. 8 of the Act of 1852 enacted that "the law officer must be satisfied that the provisional specification describes the nature of the invention," and the exact words of that section were retained in sub-sect. 3 of sect. 5 of the Act of 1883. Probably the legislature had in view the desirability of retaining the effect of the numerous valuable decisions of the Courts of law upon the construction which should be placed upon what is a sufficient description of the nature of the invention.

Provisional protection.

The filing of a provisional specification confers upon the applicant "Provisional Protection" for his invention against the consequences of publication (*c*). The patent when granted dates back to the time when the application was lodged (*d*), but no rights against the public are conferred until the complete specification is accepted and published (*e*), after which a right of action accrues against infringers. No proceedings may be taken, however, until the patent is sealed (*f*). In these respects the law is the same as under the Act of 1883.

It is somewhat difficult to define clearly the distinction between that which is absolutely necessary in the provisional specification and that which is absolutely necessary in a complete specification. In *Newall* v. *Elliott* (1863, 4 C. B. N. S. 293) Byles, J., said: "The office of the provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out." In *Stoner* v. *Todd* (1876, L. R. 4 Ch. D. 58) Jessel, M.R., said: "I must consider first the nature of a provisional specification, and the effect of a provisional specification on a final specification of the same invention. A provisional specification was never

(*b*) Sect. 2, sub-sect. 4.
(*c*) Sect. 4.
(*d*) Sect. 13.
(*e*) Sect. 13.
(*f*) Sect. 10.

intended to be more than a mode of protecting an inventor until the time of filing a final specification; it was not intended to contain a complete description of the thing so as to enable any workman of ordinary skill to make it, but only to disclose the invention, fairly no doubt, but in its rough state." In *Woodward* v. *Sansum* (1887, 4 R. P. C. at p. 174; 56 L. T. 347) the Court of Appeal held that all a patentee need do in his provisional specification is to describe his invention. He need not go on therein to describe any method of carrying out the invention, but, whether he do so or not, if a different or further mode of carrying out the invention is described in his complete specification that will not invalidate the patent so long as such new method of carrying out is fairly within the invention as described in the provisional specification. In *Moseley* v. *Victoria Rubber Co.* (1887, 4 R. P. C. at p. 248; 57 L. T. 142) Chitty, J., laid it down that the object of a provisional specification is only to describe generally and fairly the nature of the invention, and not to enter into all the minute details of the complete specification.

Purpose of provisional specification. Disconformity.

It is evident, therefore, that the object of the legislature in creating a provisional specification, and founding upon it a period of provisional protection, was to enable the inventor in that interval to improve and perfect his invention, and to clearly ascertain what was new and what was old in that which he proposed to patent. That being so, it is obvious that it could not have been the intention of the legislature that, when framing a complete specification, the inventor should be bound to follow implicitly every detail which he had given in his provisional specification, or that he should be prevented from adding to or subtracting from his invention; for, in that case, the object would be defeated.

The cases cited at p. 93 and decided prior to the Act of 1852 as to the fatal nature of a variation between the title and the specification apply (subject to the effect of sect. 42 of the Act of 1907, to be considered later) to a variation between the provisional specification and the complete specification.

In *Newall* v. *Elliott* (1863, 10 Jur. N. S. at p. 955) Pollock, C.B., said: "The object of the statute which requires

a provisional specification is nothing more than a legislative recognition of the custom which called upon every patentee, when he applies for a patent, to give some notion of what his invention is; that has been followed by Act of Parliament, requiring it to be done; but the object in both cases is to ascertain the identity of the invention, and make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance. . . . I have no doubt that the object of the Act of Parliament was not to ascertain the **entirety** of the invention, but the **identity** of the invention, so as to enable the Attorney-General, and, in fact, to enable a jury ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification." Baron Channell, in the same case, at p. 960, describes a provisional specification as a "short note or minute of that which was ultimately disclosed in the full specification."

A. L. Smith, L.J., in *The Cassel Gold Extracting Co., Ltd.* v. *The Cyanide Gold Recovery Syndicate* (1895, 12 R. P. C. at p. 257), said: "In a provisional specification no claim is ever made by the patentee, he has not to state therein what he claims, or how he carries out his invention; but he must state its nature in such a way that the law officers may see what it is, and so that the identity of its subject-matter, with that of the complete specification which is to come thereafter, may be ascertained. In the complete specification the patentee has to do much more. Not only has he to state therein what his invention is, but he must particularly describe how his invention is to be carried out and performed, and what he claims."

Lord Chelmsford, in *Penn* v. *Bibby* (1867, L. R. 2 Ch. at p. 133), said: "The relation which the provisional specification bears to the complete specification is much the same as that which before the Patent Law Amendment Act a title bore to the specification . . . the only objection then which is open upon the complete specification, is whether it is sufficient in itself, and whether it agrees with the provisional

specification. Now, by 'agreement' is not meant a perfect correspondence, but merely that there shall be nothing in the complete specification at variance with the provisional." The learned Lord Chancellor then proceeds to quote *Newall's Case*, to which we have referred, and proceeds: "Nor is it at all necessary that the specification should extend to everything comprehended in the provisional specification. Perhaps a better illustration of this proposition could not be given than that which was offered in the course of the argument. If the patentee were to introduce into his complete specification everything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty, or for any other reason, he might afterwards cure the objection by a disclaimer. Now if he would be allowed to disclaim in such a case, which is a matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification had entitled him to demand. It is clear, therefore, that unless a complete specification in this case claims something *different* from the provisional specification, the objection to the patent under consideration cannot prevail."

Lord Justice Lopes, in *Woodward* v. *Sansum* (1887, 4 R. P. C. at p. 178), said: "A provisional specification was never intended to contain a complete and exhaustive description of the invention. It was intended to be sufficiently specific to disclose the nature of the invention so as to protect the inventor until the time for filing the final or complete specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping within what I may call the ambit of his invention as disclosed in his provisional specification. Provided that this is done, it is no objection that in the complete specification an invention is described more particularly and in more detail, nor, to use the words of Lord Blackburn in *Bailey* v. *Roberton* (1878, L. R. 3 A. C. at p. 1075), 'even if it be shown that there has been more discovery made and

so as to make the invention which he has described in the provisional specification really workable.' It is essential that the nature of the invention shall be the same, but upon principle and upon authority, it is clear that improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts, with a view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification are allowable, and cannot be successfully relied on for the purpose of invalidating a patent for disconformity."

Omission from complete specification.

In the absence of fraud, any part, whether in the description or the claim of the provisional specification, may be omitted from the complete specification without the necessity of any disclaimer (*g*); unless that part which is omitted is an essential part of the invention as originally described (*h*).

Moreover, it does not follow if the provisional specification describes some method of carrying the invention into effect, and the complete specification does not describe this method, but sets forth a better method, the nature of the invention remaining the same, that the method described in the provisional specification is thereby disclaimed (*i*).

The plea of disconformity when successful often worked great hardship, for the excess of invention in the complete specification over that in the provisional was sometimes the most meritorious part and quite novel in itself. Of course, if the excess matter had not been novel at the date when the application was made and the provisional specification filed, the patent failed for want of novelty, and the patentee was not entitled to any special sympathy. In order, however, to relieve the patentee under the circumstances of the first-mentioned kind,

(*g*) *Thomas* v. *Welch*, 1866, L. R. 1 C. P. 201; see also the remarks of Lord Chelmsford in *Penn* v. *Bibby*, quoted above; *Re Everitt's Patent*, 1886, Griff. L. O. C. 27; *The Pneumatic Tyre Co.* v. *East London Rubber Co.*, 1897, 14 R. P. C. 98, 582; *Ward* v. *Hill*, 1903, 20 R. P. C. 200.

(*h*) *Bailey* v. *Roberton*, 1878, L. R. 3 A. C. 1062; and see Vaughan Williams, L.J., in *Ward* v. *Hill*, 1903, 20 R. P. C. 198.

(*i*) *Sandow* v. *Szalay*, 1903, 23 R. P. C. 6.

the law has been considerably modified by sect. 42 of the Act of 1907. The section is as follows :—

Statutory relief by sect. 42.

"*A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.*"

It is to be noticed that **disconformity is not abolished** as a ground of invalidity. The excess matter must not only have been invented by the inventor, but it must have been novel at the date when the complete specification was put in, a considerably later date than that of the application. If the excess matter was not novel at the date of the provisional specification (*i.e.*, the application), then of course the patent will be invalid for want of novelty. If it be established that the excess matter was novel at the date of the application and provisional specification, but had been published before the complete specification had been filed, even by the patentee himself, the patent will be invalid, not on the ground of want of novelty, for in discussing novelty it is the date of the application that has to be considered, but on the old ground of disconformity.

The Welch Case.

The Welch Patent is an instructive example by which to illustrate the law on disconformity and also the effect of sect. 42. The patent was attacked on the ground of disconformity, and was held valid. If the arguments of the defendants had been successful the patent would have been held invalid under the old law, but had the section been law at that time the validity would have been saved, on the ground that the excess matter was novel at the date when the complete specification was put in. The judgment of Romer, J., in *The Pneumatic Tyre Co.* v. *The East London Rubber Co.* (1897, 14 R. P. C. at p. 98) covers all the arguments. In his provisional specification the inventor described an improved method of holding solid rubber tyres on to concave wheel rims by means of circular hoops of wire passed through circumferential holes in the edges of the tyre.

Towards the end of the specification he said: "The above described improvements are also applicable to cycle and other wheels in present use, or made in the ordinary way, in which case they may be fitted over the existing rubbers without necessarily making any alteration. Or I may substitute in place of the ordinary rubber a lighter or cheaper material such as cork"; he also indicated that his invention might be applied to "cushion tyres." No mention of pneumatic tyres was made, although they were known at that date. In the complete specification he showed the invention as applied to pneumatic tyres, and this turned out to be by far the most valuable part of the invention, the effects produced being quite new, and making the pneumatic tyre, for the first time, a merchantable article. In the provisional specification the chief objects of the invention were stated to be "easy running, reduction of vibration, and the security of the rubbers to the metal rims or felloes." The learned judge said (p. 99): "The patentee was not bound, in his provisional specification, to detail the advantages of his invention. . . . No doubt, in the first part of his invention, when he is dealing with his tyres when used as the only tyres on a cycle, and not as covers to existing rubbers, he does effect all the three chief objects mentioned above. . . . He certainly obtains one of those objects when his tyre, with its fastening, is applied as a cover to pneumatic rubbers, namely, the securing of the tyre over the existing pneumatic rubber; and if he obtains that and other advantages by the extension, I fail to see why the extension, being useful, is not within the specification. He was not bound, when he came, in his provisional specification, to the extension, to point out its particular advantages; and, indeed, it would have been imprudent, if not impossible, satisfactorily for him to do so, seeing that different advantages might probably be obtained from covering different kinds of existing rubbers" (*k*).

Sub-sects. 3 and 4 of sect. 2 are as follows:— **Drawings may be required with**

(3) "*In the case of any provisional or complete specification*

(*k*) Another example of the kind is *Nuttall* v. *Hargreaves*, 1891, 8 R. P. C. 450.

provisional specification.

where the comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification (*l*).

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

THE COMPLETE SPECIFICATION.

The complete specification.

One of the essential considerations for the grant is that the patentee shall completely disclose the nature of his invention and the manner of carrying it into effect. This he does by filing a "complete specification" either at the time of the application or within six months thereof.

The information which must be conveyed by the complete specification is therefore considerably more than that required in a provisional, which need only describe the **nature** of the invention.

A complete and full disclosure is necessary, as the patent is in the nature of a bargain with the public, and the same principle of good faith must be applied as that which regulates other contracts.

The following are the requirements which a complete specification must fulfil, and which we shall proceed to treat in detail:—

1. It must be set forth in clear language, free from ambiguity, the nature of the invention and the way it is to be carried into effect, so that persons to whom it is addressed would have no difficulty in carrying out the invention from the description.
2. It must be framed in good faith and show clearly the best way of carrying out the invention known to the patentee at the time—including any information he may have

(*l*) The relation between the drawings and the letterpress will be discussed at p. 126.

(*m*) As to title, see p. 93 *et seq.*, supra. As to claims, see p. 126, infra.

acquired since filing a provisional specification subject to the qualification that we have mentioned on p. 96 *et seq.*

PRELIMINARY.

Person to whom addressed.

It is important in framing a specification **to consider to whom it is intended to convey information.** If one wished to instruct a cobbler in a chemical process, the description would have to be of a more detailed and explanatory character than a manufacturing chemist would require. On the other hand, a manufacturing chemist, though an intelligent man, might be unable to follow a description of a boot-repairing process which a cobbler would understand without difficulty.

Therefore the language to be used and the completeness of the description will depend entirely on the person to whom it is addressed. It is not sufficient to say that it must appeal to **the ordinary workman practising that particular trade**; since, for instance, a workman, or even a foreman, in a chemical works might not possess the technical skill and knowledge to understand a new chemical process which the manager would have no difficulty in directing them to put in practice. This must be understood when those judgments in which the words "*competent workmen*" are used come to be considered.

As an instance, the case of *The Incandescent Light Co.* v. *The De Mare Incandescent Gas Light Co.* (1896, 13 R. P. C. at p. 327) may be mentioned, where Mr. Justice Wills said: "The subject-matter of the specification is such that no one but a person possessing a very considerable amount of chemical knowledge could, at the date of the specification, be considered a competent workman."

Subject to this qualification the specification must be **intelligible** to the persons actually conversant with the trade to which the invention relates, and must be **sufficiently full to enable such a person to carry the invention into effect** (*n*).

Intelligibility and sufficiency questions of fact.

Whether it be so intelligible and whether it be sufficient are **questions of fact** in each particular case to be decided on evidence (*o*). Where the meaning of a phrase is dubious, or

(*n*) See p. 110, infra, for a more detailed discussion of this point.

(*o*) *R.* v. *Arkwright*, 1787, 1 W. P. C. 64; *Hill* v. *Thompson*,

Expert evidence.

there is a doubtful use of a commonly used word, the construction, as is the case with all documents, is for the Court alone (*p*). In the construction of technical words, however, there are involved the questions of intelligibility and sufficiency, and such construction is one of fact to be decided by the jury after hearing the evidence of experts in the trade (*q*), but except as to the meaning of scientific terms or as to the working of mechanical appliances or as to what will be the result of working mechanical appliances, or for the purpose of ascertaining the state of public knowledge at the date of the patent, expert evidence is inadmissible in determining the construction of a specification, and for this reason the ambit of the monopoly claim, *i.e.*, the "nature of the invention," is a matter not of evidence but of construction. The distinction was clearly pointed out by Lord Cairns in *The British Dynamite Co.* v. *Krebs* (1879, 13 R. P. C. at p. 192): "In determining whether the complete specification is sufficient, the first thing is to ascertain what the invention is. This is a question of construction, and the construction of the specification is for the Court, to be determined like the construction of any other written instrument, the Court placing itself in the position of some person acquainted with the surrounding circumstances as to the state of art and manufacture at the time, and making itself acquainted with the technical meaning in art or manufactures which any particular word or words may have. When the nature of the invention is thus ascertained by the Court, as a matter of construction, the Court has then to inquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the

Ambit of claim is for Court alone.

1817, 1 W. P. C. at p. 237; *The British Dynamite Co.* v. *Krebs*, 1879, 13 R. P. C. at p. 192; *Brooks* v. *Steele and Currie*, 1897, 14 R. P. C. at p. 73.

(*p*) *Neilson* v. *Harford*, 1841, 1 W. P. C. at p. 370; *Bovill* v. *Pimm*, 1856, 11 Ex. 740; *Seed* v. *Higgins*, 1861, 30 L. J. Q. B. at p. 317; 8 H. L. C. 565; *Hills* v. *Evans*, 1861, 31 L. J. Ch. at p. 460; *Brooks* v. *Steele and Currie*, 1897, 14 R. P. C. 73; and see Index, cap. "Evidence."

(*q*) *Neilson* v. *Harford*, 1841, 1 W. P. C. 370; *Hills* v. *Evans*, 1861, 31 L. J. Ch. 460; *Brooks* v. *Steele and Currie*, 1897, 14 R. P. C. 73.

particular art or manufacture; and this the Court can best do by the evidence of workmen of that description, and by the evidence of what workmen of that description have actually done under the patent." And Lindley, L.J., in *Brooks* v. *Steele and Currie* (1897, 14 R. P. C. at p. 73), said: "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. . . . But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined" (*r*).

In the case of *Hills* v. *London Gaslight Co.* (1857, 27 L. J. Ex. 60) it was held, that where the meaning of a document depends upon its terms and not on matters of fact *dehors* the document, the question will be for the judge, even although the terms are technical or scientific; and where an ambiguity was raised by evidence *dehors* the document, which was plain upon the face of it, the ambiguity being as to a term which imported one thing in a scientific sense, and another in a commercial sense, Baron Bramwell was of opinion that the meaning became a matter of fact for the jury.

Benevolent construction.

The leaning of the Courts is generally in favour of the patentee, and specifications will not be construed astutely so as to overthrow a patent. Sir George Jessel, in the case of *Hinks* v. *The Safety Lighting Co.* (1876, L. R. 4 Ch. D. at p. 612), said: "I am anxious, as I believe every judge is who knows anything of patent law, to support honest bonâ fide inventors who have actually invented something novel and useful, and to prevent their patents being overturned on mere technical objections or on mere cavillings with the language of their specifications, so as to deprive the inventor of the benefit of his invention; that is sometimes called a benevolent mode of construction; perhaps that is not the best term to use, but

(*r*) And see *Gadd and another* v. *The Mayor of Manchester*, 1892, 9 R. P. C. at p. 530.

it may be described as construing the language of the specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported by a reasonable construction of a patent; beyond that the benevolent mode of construction does not go." And the same judge, in *Plimpton* v. *Spiller* (1877, L. R. 6 Ch. D. at p. 422), adopted the remark that "the judge is not to be astute to find flaws in small matters in a specification with a view to overthrow it."

The word "benevolent" has been commented on in several cases (*s*) :—

In *Otto* v. *Linford* (1881, 46 L. T. N. S. at p. 39) Jessel, M.R., said: "I have heard judges say, and I have read that other judges have said, that there should be a benevolent interpretation of specifications. What does this mean? I think, as I have explained elsewhere, it means this, when the judges are convinced that there is a genuine, great, and important invention, which, as in some cases, one might almost say, produces a revolution, in a given art or manufacture, the judges are not to be astute to find defects in the specification, but on the contrary, if it is possible, consistently with the ordinary rules of construction, to put such a construction on the patent as will support it."

In *Needham* v. *Johnson* (1884, 1 R. P. C. at p. 58) Lindley, L.J., said: "I do not like the expression 'benevolent interpretation.' I do not believe in it. The question is whether a given construction is the true construction; but, of course, if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent rather than a construction which renders it invalid."

Lord Esher, M.R., in *Nobel's Explosives Co.* v. *Anderson*

(*s*) See also on this point *Russell* v. *Cowley*, 1835, 1 W. P. C. at p. 469; 1 Cr. M. & R. 864; *Thomas* v. *Foxwell*, 1858, 6 Jur. N. S. 272; *Binney* v. *Feldtman*, 1871, Griff. P. C. at p. 50; *Cropper* v. *Smith*, 1884, Griff. P. C. at p. 62; 1 R. P. C. 88; *Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 R. P. C. at p. 307; *Edison* v. *Smith*, 1894, 11 R. P. C. at p. 400; *Parkinson* v. *Simon*, 1895, 12 R. P. C. at p. 411; *Tolson* v. *Speight*, 1896, 13 R. P. C. 721; *Patent Exploitation, Ltd.* v. *Siemens Bros.*, 1903, 20 R. P. C. at p. 234.

(1894, 11 R. P. C. at p. 530), said: "It is quite true that the Court has in this specification, as in every other, to put upon it the most favourable construction which it honestly can in favour of the patentee. What does that involve? If the Court does not take care to confine the patentee's patent within its legitimate limits the Court will hold the patent to be such as would render it void. Therefore they must take care not to stretch his claim, otherwise they may by their construction make the patent void. They must not diminish the claim, limit it too tightly, or they may make his patent worthless. Then they have to come to really what is the honest business conclusion of the meaning of what is written down. That is what they have to do."

In the same case Lord Esher said (p. 523): "I am clearly of opinion that, whether the patent be a pioneer patent, or a master patent, or a patent of the first invention, or whether it be a valuable patent or a patent for the smallest thing, or whether it be a patent for an improvement, or whatever the patent may be, the canons of construction of the patent are precisely the same. What is more, I am further of opinion that the canons of construction of the patent are the same canons of construction that are to be applied to every written instrument which has to be construed by the Court."

Lord Chelmsford, in *Harrison* v. *Anderston Foundry Co.* (1876, L. R. 1 A. C. at p. 581), said: "The language should be construed according to its ordinary meaning, the understanding of technical words being, of course, confined to those who are conversant with the subject-matter of the invention, and if the specification is thus sufficiently intelligible it performs all that is required of it." In *Clark* v. *Adie* (1877, L. R. 2 A. C. at p. 423) it was held that the words used in the specification must be construed like the words in any other instrument in their natural sense, according to the general purpose of the instrument in which they are found.

The patentee is to be presumed not to claim things which he must have **known** perfectly well **were not new** (*t*), but if

(*t*) *Haworth* v. *Hardcastle*, 1834, 1 W. P. C. at p. 484; *Cropper* v. *Smith*, 1884, 1 R. P. C. at p. 85; *Lyon* v. *Goddard*, 1893, 10 R. P. C.

upon a fair construction of the specification it is clear that he has claimed such old contrivance the patent will be void upon that ground (*u*).

In *Adie* v. *Clark* (1877, L. R. 2 A. C. at p. 437) Lord Blackburn said: "When it is attempted . . . to say that inasmuch as these specifications show, or are alleged to show, that matters which upon a fair construction of the specification are claimed by the patentee, were old at the time that the patent was taken out, and were generally known to be old, therefore the specification must be so construed as not to include them; that seems to me both contrary, as far as I know, to the course of decision and contrary to principle."

A patent may be, as we have seen, for the application of a newly-discovered principle of manufacture, or for that of an old principle to a new object, or for a new method of carrying out an old principle applied to an old object. It frequently becomes a matter of construction upon the specification as to which of these branches of invention the specification is intended to apply, and there have been several cases upon the subject. It is evident that, inasmuch as the patent will be valid provided a fair description of a new invention in either branch is given, in construing the specification of a patent a decided case upon some other specification will be of very little value. We do not propose, therefore, to discuss at length the constructions which have been placed upon specifications in particular cases.

Construction as of date of publication.

A specification is to be construed with reference to the state of knowledge at the time it is published (*x*). Lord Esher, in *Nobel's Explosives Co.* v. *Anderson* (1894, 11 R. P. C. at

at p. 133; *Tubes, Ltd.* v. *Perfecta Seamless Tube Co.*, 1903, 20 R. P. C. at p. 97.

(*u*) This statement of the law was approved by Swinfen Eady, J., in *The Cooper Patent Anchor Rail Joint Co.* v. *The London County Council*, 1906, 23 R. P. C. at p. 295.

(*x*) And see *The Badische Anilin und Soda Fabrik* v. *Levinstein*, 1887, L. R. 12 App. Cas. 710; 4 R. P. C. at p. 463; *Ellington* v. *Clark*, 1888, 5 R. P. C. at p. 325; *The Presto Gear Case Co.* v. *Orme, Evans & Co.*, 1901, 18 R. P. C. at p. 23; *Patent Exploitation, Ltd.* v. *Siemens Bros.*, 1903, 20 R. P. C. at p. 234; *The Consolidated Car Heating Co.* v. *Carne*, 1903, 20 R. P. C. at p. 766.

p. 523), said: "Now what is the very first canon of construction of all written business documents? Why, that the Court ought to construe them as if it had to construe them the day after they were published."

In the construction of a specification, as in the construction of any other document, the Court will read the whole and endeavour to place an interpretation upon it which will be consistent with each part (*y*), including the drawings (*z*), and will give an effective meaning to every part of it, if it can. Lord Esher, M.R., in *Parkinson* v. *Simon* (1894, 11 R. P. C. at p. 502), said: "Now when you find a patent with several claims in it, you must, if you can, so construe those claims as to give an effective meaning to each of them. If there are several claims in the patent which are identical with each other, then some of them have no effect at all. It follows from the ordinary rule of construction that you must construe the different claims so as to make them effective if possible, to be different from each other in some respects, or else they are not effective." And further, the Court will even look at the provisional specification for the purpose of ascertaining the real object of the invention disclosed in the complete; "for the object of the complete is to carry out in detail that which is more generally expressed in the provisional specification" (*a*). But if the provisional specification contains a description of the manner in which the invention may be carried into effect, it *does* not follow that if the complete specification describes a better method, the earlier method is thereby disclaimed (*b*).

Construction of amended specification.

In *Hattersley* v. *Hodgson* (1906, 23 R. P. C. 192) the Court of Appeal had decided that they could not look at the deleted portions of an amended specification for the purpose of construing the remainder. The House of Lords, without

(*y*) *Newton* v. *Vaucher*, 1851, 6 Exch. at p. 864; 21 L. J. Ex. 305; *Edison* v. *Woodhouse*, 1887, 4 R. P. C. at p. 107; *Parkinson* v. *Simon*, 1894, 11 R. P. C. at p. 502; *Tubes, Ltd.* v. *Perfecta Seamless Tube Co., Ltd.*, 1903, 20 R. P. C. at p. 96.

(*z*) *Hattersley* v. *Hodgson*, 1906, 23 R. P. C. at p. 203.

(*a*) Per Lord Esher, M.R., in *Parkinson* v. *Simon*, 1894, 11 R. P. C. at p. 503.

(*b*) *Sandow* v. *Szalay*, 1906, 23 R. P. C. at p. 14.

making any formal pronouncement on this point, actually did examine and consider the deleted portions. The report of the case is defective, as this action of the House of Lords is not mentioned (see p. 125).

Previous constructions binding.

When a specification has once received a judicial construction the Court, in a subsequent action in respect of the same invention, will hold itself bound on that point by such previous decision (*c*), but fresh evidence may be adduced at the second action for the purpose of showing that that which before was not regarded as an anticipation is so in fact (*d*).

For the rules governing construction of the claims see p. 130.

FIRST REQUIREMENT—INTELLIGIBILITY AND SUFFICIENCY.

Intelligibility and sufficiency distinguished.

The inventor must point out clearly (1) the nature of his invention and (2) the manner of carrying it into effect.

In *Phillpott* v. *Hanbury* (1885, 2 R.P.C. at p. 38) Grove, J., said: "By the letters patent, a patentee is required as a condition of his patent, to particularly ascertain and describe the nature of his invention and the means of performing the same. **Now those are two quite different things.** The object of requiring the patentee to state what his invention is, as has been said (for I am by no means the first who has said it), to let the public know what is the prohibited ground, and what they are not to do—what the patentee has got his grant for, which gives him a monopoly for fourteen years . . . a patentee for the purpose of telling the public what his patent prevents their using without his licence for fourteen years, must give the nature of his invention in reasonably accurate language. . . . Then the second proviso is that he shall also particularly ascertain the means—I repeat the words, though the words are not repeated but implied—of performing the same, that is, of carrying the invention into practical effect. **That is a totally different object.** The object of that is to prevent what was at one time done and

(*c*) *Edison* v. *Holland*, 1889, 6 R. P. C. at p. 276; *The Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 1889, 6 R. P. C. at p. 370, and the various actions on the Welch patent.

(*d*) *Shaw* v. *Day*, 1894, 11 R. P. C. at p. 189; see also *Edison* v. *Holland*, 1889, 6 R. P. C. at p. 277.

practised, I believe to a large extent, namely patentees getting patents for an invention and keeping to themselves the 'trick of the trade,' if I may use the expression, that is to say, the means of performing it. . . . Letters patent therefore say 'you shall not have this monopoly unless you do two things—first of all, disclose the nature of the invention and tell the public the prohibited ground; and secondly, give them the means of carrying it into effect, so that at the expiration of your patent anybody (at all events, anybody with the ordinary knowledge of the particular trade to which it relates) may put your invention into practice.'"

We will deal further with the need of stating the **nature of the invention**, *i.e.*, **the statement of the monoply claimed** when discussing the requirements which must be fulfilled by the claims (*e*).

Intelligibility and sufficiency are required. Both depend on the class of persons to whom the specification is addressed (*f*), and on the common knowledge in the industry at the date when the specification is published. An instance is provided by the case of *The Badische Anilin und Soda Fabrik* v. *Levinstein* (1885, L. R. 24 Ch. D. 156; 2 R. P. C. at p. 73). The patentee claimed, "First, the production of red and brown colouring matters, which in chemical language may be termed the sulpho acids of oxyazo-naphthaline by the action of the diazo compounds, which may be prepared from naphthylamine or from the sulpho acids of naphthylamine upon any of the isomeric naphthols, or of mixtures of the same, or upon any of the sulpho acids which may be prepared from either alpha naphthol or from beta naphthol, or from mixtures of the same substantially by the process above described." It appeared that the patent was dated 1878; that there were two descriptions of naphthylamine, one called alpha naphthylamine and the other beta naphthylamine; that the substance alpha naphthylamine had been known for a considerable period of time, but that beta naphthylamine had only been discovered in 1876; that at the date of the patent beta naphthylamine was very little known and very rare; that up to

(*e*) See p. 128

(*f*) See p. 103, ante.

the year 1880 it was only used in laboratory experiments and that it was very costly; and that until beta naphthylamine was known, the alpha compound only was known and was called naphthylamine. Objection, that it was not stated what naphthylamine it was intended to be used. Pearson, J., said (at p. 161): "I come to the conclusion that the word 'naphthylamine' in the patent means that which was generally known in the year 1878 as naphthylamine, namely, what is now described as alpha naphthylamine . . . although beta naphthylamine was invented in 1876 and would at once be called beta naphthylamine to distinguish it from the naphthylamine which had been known for at least fifteen years before, it does not follow that that naphthylamine would all of a sudden acquire the name of alpha naphthylamine; it would remain in all the books printed up to that time as naphthylamine only, and I am satisfied that at the date of the patent and subsequently to the date of the patent any person ordering naphthylamine simply, would have been supplied with the old naphthylamine, and nobody would have thought of asking him whether he wanted 'beta naphthylamine.' Under these circumstances, I think it would be improper to come to the conclusion that any naphthylamine was meant in this patent except that which was known simply as 'naphthylamine,' that is, that which is now properly described as 'alpha naphthylamine.'"

In the Court of Appeal (L. R. 29 Ch. D. at p. 384) Baggallay, L.J., differing from Fry and Bowen, L.JJ., said: "If the language of the specification can be fairly construed, so as in the one case put, to support the validity of the patent, if challenged on the ground that the use of beta naphthylamine would lead to failure, and in the other to protect the patentee against an infringement by the use of that substance, it would be fatal to the plaintiff's case in the present action whether the language had been adopted *per incuriam* or of set design. Though the term 'the literature' has been conveniently applied to the documentary evidence admitted in the present case, it is clear that publications of this nature must be regarded as of two classes—those addressed to the scientific world, and those addressed to working or

practical men, a distinction which cannot, in my opinion, be more simply and clearly illustrated than it was by Dr. Odling, who, being asked by Pearson, J., when the body, as alpha naphthylamine, but formerly known as naphthylamine without any prefix, first acquired its present name, replied as follows: 'My lord, there are two distinct forms of literature upon the subject. There is the systematic scientific literature, and there is the technical literature; and in the technical literature it is called naphthylamine up to the present day, but in the more scientific literature you may find the distinction, although it is very rare.' The distinction between the information given by scientific literature and that given by technical literature is one very important to be borne in mind when we are dealing with questions such as that now under consideration. Publications having reference to chemical science and intelligibly expressed will always be inquired after and studied in their laboratories by scientific chemists, ever on the alert to make themselves acquainted with the newest compounds, with a view of putting them to some useful purpose; but, speaking generally, it is not the fact that such publications are sought after and studied by practical working chemists, whose labours for the most part commence after the useful purpose has been ascertained."

In the House of Lords (L. R. 12 A. C. at p. 723) Lord Herschell, upon the same point, said: "I am satisfied that after 1875 and down to the time of the patent, alpha naphthylamine was still sometimes spoken of as 'naphthylamine,' and that if any *one had ordered 'naphthylamine' of a manufacturer, he would* without hesitation have supplied alpha naphthylamine. Under these circumstances, I entertain no doubt that any reader of the specification would understand by the word 'naphthylamine' occurring in it, the known commercial article, which, until recently at all events, had always borne that name, and not beta naphthylamine, to which the term 'naphthylamine' alone had never been applied. I am, therefore, of opinion that the specification is not in this respect open to the charge of ambiguity."

In *Heath* v. *Unwin* (1852, 2 W. P. C. at p. 245) Baron

Alderson said: "Every specification is to be read as if by persons acquainted with the general facts of the mechanical or chemical sciences involved in such invention; thus, if a particular mechanical process is specified, and there are for some parts of it, as specified, other well-known mechanical equivalents, the specification in those parts is in truth the specification of the well-known equivalent also, to those to whose general knowledge we refer: viz., mechanics and readers of specifications; and so it is with chemical equivalents also, in a specification which is to be read by chemists. But it may be that there are equivalents, mechanical and chemical, existing, but previously unknown to ordinary skilful mechanics and chemists. These are not included in the specification, but must be expressly stated there."

Degree of sufficiency required.

In other words, **an inventor is entitled to assume that the persons to whom the specification is addressed possess the ordinary skill of their trade,** and he is not required to give directions of a more minute nature than such a person might fairly be expected to need (*g*). If, for example, in the process of the invention it is necessary to use some old or well-known apparatus, it is not necessary in the specification to describe the apparatus, save in such terms as it is generally known by, in the particular business to which it belongs (*h*). But should the success of the invention depend particularly on the manner in which an old instrument though well known is directed to be used, the directions must lay stress on this point.

In *The Badische Anilin* v. *La Société Chimique* (1898, 15 R. P. C. 364), the specification directed that two substances were to be heated together "in an iron autoclave." Now it was proved that in similar operations the trade frequently made use of autoclaves which were not made of iron, and in many such operations enamelled autoclaves had advantages.

(*g*) *Boulton* v. *Bull*, 1795, 2 H. Bl. at p. 478; *Morgan* v. *Seaward*, 1836, 1 W. P. C. at p. 174; *In re Gaulard and Gibbs' Patent*, 1886, 6 R. P. C. 224; *Edison* v. *Holland*, 1889, 6 R. P. C. at p. 282; *Miller* v. *Clyde Bridge Steel Co.*, 1891, 8 R. P. C. at p. 201; *Hopkinson* v. *St. James's and Pall Mall Lighting Co.*, 1893, 10 R. P. C. at p. 61; *Kane* v. *Boyle*, 1901, 18 R. P. C. at p. 336.

(*h*) *Crossley* v. *Beverley*, 1829, 3 C. & P. 513; 1 W. P. C. 110, n.

The success of the plaintiff's process entirely depended upon the use of an *iron* vessel, without which the reaction would not take place. The specification was declared insufficient.

The specification must be sufficient to enable the invention to be carried into effect without a series of experiments.

Jessel, M.R., in *Plimpton* v. *Malcolmson* (1876, L. R. 3 Ch. D. at p. 576), said: "You must not give people mechanical problems and call them specifications."

In *R.* v. *Wheeler* (1819, 2 B. & Ald. at p. 354) Abbott, C.J., said: "A specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad."

Degree of experiment necessitated.

But this broad statement requires some modification. The inventor cannot be expected to relieve the "competent workman" from all obligation to take trouble in carrying into effect the description in the specification. Moreover, it may safely be said that in modern engineering practice no one would think of treating the drawings of a machine in a specification as working drawings. Even with the best of such drawings a certain amount of designing and calculation has to be carried out before a machine can be built, and the degree of knowledge requisite to perform such operations must be presumed in the person to whom the specification is addressed. From this point of view the classification by Jessel, M.R., in *Plimpton* v. *Malcolmson* (1876, 3 Ch. D. at p. 569), of different kinds of workmen, and his selection as a matter of law of the kind to which all specifications are addressed, is quite out of date as a generalisation, although of course perfectly correct as governing the issues in that particular case.

The law was stated in a manner which is applicable to modern conditions by Alderson, B., in the far older case of *Morgan* v. *Seaward* (1836, 1 W. P. C. at p. 176): "You see a specification is addressed to all the world, and, therefore, all the world, at least those possessed of a competent skill, ought to be able to construct the machine by following that specification. . . . There was put in, on the part of the defendants, a model, made as it was said, according to the specification, which model would not work. The model was a copy of the drawing, and would not work because one part happened to

be a little too small, whereas if it had been a little larger, it would have worked. Now a workman of ordinary skill . . . would, of course, by the knowledge and skill he possesses, make them of sufficient size to move. There he would have to bring to his assistance his knowledge that the size of the parts is material to the working of the machine" (*i*).

In *The Edison and Swan Light Co.* v. *Holland* (1889, 6 R. P. C. at p. 282) Lindley, L.J., said: "The defendants contend that the competent workman could have made 'carbon filaments' according to the specification without further instructions than are there given. If it be meant that few competent workmen could make them without some practice, I think the contention is well founded; but that is not sufficient to invalidate the patent. If a person is told to carbonise a thread, and, for want of thought or practice, he takes a porous crucible for that purpose, and does not protect his thread, and fails, whereas if he had packed this crucible, or had taken a non-porous crucible, he would have succeeded, his failure can hardly be said to be the fault of his instruction, if a little thought or consideration would have shown that a packed crucible, or a non-porous crucible, was the right one to employ. The fact that the 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 which tool to use."

There is a head-note to the case of *Betts* v. *Neilson* (1868, L. R. 3 Ch. 429) which is apt to mislead; it runs as follows: "Whether a specification contains a sufficient description can only be ascertained by experiments, and in making an experiment knowledge and means may be employed which have been acquired since the date of the patent." It is evident that this head-note is incorrect, and if the case be read it will be found that the judgment of Lord Chelmsford was, not that the specification of the plaintiff could be held sufficient or insufficient upon experiments tried on the specification itself, with the assistance of subsequently-acquired knowledge, but that

(*i*) And see *Otto* v. *Linford*, 1882, 46 L. T. N. S. at p. 40, per Jessel, M.R.

the specification, which was alleged to anticipate the plaintiff's patent, might be read for the purpose of determining whether there was anticipation or not, or whether there had been prior publication or not in the light of knowledge acquired by the general public since the date of the specification. This would be undoubtedly correct, because the question always is, in dealing with matters of prior publication, Was the supposed invention of the plaintiff, at the time when he obtained his patent, already part of the public stock of knowledge or not? The public stock of knowledge consisted of the specification, which is put forth as anticipating the patent, together with all knowledge on the subject which can be proved to have been published or used prior to the date of the plaintiff's patent, and so in reading a specification with a view to ascertaining whether it anticipates a subsequent patent you must read into that specification all subsequently-acquired knowledge of the subject prior to the date of the patent; but in discussing the sufficiency of the specification which is actually in dispute, you cannot make use of information which has been acquired since the publication, for otherwise it would be held that the patent, which was void at first for insufficiency of specification, might become valid at some subsequent date by further discovery, which is obviously absurd.

Effect of errors.

An error in a specification which may be said, in a sense, to be a technical error, **will not vitiate a specification,** although it be an error in description or drawing, **provided** it be such an error that an ordinary skilled workman would at once observe and be in a position to correct; provided it is not such an error as would require experiments to show that it was an error (*k*).

And it frequently occurs that the inventor states an **erroneous theory** as to the operation of the machine or process, the subject of the invention. This will not invalidate the patent unless it amounts to a misleading statement (*l*).

(*k*) Per Lord Westbury, *Simpson* v. *Holliday*, 1866, 13 W. R. 578; L. R. 1 H. L. 321; and see *Otto* v. *Linford*, 1882, 46 L. T. N. S. at p. 40; *Miller* v. *Scarle*, 1891, 10 R. P. C. at p. 111; *British United Shoe Machinery Co.* v. *A. Fussell and Sons, Ltd.*, 1908, 25 R. P. C. at p. 385.

(*l*) *Monnet* v. *Beck*, 1897, 14 R. P. C. at p. 847.

In *Wegmann* v. *Corcoran* (1879, L. R. 13 Ch. D. 67) it was held that the specification of a patent was bad if one of the materials to be used was described by a generic term comprising a variety of species, the majority of which would be unsuitable, thus rendering experiment necessary to ascertain which were suitable.

But if the inventor describes, under a generic term, an ingredient to be used, and illustrates the term by examples, the mere fact that some things which might be included under the generic term, and are not described, would not be suitable, will not invalidate the patent. In *Leonhardt* v. *Kallé* (1895, 12 R. P. C. at p. 116) Romer, J., said: "Now, with reference to that, what has the patentee done, and what really could he do more? He has pointed out numerous oxidisable substances, and admittedly those oxidisable substances he mentioned are as good, if not better, and are more easily dealt with than the other oxidisable substances which are not specifically mentioned. Was it reasonable to suppose that the patentee ought to set himself down as a sort of dictionary to specify every known oxidisable substance, and to point out which of those could not give very useful results, or which might be disregarded?"

The question of the sufficiency of a specification is one which must be dealt with on each particular case as it arises; a single word added to a specification may make that which was insufficient sufficient, and that which would be a sufficient description of one invention would be found to be an insufficient description of another, consequently there can be no absolutely fixed rules of construction in dealing with specifications.

SECOND REQUIREMENT, GOOD FAITH AND DISCLOSURE OF BEST METHOD.

Good faith and best method required.

In *Turner* v. *Winter* (1787, 1 W. P. C. at p. 80) Ashurst, J., said: "It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear that there is any **unnecessary ambiguity** affectedly introduced into the

specification, or anything which tends to mislead the public, in that case the patent is void."

If a patentee **suppresses** anything, or if he **misleads**, or **if he does not communicate all he knows**, his patent is bad.

In *Crompton* v. *Ibbotson* (1828, 1 W. P. C. 83) the specification stated: "My invention consists in conducting paper by means of a cloth against a heated cylinder, which cloth may be of *any suitable* material, but I *prefer* it to be made of linen warp and woollen weft." It appeared that the plaintiff had tried several things but was unable to discover anything that would answer the purpose with the exception of the material which he said "he preferred." Lord Tenterden held that the specification was misleading, and therefore bad.

In *Wegmann* v. *Corcoran* (1879, L. R. 13 Ch. D. 67) the invention patented, on a communication from abroad, consisted of a special construction of rollers for milling corn. The specification prescribed the use of iron rollers covered with very hard china, turned smooth by the aid of diamond tools. It was proved that china of the requisite hardness had not been made in England for half a century, and that such china could not be made unless the manufacturer tried elaborate experiments. The plaintiff himself obtained his rollers from Italy, where the process of their manufacture was kept secret, but the specification did not mention this fact, and without it the description in the specification was useless. The specification was held to be insufficient and misleading. Fry, J., said:

In case of communicated invention.

"Though the grantee of a patent for an invention communicated to him by a foreign resident abroad is only bound to tell the public what he himself knows, yet if the original inventor has not told him enough to enable him so to describe the invention as that it could be constructed by the aid only of the specification, the patent will be invalid." *Sturtz* v. *De la Rue* (1828, 1 W. P. C. 83) was a very similar case.

It will be seen that *Wegmann* v. *Corcoran* is distinguishable from the case of *Plimpton* v. *Malcolmson* (1876, L. R. 3 Ch. D. 582). There the question was whether the patentee, having disclosed a useful invention, was bound to disclose something more, some fact more useful still than the description actually

given, which he himself did not know, but which was within the knowledge of the person communicating from abroad; in that case it was properly held that he was not so bound, but it is obvious that he was bound to describe an invention in his specification which of itself was useful, and that he was bound to tell all that he himself knew, and to give a sufficient description to work the invention.

In *Lewis* v. *Marling* (1829, 1 W. P. C. at p. 495) Lord Tenterden said: "I agree that if the patentee mentioned that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful."

Inutility in unessential part of description.

Upon the same ground of mala fides it has been held, in a large number of cases, that if the patentee in his specification gives details which are not necessary to the invention, which of themselves do not constitute an invention, and which are merely put in for the purpose of misleading the public as to either what is the nature of the invention or how it is to be carried into effect, then the patent will be void.

And Bayley, J., in *Lewis* v. *Marling*, said: "His patent is for an instrument where something of that kind was always thought material, and I am of opinion that the subsequent discovery that the plush was unnecessary is no objection to the patent. If the party knew that it was unnecessary the patent would be bad, on the ground that this was a deception, but if he thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that forms no ground of objection."

Therefore the requirement is not as much for perfection of detail as for good faith on the part of the patentee. This is illustrated by the case of *The British Dynamite Co.* v. *Krebs* (1896, 13 R. P. C. at p. 195). The inventor, Nobel, described a new explosive (dynamite) which he said, in his specification, was to be made by causing nitro-glycerine, *per se* a very dangerous and erratic liquid, to be absorbed by a non-porous

unexplosive substance. He gave a list of such substances which were shown to be more or less useful. The resulting mass was safe and could be stored. He found subsequently that there was a certain, well-known silicious earth called "kieselguhr" which possessed the requisites of porosity and power of absorption to a very high degree, and the dynamite actually manufactured was, in consequence, always produced by the aid of this material. Lord Hatherley, affirming the judgment of James, L.J., said: "If it had been proved that the inventor, Nobel, knew the best material, which turned out to be a material called 'kieselguhr,' a silicious earth; if he had known of the existence of 'kieselguhr' at the time, and that it would take up 75 per cent. of the nitro-glycerine, whereas some other materials specified by the patentee took up only 25 or 50 per cent., it would have been an objection to his patent to say that he, being in possession of the best mode of producing the most valuable dynamite, had not informed the public of that method."

In *Tetley* v. *Easton* (1856, Mac. P. C. at p. 76) Pollock, C.B., said: "A man has no right to patent a principle and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it." And in *Heath* v. *Unwin* (1850, 2 W. P. C. at p. 234) Coleridge, C.J., said: "If the inventor of an alleged discovery, knowing two equivalent agents for effecting the end, could, by the disclosure of one, preclude the public from the benefit of the other, he might, for his own profit, force upon the public an expensive and difficult process, keeping back the simple and cheap one, which would be directly contrary to the good faith required from every patentee in his communication with the public."

In *Wood* v. *Zimmer* (1 W. P. C. 82, n.) decided so far back as 1815, a very clear idea of the law upon this branch of the subject is given. In this action to try the validity of Zinck's patent "for a method of making verdigris," it appeared that the method described in the specification was sufficient to make verdigris, but that Zinck had been accustomed, clandestinely, to put aquafortis into the boiler, whereby the metallic

copper was dissolved more rapidly, but the verdigris produced was neither better nor cheaper than that made according to the specification. Gibbs, C.J., said: "It is said that the method described makes verdigris, and that the specification is therefore sufficient—the law is not so. A man who applies for a patent, and possesses a mode of carrying out that invention in the most beneficial manner, must disclose the means of producing it in equal perfection and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way and with the same advantages. If anything that gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigris substantially as good without the aquafortis as with it, still, inasmuch as it would be made with more labour by the omission of aquafortis, it is **prejudicial concealment** and a breach of the terms which the patentee makes with the public."

In this case it must have been proved that the patentee, at the time when he obtained his letters patent and filed his specification, knew of the benefit to be derived by the use of aquafortis. It is evident that if he did not know it at the time, but **discovered it subsequently** during the currency of the patent, that then it would form an improvement upon his invention, and not one which he could possibly have disclosed at the time he filed his specification, and therefore there would be no mala fides on his part in not describing it (*m*).

The remarks of Gibbs, C.J., in *Bovill* v. *Moore* (1816, Dav. P. C. 400), go to the same extent; and in *Crossley* v. *Beverley* (1830, 1 W. P. C. 117) Bailey, J., said: "It is the duty of the inventor if, between the period of taking out the patent and enrolling the specification, he makes discoveries which will enable him better to effect the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and it is not sufficient for him to communicate to the public the

(*m*) See *Lewis* v. *Marling*, 1829, 1 W. P. C. at p. 496; and *British Dynamite Co.* v. *Krebs*, 1896, 13 R. P. C. at p. 195, supra.

knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he had obtained before the specification." In *Morgan* v. *Seaward* (1836, 1 W. P. C. 174) Alderson, B., said: "If the patentee is acquainted with any particular mode by which his invention may be most conveniently carried into effect he ought to state it in his specification; that was laid down in a case before Lord Mansfield; there the question arose on a patent for steel trusses. It appeared that the patentee in some parts of his process used tallow to facilitate the invention for which he had obtained a patent, and in his specification he made no mention of the use of tallow. The Court held the specification to be bad, because they said: 'You ought not to put people to find out that tallow is useful in carrying into effect the invention of steel trusses. You ought to tell the public so if that is the best mode of doing it, for you are bound to make a bonâ fide full and candid disclosure.'" The case referred to by the learned judge was the case of *Liardet* v. *Johnson* (1778, 1 W. P. C. 53).

In *The Badische Anilin und Soda Fabrik* v. *Levinstein* (1887, 4 R. P. C. at p. 464; L. R. 12 A. C. 716) the patentee in his specification described four processes whereby he could produce sulpho acids of oxyazo-naphthaline applicable to dyeing and printing, varying in colour from brown to red. All these processes he claimed, although only one of them was proved to have any practical value, and it was argued that the patent was bad on the ground that no description was given of the relative advantages of each particular shade of colour; it was held by the House of Lords, reversing the decision of the Court of Appeal, that to require such discrimination was to insist upon what was really impracticable; for, in the words of Lord Halsbury, L.C., "Upon the principle contended for, each shade must not only be shown, but its excellence or popularity must be distinguished separately by the patentee. This, as it appears to me, reduces the obligation supposed to press upon the patentee to an absurdity."

No need to state advantages,

But where the attainment of a particular advantage constitutes the whole essence of the invention it is necessary to state

save where such are whole essence of invention.

this advantage in order to properly delimit the invention. In *Clay* v. *Allcock* (1906, 23 R. P. C. 745) the invention consisted of a paternoster sea-fishing line, in which booms carrying hooks were pivoted at right angles to the trace, and were capable of swinging downwards so as to give a "straight pull" when a bite occurred; so far the invention was not novel. The specification stated, however, that the inward end of the boom should be constructed "preferably" of a diamond shape, and the drawings illustrated a construction of this form. The claim was for booms constructed "as described." It appeared, although it was not so stated in the specification, that a particular advantage attended the use of the diamond shape which rendered it very useful and constituted the whole novelty of the invention. The Court of Appeal held that the claim was invalid for want of novelty. Fletcher Moulton, L.J., said: "I quite agree that in the preferable form of his invention, which the patentee has shown in his drawings, he would have that effect or advantage, but I can find nothing which indicates that he intended that to mark out the limits of his territory. . . . Counsel for the plaintiff urged the well-known principle in patent law that a man need not state the effect or the advantage of his invention, if he describes his invention so as to produce it. But that is not true where he has to rely on the presence or absence of such effect or advantage as a part of the necessary delimitation. The fact that it is a mere consequence cannot be pleaded by him as an excuse for not putting it in, if the leaving it out leaves his invention inadequately defined."

If the specification describes **more than one process** for arriving at a result, and **fails in respect of one of them** by reason of insufficiency, **the whole patent will be void.**

To sum up the effect of the decisions on deception and insufficiency:—

If **extraneous matter** is put into the specification, bonâ fide thinking that it is necessary, the patent will not be held to be void; if it is put in malâ fide, with the intention of deceiving, or with the knowledge that it is extraneous and useless, the patent will be void. If the extraneous matter is in itself misleading, and would prevent a skilled workman from

! Drawings, illustrations only

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successfully carrying out the invention, whether it is put in malâ fide or boná fide, the patent will be void. It will be seen that in the latter case the specification is insufficient, and in the former two cases the question is one simply of bona fides on the part of the inventor.

The object of the patent is to benefit the world, and not to obstruct a subsequent invention; consequently, if the specification is worded in such a manner as to **grasp at more** than the patentee has actually invented, and to endeavour to cover, so to speak, wholesale problematic inventions, the patent will be void (*n*).

By sect. 2, sub-sect. 3, of the Act of 1907, it is enacted: "*In the case of any provisional or complete specification where the comptroller deems it desirable, he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification.*"

Before the Act of 1883 (*o*) drawings were quite optional on the part of the patentee (*p*); but then, as now, if drawings had not been filed, and the invention had been too complicated to be understood without them, the patent would be invalid on account of insufficiency, and not because drawings were not filed. Drawings have always been held to be merely part of the specification and to be read with the letterpress, and whether the invention will be limited by the drawings will depend on the nature of the invention (*q*).

Collins, M.R., said, in *Hattersley* v. *Hodgson* (1904, 21 R. P. C. at p. 525): "Now in my judgment (and I think it has been so held) a patentee may show what he claims either by the printed matter of the specification alone, or by the drawings alone, or by the combination of the two" (*r*).

(*n*) *Crossley* v. *Potter*, 1853, Macr. P. C. at p. 245.

(*o*) Sect. 5, sub-sect. 4.

(*p*) *Boulton* v. *Bull*, 1795, Dav. P. C. at p. 188; *In re Fox's Patent*, 1812, 1 W. P. C. 431, n.

(*q*) See, as instances, *Bloxam* v. *Elsee*, 1827, 1 C. & P. 558; *Lawrence* v. *Perry*, 1885, 2 R. P. C. at p. 186; *Fairburn* v. *Household*, 1886, 3 R. P. C. at p. 267; *Pickard* v. *Prescott*, 1890, 7 R. P. C. at p. 365; *Miller* v. *Scarle*, 1893, 10 R. P. C. at p. 111.

(*r*) And see *Hattersley* v. *Hodgson* (2nd action), in the House of Lords, 1906, 23 R. P. C. at p. 202.

Discrepancies in drawings.

It is sometimes asked, "What is to be done if there is a discrepancy between the printed matter and the drawings?" And this may be answered by the question, "Does the discrepancy produce ambiguity sufficient to mislead?" If it be clear to persons skilled in the trade what is meant, then the patent is not ambiguous, and it is immaterial from which part of the specification they have drawn their information. If there is ambiguity, the patent is invalid. It is submitted that this proposition covers the whole point.

The claims.

We have seen that part of the consideration for the grant of letters patent is, that the inventor shall particularly describe and ascertain the nature of his invention, and in what manner it is to be performed; consequently, for a specification to be sufficient it must particularly ascertain: (1) What the monopoly claimed is; (2) How the invention is to be carried out. Under the first head the inventor must describe exactly and accurately what he claims, and if in the course of the description of his invention it should be necessary for him to describe something which is old but which he wishes to use in the process of his invention, he must be careful to say, or at least to indicate, "This is old and I do not claim it as a part of my invention." There are two reasons why the inventor should be called upon to fulfil these conditions: one is, that the public may be placed in a position to use the invention so soon as the period of protection has elapsed; and the other is, that the public may be protected by being carefully informed what it is that during the period of protection they are not to use. In a well-drawn specification the nature of the invention should be set out in the body of the specification, as well as in the "claims" hereinafter referred to, and, if possible, prior to the description of the manner of carrying the invention into effect. This arrangement is not absolutely necessary, since the nature of the invention must in any event be set out in the claims, but it is certainly advisable, for in the course of describing the operation of the invention it will very probably be necessary to include a description of something which is well known, and which it is not desired to claim.

By sect. 2, sub-sect. 4, re-enacting sect. 5, sub-sect. 5, of

the Act of 1883, it is provided that "*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.*" This is, perhaps, emphasizing, in a more distinct manner than had been provided before the passing of the Act of 1883, that the inventor must make a distinct and unambiguous claim.

It was decided in the House of Lords that the enactment in sect. 5 of the Act of 1883, that a complete specification must end with a distinct statement of the invention claimed, was **directory** only, and when letters patent have been granted, they will not be invalid merely because it has not been complied with (*s*).

As has been pointed out at p. 93, the Act of Anne required a specification of the invention to be filed as a condition subsequent to the grant.

History of the claim.

In the case of *The British United Shoe Machinery Co.* v. *Fussell* (1908, 25 R. P. C. at p. 650) Fletcher Moulton, L.J., dealt with the history of distinct claims as part of specifications. After mentioning the Act of Anne, which required the patentee to state in a specification: (1) The nature of the invention, and (2) the method of performing the same, the learned Lord Justice proceeded: "The first was necessary to define the monopoly and the second was necessary to secure that the public was not defrauded by the patentee . . . These two things—the delimitation of the invention and full practical directions how to use it—are in their nature almost antagonistic. As it is the duty of the inventor to give the fullest practical information to the public, he is bound to put in, if for instance the invention is a process, quantities and times which are the best he knows. But it would be very cruel to hold him to the invention when carried out only with those best quantities and times, because a person could then take his invention in substance if he did not take it in quite the best way, and the value of the grant would be practically nothing. Hence inventors, in their own protection, took to

(*s*) *Vickers* v. *Siddell*, 1890, 7 R. P. C. at p. 303; L. R. 15 App. Cas. 496, 500, 505.

introducing into their specifications language intended to distinguish between that which was there for the practical information of the public, and that which was there for delimitation of the invention. Correct delimitation was of the greatest possible importance to the inventor, because if his patent covered something which was old the patent was wholly bad. At the same time there was the danger of confining himself to a mere outline which gave delimitation, but did not tell the public the best way within those limits of performing his invention. The one duty required him to state his invention in its most general form, and the other duty required him to state it in its best, and therefore in a very special form. Out of that has arisen the practice, which originally was perfectly optional, of having a separate part of the specification primarily designed for delimitation. That is what we call the claim."

The Court, therefore, must be taken to distinguish between **describing too much and claiming too much.** In the course of a well-drawn specification it is frequently necessary to describe something which is old, and, provided that it is made clear that the old parts do not constitute a portion of the invention, the description of the old parts in the specification will not invalidate the patent.

Purpose of the claim. Obligations.

Some degree of controversy has arisen by reason of the requirement that the patentee must state "the nature of the invention." **The word "invention" is capable of more than one meaning,** but is used here in the sense of "monopoly." Fletcher Moulton, L.J., pointed this out in *The British United Shoe Machinery Co.* v. *Fussell* (1908, 25 R. P. C. at p. 651): "In the Act of 1883, for the first time, it was made a statutable duty to insert claims to define the invention, and that has been continued up to the present time; but the language of the statute follows that of the old proviso and leaves no doubt that the duty is only to define the invention for which the monopoly is claimed. The justice and sufficiency of that requirement are obvious. Specifications are not for the purpose of providing material for subsequent historians as to the genesis of ideas; they are for the purpose of informing the public as to

what is the monopoly . . . A patentee often works solitarily. He has very little idea of what others are doing, and I think I may say that in the enormous majority of instances, if not universally, he has no complete knowledge of what has been done by others in connection with the matter on which he is working. The inventive acts by which he arrives at the invention for which he finally obtains protection may be inventive acts which have started far behind the level of public knowledge at the time, and much of his work truly inventive so far as he is concerned has been to re-invent that which others, without his knowledge, have invented. The consequence is that the inventive acts of the inventor can have no relevance or effect; it is a thing which depends on his knowledge of what others had done. Then are we to say that he is to state what would have been the inventive act, supposing him to know the whole knowledge of the world. . . . Of course, if his ignorance has led him to claim something which is not novel he has to take the penalty. He has chosen at his own risk to ask for and take a monopoly as against the public, and the consequence is, that if, with the best of faith, he has asked for too much, he must suffer for it. But to say that he must also ascertain, under the penalty of his patent being bad, everything that preceded his invention, every approach from every side that persons have made to it, and must correctly indicate the little step which he has made in addition to these, most of which he never knew, would be to require something of him, which would be perfectly idle so far as regards utility to the public, and grossly unjust so far as the patentee is concerned. . . . For these reasons I am satisfied that there is no duty to distinguish old from new in the invention actually claimed. If the invention actually claimed is novel that is sufficient."

Combination claims.

So where a patent is for a combination of old or new parts, or for an improved arrangement of old mechanism, provided it be clear that a monopoly is claimed for the new combination only, the specification need not discriminate between the new and old parts of such combination or improved apparatus unless it be desired to claim any of those subordinate parts *per se*, since it is the new combination alone that constitutes the novelty

and merit of the invention; but it is necessary for the patentee to particularly ascertain and define what his monopoly covers, or what are the exact parts of his new combination, so that any person of ordinary knowledge of the subject may be able at once, on reading the specification, to know that the invention claimed consists in the combination specified.

A great deal of confusion arose over the apparent conflict between the judgments of the House of Lords in *Foxwell* v. *Bostock* (1864, 4 De G. J. & S. 298) and *Harrison* v. *Anderston Foundry Co.* (1876, L. R. 1 App. Cas. 574) as to the alleged necessity of distinguishing new from old in a claim for a combination (*t*). In view of the judgments in the Court of Appeal in *The British United Shoe Machinery Co.* v. *Fussell*, above referred to, and the fact that specific claims are always found in modern specifications as a result of the official examination, it is extremely unlikely that this objection will ever be urged against a patent in future. The authorities are all reviewed in the judgments and carefully explained. The objection no longer has any substance. As Lord Justice Fletcher Moulton observed (p. 651): "If I were to sum up my criticism of the point I should say that a man must distinguish what is old from what is new *by* his claim; but he has not got to distinguish what is old from what is new *in* his claim. If the combination which he has claimed, and for which he asks a monopoly, is novel, that is sufficient. There is no obligation to go further and to state why it is novel, or what in it is novel."

Construction of the claims.

The claim will be construed with reference to the entire patent; and although at first sight there may be some appearance of obscurity in it, if it can be made clear by the consideration of the whole specification, the patent will not be thereby avoided (*u*).

(*t*) See, *e.g.*, *Clark* v. *Adie*, 1877, L. R. 2 App. Cas. 321; *Moore* v. *Bennett*, 1884, 1 R. P. C. 129; *British United Shoe Machinery Co.* v. *Thompson*, 1905, 22 R. P. C. 177.

(*u*) *Arnold* v. *Bradbury*, 1871, L. R. 6 Ch. 712; *Plimpton* v. *Spiller*, 1877 L. R. 6 Ch. D. at p. 427; *Edison* v. *Woodhouse*, 1827, 4 R. P. C. at p. 107; *Leadbeater* v. *Kitchin*, 1890, 7 R. P. C. at p. 244; *Elias* v. *Grovesend Tin Plate Co.*, 1890, 7 R. P. C. at p. 463; *Edison* v. *Smith*, 1894, 11 R. P. C. at p. 395; *Parkinson* v. *Simon*, 1894, 11 R. P. C. at p. 507; *Electric*

In the case of *Arnold* v. *Bradbury* (1871, L. R. 6 Ch. 712) Lord Hatherley, in the course of his judgment, says: "I do not think that the proper way of dealing with this question is to look first at the claims, and then see what the full description of the invention is; but rather first to read the description of the invention, in order that your mind may be prepared for what it is the inventor is about to claim."

Each subordinate part of an invention must be claimed specifically in order to be **independently** protected, for everything that is not claimed is considered to be disclaimed, and should a man describe ten inventions in his specification and claim only one of them, he thereby presents to the public the remaining nine (*x*).

"Substantially as described."

The claims at the end of a specification frequently end with the words "as herein described," or "substantially as herein described." The effect of these words on the ambit of the claim both for novelty and infringement depends entirely on the old question, "What is an invention?" In the cases in which the Courts have held that the inventor has discovered a new result, they have refused to limit the ambit of his claim on account of his use of these words (*y*), and the words are consequently superfluous.

On the other hand, if the merit of the invention be in the discovery of a new road to an old result, the words "as herein described" are a useful abbreviation for emphasising this fact in the claim, and for preventing the Court from possibly interpreting the claim as one for the result itself, a construction which might invalidate the patent (*z*). But beyond having

Construction Co. v. *Imperial Tramways Co.*, 1899, 16 R. P. C. at p. 638; *Tubes, Ltd.* v. *Perfecta Seamless Steel Tube Co.*, 1903, 20 R. P. C. at p. 98; *British United Shoe Machinery Co.* v. *Hugh Claughton, Ltd.*, 1906, 23 R. P. C. at p. 334.

(*x*) *Hinks* v. *Safety Lighting Co.*, 1876, L. R. 4 Ch. D. 612.

(*y*) See, *e.g.*, *United Telephone Co.* v. *Bassano*, 1886, 3 R. P. C. at p. 315; *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate*, 1895, 12 R. P. C. at p. 257; *Parkinson* v. *Simon*, 1895, 12 R. P. C. at p. 408; *Welsbach Incandescent Gas Light Co.* v. *New Incandescent Co.*, 1900, 17 R. P. C. at p. 250.

(*z*) *Easterbrook* v. *Great Western Rail. Co.*, 1885, 2 R. P. C. at p. 208; *Goddard* v. *Lyon*, 1894, 11 R. P. C. at pp. 361, 362; *Chadburn* v. *Mechan*, 1895, 12 R. P. C. at

this cautioning effect, they are mere verbiage, as the same result may be obtained by carefully construing the specification (*a*).

It is doubtful whether the word "substantially" is necessary at all (*b*), but if it be used, it probably somewhat neutralises the limiting effect of "as herein described."

The fact that one of the claims is practically a repetition of another will not vitiate a patent. In the *Wenham Gas Co.* v. *The Champion Gas Lamp Co.* (1892, 9 R. P. C. at p. 55) Lindley, L.J., said: "I think the true construction of the fourth claim is pointing out the importance of the perforated tube in claim 3—a repetition in fact of claim 3—I do not think it is anything more. If so, it does not vitiate the patent. It may be open to the criticism that it is redundant; but if it is nothing more than pointing out what is a valuable operation, and what has been claimed in clause 3, it does not thereby vitiate the patent."

But an effective meaning must if possible be given to each claim. In *Parkinson* v. *Simon* (1894, 11 R. P. C. at p. 502) Lord Esher, M.R., said: "When you find a patent with several claims in it, you must, if you can, so construe those claims as to give an effective meaning to each of them. If there are several claims which are identical with each other, then some of them have no effect at all. It follows from the ordinary rules of construction that you must construe the different claims so as to make them effective if possible, to be different from each other in some respects, or else they are not effective" (*c*).

Where one of the claims in a specification, although strictly it may be for something old, is purely subordinate to the main invention and merely amounts to a declaration of one of the merits and advantages of the contrivance disclosed in the specification, it has been held that a patent is not void on that account (*d*).

p. 134; *Brooks* v. *Lamplugh*, 1898, 15 R. P. C. at pp. 48, 49.

(*a*) *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1884, 1 R. P. C. at p. 240.

(*b*) *Young* v. *Rosenthal*, 1884, 1 R. P. C. at p. 33; *Westinghouse* v. *Lancashire and Yorkshire Rail Co.*, supra.

(*c*) *Clark* v. *Adie*, 1877, L. R. 2 App. Cas. at p. 321; *Cropper* v. *Smith*, 1884, 1 R. P. C. at p. 87.

(*d*) *E.g.*, *True and The Variable Electric Lamp Syndicate* v. *Bryant Trading Syndicate*, 1908, 25 R. P. C. 461.

CHAPTER VII.

PROCEDURE ON APPLICATION FOR LETTERS PATENT.

In the present chapter it is proposed to deal with the law and practice relating to the application for a grant, and the acceptance of specifications by the Comptroller.

The forms of application.

By sect. 1, sub-sect. 2, of the Act of 1907: "*The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner.*" The practice is regulated by the Patents Rules, 1908, which came into operation on December 31, 1907. In an Appendix will be found a copy of the "Instructions to Applicants for Patents," issued by the Patent Office and based on the Rules, which is a very complete practical guide.

Applications for patents for inventions made in Great Britain and Ireland and the Isle of Man must be made on Form 1; for inventions communicated from abroad on Form 1A; and applications for patent under international and colonial arrangements must be on Form 1B; an application for a patent of addition is made on Form 1C; and for a secret patent on Form 1D (*a*). In the case of an invention which is partly original and partly communicated from abroad, it would seem that the best course would be to apply on Form 1. But the patent will not be rendered invalid if the wrong course is taken, since in any case the applicant is the true and first inventor in law (*b*), and the Comptroller can have no means of knowing how the invention originated. But in the case of an application by a corporation, it has been decided that Form 1 is not applicable (*c*), apparently for the reason that a corporation cannot perform the mental function of inventing. This decision is, of course, binding on the Patent Office, but as "inventing" in the mental sense is not a requisite of a valid

(*a*) See Appendix.

(*b*) See p. 17, ante.

(*c*) *Société Anonyme du Générateur du Temple*, 1896, 13 R. P. C. 54.

patent (see Chap. III., p. 50) it is submitted that the decision is erroneous in law. The applicant must himself sign the application, and certain other specified formal documents, but for many matters he may employ an agent. (See as to this,

Patent agents.

rule 9 and the Patent Agents Rules of 1908.) Such agent need not be a "patent agent," but he must be an agent duly authorised to the satisfaction of the Comptroller (*d*).

Recently the Comptroller has refused to be satisfied with the authorisation of irresponsible foreigners, who, although resident in this country, are the nominees of foreign patent agents.

In the case of an application by two or more persons, the application must be signed by all those persons, but it is not absolutely essential that the complete specification should be signed by more than one of them (*e*).

Deceased inventor.

If a person possessed of an invention dies without having made an application for a patent, application may be made by, and a patent for the invention granted to, his legal representative, and such an application must contain a declaration by the legal representative that he believes the deceased to have been the true and first inventor (*f*).

Posting documents.

A document sent to the Patent Office by post is deemed to have been left at the time when the letter containing the same would be delivered in the ordinary course of post, and it is sufficient to prove that the letter was properly addressed and posted (*g*).

The declaration.

Sect. 1, sub-sect. 3, enacts: "*The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.*

(4) "*The declaration may be either a statutory declaration or not, as may be prescribed.*"

(*d*) See *Graham* v. *Fanta*, 1892, 9 R. P. C. 164; for forms of authorisation, see Appendix.

(*e*) *Grenfell and McEvoy's Patent*, 1890, 7 R. P. C. 151.

(*f*) Sect. 43.

(*g*) Sect. 81 and sect. 26 of the Interpretation Act, 1889.

The prescribed form of declaration is incorporated in the form of application in each case, and is not a statutory declaration. **Where the inventor is incapable,** by reason of infancy, lunacy, or other inability, of making any declaration or doing anything required or permitted by the Act, such declarations may be made and such things may be done on his behalf by the guardian or committee of such incapable person, or by any person appointed by the Court (*h*).

When inventor incapable.

Statutory declarations made in conformity with this Act are **exempt from the stamp duty** of two shillings and sixpence charged on a statutory declaration made under the Statutory Declarations Act, 1835, by the Revenue Act, 1884 (*i*).

By sect. 3, sub-sect. 1, "*The Comptroller-General of Patents, Designs and Trade Marks (hereinafter referred to as the Comptroller) shall refer every application to an examiner.*"

Reference to examiner.

The duty of the examiner is to ascertain that the application and specification have been prepared in accordance with the rules.

The following points upon the **preparation of the specification** require special notice:—

One invention only must be described.

One invention only to be described.

Rule 13 commences thus: "(1) When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus or process."

In *Jones' Patent*, Herschell, S.-G., said (Griff. P. C. 265): "I should always allow alternative devices for producing a particular object as one invention. But if you say I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct, then there are six inventions. . . . You may get in one patent the combination, and you may get all subordinate parts of that combination, so far as you claim to use them for one main purpose, but if you are going to claim a subordinate part, or one of the elements of the combination for a purpose independent

(*h*) Sect. 83

(*i*) 47 & 48 Vict. c. 62, s. 9.

of the purpose of the combination, then you have got an extra invention, and it is not all one."

The rule continues thus: "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 Act, and by these rules.

"Where the Comptroller has required or allowed any application, specifications 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" (*k*).

By sect. 16 of the Act of 1907 the following new provision has been introduced into the practice of the Office:—

Provision for cognate inventions.

"*Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.*

(2) "*Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and for*

(*k*) Paragraph 2 of rule 13 will be dealt with on p. 137.

Speech not confined to one question

5 J. 3 appr. XLII A. P.C. 1.

the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the Court or the Comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein."

It must not be forgotten that, if the applicant avails himself of this arrangement, he runs the risk of the **whole patent being declared invalid** on account of the **want of novelty in a part** of the complete specification which is founded on one only of the provisional specifications. Paragraph 2 of rule 13, dealing with this practice, is as follows: "Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other, and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connection with his application into such number of complete specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions."

The rule that a patent may only be granted for one invention is merely one of practice, and if a patent be actually granted it cannot afterwards be impugned on the ground that it was granted for more than one invention (sect. 14, sub-sect. 2).

Conformity of claims and specification.

In *Re Smith's Patent* (Griff. P. C. 268) Herschell, S.-G., said: "There is **no power** in the Patent Office **to examine into the conformity of the claims** put forward by the patentee **with the description of the invention** which he has given. I should only guard myself by saying this: that if the statement of the invention claimed were such as 'I claim the invention described in the specification,' that would be regarded as a mere colourable compliance with the terms of the statute, and not as a distinct statement of the invention claimed, because it would merely refer back to the previous description." But the facts of that case are not reported, and it is highly probable that since the Act of 1905 the power of the Comptroller has been much wider than as defined by this judgment. The Comptroller has the power to require the claims to be modified in accordance

with the results of the inquiry into novelty, and the invention must be sufficiently clearly described to show what the claims actually mean. It would be strange if the claims need not conform to the description.

Points of form frequently neglected.

The following points are worthy of attention, as a considerable waste of time and trouble are caused by the constant neglect of them by applicants:—

(1) The specification must be dated and signed (by the applicant or his authorised agent).

(2) In the case of an application on Form 1B under sect. 91 of the Act of 1907, a copy of the foreign specification, a translation and drawings, all duly certified by the official head of the foreign patent office, must be enclosed.

(3) Drawings must be furnished in duplicate, marked respectively "original" and "true copy," but the lettering of the duplicate drawings must be in black lead pencil, and not in ink.

This is somewhat irritating, but the reason for it is cogent. The drawings have to be reduced in size for abridgment in the *Journal*, and were all the lettering to be proportionately reduced great indistinctness would result. Where the lettering is in pencil it may be erased and only replaced so far as may be required when the drawing is reduced.

The duplicate may be on tracing cloth.

It may further be noticed that the office are prepared to supply the required duplicate drawings at a small cost.

If a provisional specification is filed it must clearly indicate the nature of the invention. The description must be quite clear, although the detail is not required.

Claims must be succinct.

The claims must be succinct as well as separate and distinct from the body of the specification. It must be remembered that the object of the claim is to give a perfectly clear statement of the invention claimed. Of late years a superstition has arisen that a patent is more valid and has a greater hold over infringements if every possible permutation and

combination of the elements entering into the invention is separately claimed, and it has become a practice to file claims which are copies of those used in American specifications. American claims may be very useful in dealing with American law, but in English law such prolixity does not help a Court which, whether in considering novelty or infringement, invariably seeks to obtain an answer to the broad question, "What has this man invented?"

The matter came before both law officers of the Crown on the interpretation of rule 4 of the Patents Rules, 1905 (rule 14, 1908), in the case of *Bancroft's Application* (1906, 23 R. P. C. 3). The Attorney-General pointed out that certain kinds of inventions might be such as to justify a large number of claims. "So long as the statement of each claim is in itself clear and succinct, and so long as there is an absence of repetition in the separate claims, we do not think that there is necessarily any infringement of this rule. . . . But in the present case we think that the decision of the Chief Examiner was right. . . . An attempt is made to deal with every possible contingency. . . . I must say that I deprecate very much the multiplication of claims by the system, which seems to have prevailed in America, of attempting to deal with every possible contingency. I do not think it results in clearness. I think that the system of claims with which we are more familiar in this country is really clearer in the result, and that those who have American patents and who desire protection in this country, in bringing forward their claims, must endeavour to conform to the practice which has prevailed in this country."

The title of the invention must sufficiently indicate the subject-matter of the invention (see Chap. VI., p. 95).

The complete specification and the provisional must describe substantially the same invention, and the titles must correspond.

Power of Comptroller to refuse at this stage.

By sect. 3, sub-sects. 2, 3 and 4: (2) "*If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may*

refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with."

Examiner's report not binding on Comptroller.

The report of the examiner is not to bind the judgment of the Comptroller, but merely to assist him in making his decision as to whether the application and specifications fulfil the requirements of the Act (*l*). It is difficult to define exactly what is the meaning of the words "whether the nature of the invention has been fairly described," and there is no direct decision on the point, but it is to be presumed that the duty of the Comptroller and examiner does not extend to a minute criticism of specifications. It is clear, however, that the invention must be sufficiently described to enable the inquiry as to novelty to proceed. As a matter of practice, the examiners always require ambiguous descriptions to be made clear, and this is distinctly advantageous to applicants.

(3) "*Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.*

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

The procedure on appeals to the law officer will be dealt in Chap. VIII. on "Opposition."

The Examination of the Complete Specification.

Examination of complete specification.

(A) By sect. 6, sub-sects. 1, 2 and 3: (1) "*Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner.*

(2) "*If the examiner reports that the complete specification has not been prepared in the prescribed manner, the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.*

(*l*) *C.'s Application*, 1890, 7 R. P. C. 250.

Examiner's report amended disclosed } See 68 Rep. Pat. Cas. 5 XLII R.P.C. 5

As to disconformity.

(3) "*If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the Comptroller may*—

(a) *refuse to accept the complete specification until it has been amended to his satisfaction; or*

(b) (*with the consent of the applicant*) *cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date:*

"*Provided that where the complete specification includes an invention not included in the provisional specification, the Comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left.*"

The courses which may be pursued under clause (b) and the proviso are entirely new. If the original application covers the main principle of the invention, and the subsequent additional matter is in the nature of improvement, it is better to take advantage of the proviso, and so secure the earlier date for the main invention, than to use the procedure created by clause (b).

Examination as to novelty.

(B) The complete specification is next examined with reference to the **novelty** of the invention so far as British specifications published within fifty years from the date of application are concerned. This is provided for by sect. 7 (see Appendix). If anticipations are found the Comptroller may require the specification to be amended to his satisfaction, "*and* (by sub-sect. 4) *unless the objection is removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and if so what, prior specifications ought to be made in the specification by way of notice to the public.*

Power to refuse patent.

"*Provided that the Comptroller, if satisfied that the*

invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent."

This power to refuse a grant is wholly new.

An appeal to the law officer from any decision by the Comptroller under this section is given by sub-sect. 5.

The specific reference.

Rule 32 is as follows: "When under sub-sect. 4 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:—'*Reference has been directed in pursuance of sect.* 7, *sub-sect.* 4, *of the Patents and Designs Act*, 1907, *to specification No. of* . Where the reference is inserted as the result of a provisional report (*m*) under rule 29, a statement to that effect shall be added to the reference." It will be noticed that the prescribed form of reference is very clear and explicit, and is intended to warn the public that the invention has been actually claimed in a prior specification.

Two kinds of specific reference.

There are **two distinct kinds of specific reference** in use; the **first** is in this form, "*My invention relates to fire-bars of the class described in the specification of Letters Patent No. of* ." The purpose of this is to **limit the ambit of the claim** and to define more clearly the invention. It may very properly be inserted where the object of the invention is to improve upon a known invention. The insertion of a reference of this kind may be quite sufficient to warn the public and also to safeguard prior patentees (see Chap. VIII.) where the claims are clearly and honestly drafted so as to limit the invention strictly to the improvements which are to be applied to an invention which has been claimed in a prior specification.

The *second* kind is the specific reference prescribed by the rule. The effect of this is to **warn the public that the patent is invalid** and that the invention claimed has been claimed in a prior specification.

(*m*) See p. 149.

The second kind of reference was introduced by the Patents Rules, 1905, in pursuance of the Act of 1902. Under that Act the Comptroller had no power to refuse a patent even if the claims were specifically anticipated by prior specifications. But now that the Comptroller has power to refuse a grant altogether, it seems that the prescribed form of reference is hardly necessary unless it be considered that the patent may only be refused in the case of **every** claim being anticipated by a claim in a prior specification.

An intermediate type.

There is an **intermediate type of reference** which is sometimes inserted. It amounts in effect to a disclaimer, and runs as follows: "*I am aware of the specification of Letters Patent No. of granted to J. S., and I do not lay claim to anything therein claimed or described.*" This is usually inserted as the result of compromise, and it may be useful where the invention appears to have been **described though not claimed** in a prior specification. The reason for its existence is that the Office naturally hesitates in a doubtful case to decide that there is no novelty in a claim, but prefers to leave the matter for the Courts.

These three kinds of references were analysed and explained in *P.'s Application* (1906, 23 R. P. C. 644). The decision was given before the Act of 1907, and there is little doubt that under that Act the application would have been refused. The applicant offered to insert a reference of the first kind or of the intermediate kind, but the Chief Examiner, whose decision was supported by the law officer, insisted upon a reference in accordance with rule 32.

The law officer (Sir W. Robson, S.-G.) said (p. 646): "The phrase 'notice to the public,' of course, does not necessarily mean 'Warning to the public'; and I am bound to say that it seems to me that it ought to mean 'Warning to the public,' in a somewhat peculiar case like the present, where the public cannot very easily, however expert they may be, altogether grasp the full significance of the reference as it is made by the applicant here. It is certainly not made in a way which adequately puts the reader on his guard. So far as the Comptroller is concerned, his reference, although it is not, in

form, a warning, any more than the applicant's is, is undoubtedly made in a way which excites attention and arouses apprehension. I think that is by no means inconsistent with the intention of the legislature . . ."

The additional search under sect. 8.

Before the Act of 1907 the search on novelty only extended to complete specifications filed pursuant to prior applications and published before the date of the application. By sect. 8 it is extended further to specifications filed in pursuance of prior applications and published after the application under investigation. Now specifications until accepted and thrown open to public inspection are secret documents, and the Patent Office may not disclose their contents, so that such specifications as are filed in pursuance of prior applications may only be shown to the applicant as they are accepted. The officials, however, who are acquainted with the prior applications already, will know where to find the specification when filed, and after its acceptance they may bring it to the attention of the applicant. Sect. 8 is as follows: (1) "*An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior applications; and that section shall, subject to rules under this Act, have effect accordingly.*

(2) "*Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the Comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.*

(3) "*For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.*

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

The date fixed is January 1st, 1909.

The practice is regulated by rule 33.

Immoral inventions.

Under the provisions of sect. 75 the Comptroller may refuse to grant a patent for an invention, of which the use would, in his opinion, be **contrary to law or morality.**

He may also refuse a patent where the invention is not a "new manufacture" within the Statute of Monopolies (*n*). As a matter of fact, applications are frequently made to patent most ingenious notions and systems which are not "new manufactures."

Before exercising any discretionary power **adversely** to the applicant, the Comptroller must give him ten days' notice, so that he may be heard personally or by his agent on the point in question (*o*).

Dispute between co-applicants.

When **two persons who are joint applicants quarrel,** and each lodges a complete specification, the one specification differing from the other, the Comptroller has no jurisdiction to say which specification is to be filed (*p*).

An applicant who threatens to withdraw or otherwise attempts to wreck an application may be restrained by interim injunction (*q*) on motion by his co-applicant.

The subject of **appeal** to the law officer from decisions of the Comptroller will be dealt with in the chapter relating to Opposition to a grant of letters patent.

Time for leaving complete specification.

Sect. 5 fixes the **time** within which a complete specification must be filed after filing a provisional specification.

(1) "*If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months from the date of the application.*

"*Provided that where an application is made for an extension*

(*n*) *Bridge's Application*, 1901, 18 R. P. C. 257; *Cooper's Application*, 1901, 19 R. P. C. 53; *Johnson's Application*, 1901, 19 R. P. C. 56.

(*o*) Sect. 73 of the Act of 1907; see also P. R. 1908, r. 31.

(*p*) *Apostolloff and Frendenberg's Application*, 1896, 13 R. P. C. 275.

(*q*) *The Wool Syndicate* v. *Riches*, 1902, 19 R. P. C. 127; see also *Punchard* v. *Dade*, 1894, 11 R. P. C. 257.

of the time for leaving a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.

(2) "*Unless a complete specification is so left the application shall be deemed to be abandoned.*"

Formerly the power to allow an **extension of time** was in the discretion of the Comptroller; now the applicant may obtain an extension as a **matter of right.**

Time for acceptance.

By sect. 6, sub-sect. 5, the **time** within which a complete specification must be **accepted** is fixed.

"*Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void.*

"*Provided that where an application is made for an extension of time for the acceptance of a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months.*"

The **six months** allowed by this section for the filing of the complete specification are calendar months (*r*), and are reckoned exclusive of the day of application (*s*), and in the event of the last day of such six months falling on a Saturday or on a day when the Office is not open, the specification may be filed on the day succeeding such excluded day or days (*t*).

Acceptance to be advertised.

Sect. 6 enacts: "*On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection.*"

The advertisements are published in the *Illustrated Official Journal.*

In the event of an application being abandoned, the specifications and drawings which were left in connection with the application are not published, nor are they at any time open to public inspection (*u*), except in the case of an abandoned application under sect. 91 (*x*).

(*r*) 13 & 14 Vict. c. 21, s. 4.

(*s*) *Russell* v. *Ledsam*, 1847, 14 M. & W. 574, 582; *Williams* v. *Nash*, 1859, 28 Beav. 93; 1859, 5 Jur. N. S. 696.

(*t*) Sect. 82 of the Act of 1907; see also rule 111.

(*u*) Sect. 69.

(*x*) Sect. 91, sub-sect. 3 (a).

Patents of addition.

A new kind of monopoly right was introduced by the Act of 1907. By sect. 19, sub-sect. 1: "*Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.*

(2) "*Where an application containing such a request is made, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.*

(3) "*A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal.*

(4) "*The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.*"

For remarks on the subject-matter of a valid Patent of Addition, see Chap. III., p. 64.

Secret patents.

Sect. 30 provides for the assignment by an inventor of all the benefit of an invention to the Secretary of State for War or to the Admiralty. And in such a case the Secretary of State or the Admiralty may certify that the application for a patent and the specifications be **kept secret.** A secret patent cannot be revoked. The procedure is regulated by rules 97—99.

Samples and specimens.

By sect. 2, sub-sect. 5, the Comptroller is empowered to call for **samples and specimens of a chemical invention.** The purpose of this enactment is to prevent patents being obtained for the mere purpose of stopping further investigation. It was said that certain persons merely watched for reports of investigations in chemical industry and hastened to forestall the inventors by filing specifications which purported to describe and claim the practical results of such investigations, but which contained no really useful description. The new enactment

is intended to obtain some indication of the bona fides of the applicant. It is not clear how the specimens and samples are to be dealt with. The officials can hardly be expected to analyse the specimens to see if they are genuine. It is possible, however, that the Court could order the specimens to be produced and analysed if in a subsequent action the validity of the patent were put in issue on the plea of non-utility or insufficiency.

The sub-section is as follows: "*Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the Comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification.*"

Provisional protection.

The practice is governed by rule 36.

By sect. 4: "*Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.*"

Provisional protection exists for the purpose of enabling an inventor to work at and improve his invention without thereby avoiding the patent subsequently granted to him on the ground of want of novelty (*y*); it does not afford him the perfect rights which he obtains when his patent is sealed, since he cannot bring an action in respect of any infringement committed before the publication of his complete specification (*z*), and further, he may not style the invention which is provisionally protected as "patent," but he may make use of such words as "patent applied for" (*a*).

Use of word "patent."

Rights given by acceptance of complete specification.

Sect. 10 enacts:—

"*After the acceptance of a complete specification, and until the date of sealing a patent in respect thereof, or the expiration of*

(*y*) Per Earl Cairns, L.C., in *In re Dering's Patent*, 1879, L. R. 13 Ch. D. at p. 395; and see Chap. VI., p. 95.

(*z*) Sect. 13 of the Act of 1907.

(*a*) Sect. 89; see *R.* v. *Wallis*, 1886, 3 R. P. C. 1; *R.* v. *Crampton*, 1886, 3 R. P. C. 367.

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."

It is no offence, therefore, to describe an article as "patented" after the complete specification has been accepted but before the patent is sealed (*b*).

The mere fact that the article has at one time been the subject of a patent now expired will not entitle the patentee to mark it as "patented," as the word implies that there is an existing patent (*c*).

The effect of sects. 4 and 10 is that no proceedings for **infringement** may be taken before the patent is sealed, after which time proceedings can only be taken with reference to infringements committed after the acceptance and publication of the complete specification.

The effect of the provisions of the Patents, &c. Acts to prevent **fraudulent applications**, and also of those for the protection of **foreign inventors**, has already been discussed in an earlier chapter.

OFFICE PRACTICE.

The practice on an application.

As a result of these enactments the following system of office practice has sprung up:—The actual operation of searching is performed by the assistant examiners, and the result handed over to one of the examiners. The applicant or his agent then receives a letter in which the deficiencies of his specification are indicated. In the case of a complete specification he receives a further intimation of the result of the search on the novelty of the invention and a list of specifications which the examiner may consider to be wholly or in part anticipations. If the examiner considers that a complete anticipation has been found, the fact is communicated to the applicant and the search is temporarily stayed.

(*b*) *R.* v. *Townsend*, 1896, 13 R. P. C. 265.

(*c*) See *Cheavin* v. *Walker*, 1877, L. R. 5 Ch. D. 862.

The applicant has now a choice of courses:—He may consider that the specifications cited reduce the scope of his invention. In this case he will do wisely to amend the description of the nature of his invention and modify his claims. He has two months in which to do this, and on re-submitting the specification the examiner may make further objections. The question of time is very important. The two months in which the inventor may endeavour to satisfy the Office run from the date of the first official letter in which an objection is raised to the specification, and is not extended by fresh objections. A considerable amount of annoyance has been felt by agents who are accustomed to the practice of the United States, where the time may be extended indefinitely by correspondence; and it is well to be fully prepared on this point. In suitable cases, however, the Comptroller may extend the time. The reason for the limitation is to be found in sect. 9, sub-sect. 4, of the Act of 1883, which enacts that the application is to be deemed to be abandoned if the specification be not accepted within twelve months.

It is possible that the applicant may feel that the matter is of a nature too difficult to be conveniently dealt with by correspondence. He has now a further choice—he may refuse to amend the specification according to the suggestions of the examiner and may formally apply for a hearing before the Comptroller. The better course, however, is to apply for an interview with the examiner who has the case in hand. A time will be appointed, and in view of the amount of work with which the examiners have to deal it is advisable to be punctual. The interview is of an informal and conversational character, and the applicant presents his view of the case. This usually results in an agreement in which the applicant is content to amend his specification and claims and re-submit them. If, however, the matter should arrive at a deadlock, and the applicant is of opinion that the examiner is wrong, he had better apply for a formal hearing before the Comptroller.

At this hearing, which takes place privately before the Comptroller or the Chief Examiner, the examiner and the applicant are present. The applicant should open his case

quite briefly, and describe the nature of what he considers to be his invention, and leave the objections to the examiner. The applicant replies to the objections of the examiner, a discussion usually then takes place to endeavour to arrive at a conclusion, and finally the Comptroller gives his decision.

If the applicant should decide on obtaining this hearing he should make sure that all the objections put forward by the examiner and still remaining undecided receive the attention of the Comptroller. It is very irritating after a decision, apparently, that the specification is to be accepted subject to certain specified conditions, to find that the examiner still has some objections that may necessitate another hearing. This is certainly an infrequent occurrence, but the annoyance and the extra expense for skilled advice may be considerable. It may sometimes, however, happen that a further search and objections may be unavoidable. An applicant may claim as his invention the combination of A, B, C, and D, and it may turn out, as a result of the search, that these elements of his invention have been so combined before. In his specification, however, he may have described an improvement in the element D, and the Comptroller may decide to allow him so to amend the specification and claims as to claim this only. A search to investigate the novelty of this new claim will obviously have to be on different lines to that which took place on the earlier form of the specification.

RESTORATION.

Restoration of lapsed patents.

By sect. 20 of the Act of 1907 a remedy is provided for the relief of inventors whose patents have lapsed from non-payment of fees where such non-payment has been due to circumstances concerning which no blame is attributable to the patentee. Formerly, if the agent of the patentee fraudulently misappropriated the moneys entrusted to him for payment of renewal fees, or if the renewal fees were left unpaid through accident or inadvertence, the unfortunate patentee had no remedy but to apply for a private Act of Parliament.

The section is as follows :—

(1) "*Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller in the prescribed manner for an order for the restoration of the patent.*

(2) "*Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.*

(3) "*If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the Comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.*

(4) "*Where such notice is given the Comptroller shall notify the applicant thereof.*

(5) "*After the expiration of the prescribed period the Comptroller shall hear the case and, subject to an appeal to the Court, issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.*"

A patentee will be obliged to show a clear case of hardship, and mere inadvertence will not be sufficient to justify restoration.

The following statement of fact is taken from the preamble to Vauclain's Patent Act, 1906 (Loc. & Pers. 6 Edw. VII. c. v.), and sets forth the circumstances which Parliament considered to justify restoration :—

"The application for the patent having been filed on June 3 1901 received the number 11,342 of 1901 although the patent itself is actually dated as of November 2 1900 under the provisions of the international convention Owing to the patent agent's tax clerk being misled by the year endorsed on the outside of the letters patent as the year of the patent he entered it in the tax book as of the year 1901 and entered the

fourth year's tax as being due on November 2 1905 instead of November 2 1904 Consequently the first advice the Patentee received as to any fees being due was dated September 25 1905 When about to pay the tax the tax clerk for the first time noticed a divergence between the number and the supposed date of the patent and discovered that the fee should have been paid in 1904 Notwithstanding this accident mistake or inadvertence the amount of the tax was tendered in the prescribed form to the patent authorities before the date on which it was believed to have been due but was refused"

Advertisements.

The requirement for **advertisement** of the application is for the purpose of enabling persons whose interests may be injured by the restoration to enter an opposition, when terms may be imposed for their protection.

Conditions.

The nature of the conditions which will be imposed may be inferred from those contained in sect. 2 of Vauclain's Act (supra), which is as follows:—

"No action or other proceeding shall be commenced or prosecuted nor any damage recovered—

(1) "In respect of any infringement of the said letters patent which shall have taken place after the fifteenth day of February one thousand nine hundred and five (being the day on which the letters patent were announced as void in the official journal of the Patent Office) and before the passing of this Act:

(2) "In respect of the use or employment at any time hereafter of any mechanism machine machinery process or any operation actually made or carried on within the United Kingdom and the Isle of Man or of the use or sale of any article manufactured or made in infringement of the said letters patent after the said fifteenth day of February one thousand nine hundred and five and before the passing of this Act Provided that such use sale or employment is by the person or corporation by or for whom such machine or machinery or article was bonâ fide manufactured or made or such mechanism machine machinery process or operation was bonâ fide made or carried on his or their executors

administrators successors or vendees or his or their assigns respectively:

(3) "In respect of the use or employment or sale at any time hereafter by the person or corporation entitled for the time being under the preceding sub-section to use or employ any machine machinery mechanism process or operation or any improved extended or developed machine machinery mechanism process or operation or of the use or sale of any article thereby manufactured or made in infringement of the said letters patent Provided that the use or employment of such improved extended or developed machine machinery mechanism process or operation shall be limited to the buildings works or premises of the person or corporation by or for whom such machine machinery or mechanism was manufactured or such process or operation was made or carried on within the meaning of the preceding sub-section his or their executors administrators successors or assigns.

"If any person shall within one year after the passing of this Act make an application to the Board of Trade for compensation in respect of money time or labour expended by the applicant upon the subject-matter of the said letters patent on a bonâ fide belief that such letters patent had become and continued to be void it shall be lawful for the said Board after hearing the parties concerned or their agents to assess the amount of such compensation if in their opinion the application ought to be granted and to specify the party by whom and the day on which such compensation shall be paid and if default shall be made in payment of the sum awarded then the said letters patent shall by virtue of this Act become void but the sum awarded shall not in that case be recoverable as a debt or damages."

Practice. The practice is regulated by rules 55—59 of the Patents Rules, 1908, and on appeal to the judge (whose decision is final under sect. 92, sub-sect. 2) by rules 4, 5, and 6 of Order LIII.A, and needs no particular comment.

CHAPTER VIII.

OPPOSITION TO THE GRANT.

It is provided by sect. 9 of the Act of 1907 (sect. 10 of the Act of 1883) that the acceptance of the complete specification shall be advertised, and that the application and specifications shall be open to public inspection. Sect. 11 is as follows:—

(1) "*Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds:—*

(a) "*that the applicant obtained the invention from him, or from a person of whom he is the legal representative; or*" — **First ground.**

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

(c) "*that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or*" — **Third ground.**

(d) "*that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,*" — **Fourth ground.**

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 opponent, if desirous of being heard, decide on the case.*

(3) "*The decision of the Comptroller shall be subject to appeal*

to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine."

The Opponent.

The Opponent.—The wording of sub-sect. 3 limits the interpretation which might otherwise be placed upon the words "*any person.*"

Locus standi on first and fourth grounds.

In order to oppose on the first or fourth grounds it is clear that the opponent must be a person who is interested in the invention. But at one time there was considerable doubt as to whether anyone could oppose on the ground that the invention had been previously patented, **whether he were interested or not in such prior patent.** In a very important case under the Act of 1883 (*The Queen* v. *The Comptroller-General of Patents*, 1899, 16 R. P. C. 233), an opposition had been entered to the grant of a patent on the second ground, but the opponent had no interest in the prior patent. The Comptroller applied to the law officer for directions under sect. 95 of the Act of 1883. Sir R. Webster, A.-G., construed the section to mean that the opponent must have an interest in such prior patent. The would-be opponent applied for a mandamus directed to the Comptroller. The Court of Appeal decided that no Court had any power to review a decision of the law officer under the Act, but agreed with his construction, which applies also to oppositions to applications to amend under sect. 21 (see p. 181). But, as a general rule, if there has been a bona fide attempt to carry out the invention sought to be protected by the person who desires to be heard in opposition, and proof that he may be *damnified* or *affected by* the application which he desires to oppose, he is entitled to be heard (*a*). Each case will depend on its merits.

Locus standi on second ground.

In *Heath and Frost's Patent* (1886, Griff. P. C. at p. 290),

(*a*) *Meyer's Application*, 1899, 16 R. P. C. 526. See, however, *MacEvoy's Patent*, 1888, 5 R. P. C. 285 (probably considered overruled).

Sir E. Clarke said: "It appears to me that by sect. 11 it is quite clear that the only class of persons who are entitled to be heard in opposition before the law officer, are persons who are interested with a real and legitimate interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it." In that case the opponent was an agent for the patentee, and although it had been common in opposition cases, for the sake of simplicity, for patent agents acting on behalf of clients to oppose grants of patents in their own names, the law officer decided that the opponent had not such an interest as to be entitled to be heard, and furthermore refused to grant leave to amend the notice of opposition.

An opponent who has a locus standi on the first or fourth grounds may, therefore, be unable to oppose on the second ground (*b*).

But having established his right to be heard on the second ground, the opponent is entitled to rely on prior specifications other than that of the patent in which he has an interest (*c*).

Locus standi on the third ground.

The third ground of opposition was introduced by the Act of 1907 for the purpose of placing an obstacle in the way of persons who sought to anticipate future investigations, and was expressly designed for the benefit of chemical manufacturers. No decisions have yet been published upon the question of who is entitled to oppose on this ground. But if the purpose of the enactment is considered it is clear that any bona fide rival trader would have a locus standi.

Result of collusive opposition.

Public nature of Comptroller's functions.

In a case where an opposition had been entered, and it was shown that the opposition was collusive and had been entered for the purpose of obtaining an extension of time for sealing, the law officer refused to allow a patent to be sealed (*d*). In *Kempton and Mollan's Application* (1905, 22 R. P. C. 573) the opposition was successful before the Comptroller, and a patent was refused. The applicant appealed, and prior to the hearing

(*b*) *Stewart's Application*, 1896, 13 R. P. C. 627.

(*c*) *J. and J.'s Application*, 1902, 19 R. P. C. 555.

(*d*) *A. B.'s Application*, 1902, 19 R. P. C. 403, 556.

before the law officer, came to an arrangement with the opponent to the effect that the opposition should be withdrawn. Sir E. Carson decided that the appeal could not be allowed by consent, since the Comptroller in refusing the seal was acting in a public capacity, and that the case must be decided on its merits alone, and he refused to allow the patent to be sealed.

The grounds of opposition before 1883.

The Grounds of Opposition.—Prior to the passing of the Act of 1883 any ground was available for the purpose of opposition which would have been available for the purpose of destroying the validity of the patent. Prior user was a frequent ground of opposition (*In re Samuda*, Hindmarch, p. 534), so also was an alleged dedication to the public by the inventor himself (*In re Adamson's Patent*, 1856, 6 De G. M. & G. 420; 25 L. J. Ch. 456; 4 W. R. 473); but it was always considered necessary that the ground of the opposition should be proved beyond the shadow of a doubt (*In re Tolhausen's Patent*, 14 W. R. 551, and also *In re Vincent's Patent*, 1867, L. R. 2 Ch. 341). If there was any doubt it was considered that the patent ought to be sealed, so as to give the inventor the benefit of an exhaustive trial.

Under the Act of 1883.

The Act of 1883, however, reduced the grounds of opposition to three in number, corresponding to the first, the second (with a slight difference hereinafter to be mentioned), and the fourth grounds provided by the Act of 1907.

Under the Act of 1907.

By the Act of 1907 the present third ground was introduced, and a modification of the second ground was effected.

The grounds of opposition will now be considered *seriatim*.

The first ground.

The first ground of opposition as defined by the Act is **that the applicant has obtained the invention from the opposing party, or from one of whom he is the legal representative.** This question involves the credibility of witnesses. Before the Act of 1907 the Comptroller had no power to examine witnesses, although he might request the voluntary attendance for explanation of anyone who had made a declaration; and if a conflict was shown in the declarations, the usual practice was that the Comptroller formally decided that the patent should be sealed, and the opponent appealed to the law officer, who was able to take evidence on oath. By sect. 77 the Comptroller is now

empowered to take evidence upon oath, in addition to receiving statutory declarations in any case in which he thinks it right to do so. The practice will be further dealt with at p. 167.

Patent stopped in clear cases only.

But the law officer would not and will not decide a case of this kind against the applicant unless there is very little doubt on the facts, since the opponent always has an opportunity of having the question tried in open court on a petition to revoke the patent under sect. 25, sub-sect. 3.

In *Edmund's Patent* (1886, Griff. P. C. 283), Sir R. Webster, A.-G., said: "I am clearly of opinion that, under the circumstances, the Comptroller-General was right in declining to stop the patent in the present case. Had he done so, or if I were now to do so, there would be no means of reviewing our decision, whereas, if the patent is sealed, the question can be raised either in the proceedings to which I have already referred, or it may be in proceedings for revocation, should the parties be advised to institute any such proceedings."

In *Stuart's Application* (1892, 9 R. P. C. 452), Sir E. Clarke, S.-G., said: "I think that the law officer is only entitled to stop the issue of a patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept it and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence."

In the case of an opposition upon the **first ground**, it frequently happens that the law officer is of opinion that both the applicant and the opponent contributed materially to the invention. In such case terms will be imposed giving both parties an interest in the patent (*e*).

The words "**obtained the invention**" do not necessarily imply that the person from whom the invention had been obtained

(*e*) *Russell's Patent*, 1857, 2 De G. M. & J. 130; Good. P. C. 589; *Luke's Patent*, 1886, Griff. P. C. 294; *Hatfield's Patent*, 1884, Griff. P. C. 288; *Eadie's Patent*, 1885, Griff. P. C. 279; *Evans and Otway's Patent*, 1884, Griff. P. C. 279; *Garthwaite's Patent*, 1886, Griff. P. C. 284.

had taken out or even intended to take out a patent for it; it refers to the identity of the invention, not the right of the person from whom it was obtained to be regarded as the first and true inventor (*f*).

Where it appeared that a part of the subject of the application had been obtained from the opponent, the law officer struck out that portion and allowed the remainder to go on (*g*).

Legal representative.

In *Edmunds' Patent* (1886, Griff. P. C. 281), the Comptroller was of opinion that the words "**legal representative**" meant the executor or administrator of a deceased person and would not include a person holding a power of attorney (*h*).

No inquiry into fraud abroad.

In the case of inventions **communicated from abroad** neither the Comptroller nor the law officer will inquire into **what happened outside the United Kingdom,** the importer is the true and first inventor, and the means by which he may have obtained the invention are of no importance and will not be considered, since the merit of the invention consists in its importation into this country (*i*).

The second ground.

The second ground of opposition has been extended in scope by the Act of 1907. The corresponding words of the Act of 1883 were, "*on the ground that the invention has been patented in this country on an application of prior date.*"

Compared with Act of 1883

By the words of the Act of 1907 the opponent is entitled to rely upon specifications in respect of which patents have not been sealed at the date of opposition; but it is clear that such specifications must have been accepted. The requirement that the invention must have been **claimed** in the prior specification is for the purpose of continuity with the decisions under the Act of 1883, which ruled that the word "patented" meant that the invention must not only have been described, but must have been claimed, in the prior specification (*k*).

It will be remembered that under sect. 7, dealing with the

(*f*) *Thwaite's Application*, 1892, 9 R. P. C. 515.

(*g*) *Thwaite's Application*, 1892, 9 R. P. C. 515.

(*h*) See also *Adolph Spiel's Patent*, 1888, 5 R. P. C. 281.

(*i*) *Application by McNeil and the Pearson Fire Alarm Co.*, 1907, 24 R. P. C. 680; *Edmunds' Patent*, 1886, Griff. P. C. 281.

(*k*) *Von Buch's Patent*, Griff. L. O. C. 40; *Bartlett's Application*, 1892, 9 R. P. C. 514.

search on novelty, the office may refuse a grant or insist upon a specific reference under certain circumstances. A patent may be refused when the invention has been wholly and specifically claimed in the specification of a prior patent, and a reference may be inserted when the subject-matter has been previously described. But on an opposition the Comptroller is concerned with **prior claiming only**, and there is no power to insist upon a specific reference in a case where the invention is only described in the prior specification.

Claims only, not description considered.

In the exercise of the discretion of the law officer, upon the report of the Comptroller, if the specification appears to him to comprise the same invention as is comprised in a previous application, the fact that the validity of the first patent is in dispute (*l*), or that the opponent's patent has expired (*m*), will make no difference.

Invalidity of opponent's patent immaterial.

Therefore the invalidity of the opponent's patent on account of disconformity is immaterial (*n*). But where the opponent's complete specification was filed between the dates of the filing by the applicant of his provisional and complete specifications, and it had been expressly decided in a former case that the part relied on by the opponents was not within their provisional and could not therefore be claimed, it was held that the opposition could not succeed (*o*). But where the facts were the same so far as the dates of filing were concerned, but there had been no such decision, the applicants were not allowed to rely on disconformity between the opponent's provisional and complete specifications (*p*).

Application only refused with reluctance.

In *Stubbs' Patent* (Griff. P. C. 298), Sir R. Webster said: "As this is the first case I have had to deal with, I should like to explain what I mean to do in these cases. Of course, I need not remind you that **stopping a patent is a very serious step**, because there are no means whatever of an applicant

(*l*) *Green's Patent*, 1885, Griff. P. C. 286; *Thornborough and Wilks' Application*, 1896, 13 R. P. C. 115.

(*m*) *Lancaster's Patent*, Griff. P. C. 293; *Stewart's Application*, 1896, 13 R. P. C. 627.

(*n*) *Haythornthwaite's Application*, 1890, 7 R. P. C. 70.

(*o*) *Bartlett's Application*, 1892, 9 R. P. C. 511.

(*p*) *Green's Application*, Griff. P. C. 286.

getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent unless I am satisfied that the inventions are identical. I shall not hesitate to stop it if I can see clearly they are identical (*q*). . . . ."

This means that the comparison between the two specifications will be made with greater strictness against the earlier one than would be the case were the question one of infringement. But if the differences are immaterial the opposition will be successful (*r*).

In *Smith's Application* (1896, 13 R. P. C. 200), Sir R. Webster said: "It is only in cases in which the law officer is satisfied that there is no difference which can be regarded as amounting to invention that the later patent can be stopped. . . . . I desire to say that it is quite incorrect to suppose that, in giving judgment in *Stubbs' Case*, I ever intended to suggest that the law officer ought not to consider mechanical equivalents as bearing upon the question of identity of invention. I entirely agree with the judgment of my then colleague, Sir E. Clarke, in *Haythornthwaite's Case;* and on many occasions when I had to deal with the matter previously, I did consider the question of mechanical equivalents as bearing upon the question of identity."

The consideration of subject-matter.

And where it appeared that all the elements of the combination claimed by the applicant had been previously patented, and there was no invention in combining them, a patent was refused. (*Bridge's Application*, 1901, 18 R. P. C. 257.)

In *Hodgkins' Application* (1906, 23 R. P. C. 527), the alleged invention was a new process for making golf balls. The opponent proved that the greater part of the process had been the subject of a prior grant. The applicant offered to limit his claim to the additional part only, but having been allowed to file evidence relating to the additional part, he failed

(*q*) See also *Cumming's Application*, Griff. P. C. 277; *Todd's Application*, 1892, 9 R. P. C. 487; *Tattersall's Patent*, 1892, 9 R. P. C. 150; *Nahnsen's Application*, 1900, 17 R. P. C. 203.

(*r*) *E.g.*, as in *Aire and Walker's Application*, 1888, 5 R. P. C 345; *Wallis and Ratcliff's Application*, 1888, 5 R. P. C. 347; *Daniel's Application*, 1888, 5 R. P. C. 414; *Haythornthwaite's Patent*, 1890, 7 R. P. C. 71; *Wylie and Morton's Application*, 1896, 13 R. P. C. 97.

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Re Barker Ramsfeldt : Lyster Jones. Brown Barker
36 R.P.C. 21 - 27.

" Hall's Patent 8 R.P.C 236 ; Brickle 26 R.P.C. 813.

Sun Boat Bldg v Fox Patent XXXVII R.P.C 114

to convince the law officer that such additional part produced any material advantage in fact, and a patent was refused.

It is sometimes said that the law officer is not entitled to consider the question of **subject-matter**, but this is quite a mistaken view. If regard be had to the real meaning of the requirement, *i.e.*, that the invention must be of a manufacture, it will be seen that it is not only permissible for him to consider this aspect of the matter, but it is his duty. The above cases are instances of patents having been refused for want of subject-matter (see also *Johnson's Application*, 1902, 14 R. P. C. 56, and p. 39, ante). But it is true that the application will be viewed leniently, and the law officer will be loath to refuse a patent on the ground that the difference between it and the patented invention on which the opposition is based is small. And it is of course true that an opposition cannot be based on want of subject-matter.

References enforced.

Where it appears to the Comptroller-General or law officer that the applicant's specification is too general and calculated to deceive the public, or appears to overlap the invention of the opponent, the patent will only be granted on condition of the insertion of a **disclaiming clause**; such clause may be **general or special**, that is, either a general reference to common knowledge or a specific reference to the opponent's specification, with a disclaimer to the invention therein described.

General disclaimer and special reference.

The effect of a general disclaimer is somewhat different from that of a special reference. The former is inserted for the purpose of preventing the later patentee from alleging that his invention is wider than that which he is entitled to claim, both in his own interests, in order that his specification may not be considered too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge.

The specific reference, however, is intended as a warning to the public **and to protect the prior patentee** where there is practical identity of the inventions claimed, and will only be directed with reluctance.

The difference between the two kinds of disclaimer was

pointed out by Sir Richard in *Newton's Application* (1900, 17 R. P. C. 123): "I have often laid down the rule as to the cases in which I think specific references are right, viz., where there is substantial identity between the fundamental parts of the two inventions, but a difference which can only be justified upon the ground of improvement and it being right to protect in that case both the public and the prior patentee by a specific reference to his invention. In order to make up one's mind whether or not a specific reference or a general disclaimer is required, you must to a certain extent endeavour to grasp what is the invention in each case. . . . I do not consider that a statement of public knowledge in the terms of the claim has by any means the same effect as a specific reference. It seems to me that it then becomes a statement of general knowledge. It allows no inference that the ambit of the invention is the same in the one as the other; on the contrary, it leaves the question of invention to be determined from the consideration of that which the earlier patentee and the later patentee have respectively described" (s).

When special reference given.

Therefore, in order to entitle a prior patentee to insist upon a reference to his patent in the specification of the applicant, he must show beyond reasonable doubt—

(a) that the invention claimed by the applicant is covered by the claim in the prior specification, so that at the most it can only be considered as an improvement;

(b) that the prior patentee has a special claim to consideration, exceeding that of other prior patentees, inasmuch as he was the first to disclose the principle upon which both inventions are based, in short that he has a *master patent*.

Sir R. Webster, in *Guest and Barrow's Patent* (1888, 5 R. P. C. at p. 315), said: "I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned." In *Welch's Patent* (1891, 8 R. P. C. at p. 443), Sir R. Webster

(s) See also *Hamilton's Application*, 1902, 19 R. P. C. 33, and p. 142, ante.

Where opp is under Sec 11. 16 (2) opp may not be
defeated by opp. showing prior user

Barnaclough's case
XXXVII R.P.C. 105

Seal patent where no invention
Reyl XXXVIII
XLI R.P.C 626 Reedman
XLI R.P.C 627 Philips
XLII R.P.C. 4 B.T.H.Co

said: "I do not think that a later patentee ought 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 opponent's specification."

In *Southwell and Head's Application* (1899, 16 R. P. C. 361), Sir R. Webster, A.-G., decided that, in the absence of an agreement by the parties as to the state of the art at the time of the opponent's invention, the opponent must produce evidence thereof to support his claim to have discovered a new governing principle, *i.e.*, to have a "master patent," in order to entitle him to a specific reference.

Evidence of Master Patent.

It would seem that the evidence required in such a case by the opponent would be a declaration of a search having been made at the Patent Office library through specifications of earlier date without discovering any anticipation.

Where, however, the applicant shows only a minimum of invention beyond what is described in the opponent's specification, the question of whether the latter is a "master patent" or not will not be considered in any narrow spirit, and a specific reference will probably be inserted, if the opponent's patent is of great importance (*Sachse's Application*, 1901, 18 R. P. C. 221).

It was for some time a moot point whether the applicant could refer to prior publications other than specifications to disprove the opponent's claim to a master patent; but in an unreported case Sir E. Carson, S.-G., decided that the applicant could refer to such prior publications, and this is now settled practice (see rule 47).

Amendment of applicant's specification.

It frequently happens that the applicant's invention is shown to be anticipated to a great extent, and the question then arises as to whether he may be allowed to amend his specification and claims so as to cut away the invalid part. The extent to which this is allowable depends on the circumstances of the case (*t*), and is by no means permitted as a matter of course (*u*). The true principle to be applied is to be found in

(*t*) *Harrild and Parkins' Application*, 1900, 17 R. P. C. 617.

(*u*) *Thomas and Prevost's Application*, 1899, 16 R. P. C. 69.

the question, "Does the amended specification indicate an invention substantially different from that at first described?" Where this is so, even though the specification before amendment contained the elements of what is now set forward as the invention to be protected, the patent will be refused (*x*), and the invention ultimately claimed must in any case have been within the provisional specification (*y*). In *Crist's Application* (1903, 20 R. P. C. 475), Sir E. Carson said: "Amendments must not be considered as a matter of course. They must be amendments in the real sense, and not the practical re-writing of the whole specification, and the formation of some new claim. The truth of the matter in this case is that Mr. Crist desired to obtain something by his specification which clearly was never his, and if by framing his specification in that way he has lost something which was mingled up with a claim very much wider than anything he could possibly hope to have claimed if he had taken the trouble to look into the previous specifications, it is not the fault of th department, but his own, that he did not originally frame his specification in the proper way" (*z*).

A question has arisen as to whether, when a patent is antedated, pursuant to the provisions of sect. 91 (corresponding to sect. 103 of the Act of 1883), and when an application is made for letters patent for the same invention by another applicant, between the date to which such patent is antedated and the actual date of application, such antedated patent should, for the purpose of opposition, be treated as of the antedated date or the actual date. Sir R. Webster, on January 17, 1888, held, in the matter of *Everitt's Patent* and *L'Oiseau and Pierrard's* opposition (Griff. L. O. C. 28), that although the opponent's patent would override the applicant's by reason of the antedating, nevertheless for the purpose of opposition the opponents had no locus standi. Sir R. Webster had, on December 7, 1887 (Griff. L. O. C. 36), allowed L'Oiseau and Pierrard's

(*x*) *Thomas and Prevost's Application*, 1899, 16 R. P. C. 69; *Mills' Application*, 1901, 18 R. P. C. 322.

(*y*) *Lancaster's Application*, 1903, 20 R. P. C. 366.

(*z*) *Garnett's Application*, 1903, 20 R. P. C. 475.

patent to be amended by antedating it, pursuant to the 103rd section and to the Convention, notwithstanding that such antedating would have the effect of overriding *Everitt's Patent*.

Third ground.

The **third ground** was introduced by the Act of 1907, and the purpose of it is the same as that of sect. 12, sub-sect. 5, which requires samples to be filed in the case of an application for a patent for a chemical invention. At first sight it would seem bad policy to oppose an application on this ground, since the applicant may be afforded an opportunity of amending his specification and curing defects which, had the application been allowed to proceed, would have rendered the patent when granted hopelessly void. But in the case of chemical inventions it is extremely difficult to show that a description *would have been insufficient at the date when the application was made*, since the patentee may, at the time when the allegation is made, be able to point to practical success by that time attained. Hence it is desirable that the specification should be tested as soon as possible, and before the applicant has had time to steal the fruit of subsequent investigation. Perhaps on an opposition on this ground the samples filed at the office may be brought to light. There is no rule laid down as to this, but the practical advantage would be considerable.

Question of amendment on third ground.

It is submitted that the applicant should *not* be allowed to amend his specification to any appreciable extent in the course of an opposition on this ground, otherwise its deterrent policy will to a considerable extent be thwarted.

Fourth ground.

The **fourth ground of opposition** was introduced by sect. 4 of the Act of 1888, for the purpose of preventing an applicant from claiming in his complete specification an improvement on his invention, which was contained in the provisional of the opponent filed after the date of the applicant's provisional specification and thereby depriving the opponent of the benefit of his invention; but an applicant is not thereby deprived of his old right to include fair developments of his patent in his complete specification (*a*).

Practice.

The **Practice** in oppositions is regulated by rules 40—47 of

(*a*) *Edwards' Application*, 1894, 11 R. P. C. 461; *Millar's Application*, 1898, 15 R. P. C. 718.

the Patents Rules, 1908, and appeals to the law officer by the Law Officers' Rules. (See sect. 40 of the Act of 1907.) In these will be found all the rules relating to evidence and notices.

The **notice of opposition** must state the grounds upon which the opponent intends to oppose the grant, and must be signed by him. A copy of such notice is delivered by the Comptroller to the applicant. If the opponent does not desire that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice should say so (see p. 170). Either party must give notice to the other of any specification or other publications to which he intends to refer at the hearing.

Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification the opponent may file **statutory declarations** in support of his opposition, and must deliver to the applicant copies thereof. If he intends to rely on the first ground, he **must** file declarations. If he intends to rely on the third ground, he must state in writing the deficiencies of the specification. Within fourteen days from the delivery of such copies the applicant may leave statutory declarations in reply, copies of which must be sent to the opponent. The opponent may leave further declarations at the Patent Office, copies of which must be delivered to the applicant; such last-mentioned declarations must be confined to matters strictly in reply. No further evidence may be left on either side except by leave of the Comptroller.

The parties, if they so wish, are entitled to a hearing, and when the period of two months from the date of advertisement has elapsed the Comptroller gives his decision. If the opponent dies before the day fixed for hearing the opposition, the notice of opposition may be amended by inserting the name of another opponent (*b*).

By sect. 77 of the Act of 1907 the Comptroller is empowered to receive vivâ voce evidence. The section is as follows:—

Oral evidence. (1) "*Subject to rules under this Act in any proceeding under*

(*b*) *Lake's Application*, Griff. L. O. C. 35.

this Act before the Comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the Comptroller thinks it right so to do, he may take evidence vivâ voce in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) "*In case any part of the evidence is taken vivâ voce, the Comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.*"

This enactment is quite new, but effects a very necessary reform. The usual practice is for the parties to request the Comptroller to give notice to the witnesses on the other side to attend for cross-examination. They are asked at the hearing by way of examination-in-chief whether their statutory declarations are true, and are then cross-examined by the other side, and finally re-examined. There is nothing, however, to prevent witnesses being called who have not made declarations.

The attendance of witnesses may be enforced by *subpœna* under Order XXXVI., rule 49, of the Rules of the Supreme Court.

By sect. 40—

"*The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.*"

Costs before law officer.

By sect. 39 the Comptroller has also been given power to award costs:—

(1) "*The Comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have*

Costs before Comptroller.

power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court.

(2) "*If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.*"

It is submitted that an opponent who has successfully obtained the insertion of a specific reference, but has failed to stop the applicant's patent, should not be granted costs unless he has previously notified the applicant, under Rule 40, that a specific reference or amendment is all that he requires.

Under this section the usual practice is for the successful party to send to the Comptroller and to the unsuccessful party a bill of costs. The unsuccessful party may then send in objections in writing, and the Comptroller awards a round sum in most cases approximating to the amount which appears to have been reasonably incurred. At present there is no regular system of taxation. Before the law officer the amount awarded will be specifically named, and will not be a sum large enough to indemnify the successful party; "To do so would seriously discourage the appeals, and limit very much the usefulness which the law officers fill in these matters" (Sir E. Clarke, S.-G., in *Stuart's Application*, 1892, 9 R. P. C. 452). It has been the practice since the Act of 1907, however, to award larger sums.

Costs before law officer.

The power which the law officer has, under sect. 11, subsect. 3, of obtaining the assistance of an expert, is seldom made use of.

In all cases save those where fraud is alleged the applicant opens his case first.

Notice of appeal must be filed within fourteen days from the

Issued the 9th. the sum

of 3gn as respects this costs &

direct the said sum be paid

by the appt. in the event of

application being made to

have this Order made to

a Rule of the Court, Award the said A.B.

a further sum of 3gn to be paid

by the said &c., but no application

to be made to make this Order

a Rule of the Court until the

expiration of 14 days from the

date of this Order

Lgd. H. H.

decision on appt. to 9427 10

Fraser v. Clark LJ 32 NS 240

date of the decision appealed against, and must state the nature of such decision. The evidence used on appeal to the law officer must be the same as that used at the hearing before the Comptroller, save as to matters that have occurred or come to the knowledge of either party in the meanwhile, except with the leave of the law officer. The law officer shall, at the request of either party, order the attendance at the hearing of the appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter in question, unless, in the opinion of the law officer, there is good ground for not making such an order.

The law officer will not allow the question of fraud to be raised for the first time on appeal (*c*).

(*c*) *Huth's Application*, 1884, Griff. P. C. 292.

CHAPTER IX.

AMENDMENT OF SPECIFICATIONS.

In previous chapters we have seen that the specification may be amended before publication as a result of the procedure on application and acceptance or on account of opposition to the grant. We now have to deal with cases in which the applicant or patentee desires to amend the specification after publication. The extent to which this may be done and the procedure are regulated by sects. 21 and 22 of the Act of 1907 and rules 60—67 of 1908.

History of law.

The history of the law on this matter is, however, instructive. There are several reported cases showing that at common law mere **clerical errors** in a specification might formerly be amended by the Master of the Rolls and the Lord Chancellor upon petition, but these amendments were strictly limited to verbal or clerical errors arising from mistake or inadvertence (*a*). In *Re Gare's Patent* (1884, L. R. 26 C. D. 105), Brett, M.R., allowed amendments of clerical errors in a specification filed under sects. 27 and 28 of the Patents, &c. Act, 1852, and said: "The Master of the Rolls is of opinion that sect. 18 of the Patents, &c. Act, 1883, does not affect the power of the Master of the Rolls to allow amendments in a patent specification filed in pursuance of sects. 27 and 28 of the Patent Act, 1852, *or which is otherwise to be considered as a record under the authority of the Master of the Rolls.* So long as the specification is in the Patent Office, and before the patent is sealed, the Master of the Rolls considers that the proceedings of sect. 18 should be the only proceedings taken by anyone asking for amendment under that section."

It would appear from the words printed in italics that the

(*a*) *In re Sharp's Patent*, 1840, 1 W. P. C. 649; *In re Johnson's Patent*, 1877, L. R. 5 C. D. 503.

jurisdiction of the Master of the Rolls is still intact with reference to amendments after sealing.

In *Re Berdan's Patent* (1875, L. R. 20 Eq. 346), it was held that where a disclaimer had been filed without the consent of the patentee, the Master of the Rolls had jurisdiction without bill filed to order it to be taken off the file.

Sect. 70 gives to the Comptroller power to correct any clerical error in or in connection with an application for a patent on payment of the prescribed fee.

We have seen that a patent for a very meritorious invention may be utterly vitiated by the patentee claiming something which is not new; so, also, a patent might be rendered void by reason of innocent misdescription or misrepresentation.

The **common law power** of amendment being found **insufficient** for the purposes of justice in such cases, the Act 5 & 6 Will. IV. c. 83, was passed, enabling "*any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent,* &c.," with the leave of the law officer, to **disclaim** any part of the "title of the invention or of the specification, stating the reason for such disclaimer;" or to, with such leave as aforesaid, "enter a **memorandum of** any **alteration** in such title or specification (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent), &c., &c." The case of *Spilsbury* v. *Clough* (1842, 2 Q. B. 466) having very much limited the meaning of the words of the statute, printed above in italics, the Act 7 & 8 Vict. c. 69, was passed, giving power to the original **patentee, or his assignees,** or both jointly, in the event of any interest in the patent remaining in the original patentee, to file a disclaimer or memorandum of alteration.

It will be observed that prior to the Act of 1883 any **disclaimer or amendment** made by the patentee was entirely **at his own peril,** and that in any subsequent action involving the validity of the patent objection might be taken to the disclaimer or amendment on the ground that it really extended the patent beyond its original limits.

The Act of 1907.

The provisions of sect. 21 of the Act of 1907 (following

sect. 18 of the Act of 1883 as amended by sect. 5 of the Act of 1886) are as follows.

Sub-sect. 1 provides:—

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

When the Comptroller-General has not required an amendment, **all amendments by the applicant or patentee from the date of lodging the complete specification** (save those made under sect. 22 to be considered hereafter) **must be made under sect. 21.**

"The patentee," as has been pointed out in a previous chapter, means the person for the time being entitled to the benefit of the patent, while "the applicant" means the person whose patent has not yet been sealed, but whose complete specification has been lodged.

Amendments after publication under sect. 21.

Directly the specification is accepted it becomes open to public inspection (see sect. 9), and therefore the application to amend will have to be made under sect. 21. The case of *Jones' Patent* (Griff. P. C. 313), which is otherwise badly reported and ambiguous, makes this clear. The practice of the Patent Office is to allow amendments under sects. 6, 7 and 8 before acceptance.

Permissible amendments.

We will deal firstly with the nature of **permissible amendments** and refer later to the practice.

Nature of permissible amendments.

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

It will be observed that the **amendments** are **to be by disclaimer, correction or explanation,** provided the amendment does not cause the specification to claim an invention **substantially larger or different.** The Act of Will. IV., after using the words "disclaimer" and "alteration," provided that no extension should take place in the "**exclusive right**" granted by the letters patent.

It was always a question of great difficulty whether or not a

As to amendment of Spec. of application
See Re W.E.C. XLII R.P.C. 281.
Scope as original application not as finally
Grant.

disclaimer or alteration extended the "exclusive right" of the patentee. For instance, if in his original specification, after describing several improvements in a process of manufacture, he proceeded to claim them all, and it should turn out that one of his improvements was old, the whole patent was bad and the patentee had no exclusive right at all; if he then disclaimed the objectionable portion, his patent became good as to all the rest. There was clearly, therefore, an extension of the exclusive right, notwithstanding that this was the very case the statute was passed to meet. In *R.* v. *Mill* (1850, 20 L. J. C. P. 24), Mr. Justice Maule's view of the Act of Will. IV. was: "Whereas there were previously many small and trifling objections by which, if they were sustained against any one of many important inventions, the whole was avoided. In such cases amendments may now be made by means of a disclaimer."

Romilly, M.R., in the same case at the Rolls (14 Beav. 315), said: "It is proper they (patentees) should be allowed to correct errors in their patents by removing from the specification parts which are not material or substantial, or which they have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." There is a case reported in Macrory's Patent Cases, at p. 116, where Sir Richard Bethell, when Solicitor-General, allowed a patentee to enter a disclaimer, the effect of which was to enable him to claim for a combination, the original claim being for the several parts of the described invention. When afterwards he became Lord Westbury he described the words of this statute as vague and indefinite, and said: "Possibly they mean that the patent must not, by the operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged." (*Foxwell* v. *Bostock*, 1864, 4 De G. J. & S. 306.)

The case of *Ralston* v. *Smith* (1860, 11 H. L. C. 223) shows the difficulty which the Courts had in reconciling a disclaimer which might make a patent valid which was void *ab initio*, with the prohibition against extending the exclusive right. The

judgment of Lord Chelmsford, as reported, is remarkable for its cautious vagueness, and the care which seems to have been exercised not to lay down anything approaching to a general principle.

Under the Acts of 1883 and 1907 it is not the exclusive right which must not be extended, but the invention must not be substantially larger or different.

Cases to illustrate.

The case of *Dellwick's Patent* (1898, 15 R. P. C. 682) is instructive on this point. The inventor had originally described improvements in incandescent mantles for gas lighting, in which he enumerated a long list of metallic oxides which might be used to coat the mantles, and he described an elaborate theory of the behaviour of the mantles so treated, attributing it partly to the relative conducting powers of the mantle and the coating. His claim was: "The herein-described process of treating incandescents which are non-conductors of heat, such as the oxides of calcium, magnesium, aluminium, zirconium, and similar metals of this group, or compounds of these oxides, by covering or saturating them with a coating of refractory oxide of a heavy metal or metals."

The proposed amendments were to cut out all the description of the theory, the words "non-conductors of heat" and "similar metals of this group" in the claim, and to substitute for the words "with a coating of refractory oxide of a heavy metal or metals" the words "with a coating of chromium oxide," chromium oxide being one of the coatings in the list set out in the body of the specification.

Sir Robert Finlay, S.-G., held that the amendments were permissible, since an inventor is not bound to set forth an accurate theory, nor, indeed, any theory of the behaviour of his invention, and said: "It is perfectly true in this case that the patentee desires to throw a very large part of his cargo overboard, but I confess that I think for all that it is a case of disclaimer. It may be a case of disclaiming six-sevenths, or nine-tenths, or ninety-nine hundredths of what was contained in the original patent, but for all that he is not introducing anything new; he is merely retaining one of the elements

which formed the subject of the alleged invention contained in the original patent."

But where a claim is for a combination, an alteration of that combination will mean that the claim will be for a different invention. Nature of combination unalterable.

The case of *Parkinson's Patent* (1896, 13 R. P. C. 509) is an instructive example of a disclaimer which would have made the claim not wider, but different from what it originally was. The claim originally was for the combination of A. and B. to operate on a new principle. It was found that the principle and the combination of A. and B. for effecting it were well known. The proposed amendment was to disclaim the mere combination of A. and B., and to claim A. and B. in combination with the other portions of the apparatus. Sir R. Finlay, S.-G., said: "To my mind the specification as amended, if this application were allowed, would be for something substantially different from what the patent originally claimed . . . the patentee claims the combination of the sieve with the side deposit surfaces, tapering or not tapering. . . . What would be the effect of the patent as amended? It would be really for a new combination: for the combination of the sieve and side deposit surfaces with the other parts of the apparatus indicated by the words in the proposed amendment: 'Other portions of the apparatus substantially in the manner hereinbefore described, so as practically to free the escaping air from particles of dust.' That may or may not be a good claim, but to my mind it is perfectly impossible to say that it is not substantially different from the naked claim . . . for the combination of the sieve with side deposit surfaces."

Where there are in the original specification two claims for A. and for B. respectively, it is not permissible to amend by substituting for these claims one for A. and B. in combination, since the combination is a different invention. The case of *Kelly* v. *Heathman* (1890, 45 C. D. 256; 7 R. P. C. 343 (*b*)), which seems to have been at one time considered an authority to the contrary, was explained by Sir E. Carson, S.-G., in his

(*b*) And see *Bateman and Moore's Patent*, 1854, Macr. P. C. 116.

decision in *Hattersley and Hodgson's Patent* (1904, 21 R. P. C. 233). Mr. Justice North had held in the former case that there was no objection in that particular case to the amendment, but he so decided upon the ground that even before amendment there was a claim to a combination, though not happily expressed, and that the amendment amounted to nothing more than a correction or explanation, which is, of course, admissible.

In *Johnson's Patent* (1896, 13 R. P. C. 659), Sir R. Webster said: "On previous occasions I have expressed my view that the words of sub-sect. 1 of sect. 18 of the Act of 1883, 'by way of disclaimer, correction, or explanation,' were meant to refer to disclaiming something which was originally wrongly inserted, or to explaining something which requires explanation, having regard to the statement made in the first instance by the patentee. It must be remembered that the whole of this sub-section is subject to the words 'not substantially larger than or substantially different from the invention claimed. . . .'" Disclaimer is not to be used solely for the mere purpose of turning an insufficient description into a sufficient description. Of course, it is to be used for the purpose of turning an ambiguous specification into a clear specification, but not for the purpose of turning an insufficient description into a sufficient, especially if the amendment introduces subsequent knowledge."

Explanation may only be of original statements.

Not insertion of subsequent discovery.

Therefore "**correction or explanation**" does not include amendment by the insertion of subsequently ascertained knowledge; it is only allowed for the purpose of explaining more clearly the meaning of the patentee **at the time when he patented his invention**, that is, to correct and explain the enunciation of his invention as he intended originally to give it.

In the case of *Beck and Justice's Patent* (Griff. L. O. C. 10), the specification described "improvements in nozzles for the escape of steam or gases under pressure." The proposed amendment included directions for modifying the invention for use in gas engines. Gas engines were not mentioned in the original specification, and it was admitted that the amendment was

rendered necessary by the development of them, which had since taken place. The amendment was not allowed.

Sir R. Webster, A.-G., said: "My idea of the function of an explanation within sect. 18 is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. I do not think it is intended that he should put in subsequently ascertained knowledge."

Sufficient reason must be given.

Where **no reason was shown** by the patentee for requiring the amendment, in the case of a specification which on the face of it was sufficient without it, the law officer refused the application (*c*).

In *Hampton and Facer's Patent* (Griff. L. O. C. 15), the applicants desired to insert a statement in their specification **imputing disadvantage to former patents.** The Solicitor-General refused the application on the ground that he was not at all satisfied that the faults imputed to those patents did in reality exist.

Re-writing of specification not allowable.

An amendment which in effect amounts **practically to the re-writing of the whole specification** will not be allowed (*d*), nor an amendment which abandons the original substantive claim and limits the invention to a subordinate and unimportant alternative (*e*).

The law officer will allow an amendment which upon a fair interpretation tends to **limit the scope** of the original specification, and where a specification is clearly capable of two constructions the patentee by amendment can limit himself to one of them (*f*).

No power to amend title or provisional.

Under this section there is no **power either to amend the title or the provisional specification.** When a complete specification is filed with a narrower title than the provisional, the proper course for the Comptroller-General to adopt is to amend the

(*c*) *Morgan's Patent*, Griff. L. O. C. 17; *Nordenfelt's Patent*, Griff. L. O. C. 18.

(*d*) *Nairn's Patent*, 1891, 8 R. P. C. 444; *Garnett's Application*, 1899, 16 R. P. C. 154; *Crist's Application*, 1903, 20 R. P. C. 475 (see p. 165, ante).

(*e*) *Heath and Frost's Patent*, Griff. P. C. 310; *Crist's Application*, 1903, 20 R. P. C. 475.

(*f*) *Rylands' Patent*, 1888, 5 R. P. C. 665; see also other instances, *Mills' Patent*, 1850, 10 C. B. 379; *Higgins' Patent*, 1859, 8 H. L. C. 550.

title of the provisional (such amendment, however, must be in the nature of excision only) or to give the applicant liberty to insert a disclaiming clause in the complete specification and assimilate the title of the complete to that of the provisional (*g*).

THE PRACTICE ON AN APPLICATION FOR LEAVE TO AMEND.

Practice reasons.

Under the Act of Will. IV., when a patentee sought to disclaim, it was necessary that he should give his reasons for the proposed disclaimer, but he was not compelled to state reasons for a proposed alteration. Under the present statute he must give his reasons for any amendment, whatever the form of the amendment may be. The reasons will, of course, vary with each case—*e.g.*, that the patentee has discovered that parts of the invention claimed are not new, or are useless, or that certain phrases and terms as originally used need explanation, or that parts of the machine or process as described will not work.

The reasons for an amendment form no part of the amendment itself (*h*).

If the reasons do not disclose any ground on which the amendment ought to be allowed, the application will be dismissed (*i*); but the amendment will not be refused merely on the ground that the reasons given for it are not conclusively sufficient (*k*).

Sir E. Clarke, S.-G., in *Lang's Patent* (1890, 7 R. P. C. at p. 471), summed up the jurisdiction of the law officer under the 18th section of the Act of 1883 in the following words: "I do not doubt that I have power to allow any amendments, whether of the letterpress of the specification, or of the drawings, or by way of adding drawings, if drawings have not in the first instance been appended to the specification, necessary to define the disclaimer which it is desired to make."

No prohibition to law officer.

Prohibition will not lie to the law officer in the exercise of

(*g*) *Dart's Patent*, Griff. P. C. 307.

(*h*) *Cannington* v. *Nuttall*, 1871, L. R. 5 H. L. 205, 227, 228.

(*i*) *Nordenfelt's Patent*, Griff. L. O. C. 18.

(*k*) *Ashworth's Patent*, Griff. L. O. C. 6.

his discretion under this section (*Van Gelder's Patent*, 1889, 6 R. P. C. 22).

By sub-sect. 2 of sect. 21 "*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.*"

In *Ashworth's Patent* (Griff. L. O. C. 7), Sir H. Davey, S.-G., said: "The section (18 (2) of the Act of 1883) does not in terms say the reasons are to be advertised, but probably the reasons are a part of the request." It is not the practice, however, to advertise the reasons. The practice is regulated by rules 60 to 67 of 1908.

The section says that "any person" may oppose. This is, of course, limited in exactly the same manner as an opposition entered to a grant (see p. 156). **The opponent.**

(3) "*Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.*"

The Comptroller exercises the power to impose conditions given in express terms to the law officer under sub-sect. 5 (*l*). **Power of Comptroller to impose conditions.**

But in the case of applications for leave to amend **patents granted since the Act of 1883** conditions will not be imposed except under special circumstances.

In *Allen's Patent* (1887, Griff. L. O. C. 3), application was made to amend a specification dated 1885. The opponents asked that a condition should be imposed that Allen should not bring any action or bring any proceedings whatever against them or any of their customers, &c., in respect of any articles which had been sold or contracted to be sold prior to the amendment. Sir E. Clarke, S.-G., having consulted Sir R. Webster, A.-G., gave the following decision: "I have carefully considered the question whether, in allowing this amendment, I ought to impose any condition as to the bringing of actions for infringement prior to the date of the amendment. This appears to be the first case in which that question has come up

(*l*) *Pietschmann's Patent*, Griff. P. C. 314; *Andrew* v. *Crossley*, 1892, 9 R. P. C. at p. 168.

for decision in respect of patents issued since the passing of the Act of 1883. In several cases which came before the law officer shortly after the passing of this Act I find that they imposed, as a condition of the amendment, that no action should be brought for infringements prior to 1st January, 1884. An examination of these cases, as reported in Griffin's P. C., shows that the reason for their so doing, and in each case (whatever its date) referring back to the 1st January, 1884, was, that they doubted whether sect. 20 would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act. No such question arises here. This patent was dated 20th October, 1885, and if after amendment an action is brought for a prior infringement, it is clear that the Court will have to decide whether the matters referred to in sect. 20 (sect. 23 of the Act of 1907) have been established to its satisfaction. I do not think that I am entitled to substitute my own opinion for that of the Court. Again, I do not think that I could in strictness attach this as a condition to the allowance of this amendment. I could only require an undertaking from the applicant, as was required by Sir H. James, A.-G., in the *Westinghouse Case*. If he were to refuse to give such an undertaking, I do not feel myself entitled by that refusal to deprive him of the opportunity of protecting the real invention described in his specification by a disclaimer of that which I am satisfied he does not mean to claim. I therefore do not think I can properly impose this condition" (*m*).

In *Ashworth's Patent* (Griff. L. O. C. 6), Sir H. Davey, S.-G., said: "If I saw, or if there was any evidence before me, that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims, I should consider that a special circumstance. If, for example, the patentees had been threatening persons and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different from that which is claimed, I should consider that a special circum-

(*m*) Followed in *Pitt's Patent*, 1901, 18 R. P. C. 478.

stance, and under those circumstances, as far as I am personally concerned, I should impose the condition that no action should be brought for anything done at any time before the amendment."

The nature of the conditions imposed by the Court will be discussed at p. 187. They are the terms which the Comptroller and the law officer will also impose in suitable cases.

The specification is considered to be **amended from the moment that leave to amend is given,** and the conditions imposed, if any, agreed to (*n*); no written undertaking by the applicant is necessary, although it is the practice in the Patent Office to require some such undertaking as conclusive evidence of the agreement (*o*), since the written assent precludes the patentee from alleging that he did not accept the condition (*p*).

Evidence and costs.

The Comptroller may take evidence viva voce in the same manner as on an opposition.

The power of the Comptroller to grant **costs** is expressly conferred by the 39th section, that of the law officer by sect. 40.

In *Ashworth's Patent* (Griff. L. O. C. 6), the law officer refused to grant costs to the applicant although successful, on the ground that the specification was so loosely framed, it was natural that rival traders should oppose an application for leave to amend.

In *Lake's Patent* (Griff. L. O. C. 16), which was an **unopposed** application for leave to amend, the applicants appealed to the law officer against the decision of the Comptroller-General. Sir R. Webster, A.-G., allowed the appeal on the ground that a doubtful amendment ought to be allowed, but refused to give costs against the Comptroller. "In fact," he said, "I may say that I think it would be better, as a matter of practice, that in the absence of very special circumstances the **Comptroller-General** should neither give nor receive costs."

In *Morgan's Patent* (Griff. L. O. C. 17), which was a successful appeal to the law officer from the decision of the Comptroller-General, application was made for the **return of**

(*n*) *Andrew* v. *Crossley*, 1892, 9 R. P. C. 165.

(*o*) Ibid. at p. 168.

(*p*) Ibid. at p. 169; see also *Re Berdan*, 1875, L. R. 20 Eq. 346.

the stamp on the notice of appeal. Sir R. Webster, A.-G., refused this application on the ground that he considered the case to be one in which the Comptroller-General was quite right in declining to allow the amendment in the first instance and to leave it to the law officer.

Leave to amend conclusive.

By sub-sect. 7, corresponding to sub-sect. 9 of sect. 18 of the Act of 1883, "*leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud* (*q*) ; *and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be deemed to form part of the specification.*"

The result of this enactment is that the amended specification stands in the place of the old specification, and its validity must be determined in the same way and on the same footing as though it were the original specification.

Until the decision of the House of Lords in *Moser* v. *Marsden* (1896, 13 P. O. R. 24) there had been considerable doubt as to the effect of this enactment, and numerous cases had been decided upon the question of whether, when a specification had been amended so as to include in the amended portion something that was itself invalid, the amendment only or the whole patent would be invalid (*r*). These cases are no longer of importance, and until further enactment the law on the point is definitely settled.

Lord Watson said (at p. 31) : "In my opinion, the very object of the Act of 1883 was to make an amended claim, when admitted by the proper authorities, a complete substitute, to all effects and purposes, for the claim originally lodged by the patentee. 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."

(*q*) See *In re Berdan's Patent*, 1875, L. R. 20 Eq. 346; 44 L. J. Ch. 544.

(*r*) See the 3rd edition of this book, and *Foxwell* v. *Bostock*, 1864, 4 De G. J. & S. 298 ; *Gaulard and Gibbs*, 1890, 7 R. P. C. 367 ; *Van Gelder's Patent*, 1889, 6 R. P. C. 22.

Use of deleted portions in construction.

In *Hattersley* v. *Hodgson* (1906, 23 R. P. C. 192), the House of Lords looked at the portions of the specification which had been deleted by amendment to assist them in construing the remaining portions. No formal pronouncement to this effect appears in the report, but the general consensus of opinion is to the effect that the action of the law lords has now established the practice on this point, and that a judgment in the Court below in another case (*s*) and in the Court of Appeal in the same case (*t*), in which it was decided that the deleted portions might not be looked at for the purpose of construing the remaining portions, are virtually overruled.

In *Cropper* v. *Smith* (1884, 1 R. P. C. 254; L. R. 28 C. D. 148) (*u*), the Comptroller having declined leave to amend a specification by reason of the 10th sub-section of sect. 18 on the ground that an appeal was pending to the House of Lords from a decision of the Court of Appeal, declaring the patent in question invalid, and that such appeal was "an action for infringement or other legal proceeding," application was made to the Court under sect. 19. Chitty, J., held that the words "other legal proceedings" applied to a petition for revocation, and that the words "action for infringement" referred to an action before judgment, and consequently that the appeal to the House of Lords did not deprive the Comptroller of the power of amending the specification under sect. 18.

In *Brooks* v. *Lycett's Saddle and Motor Co.* (1904, 21 R. P. C. 651), notice of trial in an action for infringement had been given. An order was obtained for the action to stand over generally, with liberty to either party to restore, in order for a settlement to be arrived at. The negotiations proved abortive, but nothing more was done for two years, when the plaintiffs applied to the Comptroller for leave to amend their specification under sect. 18, which leave was granted. The defendants afterwards applied to restore the infringement action to the list. On the trial of the action it was contended that this amendment was invalid, as the action had been

(*s*) *Jandus Arc Lamp Co.* v. *Arc Lamp Co.*, 1905, 22 R. P. C. at p. 290.

(*t*) 1904, 21 R. P. C. at p. 524.

(*u*) See also *Lawrence* v. *Perry*, 1885, 2 R. P. C. at p. 188.

"pending" at the time. Mr. Justice Farwell decided that this was so, and allowed the action to stand over with leave to the defendants to apply, under sect. 19.

In *Codd* v. *Bratby* (1884, 1 R. P. C. 209), liberty to amend under sect. 19 was given upon terms by the Court after a previous refusal by the Comptroller under sect. 18, but the applicant was ordered to pay the costs of the application to the Comptroller.

Where the application for leave to amend has been made under sect. 18 the subsequent institution of legal proceedings does not suspend the application pending before the Comptroller (*x*).

When legal proceedings are pending.

(8) "*This section shall not apply when and so long as any action for infringement or proceeding before the Court for the revocation of a patent is pending*" (corresponding to sub-sect. 10 of sect. 18.)

Power of Court to amend.

22. "*In any action for infringement of a patent or proceedings before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs advertisement or otherwise, as the Court may think fit:*

"*Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court.*"

Different from power under Act of 1883.

This section introduces a new procedure. Under sect. 19 of the Act of 1883 the patentee could apply to the Court *for leave to apply at the Patent Office for leave to amend by way of disclaimer*. The Court is now given power to amend, and the procedure at the Patent Office is abolished.

The practice under this section is regulated by Order LIIIA, rule 23, of the Rules of the Supreme Court (Appendix). The

(*x*) *Woolfe* v. *The Automatic Picture Gallery Co.*, 1903, 20 R. P. C. 177.

application must be advertised, and persons desiring to oppose are entitled to be heard. The Comptroller must be served with notice, and may be heard. The reason for this procedure is, that, although disclaimers only are allowable, it sometimes occurs that an amendment which in form is a disclaimer is in effect an alteration in the nature of the invention claimed (*y*). And it is to be noticed that while an action is pending the amendments made with the sanction of the Court are **limited to disclaimer.** This is no mere slip in the wording of the Act, which is strictly applied, and amendment by way of correction or explanation is not allowed (*z*).

Disclaimer only.

The section gives an absolute discretion to the Court or judge in imposing conditions upon which leave to amend will be granted, and the Court of Appeal "will not interfere with the exercise of that discretion unless they can clearly come to the opinion that in their view that discretion was exercised absolutely wrongly" (*a*).

Power to impose conditions.

In *Bray* v. *Gardner* (1887, 4 R. P. C. at p. 44), Lord Justice Lindley said: "I do not understand that there is any form of order which is invariably to be followed in all cases when application is made under sect. 19. It appears to me that whenever leave is given to amend under sect. 19 of this Act care ought to be taken that no injustice is done to the defendant by reason of the amendment, if amendment is made, or if leave to apply for it is granted. Adequate protection may be given to the defendant in various cases in various forms."

The order made in *The Ludington Cigarette Machine Co., Ltd.* v. *Baron Cigarette Machine Co., Ltd.* (1900, 17 R. P. C. at p. 746), and supported by the House of Lords, has, however, often been followed (*b*).

(*y*) *E.g.*, *Lane Fox* v. *The Kensington, &c., Electric Lighting Co.*, 1892, 9 R. P. C. at p. 419; *Alsop's Patent*, 1907, 24 R. P. C. 684.

(*z*) *Owen's Patent*, 1898, 15 R. P. C. 755.

(*a*) Per Lord Esher, M.R., in *Allen* v. *Doulton*, 1887, 4 R. P. C. at p. 383; see also *Bray* v. *Gardner*, 1887, 4 R. P. C. at p. 42; *Lang* v. *Whitecross Wire and Iron Co.*, 1890, 6 R. P. C. at p. 574; 7 R. P. C. 389; *Ludington Cigarette Machine Co.* v. *Baron Cigarette Machine Co.*, 1900, 17 R. P. C. at p. 747.

(*b*) See *Alsop's Patent*, 1906, 23 R. P. C. 79.

In *Corrigal* v. *Armstrong, Whitworth & Co.* (1903, 20 R. P. C. at p. 524), the order was drawn up as follows: "The plaintiff by his counsel disclaiming any relief in respect of anything done by the defendants prior to the amendment hereinafter ordered, this Court doth order that the plaintiff be at liberty to apply at the Patent Office for leave to amend the specification No. of by way of disclaimer, and after such disclaimer to amend the statement of claim and the particulars of breaches within fourteen days. And it is ordered that the defendants do have liberty, if so advised, to put in an amended defence and particulars of objections within fourteen days from the delivery of the amended statement of claim. And it is ordered that the costs of this application and the costs of and occasioned by the said amendment be the defendants' costs in any event. And it is ordered that all further proceedings in this action be stayed until the amendment of the plaintiff's specification is allowed or until further order."

In *Chatwood's Patent* (1899, 16 R. P. C. at p. 373), the Court followed the order made in *The Haslam Foundry Co.* v. *Goodfellow* (1888, L. R. 37 C. D. 118; 5 R. P. C. 28). In that case the pleadings had been delivered, and nothing remained to be done but to prepare the evidence for trial, when the plaintiffs asked for leave to apply to amend. The application was granted on the following terms:—"The plaintiffs to pay, in any event, the costs of the application, and the costs of the action up to and occasioned by the disclaimer, except only so far as the proceedings in the action might be utilised for the purpose of the trial. The plaintiffs and defendants to be allowed to make the necessary amendments in the pleadings after disclaimer. The plaintiffs to undertake forthwith to amend their pleadings in accordance with the amendment, or to consent to the action being dismissed with costs."

Statutory consequence of amendment in respect of damages.

The condition which prevents the patentee from seeking relief in respect of acts done prior to the amendment will not invariably be followed. It is to be remembered that the public are afforded considerable protection by sect. 23 (corresponding to sect. 20 of the Act of 1883):—

"Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge."

As factor in imposition of terms.

In *Geipel's Patent* (1903, 20 R. P. C. 545) (a petition for revocation) the patent was held bad because one of the methods illustrated for carrying the invention into effect was found to be unworkable, and leave was given to apply to amend by disclaiming this portion. The petitioner had made use of the useful portion of the invention. Leave was also given to apply to amend by striking out a portion which rendered the patent bad for disconformity. Buckley, J., in considering this state of affairs, said: "If the man whom I have, in the sense in which I have expressed the word, called an infringer, has availed himself of that part of the patent which will by disclaimer become good, is it fair, as between a person who will become the patentee and that infringer, that he should be allowed to go on and sell goods made in infringement of that which is going to be, I suppose, hereafter a valid patent? If he has availed himself . . . of the other parts of the patent, and the original claim was framed in good faith and with reasonable skill and knowledge, . . . it seems to me that it is fair that there should be room to restrain him, or those who are dealing with his goods, from disposing of the goods thus made"; and the learned judge left the patentee free to bring actions, subject to the liability to failure if at the trial of such actions it could be shown that the original specification was not framed in good faith and with reasonable skill and knowledge (*c*).

In *Armstrong's Patent* (1896, 13 R. P. C. 501), leave to apply to amend was refused on the ground that there would be nothing left to support a patent after the proposed amendment should have been made. The Court of Appeal (1897, 14

(*c*) Followed in *Klaber's Patent*, 1908, 25 R. P. C. at p. 334 (under the Act of 1907).

R. P. C. 747) refused to interfere with the judge's discretion, and, moreover, agreed with his view of the matter.

Liberty to amend under sect. 22 will not be given after judgment (*d*), since the patentee is then free to act under sect. 21.

In *Hopkinson* v. *St. James and Pall Mall Electric Light Co.* (1893, 10 R. P. C. at p. 62), judgment was given for plaintiff with the usual relief. The defendants referred to sect. 20 of the Act of 1883, and asked that the account of profits should be kept only from the date of the amended specification. Romer, J., refused the application, and said that "he thought it was clear from the evidence which was before him that the plaintiff's original claim was framed in good faith and with reasonable skill and knowledge." The relief afforded by the Act is seldom granted, and the onus of proof of the circumstances under which the original specification was framed is entirely on the shoulders of the patentee (*e*).

In *Kane and Pattison* v. *Boyle* (1901, 18 R. P. C. at p. 338), Byrne, J., said: "I think that what the patentee has to establish is that in his original specification he meant and intended to claim that which he had invented, and no more. . . . If the inventor has knowingly sought to include a field of subject matter beyond that which he knows he has invented, I think he cannot be regarded as having framed his claim in good faith within the meaning of this particular section, and I am of opinion, in the present case, that he meant and intended that which his original specification says, namely, to make a larger claim than that which he knew he was entitled to; and, secondly, I think he has failed to establish, to my satisfaction, that his original claim was framed in good faith and with reasonable skill and knowledge within the meaning of that expression in the section. I believe that the power given by this section of the Act to award further damages has been exercised in one case only in the immense number of cases in which, since the passing of this section, amendments must

(*d*) *Lawrence* v. *Perry*, 1885, 2 R. P. C. 180; Griff. P. C. at p. 148.

(*e*) See *The British United Shoe Machinery Co.* v. *A. Fussel & Co.*, 1908, 25 R. P. C. 368.

Any reference be made to unamended Spec. or to
reasons for amendment. Burke v Perfecta Roto
XLI R.P.C. 463.

have been allowed and actions have been brought upon the amended patents."

The effect of sects. 18—20 of the Act of 1883 is summed up in the judgment of A. L. Smith, J., in *Re Hall and Others* (1888, 5 R. P. C. at p. 312): "Sect. 18 gives power to a patentee, when he finds out the blunder in the specification himself, to seek leave to amend his specification by way of disclaimer, correction, or explanation, and he can go *proprio motu* to the Comptroller, and say, 'I want to amend the blunder I have got in my specification as regards disclaimer, correction, or explanation.' Then there are a series of sub-sections showing what the Comptroller is to do; how notice is to be given; what has to be done, and how other parties may come in and object; and the last sub-section, it seems to me, is most natural: 'The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.' That means this, that where a patent is in litigation he should not go behind the back of the other party and get these amendments and set himself quite right. . . . What would happen if that had remained there? After litigation had been commenced, if there had been no section 19, the patentee, as soon as the writ was issued, would be fixed, no matter what small technical blunder there might be in his specification. But what the legislature says is this—and I read sect. 19 as a proviso to sect. 18—'Provided always that a judge or the Court may give liberty,' but only liberty . . . to the patentee to apply at the Patent Office for leave to amend his specification by way of disclaimer."

CHAPTER X.

DEVOLUTION, ASSIGNMENT AND LICENSES.

We have seen that a "**patentee**" is "the person for the time being entitled to the benefit of a patent." This includes the first inventor and any person or persons in whom the patent may have become vested by operation of law or by assignment.

Devolution on death.

Devolution.—The property of a patent passes, **by operation of law,** when the patentee dies or becomes **a bankrupt.** Upon the **death of** a patentee his interest in the property passes to his executors or administrators, as the case may be, in the like manner to the rest of his personal estate. Any step which in the Act is required to be taken by the patentee may be taken by the executor or administrator, and sect. 43 of the Act provides that—" (1) *if the person claiming to be inventor 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.*" This undoubtedly, seeing the terms of the grant itself, means his legal **personal representative** (*a*).

Death of co-grantee.

Prior to the Act of 1907, if one of two co-patentees died, his interest passed to the survivor, unless their relations had been modified by contract. By sect. 37, however, it is provided as follows as regards patents granted to two or more persons jointly after January 1, 1908:—

As to grants after January, 1908.

" *Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a license without their consent, and if any such*

(*a*) See *Edmund's Patent*, Griff. P. C. 281.

person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate" (*b*). As regards patents granted before the Act the law will remain unchanged.

As to grants after January 1st, 1908.

Some letters patent of the Crown (not for inventions) have a limitation to heirs or heirs male; such, for instance, as patents of nobility.

If the patentee becomes **bankrupt** the property in the patent will pass to his receiver, trustee, or assignee in bankruptcy (*c*), and a patent granted to a bankrupt prior to his discharge will vest in the trustee in bankruptcy (*d*). The persons in whom the patent vests by reason of bankruptcy, are placed in all respects in the position of the original patentee, and may sue in respect of infringements (*e*).

Bankruptcy.

Where a patentee **dies intestate** and leaving no heirs, his patent, together with the rest of his property, will **vest in the Crown.** And the same result will occur if a limited liability company be dissolved without having assigned the patent (*f*). An interesting question arises as to whether **merger** would take place, the patent franchise being re-absorbed by the Crown (*g*). If this were so the Crown would have no power to enforce a patent, which no longer existed as against third parties, and the monopoly would have come to an end, as is the case where a patent is surrendered under sect. 26, sub-sect. 3 (*h*). In any case it is essential for a purchaser of a patent from a company in liquidation to obtain an assignment from the liquidator before the company is dissolved.

Dissolution of limited company.

Merger.

The rights conferred by letters patent being of an incorporeal nature, it would appear that a patent **cannot be seized by the sheriff** under a writ of *fi. fa.* (*i*). The proper course is to apply

Not seizable by sheriff under fi. fa.

(*b*) As to the right of each joint grantee to sue for infringement, see p. 198.

(*c*) *Hesse* v. *Stevenson*, 1803, 3 B. & P. 565. See also *Bloxam* v. *Elsee*, 9 D. & R. 215; *McAlpine* v. *Mangnall*, 1846, 15 L. J. C. P. 298.

(*d*) *Hesse* v. *Stevenson*, 1803, 3 B. & P. 565.

(*e*) *Bloxam* v. *Elsee*, 9 D. & R. 215.

(*f*) *In re Taylor's Agreement Trusts*, 1904, 2 Ch. 737; 21 R. P. C. 713. See also *In re Higginson and Dean*, 1899, 1 Q. B. 325.

(*g*) See *In re Taylor's Agreement Trusts*, supra.

(*h*) See Chap. XII.

(*i*) See judgment of Farwell, J., in *British Mutoscope and Biograph*

for the appointment of a receiver with power to sell the letters patent and notify the Comptroller of the appointment and apply for the same to be registered.

ASSIGNMENT.

Assignment.

Assignment.—Patent rights may be transferred by absolute assignment of the whole of the patent, or by absolute assignment of the patent right for a limited area, or by assignment by way of mortgage, or by the grant of licenses.

The right of the patentee to assign the exclusive right which has been granted to him is recognised in the patent itself in the recital " . . . the said inventor (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee). . . ."

Agreement to assign.

An assignment must be by deed to convey the legal estate (*k*), but a parol agreement to assign will be specifically enforceable in equity. An agreement to assign will depend upon the ordinary rules relating to contract as to specific performance, and consideration, etc. It does not alter the proprietorship of a patent, but it gives the right in equity to have the proprietorship altered in law (*l*); and this is so even when the patent was not at the date of the contract actually taken out by the vendor, provided, at least, that he was then entitled to make an application for the same (*m*). The usual conditions of an equitable assignment will apply, and a legal assignee without notice may claim priority (*n*).

Equities.

The assignment of patent rights to a company is usually preceded by an agreement between the patentee and the promoters, by which the latter agree to procure incorporation of the future company and the execution by the company of a scheduled form of contract with the patentee, by which the

Co. v. *Horner*, 1901, 18 R. P. C. at p. 179.

(*k*) Co. Lit. 9 b, 172 a; *Stewart* v. *Casey*, 1892, L. R. 1 Ch. 113; 9 R. P. C. 9.

(*l*) Bowen, L.J., in *Stewart* v. *Casey*, 1892, L. R. 1 Ch. at p. 116.

(*m*) *Cogent* v. *Gibson*, 33 Beav. 557.

(*n*) *E.g.* as in *Wapshare Tube Co., Ltd.* v. *Hyde Imperial Rubber Co.*, 1901, 18 R. P. C. 374, and see p. 216, post.

patentee shall agree to assign the letters patent to the company. The assignment of the patent to the company usually takes place after the payment of the purchase price.

Where the patent has not been granted at the date of the agreement to assign, a clause is inserted by which the vendor agrees to take all necessary steps to obtain it.

After an assignment by deed has been executed the assignee becomes "the patentee" within the definition of the Act, and his rights against the public, including the assignor unless specially limited by the terms of the assignment, are the same as those which the assignor had, and the latter may be restrained from infringing.

Notice of previous licenses.

An **assignee with notice of previous licenses** takes subject to those licenses, otherwise he is not bound by them, and may restrain the persons purporting to manufacture under them. Consequently it is of great importance that licenses should be immediately registered, but a licensee who has an express notice of a prior equitable assignment of the patent may be restrained from using the invention by the assignee even though the registration of the assignment is subsequent to the registration of the license (*o*).

Where an assignee of a patent covenants with the assignor for himself and his assigns that he will work the patent and pay certain royalties thereon to the assignor, a **subsequent assignee with notice** takes the patent subject to those covenants, as was said by Jessel, M.R., in *Werderman* v. *Société Générale d'Electricité* (1881, 19 C. D. at p. 252): "It is a part of the bargain that the patent shall be worked in a particular way and the profits be disposed of in a particular way, and no one taking with notice of that bargain can avoid the liability." It must be remembered that in such a case there is no privity of contract between the assignor and the second assignee, but the rights of the assignor are analogous to a vendor's lien, and the second assignee cannot hold the rights which he has acquired without also fulfilling the obligations which may be said to attach to those rights, and consequently the terms of the original assign-

(*o*) *Hassall* v. *Wright*, 1870, L. R. 10 Eq. 509; *The New Ixion Tyre and Cycle Co.* v. *Spilsbury*, 1898, 2 Ch. 484.

ment become a matter of great importance. In *Dansk Rekylriffel Syndikat Akticselskab* v. *Snell* (1908, 2 Ch. at p. 136), Neville, J., said: "The obligation to fulfil the terms of the agreement, being with regard to the assignees not personal, but attached to the property which they acquired with notice of the terms upon which it was held by their assignor, disables them from holding the property without fulfilling the terms. It appears to me that such an interest of the vendor, if not properly described as a vendor's lien, is closely analogous to it. The question involved is whether, upon the true construction of the original assignment, it was intended that the vendor should retain a charge upon the property, or that he should part with the property completely, looking solely to the personal liability of the purchaser to pay the consideration" (*p*).

Covenants not implied to pay renewal fees.

Unless it be specially so provided the assignment does not *per se* cast on either party the obligation of maintaining the patent by paying the fees (*q*).

Nor to work invention.

And by analogy there is no implied obligation to work the patented invention in this country to an extent necessary to avoid revocation under sect. 27 of the Act of 1907. Express covenants should be entered into for this purpose (*r*).

Assignment of part of patent.

There may be an assignment of a distinct part of a patent right, but now that patents are not issued for more than one invention this form is seldom required. An assignee of a part is entitled to sue for an infringement without joining the persons who are interested in the remaining part or parts (*s*).

Mortgagee cannot sue.

A mortgagee, although an assignee, is not entitled to sue infringers. This right remains vested in the mortgagor as the "patentee" (*t*).

Rights of co-patentees inter se.

Where a grant of letters patent has been made to two or more persons, or has been assigned by the original patentee to two or more persons, each of the co-grantees or co-assignees has the right to use the invention for his own profit without

(*p*) See also *Bagot Pneumatic Tyre Co.* v. *Clipper Pneumatic Tyre Co.*, 1901, 1 Ch. 157.

(*q*) *Re Railway and Electrical Appliance Co.*, 1888, L. R. 38 C. D. 597.

(*r*) See Appendix.

(*s*) *Dunnicliffe* v. *Mallett*, 1859, 7 C. B. N. S. 209; 29 L. J. C. P. 70.

(*t*) *Van Gelder, Apsimon & Co.* v. *Sowerby Bridge Co.*, 1890, 7 R. P. C. 208

incurring the liability to account to his co-owners for the profits which he may make. In *Steers* v. *Rogers* (1893, 10 R. P. C. at p. 251), Lord Herschell, in delivering the judgment of the House of Lords, said: "Letters patent do not give the patentee any right to use the invention; they do not confer a right to manufacture according to his invention. That is a right which he would have equally effectually if there were no letters patent at all; only in that case all the world would equally have the right. What the letters patent confer is the right to exclude others from manufacturing in a particular way, and using a particular invention. When that is borne in mind it appears to me impossible to hold, under these circumstances, that where there are several patentees, either of them, if he uses the patent, can be called upon by the others to pay to them a portion of the profits which he makes by that manufacture, because they are all of them entitled, or perhaps any of them entitled, to prevent the rest of the world from using it."

The **rights of co-owners** *inter se*, prior to the Act of 1907, were summed up by Lindley, L.J., in his book on Partnership (*u*): "In the case of a patent belonging to several persons in common, each co-owner can assign his share, and sue for an infringement (*x*); and can also work the patent himself, and give licenses to work it, and sue for royalties payable to him for its use (*y*); and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licenses" (*z*). But the mutual obligations of co-owners as to the grant of licenses have been placed beyond doubt by sect. 37 of the Act of 1907: "*Where, after the commencement of this Act, a patent is granted to two or more*

(*u*) 5th ed. p. 62.

(*x*) *Dunnicliffe* v. *Mallett*, 1859, 7 C. B. N. S. 209; *Dent* v. *Turpin*, 1861, 2 J. & H. 139; 30 L. J. Ch. 495; *Sheehan* v. *Great Eastern Railway*, 1881, L. R. 16 Ch. D. 59, 63.

(*y*) *Sheehan* v. *Great Eastern Railway*, 1881, L. R. 16 Ch. D. 59.

(*z*) *Mathers* v. *Green*, 1865, L. R. 1 Ch. 29; *Russell's Patent*, 1857, 2 De G. & J. 130.

persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a license without their consent, and if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate."

It is to be noted that this only applies to patents granted after January 1st, 1908.

Co-owner may sue.

The grounds upon which one co-owner can sue for infringement of the patent without joining the other co-owners are clearly set out in the judgment of Page-Wood, V.-C., in *Dent* v. *Turpin* (1861, 30 L. J. Ch. 496). The law as therein expressed is that although he may sue alone, the Court will not grant a decree for further relief than that which is purely personal to himself, that is to say, he may have an injunction against the infringer, but he will only receive that portion of the damages to which the Court may think he is entitled; this would seem to show that he is only entitled to such portion of the damages as bears a relation to his interest in the patent. And it would appear that the other co-owners should be joined if possible in order that an account may be taken of the amount due to all the co-owners, without having recourse to a series of actions (*a*).

In *Smith* v. *L. & N. W. Ry. Co.* (1853, 8 El. & B. 74), it was decided that the right of co-owners to damages for infringement was a joint right, and on the death of one the survivor was entitled to recover the whole. It is submitted that the effect of sect. 37 is to overrule this decision, for a right to damages is certainly a "beneficial interest in the patent," and if this be so, the right to the share of the amount recovered would accrue to the personal representatives of the deceased.

Partnership.

Where a sole patentee worked the patent in partnership with another for some years, during which time they were extensively advertised as joint patentees, it was held that the

(*a*) See *Bergmann* v. *Macmillan*, 1881, 17 Ch. D. 423.

partner of the sole patentee thereby acquired such an interest in the patent as to enable him to work it independently after the partnership had expired (*b*), but this would not be the case if it were a term of the partnership that the patent rights in the invention should belong exclusively to one of them (*c*).

Where a grant is made to more than one person it is usual to divide the interests, as the power which each grantee has to work the invention himself without accounting is highly inconvenient. Provision may thus be made for accounts, granting licenses, survivorship, and many other matters.

A patent may be vested in trustees, who may sue for infringement in their own names, subject to the power of the Court to order the cestuis que trust to be joined (*d*).

Covenants for improvements and in restraint of trade.

Covenants for improvements and in restraint of trade.—An agreement by the vendor of a patent to assign to the purchaser all patent rights that he may subsequently acquire of a like nature to the patent then sold is not contrary to public policy and will be upheld. And a covenant by the vendor not to make or sell the invention at all, nor the product obtained by the invented process, even though obtained in a different manner, is good. As Jessel, M.R., said in *Printing and Numerical Registering Co.* v. *Sampson* (1875, L. R. 19 Eq. at p. 464), the purchasers are entitled to say: "We cannot buy on any other terms because otherwise we are exposed to the instantaneous, or almost instantaneous, competition with the inventor with the benefit of his previous experience." As in all contracts which involve the restraint of trade, their validity depends upon whether they extend further than is necessary to protect the reasonable rights of the other party under the particular circumstances in question (*e*).

Should be carefully drawn.

Covenants for the assignment of future improvements require to be very carefully drawn. The ambit of the assignee's rights depends entirely upon the construction of the contract (*f*).

(*b*) *Kenny's Patent Button-Holeing Co.* v. *Somervell*, 1878, 38 L. T. 878; 26 W. R. 786.

(*c*) See *Axmann* v. *Lund*, 1874, L. R. 18 Eq. at p. 336.

(*d*) R.S.C. Order XVI., rule 8.

(*e*) See *Nordenfelt* v. *The Maxim Nordenfelt, &c., Co.*, 1894, A. C. 535; *Mouchel* v. *Cubitt & Co.*, 1907, 24 R. P. C. 194.

(*f*) *Valveless Gas Engine Co.* v. *Day*, 1899, 16 R. P. C. 97.

In some cases it may be that only such improvements as would involve an infringement of the original patent may be intended; in others it may be desired to secure for the assignee any further inventions of the assignor relating to the particular art. As a rule, if the term "improvements" only is used, it is submitted that what is meant is such an improvement as would be an infringement of the original patent (*g*). This view is supported by the use of the word in sect. 19, sub-sect. 1, of the Act of 1907, which deals with "patents of addition."

Estoppel.

Estoppel.—Having assigned a patent, the original patentee cannot manufacture the patented article; should he do so, and an action for infringement be brought against him by his assignee, he may not set up the defence that the patent is invalid; he is **estopped by his deed** (*h*), that is, by the deed of assignment, but when the assignment is by operation of law there is no such estoppel. In *Cropper* v. *Smith* (1884, L. R. 26 Ch. D. 700; 2 R. P. C. 17), letters patent for improvements in lace machines were granted to H. in 1873, who in 1877 went into liquidation, and the patent was sold by the trustee to the plaintiffs. H. afterwards entered into partnership with S., and this action was brought against S. and H. to restrain them from infringing the patent; held that H. was not estopped from disputing the validity of the patent either by matter of record, on the ground that the letters patent were of record; or by deed, by reason of the specification being under his seal; or by matter *in pais*, on the ground of the statements in his petition to the Crown, there being nothing to show that the plaintiffs bought on the faith of those statements. (But see Bankruptcy Act, 1883, s. 50, sub-s. 5.) It is probable that there is estoppel by record between the Crown and the grantee of letters patent (*i*), but this would only be against the subject, since **no estoppel operates against the Crown.**

(*g*) *Davies* v. *Curtis & Harvey, Ltd.*, 1903, 20 R. P. C. 561. See *Linotype & Machinery, Ltd.* v. *Hopkins*, 1908, 25 R. P. C. 349, 665.

(*h*) *Bowman* v. *Taylor*, 1834, 2 A. & E. 278; *Franklin Hocking* v. *Hocking*, 1889, 6 R. P. C. 69; and see 1 W. P. C. 290—295.

(*i*) Per Fry, L. J., L. R. 26 Ch.D. at p. 712.

Upon **assignment** of a patent **without a warranty** the assignee may not, in an action upon the contract for the purchase price, set up the invalidity of the patent as a defence, since there is no implied warranty of validity (*k*); so that the question to be decided in each case is: "Did the defendants buy a good and indefeasible patent right, or was the contract merely to place the defendants in the same situation as the plaintiff was in with reference to the alleged patent?" (*l*). An express covenant for the validity of the patent will, of course, remove the estoppel, and the assignee may rely on this in answer to an action for the purchase-money (*m*).

Warranty of validity.

Where the plaintiff purports to assign the **exclusive right of selling** certain things for the manufacture of which a patent had been obtained, there is in such case an implied warranty that the patent is a valid one, since otherwise it would be impossible to assign such exclusive right (*n*).

It may be here noted that upon the sale of an article there is no implied warranty that it is not an infringement of any existing patent (*o*), and it may from this be inferred that, in an assignment of a patent or a license under a patent, there is no implied warranty that the manufacture or sale of articles made under the patent will not infringe any other patent. On the other hand, if the assignor or licensor concealed the fact, it being within his knowledge, it is possible that the contract might be rescinded on the ground of fraud.

No implied warranty against infringement.

An assignment of patent rights in a **partnership** dissolution deed will estop the retiring partner from subsequently setting up the invalidity of the patent by way of defence to an action brought by his late partners (*p*). But where the plaintiff and defendant had been partners, and had worked

(*k*) *Hall* v. *Conder*, 1857, 26 L. J. C. P. 138; 2 C. B. N. S. 22; *Smith* v. *Buckingham*, 1870, 21 L. T. N. S. 819; *Liardet* v. *Hammond Electric Light Co.*, 1883, 31 W. R. 710.

(*l*) Per Cresswell, J., in *Hall* v. *Conder*, 1857, 26 L. J. C. P. at p. 143 a.

(*m*) *E.g.* as in *Nadel* v. *Martin*, 1903, 20 R. P. C. 721; 23 R. P. C. 41; *Henderson* v. *Shiels*, 1907, 24 R. P. C. 108.

(*n*) *Chanter* v. *Leese*, 1838, 5 M. & W. 698; *Hall* v. *Conder*, 1857, 26 L. J. C. P. at p. 143.

(*o*) *Montforts* v. *Marsden*, 1895, 12 R. P. C. 266.

(*p*) *Chambers* v. *Critchley*, 1864, 33 Beav. 374.

as such the defendant's patent, there being no deed between the plaintiff and defendant which inferred the validity of the patent, it was held that plaintiff was not estopped from denying the validity of the patent (*q*). And where partners are joined as defendants in an action for infringement, and one is assignor of the patent, the other is not debarred from setting up the pleas of invalidity (*r*).

An **assignor** of a patent **cannot be restrained from giving evidence** in an action for infringement brought by the assignee against a third party, although such evidence should tend to prove that the patent is in fact bad (*s*). And he is at liberty to show that the ambit of the claims of the patent assigned is not as wide as the assignee alleges (*t*).

LICENSES.

Licenses.

Licenses differ from assignments, in that the patentee granting a license does not part with his whole interest, but grants merely a right to use the invention for the whole term or any portion of the whole term, that is merely a right to do that which without a license could not be done except by violating the monopoly granted to and still vested in the licensor (*u*).

Licensee cannot sue.

A licensee, whether under a general or an exclusive license, cannot sue infringers (*x*); the person in whom the legal interest in the patent is vested must be joined, and it is usual to insert covenants by which the licensor agrees to proceed against infringers or to allow his name to be joined.

Licenses may be voluntarily granted by the patentee, or they may be compulsory under an order of the Court (*y*). In this chapter we shall deal with voluntary licenses only.

An **exclusive license** grants the sole right to put the invention into practice, and the licensor covenants not to grant licenses

(*q*) *Axmann* v. *Lund*, 1874, L. R. 18 Eq. 330; 22 W. R. 789.

(*r*) *Heugh* v. *Chamberlain*, 1877, 25 W. R. 742.

(*s*) *London and Leicester Hosiery Co.* v. *Griswold*, 1886, 3 R. P. C. 251.

(*t*) *Hocking* v. *Hocking*, 1889, 6 R. P. C. 69.

(*u*) *Heap* v. *Hartley*, 1889, 6 R. P. C. at p. 499.

(*x*) *Heap* v. *Hartley*, 1889, 6 R. P. C. 495.

(*y*) See Chap. XII.

to any other person during the continuation of the license; and unless he reserves to himself a right to manufacture he may be restrained from so doing by his licensee.

A **general license** leaves to the licensor the power to grant other licenses in respect of the same invention.

A **limited license** may contain restrictions as to time, place, or manner of use of the invention.

Form of license.

It would appear from the words of the prohibition contained in the grant—" without the consent, license or agreement of the said patentee in writing under his hand and seal "—that licenses should be under seal; but at the end of the patent occur the words, " but nothing herein contained shall prevent the granting of licenses in such manner and for such consideration as they may by law be granted." Therefore, provided it can be proved that there is an agreement to grant a license, no matter how made, it will be acted upon, and neither party can be excused on the ground that it is not under seal (*z*).

An agreement to grant a license for a fixed term may be specifically enforced (*a*). But an agreement to grant a license at will could not be enforced.

Stamps.

A mere license in writing does not require a stamp, but if it amounts to an agreement to pay by royalties or otherwise a stamp is required (*b*). A license by deed requires a ten shilling stamp and an ad valorem stamp on the consideration money, or the minimum royalty prescribed, and this is the case even though the license is to work the invention abroad under a foreign patent (*c*).

Ambit of license: exercising, using, making, vending.

By the prohibition the public are to refrain from making, using or vending. These terms require examination, as they have not the same meaning. A license to " use and exercise "

(*z*) *Chanter* v. *Dewhurst*, 1844, 12 M. & W. 823; 13 L. J. Ex. 198; *Chanter* v. *Johnson*, 1845, 14 M. & W. 408; *Crossley* v. *Dixon*, 1863, 10 H. L. C. 293; *Postcard Automatic Supply Co.* v. *Samuel*, 1889, 6 R. P. C. 560; *Tweedale* v. *Howard*, 1896, 13 R. P. C. 522.

(*a*) *E.g.* as in *Brake* v. *Radermacher*, 1903, 20 R. P. C. 631.

(*b*) *Wilson* v. *Union Oil Mills*, 1892, 9 R. P. C. at p. 62.

(*c*) *Smelting Co. of Australia* v. *Commissioners of Inland Revenue*, 1897, 1 Q. B. 175.

conveys the fullest rights, including that of importation (*d*). A license to make does not imply a license to use or vend (*e*). But a license to make and vend will imply a license to the purchaser to use and vend (*f*).

An inventor, by himself or his agent, unreservedly selling the patented article abroad cannot restrain the importation and sale of articles so sold in this country (*g*). But the assignee of the English patent could restrain the importation of articles sold abroad, prior to the assignment, by a person who had been the owner of the English patent (*h*); and a license under a foreign patent to manufacture abroad and sell abroad does not imply a license under the corresponding British patent to import articles so manufactured or sold into this country (*i*). And if the patentee assigned his English patent at a date later than that of the importation of articles sold abroad under the patentee's foreign patent, the assignee could not restrain their continued use, since the sale by the patentee would have implied a license to use and sell as wide as his own right at the date of the sale.

Sub-licensing.

Whether a **licensee may sub-license or assign** depends upon the terms of the contract, but in the absence of such terms the license would appear to be personal only (*k*). Should the patentee accept royalties from the person acting with the authority of the licensee, he will be estopped from denying that the license was assignable (*l*).

No implied covenant to pay fees.

It is not an implied term of a license that the patentee will maintain the patent in force by paying the fees; express covenants should be entered into on this point (*m*), and a

(*d*) *Dunlop Pneumatic Tyre Co.* v. *North British Rubber Co.*, 1904, 21 R. P. C. 161.

(*e*) *Basset* v. *Graydon*, 1897, 14 R. P. C. 701.

(*f*) *Thomas* v. *Hunt*, 1864, 17 C. B. N. S. 183; *Badische Anilin und Soda Fabrik* v. *Isler*, 1906, 1 Ch. 605; 1906, 2 Ch. 443.

(*g*) *Betts* v. *Wilmott*, 1870, L. R. 6 Ch. 239.

(*h*) Ibid. at p. 244.

(*i*) *Société Anonyme des Manufactures de Glaces* v. *Tilghmann's Patent Sand Blast Co.*, 1883, L. R. 25 Ch. D. at p. 9.

(*k*) *Lawson* v. *Donald Macpherson & Co.*, 1897, 14 R. P. C. 696.

(*l*) Ibid.

(*m*) *Mills* v. *Carson*, 1893, 10 R. P. C. 9; see also *Ward* v. *Livesey*, 1888, 5 R. P. C. 102; *Cutlan* v. *Dawson*, 1897, 14 R. P. C. 249 and Appendix.

covenant to pay renewal fees cannot be implied from a covenant for quiet enjoyment (*n*).

Nor to work invention.

Similarly no covenant can be implied binding the licensee to manufacture in this country to an extent necessary to avoid revocation under sect. 27 of the Act of 1907 (*q.v.*), and express covenants to this effect should be inserted in an exclusive license (*o*).

Power to revoke license.

Licenses usually contain clauses which empower either party to revoke the arrangement after due notice; but, apart from such a clause, the question of the power of revocation by the licensor gives rise to some difficulty. It is quite clear that a mere license without a contract may be revoked at will. It is clear also that revocation of a license granted as the consideration in a contract will give a right to an action for damages for breach of that contract. But will the licensee be restrained from manufacturing after the revocation? It would appear from the judgment of Lindley, L.J., in *Guyot* v. *Thompson* (1894, 11 R. P. C. at p. 552), that the general intention of the parties must be looked to, and that where there are mutual obligations to be fulfilled, or, in other words, where the granting of the license is part of a contract, the licensor may not revoke. Moreover, it has been noticed above (*p*) that an agreement to grant a license for a fixed term may be specifically enforced, but an agreement to grant a license at will could not be enforced.

Estoppel.

Estoppel.—Unless the licensor has covenanted for the validity of the patent in express terms, the licensee will be estopped from alleging its invalidity in answer to an action for royalties.

Express warranty of validity.

An express warranty of validity will, of course, negative estoppel (*q*).

In *Bowman* v. *Taylor and Others* (1834, 2 A. & E. 278; 1 W. P. C. 292), the plaintiff sued the defendants for the non-payment of certain royalties due from the defendants to the plaintiff under a license under seal for the use of the plaintiff's

(*n*) *In re Railway and Electric Appliances Co.*, 1888, 38 Ch. D. 597.

(*o*) See Appendix.

(*p*) P. 203.

(*q*) *Wilson* v. *Union Oil Mills Co., Ltd.*, 1892, 9 R. P. C. 57; *Mills* v. *Carson*, 1893, 10 R. P. C. at p. 17.

patent. The defendants defended on the grounds (1) that the invention was not a new invention; (2) that the plaintiff was not the first and true inventor; (3) that the specification was not sufficient—pleas which in effect endeavoured to put in issue the validity of the plaintiff's title. Upon demurrer, Taunton, J., said (2 A. & E. at p. 291): "The law of estoppel is not so unjust or absurd as it has been too much the custom to represent. The principle is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts, he shall not be permitted to deny any matter which he has so asserted. The question here is, whether there is a matter so asserted by the defendant under his hand and seal that he shall not be permitted to deny it in pleading. It is said that the allegation in the deed is made by way of recital, but I do not see that a statement such as this is the less positive because it is introduced by a 'whereas.' Then the defendant has pleaded that the supposed invention in the declaration and letters patent mentioned was not nor is a new invention. These words 'was not nor is a new invention' must be understood in the same sense as the words 'had invented' in the recital of the deed set out in the declaration, and must refer to the time of granting the patent, and if the invention could not then be termed a new invention, it could not, I think, have been truly said in the deed, that the plaintiff 'had invented' the improvements in the sense in which the deed uses the words. Then the plea directly negatives the deed, and comes within the rule that a party shall not deny what he has asserted by his solemn instrument under hand and seal." The learned judge then proceeds to distinguish *Hayne* v. *Maltby* (3 T. R. 438), but for some reason does not refer to the element of fraud in that case, which certainly would take it out of the operation of the doctrine of estoppel.

In the case of *Lawes* v. *Purser* (1856, 6 E. & B. 930), the license was not under seal, and the licensee was held to be estopped from alleging the invalidity of the patent, and in *Crossley* v. *Dixon* (1863, 10 H. L. C. 293) the same principle was held to apply in the case of a mere verbal license.

In *Adie* v. *Clark* (L. R. 3 Ch. D. at p. 144), James, L.J.,

said: "A licensee cannot under any pretence whatever bring his licensor into litigation as to the novelty of any part of the patent." This case was afterwards affirmed in the House of Lords (L. R. 2 A. C. 423). But it appears that if the license has been determined prior to the expiration of the term of the patent the ex-licensees may contest the validity of the patent, notwithstanding the covenants or recitals in the license; for example, in the case of an agreement between a patentee and a manufacturer to the effect that the manufacturer shall pay to the patentee a fixed royalty on each patented article made, there being no stipulation as to the length of time during which the arrangement shall last, and no annual minimum, it is within the power of the licensee to determine the license, and in answer to an action for damages on any articles made by him after such determination, but not before, he may plead the invalidity of the patent (*r*).

Where, however, the license was for a specified term of four years, and the patent was revoked within that period, the licensees were nevertheless held liable for royalties on the patented process during the remainder of the term of the license (*s*).

In *Cheetham* v. *Nuthall* (1893, 10 R. P. C. 321), it was provided that the license should determine if the patent should be declared invalid: in an action brought by the licensor against a third party for infringement, the patent was held to be invalid, but this judgment was reversed by consent; the defendant after due notice continued to work under his license, and it was held that he was still liable to pay royalties for the use of the invention.

Mills v. *Carson* (1893, 10 R. P. C. 9) was an action for royalties due under an indenture made between the patentee *W. Notley* of the one part, and the defendants *J. A. Carson* and *D. Coleman Defries* of the other part, whereby an exclusive license to use the invention was granted to the defendants. One of the terms of the agreement was that the patentee or

(*r*) *Crossley* v. *Dixon*, 1863, 10 H. L. C. 293; *Redyes* v. *Mulliner*, 1893, 10 R. P. C. 21.

(*s*) *African Gold Recovery Co., Ltd.* v. *Sheba Gold Mining Co., Ltd.*, 1897, 14 R. P. C. 660.

his assigns would, at the request of the defendants, take proceedings against any person infringing the patent; and it was further agreed that "if the said *W. Notley* should at any time omit or refuse to take such proceedings as aforesaid, and if the said letters patent should become void or ineffectual by reason of any such omission or refusal on the part of the said *W. Notley*, or *by reason of the said invention not being novel*, or being an infringement of other letters patent, then the payment of the said annual sum under the indenture should cease and determine." Relying upon this condition, the defendants set up the defence that the invention was not new; it was held that they were estopped from doing so, and that the words, "by reason of the said invention not being novel," meant, if it was proved not to be novel in an action brought for infringement by the patentee at the instigation of the defendants.

But where the defendant took a license from the plaintiff to work his invention "**subject to the result of an inquiry into the validity of the patent,**" and after the expiration of six months refused to continue to work the plaintiff's process on the ground that the patent was bad, it was held, in an action for royalties under the agreement, that it was open to the defendant to contest the validity of the plaintiff's patent (*t*).

Licensee may contend for limited construction.

The licensee may refer to the state of public knowledge at the date of the patent **for the purpose of showing what is the true ambit of the claim** (*u*), and he may, following the analogy of lessor and lessee, show that the patent in question has in fact expired (*x*).

Fraud negatives estoppel.

Fraud is practically the only plea which a licensee can put forward in an action brought against him for the recovery of royalties, but this must be distinctly pleaded (*y*); beyond that

(*t*) *Wilson* v. *Union Oil Mills Co.*, 1892, 9 R. P. C. 57.

(*u*) *Adie* v. *Clark*, 1876, L. R. 2 A. C. 423; *Young and Beilby* v. *Hermand Oil Co., Ltd.*, 1892, 9 R. P. C. 373; see also *Neil and Others* v. *Neil*, 1903, 20 R. P. C. at p. 223; *Davies* v. *Curtis & Harvey*, 1903, 20 R. P. C. 561.

(*x*) *Muirhead* v. *Commercial Cable Co.*, 1894, 11 R. P. C. 317; 12 R. P. C. 39.

(*y*) *McDougall* v. *Partington*, 1890, 7 R. P. C. at p. 223; *Ashworth* v. *Law*, 1890, 7 R. P. C. at p. 234.

the only reply that is left to the licensee is that he has not worked the patent in question (*z*).

Where the plaintiff, **fraudulently asserting that he had a right to a patent**, induced the defendant to come to terms with him for a license to use that patent, the defendant, in an action upon that agreement, is not estopped from alleging the want of title in the plaintiff as a defence (*a*). But it would be otherwise in the absence of fraud and where both parties are innocent; in that case neither the assignee nor licensee would be allowed to set up as a defence the bad title of the assignor or licensor (*b*).

An **assignee of a share of the profits** is entitled to an account of the profits from the person by whom they are payable; but the account should be taken once for all in the presence of all the persons interested; the licensee is not bound to account to the assignor and to each assignee of a share separately (*c*).

As to licenses and assignments to a Government department, see p. 13, *ante*.

LIMITED LICENSES.

Limited licenses.

Some observations are necessary upon what are known as "**limited licenses**," and the effect of the Act of 1907 in restricting the power of the patentee to impose terms of limitation. It had been decided that a "patentee had a right, not merely by sale without reserve to give an unlimited right to the purchaser to use, and thereby to make in effect a grant from which he could not derogate, but might attach to it conditions, and if those conditions were broken, then there was no license, because the license was bound up with the observance of the conditions" (*d*). Consequently the patentee might license the user of his patented article, but might attach the condition that it was to be used only in connection with some other article sold by him. In the cases of *The Incandescent Gas*

(*z*) *Clark* v. *Adie*, L. R. 2 App. Cas. 423, 435.

(*a*) *Hayne* v. *Maltby*, 3 T. R. 438.

(*b*) *Taylor* v *are*, 1 W. P. C. 292.

(*c*) *Berymann* v. *Macmillan*, 1881, L. R. 17 Ch. D. 423.

(*d*) Kennedy, J., in *The Incandescent Gas Light Co., Ltd.* v. *Brogden*, 1899, 16 R. P. C.

Light Co., Ltd. v. *Cantelo* (1895, 12 R. P. C. 262), and *The Incandescent Gas Light Co., Ltd.* v. *Brogden* (1899, 16 R. P. C. 179), the article the subject of the patent was an incandescent mantle, and the condition imposed was that the mantle was to be used only upon gas burners supplied by the patentees, and upon no other burners. It was held that such conditions might lawfully be imposed, and that the license to use was to that extent a limited one. It has been pointed out above (p. 204) that the sale of an article by the patentee or by his agent implies a full license to use and to resell. Consequently it was necessary for the patentee in an action against a purchaser for infringement by breach of such conditions to prove that the license was limited, and that the terms thereof were communicated to the purchaser, otherwise he would not be bound by them. In the first of the cases above cited the agent did not bring the limitation to the notice of the purchaser; in the second case the agent did communicate the limitation to the purchaser. In the case, however, of the **sale by the patentee to a licensee with a limited license, a purchaser from such licensee** (as opposed to an agent) **is bound** by the limitations in the license, whether he knew of them or not. This point was explained by Buckley, J., in *The Badische Anilin und Soda Fabrik* v. *Isler* (1906, 1 Ch. at p. 610): "If the patentee sells, imposing no restriction or condition upon his purchaser at the time of sale, he cannot impose a condition subsequently by delivery of the goods with a condition endorsed upon them or upon the package in which they are contained. Unless the purchaser knows of the condition at the time of purchase and buys subject to the condition, he has the benefit of an implied license to use free from condition. But suppose the purchaser buys, not from the patentee, but from a licensee, the patentee may have attached to his license any conditions he pleased, and if he did attach a condition, then upon principle it seems to me that nothing (so far as license as distinguished from estoppel is concerned) can turn on the question whether the purchaser from the licensee knew of the condition or not. If a person innocently uses a patented invention not knowing that there is a patent, he is none the less an infringer,

Knowledge of conditions when necessary.

and if a person innocently buys a patented invention from a licensee and uses it not knowing that there are limits on the license, I conceive that he is equally an infringer."

Abuse of limited licenses.

The device of the "limited license" was gradually developed into a machine by means of which Letters Patent for certain kinds of inventions were made to produce commercial profits independently of any royalty that might adequately have rewarded the ingenuity of the inventor or the enterprise of the capitalist. It became customary (particularly in the world of labour-saving machinery) for the patentee to lease such machinery on hire to the manufacturer, and to stipulate that, in addition to paying a royalty, the manufacturer should use in his factory no machinery of any kind other than that supplied by the patentee, and further that the manufacturer should purchase from the patentee the raw material used in connection with his factory. Another stipulation was to the effect that the leasing contract should endure between the parties for a term of years longer than that of the Letters Patent.

By sub-sect. 1 of sect. 38 of the Act of 1907 it was enacted:—

Statutory change of law.

"*It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or license to use or work, any article or process protected by a patent to insert a condition the effect of which will be*—

(a) "*to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or*

(b) "*to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;*

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy."

The definitions in clauses (a) and (b) of the kinds of conditions which are to be void are modified by sub-sect. 5, which is as follows:—

(5.) "*Nothing in this section shall*—

(a) "*affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or*

(b) "*be construed as validating any contract which would, apart from this section, be invalid; or*

(c) "*affect any right of determining a contract or condition in a contract exercisable independently of this section; or*

(d) "*affect any condition in a contract for the lease of or license to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.*"

Respects in which law remains unchanged.

The consequence of sub-sect. 1 and of par. (a) of sub-sect. 5 is that a patentee may supply patented goods on sale or hire on condition that the purchaser or hirer does not *sell* any other goods than those supplied by the patentee whether patented or not, but the purchaser or hirer may not be restricted in any way from *using* goods other than those supplied by the patentee.

The consequence of par. b of sub-sect. (1) and of par. (d) of sub-sect. 5 is to leave the right of deriving profits from the repair of the patented article in the hands of the patentee.

By par. (b) the common law rule as to contracts in restraint of trade is left untouched, and licenses limiting the price at which the patented article may be sold (*e*), or the quantities which may be sold at one time (*f*), are still valid.

Condition not necessarily invalid.

But it is most important to notice that **contracts of the kind mentioned are not invariably to be deemed invalid.** The evil that was aimed at by the statute only existed in the case of a purchaser or licensee who was practically compelled to enter into such a contract, and it was not the purpose of the section to interfere with contracts which had been voluntarily entered into by parties who had the opportunity clearly laid before them of purchasing or hiring upon different terms. Accordingly sub-section 1 concludes with this proviso :—

(*e*) See p. 246.

(*f*) See *The Badische Anilin und Soda Fabrik* v. *Isler*, 1906, 1 Ch. 605; 2 Ch. 443.

"*Provided that this sub-section shall not apply if—*

(i) "*the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or license on reasonable terms, without such conditions as aforesaid; and*

(ii) "*the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or license of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.*"

It is suggested that one way of reducing the risk of such a condition being set aside would be to recite in the agreement an alternative offer to the purchaser or hirer and to recite that the purchaser, although deeming such terms to be reasonable, nevertheless preferred to enter into the agreement as herein provided. This would at all events cast the onus of proof on to the licensee. In the event of the contract providing for compensation, such **compensation cannot be fixed in the agreement as liquidated damages**, but will be such as the arbitrator appointed by the Board of Trade may fix.

Contracts made before Act.

Contracts made before the passing of the Act are to be deemed valid **save in so far as they were invalid at Common Law**, but may be terminated, and the party terminating becomes liable to pay compensation :—

(2) "*Any contract relating to the lease of or license to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be*

liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.

(3) "*Any contract made before the passing of this Act relating to the lease of or license to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding sub-section, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.*"

Whole contract may be terminated.

It is to be noticed that the **whole contract may be terminated,** and not the condition only.

Basis of compensation.

No directions are given as to the proper basis upon which such compensation shall be fixed, and it is to be remembered that cases in which decisions have been given upon the assessment of statutory compensation have invariably been based upon the wording of the particular statute and its general intention. There is no definition of "compensation" universally applicable. In a case in which the writer of these observations recently took part, counsel on behalf of those who gave the prescribed notice sought to establish the proposition that the policy of this statute was merely to award such a sum beyond that already paid under the lease as would reasonably reward the lessors, having regard to the merit and value of the patent right, plus such a sum as would yield them a reasonable profit as manufacturers. Counsel for the lessors argued that the compensation payable should be the purchase price of an annuity for the remainder of the term during which the contract would have endured, of an annual value equal to the average annual value during the period during which the rental had actually been paid, thus taking the value of the contract **to the lessor** as the basis of compensation. The arbitrator awarded a sum less than such purchase price, but considerably more than that suggested by the lessee. As, in

accordance with custom, no reasons were given with the award, it is not possible to say what principle was followed, but the sum awarded was such as to indicate that the view contended for by the lessor was probably the correct one. Until a case is stated for the Court no definite rule can be laid down.

Sub-sect. 4 of sect. 38 is of a penal nature, and will probably effectually prevent patentees from inserting such oppressive conditions in future contracts:— **Defence in infringement action.**

"*The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.*"

It is to be noticed that the defence is available to any defendant, and is not limited to a party to the contract.

THE REGISTER.

Sect. 28 of the Act of 1907 (corresponding with sect. 23 of the Act of 1883) provides:— **The register.**

(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 licenses 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 existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act; (3) the register of patents shall be primâ facie evidence of any matters by this Act directed or authorised to be inserted therein; (4) copies of deeds, licenses and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office.*"

The practice of the Patent Office with regard to registration is regulated by rules 82 to 94 of 1908.

By sect. 66, "**There shall not be entered in any register** *kept under this Act, or be receivable by the Comptroller, any notice of* **Notice of trust not registrable.**

any trust, *express*, *implied*, *or constructive.*" Sect. 71 provides for the entry in the register, at the request of the person becoming entitled, of any assignment or transmission of interest. The person registered shall have power to deal with such interest as he has registered absolutely: "*Provided that any equities in respect of such patent or design may be enforced in like manner, as in respect of any other personal property.*"

Equities may be enforced.

Doctrine of notice.

Lindley, M.R., in *New Ixion Tyre Co.* v. *Spilsbury* (1898, 2 Ch. at p. 488; 15 R. P. C. at p. 571), said, referring to this proviso: "That lets in the whole doctrine of notice and the equitable consequences of it. That proviso cannot be cut down. When it says, 'any equities in respect of such patent,' it cannot mean registered equities. You do not want a proviso for that, because you have got that before. It means that any equitable rights in any person in respect of such patent may be enforced in like manner as in respect of any other personal property. What are they? Those rights are that they can be enforced in equity against all persons who have taken with notice."

In *In re Morsey's Patent* (1858, 25 Beav. 581), a patentee assigned half a patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a license to work and use to A. B.'s assignment was first registered:—Held that B. had **constructive notice** of A.'s rights, and an entry was ordered to be made in the register that the license referred to in B.'s assignment was the deed of assignment to A. subsequently entered.

Registration does not amount to notice to the whole world, so where the grant of an exclusive license for a district had been entered on the register, it was held that this did not by itself amount to notice so as to affect an innocent purchaser outside of that district bringing his purchase within the district in violation of the rights of the licensee. But it was also decided that the exclusive licensee had no cause of action, and this was the real reason for the dismissal of the action (*g*).

Sect. 67 deals with the inspection of registers, and the

(*g*) *Heap* v. *Hartley*, 1888, 5 R. P. C. 603; 6 R. P. C. 495.

obtaining of certified copies. By sect. 79 sealed copies are to be received in evidence.

Registrable documents.

The effect of these sections is to prohibit the entry upon the register of simple **notices** of trusts, but any other documents affecting the proprietorship of the patent, whether by creating trusts or otherwise, are not to be excluded (*h*). In *Stewart* v. *Casey* (1892, 9 R. P. C. 9) the owners of two patents employed C. about their patents and wrote to him that, in consideration of his services, they agreed to give him one-third share of the patents, to take effect from the date of the letter. The original Letters Patent were subsequently put into C.'s hands for the purpose of a sale which fell through. C. retained the Letters Patent, and caused an entry to be made on the register of patents of the above-mentioned letter. An entry was also made in the register of proprietors that C. claimed an interest in the patents under this document. It was held that the letter was properly registered, it being a document **affecting the proprietorship** of the patents, and although an assignment of a patent should be by deed, yet an agreement to assign is an equitable assignment, and consequently may be entered on the register under the section, but the documents containing **the agreement** and entered on the register **must be complete**, and, of a nature that specific performance of the agreement could be enforced, since otherwise no legal or equitable interest in the patent or proprietorship thereof would pass (*i*). For example, in *Fletcher's Patent* (1893, 10 R. P. C.) X., the owner of a patent, wrote a letter to Y. agreeing to give him an exclusive license for the duration of the patent, "provided always that you pay me a royalty, of the amount to be mutually agreed upon between us." X. and Y. subsequently disagreed. Y. contended that the royalties had been verbally agreed upon; this was disputed by X. Y. applied to register the letter. It was held that the letter was not registrable.

Agreement must be complete.

Power to amend entries.

Sect. 72 empowers the Court (High Court of Justice) to order the alteration of the registers, upon the application of

(*h*) *Stewart* v. *Casey*, 1892, 9 R. P. C. 9; see also *In re Fletcher's Patent*, 1893, 10 R. P. C. 252.

(*i*) *Fletcher's Patent*, 1893, 10 R. P. C. 252; *Haslett* v. *Hutchinson*, 1891, 8 R. P. C. 457.

persons aggrieved, and upon sufficient cause shown. The application is made by motion, and notice must be given to the Comptroller, who is entitled to appear and to be heard. The Comptroller may himself under sect. 70 correct errors in the registers which are merely of a clerical nature.

The Comptroller may refuse to enter upon the register of patents a document dated before the patent, upon the ground that it does not contain a sufficient proof of title, but it would appear that if that objection does not apply, the fact that the document is dated prior to the date of the patent is not in itself a bar to registration (*k*). Needless to say, until the patent is granted the registration cannot be effected.

Sect. 35 of the **Act of 1852**, after providing for the registration of proprietors, assignments, &c., of patents, proceeded: "Provided always, that, until such entries shall have been made, the grantee or grantees of Letters Patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such Letters Patent, and of all licenses and privileges thereby given or granted."

Necessity of registration of assignment.

It will be observed that the Acts of 1883 and 1907, quoted above, do not contain these words. Hence, it is submitted, *Chollett* v. *Hoffman* (*l*) and *Hassall* v. *Wright* (*m*), which laid down the rule that an assignee could not sue infringers unless the assignment was registered, are not applicable to the present law (*n*).

(*k*) *Parnell's Patent*, 1888, 5 R. P. C. 126.

(*l*) 1857, 7 Ell. & B. 686.

(*m*) 1870, L. R. 10 Eq. 509; 40 L. J. Ch. 145.

(*n*) See, however, the contrary view expressed by Mr. Frost in the 3rd edition of his work, Vol. II. at p. 129.

Extension under Sec 18 Act 1907 as amended
Sec 7. Act 1916. Re Brown Patent XXXVII RPC

1 Brown's Patent XXXVIII R P C 23

Re Davidson XXXVII R.P.C 145

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CHAPTER XI.

EXTENSION OF THE TERM OF A PATENT.

History of practice.

PRIOR to the year 1835 a patentee who desired an extension of the term of his patent had to apply for a private Act of Parliament, the grant by the Crown being limited to the period of fourteen years fixed by the Statute of Monopolies. By the Act 5 & 6 Will. IV. c. 83, amended by 2 & 3 Vict. c. 67 and by sects. 2 and 3 of 7 & 8 Vict. c. 69, and re-enacted by sect. 25 of the Act of 1883, the Crown was enabled to prolong the term for seven, or in exceptional cases for fourteen, years upon the advice of the Judicial Committee of the Privy Council, which was given jurisdiction to hear petitions. By sect. 18 of the Act of 1907 the power to hear petitions and to grant prolongation is transferred to the High Court, but the considerations which are to guide the tribunal in arriving at a decision remain the same. The judgments here cited are for the most part judgments of the Privy Council, but they are applicable to petitions to the Court.

Sect. 18 is as follows:—

The Act of 1907.

(1) "*A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the Court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent.*

(2) "*Any person may give notice to the Court of objection to the extension.*

(3) "*On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the Court.*

(4) "*The Court, in considering its decision, shall have regard*

to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

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

Judge's decision final.

By sect. 92, sub-sect. 2, all petitions which "*by virtue of this Act*" are to be presented to the Court are to be presented to a judge to be selected by the Lord Chancellor, and his decision is to be final. A petition for prolongation is "by virtue of this Act" to be presented to the Court.

Grounds for extension.

The transference to a judicial authority of powers which had formerly been exercised by Parliament gave rise in the beginning to some doubts as to the spirit in which petitions should be approached. In *Soame's Patent* (1843, 1 W. P. C. 733), Lord Brougham said: "If this case were to be disposed of upon the ground which in arguing such cases has sometimes been assumed to be the fit one, that there must not only be merit and benefit to the public, and (which is essential) a want of sufficient remuneration in the course of using the patent, but that, moreover, the case is to be tried here as on a Bill in Parliament introduced to prolong the patent, then I apprehend, there can really be no doubt whatever that in this case no Bill would ever have passed through the two Houses of Parliament; but their lordships have always considered that it was with the view of affording a better remedy, not only cheaper and easier, but better in this respect: that there might be cases which never would have prevailed on the legislature to make a new personal law prolonging a monopoly, which nevertheless might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference, which nevertheless, had they been presented in the form of a petition to Parliament, would have failed to procure an Act. Proceeding therefore

upon this ground, that it is not necessary to show there is case enough for an Act of Parliament, their lordships are of opinion that in this case there may be sufficient ground for granting a very moderate extension of the term" (*a*). The considerations laid down by the Act of 1883, and again by the Act of 1907, are almost identical with those given by Lord Brougham in *Derosne's Patent* (1844, 2 W. P. C. 4): "The parties must show in the first place some invention, in the next place a benefit to the public, and in the third place that they have not had adequate remuneration."

Must be strictly proved.

It is immaterial whether or not the application is opposed. The Privy Council required every necessary ground for extension to be **strictly proved** before they advised an extension, and this even though the Crown through the Attorney-General consented (*b*).

Uberrima fides required.

The **utmost good faith** is required to be observed in framing the petition for prolongation. In addition to setting forth the accounts, the nature of which we shall consider later, the petition should state the whole history of the case and everything bearing on the matter. In *Ferranti's Paient* (1901, 18 R. P. C. 518), for example, it transpired at the hearing that the petitioner had long ago parted with a substantial interest in his invention, and this fact was not disclosed in the petition. Prolongation was refused without any further investigation (*c*). And the circumstances relating to any foreign patents which may have been obtained must be set forth with great strictness (*d*).

Conduct of petitioner considered.

The **conduct of the petitioner** in placing the invention before the public is one of the circumstances which will be considered; and so where false statements are made as to profits in the prospectus of a company floated for the purpose of manufacturing under the patent, this was a ground for refusing prolongation (*e*).

(*a*) And see *Morgan's Patent*, 1898, 15 R. P. C. 17; *Ferranti's Patent*, 1901, 18 R. P. C. 518.

(*b*) *Cardwell's Patent*, 1856, 10 Moo. P. C. C. 488.

(*c*) See also *Horsey's Patent*, 1884, 1 R. P. C. 226; *Standfield's Patent*, 1843, 1 W. P. C. 739.

(*d*) *Pitman's Patent*, 1871, L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293.

(*e*) *Lawrence's Patent*, 1892, 9 R. P. C. 89

Merit of the invention.

The merit of the invention does not mean the merit of the inventor, which must be considered separately (*f*), but the **merit of the consideration** which he has given. An inventor may have diligently worked for years in a most deserving manner, and yet have produced an improvement of the most trifling nature—the merit of the inventor in such a case will not be considered.

Again, the invention may have been a very simple one, produced by an inventor with a moment of thought, and yet of great importance to the world. This latter case would be one of merit—simplicity of an invention being an element of its value (*g*).

In *Bailey's Patent* (1884, 1 R. P. C. at p. 3), Lord Blackburn said: "What the statute says is that the Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public. Upon that evidence has been called which shows what can hardly be disputed, viz., that the invention which is the subject of the patent is a beneficial invention; but as to the petitioner showing that there was any special or peculiar advantage in the invention in relation to the public to entitle the patentee to the large reward of an extension of his patent, their lordships are of opinion that he has totally failed to do so."

Degree of merit required.

To sustain a petition for prolongation, a greater degree of merit must be shown than that which would be sufficient to support the patent in a Court of law (*h*).

Novelty of invention immaterial.

The Court will not inquire into the **novelty or utility** of an invention, except in so far as such novelty or utility may form elements in the consideration of the merit of the invention, save in the case of obvious invalidity.

In *Saxby's Patent* (1870, L. R. 3 P. C. 294), Lord Cairns said: "In point of fact, it is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would, of course, abstain in any case from prolonging a

(*f*) See *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 264.

(*g*) *Muntz's Patent*, 1846, 2 W. P. C. at p. 119.

(*h*) Per Sir W. Grove, *Stoney's Patent*, 1888, 5 R. P. C. 520; see also *Saxby's Patent*, 1870, L. R. 3 P. C. 292, 294.

patent which was manifestly bad, yet, in one point of view, they are in the habit, in taking into account that which may be termed the question of utility, to consider not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit. Upon that question it is the habit of this tribunal to consider whether the invention brought before them is one of that high degree of merit which, if everything else were satisfactory, would entitle the patentee to a prolongation."

In *Stewart's Patent* (1886, 3 R. P. C. at p. 10), Lord Monkswell said: "Their lordships do not propose to determine the validity or invalidity of the patent on this occasion; but they are satisfied that the invention, whether or not it may have sufficient novelty to sustain the patent, upon which they give no opinion, has been so far anticipated by previous patents and by actual user of machines in this country as to deprive the invention of that degree of novelty which would be necessary in order to justify their lordships in advising her Majesty to prolong its term."

Save as affecting merit.

In *Johnson's Patent* (1908, 25 R. P. C. at p. 723, Mr. Justice Parker said: "The consideration which supports the grant of the monopoly granted by Letters Patent being in fact the disclosure of something of value to the public, it is only where this value largely exceeds the benefit derived by the patentee from his invention that the patentee can be said to have been inadequately remunerated; but, even where this inadequacy exists, there may be other circumstances sufficient to induce the Court to refrain from exercising its power. The first question, therefore, which arises on a petition for extension is the nature of the disclosure contained in the specification. For, without deciding first on the nature of the disclosure made, it would be impossible to form an opinion on its value to the public. For the purpose of determining the nature of the disclosure made and its value to the public, questions of novelty and subject-matter, though not directly in issue, are necessarily of considerable materiality, for, without considering what was already known at the date of the Letters Patent, it is impossible to arrive at any adequate

conception of the nature of the disclosure made by the patentee, and, in the same way, the value of this disclosure to the public cannot be altogether independent of the extent of inventive ingenuity required to arrive at the thing disclosed. While, therefore, it would be wrong to allow detailed scientific evidence such as is usual in actions for infringement or petitions for revocation, evidence as to novelty or subject-matter cannot be altogether excluded. It is the duty of the petitioner at the outset to bring to the notice of the Court all that may in any way affect the judgment of the Court in these matters. The length to which the petitioner's witnesses should be cross-examined, and the extent to which an objector should be allowed to bring evidence impeaching the validity of a patent on the ground of want of novelty or subject-matter, must be left to the determination of the judge who hears the petition having regard to the nature of the individual case. As a general rule, if, after hearing the evidence of the petitioner's witnesses, there be in the opinion of the Court a primâ facie case for upholding the validity of the patent in respect of novelty and subject-matter, the Court need not, in my opinion, investigate the matter further. It is always open to an objector to challenge the validity of a patent in proceedings more appropriate for that purpose. The Court on a petition for prolongation ought, in my opinion, to pay especial attention to the fact that the thing disclosed may be minute compared with the sum total of what was known before, and yet may be the *sine quâ non* of the successful application of existing knowledge, and thus falls within the category of great inventions."

Nor in validity.

In *Lane Fox's Patent* (1892, 9 P. O. R. 412), a Court of **First Instance held the patent invalid**; while an appeal from that decision was pending, a petition for prolongation was brought, the Committee decided to hear the petition on the ground that it was not their duty to look into the validity of the patent, and the decision of the Court was one which might not be upheld and therefore in no way binding (*i*).

(*i*) And see *Heath's Patent*, 1853, 2 W. P. C. 257; *In re Stoney's Patent*, 1888, 5 R. P. C. 522.

In *Burlingham's Patent* (1898, 15 R. P. C. 195), counsel admitted at the hearing that one of the claims in the specification was invalid; the Committee did not decide upon the effect of this admission and dismissed the petition upon other grounds.

And the Committee will not hear an objection to the validity of the patent on the ground of non-payment of fees (*k*).

Effect of non-user.

Non-user of the invention for the whole or a great part of the period of the grant creates a strong presumption against the merit of an invention, which presumption can only be rebutted by the strongest evidence (*l*). But the same objection being raised in *Hughes' Patent* (1879, L. R. 4 A. C. 174), the application was granted after strong and unanswered evidence of merit, though the patent had not been used in England during the whole term (*m*).

In *Semet and Solvay's Patent* (1895, 12 R. P. C. 10), the invention consisted in an improved apparatus for coking and distilling coal. For some time it was found impossible to obtain any practical introduction of the invention into the country, partly by reason of expense and partly owing to the prejudices of the manufacturers. Lord Watson said: "The invention appears to their lordships to be one which from its very nature cannot reasonably be expected to come at once, or within a short period, into general use. Its adoption necessitates the destruction of existing and the erection of new apparatus, and will therefore, in all probability, be gradual, as the old-fashioned apparatus wears out." The prolongation was granted (*n*).

In *Pieper's Patent* (1895, 12 R. P. C. 292), the invention consisted in an improved expansion gear for steam engines. Prolongation was refused on several grounds, one being that no steps were taken to push the invention for two and a half

(*k*) *Dolbear's Patent*, 1896, 13 R. P. C. 203.

(*l*) *Allan's Patent*, 1867, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; *Dolbear's Patent*, 1896, 13 R. P. C. 203; *Henderson's Patent*, 1901, 18 R. P. C. 449.

(*m*) See also *Wright's Patent*, 1839, 1 W. P. C. 575; *Herbert's Patent*, 1867, L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300; *Southby's Patent*, 1891, 8 R. P. C. 433.

(*n*) And see *Thompson's Patent*, 1902, 19 R. P. C. 565.

Conduct of inventor in pushing invention.

years after the date of the patent. Lord Watson, dealing with this as a reason for the refusal, said: "Looking at the progressive amounts obtained from year to year under the English patent, it is by no means clear that if due activity had been shown in making the invention known to persons who were likely to use it in this country, there might not have been, during the last year or two's currency, a sum which, added to those which have actually been obtained, might have amounted to adequate remuneration."

The principle upon which these cases were decided was approved in *Henderson's Patent* (1901, 18 R. P. C. 449), and in *Johnson's Patent* (1908, 25 R. P. C., at p. 727) Mr. Justice Parker said:—

"As this is the first petition under sect. 18 of the Act of 1907, I think it may be useful to add a few further observations. In the first place, I do not consider that the reasons given by the petitioner for not bringing his invention prominently before British manufacturers are at all satisfactory. His attitude of mind appears to have been that, if he could not persuade his own firm to give his invention a trial, he certainly would be unable to persuade anyone else, either in America or in England. This may have been quite true with regard to the invention in question, but it is, in my opinion, incumbent on a patentee who invokes the discretionary power conferred by sect. 18 to prove that he has done all a patentee could do to launch his invention on the British market. If an invention be of that large value to the public which alone will justify the term of the patent being extended—and there is certainly a chance, and I should say a reasonable chance, of someone being found in this country enterprising enough to give it a trial—the least that can be required of the patentee is to show that he has made an effort to find such a person. The petitioner had been able to convince himself of the value of his process, and I cannot ignore the possibility that with reasonable effort he might have convinced others."

In *Roper's Patent* (1887, 4 R. P. C. 201), an extension was granted although the invention had not been pushed during a period of eight years, the reason for the delay being

the serious ill-health of the patentee produced by a railway accident.

Where part of the invention is sufficiently meritorious and part not so, an extension of the term will be granted for the meritorious part only (*o*).

Subsequent improvement no bar to prolongation.

The mere fact that the invention has been considerably improved upon since it was patented is not a reason for refusing prolongation (*p*).

Save as affecting remuneration.

But where a patent had been taken out for the subsequent improvements, and remuneration had been derived therefrom, this was held to be a reason amongst others for refusing a prolongation (*q*), and if the invention in its original form was useless, it would be a ground for refusal.

Period of prolongation.

The degree of merit together with the circumstances which in the future are likely to tend to the proper remuneration of the patentee are taken into consideration in determining for what period the patent shall be prolonged. Sub-sect. 5 of sect. 18, following the Act of 1883, allows an extension "*not exceeding seven, or, in exceptional cases, fourteen years.*"

Exceptional merit.

In *Stoney's Patent* (1888, 5 R. P. C. 518), the patent was for improvements in sluice or flood gates, and enabled a very small amount of power to move gates which had theretofore required the expenditure of great force. Sir William Grove said: "There is one other matter which has always been considered by this Court, and that is that the invention is not one which would promote itself. This is not a case like that of some of those little improvements in forks or knives, in fireplaces, or things of that sort, which, if once known, the public will necessarily have for their own convenience. On the contrary, this is an invention which only appeals to a small number of minds, is only used in a small number of cases, and requires a considerable outlay, and consequently is not an invention of daily use, nor one of that class which rapidly gets

(*o*) *Bolmer's Patent*, 1849, 8 Moo. P. C. C. 282; *Lee's Patent*, 1856, 10 Moo. P. C. C. 226; *Church's Patent*, 1886, 3 R. P. C. 95; *Joy's Paten* 1893, 10 R. P. C. 89.

(*p*) *Galloway's Patent*, 1843, 1 W. P. C. 727; *Soame's Patent*, 1843, 1 W. P. C. 734.

(*q*) *Nussey and Leachman's Patent*, 1890, 7 R. P. C. 22.

into general use; it is exceptional therefore in that respect. . . . Now, in the case of a common application such as I have spoken of, . . . if by some means it has been ignored by the public and the patentees come before the Court for a prolongation of their patent, the mere advertisement of the petition would materially assist and start the invention, . . . and would probably lead to its getting into rapid application, and to its becoming rapidly remunerative to the patentees. But this is not an invention of that description. It is from its nature an invention which cannot be very largely used, and which only applies to peculiar cases, namely, where sluices are wanted for large bodies of water to regulate the flow of that water, and to do it without friction and without substantial leakage. It can therefore only be profitably applied, at all events, in certain large undertakings, which must be few and far between. . . . Under those circumstances my lords think that this is an exceptional case within the meaning of the statute, and that there should be a prolongation for the term of ten years."

The Act gives a **patentee** the right to petition, and, bearing in mind that the **definition of the word patentee** is by sect. 93, "*The person for the time being entitled to the benefit of a patent,*" it will be observed that some latitude is given as to persons who may petition.

Persons entitled to petition, merits of.

Prior to the Act of 1883 it had been held, in a series of cases, that **executors and administrators** of a grantee of letters patent might petition for an extension (*r*). So might the assignee of a patent (*s*), even though a public company. So might the executor of an assignee (*t*); so also any person having merely an equitable interest in the patent (*u*); an **unpaid mortgagee** should be joined as a party (*x*).

But the Court, in addition to considering the merit of the invention, consider that of the petitioner.

"The merit of an **importer** is less than of an inventor. We

(*r*) *Heath's Patent*, 1853, 8 Moo. P. C. C. 217; 2 W. P. C. 247.

(*s*) *Norton's Patent*, 1863, 1 Moo. P. C. N. S. 339.

(*t*) *Bodmer's Patent*, 1849, 6 Moo. P. C. C. 468.

(*u*) *Noble's Patent*, 1850, 7 Moo. P. C. C. 191.

(*x*) *Church's Patent*, 1886, 3 R. P. C. 95.

are sitting judicially, and it is an argument against the patent that it is imported and not invented. I do not say it takes away the merit, but it makes it much smaller" (*y*).

Where it appeared that the imported invention had great commercial value, and that the petitioners had embarked a large capital in bringing the patent into use, whereby they had sustained a loss of nearly 10,000*l*., an extension for six years was granted (*z*).

Merit of assignee.

Extension of the term will be granted to assignees, as they have, so to speak, purchased the merit of the original inventor, but the argument against importers will apply with equal force against assignees (*a*).

In *Norton's Patent* (1863, 1 Moo. P. C. N. S. 339), Sir John Romilly, then Master of the Rolls, said: "Under the late statute 7 & 8 Vict. c. 69, s. 4, a person is not excluded from applying for an extension of a patent upon the ground of his being the assignee of the patent; but it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use" (*b*).

And in *Pitman's Patent* (1871, 8 Moo. P. C. N. S. 293, L. R. 4 P. C. 84), Sir J. W. Colvile said: "There are no doubt cases in which their lordships have granted applications by the assignees of the patentee for extension of the term, and have also considered, in some respects, the expenses incurred by the assignee in bringing the patent into notice, and for the merit, as it may be said, of the assignee in patronising the

(*y*) Per Lord Brougham, *Soame's Patent*, 1843, 1 W. P. C. at p. 733.

(*z*) *Berry's Patent*, 1850, 7 Moo. P. C. C. 187.

(*a*) See *Napier's Patent*, 1861, 13 Moo. P. C. C. 543. See also *Norton's Patent*, 1863, 1 Moo. P. C. N. S. 339; *Pitman's Patent*, 1871, L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293.

(*b*) And see *Finch's Patent*, 1898, 15 R. P. C. 674.

patentee, and in pushing the patent into notice; but the general rule which their lordships entertain in applications on the part of assignees is, as was stated by Lord Brougham in *Morgan's Patent* (1843, 1 W. P. C. 737), that by so doing 'they are, though not directly, yet immediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damnified. For this reason consideration has been given to the claims of the assignee who has an interest in the patent.'"

In *Hopkinson's Patent* (1897, 14 R. P. C. 5), the petitioners were the inventor and a company who had purchased the patents from an assignee of the inventor. It appeared that the inventor himself had been well remunerated in the course of the transactions. Lord Hobhouse dealt with the questions of principle involved and the authorities which illustrate them, and said: "Their lordships consider that they would be departing both from authority and from sound principle if they were to hold that this company occupies the position of an inventor who has been inadequately remunerated. The company entered upon a purely commercial speculation, which, unluckily for them, has, up to the present time, proved unremunerative. They did not assist to perfect or bring out the invention. They purchased it out and out from a prior assignee of the inventor, who has, in one way or another, been well paid, and has now no claim or interest to ask for an extension" (*c*).

In *Houghton's Patent* (1871, L. R. 3 P. C. 461), however, where the petitioning company had spent large sums in trying to make the invention known and in bringing it into public use, and the patentee was a holder of a considerable number of shares, the patent was prolonged.

Where the petitioner is an assignee conditions may be imposed in favour of the original inventor. In *Herbert's*

(*c*) And see *Barff and Bower's Patent*, 1895, 12 R. P. C. 383; *Henderson's Patent*, 1901, 18 R. P. C. 453.

Patent (1867, L. R. 1 P. C. 399), the petition was presented by the patentee and the assignees of a part share conjointly; while the petition was pending the patentee died; the Committee permitted the hearing to proceed, and granted an extension, subject to a condition that the assignees should hold a moiety on behalf of the widow of the patentee.

Interests of applicant considered.

In *Whitehouse's Patent* (1838, 1 W. P. C. 473) (*d*), the inventor was a mechanic in the employ of the petitioner. The petitioner was the assignee of the patent, and had expended large sums of money on the necessary plant and machinery. An extension was granted for six years, on condition that the petitioner secured to Whitehouse an annuity of 500*l.* during the term of the patent.

Interests of public considered.

The interests of the public will also be considered, and in the event of the petition being granted terms may be imposed. In *Hardy's Patent* (1849, 6 Moo. P. C. C. 441), the patentee was obliged to sell the patented articles at a certain fixed price, and no more. In *Lyon's Patent* (1894, 11 R. P. C. 537), an extension was granted upon the condition that the petitioner should grant licenses on the same terms to all persons, and the royalty receivable was limited. In *Shone's Patent* (1892, 9 R. P. C. 438), where the petitioners had been obliged by stress of circumstances to grant an exclusive license, the exclusive licensees were co-petitioners, but were compelled to renounce the license in so far as it was exclusive as a term of renewal.

Effect of exclusive license.

A grant by the patentee of an exclusive license to work his invention, together with a covenant to continue such exclusive license in the event of a renewal being granted, is a good ground of objection to the prolongation (*e*); but where the licensee had no rights to the exclusive use of the patent during any period of prolongation that might be granted, and it did not appear that the interests of the public had been in any way affected by the grant of the exclusive license, it was held that this was no objection to the petition for extension (*f*), and in *Shone's Patent* (1892, 9 R. P. C. 438), an extension was granted subject to the

(*d*) See also *Hardy's Patent*, 1849, 6 Moo. P. C. C. 441.

(*e*) *Cardwell's Patent*, 1856, 10 Moo. P. C. C. 488.

(*f*) *Darby's Patent*, 1891, 8 R. P. C. 380.

condition that the exclusive licensee abandoned all right and benefit under the license.

Inventions worked abroad.

The Act of 1908 provides for the revocation of patents for manufactures wholly or mainly carried on outside the United Kingdom. This enactment introduces a new policy into English patent law, and it may well be that the Court will in future more carefully consider the extent to which the manufacture may be a benefit to the public in the sense of giving employment to British labour. To a certain extent this aspect of the matter was not ignored before the Act. In *Johnson's Patent* (1871, L. R. 4 P. C. at p. 80) James, L.J., said: "The merits of the case, so far as regards the English patent, appear to their lordships to be nil. The patentee, by taking out a patent in England, has in effect secured to himself a monopoly during a period of fourteen years of the sale of articles manufactured in America, and exported from America here, which would have been manufactured there and exported to this country quite in the same way if no English patent had been taken out, but with this difference, that the patentee would not have had the monopoly of his patent, and would not, therefore, have had any opportunity of securing the monopoly of prices. The merits, therefore, so far as regards the introduction of the invention into this country, seem to their lordships to be nothing."

"Merit" is a vague term. Different persons have different ideas as to wherein it consists. Each case that comes before the Court must of necessity, therefore, be decided upon the facts of that particular case. It is otherwise with the other necessary condition for an extension, viz., the inadequacy of the remuneration of the inventor. Here figures can be dealt with, and a nearer approach to uniformity of decision obtained. It is possible, therefore, to gather from the various decisions a reasonably accurate set of rules for the guidance of the applicant for an extension on the ground of the inadequacy of the remuneration.

Sufficiency of remuneration.

The **sufficiency of the remuneration** will be estimated with a view to the **importance of the invention** and the **benefit the public** have derived from it. That which would be ample remunera-

tion for one patent would be considered inadequate for another. Refining sugar by filtering it through animal charcoal was an invention of great value and importance. The patent was extended for six years on the ground that although there had been a considerable profit it bore no relation to the great merit of the invention (*g*).

The account of profit and loss must be clear and precise.

Accounts must be clear.

In *Wüterick's Patent* (1903, 20 R. P. C. 286), Lord Macnaghten said: "That the accounts presented to them have been honestly kept, and have been honestly made out by the accountant, their lordships do not doubt, nor do they doubt that the accountant has done his best to present the accounts to them in an intelligible form; but still the fact remains that their lordships are unable to discover from the accounts put before the Committee what is the remuneration that the patentee has actually received. What a patentee intending to come for prolongation of his patent ought to do is stated very plainly in a judgment of Lord Chelmsford in *Betts' Patent* (1862, 1 Moo. P. C. N. S. 49). It was repeated by Lord Cairns in perhaps stronger language in *Saxby's Patent* (1870, L. R. 3 P. C. 294; 7 Moo. P. C. N. S. 82), and it has been recently repeated in a judgment delivered by Lord Davey in the matter of *Henderson's Patent* (1901, 18 R. P. C. 449)."

In *Hughes' Patent* (1898, 15 R. P. C. 371), the petitioner had kept no books, but shortly before the presentation of the petition he had marked upon certain cheques drawn upon his private account approximately the amounts expended by him in working the patent. Upon these materials the accounts accompanying the petition were made up by the accountant. There were no vouchers or other corroboration. Prolongation was refused.

In one case, the accounts being prima facie unsatisfactory, the Judicial Committee directed the question of accounts to be taken before considering the merits of the invention (*h*). And where the accounts were prima facie satisfactory, the petitioners

(*g*) *Derosne's Patent*, 1844, 2 W. P. C. 1; *Newton's Patent*, 1861, 14 Moo. P. C. C. 156.

(*h*) *Wield's Patent*, 1871, L. R. 4 P. C. 89.

were allowed to prove the merits of the invention before going into the accounts (*i*). The books of the petitioner in respect to profits arising from his patent having been lost during his bankruptcy, the account of profit and loss was taken upon his own evidence (*k*). This was an exception to the general rule, which is, that evidence will not be received from the petitioner; but in the absence of the books, without reasonable excuse, everything will be taken most strongly against the petitioner (*l*).

Perfect accounts sometimes excused.

But in exceptional cases, where a strong prima facie case has been made out, the **filing of perfect accounts may be excused** (*m*). Where the estate of a deceased patentee was of little value, and no accounts had ever been kept, the petitioner, the administratrix and widow of the patentee, was examined to prove an allegation in the petition to the effect that not only had there been no profits, but a considerable loss (*n*).

And where the invention was of **exceptional merit**, and it was clear that a loss of about 8,000*l.* had been incurred, it was held that extreme accuracy in the accounts was unnecessary (*o*).

Should the accounts filed in the first instance be unsatisfactory, an adjournment of the hearing will sometimes be granted to allow the petitioner to **amend** (*p*), but good reason must be disclosed, as otherwise the petition will be dismissed (*q*).

Patentee's distinguished from manufacturer's profits.

In the accounts which the patentee must file upon an application for an extension, when he is a **manufacturer of the patented article** he should, so far as possible, distinguish profits as a manufacturer from profits as a patentee; and the profits that he would in any case have made in his capacity of a manufacturer will not be taken as patentee's profits (*r*). But in some cases

(*i*) *Houghton's Patent*, 1870, L. R. 3 P. C. 461; 7 Moo. P. C. N. S. 309.

(*k*) *Hutchinson's Patent*, 1861, 14 Moo. P. C. C. 364.

(*l*) *Lawrence's Patent*, 1892, 9 R. P. C. 85; see also *Yates and Kellett's Patent*, 1887, L. R. 12 A. C. 147; 4 R. P. C. 150.

(*m*) *Lowe's Patent*, 1846, 10 Jur. 363.

(*n*) *Heath's Patent*, 1853, 8 Moo. P. C. C. 217; 2 W. P. C. 247.

(*o*) *Darby's Patent*, 1891, 8 R. P. C. 380, 384.

(*p*) *Johnson and Atkinson's Patents*, 1873, L. R. 5 P. C. 87.

(*q*) *Newton's Patent*, 1884, L. R. 9 A. C. 592; 1 R. P. C. 177; *Yates and Kellett's Patent*, 1887, L. R. 12 A. C. 147; 4 R. P. C. 150.

(*r*) See Lord Brougham's remarks in *Galloway's Patent*, 1843, 1 W. P. C. at p. 729.

the very fact of the ownership of the patent will be sufficient to greatly increase the number of orders he will receive as a manufacturer, and such matters will be taken into account in considering the remuneration. In *Saxby's Patent* (1870, L. R. 3 P. C. 295), Lord Cairns said: "It has been decided more than once by this Committee (*s*) that where the patentee is also the manufacturer, the profits which he makes as manufacturer, although they may not be in a strict point of view profits of the patent, must undoubtedly be taken into consideration upon a question of this kind. It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer and his business or his position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of a manufacturer, and there may be patents of a different kind, where there is an intimate connection with the business of the manufacturer; that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer."

Also losses.

The same remarks apply to the reckoning of losses. In *Thorneycroft's Patent* (1899, 16 R. P. C. 202), the owners of the patent, which was granted for a new form of marine boiler, had constructed boilers for ships built by other firms, and on these there had been a profit. They also built a vessel (the "Speedy") themselves, and equipped her with boilers. On this vessel the firm made a great loss, and in estimating the loss they divided the total loss between the boilers and the vessel without the boilers in proportion to their relative cost; thus obtained, the loss attributable to the boilers was about 5,000*l*. Lord Davey said: "It appears, however, on cross-examination, that the tenders for the 'Speedy' . . . contained separate prices for the boilers and for the boat, and the difference between the contract price and the actual cost of the boilers of the 'Speedy' was 688*l*. only. Their lordships think that the proportion of loss attributed to the boilers is ascertained on a fallacious principle. . . . No explanation whatever has been

(*s*) See *In re Betts' Patent*, 1862, 1 Moo. P. C. N. S. 49, also *Willans and Robinson's Patent*, 1896, 13 R. P. C. 550.

offered why this large loss was incurred in building boats fitted with the patent boilers for themselves, while a handsome profit was made on supplying the boilers for boats built by other builders. In the absence of any explanation, the facts proved are consistent with the existence of some error of judgment, miscalculation, or other defect in the petitioners' mode of carrying on their business of boat-building."

Deduction allowed.

In estimating profits, a deduction will be allowed for the **expenses of experiments** in bringing the invention to perfection (*t*).

The **expenses of taking out the patent** will be allowed as deduction (*u*). So also will the **expenses incurred in bringing the invention into general public use** (*x*). And a deduction will be allowed in respect of the **personal expenses of the patentee**, and by way of salary for the exclusive devotion of his time in bringing the patent into practical operation and public notice (*y*). The amount allowed will depend on the circumstances of the case (*z*), but it must be quite clear to what extent the patentee has given his time (*a*). A patentee residing in America, for the purpose of getting the patented article into general use in England, employed **an agent**, and allowed him half profits. This half was allowed to be deducted (*b*), but where the relations between the inventor and the agent were those of partners, the share of the agent had to be brought into account as profits (*c*). And deductions will also be allowed in respect of the **costs of litigation** necessary to maintain the validity of the patent, and to restrain infringers (*d*). But not where actions have been compromised improvidently, and costs abandoned without sufficient reason (*e*).

(*t*) *Bate's Patent*, 1836, 1 W. P. C. 739, n.; *Kay's Patent*, 1839, 1 W. P. C. 572; *Davies's Patent*, 1894, 11 R. P. C. 28.

(*u*) *Roberts' Patent*, 1839, 1 W. P. C. 575.

(*x*) *Galloway's Patent*, supra.

(*y*) *Carr's Patent*, 1873, L. R. 4 P. C. 539.

(*z*) *Bailey's Patent*, 1884, 1 R. P. C. 2.

(*a*) *Turner's Patent*, 1885, 2 R. P. C. 177.

(*b*) *Poole's Patent*, 1867, 4 Moo. P. C. N. S. 452; L. R. 1 P. C. 514.

(*c*) *Pieper's Patent*, 1895, 12 R. P. C. 292.

(*d*) *Kay's Patent*, 1839, 1 W. P. C. 572; *Galloway's Patent*, 1843, 1 W. P. C. 729; *Betts' Patent*, 1862, 1 Moo. N. S. 62.

(*e*) *Hill's Patent*, 1863, 1 Moo. N. S. 258.

Profits of interested parties.

The profits of persons interested in the patent, such as part assignees or free licensees (*f*), must be shown, but not necessarily those made by licensees who pay a royalty (*g*).

And in *Johnson's Patent* (1871, L. R. 4 P. C. 75), Lord Justice James said: "Their lordships are of opinion that, where the question to be considered is, whether an invention has been sufficiently remunerative or not, in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee, or the person who claims the right to the patentee, *whether it be in one country or another*" (*h*).

Future profits and foreign patents.

Probable future profits must also be taken into account. In *Johnson's Patent* (1908, 25 R. P. C. at p. 727), Mr. Justice Parker said: "For the purpose of considering whether a patentee has been inadequately remunerated I am of opinion (1) that profits on his corresponding foreign patents as well as on his English patents must be taken into account, and (2) that some allowance ought properly to be made for profits *which, though not yet received, will in all probability be received* in respect of both the English and the foreign patents before their expiration. The petitioner in the present case admits a realised profit in respect of the American patent of some 7,500*l*., and in respect of the English patent of over 1,000*l*. Unless something very unforeseen happens, he will receive further profits in respect of both the English and American patents, and he anticipates that under the American patent his receipts will be very considerable—more, in fact, than he has yet realised in America. Under these circumstances I am not satisfied that he can be said to have been inadequately remunerated, having regard to the nature and character of his invention."

Where the patent has been granted on a communication from abroad it must be established that the foreign inventor has been insufficiently remunerated, or at least sufficient

(*f*) *Thomas' Patents*, 1892, 9 R. P. C. 367, 373.

(*g*) *Thomas' Patents*, 1892, 9 R. P. C. 367; cf. *Trotman's Patent*, 1866, L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488.

(*h*) See also *Hardy's Patent*, 1849, 6 Moo. P. C. C. 441.

information must be given to enable the Court to form an opinion as to his position in the matter (*i*).

Sect. 25 of the Patent Law Amendment Act, 1852, provided that letters patent obtained in the United Kingdom for patented foreign inventions should not continue in force after the expiration of the foreign patent, and that any prolongation of letters patent should be made subject to that condition; consequently an inquiry into foreign patents and their duration was always an essential element of the proceedings before the Privy Council (*k*). The lapse of a foreign patent the date of which was subsequent to the date of protection obtained in England for the same invention did not affect the English patent, and was no objection to its prolongation (*l*).

This Act, however, was specifically repealed, and by sect. 45, sub-sects. 2 and 3 of the Act of 1883, it was provided :—

"*Every patent granted* before *the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses. In all other respects* (*including the amount and time of payment of fees*) *this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.*"

Dealing with this repeal and its effect, Lord Watson, in *Semet and Solvay's Patent* (1895, 12 R. P. C. 17), said: "But the lapse or expiry of foreign patents remains, as it always has been, one of the circumstances which must necessarily be considered. . . . In cases where the prolongation of a patent would place the inhabitants of Great Britain and Ireland at a disadvantage in competition with the subjects of a foreign

(*i*) *Peach's Patent*, 1902, 19 R. P. C. 65.

(*k*) *Bodmer's Patent*, 1849, 8 Moo. P. C. C. 282; *Newton's Patent*, 1862, 15 Moo. P. C. C. 176; *Betts' Patent*, 1862, 1 Moo. P. C. N. S. 49; *Johnson's Patent*, 1871, 8 Moo. P. C. N. S. 282; L. R. 4 C. P. 75.

(*l*) *Betts' Patent*, 1862, 1 Moo. P. C. N. S. 49; *Poole's Patent*, 1867, 4 Moo. P. C. N. S. 452; *Adair's Patent*, 1881, L. R. 6 App. Cas. 176; 50 L. J. P. C. 68; but see *Blake's Patent*, 1873, L. R. 4 P. C. 535; 9 Moo. P. C. N. S. 373.

State, that circumstance must militate strongly against its extension. Whether the disadvantage, either certain or probable, ought to outweigh the right of the patentee to obtain a renewal upon other grounds, must always be a question of degree, to be decided according to the special circumstances of each case (*m*). But the profits derived from foreign patents must be set out clearly, as they are considered with 'all the circumstances of the case'" (*n*).

The practice is regulated by rule 3 of Order LIII. A (see Appendix), which, "taken in connection with the rules of the Supreme Court which (by rule 2) are made applicable, forms in itself a code by which all questions relating to petitions for the extension of patents ought to be governed as to matters of practice" (*o*). Practice.

The practice is substantially similar to that under the Privy Council Rules, and it is anticipated that the cases herein referred to decided by the Privy Council will guide the Court.

Two or more patents might be made the subject of one petition (*p*). The Attorney-General appears on behalf of the Comptroller and the Board of Trade. His duty is as much to assist and instruct the Court as to oppose, and indeed only to oppose when in his judgment prolongation should not be granted (*q*).

Any person may give notice of opposition, which must be lodged and served before the day named in the petitioner's advertisements as that on which he intends to apply for a day to be fixed for hearing the petition, and no extension of the time will be granted unless good reason is shown (*r*). The petitioner must then serve a copy of the petition upon the objector, who within three weeks of such service must serve upon the petitioner "particulars of objections" (rule 3 (l)).

(*m*) And see *Pieper's Patent*, 1895, 12 R. P. C. 292.

(*n*) *Newton's Patent*, 1884, 1 R. P. C. 177; *Barff and Bower's Patent*, 1895, 12 R. P. C. 385.

(*o*) Parker, J., in *Johnson's Patent*, 1908, 25 R. P. C. at p. 544.

(*p*) *In re Clark's Patent*, 1870, L. R. 3 P. C. 421; *Johnson's and Atkinson's Patent*, 1873, L. R. 5 P. C. 87; *Church's Patent*, 1886, 3 R. P. C. 95.

(*q*) *Stoney's Patent*, 1888, 5 R. P. C. 522.

(*r*) *Hopkinson's Patent*, 1896, 13 R. P. C. 114.

In *Johnson's Patent* (1908, 25 R. P. C. 542), among other matters, the objector stated that the alleged invention "was not novel." A summons was taken out for further and better particulars, and Parker, J., said: "It . . . appears to me that rule 3 (l) is drawn in such a way as to give the Court considerable latitude as to what particulars it may in any particular case be necessary and proper for the objector to give. On the one hand, I do not think it would be at all desirable that a bona fide objector should be bound down by objections given at an early stage of the proceedings, or rather particulars of the objections given at an early stage of the proceedings, because he might acquire some valuable evidence on, say, the question of novelty which it would be his duty at a subsequent stage to communicate to the Court on behalf of the public (*s*). On the other hand, it would be only fair, having regard to the nature of the proceedings, that he should be tied down, and accordingly that provision is made in the rule. In considering what particulars of the objections, on which he is entitled to rely and of which he gives notice, he ought to give in the document which states the grounds of his objection, I think that really the considerations which apply are those considerations which apply to pleadings generally. It is, in my opinion, only fair that a petitioner should at the earliest possible stage get to know what it is alleged prevents his patent from being considered novel or from having subject-matter. . . . If any prior user is intended to be relied on, some particulars of that prior user ought to be given, and it ought not to be sprung upon the petitioner at the trial. . . . Similarly, if there has been anticipation by a document, he ought to be informed what that anticipation is, because the existence of that anticipation may lead him to withdraw his petition."

The Crown may rely on prior publications without giving any notice (rule 3 (t), and see note (*d*)).

The Court may give costs to or against opponents (rule 3 (u)). Where the petition had been very honestly prepared

(*s*) See *Ball's Patent*, 1879, L. R. 4 App. Cas. 171; *Stewart's Patent*, 1886, 3 R. P. C. 9; *Livet's Patent*, 1892, 9 R. P. C. 327.

and the invention was of merit, but the petition was dismissed on the ground that the petitioner had been sufficiently remunerated, and the effect of the opposition had been merely to prolong the inquiry, costs were refused the opponent (*t*).

Under rule 3 (v), following the Privy Council practice as laid down in *Wield's Patent* (1871, L. R. 4 P. C. 92; 8 Moo. P. C. N. S. 300), the Court will not, save under special circumstances, grant more than one set of costs amongst all the opponents.

Whether the petition be opposed or not, the petitioner must formally prove his case (*u*).

Rule 3 (s), corresponding to rule 7 of the old Privy Council rules, enables the Court to excuse petitioners and opponents from compliance with the rules and to give such directions in matters of procedure and practice as it shall consider just and expedient (*x*). This does not, however, enable the Court to excuse non-compliance with statutory requirements (*y*).

The Privy Council in *Goucher's Patent* (1865, 2 Moo. P. C. N. S. 532) decided that, having once granted an extension, they had no power to entertain a petition for a further extension under the laws then in force. The reasoning is applicable to the present law and was followed by Parker, J., in *Thompson's Patent* (No. 2) (1909, 26 R. P. C. 673).

It is the practice for the Court to make an order for a new grant for the further term specified and containing such terms and conditions as may be imposed.

(*t*) *Muntz's Patent*, 1846, 2 W. P. C. 122.

(*u*) *Darby's Patent*, 1891, 8 R. P. C. 383.

(*x*) See, *e.g.*, *Lindon's Patent*, 1897, 14 R. P. C. 643 (extension of time for advertising).

(*y*) *Adam's Patent*, 1899, 16 R. P. C. 1.

CHAPTER XII.

THE REMEDY OF THE PUBLIC AGAINST THE PATENTEE.

COMPULSORY LICENCE AND REVOCATION.

THE monopoly enjoyed by the patentee and the consequent restraint of trade for his benefit render necessary certain provisions for the protection of the public in cases where it can be shown that the monopoly has been improperly obtained, or where though properly granted it has subsequently been misused. Accordingly the Act of 1908 gives certain remedies to the public against the patentee, some of which are entirely new. They may be briefly set forth before being considered at length.

Summary of remedies.

(a) Under sect. 24, where the reasonable requirements of the public with respect to the patented invention are not satisfied, or a trade is prejudiced by unfair conditions attached to the purchase, hire, or use of the articles the subject of the invention, the Court may order a compulsory licence upon just terms, or if this remedy be not sufficiently drastic it may revoke the patent.

(b) Under sect. 25, if the patent is invalid for any reason it may be revoked by the Court. And any ground on which a patent may be revoked under this Act by the Comptroller or as an alternative to the grant of a compulsory licence is also a ground of revocation under this section.

(c) Any person who would have been entitled to oppose the grant may within two years from the date of the patent apply to the Comptroller to revoke the patent on any ground on which it might have been opposed.

(d) If the patented invention is not sufficiently manufactured or carried on, any person, after the expiration

of four years from the grant, may apply to the Comptroller to revoke the patent under sect. 27.

(e) Any ground on which a patent might have been revoked either by the Comptroller or by the Court, and especially the fact that the invention is wholly or mainly worked abroad, is by sect. 25 made a defence to an action for infringement.

(f) A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, under sect. 32, without presenting such a petition, counterclaim for the revocation of the patent.

(g) If the patentee inserts in any contract made after the passing of the Act any of certain onerous conditions specified in sect. 38, this fact is available to the defendant under sect. 38, sub-sect. 4, as a defence to any action for infringement which he may bring while such contract remains in force.

PETITION FOR COMPULSORY LICENCE OR REVOCATION.

Sect. 24. Compulsory licence or revocation. History of law.

Under the Act of 1883, where the patentee abused his monopoly in such a manner that (1) the patent was not *being worked in the United Kingdom*; *or* (2) the *reasonable* requirements of the public with respect to the invention were not satisfied; or (3) any person was prevented from working or using an invention of which he was possessed, the Board of Trade might be petitioned to order the patentee to grant a compulsory licence upon such terms as the Board might deem reasonable. The Board appointed a referee, who heard the parties and reported to the Board, but every case so dealt with resulted in a compromise, the order made was by consent, and the terms thereof were never published. There are only a few cases reported of the enactment having been put in force.

By sect. 3 of the Act of 1902 the provisions of the Act of 1883 with respect to compulsory licences were repealed. The petition was thereafter to be referred to the Judicial Committee of the Privy Council, who might order a compulsory licence, or in cases where the Committee were of opinion that the granting

of licences would be an inadequate remedy they might revoke the patent.

The provision in this enactment for revocation of the patent marked a change in the attitude of the law towards the privileges conferred by letters patent, and probably a reversion to the earlier policy of the Crown. In Mr. J. W. Gordon's learned work on "Compulsory Licences," published in 1899, the history of the law is discussed in a most interesting manner. The author points out that it is only in comparatively recent times that the Courts have adopted the view that the abuse of his privileges by the patentee has been deemed no ground for invalidating the patent (*a*).

No cases are reported of the Act of 1902 having been put into force.

By the Act of 1908 the Court has been substituted for the Judicial Committee of the Privy Council.

The first two sub-sects. of sect. 24 are as follows :—

(1) "*Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.*

(2) "*The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a primâ facie case has been made out, shall refer the petition to the Court, and, if the Board are not so satisfied, they may dismiss the petition.*"

Petition referred to Court.

It is to be noticed that this remedy is only available to a "*person interested,*" which indicates that only persons directly affected by the abuse of the monopoly will be heard. The rules compel the petitioner to state his interests on the face of his petition, and to verify them by declaration.

The grievance, which must be shown by the petitioner to entitle him to the remedy, is indicated more clearly in sub-sect. 5 :—

(*a*) See, *e.g.*, *Badische Anilin und Soda Fabrik* v. *W. G. Thompson & Sons*, 1904, 21 R. P. C. 478.

"(5) *For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—*

"(*a*) *if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom, is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or*

"(*b*) *if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.*"

Onerous conditions in licences.

The provision for the circumstances set forth in clause (b) is new and is intended to attack the system of limited licences which have been in vogue during the last ten years or so (*b*). It must be remembered that by sect. 38 of the Act (see Chap. X.) certain restrictive and burdensome covenants, which were until the passing of this Act often made use of in licences, are declared to be void as being in restraint of trade if inserted in contracts made after the passing of the Act. Such covenants are thus specified by the section:—

"(*a*) *to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or*

"(*b*) *to require the purchaser, lessee, or licensee to acquire from the seller, lessor or licensor, or his nominees, any article or class of articles not protected by the patent.*"

Will apply to legally

Now such covenants being void *ab initio*, it is clearly not to

(*b*) See, *e.g.*, *The Incandescent Gas Light Co.* v. *Cantelo*, 1895, 12 R. P. C. 262.

valid conditions.

these that clause (b) of sub-sect. 5 applies; it is apparently contemplated that the kind of oppressive condition aimed at by sub-sect. 5 (b) of sect. 24 may legally be quite binding, such, for example, as the stipulation for a minimum price at which the patented article may be sold, in which case it might be possible to show either that the trade in that article was unfairly prejudiced, or that manufactures in which the article was used could not be carried on under reasonable conditions. Again, it might be that the patentee imposed restrictions as to price upon one licensee which he dispensed with in the cases of other licensees. In such cases compulsory licences at a reasonable price might be ordered.

Sub-sect. 3 empowers the Court to order the patentee to grant licences upon such terms as it may think just, or if it is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, it may revoke the patent—

"*Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.*"

It will be seen that the Court has extensive power to prevent abuse of the patentee's monopoly; and, on the other hand, the requirements which a patentee has to fulfil are sufficiently elastic to prevent hardship.

The evil arrived at is not that with which sect. 27 is designed to deal. Here the patentee is required to license or to lose his patent because the public cannot obtain the invention on reasonable terms. Sect. 27 is for the purpose of preventing the public choice from being restricted to foreign supplies only and enabling manufacturers to manufacture at home for home and foreign markets without unreasonable hindrance.

"Satisfactory reasons" for default.

What is necessary to constitute a "satisfactory reason" for the default is difficult to imagine, but it will certainly be more difficult to establish than a "satisfactory reason" under sect. 27; it is not easy, however, to see how a case of such abuse could be so serious as to be incurable by a compulsory licence. Perhaps revocation would be justified as a punishment for

misfeasance in the past. One might suppose, for example, a case in which the invention consisted in the artificial manufacture of what had previously been obtained from nature, such as indigo. The patentee might put the artificial product on the market at such a price as to cause all the natural sources to be abandoned and their industries to be ruined; and then when there was no further competition he might raise the price of his own product to an oppressive degree. Such an abuse (*i.e.*, in raising the price) might justify revocation.

Enforcement of order.

The enforcement of the order for a compulsory licence is no longer effected by mandamus as under the Act of 1883. By sub-sect. 6 it is enacted:—

"*An order of the Court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.*"

Practice.

The practice in presenting the petition to the Board of Trade is regulated by rules 68—74 of the Patents Rules, 1908 (see Appendix).

The practice before the Court is dealt with in Rule 7 of Order LIII. A (*c*). Sub-sect. 4 of sect. 24 of the Act is as follows:—

"*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.*"

The law officer will of course represent the public and will call the attention of the Court to any terms in the proposed compulsory licence which might tend to give the petitioner any unfair advantage over other traders, and any circumstances which might justify revocation of the patent.

The decision of the judge is final, and there is no appeal (see sect. 92) (*c*).

(*c*) See Appendix.

Revocation under sect. 25.

REVOCATION UNDER SECTION 25.

Under sect. 25:—

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

"(2) *Every ground on which—*

"(*a*) *a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by* scire facias; *or*

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

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

The Act of 1883 abolished the proceeding of *scire facias*, which had already fallen into desuetude, and had substituted the petition for revocation.

Expired patent.

The Court of Appeal in *The North Eastern Marine Engineering Co.* v. *Leeds Forge Co.* (1906, 23 R. P. C. 529) seemed to be of opinion that a petition would lie to revoke an expired patent.

By sect. 30, sub-sect. 9, no petition for revocation will lie in respect of a patent granted for an invention which the Secretary of State has certified should be kept secret in the interest of the public service.

Grounds of Revocation.

The grounds upon which a patent may be revoked are those upon which it might have been cancelled by *scire facias*. These are in the Fourth Institute (p. 88) said to be: "*Firstly*, when the king by his letters patent doth grant by several letters patent one and the self-same thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent; *secondly*, when the king granteth anything that is grantable upon a false suggestion, the king by his prerogative *jure regio* may have a *scire facias* to repeal his own grant. When the king doth grant anything, which by law he cannot grant, he *jure regio* (for the advancement of justice and right) may have a *scire facias* to repeal his own letters patent."

And it was held in *Sir Oliver Butler's Case* (about 1680,

2 Vent. 344) that "where a patent is granted to the prejudice of the subject, the king, of right, is to permit him on his petition to use his name for the repeal of it in a *scire facias* at the king's suit, and to hinder multiplicity of actions upon the case." Thus it will be seen that formerly any person might, on behalf of the public, proceed by *scire facias* to repeal a patent, although security for costs was required. Sub-sect. 4 of sect. 26 of the Act of 1883 (re-enacted as sub-sect. 3 of sect. 24 of the Act of 1907) very considerably narrowed and limited this general right.

There is no such remedy as a declaration of invalidity, and if it is desired to establish invalidity it is necessary to petition for revocation (*d*).

Nearly every ground which may be set up as a defence to an action for infringement may be employed as a ground for revocation—such as that the person to whom the letters patent were granted was not the first and true inventor, or that the invention was not new or useful, or that it was not true that the invention had not been practised before, or that the said invention did not come within the meaning of the words "a new manufacture," or that the specification was insufficient and did not disclose the nature of the invention.

Under (b) the Court is given original jurisdiction to revoke a patent upon a petition alleging any facts which would have enabled the Comptroller to have revoked under sects. 26 or 27. It must be remembered that appeals from decisions of the Comptroller upon applications to revoke under sects. 26 and 27 lie to the Court. Sect. 92, sub-sect. 2, is as follows:—

"*Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the Court, or a petition may be referred or presented to the Court, the appeal shall, subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a*

(*d*) *The North Eastern Marine Engineering Co.* v. *Leeds Forge Co.*, 1906, 23 R. P. C. 529.

decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed."

This section has been explained by the Patents and Designs Act, 1908 (8 Edw. VII., c. 4), passed expressly for that purpose. Sect. 1 of this Act is as follows:—

Right to appeal under sect. 25.

"*It is hereby declared that so much of sub-section* (2) *of section ninety-two of the Patents and Designs Act*, 1907, *as provides that the decision of a judge of the High Court to whom a petition is presented by virtue of that Act is to be final does not apply in the case of a petition for the revocation of a patent under section twenty-five of that Act.*"

If therefore it is desired to carry the petition to the Court of Appeal and the House of Lords it should in most cases be presented to the Court under sect. 25 and not to the Comptroller in the first instance.

The Act makes a distinction between persons who are entitled to petition as of right and persons who must first obtain the fiat of the Attorney-General; by sub-sect. 3—

"*A petition for revocation of a patent may be presented—*

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

"(*b*) *by any person alleging—*

Persons entitled of right.

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

"(ii.) *that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or*

"(iii.) *that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.*"

It will be seen that it is necessary that one of the three grounds specified under clause (b) should be established in order to give the petitioner a locus standi unless he had previously obtained the fiat of the Attorney-General. But a person who is entitled to present a petition for revocation

without the necessity of first obtaining the fiat of the Attorney-General may rely upon any lawful ground whereby to impeach the validity of the patent in question, and is not confined to the ground upon which his title to present the petition is based (*e*).

The fiat of the Attorney-General.

If, however, the petitioner should fail to establish the ground which would have given him his locus standi, it is submitted that he cannot proceed upon the other grounds alleged by him, but must retire to obtain the fiat of the Attorney-General to enable him to allege such other grounds of objection. In *Max Müller's Patent* (1907, 24 R. P. C. 465) the petitioners proceeded without the fiat, alleging that certain persons through whom they claimed were the true and first inventors of the invention patented by the respondent, and relied also on other grounds affecting the validity of the patent. During the course of the trial it became doubtful whether the first ground of objection could be sustained. Parke, J., gave leave to the petitioners to apply for the fiat, which, if granted, was to be treated as having been granted *nunc pro tunc*, and directed that the petition should be treated as having been technically amended by inserting an allegation that the fiat had been obtained, and expressed a doubt as to whether the petitioners had any locus standi if the fiat were not granted. It is to be noticed, however, that if it were merely necessary to allege one of the grounds set forth in the sub-section in order to dispense with the fiat, without any obligation to prove it, no one would ever incur the expense and trouble of laying the case before the Attorney-General. In any case it is a useful measure of precaution to obtain the fiat. The hearing of the petition may be adjourned to enable the petitioner to apply for the fiat (*f*). The clauses defining the grounds which entitle a petitioner to proceed without the fiat are strictly construed, and care must be taken that the petition is framed under the proper clause.

In re Avery's Patent (1887, L. R. 36 C. D. 307; 4 R. P. C. 322) was a petition for revocation presented under clause (c)

(*e*) *Morgan's Patent*, 1888, 5 R. P. C. 106.

(*f*) *Dege's Patent*, 1895, 12 R. P. C. at p. 452; *Jameson's Patent*, 1902, 19 R. P. C. at p. 250.

(clause (i.) under the Act of 1907); it was held by Stirling, J., and the Court of Appeal, that this applied only to cases of actual fraud, and would not be extended to questions of mistake, though the consequences might be to deprive the inventor of his patent rights. Cotton, L.J., said: "If it is made out that the present petitioner Avery is a person who brings himself within that clause, and *satisfies the Court* that the patent was obtained in fraud of his rights, then we should have to go into the other question, namely, whether the patent is or is not good" . . . (at p. 325), "an act, to be 'in fraud of his rights,' to my mind must involve an attempt by the agent to deprive the principal of something, or to gain for himself something at the expense of his principal." The petition consequently was dismissed, but without prejudice to the right of the petitioner to present a fresh petition framed under clause (d) (clause (ii.) under the Act of 1907).

In those cases in which a petition for revocation may be presented to the Comptroller with a subsequent appeal to the Court the fiat is not required if this course be adopted, though it would be necessary if the petition were presented direct to the Court in the first instance under sect. 25.

If the patent be revoked on the ground of fraud, the first and true inventor may apply to the Comptroller under sub-sect. 2 of sect. 15 for a patent to be granted to him in lieu thereof, but the Comptroller is not bound to accede to the application, and retains his discretion as in any ordinary application (*g*). This right will not apply where the petition is under clause (ii.) only.

To obtain the fiat.

In order to obtain the Attorney-General's fiat the following documents must be lodged with the Attorney-General's clerk:—

1. A memorial drawn up on judicature paper setting out the history of the case and the grounds upon which the application is based; where there have been proceedings taken for infringement, these and their result must be mentioned. This memorial must be accompanied by all specifications and documents referred to.

(*g*) *Norwood's Patents*, 1895, 12 R. P. C., per Stirling, J., at p. 219.

2. A declaration by the petitioner verifying the statements in the memorial; this also should be upon judicature paper.

3. Two copies of the proposed petition on brief paper.

4. Two copies of the particulars of objections.

5. A certificate by counsel on foolscap, that in his opinion the petition is a proper one for the grant of the fiat of the Attorney-General.

6. A certificate by a solicitor that the applicant is a proper person to present the petition, and that he is competent to answer the costs of all proceedings in connection with the petition.

7. A declaration by the applicant that the questions proposed to be raised by the petition are not and cannot be raised in any legal proceedings then pending in the United Kingdom.

The fees payable on lodging these documents amount to 2*l.* 13*s.* 4*d.*

The costs of obtaining the fiat are recoverable if the petition proves successful (*h*).

The seventh of the above-mentioned documents will not be required when it is proposed to counterclaim under sect. 32 for revocation in an action for infringement. Sect. 32 is as follows:—

Counter-claim for Revocation.

"*A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.*" But it is to be noted that unless properly qualified a defendant must obtain the fiat of the Attorney-General for his counterclaim for revocation.

This section introduces a new form of procedure. Formerly, if the defendant in an action for infringement desired the revocation of the patent sued on, he had to present a petition independently, and then apply for the two cases to be tried together.

Estoppel.

If the defendant does not counterclaim and obtain the

(*h*) *Poulton's Patent*, 1906, 23 R. P. C. 571.

revocation of the patent, a judgment in an action for infringement either for or against the validity of a patent does not create an estoppel in a petition for revocation. In *The Shoe Machinery Co., Ltd.* v. *Cutlan* (1895, 12 R. P. C. 533) Smith, L.J., said: "We held in *Deeley's Patent* (1895, 12 R. P. C. 199) that in a petition for revocation of a patent there was no estoppel, because the person petitioning . . . stands as one of the public, and not as an individual; and although the person petitioning for revocation may be the same person against whom judgment has been given in a patent suit, there is no estoppel against him when he petitions, because he appears as one of the public" (*i*).

The Attorney-General has absolute discretion in granting or refusing his fiat; but cases are unlikely to arise in which the fiat will be refused (*k*). If the applicant shows sufficient interest, and makes out a good case, the Attorney-General will grant his fiat without hearing the patentee (*l*), but in some cases (*e.g.*, as in *Martin's Patent*, Griff. P. C. 320, where the applicant was a licensee under the patent) he will direct notice to be given to the persons interested in the patent, and will hear both parties and give his decision in the ordinary way (*m*). Sir H. James, A.-G., decided that he had no power under sect. 38 of the Act of 1883 to give costs in these cases (*n*).

The form of the fiat of the Attorney-General will be found in the Appendix.

Practice. The practice before the Court is partly regulated by Order LIII. A. By rule 11 the petitioner is bound to deliver particulars of the objections on which he intends to rely, and the degree of particularity required, and the consequences, so far as costs are concerned, are precisely the same as in the case of the particulars delivered in an action for infringement.

(*i*) And see *Re Lewis' Patent*, 1897, 14 R. P. C. 35; *Jameson's Patent*, 1902, 19 R. P. C. 252.

(*k*) Per A. L. Smith, L.J., in *The Shoe Machinery Co.* v. *Cutlan*, 1895, 12 R. P. C. 533.

(*l*) *Gaulard and Gibbs Patent*, Griff. P. C. 320; *Rothwell's Patent*, Griff. P. C. 320.

(*m*) And see *Bell and Coleman' Patent*, Griff. P. C. 320; *Siddell's Patent*, Griff. P. C. 320; *Watling's Patent*, Griff. P. C. 320.

(*n*) *Martin's Patent*, Griff. P. C. 320.

By rule 12 the respondent is entitled to begin and give evidence in support of the patent, and if the petitioner gives evidence impeaching the validity of the patent the respondent is entitled to reply.

The evidence which will be required of the respondent (defendant), in the first instance, will be very slight, and will be similar to that which he would give as to the validity of the patent were he plaintiff in an action for infringement. The petitioner will then have to prove the case he alleges in his petition and particulars, and the respondent has the right of reply. It is merely to preserve this right of reply that the respondent is made practically plaintiff at the trial.

The usual practice is to allow the petition to appear in the petition list, nominally for hearing; a patent may be revoked at this stage when a clear case is made out (*o*). The order for revocation will, however, only be made in open Court and not in chambers, even though the respondent consent (*p*); but the usual course is for the judge to give directions as to the filing of an answer, and also as to interrogatories, inspection, discovery, &c., and the manner of trial, after which the petition stands adjourned.

A day should be fixed before which the petition is not to come on for trial, and the day should not be fixed earlier than that on which the parties will be ready (*q*).

It is advisable to ask for directions as to the persons to be served with the petition if there are any parties interested in the patent other than its actual owners, since it is possible that by serving licensees extra costs may be incurred, although such persons may have taken no active part in the trial at all (*r*). But all persons whose names appear upon the register as beneficially interested should be served.

Where an assignment had been executed after the petition had been presented, the name of the assignee was ordered to be substituted for that of the original respondent to the petition (*s*).

(*o*) *Vaisey's Patent*, 1894, 11 R. P. C. 591.

(*p*) *Clifton's Patent*, 1904, 21 R. P. C. 515.

(*q*) *Borrowman's Patent*, 1902, 19 R. P. C. 160.

(*r*) See, *e.g.*, *Brown's Patent*, 1907, 24 R. P. C. 313.

(*s*) *Haddan's Patent*, 1885, 2 R. P. C. 218.

Where the patentee or other person interested in the patent is out of the jurisdiction, notice should be given to such person by registered letter that the petition has been presented (*t*), as the Court will not decree the revocation of a patent without giving all interested parties an opportunity of being heard, but the mere fact that the patentee is out of the jurisdiction will not prevent the institution of proceedings for revocation (*u*).

A respondent residing out of the jurisdiction will not be ordered to give security for costs (*x*).

Order XXXI., rule 1, of the Rules of the Supreme Court gives power to the Court, or a judge, to permit interrogatories "*in any cause or matter*," to be delivered by either party to the other, and leave will be given to the respondent (called defendant in the Patent Act, 1883) to deliver interrogatories to the petitioner. Circumstances may arise when it would be just to permit the petitioner to examine the respondent. The rules as to interrogatories are similar to those in an action for infringement.

The petition may be tried at the assizes if convenient (*y*); but by sect. 31, sub-sect. 1, the trial is to be without a jury unless otherwise ordered. In modern practice patent actions are almost invariably tried in the Chancery Division.

The parties are entitled to have the petition heard with *viva voce* evidence (*z*).

Amendment of specification.

In cases where the patent was invalid on the ground of want of novelty in part, which defect might be cured by amendment, the Court usually followed the order made in *Deeley* v. *Perkes* (1896, 13 R. P. C. 581; 1896, L. R. A. C. 496), by which the

(*t*) *Drummond's Patent*, 1889, 6 R. P. C. 576; L. R. 43 Ch. D. 80; *La Compagnie Générale d'Eaux Minérales Trade Marks*, 1891, 8 R. P. C. 446; 1891, L. R. 3 Ch. 451; *F. King & Co.'s Trade Mark*, 1892, 9 R. P. C. 350; 1892, L. R. 2 Ch. 462; *Kay's Patent*, 1893, 11 R. P. C. 279; *Goerz and Hoegh's Patent*, 1895, 12 R. P. C. 370; *Cerckel's Patent*, 1898, 15 R. P. C. 500.

(*u*) Ibid.

(*x*) *La Société Anonyme Trade Mark*, 1893, 10 R. P. C. 290; *Miller's Patent*, 1894, 11 R. P. C. 55.

(*y*) *Edmond's Patent*, 1889, 6 R. P. C. 355.

(*z*) *Gaulard and Gibbs' Patent*, 1887, L. R. 34 C. D. 396; 56 L. J. Ch. 606; 56 L. T. 284.

patent was ordered to be revoked unless within a given time the patentee applied at the Patent Office to amend by a specified disclaimer and unless such disclaimer was allowed.

This course was followed because if the order to revoke had not been made conditional, the Comptroller would have been unable to amend the specification of a patent which did not exist. This difficulty arose in *Deeley* v. *Perkes* (supra), and was thus surmounted.

Under sect. 22 the Court now has power in an action for infringement or petition for revocation to make an order amending the specification by way of disclaimer. By rule 23 of Order LIII.A the application to amend must be made by way of motion, and directions may be given by the judge as to advertisements, &c., and the Comptroller is to be notified. It is supposed that this procedure will take the place of the conditional order formerly made, and the Court will postpone judgment in order to give the patentee an opportunity to apply under the section. The order will be made subject to suitable terms. (See Chap. IX. on "Amendment.")

Surrender of patent.

By sub-sect. 3 of sect. 26, *A patentee may at any time by giving notice in the prescribed manner to the Comptroller offer to surrender his patent, and the Comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.*

This remedies an evil of long standing. Formerly there was no way of surrendering a patent. Consequently a patentee who had an invalid patent and who had no desire to utilise it, being aware of its deficiencies, might be put to the annoyance of having to submit to an order for revocation and to pay the costs of the petitioner even when the order was made by consent. The Comptroller need only hear such persons as he deems to have a right to be heard, and it is probable that only persons who have an interest in the existence of the patent will have the right to object, *e.g.*, exclusive licensees. But the Act makes no mention of the manner in which the interests of such persons are to be protected, as by compensation or otherwise, and it would be manifestly unfair to allow a patentee to

use the section to surrender a valuable patent as a weapon to bring a licensee to his knees on a subject of royalties. By sub-sect. 4 the decision of the Comptroller is made subject to appeal to the judge, and the decision of the judge is final. The procedure before the Comptroller is regulated by Patents Rule 77, and before the Court by Order LIII.A, rules 4, 5, 6.

Revocation under sect. 26 by Comptroller.

REVOCATION BY THE COMPTROLLER UNDER SECT. 26.

Sub-sect. 1 of sect. 26 is as follows:—

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

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

This remedy is limited to a particular class of persons, *viz.*, those who would have been entitled to oppose. The necessary qualifications are dealt with in Chap. VIII., on "Opposition to the Grant." The time for making the application is limited, and amounts in effect to an extension of the time for opposition. The grounds for revocation are also limited, and are specified in sect. 11 and dealt with at p. 155. It is to be noticed that by sect. 92 an appeal lies to the judge of the High Court selected by the Lord Chancellor, "*and the decision of that judge shall be final, except in the case of an appeal from a decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.*" A difficulty is created by these words. If they are construed strictly it will follow that in a case where the Comptroller declines to revoke a patent and the judge either affirms or reverses his decision there is no further appeal; and, on the other hand, if the Comptroller revokes the patent, then whatever the view taken by the judge there is an

Appeal to Court.

Further appeals.

unlimited right of appeal. If, however the words are construed to mean "a decision of the Comptroller upon an application to revoke" (which is unlikely), then there is an unlimited right of appeal in any case.

Any ground on which the Comptroller may revoke is also a ground of revocation under sect. 25, and sect. 92, as explained by the Act 8 Edw. VII., c. 4, allows the fullest appeal in the case of a petition under that section. A further question arises therefore as to whether a decision of the Comptroller or of the judge on appeal will create a bar to further proceedings under sect. 25. We submit that no such bar exists, since the opponent under sect. 25 is a "member of the public."

The power of the Comptroller is limited by sub-sect. 2.

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

Power to amend specification

Amendments here are not limited to disclaimer only as they are in actions for infringement and petitions under sect. 25. Consequently if the opposition be based on the ground that the specification does not sufficiently describe the invention or the manner in which it is to be performed, the patentee is to have an opportunity as far as possible to remedy the defect. But amendments, to be allowable, must not be of a character to make the invention substantially larger or substantially different from the invention as claimed before amendment (sect. 21, sub-sect. 6. See p. 174), and an insufficient description may not be turned into a sufficient description by adding new matter. What is permissible is the clearing up of ambiguous phrases, correction of erroneous theory, discrepancies between drawings and letterpress, &c. The remedy and the power to allow amendment of the specification are very important in view of the allegation that patents were

sometimes granted for chemical processes which were obtained on speculation with the view that means might subsequently be discovered for making them practical, to the hindrance of persons who in the meantime actually made practical discoveries in the same line. The proviso that the Comptroller is not to revoke unless the circumstances would have justified refusal of a grant, limits revocation to cases in which the *ground of opposition* is *absolutely established beyond hope of* cure by amendment. (See p. 159.)

Practice. The practice before the Comptroller is regulated by rules 75—77 of the Patents Rules.

The practice on appeal to the judge is regulated by rules 4, 5, and 6 of Order LIII.A, and will be considered at the end of this chapter.

Revocation under sect. 27.

Revocation under Sect. 27.

Prior to the Act of 1907 it had been decided that no obligation lay on a patentee to establish the manufacture of his invention in this country, and that he was at liberty to use his patent to suppress manufacture in this country, and to supply all demand for the patented article from abroad (*a*).

Sect. 27 of the Act of 1907 was passed to remedy this defect in the law. The enactment is to the effect that a patent may be revoked when it can be shown that the manufacture of the patented article is mainly or exclusively carried on abroad, unless the patentee can show some satisfactory reason why the manufacture is not carried on, or that it is carried on to an adequate extent.

The sub-section (1) is as follows:—"*At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the Comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.*" The Act says that "*any person*" may apply for revocation. The same

The applicant.

(*a*) *Badische Anilin und Soda Fabrik* v. *W. G. Thompson & Sons, Ltd.*, 1904, 21 R. P. C. 473.

expression was used in the Act of 1883, and again in the Act of 1907 when providing for opposition to the grant of a patent (*b*), and its literal meaning was not accepted. It was ruled that the opponent must be in some way directly interested in the proceedings, but the same construction will not be applied in proceedings for revocation under this section. The applicant need not be a person who is desirous of establishing a manufacture in this country. He may even be a common informer (*c*).

If the applicant for revocation succeeds in establishing that the manufacture is carried on exclusively or mainly abroad he establishes a primâ facie case for the revocation of the patent and the onus then lies upon the patentee either to show that the statement is unfounded in fact or to justify the facts as alleged, within the meaning of the statute. It is submitted that if the patented invention is not manufactured **anywhere at all**, the applicant cannot succeed. Sub-sect. (2) commences with a statement of the possible grounds of justification:—

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

"Adequate extent."

Therefore where some degree of manufacture is carried on in the United Kingdom but the bulk of it is carried on abroad, the patentee must show that the manufacture is carried on in this country to an **adequate extent.** No rules are given to guide the Comptroller or the judge (*d*) in construing these words.

The word "mainly" has been construed by Mr. Justice Parker in *Hatschek's Patents*, 1909, 26 R. P. C. at p. 240, and it is clear that its meaning is not to express a mere numerical

(*b*) See p. 156, ante.

(*c*) *Application to Revoke Hatschek's Patents*, 1909, 26 R. P. C. at p. 239. (The judgment is printed in full in the Appendix.)

(*d*) See sub-sect. 4.

ratio. The learned judge said: "If the patented article be manufactured in the United Kingdom to as great an extent as can reasonably be expected having regard to the industrial development of other countries, I do not think any presumption against the patentee can fairly arise, nor do I think that the Legislature intended it should arise. The word 'mainly' is used in the sub-section in close connection with and as an alternative to the word 'exclusively,' and having regard to this fact, I do not think that a process or article can be said to be mainly carried on or manufactured abroad, merely because it is carried on or manufactured abroad to a somewhat greater extent than within the United Kingdom. . . . To come within the sub-section the disparity must, in my opinion, be greater than a mere small percentage, and indeed if the article be manufactured or the process be carried on within the United Kingdom, not only to a substantial extent, but to an extent as substantial as may reasonably be expected, having regard to what is done abroad, I do not think the state of circumstances is that contemplated by sub-section 1."

Meaning of "Demand."

It has been said that the penalties imposed by the Act are avoided if the patented article or process is manufactured or carried on to an extent "sufficient to satisfy the demand" in the United Kingdom, but it is submitted that if the word "demand" be used in the interpretation of this Act it should mean not merely "demand for the manufactured article," but more than this it must mean "**demand for opportunity to manufacture.**" Cases may arise in which there may be no demand whatever for the manufactured article in this country, but the article which could easily be manufactured in this country for export, may be in great demand abroad. Wooden shoes may be instanced as an example. A foreign manufacturer might use a British patent to suppress the manufacture of wooden shoes in this country while supplying the demand in Holland entirely from a Dutch or German factory. It is submitted that in such a case the patent should be revoked. This view is to some extent supported by the words of the learned judge at p. 243 (q. v.).

Foreign advantage owing to Royalty only.

Cases may, and probably will arise in which the patentee has no foreign patents, but the mere difference in cost of manufacture produced by the obligation to pay a moderate royalty to the patentee may force manufacturers for a foreign market to make such goods abroad. In such a case it would be hard to punish the patentee for merely insisting upon the reasonable recognition of his rights as a patentee, and in such a case the patent ought not to be revoked. **The true test is, it is submitted, to inquire whether the patentee has used his monopoly unjustly to give a preference to the foreign manufacturer.** In the case suggested the foreign manufacturer would have an advantage not by the wish of the patentee, but through the misfortune of the patentee in having no foreign patents.

Where part only of machine is patented.

Questions have arisen as to the meaning of the words "adequate extent" when applied to the case of a patent which is granted for a **small improvement or part** of a complicated machine. It is suggested that only the **patented portions** of the machine are indicated. This view, although not supported by any direct decision, may to some extent be inferred from the decision in *Hatschek's Patent* (supra). In that case the patent had forty-five claims relating to different parts of a high-speed sewing-machine which was manufactured in America, and when brought over to this country certain unpatented accessories, not being necessary parts of the machine as a whole, were added to suit the peculiar requirements of British manufacturers. It was argued that the manufacture and adjustment of these parts would constitute manufacture "to an adequate extent." Dealing with this point the Comptroller said (at p. 56): "The first question which I have to decide is whether the patented article is manufactured in an adequate extent in the United Kingdom. For the purposes of this question, the accessories to the machine, which are alleged to be manufactured in this country, must, I think, be disregarded; for it is not suggested that any of them form part of the invention protected by the patent."

"Satisfactory reasons."

If the manufacture be not carried on in this country the onus lies on the patentee to give "**satisfactory reasons**" why

it is not so carried on. These words are more difficult to interpret (see Parker, J., in *Hatschek's Patents* at p. 241).

It is submitted that the purpose of the Act was not to punish a patentee for taking advantage of real economic advantages which may be obtained by manufacture abroad. But the allegation of such economic advantages must be definitely proved, and must not be a mere matter of probability, and moreover such economic advantages must result in a benefit to the consumer and not to the patentee only. Cases may arise of patents for processes, and for the product obtained, in which it would be well-nigh impossible to carry on the manufacture in this country owing to the fact that the necessary raw materials are unobtainable, or obtainable only at a very enhanced price. In such a case it would be manifestly unjust to deprive the patentee of his sole right of vending the product.

On the other hand, a patentee who alleged as his "reason" that his foreign manufacture had now become so well systematised and his foreign employees so skilled, that only a great increase in selling price would enable him to establish factories in this country, would have to make out a very strong case indeed to justify his action.

". . . It can never, in my opinion, be sufficient for a patentee, defending himself under the section, to prove that he cannot now start an industry with any chance of profit. The question really is: could he have done so if he had used his monopoly fairly as between home and foreign trade, or if he had devoted the time and money which he has expended in developing a foreign industry to developing a home industry? It may well be that having developed the industry abroad and given foreigners several years' start, he may find it difficult, if not impossible, to develop an industry on the same lines here, and yet such an industry might well have arisen but for the preference he has given to foreign countries" (*e*).

It is manifest that the term "satisfactory reasons" must be applied with discretion, and that no definite rule can be laid down, and all the circumstances must be taken into consideration. One of such circumstances to be considered in the exercise

(*e*) Parker, J., in *Hatschek's Patents*, at p. 243.

of such discretion to impose the penalty of revocation must be the conduct of the patentee in his endeavours to push the establishment of manufactures or the execution of licences to British manufacturers. A view seems to have been held by some people that a perfunctory advertisement of willingness to treat, issued by a patent agent on behalf of his client, would suffice to show that the latter had done his best to push his invention. This view can no longer be held after the decision in *Hatschek's Patent* (supra). The Comptroller said (p. 9): "It seems to me impossible to hold that a patentee can relieve himself from the duty of manufacturing in this country by the mere insertion at any time of a few advertisements and the sending round to manufacturers of a few circulars to which no replies were received. The advertisements and offers in this case were, I may say, of the vaguest description. They gave no intimation of the terms on which the owners of the patents were prepared to treat, beyond the statement that such terms would be reasonable." On the other hand, it is most important that a patent should not be revoked if the patentee has made bona fide endeavours to get his patent taken up (*f*). Otherwise a poor inventor with a valuable invention might easily be swindled by a combination of dishonest manufacturers, who by deliberately causing the patented article to be manufactured abroad, but refusing support to it in the United Kingdom, could lay the basis of a claim for revocation in order to bring the inventor to his knees.

The Comptroller is not bound to revoke the patent immediately. Sub-sect. 2 continues thus: ". . . *the Comptroller may make an order revoking the patent either*—

(a) *forthwith; or*

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

Suspension of order.

Provided that no such order shall be made which is at variance

(*f*) *Bremer's Patent and Högner's Patent*, The Times, May 26th, 1909, p. 3.

with any treaty, convention, arrangement, or engagement with any foreign country or British possession."

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

It is clear that a patentee must establish some very good ground for the suspension of the order of revocation. It is submitted that the main circumstance which should be taken into consideration is the patentee's own conduct in pushing the invention, having regard to his position and opportunities. At the conclusion of his judgment in *Hatschek's Patent* (supra) the Comptroller said: "The only step alleged to have been taken by the patentees with a view to compliance with the requirements of the section, before the application for revocation was made, was the issue of the vague and futile advertisements and offers above referred to during the last month of the year of grace allowed by the Act. If I were to allow any further opportunity to the patentees to comply with the requirements of the law I should be establishing a precedent, the practical result of which would be to encourage patentees to defer compliance with the requirements of the section until applications are made to revoke their patents."

On the other hand in *Weber's Patent* (1909, 26 R. P. C. 300), where the patentee had made bonâ fide attempts to induce manufacturers to consider his invention, the Comptroller (Mr. Temple Franks) gave him six months' grace.

The International Convention.

The proviso at the end of clause 2 is for the purpose of preserving the effect of article II. of the International Convention of 1902. By this clause the contracting States agree that "*the patent, in each country, shall not be liable to forfeiture on account of failure to utilise it, until after the expiration of at least three years from the date of the deposit of the application in the country concerned, and only provided the patentee cannot show reasonable cause for his inaction.*"

By sub-sect. 4 a right of appeal is given to the Court:— "*Any decision of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.*" By sect. 92, sub-sect. 2, the appeal lies to the judge selected by the Lord Chancellor, and his decision is **absolutely final.**

Appeal to Court.

The practice before the Comptroller is regulated by rules 78—81 of the Patents Rules, 1908, as modified by the notice in the *Illustrated Journal* of May 12th, 1909 (see Appendix). The onus is on the applicant to establish a primâ facie case. It is submitted that the patentee should be at liberty to state merely that "he does not admit the allegations in the declarations filed with the applications" so as to force the applicant to prove his case by evidence before the patentee is called upon for "particulars in answer" (*g*).

Practice.

The practice before the Court is regulated by rules 4, 5, and 6 of Order LIIIA.

Costs will not be granted against a patentee who promptly submits to revocation (*h*).

Costs.

The evidence before the Comptroller is to be by statutory declaration, but oral evidence may be heard in addition. The procedure as to costs is much the same as in an opposition. The appeal is brought by way of petition, and is set down as a witness action. Rule 7 says that the evidence used shall be that used before the Comptroller, and no further evidence shall be adduced without the leave of the Court. Leave to adduce further evidence will not readily be granted (*h*). It would seem, therefore, that only the declarations may be used, together with a shorthand note of the oral evidence.

If the person desiring to obtain revocation chooses to proceed under sect. 25 (see p. 248, ante) merely in order to obtain an unlimited right of appeal, it is probable that the Attorney-General would refuse the fiat (see p. 251, ante).

Procedure under sect. 25.

(*g*) *Bremer's Patent and Högner's Patent*, The Times, May 26th, 1909, p. 3.

(*h*) *Taylor's Patent*, 1909, 26 R. P. C. 381.

Holdens v Ramsden - Abr. xxxi R.P.C 323
Horne v Johnston Bros xxxviii R.P.C 365.

CHAPTER XIII.

ACTION TO RESTRAIN THREATS.

SECT. 36 of the Patents Act, 1907 (corresponding to Sect. 32 of the Act of 1883), provides, "*Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings, or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement, to which the threats related, was not in fact an infringement of any legal rights of the person making such threats:*

"*Provided that this section shall not apply if the person making such threats, with due diligence, commences and prosecutes an action for infringement of his patent.*"

Common law before 1883.

Prior to the Act of 1883, the proprietor of a patent might issue threats of proceedings for infringement broadcast without rendering himself liable to account for any of the damage which he might occasion thereby, provided such threats were made bonâ fide; in such a case the only remedy open to an injured person was to apply for an injunction to restrain the patentee from continuing to threaten him, and in this he could only be successful after showing that the statements made were in fact untrue (*a*).

In the case of malicious threats an action for damages lay similar to that of slander of title, when the plaintiff would have to show that the threat made by the defendant amounted to a "malicious attempt to injure the plaintiffs by asserting a

(*a*) *Halsey* v. *Brotherhood*, 1880, L. R. 15 C. D. 514.

claim of right against his own knowledge that it was without any foundation" (*b*).

Object of statutory change.

The object of sect. 32 of the Act of 1883 was to remedy the hardship we have described, namely, that of a man whose business is paralysed by the threats of the proprietor of a patent, without any opportunity being afforded him of putting the question to the test. The section is addressed to the case "of a patentee who causes damage by disseminating threats which he dare not or will not justify by an action, who is willing to wound but yet afraid to strike" (*c*).

The old common law remedy still lies when the case is taken out of the statute by the proviso, and in such a case the plaintiff in the threats action must show that notwithstanding that the defendant has duly prosecuted an action for infringement such action was not brought bonâ fide(*d*).

Nature of threats.

The words "**by circulars, advertisements, or otherwise**" have given rise to a number of cases in which an interpretation has been put upon them, and in which the principle of the enactment is clearly illustrated. The cause of action is not similar to libel, and there is no question of publication; therefore the manner in which the threat is made is immaterial. In *Skinner* v. *Perry* (1893, 1 Ch. 413, 10 R. P. C. 1), the plaintiffs complained of two threats—one in the form of a letter to a third party, who had enquired of the defendants whether they thought that the plaintiffs' article of manufacture infringed the defendants' patent; the other contained in a letter from the defendants to the plaintiffs themselves in reply to similar enquiries. In giving judgment for the plaintiffs, Bowen, L.J., said: "Using language in its ordinary sense, it is difficult to see that an intimation ceases to be a threat because it is addressed to a third person in answer to an enquiry, or because it is addressed to the person himself. We are not dealing with

(*b*) Per Blackburn, J., in *Wren* v. *Wield*, 1869, L. R. 4 Q. B. at p. 737.

(*c*) Per North, J., in *Day* v. *Foster*, 1890, 7 R. P. C. at p. 60; see also Lindley, L.J., in *Skinner* v. *Perry*, 1893, 1 Ch. at p. 420; 10 R. P. C. at p. 5.

(*d*) *Challender* v. *Royle*, 1887, 36 C. D. at p. 433; *Colley* v. *Hart*, 1890, 7 R. P. C. at p. 112.

libel or questions of publication—we are dealing with threats. 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" (*e*). And verbal statements will therefore probably be threats (*f*), and the use of the words "without prejudice" will not affect the matter (*g*).

Bona fides of patentee immaterial.

It is immaterial that the threat was made bonâ fide; the question to be considered is what the defendant said or did, and not what he intended; and if damage is occasioned by the circulation of a threat, it is no reply to an action to say that damage was not intended if the threatener does not bring himself within the shelter of the proviso at the end of the section (*h*).

In usual practice the defendant in a threats action has issued the threats in a solicitor's letter, or by circular to purchasers from the plaintiffs who are the defendant's rivals in trade.

General warning is not threat.

The publication of a general warning to the whole world—such as, "I have a patent for such and such a machine, proceedings will be taken against any person who infringes it"—**will not be actionable,** since this is no more than the patent itself says (*i*); but should such warning amount by implication to a suggestion that the manufactures of a certain person are infringements of the patent referred to, and be circulated in the trade to the detriment of such manufacturer, an action will lie under the section.

Save when aimed at special manufacture.

In *Challender* v. *Royle* (1887, L. R. 36 C. D. at p. 441, 4 R. P. C. at p. 375), Bowen, L.J., said: "Suppose that a manufacturer is making and issuing machines which the

(*e*) And see *Driffield Cake Co.* v. *Waterloo Mills Cake Co.*, 1886, 3 R. P. C. 46; L. R. 31 C. D. 638; *The Combined Weighing Machine Co.* v. *The Automatic Weighing Machine Co.*, 1889, 6 R. P. C. 502; 42 C. D. 66.

(*f*) See *Kurtz* v. *Spence*, 1888, 5 R. P. C. 160.

(*g*) Ibid.

(*h*) *Day* v. *Foster*, 1890, 7 R. P. C. at p. 58; *Skinner* v. *Perry*, 1893, 10 R. P. C. at p. 8.

(*i*) *Johnson* v. *Edge*, 1892, 9 R. P. C. at p. 148; L. R. 1892, 2 Ch. 1; also *Challender* v. *Royle*, 1887, L. R. 36 Ch. D. at p. 441; 4 R. P. C. at p. 375; *Ungar* v. *Sugg*, 1891, 8 R. P. C. at p. 388; *Douglas* v. *Pintsch's Patent Lighting Co.*, 1896, 13 R. P. C. at p. 610.

patentee considers to be infringements of his patent, and the patentee issued a threat really directed against the manufacture and sale of those machines, I do not think he could escape from the section by wording his notice in such terms that, according to the letter, it was only a general warning to all persons not to infringe his patent."

In the same case the same Lord Justice, in his judgment suggested that the language of the section would not apply to **threats relating to future infringements.** Commenting upon that portion of the Lord Justice's judgment in *Johnson* v. *Edge* (1892, 9 R. P. C. at p. 148), Lindley, L.J., said: "I should like to qualify that a little by saying that I think upon the true construction of this section, the section might apply to an intended infringement, provided that you could make out that the intended infringement, if carried out, would be an actual infringement." And Kay, L.J., in the same case, said: "I can easily conceive one case of future infringement which would come entirely within the mischief which this section was intended to provide against. For instance, take this case: suppose a man issued a circular saying, 'I have a patent for such and such an article; I understand that Messrs. A. & Co. have recently erected a large manufactory for the purpose of manufacturing articles, which, when made, will be an infringement of my patent.' Can it be said that a case like that would not come within the mischief intended to be provided against by this section? (*k*)."

The person aggrieved.

"**Any person aggrieved:**"—The right of action under the section is not limited merely to the person threatened, but any person, such as a rival patentee, to whom damage is occasioned by the issue of the threats is entitled to relief; so where circulars were issued to the trade intimating that the articles manufactured and sold by the plaintiff were infringements of the defendants' patent and that proceedings would be taken against any person dealing with such articles, and in consequence injury was done to the plaintiff's business, it was held that the plaintiff was a person aggrieved and could

(*k*) See also *Kurtz* v. *Spence*, 5 R. P. C. at p. 171.

maintain an action, although no threats were made to him personally (*l*).

Validity of patent may be in issue.

"**If the alleged manufacture, &c.:**"—In an action brought under this section the validity of the patent may be put in issue. In *Challender* v. *Royle*, Cotton, L.J., said: "In my opinion . . . the question whether the patent of the person making the threats is a valid patent must come into consideration if the plaintiff in the action seeks it, because I cannot see how, if a patent is invalid, there can be any act done in infringement of a legal right when the legal right depends only on the validity of that patent (*m*).

Defendant must be legal owner to succeed.

To constitute a defence to an action under this section, not only must it be shown that the act complained of was an infringement of the patent in question, but also that it was an infringement of the legal rights of the defendant, that is to say, the **defendant must be the legal owner** of the patent and not merely possessed of a beneficial interest; so in *The Kensington, &c., Electric Light Co.* v. *Lane-Fox Co.* (1891, 2 Ch. 573, 8 R. P. C. 277), where it appeared that an agreement had been entered into whereby the patentee had agreed to assign the patent alleged to have been infringed to the defendant company, but no assignment had in fact been executed, it was held that the defendants, having only a beneficial interest in the patent, had no legal rights in it capable of being infringed, and consequently the plaintiffs were entitled to judgment without entering into the consideration of the validity or invalidity of the patent.

The burden of proof.

Primâ facie the burden of proof is on the plaintiff that what he has done is not an infringement of the defendant's patent but the onus may easily be shifted on to the defendant, and the issues, including validity, will be tried as in an action for infringement (*n*).

(*l*) *Kensington, &c. Electric Lighting Co.* v. *Lane-Fox Co.*, 1891, 2 Ch. 573; 8 R. P. C. 277; see also *Burt* v. *Morgan*, 1887, 4 R. P. C. 278; *Johnson* v. *Edge*, 1892, 9 R. P. C. 142; L. R. 1892, 2 Ch. 1.

(*m*) 4 R. P. C. at p. 371; L. R. 36 Ch. D. at p. 435; see also *Kurtz* v. *Spence*, 1887, 4 R. P. C. 427; *Herrburger* v. *Squire*, 1888, 5 R. P. C. 581.

(*n*) *Challender* v. *Royle*, 1887, 4 R. P. C. at p. 371; L. R. 36 C. D at p. 435.

The proviso.

"**Provided that this section shall not apply, &c.**":—In this proviso lies the most important part of the section, and many points arise in its consideration of considerable difficulty. It is proposed to deal with it first in detail, after which the effect of the proviso as a whole will be more easily understood. To take the last portion first, it is necessary that the person making such threats should commence and prosecute an action for infringement of his patent; as has been pointed out above, the beneficial owner of a patent cannot shelter himself under the saving clause; for similar reasons an action brought by the legal owner for infringement of his patent will not be such an action as to entitle the beneficial owner to the benefit of the proviso in an action in restraint of threats brought against him by alleged infringers (*o*).

The infringement action.

Only legal owner may benefit by proviso.

The action must be in respect of infringements which were referred to in the threats circulated by the patentee. But it need not necessarily be against the person aggrieved by the threats (*p*), since in many cases an action could not be brought against him—where, for instance, the person aggrieved is a rival patentee who does not manufacture at all.

The action must be honestly brought on account of an infringement substantially similar to that which is the subject-matter of the threat, but it is immaterial whether the issue of validity is raised in the infringement action. In *Day* v. *Foster* (1890, 7 R. P. C. 54) the plaintiff, after threatening the defendant, who was a licensee under the plaintiff's patent, and also Messrs. Barrett and Elers, brought an action against the defendant for infringement and royalties; he being a licensee, was unable to dispute the validity of the patent, and consequently Messrs. Barrett and Elers were anxious to be joined as co-defendants to the action. This being refused by the plaintiff, they instituted proceedings under the section. North, J., held that the action of *Day* v. *Foster* was an action for infringement within the meaning of the proviso, and in

Validity need not be disputed.

(*o*) *Kensington and Knightsbridge Electric Co.* v. *Lane-Fox Co.*, 1891, 2 Ch. 573; 8 R. P. C. 277.

(*p*) *Challender* v. *Royle*, 1887, 4 R. P. C. 363; 36 Ch. D. 425; and see *Combined Weighing Machine Co.* v. *Automatic Co.*, 1889, L. R. 42 Ch. D. 665.

Y. v. O 26A. AC 479.

accordance with the interpretation laid down by Cotton, L.J., in *Challender* v. *Royle* (supra): "That in order to bring the case within the proviso the action must be an honest action, honestly brought in order to test the validity of the patent, or the fact of infringement, whichever may be in question"; and in consequence held that the action for threats was vexatious, and directed that all further proceedings in it should be stayed.

Must be on same patent as threats.

The action for infringement must be brought in respect of **the same patent and in respect of the same or substantially the same infringement.** In *Dowson, Taylor & Co., Ltd.* v. *The Drosophore Co., Ltd.* (1895, 12 R. P. C. 95), where the threats action was in respect of four patents on which the defendant threatened, and the infringement action was in respect of one only of these four, the motion to stay the threats action was dismissed. In *Temler* v. *Stevenson & Sons* (1898, 15 R. P. C. 24) the defendants issued general threats in respect of three patents. In the action for infringement they sued on all three patents, but abandoned one of them in the statement of claim, and abandoned another after the particulars of objections had been amended, and as to the third they discontinued the action altogether after the particulars had been re-amended. Romer, J., said (at p. 31): "Of course considerations applicable to a case like this would not concern a case where there were special threats under separate patents. I am only dealing with a case like that before me, where the particular acts were done, not under a particular patent, but where there were only general threats that what the plaintiff was doing would be stopped because of the defendants' rights as patentees generally of the three patents. In this case, it seems to me that even if the action had been originally brought on the two patents alone, it would have brought them within the benefit of the proviso."

And for same infringement.

The same considerations apply to the issue of infringement (*q*). The case of *The Lycett Saddle Co., Ltd.* v. *Brooks,*

(*q*) *Combined Weighing Machine Co.* v. *The Automatic Weighing Machine Co.*, 1889, 6 R. P. C. 502; 42 Ch. D. 665.

Ltd. (1904, 21 R. P. C. 656), which deals with this point, requires some comment. The defendants in that case had issued threats with respect to three specific types of saddle called 'L 16,' 'L 5,' and 'L 14.' The plaintiffs issued their writ on November 19th, 1903. On May 9th, 1903, the defendants had issued a writ claiming damages for infringement by the manufacture of certain saddles, not specifically mentioning 'L 5,' 'L 14,' and 'L 16.' 'L 5' and 'L 14' were not manufactured at all when the action for infringement was commenced, and so could not have been included in the particulars of breaches. It would seem from the report that the learned judge considered that the saddles complained of in the infringement action and those the subject of the threats were of the same type, and he held that the case came within the proviso. The case was therefore decided upon a question of fact only, and is no authority for the proposition that the infringement sued for need not be the same as the act in respect of which the threats are made.

Bona fides essential.

As is pointed out, the action must be brought bona fide (*r*), and the onus of proof rests on the other party to show that the action was not in fact an honest one (*s*), and so to bring the action for threats under the old common law rule requiring malice.

Due diligence.

"**With due diligence commences and prosecutes.**"—In considering whether such an action is brought with due diligence, the time of issuing the threats, and not the time when the party bringing the action first knew of the acts which he alleges to be infringements, is the period to be looked at (*t*), and it is immaterial whether the action is brought before or after the commencement of the threats action (*u*).

The Courts have refused to consider threats made after an

(*r*) *Challender* v. *Royle*, 1887, L. R. 36 Ch. D. at p. 439; 4 R. P. C. 363; *Colley* v. *Hart*, 1890, 7 R. P. C. at p. 112; 44 Ch. D. 179.

(*s*) *Colley* v. *Hart*, 1890, 7 R. P. C. at p. 112.

(*t*) *Challender* v. *Royle*, L. R. 36 Ch. D. at p. 437.

(*u*) *Combined Weighing Machine Co.* v. *Automatic, &c. Co.*, 1889, 6 R. P. C. 502; *Berliner* v. *The Edison-Bell Phonograph Co.*, 1899, 16 R. P. C. 336; *Haskell Golf Ball Co.* v. *Hutchison*, 1904, 21 R. P. C. 497.

action has been commenced for infringement, as contempt of court (*x*).

Where threats of proceedings were made by the patentee to another for the space of three years, after which continuous negotiations took place between the parties and further complaints made, it was held that an action for infringement brought on the termination of those negotiations by the patentee disclosed no lack of due diligence (*y*).

Infringement action need not be successful.

The section does not require that the action should be prosecuted to a successful termination, and the extent to which the action must be prosecuted will depend largely on the circumstances of the case.

In *Colley* v. *Hart* (1890, 7 R. P. C. 101; 44 Ch. D. 179), the facts were as follows:—On September 15th, 1888, the defendant issued a circular threatening proceedings against the plaintiff, amongst others. On the 22nd of the same month the plaintiff commenced an action to restrain the threats of the defendant; on December 6th the defendant commenced an action for infringement against the plaintiff, and delivered particulars of infringement in February in the following year, and on May 13th delivered his statement of claim. On November 7th, after the close of the pleadings, but before trial, the defendant abandoned his action for infringement. It was held that this action had been prosecuted with due diligence within the meaning of the proviso in the section. In his judgment, North, J., said (7 R. P. C. at p. 111):

May be discontinued.

"Under those circumstances, of course, he is exactly in the same position by discontinuing a hopeless action before trial as he would have been in if he had prosecuted it to trial, and had then failed. As failure at the trial would not have prevented the action being one within the proviso, so, in my opinion, the discontinuance before trial does not put him in a worse position than if he had carried it to trial."

In *The English and American Machinery Co.* v. *The Gare Machine Co.* (1894, 11 R. P. C. 627), the facts were very

(*x*) *Dunlop Pneumatic Tyre Co.* v. *Clifton Rubber Co.*, 1902, 19 R. P. C. 527; *Haskell Golf Ball Co.* v. *Hutchison*, 1904, 21 R. P. C. 497.

(*y*) *Edlin* v. *Pneumatic Tyre, &c. Agency*, 1893, 10 R. P. C. 311.

similar to those in *Colley* v. *Hart* (supra), but in this case the defendants abandoned their infringement action before delivering their reply. It was held by Chitty, J., approving of the decision of North, J., in the earlier case, and upon the same grounds, that due diligence had been exercised in the prosecution of the action for infringement.

It is difficult to say how far the above reasoning might be carried, whether the mere serving of a writ would be held to amount to prosecuting with due diligence, or is it necessary to deliver a statement of claim? No doubt the circumstances of the case must be the guide. As has been pointed out above, bona fides is required, and if that is shown to be absent, no action would be sufficient; but if, on the other hand, the Court considers that the person making the threats did commence his action bona fide, and with due diligence, a very slight amount of prosecution, probably, would take the case out of the operation of the section.

But where the defendant showed great delay in taking proceedings for infringement, in accordance with his threats, and, further, it appeared that he only took such proceedings in order to escape from the liability to which he had exposed himself by reason of those threats, it was held that such proceedings were not sufficient to satisfy the proviso (*z*).

The question of "due diligence" is therefore one of fact.

Infringement raised by counterclaim.

The action for infringement may be raised by way of counterclaim, and it will be a question of fact whether such a claim is brought with sufficient diligence (*a*).

Stay of threats action.

If an action to restrain threats has been commenced and stayed pending an action for infringement, and the action for infringement is not prosecuted with due diligence, the stay upon the first action will be removed, and an injunction will be granted.

In *The Fusee Vesta Co.* v. *Bryant and May* (1887, 4 R. P. C. 191), the action, which was one for infringement of the plaintiffs' patent, was stayed, pending the amendment by the plaintiffs of

(*z*) See, *e.g.*, *Herrburger* v. *Squire*, 1888, 5 R. P. C. at p. 594.

(*a*) *Appleby Twin Roller Chain Co.* v. *Albert Eadie Chain Co.*, 1899, 16 R. P. C. 318.

their specification. During the stay, and prior to amendment, the plaintiffs circulated post-cards among the customers of the defendants, threatening legal proceedings. On a motion by the defendants for an injunction to restrain such threats, Kay, J., granted the injunction applied for to extend to the trial of the action, or further order, the plaintiffs to pay the costs of the motion.

The effect of commencing and prosecuting an action for infringement with due diligence is to nullify the whole of the section, that is to say, its provisions cease to apply, and the rights of the person threatened are confined to those which existed prior to the Act of 1883. What those rights were has already been indicated at the commencement of the present chapter. There it was pointed out that damages could only be recovered when the threats were malicious; but since the action to satisfy the proviso must be a bona fide one, and, in fact, it has been suggested that that action was required as a sort of test whether the threats were bona fide or not (*b*), it would be practically impossible to recover damages upon the plea that the threats were in fact malicious. The result is that in such a case the only course opened to persons threatened, where the action for infringement has been dropped, as in *Colley* v. *Hart* (supra), and the question of infringement never tested in the Court, is to apply for an injunction to restrain the further issue of threats; but it is doubtful whether such an injunction would be granted under the circumstances, since, it being presumed that the threats were bona fide (*c*), the abandonment of the proceedings for infringement would imply, of necessity, that those threats would not be continued, and injunctions are only granted where there is a probability of the continuance of the acts complained of. Moreover, in the event of the renewal of the threats, the right of action under the section would be revived.

Proper course to pursue.

Where an action for infringement has been commenced after the institution of proceedings under the section the proper course

(*b*) *Challender* v. *Royle*, 1887, L. R. 36 Ch. D. at p. 439.

(*c*) See *Dredge* v. *Parnell*, 1896, 13 R. P. C. at p. 393; *Incandescent Gas Light Co.* v. *Sunlight Incandescent Gas Lamp Co.*, 1897, 14 R. P. C. at p. 188.

for the parties to pursue in the threats action was indicated by Kekewich, J. (*d*). The patentee should take steps to get rid of the threats action, or to put a stay upon it, so that no unnecessary cost should be incurred, and in that case, where it appeared that the patentees had insisted upon having the threats action set down for trial and disposed of, the learned judge, at the close of his judgment, said: "If I could with propriety make them (the patentees) pay the costs, I should be disposed to do so. I cannot do that. I dismiss the action; but I certainly shall dismiss it without costs."

But on a motion to stay an action for threats, on the ground that an action for infringement is being prosecuted, it must be shown that the letters patent, which are the subject-matter of the two actions, must be the same. So where the threats action was in respect of four patents on which the defendant threatened, and the infringement action was in respect of one only of these four, the motion to stay the threats action was dismissed (*e*). But where the defendant has threatened, on the strength of several patents, he is not compelled to use all of them in the infringement action (*f*) (see p. 274, supra).

General effect of section.

The effect of the section, taken as a whole, is not to deprive a patentee of the power, or it may be termed the duty (*g*), of warning infringers before rushing into litigation; but it does limit that power to one class of patentees, that is to say, only a man who is in possession of a patent which he is willing and intends to support in a Court of law may threaten others with legal proceedings in respect of it. A. may be infringing through ignorance, B. through design, but both possibly would desist on receipt of a warning. But when an alleged infringer shows that, in spite of the warnings, he has no intention of desisting from the acts complained of, the patentee must put his threat

(*d*) *Combined Weighing, &c. Co.* 1898, 15 R. P. C. 34; *Lycett Saddle Co.* v. *Brooks*, 1904, 21 R. P. C. 656.

(*e*) *Dowson-Taylor Co., Ltd.* v. *The Drosophore Co., Ltd.*, 1895, 12 R. P. C. 95.

(*f*) *Temler* v. *Stevenson & Sons*, 1889, L. R. 42 Ch. D. 665.

(*g*) Per Jessel, M.R., in *Halsey* v. *Brotherhood*, 1880, L. R. 15 Ch. D. at p. 517.

into execution, by which means alone can he escape liability under the provisions of this section.

Interlocutory injunction.

In *Challender* v. *Royle* (1887, L. R. 36 Ch. D. at p. 435), upon the subject of an interlocutory injunction to restrain threats, Cotton, L.J., said: "I think, however, that before going to the proviso I ought, having regard to the judgment of the Vice-Chancellor, to state my opinion as to how the matter ought to be dealt with in an interlocutory application. As far as I understand the Vice-Chancellor, he seems to have considered that he could not enter, or that he need not enter, at this stage of the cause into the question whether the sale of the plaintiff's tap-unions was an infringement of the defendant's patent, or whether that patent was a valid patent, and that all he need consider was the balance of convenience and inconvenience as between these parties in granting or refusing the interlocutory injunction. I must express my dissent from that view. It is very true that in all cases of interlocutory injunction the Court does consider and ought to consider the balance of convenience and inconvenience in granting or refusing the injunction. But there is another and very material question to be considered—Has the plaintiff made out a primâ facie case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, though I quite agree that the Court ought not on an interlocutory injunction to attempt finally to decide the question whether the act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of these points the plaintiff in the action has made out a primâ facie case, and unless the Court is so satisfied it would be wrong to grant an injunction merely on the ground that it cannot do the defendant any harm."

Where there was a serious conflict of testimony as to the fact of infringement, the Court refused to grant an interlocutory injunction (*h*).

(*h*) *Barney* v. *United Telephone Co.*, 1885, 2 R. P. C. 173.

In *Colley* v. *Hart* (1889, 6 R. P. C. 17), which was a motion for an interlocutory injunction to restrain threats, North, J., said: "When there is a doubt whether the thing does infringe what he calls his rights or not, the fact that the defendant refrains from bringing an action to assert his rights is a fact I cannot leave out of consideration in forming an opinion as to whether he has such rights or not."

Form of injunction.

The injunction being by far the more important remedy, it seldom occurs that a substantial sum in damages is asked for or granted. The form of injunction granted in *Mountain* v. *Parker and Smith* (1903, 20 R. P. C. at p. 774) is given in the Appendix.

Damages.

The best course is for the judge to assess the damages at the trial. They are usually problematical, and depend upon a general impression of the case rather than upon a close examination of figures, and the cost of a reference for inquiry would be as a rule quite out of proportion to the amount that could be awarded. See, for example, *Ungar* v. *Sugg* (1892, 9 R. P. C. 113) (*i*).

Particulars.

The defendant in an action under this section is entitled to particulars of the threats upon which the plaintiff relies (*k*), and if the validity of the patent is put in question the general rules relating to particulars of objections will apply (*l*). Those rules will be considered in detail hereafter.

Where there was a doubt upon which patents the defendants had based their threats, the Court ordered that the defendants should deliver to the plaintiffs a list of such patents (*m*).

And where the plaintiffs alleged that the threats were made by the defendants' agents, it was held that the defendants were entitled to particulars of the names of those agents (*n*).

(*i*) But see *Skinner* v. *Perry*, 1894, 11 R. P. C. 406; *Hoffmann* v. *Salsbury*, 1899, 16 R. P. C. 375.

(*k*) *Law* v. *Ashworth*, 1890, 7 R. P. C. 86.

(*l*) Ibid., and *Union Electrical Power Co.* v. *Electrical Power Storage Co.*, 1888, 5 R. P. C. 329.

(*m*) *Union Electrical Power Co.* v. *Electrical Storage Co.*, 1888, 5 R. P. C. 329; 38 Ch. D. 325.

(*n*) *Dowson-Taylor* v. *The Drosophore Co.*, 1894, 11 R. P. C. 536.

CHAPTER XIV.

INFRINGEMENT OF LETTERS PATENT.

Royal Command in Letters Patent.

THE infringement of a patent is the doing that which the patent prohibits from being done (*a*). The words of the Royal Command are as follows: "We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years, either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license 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."

No duty to warn infringers.

There is no duty cast upon a patentee to inform persons that what they are doing amounts to an infringement of his patent, and he is not estopped by omitting to give such information, although he knew of the infringement, from subsequently bringing his action (*b*). If, however, the patentee **were to falsely represent** to a manufacturer that the wares manufactured by him were not an infringement of the patent, and thereby induced him to spend money on further manufactures or otherwise to place himself at a disadvantage, the conduct of the patentee would have amounted to acquiescence, and he could not succeed in an action for infringement (*c*).

(*a*) *Walton* v. *Bateman*, 1842, 1 W. P. C. at p. 615.

(*b*) *Proctor* v. *Bennis*, L. R. 36 Ch. D. 740.

(*c*) Ibid. at p. 760.

Infringement is question of fact.

The **question of infringement** or no infringement is one of fact (*d*), after the specification has been construed and its ambit determined as a matter of law (*e*). But this refers to the mere infringement alone within the meaning of Tindal, C.J., in *Muntz* v. *Foster* (1843, 2 W. P. C. 99), when he told the jury that "for the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection arises either to the nature of the grant or the specification which has been enrolled by the plaintiff."

No infringement of invalid patent.

If the patent be invalid there can be no infringement in the sense that a patent which has no legal existence cannot be infringed. But assuming that it has a legal existence, the question is for the jury. (This explains the apparently contradictory decision in *Curtis* v. *Platt* (1866, L. R. 1 H. L. 337; 35 L. J. Ch. 852), in the House of Lords. The question of infringement was there taken as involving the validity of the patent.)

Ignorance no excuse.

It is equally an infringement whether the defendant acted in ignorance of the plaintiff's patent or not. In *Heath* v. *Unwin* (1845, 14 L. J. Ex. at p. 156; 2 W. P. C. at p. 227), Parke, B., delivering the judgment of the Court, said: "There was therefore no intention to imitate the patentee's invention, and we do not think the defendant can be considered to be guilty of any indirect infringement if he did not intend to imitate at all." This judgment certainly gives an erroneous impression of the law, and subsequently, when *Heath* v. *Unwin* (1854, 25 L. J. C. P. at p. 19; 5 H. L. at p. 537) came before the House of Lords, the opinion of the judges being taken, Parke, B., acknowledged the error into which the Court had fallen.

No intention.

In *Stead* v. *Anderson* (1847, 2 W. P. C. at p. 156), Wilde, C.J., tersely puts it: "The question of infringement depends not on what the defendant intends, but on what he does."

So it is **immaterial whether the defendant was aware** that the thing was patented or not, since in law every person in the realm

(*d*) *Walton* v. *Potter*, 1841, 1 W. P. C. at p. 586; *De la Rue* v. *Dickenson*, 1857, 7 E. & B. at p. 738.

(*e*) See p. 104, supra.

is taken to have notice of a patent in the same way that he is taken to be aware of the law (*f*).

Save as to question of remedy.

The bona fides of the infringer does, however, affect the rights of the patentee with respect to the remedy which he may obtain (*g*).

And the converse is also sound—if a person intending to infringe a patent does not in fact do so, he will not be taken to have infringed (*h*).

In *M'Cormick* v. *Gray* (1862, 31 L. J. Ex. 42) the specification, after describing several parts of reaping machines, including some cutting blades of peculiar construction, claimed: "The construction of reaping machines according to the improvements before described—that is to say, the constructing and placing of holding fingers, cutting blades, and gathering reels, respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed."

The defendant made and sold cutting blades similar to those described by the plaintiff's patent, which were *capable of being used* in the plaintiff's reaping machine. Bramwell, B., in giving judgment, said (at p. 48): "A man could not make the blade of a knife without infringing this person's patent, because you may intend to put it into a machine, or you may not. I think it is a very clear case, and I am satisfied there is no difference between making a thing with one intent and making it with another, because I always understood that if a man may do a thing, he may do it with whatever intent he pleases." It will be observed, that in this case to make the knives was no infringement, and there was no evidence of the defendant having applied them to reaping machines.

Thus we see that infringement, as taken apart from the

(*f*) And see *Wright* v. *Hitchcock*, 1870, L. R. 5 Ex. at p. 47; *Young* v. *Rosenthal*, 1884, 1 R. P. C. at p. 39.

(*g*) See sect. 33 of the Act of 1907.

(*h*) *Newall* v. *Elliott*, 1864, 10 Jur. N. S. at p. 958; 13 W. R. at p. 18; see also *Saccharin Corporation* v. *Reitmeyer & Co.*, 1900, 17 R. P. C. at p. 612.

question of validity, is a matter of fact, and that intention is not material to the conclusion.

Proof of an intention to infringe, apart from actual infringement, may, however, justify an injunction to restrain such infringement (*i*).

To prove infringement, it must be shown that there is a **substantial resemblance.** The infringement must be of a part for which the patent was granted, and not merely of a part described in the specification.

The question as to **what will or what will not amount to infringement,** like many other points which arise in the law of letters patent, must depend upon the facts of each particular case, and the decision in one case cannot possibly bind the decision in another; consequently the consideration of decided cases is only useful as showing the principles which underlie the judgments in those cases.

In *Nobel's Explosives Co.* v. *Anderson* (1894, 11 R. P. C. at p. 127), Romer, J., said: "Several cases were cited to show the canons of construction on which the Courts have acted in different cases relating to infringements. But it is not necessary for me to deal with these cases in detail, for I desire emphatically to state that, in my view, **one principle only governs all the cases,** whether they relate to so-called 'master' patents, or patents dealing with discoveries in matter of principle, or to any other kind of patent; and that principle is this: In order to make out infringement, it must be established, to the satisfaction of the Court, that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent; not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification" (and see p. 293, post).

One principle governs all cases.

But the consideration of the question of infringement is much simplified if one remembers that inventions may be divided roughly into two classes in respect to subject-matter (see p. 42, supra). **Firstly** there is that kind of invention which

But two classes of inventions.

(*i*) See Index, Cap. "Injunction."

consists in the discovery of a **method of application of a new principle**—here what has been invented is in effect the new principle, and, generally speaking, the Court will regard jealously any other method embodying that principle, for the patentee was not bound to describe every method by which his invention could be carried into effect. **Secondly** there is that kind of invention which consists in some particular new method of applying a well-known principle, and in this case the use of other methods is not contemplated by the patentee, and such will not fall within the ambit of his claim. It is important to remember that, as was pointed out by Romer, J., in the passage quoted above, the **claim** made by the patentee is the point to be considered, not the actual merit of the invention.

In the case above cited, in the Court of Appeal (1894, 11 R. P. C. at p. 527), Kay, L.J., in his judgment, said: "I think the law now is reasonably well settled. There are two classes of cases: one where a patentee has invented a **new method of producing a known result**, the other where he has **invented a new result, and has described one method of producing it.**"

Claims to principles.

A difficulty of some theoretical interest, but of little practical importance, has arisen upon the question whether a claim to a method of carrying out a new principle will cover every other method of carrying out that principle (*k*). We venture to say "of little practical importance" because claims may be drafted which without being bald claims to a principle will nevertheless cover every method of carrying that principle into effect. In *Jupe* v. *Pratt* (1 W. P. C. at p. 146), in the course of the argument Alderson, B., said: "You cannot take out a patent for a principle. You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect. If you have done that, then you are entitled to protect yourself from all the other modes of carrying the principle into effect, that being treated by the jury as

Baron Alderson's dictum.

(*k*) See p. 39, ante, for further discussion of this topic.

a piracy of your original invention." This statement of the law was approved by the House of Lords in *Chamberlain and Hookham, Ltd.*, v. *Bradford Corporation* (1903, 20 R. P. C. at p. 684), and by Parker, J., in *The British United Shoe Machinery Co., Ltd.*, v. *Simon Collier, Ltd.* (1908, 26 R. P. C. at p. 49), but when the words ". . . patent for a principle *coupled with* the mode . . ." are closely examined it is easy to see that they are liable to misinterpretation. Alderson, B., did *not* say that in such a case the specification could end with two distinct claims, one for the principle irrespective of its application, and the other for the method of application—his meaning is made clear by his observations in *Neilson* v. *Harford* (1 W. P. C. at p. 355). The dictum in *Jupe* v. *Pratt* and the subsequent observations in *Neilson* v. *Harford* were dealt with by Lindley and Cotton, L.JJ., in *The Automatic Weighing Machine Co.* v. *Knight* (1889, 6 R. P. C. 297). Lindley, L.J. (at p. 308), said: "The passage from *Jupe's* case goes rather further than the passage which I am going to read, and which I have always regarded as the best exposition I know of the law upon this subject. . . . It was in answer to the argument, I think, of Sir William Follett. Sir William Follett said: 'I say we do claim every vessel, every shape of vessel, closed vessel, in which air can be heated between the blowing apparatus and the furnace.' Then Mr. Baron Alderson says this, 'Then I think that is a principle if you claim every shape. If you claim a specific shape, and go to the jury and say that which the other people have adopted is a colourable imitation, then I can understand it. If you claim every shape you claim a principle. There is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself. You must detail some specific mode of doing it. Then the rest is a question for the jury.' That, I take it, explains in short language the real state of the law as it at present stands." And in the same case Cotton, L.J., said, referring to the dictum in *Jupe* v. *Pratt*: "Those were the expressions used by Baron Alderson during the discussion, probably to meet something that was said by counsel, and did not express his full opinion. You can prevent anyone from

Criticised by Lindley, L.J.

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. That is what we had to consider in *Proctor* v. *Bennis* (1887, 4 R. P. C. 333). Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle, and say they do it by a different mode, and looks to see whether, in effect, although the mode is not exactly the same, it is only a colourable difference, a mechanical equivalent for a substantial part of the patentee's invention being looked upon as a mere colourable difference, and, therefore, he being entitled to an injunction against that mode of carrying out his principle, which is only the same in substance as that which he patented, though there are colourable differences "(*l*).

No valid claim to principle.

It is submitted that a claim cannot be sustained for a bare principle or for every method of applying a principle whether that principle be new or old, but when the principle is new the Court will give a wide construction to the claim. The Court in every case will inquire in what the essence of the invention as claimed consists, and will hold the defendant to have infringed if he has taken the pith and marrow of the invention as claimed (*m*), and when the invention is merely for an improved mode of attaining an old object the pith of his invention is that particular improved method, and only by making use of that particular method will a man be held to have infringed; but when the invention is for a new method of attaining a new result, the novelty of the result itself is part of the merit of the invention and of the consideration given by the patentee in return for the grant; and, consequently, a man will be held to have infringed if he should have arrived at the same result by means of a process substantially the same as, or only colourably different from, that disclosed in the specification,

(*l*) And see the observations of Lord Esher, M.R., and Kay, L.J., in *Nobel's Explosives Co.* v. *Anderson*, 1894, 11 R. P. C. at pp. 525 and 527; and Halsbury, L.C., in *Ashworth* v. *English Card Clothing Co.* 1903, 20 R. P. C. at p. 797.

(*m*) *Clark* v. *Adie*, 1877, L. R. 2 App. Cas. at p. 320.

of the original invention (*n*). In other words there are two classes of invention, but only one principle governing the law of infringement.

In *Curtis* v. *Platt* (1863, L. R. 3 C. D. 136, n.), Wood, V.-C., said: "Where the thing is wholly novel, and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machine for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before, has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because, otherwise, that would be to say that the whole world is to be precluded from achieving some desirable and well-known object which everybody has had in view for years. In such a case it may be said that the means taken are simply mechanical equivalents for the means previously adopted for arriving at the same object." **Curtis v. Platt.**

In *Proctor* v. *Bennis* (1887, 4 R. P. C. at p. 355), Cotton, L.J., referring to the patent sued on in *Curtis* v. *Platt*, said: "It was specially to introduce improvements into the mechanical, means and arrangements which a previous patentee had used to obtain a well-known object in a well-known machine. **Proctor v. Bennis.**

(*n*) *Curtis* v. *Platt*, 1863, L. R. 3 Ch. D. 136, n.; *Proctor* v. *Bennis*, 1887, 4 R. P. C. 333; *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. 437; *Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 R. P. C. 297; *Thompson* v. *Moore*, 1889, 6 R. P. C. 426; *Tweedale* v. *Ashworth*, 1890-92, 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121; *Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 1891, 8 R. P. C. 345; 9 R. P. C. 41; *Miller* v. *Clyde Bridge Steel Co.*, 1892, 9 R. P. C. 470; *Ashworth* v. *Roberts*, 1892, 9 R. P. C. 309; *The Incandescent Light Co.* v. *De Mare*, 1896, 13 R. P. C. 301; *Consolidated Car Heating Co.* v. *Carne*, L. R. 1903, A. C. 509; 20 R. P. C. 745; *Ashworth* v. *English Card Clothing Co.*, 1903, 20 R. P. C. 790; *British Vacuum Cleaners* v. *Suction Cleaners Ltd.*, 1904, 21 R. P. C. 303; and many other cases.

Therefore in that case, in applying those words used by the judges, we must deal with the case before them and come to the conclusion, as I do, that what they meant was this, that where there is no novelty in the result, where neither the machine nor the result is new, there you must tie down the patentee, who claims an improvement in the machinery for producing in a known machine that result, strictly to the invention which he claims, and the mode of effecting the improvement which he says is his invention. But here the throwing coal on to the furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. It is true there had been previous though imperfect machines for feeding furnaces automatically, but that had not been done previous to this machine by any intermittent radial action of a flap or door, as was done by the plaintiff, and apparently successfully done by him. In my opinion, therefore, these opinions expressed by the judges with reference to mere improvements in an old machine for an old purpose cannot lay down any law for a case like this, where the result of throwing coal on to the furnace by the intermittent radial action of the flap is first applied in a machine invented by the plaintiff. There was not only novelty in the machine, but there was novelty in the effect, and in the result to be produced by that machine."

There is no distinction whatever in principle between the two classes of cases. The question is invariably: "What is the subject-matter of the invention?" If the invention is the new result, it is not for the means of producing it only; on the other hand, if the invention is a new means of producing an old result, only substantial imitation of those means will infringe. (See Chapter IV., "Subject-matter.")

The kinds of invention which fall within the class of which *Proctor* v. *Bennis* is a type, sometimes called "pioneer" or master patents, and to which a wide construction will be given, are—

(1) A method of application of a new principle.

(2) A new machine, material, or process for a new purpose.

The *Curtis* v. *Platt* type, in which a narrow construction will be given, are—

(1) The novel application of an old principle.
(2) A new machine, material, or process for an old purpose.
(3) An old machine for a new purpose.

"Combination" patents will be further considered with reference to certain special points, but whether they fall within the wide construction or the narrow construction class depends on the circumstances of each case, and the fact that they are combinations is immaterial on the question of principle.

Construction of the specification.

In order to ascertain what the subject-matter of the invention is, it is necessary to construe the specification having regard to the state of knowledge in the trade at the time of the invention. (See p. 294, post, and p. 108, ante.)

Improvement does not negative infringement.

If a man has taken the pith of an invention, the fact that he has improved upon it is immaterial; he has nevertheless infringed (*o*).

Infringement by taking part only.

The principles that underlie the question of infringement, **by taking a part only of the invention**, were very fully and clearly considered by Mr. Justice Wills in *The Incandescent Gas Light Co.* v. *The De Mare Incandescent Gas Light System* (1896, 13 R. P. C. at p. 330). In his judgment the learned judge deals with the means by which the relative importance of different parts of the invention is to be ascertained, and consequently in what part the **substance** lies, as follows:—"In dealing with the question of construction, I have carefully avoided any reference to the relative importance of different parts of the invention. In dealing with the question of infringement, it is impossible not to consider them. Infringement is a question of fact for the jury, if there be one; and the question is not whether the substantial part of the process, said to be an infringement, has been taken from the specification; but the very different one, whether what is done, or proposed to be done, takes from the patentee the substance of his invention. What the thing invented is must be gathered from the specification

(*o*) *Neilson* v. *Harford*, 1841, 1 W. P. C. at p. 310; *United Telephone Co.* v. *Harrison*, 1882, 21 C. D. at p. 740; *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. at p. 454; *Thomson* v. *Moore*, 1889, 6 R. P. C. at p. 436; *Wenham Gas Co.* v. *Champion Gas Co.*, 1892, 9 R. P. C. at p. 55; *Pilkington* v. *Massey*, 1904, 21 R. P. C. at p. 437.

alone, and the patentee cannot escape from the thing he has claimed as the standard, and the only standard with which to compare the alleged infringement, so as to see if it constitutes substantially the appropriation of the thing claimed. When, however, you come to make that comparison, how can you escape from considering the relative magnitude and value of the things taken and of those left or varied? It is seldom that the infringer does the thing, the whole thing, and nothing but the thing claimed by the specification. He always varies, adds, omits; and the only protection the patentee has in such a case lies, as has often been pointed out by every Court, from the House of Lords downwards, in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated. It is contended by the defendants that what is important, and what is of subsidiary consequence, can only be gathered from the specification itself. I am satisfied that that neither is nor can be the law. . . . There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken, except by seeing what they are worth as compared with the things which have been taken bodily from the invention." The earlier authorities of *Clark* v. *Adie* and *Proctor* v. *Bennis* were then analysed in detail.

Relative importance of parts.

The question of relative importance, therefore, remains one of fact to be decided on evidence. But in saying that the **relative importance of parts** of the invention is to be ascertained as a **question of fact** and by means outside a direct reference to the specification, the learned judge was clearly referring to cases in which the patentee has not given any indication of what he considers essential. Where, however, the patentee has **expressly claimed some specific means** of accomplishing an object, he will be tied down to that means, for it must be remembered that **what is protected is what is claimed**, and not all that is described (see p. 297, *post*). Bowen, L.J., in *Jackson* v. *Wolstenholmes* (1884, 1 R. P. C. at p. 108), said: "It must be remembered that **claims are for the security of patentees**, to prevent it being said that the patentee has claimed more than can be really supported as his invention."

In *Dudgeon* v. *Thompson* (1877, L. R. 3 A. C. 44), Lord Cairns makes strong objection to the use of the term **colourable imitation**, in connection with the infringement of patents, and proceeds:—"If there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the Court, that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it; taken, it may be, something away from it, so that of the whole of it may be said, as is said in this injunction: Here is a machine, which is either the plaintiff's machine or differs from it only colourably. But underlying all that there must be a taking of the invention of the plaintiff. There used to be a theory in this country that persons might infringe upon the equity of a statute, if it could not be shown that they had infringed the words of the statute; it was said that they had infringed the equity of the statute, and I know there is, by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. My lords, I cannot think that there is any sound principle of that kind in our law; **that which is protected is that which is specified**, and that which is held to be an infringement must be an infringement of that which is specified. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected by the specification be taken notwithstanding."

An interesting case of an inventor limiting himself by his claim to something narrower than he had actually invented, and thereby failing to catch an infringer, is to be found in *The Incandescent Gas Light Co.* v. *The Sunlight Incandescent Gas Lamp Co.* (1896, 13 R. P. C. 333). The real nature of the discovery was that a skeleton of earthy oxides could be produced, which, when suspended in a Bunsen flame, formed an illuminant. The claim, however, was limited to the manufacture of such a skeleton of certain specified materials, and in a certain specified manner. The defendant skilfully avoided the patent by making use of the principle, but producing the

skeleton of different substances, and manufacturing in a different manner. Lord Justice Romer said, in *Nobel's Explosives Co.* v. *Anderson* (1894, 11 R. P. C. at p. 128): "In order to make out infringement it must be established to the satisfaction of the Court that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent, not the invention which the patentee might have claimed, if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification." In *Bunge* v. *Higginbotham* (1901, 18 R. P. C. at p. 206; 1902, 19 R. P. C. at p. 199), Kekewich, J., said on this point of the substance of the combination: "But in order to ascertain whether any part of the combination, which is absent in the alleged infringement, can be dispensed with so as still to hold the latter to be an infringement, one must go back to the specification, and one must hear what the patentee himself has said about it. . . . You must find whether he considers the one part which has not been taken to be an integral part of his invention, or perhaps it would be better to say an essential part of his invention."

Infringement is of specified claim only.

Lord Alverstone, L.C.J., in *The Presto Gear Case and Components Co.* v. *Orme, Evans & Co.* (1901, 18 R. P. C. at p. 23), said: "In patent cases I have always felt that there is a line of thought which is most likely to lead you to the right result in the speediest way. The first thing, assuming you understand the alphabet of the science or art, is to clearly understand what was the previous state of knowledge. Having got, either by agreement or deduction from the evidence, a clear view as to what was the previous state of knowledge, you must then construe the specification with reference to that, disregarding issues of novelty or subject-matter which may arise in the particular case, and you then have to consider whether or not the infringement comes within the fair meaning of the claims—not anything else, but the claims read in the light of the previous state of knowledge, and without altering the words unduly in favour of the patentee or infringer."

How to approach infringement.

Combinations how infringed.

The cases in which a **claim for a combination** is alleged to be infringed do not differ in general principles from any other kind of infringement. But they are liable to give rise to difficulty under either of the following circumstances:—(a) A part only of the combination may be taken; or (b) A mechanical or chemical equivalent may be substituted for a portion of the combination.

In *Nordenfelt* v. *Gardner* (1884, 1 R. P. C. at p. 65), Brett, M.R., said: "The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement, or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same; and in any case, notwithstanding such colourable alteration, there may be an infringement. An *alteration by addition* may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An *alteration by subtraction, if it were more than a colourable subtraction*, would, as it seems to me, alter the combination. It would not be a combination of the same things, it would be a combination of different things; and if the combination were altered by *a material subtraction*, I should think that it was a new combination. But an *alteration by substitution*, that is, by substitution of one of the *material* elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and a putting in of a

new material element which is different from any of the elements of the former."

In *Clark* v. *Adie* (1875, 10 Ch. at p. 675), Lord Justice James said: "A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact, every, or almost every, patent is a patent for a new combination. The patent is for the entire combination; but there is, or may be, an essence or **substance of the invention** underlying the mere accident of form, and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact, whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination." And when the same case reached the House of Lords (1877, 2 A. C. 320), Lord Cairns, L.C., said: "One mode of infringement would be a very simple and clear one; the infringer would take the whole instrument from beginning to end. . . . About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument described; he might make an instrument which in many respects would resemble the patent instrument, but would not resemble it in all its parts. And there the question would be, either for a jury or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. And it might well be, that if the instrument patented consisted of twelve different steps, producing in the result the improved clipper, 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 and represented upon his machine."

In *Sellers* v. *Dickenson* (1850, 5 Ex. at p. 324), Pollock, C.B., said: "There may be an **infringement by using so much of a combination as is material** . . . if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it another mechanical equivalent, that would be an infringement of the patent."

As in the case of other kinds of inventions, it will be seen that the materiality of the portion of a combination that has been taken by the infringer, *i.e.*, the question of whether that portion is or is not the pith and essence of the invention, is a question of fact to be decided by evidence (but see p. 292, *ante*). No fine lines can be drawn as to what amounts to substantial imitation. In *Clark* v. *Adie* (1877, L. R. 2 A. C. at p. 335), in the House of Lords, Lord Blackburn said: "I incline to agree with what was said in the Exchequer Chamber in the case of *Lister* v. *Leather* (1858, 8 E. & B. 1004; 27 L. J. Q. B. 296), that you cannot decide in the abstract whether the using of two parts, A and B, of a combination of A, B, and C, is or is not using part of that invention; nor can you decide in the abstract the other question, which was somewhat discussed in the case of the sewing machine (*Foxwell* v. *Bostock*, 1864, 12 W. R. 723), whether or not the specification shows that A or B is sufficiently claimed as a part of the invention or not. I do not think that either of those questions can be decided in the abstract. I would wish—like the Exchequer Chamber in *Lister* v. *Leather*—before deciding it, to have before me the nature of the machine, in order that I may see what A, B, and C are, and what is their relation to each other."

Combination does not protect integers.

A patent for a combination is not infringed by taking separately the integers which are comprised in that combination. For some considerable time it was thought that the judgment in *Lister* v. *Leather* (1858, 8 E. & B. 1004) established the contrary proposition, but, as was pointed out by Fletcher Moulton, L.J., in his elaborate review of the authorities in *The British United Shoe Machinery Co., Ltd.* v. *A. Fussell & Sons, Ltd.* (1908, 25 R. P. C. at p. 653), the law on this

point was not correctly stated in that case, but was made clear by Lord Cairns in *Clark* v. *Adie* (1873, L. R. 2 A. C. at p. 321): "Suppose, my lords, that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which possibly were old in themselves, but which, put together and used as he puts them together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then, my lords, the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind, and has intended to claim, protection for those subordinate integers; and moreover he is, as was said by the Lords Justices, at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

Substitution of equivalents.

There is a description of imitation which is produced by the substitution of chemical or mechanical equivalents. To the unscientific eye there is a total dissimilarity between the infringing machine or process and the original; but, none the less, it is a mere imitation—it is a robbery of the ideas and intentions of the first inventor, but a robbery conducted in a scientific manner. A great deal of confusion has been caused by misunderstanding the term "mechanical equivalent." As has been pointed out many times, the question is always, "What is the invention?" And the use of a mechanical equivalent for that which the plaintiff has invented, which at the time of the act complained of is known as an equivalent, is always an infringement (*p*). It is not true to say that "the doctrine of mechanical equivalents does not apply in the *Curtis*

(*p*) *Bunge* v. *Higginbotham*, 1902, 19 R. P. C. at p. 196.

v. *Platt* type of cases." A patent which did not cover all known mechanical equivalents would be void for want of invention. The narrowest claim for a particular means of attaining an old ultimate result may be infringed by the use of a mechanical or chemical equivalent, *i.e.*, an obvious method of carrying out the same invention, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity for any inventive power whatever. The confusion has arisen partly because the expression "new result" has been loosely applied, sometimes to mean the ultimate result, and sometimes to mean the new effect immediately produced by the invention. In this latter sense all inventions must produce a new result, or they would fail for want of utility. Things may be mechanical equivalents for many purposes, and yet not for the purpose immediately at hand. A fire-tongs is in many aspects the mechanical equivalent of a dental forceps, but not for the purpose of extracting teeth. Sulphuric acid is a chemical equivalent for nitric acid as far as the reddening of litmus is concerned, but is far from an equivalent in the manufacture of explosives. Equivalents may be substituted for parts as well as for the whole invention, so that it may happen that a patent may be taken out which consists of three parts, and an equivalent may be substituted for each part, so that in effect the whole invention may be changed, and yet there may be a most flagrant infringement.

Knowledge of equivalent at date of patent effect of, discussed.

It is submitted that whether the substituted equivalent was known to be such at the date of the patent or was subsequently discovered is immaterial to the issue of infringement. It might well be that the substitution of a subsequently discovered equivalent might in itself be good subject-matter for a patent, but it would none the less be an infringement. But it is necessary that the claim should be sufficiently wide as to include in its generic terms any specific example subsequently discovered, and the whole question of infringement thus turns upon the construction of the claim.

Take, for instance, the case of *Stevens* v. *Keating* (1847, 2 W. P. C. 181). Here the patent was for the manufacture of cement. The cement was made from gypsum (sulphate of lime)

by admixing it with pearl-ash (carbonate of potash) and sulphuric acid. Chemically, the effect was this: A salt, sulphate of potash, was produced; this, combined with the sulphate of lime, produced a double salt, which, when submitted to a high temperature and subsequently ground to a fine powder, constituted the cement. The specification terminated thus: "And whereas other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my said invention, though none that I have tried have answered so well as the alkali and acid hereinbefore set forth, and whereas I claim as my invention the processes of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning, heating or calcining the same, for the purposes hereinbefore set forth." The principle of this discovery was that sulphate of lime combined with salts of potash or soda, and, when so combined, produced a substance which set very hard. The defendant substituted for the pearl-ash and sulphuric acid a salt which is a chemical equivalent, borate of soda (borax), and heated that with gypsum, producing in the same manner a double salt, and with the same resulting property of setting. This was properly held to be an infringement.

In *Unwin* v. *Heath* (1855, 5 H. L. C. 505) the patentee said in his specification: "I propose to make an improved quality of cast steel, by introducing into a crucible bars of common blistered steel, broken, as usual, into fragments, or mixtures of cast or malleable iron, or malleable iron and carbonaceous matters, *along with from one to three per cent. of their weight of carburet of manganese*, and exposing the crucible to the proper heat for melting the materials, which are, when fluid, to be poured into an ingot mould in the usual manner; but I do not claim the use of any such mixture of cast and malleable iron, or malleable iron and carbonaceous matter, as any part of my invention, *but only the use of carburet of manganese in any process for the conversion of iron into cast steel.*" In another part of the specification he said: "I claim the employment of *carburet of manganese* in preparing an improved cast steel." At the date of the patent carburet of manganese was well

known and very expensive. The defendant heated broken iron with coal tar and oxide of manganese—an inexpensive process. The evidence of the plaintiff was to the effect that carburet of manganese was actually formed in the defendant's melting pot at the moment of fusion. The House of Lords took the opinions of the judges, and Pollock. C.B., and Parke, B., considered that upon the construction of the specification the alleged infringement was not within its ambit and was *not an equivalent*, and expressed the opinion that a subsequently discovered equivalent could not be an infringement. We venture with the greatest respect to the memory of these great judges to suggest that this opinion was erroneous, and it was clearly unnecessary to the decision of the case. The more accurate test was applied by Lord Brougham, who in his judgment referred to *Stevens* v. *Keating*, *supra*. "I come at once to the case which is chiefly relied upon, namely, *Stevens* v. *Keating*, which came before Lord Cottenham (*q*), and in which, the patent being for making cement by uniting gypsum with an acid and an alkali, the defendant made cement (which was the alleged infringement) by uniting gypsum with borax, and it being discovered that borax was composed of an acid and an alkali, Lord Cottenham held that uniting gypsum with borax was uniting gypsum with an acid and an alkali; and that consequently there was an infringement of the patent, which was granted for gypsum united with an acid and an alkali. . . . But I very much question whether the judgment would have been in the affirmative upon the question of infringement or no infringement, if, instead of the patent having been for uniting gypsum with an acid and an alkali, the patent had been for making cement by uniting gypsum with borax; and it being found that borax was compounded of an acid and an alkali, it then had been contended that any compounding of an acid and an alkali was an infringement of the patent, inasmuch as the materials of borax being an acid and

(*q*) The proceedings before Lord Cottenham are not reported, but are referred to in Newton's London Journal C. S. 62; Norman on Patents, 141.

an alkali, and the patent being for continuing an acid and an alkali with gypsum to make cement, therefore there was an infringement. In my opinion, the proposition affirmed by Lord Cottenham in this decision would not at all lead by any necessity whatever to giving a similar decision upon the converse, where the case was such as I have just supposed."

In *Nobel's Explosives Co.* v. *Anderson* (1894, 11 R. P. C. 115, 519; 12 R. P. C. 164), the object of the invention was the production of an explosive suitable for propelling projectiles, in the use of which explosive perfect combustion might be obtained. The patentee in his specification confined his claim to powder made from soluble nitro-cellulose and nitro-glycerine. It was not known at the date of the patent that insoluble nitro-cellulose could be used in the place of the soluble to effect the same object in a similar manner, and, in fact, anyone reading the specification of the patentee would be led to the conclusion that he was to avoid the use of insoluble nitro-cellulose. It was held by Romer, J., whose decision was confirmed in the Court of Appeal and the House of Lords, that the use of the insoluble nitro-cellulose, although in a similar way and to effect a similar result to that attained by the soluble nitro-cellulose, did not amount to an infringement of the patent. In his judgment he said (11 R. P. C. at p. 127): "The soluble and insoluble are, in my opinion, distinct substances, having, as I pointed out above, distinct properties, and the insoluble cannot, for the purposes of the plaintiff's patent, be regarded as merely the chemical equivalent of the soluble. The plaintiff's patent and claim show that the patentee regarded the two as distinct for the purposes of his invention."

As an instance of an infringement involving the use of a **mechanical equivalent** we may cite *Russell* v. *Cowley* (1834, 1 W. P. C. 462), in which the invention claimed was the bringing to a welding heat of a long piece of iron of the proper quality, after having turned up its edges, and drawing it through a hole of the size of the intended tube, so as to compress together the edges and give it a complete circular form. The defendants turned up the skelp, and, after heating it in the furnace, passed it through two rollers with grooves: Held as a fact, that the

two rollers with grooves were a mere mechanical equivalent for the hole through which the iron was passed according to the plaintiff's invention, and that the patent had been infringed.

Taking out a patent for a process or machine that infringes a prior patent does not in itself amount to infringement (*r*), nor does the granting of a licence to manufacture under a subsequent patent amount to infringement (*s*); infringement depends upon *what the alleged infringer has done*. There are three ways in which a patent may be infringed:—

Patenting is not infringing.

1. By making the patented article or working the process.
2. By using.
3. By selling.

A person may infringe a patent by making the article himself, or by his agent, or by his servants. **The agent and servants**, it is true, will be considered as equally infringing the patent, and actions may be brought against them individually, but that in no way absolves the person who employs them for that purpose. In *Sykes* v. *Howarth* (1879, L. R. 12 Ch. D. 826) the invention consisted in the application of cards or strips of leather covered with wire to rollers at "wide distances." A person who contracted to clothe rollers and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer, was held to have infringed the patent, though he alleged that his business was that of a card-maker only, and did not include the nailer's work. In giving judgment Fry, J., said: "I have come to the conclusion that the nailer must be deemed to have been the agent, for the purpose of nailing on, of the defendant . . . there is a contract to clothe in the manner prescribed by the particulars given to the defendant, and that contract was carried into effect by a person paid by the defendant—the defendant himself receiving the total amount for which he contracted. The consequence is that in my judgment all the defences fail" (*t*).

Infringment by agents and servants.

(*r*) *Tweedale* v. *Ashworth*, 1890, 7 R. P. C. at p. 431.

(*s*) And see *Gibson and Campbell* v. *Brand*, 1842, 1 W. P. C. at p. 631; *McCornish* v. *Gray*, 1861, 7 H. & N. 25; 31 L. J. Ex. 46.

(*t*) *Montgomerie* v. *Paterson*, 1894, 11 R. P. C. 221.

But actions against mere workmen who innocently help in an infringement, and are not the really guilty persons, will not be encouraged (*u*).

Express instructions as of patentee.

Express instructions given by the patentee or on his behalf will negative infringement.

In *Kelly* v. *Batchelar* (1893, 10 R. P. C. 289) the plaintiff's patent was for a telescopic ladder, being two ladders joined together, the inner being raised or lowered by means of an endless cord. The plaintiff, for the purpose of adducing evidence of infringement, instructed an agent to order from the defendant an adjustable ladder with an endless cord. The defendant made a ladder to this order, but without a cord. The agent of the plaintiff said that it would not do, but must have a cord with pulleys, whereupon the defendant added the cord as instructed. In the action for infringement brought against the defendant, North, J., held that the defendant acted **upon the express instructions of the plaintiff's agent**, who had power and authority to give such instructions, and, consequently, that making this ladder did not amount to an infringement of the plaintiff's patent (*x*).

In *The Dunlop Pneumatic Tyre Co.* v. *Neal* (1899, 16 R. P. C. 247), the agent of the plaintiffs was sent to the defendant to ask him to repair an old tyre, the subject of the plaintiffs' patent, with a view to ascertaining whether the defendant was infringing the patent by purporting merely to repair tyres. The agent gave no express instructions as to what was to be done to the worn tyres beyond saying that they were to be repaired. It was held that what was done by the defendant amounted to infringement, and that in such a case he could not shelter himself behind the instructions of the plaintiffs' agent.

Making and selling elements of combination.

Where the patent is for a combination there is no infringement in making or selling the separate elements of the combination even though the manufacturer or vendor knows perfectly well that the separate elements are destined eventually to be combined so as to constitute an infringement.

(*u*) See *Savage* v. *Brindle*, 1896, 13 R. P. C. at p. 267.

(*x*) Also *Henser* v. *Hardie*, 1894, 11 R. P. C. 421

In *The Dunlop Pneumatic Tyre Co.* v. *Moseley* (1904, 1 Ch. 177; 21 R. P. C. 274) the patent was for a pneumatic tyre cover, held on to the rim of the wheel by wires passed through circumferential pockets in the edges of the cover. The defendants made and sold covers only, fitted with pockets, but without wires, and advertised them as "ready for wires." There was no other evidence to connect the defendants with the persons who purchased the covers and fitted the wires. It was held, following *Townsend* v. *Haworth* (1875, L. R. 12 Ch. D. 831, n.), and after an elaborate review of the authorities, that this did not constitute infringement.

But where the circumstances were such as to indicate very clearly that the person selling an element which did not infringe was practically in partnership with another person who completed the infringement, and the real object of his business was to aid in the infringement, an injunction was granted (*y*). And making and selling all the constituent parts of a machine so that they could easily be put together would probably amount to evidence of infringement (*z*).

In *Townsend* v. *Haworth* (1875, L. R. 12 Ch. D. 831, n.) Jessel, M.R., said: "The chief of these chemical substances are substances which are perfectly well known, and most of them are common substances; they are all old chemical compounds, and there is no claim in the patent at all except for the peculiar use of these chemical compounds for the purpose of preserving the cloth from mildew. No judge has ever said that the vendor of an ordinary ingredient does a wrong if the purchaser, coming to him, says, 'I want your compound, because I want to preserve my cloth from mildew. I wish to try the question with the patentee.' No one would doubt that that sale would be perfectly legal. You cannot make out the proposition that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article, can be sued as an infringer, because he knows

(*y*) *The Incandescent Gas Light Co.* v. *New Incandescent Mantle Co.*, 1898, 15 R. P. C. 81.

(*z*) *United Telephone Co.* v. *Dale*, 1884, L. R. 25 Ch. D. at p. 782.

that the purchaser intends to make use of it for that purpose."

Aiding and abetting infringement.

In *Innes* v. *Short* (1898, 15 R. P. C. 450) the plaintiff's patent was for the use of powdered zinc in boilers to prevent incrustation. The defendant sold bags of powdered zinc with directions for the use of the powder in boilers. Bigham, J., granted an injunction to restrain the sale *in this manner*, and said: "There is no reason whatever why Mr. Short should not sell powdered zinc, and he will not be in the wrong, though he may know or expect that the people who buy it from him are going to use it in such a way as will amount to an infringement of Mr. Innes' patent rights. But he must not ask the people to use it in that way in order to induce them to buy his powdered zinc from him." It is submitted that this decision was erroneous. There cannot be a claim for "an old substance for a new purpose," for a purpose is not a manufacture—the true claim is for the "new use of an old substance"—and this is not infringed unless the old substance is actually put to that new use. Moreover, there is no such tort as "aiding and abetting" infringement (*a*).

Infringement by repairing.

The points above considered are of material importance when it is alleged that the patent has been infringed by what amounts to the manufacture of a new article under the guise of repairing an old article which has been made under the patent. The tests by which such cases may be decided were enunciated by Kekewich, J., in *The Dunlop Pneumatic Tyre Co.* v. *The Holborn Tyre Co.* (1901, 18 P. O. R. 226): "There are two tests which might equally well be applied to this question on the evidence. The first test would be this: In the alleged repair, has the workman so employed the patent as that in doing it he has taken an essential part of the patent and infringed it? . . . . But there is another test which, but for the existence of the patent, one would employ, and which I think is the real and most satisfactory test to employ now, and

(*a*) See Lindley, L.J., in *Badische Anilin und Soda Fabrik* v. *Johnson & Co.* 1897, 14 R. P. C. at p. 413; and Fry, J., in *Sykes* v. *Howarth*, 1879, L. R. 12 Ch. D. at p. 833.

that is this: Is it substantially, in common parlance, honestly, a new article, or is it an old article repaired?" (*b*).

In *The United Telephone Co.* v. *Nelson* (1887, W. N. 192) it was held that the restoration of a broken instrument which had originally been licensed under the patent was an infringement. But the case is not fully reported. It appears to be a question of fact whether an instrument is broken to such an extent as to destroy its identity so as to enable the patentee to say that the repair by its owner amounts in fact to the manufacture of a new article. In *The Sirdar Rubber Co., Ltd.* v. *Wallington, Weston & Co.* (1907, 24 R. P. C. at p. 543) Lord Halsbury said: "The principle is quite clear, although its application is sometimes difficult; you may prolong the life of a licensed article but you must not make a new one under cover of repair."

Experiments.

The working and making must be by way of using the invention, as distinguished from experimenting with it, so as to operate as an infringement. In *Jones* v. *Pearce* (1832, 1 W. P. C. at p. 125) Patteson, J., said: "Now, if he did actually make these wheels, his making them would be a sufficient infringement of the patent, unless he merely made them for his own amusement or as a model." In *Frearson* v. *Loe* (1878, 9 C. D. at p. 66) Jessel, M.R., adverting to this branch of the subject, said: "The other point raised was a curious one, and by no means free from difficulty, and what occurred with regard to that was this: That the defendant at various times made screw blanks, as he said, not in all more than 2 lbs., by various contrivances, by which no doubt screw blanks were made according to the plaintiff's patent of 1870, as well as that of 1875; they seem to have been an infringement of both. He said he did this merely by way of experiment; and no doubt if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has

(*b*) See also *Dunlop Pneumatic Tyre Co., Ltd.* v. *Neal*, 1899, 16 R. P. C. 247; *Dunlop Pneumatic Tyre Co., Ltd.* v. *Excelsior Tyre Co.*, 1901, 18 R. P. C. 209; *Dunlop Pneumatic Tyre Co., Ltd.* v. *Holborn Tyre Co., Ltd.*, 1901, 18 R. P. C. 222.

been granted, but with a view of improving upon the invention, the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment and not for a fraudulent purpose ought not to be considered within the meaning of the prohibition, and if it were, it is certainly not the subject for an injunction" (*c*).

Use to instruct pupils.

To purchase and use infringing articles for the purpose of instructing pupils and to enable them to pull them to pieces and put them together again is not mere experimental user, and amounts to infringement (*d*).

The grant confers the sole right to "**make, use, exercise, and vend**" the invention, and by the words of the prohibition the subject is commanded to refrain from "**making use of or putting in practice**" the said invention. There are a number of cases which have been decided upon the meaning of these words, and they are principally concerned with instances where the defendant has certainly derived advantage from the invention, and yet it would be difficult to say that he had been guilty of making or vending.

Sale of article made by patented process.

In the case of a patent for a process the sale of goods manufactured by that process is an infringement of the process, even though the manufacture took place abroad. In *Wright* v. *Hitchcock* (1870, L. R. 5 Ex. at p. 47) Kelly, C.B., said: "If the law were otherwise, then when a man has patented an invention, another might, by merely crossing the Channel, and manufacturing abroad and selling in London for far less than the original price, but also at a trifle less than the price charged by the patentee, articles made by the patented process, wholly deprive the patentee of the benefit of his invention. It is therefore impossible to suppose that an exclusive right to vend is not given, and the defendants have therefore infringed the

(*c*) See also *Muntz* v. *Foster*, 1844, 2 W. P. C. at p. 101; *Proctor* v. *Bayley*, 1889, 6 R. P. C. 106.

(*d*) *United Telephone Co.* v. *Sharples*, 1885, L. R. 29 Ch. D. 164; 2 R. P. C. 28.

plaintiff's right, and it is immaterial whether it was so was not known to them that Orr's machine was identical with the plaintiffs" (*e*).

Onus of proof in such cases.

Where the defendant has used and sold articles alleged to have been made by the patented process, the onus of proving that they were in fact made by that process is on the plaintiff; but where such articles were made abroad, and the plaintiffs, in consequence, could not be afforded full opportunity of inspecting the machinery by which they were made, it has been held that it lies with the defendants to rebut a *primâ facie* case made out by the plaintiffs (*f*).

In the various *Saccharin Cases* (*f*), the plaintiffs were the owners of patents which covered all known processes of making saccharin. They were able to produce evidence to the effect that although it was conceivable that saccharin might be made in some other way, no other processes were then known to the scientific world. The defendants, who imported saccharin, could never give any satisfactory account of the way in which the imported substance was actually made. It was held that infringement had been made out.

But in *The Cartsburn Sugar Refining Co.* v. *Sharp* (1884, 1 R. P. C. 181) the alleged infringement consisted in the sale in England of cube sugar manufactured in America by a machine made in accordance with the specification of the plaintiff's patent. Lord Kinnear, in his judgment, said (at p. 186): "No witness has been examined of sufficient skill as a mechanic to give a detailed description of the machine in question. All that is proved is that it does not correspond in all respects, though in some respects it does correspond, to the description in *Hersey's* patent. It is said that as the manufacture complained of had taken place in America, it was incumbent on the respondents, upon the principle which received effect, in the case of *Neilson* v. *Betts* (supra), to prove by negative evidence that it was not manufactured according

(*e*) See also *Elmslie* v. *Boursier*, L. R. 9 Eq. 217; *Von Heyden* v. *Neustadt*, 1880, 14 C. D. 230.

(*f*) *Neilson* v. *Betts*, 1871, L. R. 5 H. L. at p. 11; *Saccharin Corporation* v. *Dawson*, 1902, 19 R. P. C. 169; *Saccharin Corporation* v. *Jackson*, 1903, 20 R. P. C. 611; *Saccharin Corporation* v. *Mack*, 1906, 23 R. P. C. 611.

to the specified process. I think no such onus lies upon the respondents in the present case, because there can be no question on the evidence that such articles as were sold by the respondents *may have been* produced by machinery which involved no infringement of the complainer's patent. That being so, it lay upon the complainers to prove their case, and as they took a commission to America for the purpose of proving it, there could have been no difficulty in their obtaining a sufficient description of the machine to which it is alleged they have traced the cubes of sugar sold by the respondents to enable them to establish the infringement, if infringement there was."

In *Gibson* v. *Brand* (1842, 4 M. & G. 196, 2 W. P. C. 631) it was held that an order given by the defendant for the making of silk by a process which infringed the plaintiff's patent, which order was executed in England, was sufficient to satisfy the allegation that the defendant made, used, and put in practice the plaintiff's invention, though the silk was in fact made through the agency of others. Sir N. C. Tindal, C.J., said: "This is quite sufficient to satisfy an allegation that he made those articles, for he that causes or procures to be made, may well be said to have made them himself."

Contracts for delivery in United Kingdom and abroad.

The delivery, however, must take place in this country to constitute an infringement. In *The Badische Anilin und Soda Fabrik* v. *The Basle Chemical Works* (1898, A. C. 200; 14 R. P. C. 919), a trader in England ordered goods from the defendant in Switzerland to be sent by post to England. The defendant addressed the goods to the trader in England, and delivered them to the Swiss Post Office, by whom they were forwarded to England. The goods were manufactured according to an invention protected by the plaintiffs' patent It was held by the House of Lords that, since the contract of sale was completed by the delivery to the Post Office in Switzerland, and since the Post Office was the agent of the buyer and not of the vendor, the vendor had not made, used, exercised, or vended the invention within the ambit of the patent, and that the patentee had no right of action against the vendor for an infringement of the patent.

In *The Saccharin Corporation* v. *Reitmeyer & Co.* (1900, 2 Ch. 659; 17 R. P. C. 606) the facts were as follows: The defendant, while in England, contracted with persons in England for the delivery to them at a *foreign* port of goods manufactured on the Continent by a process similar to that protected by the plaintiff's English patent. Cozens-Hardy, J., said: "Now it is plain that a patent is of local force . . . . it is admitted that the defendant has not 'made' or 'used,' and I think it is clear that he has not 'vended' within the jurisdiction (see *Badische Anilin Co.* v. *Basle Chemical Works*, supra). It is said, however, that he has 'exercised' the invention within the jurisdiction. It is remarkable that this word, which has been found in letters patent at least since 1621, so far as I am aware, has never been construed. I think, however, that it can only mean 'put in practice.' I do not think it can be taken to cover a transaction such as I have to deal with. The defendant, as a commission agent, contracted for delivery to the purchasers at a German port. He had no interest whatever in the case when delivered at the foreign port to the purchasers. He had no right to control its destination. I assume that he knew or suspected that the greater part of the stuff would find its way into this country, but I cannot regard that as material."

The House of Lords in *The Badische Anilin und Soda Fabrik* v. *Hickson* (1906, A. C. 419; 23 R. P. C. 433) approved of this decision, and a *ratio decidendi* was stated by Lord Loreburn, L.C., which raises a point of difficulty: "A contract to sell unascertained goods is not a complete sale, but a promise to sell. There must be added to it some act which completes the sale, such as delivery or the appropriation of specific goods to the contract by the assent, express or implied, of both buyer and seller. Such appropriation will convert the executory agreement into a complete sale." It would seem, therefore—if this be the correct view—that had the vendor notified the purchaser in accordance with the Sale of Goods Act that certain specific lots had been set aside for him abroad, and had the purchaser expressly or impliedly assented to such appropriation, an action for infringement could successfully have been brought against

the vendor. On the other hand, Lord Davey considered that even if the property passed in this country it would not affect the question of infringement." He said (1906, A. C. at p. 423): " . . . Nor is it material to consider whether or when the property in the goods passed to the purchaser. It is lawful to be the owner of the goods if made and situate abroad, and neither the vendor nor the purchaser in my opinion thereby infringes the patent. The goods may or may not be afterwards brought into this country, and a different question will then arise, but that is no concern of the vendor after he has parted with them. I am of opinion that 'vending the invention' in the common form of patent is confined to selling goods made or brought into this country, and that the respondent in this case has not, directly or indirectly, made, used, or put in practice the appellant's invention within the meaning of the prohibition contained in the patent." Lord Atkinson's judgment is to the same effect. To export under a contract of sale, whether such contract was made here or abroad, is an infringement. In *The British Motor Syndicate* v. *Taylor* (1900, 17 R. P. C. 189, 723) the defendants bought in England twenty-seven infringing articles; they sold seven of them and used another in England; As regards the remaining nineteen, they sent them abroad to their French house in Paris, where they sold them to various foreign firms. The question was whether there had been an infringement in respect of these nineteen. Stirling, J., decided that this was "making use of" the invention, and *that the words "make use of" have a wider significance than the words "put in practice."* The learned judge said: "In the present case the patented articles, when being transported from place to place in this country, were not serving the purpose for which they were patented, and in my opinion the defendants did not, during that transporting, exercise or put in practice the patented invention. What the defendants did was to carry these articles out of the kingdom with a view to selling them; that is, with the object of turning them to profitable account" (*g*).

Sending abroad.

Purchase, transport, and possession.

Mere purchase, possession, or transport does not amount to

(*g*) See also *United Telephone Co.* v. *Sharples*, 1885, L. R. 29 C. D. 164; 2 R. P. C. 28.

infringement, unless it involves the putting in practice of the invention, although it may justify an injunction on the ground that it is strong evidence of a threat to use (*h*).

In the case of *Neilson* v. *Betts* (1871, L. R. 5 H. L. 1), in the House of Lords, the facts were as follows: Betts, the plaintiff in the suit, was the patentee of an invention for the manufacture of capsules for the purpose of covering bottles of liquid (wine, beer, or otherwise), and protecting them from the action of the atmosphere. Betts' patent did not extend to Scotland. Neilson and his co-appellants, defendants in the suit, were persons who bottled beer in Glasgow for the Indian market. They bottled the beer and covered it with capsules, which were made in Germany in pursuance of Betts' specification. The beer was shipped by the appellants in vessels which called at Liverpool to complete their cargoes; on some occasions the beer was transhipped in England, but no cases of beer were opened, nor was any of the beer sold in this country. Held, by the House of Lords, that, inasmuch as the object of Betts' invention was to make a capsule that would preserve the beer, whilst the beer was in England it was being preserved by the use of Betts' invention, and consequently that there was an infringement of the patent. Lord Chelmsford, in giving judgment in the Court below, said (L. R. 3 Ch. at p. 439): "It is the employment of the machine or article for the purpose for which it was designed which constitutes its active use, and whether the capsules were intended for ornament, or for protection of the contents of the bottles upon which they were placed, the whole time they were in England they may be correctly said to be in active use for the very objects for which they were placed upon the bottles by the vendors. If the beer, after being purchased in Glasgow, had been sent to England, and had been afterwards sold here, there can be no doubt, I suppose, that this would have been an infringement, because it

(*h*) *Adair* v. *Young*, 1877, 12 C. D. 13; *United Telephone Co.* v. *London and Globe Telephone Co.*, 1884, L. R. 26 C. D. 766; *British Motor Syndicate* v. *John Taylor and Sons*, 1901, 1 Ch. 122; 17 R. P. C. at p. 723; *British United Shoe Machinery Co.* v. *Simon Collier, Ltd.* 1909, 26 R. P. C. at p. 41. Cf. *Proctor* v. *Bayley*, 538, and see Chap. XV., part ii.

would have been a profitable user of the invention, and I cannot see how it can cease to be a user because England is not the final destination of the beer."

The case of *Nobel's Explosives Co.* v. *Jones, Scott & Co.* (1881, 17 C. D. 721) is instructive upon the question of user. The subject of the plaintiff's patent, dynamite, is a mechanical compound of nitro-glycerine and infusorial earth. The compounding of nitro-glycerine in this matter is done for and effects the purpose of rendering it less liable to explosion from concussion. The object of the patent was, therefore, to enable nitro-glycerine to be kept and handled with safety. It was held by Bacon, V.-C., that the mere storage of dynamite made abroad, and only landed in this country for the purpose of transhipment, amounted to an infringement of the plaintiff's patent. His judgment was reversed in the Court of Appeal, but upon another point, to be mentioned presently, and without in any manner impugning the correctness of the Vice-Chancellor's decision on this question. (*i*).

Exposure for sale.

Possession accompanied by exposure for sale is an infringement, as it is a user for one of the purposes for which it was intended that the patentee alone should use it during the fourteen years (*k*).

Use on ships.

In the case of *Caldwell* v. *Vanvlissengen* (1852, 21 L. J. Ch. 97), it was held by Turner, V.-C., that **foreign ships coming into British ports**, fitted with screw propellers, which were made in pursuance of the specification of an English patent, thereby infringed the patent. If the injunction which was granted be carefully read, it will be found to amount to a restraint from propelling the vessels with the propellers, not from having the ships merely fitted with them. Legally speaking, the user of propellers differs from that of capsules or dynamite in this important respect, that the one is in use only when in motion; the others are at use, the one when merely affixed to the bottles, and the other when merely in possession.

(*i*) See also *The Universities of Oxford and Cambridge* v. *Richardson*, 6 Ves. 689; *The Dunlop Pneumatic Tyre Co.* v. *British and Colonial Motor Car Co.*, 1901, 18 R. P. C. 313.

(*k*) Alverstone, L.C.J., in *British Motor Syndicate, Ltd.* v. *John Taylor and Sons, Ltd.*, 1900, 17 R. P. C. at p. 729.

In the case of *Adair* v. *Young* (1877, 12 C. D. 13), certain pumps, which were an infringement of the plaintiff's patent, were fitted on board a British ship. There was no evidence of their having been used. Held, by the Court of Appeal, that there had been no infringement, but as there was evidence of an intention to use the pumps, an injunction would be granted against the use of the pumps.

By sect. 48 of the Act of 1907, corresponding to sect. 43 of the Act of 1883,

(1) "*A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.*

(2) "*This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.*"

A patent is not infringed by the use of the invention on board an English vessel abroad (*l*).

Custom House agents.

In the case of *Nobel's Explosives Co.* v. *Jones and Scott* (L. R. 8 A. C. 5) the Court of Appeal reversed the decision of Vice-Chancellor Bacon, on the grounds that the defendants had not infringed the plaintiffs' patent, they having merely acted as **Custom House agents** for the transhipment of the dynamite, and their functions being confined to obtaining papers necessary for such transhipment, and that they never had any ownership in or exercised any control over the dynamite.

Carriers.

An action may properly be brought against innocent carriers of infringing articles for an injunction to restrain them from dealing with or disposing of such articles in any way (*m*).

(*l*) *Newall* v. *Elliot*, 1863, 10 Jur. N. S. 954.

(*m*) *Washburn and Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 1889, 6 R. P. C. at p. 403; see also *Upmann* v. *Elkan*, 1869, L. R. 7 Ch. 130.

Lending.

Lending is not selling and is not an infringement (*n*).

Effect of sale by patentee.

A patentee by himself or by his agent selling the patented article without limitation sells with it the right of free disposition as to that article, and if he sells the article abroad, the purchaser may import and sell it in England. Lord Hatherley, in *Betts* v. *Willmott* (1871, L. R. 6 Ch. at p. 245), said: "Unless it can be shown, not that there is some clear injunction to his agents, but that there is some clear communication to the party to whom the article is sold, I apprehend that inasmuch as he has the right of vending the goods in France, or Belgium, or England, or in any other quarter of the globe, he transfers with the goods necessarily the licence to use them wherever the purchaser pleases. When a man has purchased an article he expects to have the control of it, and there must be some clear and explicit agreement to the contrary to justify the vendor in saying that he has not given the purchaser his license to sell the article, or to use it wherever he pleases *as against himself*."

Where the defendants, being owners of patents in Belgium and England for an invention for making glass lamp globes, by a deed executed in Belgium, granted a licence to the plaintiffs to manufacture under their invention in Belgium but not elsewhere, and the plaintiffs under this licence manufactured articles in Belgium and sold them in England, it was held by the Court of Appeal, affirming Pearson, J., that the grant of the licence to use the patent in Belgium did not imply permission to sell the manufactured article in England in violation of the defendants' English patent (*o*).

Conversely, if the patentee had assigned his patent rights in England, he could not manufacture in France and sell in England, and the sale of an article in France would carry with it no implied right to import into or sell in England. But if the rights under the patent are vested in one and the same person for both France and England, or if there are no

(*n*) *United Telephone Co.* v. *Henry*, 1885, 2 R. P. C. 11; Griff. P. C. 228.

(*o*) *Société Anonyme des Manufactures de Glaces* v. *Tilghman's Patent Sand Blast Co.*, 1883, L. R. 25 Ch. D. at p. 9; and see p. 204, ante.

Act 1907. Sec 29. Aston v. Crow
as to Hale.
XXXVII R.P.C. 172. & XLII. R.P.C. 18
Hale v Coombes
Comm on Bond Inventor
Selling articles below fixed price
Columbia Graphophone v Kennedy
XXIX R.P.C. 249.

monopóly rights in France, but only in England, the patentee could not make and sell in France and restrain the purchaser from selling or using the article in England, unless, indeed, there was a special agreement for that purpose; and then such agreement could not be held to attach to the article so as to prevent any person in whose hands it might come from importing it (*p*).

Limited licence.

The question of infringement by the breach of a limited licence has been dealt with in Chap. X. at p. 209 et seq.

No warranty under Sale of Goods Act.

In *Monforts* v. *Marsden* (1895, 12 R. P. C. 266) it was decided that the sale of an article does not imply any warranty within sect. 12 of the Sale of Goods Act, 1893, that the article sold is not an infringement of an existing patent, and in that case it was not contended that there was any implied warranty apart from the section.

It will be remembered that prior to the Act of 1883 letters patent did not operate as against the Crown; questions sometimes arose as to whether persons acting in the service of the **Crown** might manufacture a patented article or use a patented process.

When the persons using the invention were servants of the Crown, and acting in pursuance of their duty as servants, they were protected; but if they were contractors contracting with the Crown, they were not protected, but stood in exactly the same position as other subjects (*q*).

Sect. 27 of the Act of 1883 (re-enacted by sect. 29 of the Act of 1907) provided that a patent should bind the Crown, but that the Crown might use the invention "by agents or *contractors*" on terms to be before or after the use agreed upon (see p. 12, ante).

(*p*) *Betts* v. *Willmott*, 1871, L. R. 6 Ch. 239.

(*q*) *Dixon* v. *The London Small Arms Co.*, 1875, L. R. 10 Q. B. 130, and L. R. 1 App. Cas. 632, reversing decision of the Court of Appeal, L. R. 1 Q. B. D. 384; also *Feather* v. *R.*, 1865, 6 B. & S. 257.

CHAPTER XV.

ACTION FOR INFRINGEMENT.

I. Parties.

An action for infringement is the remedy which the patentee has, and the means which is given to him for enforcing his patent privileges.

The courts are bound to take notice of the patent, and are bound to give legal effect to it, provided it cannot be shown to have been granted contrary to law.

The Act gives no directions as to what persons may be **plaintiffs or defendants** in an action for infringement, and therefore leaves the question of the parties to the action as it was before the passing of the Act.

Plaintiff. *The Plaintiff.*—The **original grantee**, it is obvious, so long as he has not parted with the whole of his interest in the

Assignees. patent, may be a plaintiff. And so may the **assignee** of a patent, even though he have acquired the right by assignment of two separate moieties, and the party sued be the original grantee (*a*).

Joint owners. **One of several joint owners** of a patent may bring an action in his own name to restrain infringement, or for damages, without joining his other co-owners (*b*), and he may sue alone for an account of profits, and for payment to the plaintiff of such part of such profits as the plaintiff should be entitled to.

The **assignee of a portion** of a patent may sue for an infringement of that part. Erle, C.J., in giving judgment in *Dunnicliff* v. *Mallett* (7 C. B. N. S. at p. 209), said: "The question is whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice for the sake of economy to include in one patent several things which are in

(*a*) *Walton* v. *Lavater*, 1842, 8 C. B. N. S. 162; 29 L. J. C. P. 275; see p. 196, supra.

(*b*) *Sheehan* v. *Great Eastern Railway Co.*, 1880, 16 Ch. D. 59, and see p. 198, supra.

their nature perfectly distinct and severable. . . . Being therefore inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action." The plaintiff in such an action would not be allowed to sever his part from the rest of the patent, and he would be liable to. be defeated if it could be shown that the patent in any of its parts was void. But, on the other hand, he would have to show that his part alone would have been sufficient to support a patent, *i.e.*, that it contains a new and useful invention. Sect. 14, sub-sect. 2, however, of the Act of 1907 (corresponding to sect. 33 of the Act of 1883) provides, "*Every patent . . . shall be granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.*"

Assignee for a district.

By sect. 14, sub-sect. 1, "*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.*" The **assignee for a district** will be in a position to bring an action for infringement, but it is obvious that the infringement must be within his district, otherwise he will be unable to prove damage.

Registration of assignment.

Whether the assignment must be registered before the assignee can sue is a question which has not been settled (*c*). But as there is no difficulty in effecting registration at any time this point need not give trouble.

Legal owner must be party.

An **equitable assignee** cannot sue without joining the legal owner. In *Bowden's Patent Syndicate, Ltd.* v. *H. Smith & Co.* (1904, 2 Ch. 86; 21 R. P. C. 438), the facts were as follows. In 1897 B. applied for a patent. By a deed in the same year B. assigned to the plaintiffs the benefit of this application. The patent was subsequently granted to B. and of course was dated as of the day of application. In June, 1903, the plaintiffs issued the writ in this action, and in October, 1903,

(*c*) See p. 218, supra.

B., in pursuance of the deed of 1897, assigned the letters patent to the plaintiffs. B. had since died. It was held that as the patent was not granted at the time of the assignment of 1897 that assignment was equitable only, and consequently the plaintiffs at the date of the issue of the writ were not the legal owners of the patent and could not sue. They were allowed to amend the writ and statement of claim by adding the executors of B.

Licensees cannot sue.

A mere **licensee** would have no exclusive right to use the invention; he is only a person who is permitted to use it. The grantor of such a licence might grant a dozen other such licences without prejudicing the rights of the licence; and although an exclusive licensee has a right of property in the monopoly, and stands very much in the same position as an assignee for a district, yet he cannot sue infringers (*d*).

Trustees in bankruptcy and executors.

The **assignees or trustees** in bankruptcy of a patentee may maintain action for infringement in their own name (*e*), and so may the **executors or administrators** of a patentee.

Mortgagee cannot sue.

A **mortgagee** of a patent is not a necessary party in an action for infringement of that patent (*f*), and he cannot sue infringers (*g*).

A mere agent to introduce, sell, and grant licences for the use of a foreign patent in this country is not entitled to take proceedings to restrain infringement (*h*).

Defendants.

As defendants, any person infringing is liable (*i*).

A **company,** to whom the business of the defendants was assigned while an action for infringement of a patent was pending against them, cannot be joined as co-defendants in that action (*k*).

Effect of contract of indemnity.

But where an **indemnity** was given to the defendants, after the commencement of the action, by a third party who had manufactured the infringing articles, it was held that the person giving such an indemnity should be joined as a party

(*d*) See p. 202, supra.

(*e*) See p. 193, supra.

(*f*) *Van Gelder* v. *Sowerby Bridge Flour Co.*, 1890, 7 R. P. C. 208; and see p. 196, supra.

(*g*) Ibid.

(*h*) *Adams* v. *North British Railway Co.*, 1873, 29 L. T. N. S. 367.

(*i*) See Chap. XIV.

(*k*) *Briggs* v. *Lardeur*, 1885, 2 R. P. C. 13.

under R.S.C. Order XVI. r. 48 (*l*), but such third party will only be bound by the decision of the Court so far as such decision falls within the terms of the order by which he was directed to appear, and if the plaintiffs neglect to amend by joining him as a defendant they will not be able to obtain an injunction against him as well as against the actual defendant (*m*).

Manufacturers need not be joined.

The manufacturer and patentee of a machine, the use of which is claimed to be an infringement of another patent, cannot compel the plaintiff to join him as a co-defendant with the person by whom the machine was used and against whom the action for infringement was brought (*n*).

Carriers.

An action is properly brought by the patentee against a company who are **innocent carriers** of infringing articles, to restrain them from dealing with or handing over such articles to other persons, and on the discovery of the name of the consignee, such consignee should be joined as a co-defendant in the action (*o*).

II. PLEADINGS.

The writ.

Writ.—An action for infringement is commenced by writ issued out of the High Court of Justice.

The writ may be issued either in the King's Bench or in the Chancery Division, but the machinery of the latter tribunal is the more suitable, and is the more generally used.

In nearly all actions for infringement, the writ is indorsed with a claim for (1) an injunction; (2) damages, or, in the alternative and at the option of the plaintiffs, an account of sales and profits; and (3) delivery up to the plaintiffs or destruction of all infringing articles in the possession of the defendants. If the patent has expired there cannot, of course, be a claim for an injunction.

Service of a writ in Scotland for an infringement in England will be allowed (*a*).

(*l*) *Edison* v. *Holland*, 1886, 3 R. P. C. 395.

(*m*) *Edison* v. *Holland*, 1889, 6 R. P. C. 243, 286.

(*n*) *Moser* v. *Marsden*, 1892, 9 R. P. C. 214.

(*o*) *Washburn and Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 1889, 6 R. P. C. 398, 403; and see p. 370, post.

(*a*) *Speckhart* v. *Campbell, Achnach & Co.*, Solr. Journ. Feb. 2nd, 1884; Vol. 28, p. 254; W. N. (84) 24.

The practice is regulated by Order LIIIA. of the Supreme Court Rules, dated June 3, 1908, and made pursuant to sect. 98, sub-sect. 1, of the Act of 1907. In addition to the special rules of this order, the ordinary rules apply where applicable (*b*).

By sect. 98, sub-sect. 1, corresponding to sect. 107 of the Act of 1883, nothing is to affect the forms of process in Scotland, and, apart from rules which may be made by the Scotch Courts, the practice seems to remain what it was under the Act of 1883, so far as particulars and costs are concerned, for the English Supreme Court Rules do not apply to Scotland (*c*).

Statement of claim.

Statement of claim.—Order XIX., rule 4, requires all material facts to be pleaded, and prohibits the pleading of evidence. Rule 5 is as follows :—"The forms in Appendices (C., D. and E.), when applicable, and where they are not applicable forms of the like character, as near as may be, shall be used for all pleadings, and where such forms are applicable and sufficient, any longer form shall be deemed prolix, and the costs occasioned by such prolixity shall be disallowed to or borne by the party so using the same, as the case may be."

The forms mentioned relate to pleadings in an action for the infringement of a patent, but there is no provision made for the case where infringement has only been threatened, nor for the case when a mandatory order or an account of sales and profits is required.

The statement of claim should allege that the plaintiff is the grantee or registered legal owner of the letters patent, and if his title is derived by assignment he should set forth the devolution; this, however, is not strictly necessary.

It is unnecessary to allege either that the plaintiff or the original patentee was the first and true inventor (*d*), or that the invention is new (*e*). If the specification has been amended, it is better to plead the fact, and that the original specification was framed in good faith and with reasonable skill and

(*b*) See *Haddan's Patent*, 1884, 54 L. J. Ch. 126; Griff. P. C. 108 (decided before O. LIIIA.).

(*c*) And see *Mica Insulators Co., Ltd.* v. *Bruce, Peebles & Co., Ltd.*, 1905, 22 R. P. C. 527.

(*d*) See *Ward* v. *Hill*, 1901, 18 R. P. C. 491.

(*e*) *Amory* v. *Brown*, 1869, L. R. 8 Eq. 663.

knowledge (*f*), since, by sect. 23 of the Act of 1907 (sect. 20 of the Act of 1883) (see p. 189, ante), no damages are recoverable in respect of infringements committed prior to the amendment unless the patentee can satisfy the Court that it was so framed.

If a certificate of validity has been granted in a previous action so as to entitle the plaintiff to solicitor and client costs under sect. 35 of the Act of 1907 (sect. 31 of the Act of 1883), the certificate and the claim to such costs should be pleaded (*g*).

Two or more patents may be sued on at one and the same time if the different issues can be conveniently tried together. In some of the actions brought by the Saccharin Corporation, the position was peculiar. The Corporation owned more than twenty patents for processes for making saccharin, which included every known process of manufacture. The saccharin manufactured by the defendants showed no trace of the method by which it had been brought into existence, and the plaintiffs were unable to say precisely which of their patents had been infringed. The Court of Appeal allowed the plaintiffs to select a certain limited number of these patents and to allege that the defendants had infringed one or other of them (*h*). The limitation of the number of the patents sued on was to enable the defendants to attack their validity without embarrassment on the question of costs (see particulars of objections, below).

Particulars of Breaches.

Particulars of breaches.—**Particulars of breaches** were required to be delivered in every action for the infringement of a patent by sect. 41 of the Patent Law Amendment Act, 1852, and by sect. 29, sub-sect. 1, of the Act of 1883. Rules 13, 16, 19, 20 and 21 of Order LIIIA., have replaced these statutory requirements and are as follows: "(13) *In action for infringement of a patent, the plaintiff must deliver with his statement of claim particulars of the breaches relied upon.*"

The new rules.

"(16) *Particulars of breaches shall specify which of the claims in the specification of the patent sued upon are alleged to be*

(*f*) *Kane and Pattison* v. *Boyle*, 1901, 18 R. P. C. 337.

(*g*) *The Pneumatic Tyre Co.* v. *Chisholm*, 1896, 13 R. P. C. 488.

(*h*) *Saccharin Corporation* v. *R. White & Sons, Ltd.*, 1903, 20 R. P. C. 454; *Saccharin Corporation* v *Alliance Chemical Co., Ltd.*, 1905, 22 R. P. C. 175.

infringed, and shall give at least one instance of each type of infringement of which complaint is made."

"(19) *Particulars of breaches and particulars of objections* (*i*) *may from time to time be amended by leave of the Court, upon such terms as may be just.*"

"(20) *Further and better particulars of breaches or particulars of objections may at any time be ordered by the Court.*"

"(21) *At the hearing of any action, petition, or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may deem just), be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.*"

The practice as formulated by these rules is substantially the same as that under sect. 29, sub-sect. 1, of the Act of 1883.

Purpose of particulars of breaches.

Particulars of breaches are particulars of the times, places, occasions, and manner in which the plaintiff says the defendant has infringed his letters patent. The **defendant must have full, fair, and distinct notice of the case to be made against him** (*k*). In *Batley* v. *Kynoch* (1874, L. R. 19 Eq. at p. 231), Sir James Bacon, V.-C., said: "All that is required and provided by the Patent Law Amendment Act, 1852, which has made no alteration in the practice to be observed in these cases, is that the defendants shall not be taken by surprise, and it is the duty of the judge to take care that by the particulars of breaches they shall have full and fair notice of the case that they will have to meet."

It had, prior to the passing of the Patent Law Amendment Act, 1852, been the practice of the Courts to compel plaintiffs to give particulars of breaches, and the cases which were then decided as to the sufficiency of particulars are applicable now; for then, as now, the object was that the defendant should be warned with reasonable certainty of the case that was to be made against him.

The plaintiff cannot be required to place a construction upon his patent in his particulars of breaches (*l*).

(*i*) See p. 335, infra.

(*k*) *Needham* v. *Oxley*, 1863, 1 H. & M. 248; *Mandleberg* v. *Morley*, 1893, 10 R. P. C. 256.

(*l*) *Wenham Co.* v. *Champion Gas Co.*, 1891, 8 R. P. C. 22.

Differ from particulars of objections.

The requirements of particulars of objections differ materially from those of particulars of breaches. In the case of objections taken by the defendant to the plaintiff's patent, it is essential that each objection should be set out in detail and that the defendant should be tied down to the particular instances of anticipation which he discloses in those particulars, since the objections to be taken by the defendant at the trial cannot otherwise lie within the plaintiff's knowledge, whereas in the case of particulars of breaches, to use the words of Bristowe, V.-C. (*m*): "You must always bear this in mind, that the plaintiff, asserting his patent, knows what he claims, and he says, 'I tell the public according to that which I am bound to do by the specification that which I do claim'; and the defendant well knows, or the defendants, as in this case, perfectly well know what they are doing." Consequently to fulfil the object for which such particulars are required, it is only necessary for the plaintiff to indicate what patent or portions of what patent he relies upon and in what way he considers the defendant to have infringed, and if these two points be made clear without adducing specific instances, that will be sufficient.

Rule 16, in so far as it refers to the necessity of specifying, in all cases, the claiming clauses which are alleged to be infringed, follows what was substantially the practice before the rule in cases where the specification included a number of claims.

There is no objection, however, to a plaintiff stating that he relies on *all* the claims of his specification, and it is a matter of costs at the trial if this course has been taken unreasonably (*n*).

Type of infringement must be specified.

In future, by rule 16, it will be obligatory to specify some instance of infringement. This is new, as a rule of practice, but in most particulars of breaches it has been customary to state that the patent has been infringed and "in particular by the sale, on the 3rd day of May, 1909, to one A. B., of an article constructed according to the invention described and claimed in claim No. —." This has been for the purpose of

? Johnson v Kenny Ch. Cook v Levenstein xxix R.P.C. 677.

(*m*) *Cheetham* v. *Oldham*, 1888, 5 R. P. C. at p. 626; see also *Talbot* v. *La Roche*, 1854, 15 C. B. at p. 321; *Ledgard* v. *Bull*, 1886, L. R. 11 App. Cas. 648; *Haslam* v. *Hall*, 1887, 4 R. P. C. 206.

(*n*) *Haslam & Co.* v. *Hall*, 1887, 4 R. P. C. at p. 206.

identifying the type of act complained of, and technically proving it if denied. The giving of the instance is merely for indentification purposes, and a defendant was not supposed to limit his rights to damages to the example only (*o*). "It lies on the party who alleges that for the honest purpose of his litigation he wants further information or limitation, to satisfy the Court that he is really placed in a difficulty by the particulars as they stand" (*p*).

When an action is brought in respect of a particular type of infringement, and to restrain the threatened infringement by continued manufacture of that type (the usual way in which an action is framed), the plaintiffs will not be allowed to give evidence of infringements of a different type committed after action brought to justify the allegation of intention to infringe; the proper course is to apply to amend the particulars of breaches (*q*).

Further particulars of breaches have sometimes been **postponed to discovery** on the ground that the defendant knew the breaches which he had committed better than the plaintiff (*t*).

Degrees of particularity required against vendor.

Where an action is brought against the vendor of articles alleged to have been made by a process which infringed the plaintiff's patent, a greater degree of precision is required in the particulars of breaches than if the defendant had been the manufacturer himself.

In *Mandleberg* v. *Morley* (1893, 10 R. P. C. 260), Stirling, J., said: "Now if a manufacturer is attacked for infringing a patent by a particular process he does not want to be told in the shape of particulars, or otherwise, what the process is he is using. He knows what the process he is using is. But it is a very different thing with respect to a vendor. The vendor does not know with certainty what process is being used

(*o*) See *Haslam & Co.* v. *Hall*, 1887, 4 R. P. C. 203. *Tilghman's Patent Sand Blast Co., Ltd.* v. *Wright and Butler Ltd.*, 1884, 1 R. P. C. 103.

(*p*) Per Wills, J., in *Haslam & Co.* v. *Hall*, 1887, 4 R. P. C. at p. 207.

(*q*) *The Shoe Machinery Co., Ltd.*, v. *Cutlan*, 1895, 12 R. P. C. 342; *The Welsbach Incandescent Light Co., Ltd.* v. *Dowle*, 1899, 16 R. P. C. 391.

(*t*) *Russell* v. *Hatfield*, 1885, Griff. P. C. 204; 2 R. P. C. 144.

by the person from whom he himself buys, and who manufactures the article."

In that case the particulars of breaches alleged that: "The plaintiffs complain that each of the said letters patent of the plaintiffs have been infringed by the sale and exposure for sale by the defendants of each of the said garments known as 'The Champion,' and 'The Distingué,' and by the sale and exposure for sale of other waterproof garments made by the manufacturers of 'The Champion,' 'The Distingué,' and 'The Tropical Odourless,' but not bearing their distinguishing names, but which unnamed garments are manufactured by similar processes to the three named garments." It was held that the reference to unnamed garments was not sufficiently specific, as it was not clear that the unnamed garments referred to were substantially the same as those which were specifically mentioned.

If the particulars delivered are too general, the defendant should apply **for further and better particulars.**

Evidence admitted if within particulars.

If at the trial evidence is tendered which comes within the literal meaning of the particulars it will be admitted, notwithstanding that the particulars are too general, as **the defendant should have objected to the particulars**, and not have waited until the trial to take his objection (*u*).

The plaintiff having delivered particulars of breaches specifying certain sales by the defendant of rollers, and in particular to Shaw and Smith, the defendant, in answer to interrogatories, admitted sales to Hirst. Fry, J., in giving judgment, said: "In this case I think I must admit the evidence tendered in respect of Hirst's case. It is said that in respect of those cases which are not mentioned by name in the particulars of breaches, the plaintiff cannot give evidence. It may be that the particulars were not sufficient, or tended to embarrass. But the defendant did not apply for amended particulars, according to the case of *Hull* v. *Bollard*. It appears to me I have to inquire what is the meaning of the particulars. I find the case of Hirst is within the literal meaning of the particulars.

(*u*) *Hull* v. *Bollard*, 1856, 25 L. J. Ex. at p. 306.

If I had found that the case of Hirst was likely to create surprise, or likely to introduce any point not raised by Smith's or Shaw's case, I should probably have given an opportunity to the defendant to bring fresh evidence. I have asked whether there is any witness not here whom the defendants would desire to bring in respect of Hirst's case, and have received no satisfactory answer on that point, and must assume that there is no such witness" (*v*).

Conversely, where the particulars of breaches complained of infringement by user only, the Court refused to enter into the question as to whether there had been infringement by manufacturing the articles complained of (*w*).

Particulars of breaches may also be ordered in actions which are not strictly actions for infringement or petitions for revocation; this is done under the ordinary jurisdiction of the Court (*x*). In an action charging that the defendant falsely and maliciously wrote and told persons who had bought certain machines of the plaintiff's that the machines were infringements of his the defendant's patents, the defendant having pleaded not guilty, the Court ordered the defendant to deliver particulars, showing in what part the plaintiff's machines were an infringement of the defendant's patents, and pointing out, by reference to the page and line of the defendant's specifications, which part of the inventions therein described he alleged to have been infringed (*y*).

Where infringement alleged to be contemplated in future.

Where the plaintiff claiming an injunction relies on certain acts of the defendant as evidence of an intention to infringe in the future, the defendant is entitled to full notice of the nature of the infringements he is alleged to be contemplating, especially where such acts have been committed since action brought (*z*), and the plaintiff will not be permitted to adduce evidence thereof unless such notice has been given.

(*v*) *Sykes* v. *Howarth*, 1879, L. R. 12 Ch. D. 826.

(*w*) *Henser* v. *Hardie*, 1894, 11 R. P. C. 421, 427.

(*x*) *Perry* v. *Mitchell*, 1840, 1 Web. P. C. 269.

(*y*) *Wren* v. *Weild*, 1869, L. R. 4 Q. B. 213.

(*z*) See *The Shoe Machinery Co.* v. *Cutlan*, 1895, 12 R. P. C. 357; *Welsbach Incandescent Light Co.* v. *Dowle*, 1899, 16 R. P. C. 391.

STATEMENT OF DEFENCE.

Defence.—The following defences are available to a defendant to an action for infringement. **Defences available.**

1. He may deny the plaintiff's title to the letters patent sued on.
2. He may plead the leave and license of the patentee, specifying the circumstances.
3. He may deny that he has committed the acts complained of in the particulars of breaches.
4. He may deny that the acts complained of are infringements of the letters patent.

   [Nos. 3 and 4 are included under a mere denial of infringement.]

5. He may allege that the letters patent are invalid, in which case he must deliver particulars of objections to the validity.
6. He may allege that the patented article or process is carried on exclusively or mainly outside the United Kingdom (constituted a defence by sect. 25, sub-sect. 2, of the Act of 1907).
7. He may allege circumstances which would have justified revocation of the patent on an application for a compulsory licence or revocation under sect. 24 of the Act of 1907 (constituted a defence by sect. 25, sub-sect. 2).
8. He may allege that in a contract made after the passing of the Act of 1907, if such contract is in force at the time, relating to the sale or lease of, or licence to use or work any article or process protected by the patent, there exist certain conditions which are made void by sect. 38 (constituted a defence by sect. 38, sub-sect. 4).
9. As a defence to a claim for damage (but not to a claim for an injunction) on a patent granted after the commencement of the Act of 1907, he may allege that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent (constituted a defence to a claim for damages by sect. 33 of the Act of 1907).

Estoppel.

An assignor who has covenanted for the validity of the patent is estopped from alleging invalidity in an action for infringement brought against him by the assignee (see p. 200 *et seq.*).

A licensee is always estopped from denying the validity of the patent or the title of his licensor (see p. 205 *et seq.*).

Where there are several defendants, an estoppel may operate against one and not against the others, and in an action against partners, one of the partners by putting in a separate defence may be able to free himself from the effect of the estoppel which prevents his partner from raising the issue of validity (*a*).

Judgment having been recovered against the defendant in an action for infringement, such defendant cannot plead the invalidity of the patent as a defence to a subsequent action brought against him for an infringement of the same patent; he is **estopped by the first judgment**, and this is so, even though the first judgment was entered by consent (*b*), and the defendant will not even be allowed to raise the question of validity on new grounds (*c*).

But where the defendants in the second action are not the same as those in the first, there will be no estoppel (*d*), though in such a case, if the patent had been previously upheld by a court of co-ordinate or superior jurisdiction, strong additional evidence will be required in order to reverse the previous finding, and the Court will usually hold itself bound by previous decisions in the question of the construction of the patent (*e*).

Similarly if the patent has been held invalid in a previous

(*a*) *Heugh and Chamberlain*, 25 W. R. 742; *Goucher* v. *Clayton*, 1865, 11 Jur. N. S. 107.

(*b*) *Thomson* v. *Moore*, 1889, 6 R. P. C. 426; 7 R. P. C. 325; *Brown* v. *Hastie & Co., Ltd.*, 1906, 23 R. P. C. at p. 374.

(*c*) *The Shoe Machinery Co.* v. *Cutlan* (No. 2), 1896, 13 R. P. C. at p. 145.

(*d*) *Goucher* v. *Clayton*, 1865, 11 Jur. N. S. 107; 34 L. J. Ch. 239; *Otto* v. *Steel*, 1886, 3 R. P. C. 109, 114.

(*e*) *Otto* v. *Steel*, 1886, 3 R. P. C. at p. 114; *Slazenger* v. *Feltham*, 1889, 6 R. P. C. at p. 130; *Automatic Weighing Machine Co.* v. *Combined Co.*, 1889, 6 R. P. C. 120, 367; *Edison* v. *Holland*, 1889, 6 R. P. C. 243; *The Shoe Machinery Co.* v. *Cutlan*, 1896, 13 R. P. C. 143; *The Flour Oxidising Co., Ltd.* v. *Carr & Co., Ltd.*, 1908, 25 R. P. C. at p. 448.

action it will be a bar to a subsequent action for infringement between the same parties (*f*). But if the ground of invalidity has been removed by amendment of the specification there will be no estoppel (*g*).

"An estoppel must be certain to every intent and not be taken by argument or inference" (*h*), so where a question of infringement was submitted to an arbitrator who in his award found that the letters patent were not illegal or void, in a subsequent action for infringement against the same defendant, it was held that the arbitrator's award was not such a decision as to make an estoppel within the above-cited rule (*i*).

And in an action against manufacturers who have at an earlier date, under a contract of indemnity, financed the defence of users in actions by the same plaintiffs, the manufacturers will not be precluded from raising the issue of validity (*k*).

Conditional defence.

A statement of defence alleged that if the specification were construed so as to make the defendant an infringer, the claims of invention would be bad for want of novelty, as including matters described in certain specifications (stating them). North, J., refused to strike out the paragraph under Order XIX., rule 27; the Court of Appeal dismissed the appeal with costs (*l*).

A statement of defence admitted infringement in ten instances and no more; the plaintiffs elected to move for judgment upon such admissions; held, that they were entitled to an inquiry as to damages as to these ten instances of infringement and no more, and that all evidence as to any other instances of infringement alleged to have been committed by the defendant must be excluded (*m*).

Special defence

The defences which are made available by the Act of 1907

(*f*) *Horrocks* v. *Stubbs*, 1895, 12 R. P. C. at p. 540.

(*g*) *Decley's Patent*, 1894, 11 R. P. C. at p. 76.

(*h*) Com. Dig. tit. Estoppel (E 4).

(*i*) *Newall* v. *Elliott*, 1863, 32 L. J. Ex. 120.

(*k*) *Gammons* v. *Singer Manufacturing Co.*, 1905, 22 R. P. C. at p. 459.

(*l*) *Hocking* v. *Hocking*, 1886, Griff. P. C. 129; 3 R. P. C. 291.

(*m*) *United Telephone Co.* v. *Donohoe*, 1886, L. R. 31 C. D. 399; 3 R. P. C. 45.

created by Act of 1907.

and numbered 6, 7, 8, and 9 on p. 329, supra, must be specially pleaded in the defence and are not matters to be dealt with in the particulars of objections to validity.

By sect. 25, sub-sect. 2, "*Every ground on which*—

(a) *a patent might, immediately before the first day of January, one thousand eight hundred and eighty four, have been repealed by scire facias ; or*

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

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

The defences numbered 6 and 7 are made available by this sub-section and will now be considered.

In Chap. XII. supra, we have seen that the Comptroller may revoke a patent under sect. 26 on any ground on which the grant might have been opposed, *i.e.*, on certain specified grounds of invalidity. As one or more of these grounds may be alleged in support of the defence of invalidity they need not be further considered here.

Patent mainly worked abroad.

We have also seen (Chap. XII.) that by sect. 27 the Comptroller is empowered to revoke a patent on the ground that the patented article or process is carried on exclusively or mainly outside the United Kingdom. It is therefore possible to allege that the patented article or process is carried on exclusively or mainly outside the United Kingdom as a **defence** to an action for infringement, and by sect. 32 (see p. 253) the defendant *may* be in a position to **counterclaim** for revocation on this ground. This is not necessarily so, however.

This defence is only available after the lapse of **four years** from the date of the patent.

There are no rules in Order LIIIA. which deal with this defence, but it would appear from the observations of Mr. Justice Parker in *Hatschek's Patent*, 1909, 26 R. P. C. at p. 246, that the onus of proof lies on the person seeking to revoke the patent (and by analogy the same may be said of a defendant) to prove the truth of his allegations. Consequently it would appear just that the defendant should be called upon to deliver

some particulars justifying the plea in order that the plaintiff may know what case he has to meet.

The defence is of course available on appeal to the Court of Appeal and the House of Lords, and raises an **issue of fact as between the plaintiff and the defendant only.** Consequently a judgment upon this issue will not create an estoppel against or in favour of a person seeking to revoke the patent on this ground, since a petitioner to revoke is in the position of a member of the public (*n*). Moreover, the defence raises an issue of fact as regards **a particular date only,** consequently a defendant may raise the defence in successive actions on the same patent, just as a petitioner may present petitions under sect. 27 to revoke the same patent from time to time as the circumstances change (*o*).

Wants of public unsatisfied.

In Chap. XII., we have seen that, under sect. 24, if the reasonable requirements of the public with respect to the patented invention have not been satisfied, any person interested may present a petition for the grant of a compulsory licence or in the alternative for the revocation of the patent. The petition is referred to the Court.

The defence (to an action for infringement) based on this section must be the allegation of some ground which, if true, would have justified the Court in coming to the conclusion that the reasonable requirements of the public would not be satisfied by the granting of licences.

Only a **person interested,**—not any member of the public, may present a petition under sect. 24, and it would seem that this defence will be available only to such persons as could have been considered **interested** on a petition, and consequently a judgment obtained on this defence or on a petition under sect. 24 would be conclusive as between the parties with respect to the particular circumstances at any particular date.

It is submitted that the pleading should not be confined to the bare statement that the requirements of the public with respect to the patented invention have not been satisfied, but should set forth the **facts,** *i.e.*, "the ground" upon which the

(*n*) See pp. 253—254, supra.

(*o*) See Parker, J., in *Hatschek's Patent*, 1909, 26 R. P. C. at p. 246.

patent might have been revoked as an alternative to a compulsory licence. The question of the nature of the facts necessary to justify revocation has been discussed in Chap. XII., supra.

Since by sect. 24, sub-sect. 3, it is provided that the patent may not be revoked until after **three years** from the date of the patent, it follows that the defence is not available until after this period has elapsed.

By sect. 38, sub-sect. 4, of the Act of 1907 it is provided :—

Defence of existence of contract with void conditions.

"*The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.*"

The nature of the conditions made void by sect. 38 has been discussed at p. 211.

It is clear that the words "*by the patentee*" refer to anyone who has owned the patent since it was in force, and it will be no reply to this defence for the owner of the patent to say that the objectionable contract was made by a previous owner of the patent.

By rule 10 of Order LIIIA. it is provided that a defendant relying on this defence must deliver with his defence full particulars of the contract and condition on which he relies.

It is not anticipated that many cases will arise on this defence, as the public are by now fully aware of the restrictions placed upon the insertion of conditions, and moreover before bringing an action, if such a contract existed, the patentee could take steps to relieve the other party from the objectionable conditions.

Defence as to damages; ignorance of patent.

By sect. 33 it is provided that a patentee shall not be entitled to recover damages from a defendant who proves that he was not aware of the patent, and had no reasonable means of making himself aware of it.

This section is discussed further on in this chapter. From the point of view of the pleader it is submitted that he should merely state that "at the date of the infringement alleged, he was not aware, nor had reasonable means of making himself

aware, of the patent." The onus of proof is expressly laid upon the shoulders of the defendant.

Particulars of objections.

Particulars of Objections.—If the defendant in an action for infringement, or the petitioner in a petition for revocation pleads the invalidity of the patent he must deliver with his defence particulars of the objections upon which he intends to rely. The requirements as to the specific nature of such particulars have grown more and more stringent since the Act 5 & 6 Will. IV. c. 83, s. 3, which required that "in any action brought against any person for infringing any letters patent, the defendant, on pleading thereto, shall give to the plaintiff a notice of any objections on which he means to rely at the trial of such action." The Act of 1883 required particulars of the objections, which implies considerably more than a mere notice.

Sect. 29, sub-sect. (2), of that Act provided:—"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."

The new rules.

The statutory requirement is now replaced by rules 14, 15, 17, 18, 19, 20 and 21 of Order LIIIA. Rule 17 is as follows:—"*Particulars of objections (whether delivered with the defence in an action for infringement of patent or with a petition for revocation under sect.* 25 *of the Act or with a counterclaim for revocation under sect.* 32 *of the Act) must state every ground upon which the validity of the patent is disputed and must give such particulars as will clearly define every issue which it is intended to raise.*"

By rule 21, "*At the hearing of any action, petition, or counter-*

claim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem just) be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively."

Every objection must be pleaded.

Apart from granting leave to amend the particulars, the Court will not allow an objection to be taken to the validity of the patent unless that objection has been pleaded, even though the objection should become clear in the evidence at the trial. In the case of the *Alsop Flour Process, Ltd.* v. *Flour Oxidising Co. Ltd.* the particulars of objections alleged that the patent was invalid on the grounds of want of novelty, want of utility, and insufficiency of the specification. Paragraph 3 of the particulars was as follows: "The alleged invention was not the subject-matter for valid letters patent, inasmuch as the action of gaseous oxidising agents, prepared in any of the matters described in the specification, on flour and the like was well known at the date of the patent." At the trial want of subject-matter was urged by counsel for the defendants upon a particular construction of the claim, apart from anticipation. Lord Loreburn, L.C., dealing with this argument, said (1908, 25 R. P. C. at p. 490), "He (defendant's counsel) also urged that if the claim were for all oxidising agents in the gaseous or vapourised state, except ozone, there was no proper subject-matter. I will not enter upon these points, because they were not raised either in the particulars, or in the Court of Appeal, or in the printed case of the appellants in this House. Patentees are entitled to protection against objections made without notice or opportunity of refuting them by evidence, and it is possible the respondents here would have desired to give evidence, had they been so challenged (*p*).

In other than infringement actions or petitions.

Particulars of objections have always been ordered, when the validity of a patent has been put in issue. When it was a condition precedent to an agreement to assign letters patent, that the assignee should first satisfy himself as to the validity of the patent, in an action brought for specific performance of this

(*p*) See also judgment of Fletcher Moulton, L.J., in *British United Shoe Machinery Co., Ltd.* v. *A. Fussell & Sons*, 1908, 25 R. P. C. at p. 659.

agreement, and resisted by the assignee on the ground of his right under the condition precedent, it was held that the validity of the patent was at issue and that the plaintiff was entitled to particulars of objections (*q*).

It is not necessary for every one of two or more defendants defending in the same interest to deliver particulars of objections (*r*).

Any of the objections which we have discussed in previous chapters may be taken in order to upset a patent, but the particulars must set out those objections in such terms that the plaintiff may be informed what case he will have to meet at the trial of the action.

True and first inventor.

If it be pleaded that the patentee was not the true and first inventor it is submitted that particulars must be delivered stating the name of the person whom the defendant alleges to have been the true and first inventor. The case of *Russell* v. *Ledsam* (1843, 11 M. & W. 647), which has been referred to in various text-books as an authority to the contrary, was decided upon the construction of the Act 5 & 6 Will. IV. c. 83, s. 3, and is now obsolete. Moreover, it is to be remembered, as was pointed at p. 20, ante, the issue raised by this plea is not one of novelty, but a specific ground of attack in itself.

Want of novelty. Rule 18.

The most common ground of objection to the validity of a patent is **want of novelty** either on account of prior publication in some document or prior public user of the invention. By rule 18 of Order LIIIA., "*If one of the objections taken in the particulars of objections be want of novelty, the particulars must state the time and place of the previous publication or user alleged, and if it be alleged that the invention has been used prior to the date of the patent, must also specify the names of the persons or person who are alleged to have made such prior user and whether such prior user is alleged to have continued down to the date of the patent, and if not, the earliest and latest dates on which such prior user is alleged to have taken place, and shall also contain a description (accompanied by drawings if necessary) sufficient to identify such alleged prior user, and if such user*

(*q*) *Hazlehurst* v. *Rylands*, 1892, 9 R. P. C. 1.

(*r*) *Smith* v. *Cropper*, 1885, 10 A. C. 249.

relates to any machinery or apparatus shall specify whether the same is in existence and where the same can be inspected."

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

If this rule be compared with paragraph 2 of sect. 29, sub-sect. 2, of the Act of 1883, it will be seen that the requirement for particulars has become far more strict than was formerly the case. It has been decided by Parker, J. (*s*), that in the case of a prior user alleged to be in existence at the date of the particulars the defendants were not bound to deliver a description and drawings provided they obtained inspection of the articles for the plaintiffs, for in that case the plaintiffs might themselves make the required drawings.

Some difficulty is occasioned by the words "sufficient to identify." Do they mean that the particulars must be such as to enable the plaintiff to know precisely the nature of the prior user alleged, or would it be sufficient to say that an article kept in some specific safe in a safe deposit and no other was relied on? In the case of an article the requirement for drawings to be delivered might supply the solution of the difficulty, but in the case of a process the answer is not so easy (*t*).

We submit that the defendant should be forced to disclose in his particulars all the information in his possession concerning the prior user which he proposes to prove in Court, and that no useful purpose is served by allowing him to conceal the true nature thereof until the trial. Unfortu-

(*s*) *The Crossthwaite Fire Bar Syndicate* v. *Senior*, 1909, 26 R. P. C. 260.

(*t*) See judgment of C. A. in *Minerals Separation Ltd.* v. *Ore Concentration Co. Ltd.*, April 2nd, 1909.

nately the words "sufficient to identify" are precisely the words used in the judgment of Fletcher Moulton, L.J., in *Brown's Patent* (1906, 23 R. P. C. 792) before Order LIIIA. came into force. The learned Lord Justice held that the purpose of particulars under the old practice was not to describe the prior user to the plaintiff or to inform him of its nature, but merely to identify the article in question. We are not concerned with the question of whether this judgment was taken into account in framing the rules, but if the words of the rules bear the same meaning as those in the judgment there is some danger that a manifest and ridiculous injustice will be perpetuated.

Objections on the ground of **prior publication** stand very much upon the same footing as those on the ground of prior user.

If the prior publication is alleged to be in books or newspapers, the plaintiff is entitled to be told the name of the book or newspaper, and to be given such details of the books or newspapers as will enable them to be found and identified by the plaintiff.

Whether or not a defendant will be required to give particulars of **lines and pages of the specifications** upon which he relies in his objections or to point out specifically what part or parts of the plaintiff's specification he alleges to be affected thereby will depend upon the circumstances of the case and the nature of those specifications (*u*); where it appeared that the defendant had, figuratively speaking, "thrown at the head" of the plaintiff a large number of complicated specifications without any attempt at discrimination, further particulars were required (*x*), but if the defendant bonâ fide relies upon the whole of a specification, or any number of specifications in reason, and the subject-matter is simple, his particulars of objections will not be interfered with (*y*).

In *Nettlefolds* v. *Reynolds* (1891, 8 R. P. C. at p. 417),

(*u*) *Heathfield* v. *Greenway*, 1894, 11 R. P. C. 17.

(*x*) *Holliday* v. *Heppenstall*, 1889, 6 R. P. C. 320; *Sidebottom* v. *Fielden*, 1891, 8 R. P. C. at p. 270; *Heathfield* v. *Greenway*, 1894, 11 R. P. C. 17.

(*y*) *Siemens* v. *Karo*, 1891, 8 R. P. C. 376; *Nettlefolds* v. *Reynolds*, 1891, 8 R. P. C. 410; *Edison-Bell Phonograph Co.* v. *Columbia Phonograph Co.*, 1901, 18 R. P. C. 4.

Lindley, L.J., said: "It appears to me, therefore, that the moment the learned judge came to the conclusion, as he did in fact, that the defendant here had honestly done his best to give to the plaintiff that information that he is entitled to, unless the Court came to the conclusion that there was some grievous or some obvious mistake, he ought to be satisfied with that, and not to say, 'I shall order further particulars, because I know from experience that if you say you rely on the whole of the specification, when you come into Court nine-tenths will not be referred to.' If the defendant is to be bound hand and foot to a particular page, and to a particular line, it will be perfectly impossible for him to defend his case, or to impeach the patent to the extent and in the manner in which he is entitled to do it."

In *Plimpton* v. *Spiller* (1876, 20 Solrs. Journal, 866), the particulars were—"before the date of the alleged letters patent the alleged invention had been published in England in the 'Commissioners of Patents Journal,' of the 6th February, 1863, and in the 'Scientific American' of the 24th January, 1863, and in drawings and sketches deposited in the Patent Office Library in July, 1865." Mr. Justice Field directed that the defendant should amend his particulars by stating the date of the American patent, and in whose name it had been granted. And also by giving the pages of the publications mentioned, but not the lines. And also by giving such written details as would enable the drawings mentioned to be identified, and to state whether the drawings were or were not contained in books, and what books.

Want of Subject-matter.

The objection that the invention is not proper subject-matter in view of the common knowledge of the time when it was patented is a distinct allegation, and should be specifically pleaded (*z*).

Common knowledge.

Objections on the ground of common knowledge must be carefully distinguished from objections on the ground of prior publication; in the latter case every book or document must be particularised, as no instance of anticipation can be adduced

(*z*) *Holliday* v. *Heppenstall*, 1889, 6 R. P. C. at p. 328; *Phillips* v. *The Ivel Cycle Co.*, 1890, 7 R. P. C. at p. 82.

at the trial of which particulars have not been delivered; but when the objection to a patent is based upon common knowledge, no particular instances need be referred to, as this objection can only be proved by the examination of witnesses and references to well-known standard works upon the subject (*a*). But specifications may not be used as evidence of common knowledge unless they have been referred to in the particulars of objections, either under the plea of anticipation or specifically under the objection at present under consideration (*b*).

It is important to remember that the contents of specifications are not necessarily common knowledge, but may be shown to be part of the common knowledge (*c*). It is for this reason that attempts to show that a newly patented combination is not good subject-matter, because the elements have been described in prior specifications in different combinations, usually fails (*d*).

The usual practice is to state in the particulars whether the specifications cited are referred to as anticipations or as part of the common knowledge.

Want of utility.

Particulars are not required of the allegation that "the patented invention is not useful."

Insufficiency of specification.

The allegation that the specification is insufficient must be supported by particulars which indicate the alleged defect, and where a workman would meet with difficulty in carrying out the directions given (*e*). In *Heathfield* v. *Greenway* (1894, 11 R. P. C. 17), the following objections, viz.: "That the specification does not sufficiently describe and ascertain the

(*a*) *Holliday* v. *Heppenstall*, supra; *English and American Machinery Co.* v. *Union Boot Co.*, 1894, 11 R. P. C. at p. 374.

(*b*) *The Salvo Laundry Co.* v. *Mackie*, 1893, 10 R. P. C. 68; *English and American Machinery Co.* v. *Union Boot Co.*, 1894, 11 R. P. C. 367; *Castner-Kellner Alkali Co.* v. *Commercial Development Co.*, 1899, 16 R. P. C. at p. 276; *Sutcliffe* v. *Abbott*, 1903, 20 R. P. C. at p. 55.

(*c*) *Salvo Laundry Supply Co.* v. *Mackie*, 1893, 10 R. P. C. at p. 70; *Holliday* v. *Heppenstall*, 1889, 6 R. P. C. 326.

(*d*) See, *e.g.*, *British United Shoe Machinery Co.* v. *A. Fussell & Sons, Ltd.*, 1908, 25 R. P. C. 631.

(*e*) *Crompton* v. *Anglo-American Brush Corpn.*, 1887, 4 R. P. C. 197; *Heathfield* v. *Greenway*, 1894, 11 R. P. C. 17; *Dege's Patent*, 1895, 12 R. P. C. 448.

nature of the invention, and the manner in which the same is to be performed;" and, "That the said specification is ambiguous and framed in a manner calculated to mislead;" were held to be too vague. A very typical and instructive instance of such an objection, where better particulars were ordered of the insufficiency, is to be found in *Dege's Patent* (1895, 12 R. P. C. 447).

Specification does not define invention.

The objection that the **specification does not define the limits of the invention claimed** is sufficient and does not require to be further particularised (*f*). But as to the substantiality of this defence see the judgment of Fletcher Moulton, L.J., in *British United Shoe Machinery Co., Ltd.* v. *A. Fussell & Sons, Ltd.* (1908, 25 R. P. C. 631).

Disconformity.

When the objection is on the ground of **disconformity** between the provisional and complete specification, the defendant ought to give such particulars as would inform the plaintiffs of the nature and scope of the alleged differences. This does not mean that the defendants must furnish the plaintiffs with the heads of what the defendants' argument will be at the trial, but only such information as the plaintiffs may reasonably require in order to know precisely the nature of the case that will be raised against them (*g*). On account of sect. 42 of the Act of 1907 (see p. 100, ante), it is not sufficient to show that there is disconformity between the provisional and the complete specifications,—the objector must show that the excess in the complete specification was not novel at the date of the complete specification, and consequently it would seem that he should be obliged to specify the manner in which that matter had been published, as in the case of an objection to the patent on the ground of want of novelty at the date of the patent.

Fraud.

Order XIX. rule 6, of the Rules of the Supreme Court, 1883, provides: "In all cases in which the party pleading relies on any misrepresentation, fraud, breach of trust, wilful default, or undue influence, and in all other cases in which

(*f*) *British Ore Concentration, Ltd.* v. *Minerals Separation, Ltd.*, 1907, 24 R. P. C. 790.

(*g*) *Anglo-American Brush Corpn.* v. *Crompton*, 1886, L. R. 34 C. D. 152.

particulars may be necessary beyond such as are exemplified in the forms aforesaid, particulars (with dates and items, if necessary) shall be stated in the pleading: provided that if the particulars be of debt, expenses, or damages, and exceed three folios, the fact must be so stated, and a reference to full particulars already delivered or to be delivered with the pleading."

Such an allegation of fraud might be involved where the plaintiff is alleged to have stolen the invention from someone else, or that he had obtained the patent by bribery.

Particulars limit evidence.

By rule 21 of Order LIIIA. "*At the hearing of any action, petition or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem just) be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.*"

But Court may allow further evidence.

Apart from rule 19, which will be considered presently, the Court has always possessed the power to allow the evidence to go beyond the matters set forth in the particulars of objections. In *Britain* v. *Hirsch* (1887, 5 R. P. C. at p. 231) Cotton, L.J., said: "In my opinion, under the present Act of Parliament (1883) it is within the discretion of a judge who hears evidence in a patent case to allow evidence to go beyond the particulars actually delivered. Sub-sect. 4 of sect. 29 provides '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.' But that is different from amending the particulars, because the very next sub-section is 'Particulars delivered may be from time to time amended, by leave of the Court or a judge,' as something different from the discretion which is left to the judge, under the previous sub-section, and I think it is very right that that discretion should be given, so that the judge at the trial of a patent action should not be fettered or hampered in any way, which would prevent the real facts of the case being laid before the Court and justice being done between the parties."

Evidence will be admitted at the trial, provided the language

of the particulars of objections is large enough to admit it; since the proper course for the plaintiff to take should the defendant deliver vague particulars is to issue a summons before a judge in Chambers for further and better particulars, or, in the alternative, to have the objectionable words struck out.

In *Sugg* v. *Silber* (1876, L. R. 2 Q. B. D. at p. 495), Mellish, L.J., said: "In my opinion there is a very large difference between a case where a judge has been applied to and has ordered further particulars in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. It is perfectly obvious that, if Mr. Cave was right in saying that the two questions are the same, and that wherever the Court would order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a judge for further particulars."

Amendment of particulars.

By rule 19, "*Particulars of breaches, and particulars of objections may from time to time be amended by leave of the Court upon such terms as may be just.*"

The defendant will not be allowed at the hearing of the action to introduce evidence of prior user, not disclosed in the particulars of objection, although such evidence may have only come to his knowledge since the delivery of the particulars of objection. His proper course is to obtain leave by summons or by serving short notice of motion for leave to amend, when an order will be made upon terms.

Whether the application to amend be made before or at the trial the terms should be such that the plaintiff is at liberty, if he pleases, to discontinue the action, and to be in the same position as to costs, as if the proposed amended particulars had been delivered in the first instance; and the defendant should be put under such terms as to costs as to the judge or Court may seem just. The particulars of objections give notice to the plaintiff of the case which is to be made against him; and he should be able to discontinue or not, as he pleases,

paying the defendant's costs. The defendant should not be permitted to keep back his most salient objections, and so to entice the plaintiff to proceed and incur costs, and then to amend his particulars at the last moment.

The form of order for leave to amend before trial which has been consistently followed is that which was made in *Baird* v. *Moule's Patent Earth Closet Co.* set out in the report of *Edison Telephone Co.* v. *India Rubber Co.* (1881, 17 C. D. 137) (*h*).

Where the application to amend is made at the trial such leave will only be granted if the new evidence has only been recently discovered, and could not with reasonable diligence have been discovered before (*i*).

In *The Shrewsbury and Talbot Co.* v. *Morgan* (1896, 13 R. P. C. 75), Romer, J., refused leave to amend by adding an allegation of disconformity between the title and the claims after the question of infringement had been decided against the defendants.

In *Badische Anilin und Soda Fabrik* v. *La Société Chimique* (1897, 14 R. P. C. at p. 881) it became clear during the course of the trial that the specification of the patent sued upon was insufficient, and the defendants applied to Romer, J., who was trying the case, for leave to amend the particulars by inserting an objection on this ground. Leave was granted to amend, the plaintiffs having a fortnight to elect whether they would continue the action, the terms upon which such leave should be granted being left for argument until the plaintiffs had elected. On the hearing the plaintiffs elected to continue, and the patent was declared invalid as a result of the new objection, but all costs of and occasioned by the application to amend, and all costs thrown away by reason of the amendment being made so late, were given to the plaintiff (*k*).

In *Westley, Richards & Co.* v. *Parkes* (1893, 10 R. P. C. at p. 186), the Court allowed the defendants to amend at the

(*h*) See also *Ehrlich* v. *Ihlee*, 1887, 4 R. P. C. 115; *Wilson* v. *Wilson*, 1899, 16 R. P. C. 315.

(*i*) Per North, J., in *Moss* v. *Malings*, 1886, 3 R. P. C. at p. 375.

(*k*) See also *Parker* v. *Maignen's Filtre Rapide Co.*, 1888, 5 R. P. C. 207; *Allen* v. *Horton*, 1893, 10 R. P. C. 412.

trial by adding an allegation that the patented invention lacked subject-matter.

In *Pirrie* v. *York Street Spinning Co.* (1894, 11 R. P. C. at p. 431), leave to amend the particulars of objections was granted by the Court of Appeal in Ireland pending appeal.

The terms on which amendment will be allowed are a matter for the discretion of the Court, and it is of little use to appeal (*l*).

In *The Shoe Machinery Co.* v. *Cutlan* (1896, 1 Ch. 108), the Court of Appeal decided that they had jurisdiction to amend the particulars of objections although in that particular case they declined to do so.

III. Interlocutory Injunction.

Interlocutory injunction, when granted.

An interlocutory injunction may be granted **ex parte**, after the issue of the writ, and before service. An ex parte injunction will only be granted when it can be shown that great injury will accrue to the plaintiff by delay, where there is a presumption that the patent is valid, when he can clearly establish his title and the commission of the act which he declares to be an infringement, and where there is a strong primâ facie case that that act is an infringement of the patent (*a*); and the Court will usually require the plaintiff to give a satisfactory undertaking that he will pay any damage that the defendant may suffer in the event of the latter being successful at the trial (*b*).

Notice of motion.

Notice of motion having been given, an interlocutory injunction will be granted after appearance, or leave may be given to serve notice of motion with the writ.

By sect. 25 of the Judicature Act, 1871, sub-sect. 8: "A mandamus or an injunction may be granted, or a receiver appointed by an interlocutory order of the Court, in all cases in which it shall appear to the Court to be just or convenient that such order should be made; and any such order may be made either unconditionally or upon such terms and conditions as the

(*l*) *Wilson* v. *Wilson*, 1899, 16 R. P. C. 315.

(*a*) See *Gardner* v. *Broadbent*, 1856, 2 Jur. N. S. 1041.

(*b*) See p. 351, infra.

Court shall think just; and if an injunction is asked either before, or at, or after the hearing of any cause or matter to prevent any threatened or apprehended waste or trespass, such injunction may be granted if the Court shall think fit, whether the person against whom such injunction is sought is or is not in possession under any claim of title or otherwise, or (if out of possession) does or does not claim a right to do the act sought to be restrained under any colour of title; and whether the estates claimed by both or either of the parties are legal or equitable."

It will be observed that this section confers upon the Court very wide limits within which, in its discretion, it may grant injunctions. It sweeps away a great deal of the technical rules which had been from time to time laid down by the Court of Chancery for the granting of injunctions, and it practically substitutes for them the opinion of the judge trying each particular action as to the balance of convenience upon a consideration of the *facts* of the case.

Order L. rule 6, directs that "An application for an order under sect. 25, sub-sect. 8, or under rules 2 or 3 of this Order, may be made to the Court or a judge by any party. If the application be by the plaintiff for an order under the said sub-sect. 8, it may be made either *ex parte* or with notice. . . . ."

A master of the Queen's Bench Division has no power to grant an injunction. (Order LIV. rule 12.)

Must be "primâ facie" evidence of validity.

An interlocutory injunction will be granted whenever there has been such **working, user and enjoyment** of the patent rights by the patentee as will satisfy the Court that there are strong primâ facie reasons for acting on the supposition that the patent is valid.

Lord Eldon, in the case of the *Universities of Oxford and Cambridge* v. *Richardson* (1802, 6 Ves. 706), said: "It is then said in cases of this sort the universal rule is that if the title is not clear at law the Court will not grant or sustain an injunction until it is made clear at law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory in which this Court has granted or continued an injunction to the hearing

under such circumstances. In the case of patent rights, if the party gets his patent and puts his invention in execution and has proceeded to a sale, that may be called possession under it; however doubtful it may be whether the patent can be sustained, this Court has lately said **possession under a colour of title** is ground enough to enjoin, and to continue the injunction, till it shall be proved at law that it is only colour and not real title."

And in *Gardner* v. *Broadbent* (1856, 2 Jur. N. S. 1041), Sir J. Stuart, V.-C., said: "I wish it to be understood that the law of the Court is that laid down by Lord Eldon in the *Universities of Oxford and Cambridge* v. *Richardson*."

Established in former trial.

There having been a trial as to the validity of the patent, which has terminated in favour of the patentee, will be considered by the Court sufficient **reason for granting an interlocutory injunction**; and where the patentee has worked and enjoyed the patent for many years without dispute, an interlocutory injunction will be granted (*c*); so also where the defendant has admitted the validity of the patent (*d*), or is so placed in his relationship to the patentee as to be estopped from denying its validity (*e*).

Long possession.

In *Dudgeon* v. *Thompson* (1874, 30 L. T. N. S. 244), Jessel, M.R., said: "The Court can grant an injunction before the hearing where the patent is an old one and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent."

So in *Betts* v. *Menzies* (1857, 3 Jur. N. S. 358), Wood, V.-C., said: "The law of this Court is, that where the patentee has had long enjoyment, then he shall have an injunction to

(*c*) *Dudgeon* v. *Thompson*, 1874, 30 L. T. N. S. 244; *Muntz* v. *Foster*, 1843, 2 W. P. C. at p. 95; *Rothwell* v. *King*, 1886, 3 R. P. C. 379; *Hayward* v. *Pavement Light Co.*, 1884, Griff. P. C. 124.

(*d*) *Dircks* v. *Mellor*, 1845, 26 Lon. Journ. 268.

(*e*) *Dudgeon* v. *Thompson*, 1874, 30 L. T. N. S. 244; *Clarke* v. *Fergusson*, 1859, 1 Giff. 184.

protect his rights until trial, even although his rights under his patent be doubtful."

What amounts to long enjoyment is difficult to define, but decided cases would appear to suggest that undisturbed enjoyment for six years would be sufficient (*f*); but the user of the invention during that time must be active. The mere possession of a patent for a long period does not of itself give rise to a presumption of its validity (*g*).

Mere possession insufficient.

An interlocutory injunction is seldom granted **in the case of a new patent** (*h*), unless very strong evidence in support of the motion be adduced.

Seldom granted for new patent.

In *Clarke* v. *Nichols* (1895, 12 R. P. C. 310) the patent was less than a year old. Notice of motion was served with the writ, but the defendant did not appear. The affidavit by the plaintiff stated that prior to the purchase of the patent he had caused a full investigation to be made into its validity by his patent agents, and that he was advised that it was valid, and to the best of his knowledge, information and belief, it was valid now. The injunction was granted.

In *Holophane, Ltd.* v. *Berend & Co.* (1898, 15 R. P. C. at p. 19), Kekewich, J., said: "During the forty years over which my experience extends, and I think for a considerably longer period, the Court has acted on one uniform rule, subject, of course, to exceptions, in dealing with applications of this character. The rule, as I understand, is this: that where the proprietor of recently granted letters patent, the validity of which has not been established by legal process, seeks an injunction against an alleged infringer, the Court declines to interfere by interlocutory injunction and leaves the patentee to establish the validity by formal proceedings. Of course, forty years ago, the motion for injunction had to stand over while the validity of the patent was established at law. Fortunately we have got rid of that, and the injunction and the validity

(*f*) *Bickford* v. *Skewes*, 1837, 1 Web. P. C. 211; *Rothwell* v. *King*, 1886, 3 R. P. C. 379.

(*g*) *Plimpton* v. *Malcolmson*, 1875, 44 L. J. Ch. 257; L. R. 20 Eq. 37.

(*h*) *Cladwell* v. *Vanvlissengen*, 1851, 9 Hare, 415, 424; *Renard* v. *Levinstein*, 1864, 10 L. T. N. S. 177; *Lister* v. *Norton*, 1884, 1 R. P. C. 114; *Jackson* v. *Needle*, 1884, 1 R. P. C. 174; *British Tanning Co.* v. *Groth*, 1890, 7 R. P. C. 1.

can all be determined and disposed of in one and the same action in one and the same Court; but the rule holds still. Of course, there are exceptions; it will not do for a defendant coming here as against the proprietors of letters patent simply to say, 'I challenge the validity.' There must be something more than that. The Court must be satisfied that there is an honest intention of trying the question; and not only an honest intention of trying the question, but that there is something to be tried."

If a certificate of validity has been granted in a previous action, it will not avail the defendant on an application for an interlocutory injunction to allege fresh grounds for invalidity (*i*).

Delay will bar right.

An interlocutory injunction will not be granted in cases where the plaintiff is guilty of delay.

In *The North British Rubber Co.* v. *The Gormully and Jeffery Co.* (1895, 12 R. P. C. at p. 20), Chitty, J., said: "Now I am not aware, having regard to patents, that there is any substantial ground of distinction between an interlocutory injunction upon a patent right and upon any other. The principles appear to me to be substantially the same; and the general rule of the Court is that a person who comes to ask for that remedy, which is granted with despatch and for the purpose of protecting rights until the trial, should come promptly" (*k*).

The amount of delay which will prevent the granting of an interlocutory injuction will, of course, vary with the nature of the patent and the circumstances of the trade.

Unless explained.

The delay may, in some cases, be satisfactorily explained, and will not therefore be fatal, as in a case where the plaintiffs' solicitors advised them not to commence an action until the defendants appeared to be in a condition of sufficient financial soundness to undertake manufacture of the infringing articles (*l*).

Delay in proceeding against persons who are not parties to

(*i*) *Heine, Solly & Co.* v. *Norden*, 1904, 21 R. P. C. 513.

(*k*) See also *Bovill* v. *Crate*, 1866, L. R. 1 Eq. 388; *Greer* v. *Bristol Tanning Co.*, 1885, 2 R. P. C. 268; *The Aluminium Co.* v. *Domeiere* 1898, 15 R. P. C. 32; *Gillette Safety, Razor Co.* v. *A. W. Gamage, Ltd.*, 1907, 24 R. P. C. at p. 3.

(*l*) *United Telephone Co.* v. *Equitable Telephone Co.*, 1888, 5 R. P. C. 233.

the application in question is no ground for refusing an injunction, if there has been no delay in proceeding against the defendant (*m*).

Usual course on application.

A common course is for the Court to order the motion to stand until the trial of the action on the condition that the defendant undertakes to keep an account of all articles made and sold by him, but in some cases the plaintiff may be justified in persisting in his application, and the Court may make the injunction notwithstanding that the defendant offers to keep such an account (*n*). In considering which course should be adopted, the Court will be influenced chiefly by the balance of convenience and the probability of injury to either side, and the plaintiff will usually be required to give an undertaking to pay any damages occasioned by the injunction if it should appear subsequently that the defendant was in the right (*o*). And the discontinuance of the action will not prevent the undertaking being enforced (*p*).

Undertaking to keep account.

In *Plimpton* v. *Spiller* (1876, L. R. 4 C. D. 289), James, L.J., said: "The Court, not forming an opinion very strongly either one way or the other whether there is an infringement or not, but considering it is as a fairly open question to be determined at the hearing, and not to be prejudiced by any observations in the first instance, reserves the question of infringement as one which will have to be tried at the hearing and which it will then have to consider. There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things in statu quo—for that is really what the Court has to do, to keep things in statu quo—until the final decision of the question; and then, of course, the Court says: 'We will not stop a going trade. We will not adopt a course which will result in a very great difficulty in giving compensation on the one side or on the other. We have to deal with it as a practical question, in the best way we can.' I think, on the whole, that

(*m*) *The Pneumatic Tyre Co.* v. *Warrilow*, 1896, 13 R. P. C. 284.

(*n*) *Plimpton* v. *Spiller*, 1876, L. R. 4 C. D. 286.

(*o*) See *Graham* v. *Campbell*, 1878, L. R. 7 C. D. 490 (undertaking enforced).

(*p*) *New Comen* v. *Coulson*, 1878, L. R. 7 C. D. 764.

the Master of the Rolls has made the right order, viz., by granting the injunction and putting the plaintiff upon an undertaking to abide by such order (if any) as to damages as the Court may think fit to make if he should ultimately turn out to be in the wrong, and that it would not be right in this case merely to put the defendant upon the terms of keeping an account which, I conceive, might be a very clumsy and inefficient mode of recompensing the plaintiff if he should turn out ultimately to be in the right." In the same case the Master of the Rolls, Sir W. B. Brett, said (*q*): "There will be a hardship on the one side or on the other, and the question is on which side does the balance appear to lie? Now, if the trade of a defendant be an old and established trade, I should say that the hardship upon him would be too great if any injunction were granted. But where, as here, the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people, it seems to me to be 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."

Although the Court is naturally disposed to avoid granting an injunction and to induce the defendant to keep an account, yet if he should refuse to keep an account the Court will not be the more disposed to grant the injunction, the application for which must be heard on its merits (*r*).

The evidence to be used upon an application for an interlocutory injunction is upon affidavit.

Nature of affidavit required.

The affidavit should clearly point out in what the alleged infringement consists (*s*). If the plaintiff is the first inventor, he must distinctly swear to the fact, as also to the novelty and utility of the invention, and to the due filing of a sufficient specification (*t*). If the plaintiff is an assignee, he must swear

(*q*) At p. 292.

(*r*) See e.g., *The British Tanning Co., Ltd.* v. *Groth*, 1889, 7 R. P. C. 1.

(*s*) *Hill* v. *Thompson*, 1817, 1 W. P. C. at p. 231; 3 Mer. 624.

(*t*) *Hill* v. *Thompson*, 1817, 1 W. P. C. at p. 321; 3 Mer. 624; *Sturtz* v. *De la Rue*, 1828 (per Lord Lyndhurst), 5 Russ. 329; *Whitton* v. *Jennings*, 1860, 1 Dr. & S. 110; *Clarke* v. *Nichols*, 1895, 12 R. P. C. 310.

to the best of his belief (*u*). The affidavits in either case must state the facts as at the time of swearing, and it is not sufficient to swear that the invention was believed to be new when the patent was granted (*x*). Affidavits on "information and belief" must state the sources of the information (*y*). An injunction granted prior to statement of claim will be dissolved if the statement of claim when delivered does not agree with the affidavits upon which the injunction was granted (*z*).

In the Chancery Division it is the practice to hear applications for interlocutory injunctions as motions in Court. In the King's Bench Division the application is heard by the judge in chambers upon a summons.

Forms of injunction upon undertaking as to damages, and of order refusing injunction upon terms, will be found in the Appendix.

IV. Discovery.

Order XXXI. Rule 1, of the Rules of the Supreme Court provides that either party to an action, with leave of the Court, or a judge, may interrogate the other party.

The general rules as to interrogatories in ordinary actions apply equally to actions for infringement.

Interrogatories.

Interrogatories must be relevant to the issue, and will not be allowed to be used for the purpose of cross-examination. Since it is not possible to say precisely what the issues between the parties are before the statement of defence is delivered, neither party, except under special circumstances, will be allowed to interrogate until that stage of the action has been reached.

Directed to infringement issue.

The plaintiff may interrogate the defendant as to the act of infringement complained of; but where the defendant is asked concerning the **customers** whom he has supplied, it becomes material to ascertain from the pleadings whether the acts

(*u*) *Gardner* v. *Broadbent*, 1856, 2 Jur. N. S. 1041.

(*x*) *Hill* v. *Thompson*, 1817, 3 Mer. 624.

(*y*) *The Saccharin Corporation* v. *Chemicals Co.*, 1898, 15 R. P. C. 55; *Badische Anilin und Soda Fabrik* v. *W. G. Thompson*, 1902, 19 R. P. C. 502.

(*z*) *Stocking* v. *Llewellyn*, 1842, 3 L. T. 33.

complained of are admitted. If the act complained of be not admitted, the defendant may be asked whether he has not supplied a **certain definite article** to *anybody*, *and to whom*—since by this means an admission, not necessarily of infringement but of the act complained of, may be obtained. But if the act complained of be admitted, an inquiry as to the persons supplied only becomes relevant on the issue of damages and should be postponed until the inquiry. This principle was clearly stated by Chitty, J., in *Lister* v. *Norton* (1885, 2 R. P. C. 69 (*a*)).

Crossley v. *Tomey* (1876, L. R. 2 Ch. D. 533) was an action to restrain infringement. The defendant in interrogatories was required to state whether he was not making articles in all respects identical with those of the plaintiff, and to set forth in what respects they differed, and by what process they were made. It was held that the defendant, who alleged prior user by himself and others, had sufficiently answered by stating that, save so far as the articles manufactured by him before the date of the patent were similar to those of the plaintiff, the articles he now made differed from those made by the plaintiff, but he could not show in what they differed without ocular demonstration.

As to persons who supplied defendant.

An inquiry as to the **names of persons who supplied a defendant** who is merely a vendor will usually be inadmissible, since it is not relevant to any issue between the parties. But where the vendors sold a chemical product, which the plaintiffs had good reason to believe was manufactured in infringement of one of their patents for processes, the Court of Appeal allowed the interrogatory on the ground that the answers would probably enable the plaintiffs to ascertain whether the article were an infringement or not (*b*).

Framed on plaintiff's specification.

In *Benno Jaffé* v. *Richardson* (1893, 10 R. P. C. 136), the plaintiff administered interrogatories to the defendant, **framing them upon the statements in his specification**, which he

(*a*) And See *Tetley* v. *Easton* 1856, 18 C. B. 643; *De la Rue* v. *Dickinson*, 1857, 3 K. & J. 388; *Lea* v. *Saxby*, 1875, 32 L. T. N. S. 731; *Fennessy* v *Clark*, 1887, 37 C. D. 184; *Rawes* v. *Chance*, 1890, 7 R. P. C. 275.

(*b*) *Saccharin Corpn.* v. *Haines*, 1898, 15 R. P. C. 344.

alleged that the defendant had infringed, and asked the defendant if he had used the processes described in the specification, taking them step by step. Some of these interrogatories the defendant refused to answer, on the ground that they were not relevant until the patent was established. It was held by North, J., that the plaintiff was entitled to further answers.

Where defendant's process is secret.

Where a defendant alleged that his process was secret, he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials, but not to disclose the proportions in which he used the specified materials, or what the additional materials were (*c*).

"The mere plea of secret process is not sufficient to defeat discovery, but, on the other hand, interrogatories must not be made the means of unfair treatment of a man who is fighting fairly" (*d*).

The use of interrogatories after judgment on an enquiry as to damages (*e*), or on the taking of an account of profits (*f*), will be dealt with later.

Particulars will not excuse interrogatories.

The fact that the defendant's particulars of objections are sufficient will not necessarily preclude the plaintiff from obtaining more detailed information by administering interrogatories. In *Birch* v. *Mather* (1883, L. R. 22 Ch. D. at p. 631), Chitty, J., said: "The right to interrogate is conferred by the general orders, and I cannot say as a matter of principle that it can be laid down that the plaintiff is not entitled to interrogate the defendant, and vice versâ, with reference to these matters which may be covered by the particulars. I hold, therefore, on the general question, that there is a right to deliver interrogatories, and provided the interrogatories are properly worded, interrogatories with reference to these very matters which ought to be covered by the particulars" (*g*).

As to prior user.

In *Delta Metal Co., Ltd.* v. *Maxim Nordenfelt, Ltd.* (1891, 8 R. P. C. 169), the defendants had pleaded prior user; the

(*c*) *Renard* v. *Levinstein*, 1864, 3 N. R. 665; 10 L. T., N. S. 94.

(*d*) Per Kekewich, J., in *Ashworth* v. *Roberts*, 1890, 7 R. P. C. at p. 455.

(*e*) See p. 377.

(*f*) See p. 379.

(*g*) *Alliance Pure Whitelead Syndicate* v. *MacIvor's Patents*, 1891, 8 R. P. C. at p. 322; *General Electric Co.* v. *Safety Light and Elevator Co.*, 1904, 21 R. P. C. 109.

plaintiffs proposed to interrogate by asking whether the alleged prior user was in respect of a particular process, specifying it. The defendants answered that the prior user was substantially the process as described in the plaintiffs' specification. It was held that this was a sufficient answer.

The delivery of particulars does not prevent the plaintiff being entitled to interrogate as to the names and addresses of the persons by whom the defendant alleges the invention was used prior to the date of the plaintiff's patent, also as to the places where such prior user occurred (*h*).

Documents relating to prior user.

In *Carnegie Steel Co.* v. *Bell Bros., Ltd.* (1907, 24 R. P. C. 82), the defendants objected to allow inspection of certain documents referred to in their affidavit of documents, which documents, they said, referred solely to certain prior users alleged in their particulars of objections. It was held that the documents were privileged, and Buckley, L,J., said (at p. 92), "Particulars of prior user must be given; evidence of prior user need not be given; and it does not follow that every document relating to prior user is a particular of prior user; it may be something which may assist the defendant to prove the prior user, but that he is not bound to produce. I am not aware of any principle which in a patent action any more than any other action compels the defendant to produce documents of that description." Needless to say, however, all documents that are relevant must be included in the affidavit of documents whether privileged or not (*i*). The same rules apply to a petition for revocation under sect. 25 (*k*).

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's case (*l*).

(*h*) *Crossley* v. *Tomey*, 1876, L. R. 2 Ch. D. 533; *Birch* v. *Mather*, 1883, L. R. 22 Ch. D. 629; *Alliance Pure Whitelead Syndicate* v. *MacIvor's Patents*, 1891, 8 R. P. C. 321; *General Electric Co. v. Safety Light and Elevator Co.*, 1904, 21 R. P. C. 108.

(*i*) *Carnegie Steel Co. Ltd.* v. *Bell Bros. Ltd.*, 1907, 24 R. P. C. at p. 93.

(*k*) *Haddan's Patent*, 1884, 54 L. J. Ch. 126.

(*l*) *Hoffman* v. *Posthill*, L. R. 4 Ch. 673.

Communications with patent agent not privileged.

Communications between a man and his patent agent are not privileged, consequently, where the plaintiff's patent agent also acted as his solicitor, he was ordered to answer interrogatories with reference to documents which passed between them at the time the specification was prepared, such communications having taken place in the relationship of patent agent, and not of solicitor, and client (*m*).

In the same case interrogatories which sought to compel the plaintiff to particularise the alleged breaches by stating what parts of the plaintiff's speculation were infringed by the defendants (the defendants having in answers to interrogatories disclosed what they had done) were disallowed on the ground that the defendants could for themselves compare the plaintiff's specification with what they admitted they had done.

In determining whether a question is one of fact, and, therefore, to be answered, it makes no difference that it is asked with reference to a written document (*n*).

A defendant in a suit for infringement of a patent in order to prove that there was no novelty in the plaintiff's patent, interrogated the plaintiff as to the inventions described in the specifications of various patents, and asked him to show in what respects they differed from his. The plaintiff declined to answer these interrogatories on the ground that the questions were **not questions of fact, and that they related to the plaintiff's case**; the defendant excepted to the answer, and the exceptions were allowed (*o*).

The plaintiff was also required to set out a correspondence between himself and a third party, and also to state the particulars of the infringement of his patent on which he relied. He refused to answer these questions on the ground that the defendant might obtain an order in chambers to inspect the correspondence, and that he had sufficiently set out the particulars of the infringement in his bill. These answers were held to be sufficient (*p*).

We have set out the effect of this case at length, because it

(*m*) *Moseley* v. *Victoria Rubber Co.*, 1886, 3 R. P. C. 351.

(*n*) *Hoffman* v. *Posthill*, L. R. 4 Ch. 673.

(*o*) Ibid.

(*p*) Ibid.

is founded upon and exemplifies in many ways the principle upon which a defendant may examine a plaintiff. Lord Justice Giffard, in giving judgment, said: "As regards the case of *Daw* v. *Eley* (1865, 2 H. & M. 725), it must be always remembered that that was the case of a plaintiff exhibiting interrogatories to a defendant, and it was there held that the plaintiff could not call on the defendant to set forth the particulars of his defence. But when you come to the case of a defendant asking questions of a plaintiff, it is a very different thing. It is the defendant's business to destroy the plaintiff's case, and there the defendant has a right to ask all questions which are fairly calculated to show that the patent is not a good patent, or that what he alleges to be an infringement is not an infringement." Lord Justice Selwyn had said: "Our decision in this case will leave it entirely within the power of the learned Vice-Chancellor to order that all the costs occasioned by the interrogatories, the answer, the exceptions, the hearing the exceptions before him, and the hearing of this appeal, shall be dealt with as he, in his discretion, shall think fit; and if it shall appear that the power with the Court, for the purpose of justice and discovery, gives to the parties to administer interrogatories to each other has been abused, I have no doubt the learned Vice-Chancellor will take care that justice shall be done, and will make the party who is to blame pay all the costs of the improper exercise of his power" (*q*).

In *Rylands* v. *Ashley's Patent Bottle Co.* (1890, 7 R. P. C. 175) the defendant pleaded that the invention patented was not useful, and administered an interrogatory asking whether it had not been found necessary to use some and what modifications in the process described in the specification. The Court of Appeal allowed this interrogatory.

As in other cases discovery of documents will not be ordered until after the delivery of the defence (*r*).

The rules generally applicable with reference to discovery of documents apply to patent cases.

(*q*) *C.f.* the judgment of Kay, J., in *Bidder* v. *Bridges*, 1885, L. R. 29 C. D. 34.

(*r*) See *Woolfe* v. *Automatic Picture Gallery Co.*, 1902, 19 R. P. C. 161.

V. Inspection.

Sect. 34 of the Act of 1907 (sect. 30 of the Act of 1883), **Inspection.** provides: "*In an action for infringement of a patent, the Court may, on the application of either party, make such order for an injunction,* **inspection,** *or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court may see fit.*"

The power to order an inspection was always assumed by the Courts; in *Borill* v. *Moore* (1815, 2 Coop. Ch. Ca. Temp. Cottenham 56, n.) Lord Eldon said: "There is no use in this Court directing an action to be brought, if it does not possess the power to have the action properly tried. The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article; and, as the plaintiff alleges, he is making it with a machine constructed upon the principle of the machine protected by plaintiff's patent. Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy, at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted before the trial of the action to inspect the defendant's machine, and to see it work."

"The right to inspection is a right to be given at the discretion of the Court—to be exercised with a judicial discretion and with due regard to the interests of the partes concerned in the litigation" (*a*).

The object which the Court had in view in all cases where

(*a*) Per Bristowe, V.-C. in *McDougall* v. *Partington*, 1890, 7 R. P. C. at p. 357.

an inspection is permitted, is to ensure that the true facts of the case shall be carefully sifted; but at the same time the Court will take care that the process of the law is not abused, and that an action for infringement shall not be made a means and lever for the discovery of other persons' secrets.

Primâ facie case of infringement necessary.

The Court requires, before granting an order for inspection, that a **primâ facie case of infringement** (*b*) shall be made out.

May be limited to scientific witnesses.

When the interests of justice require, the inspection will be granted to **scientific witnesses**, who will be required to keep any secrets which they may have discovered, and do not affect the question of infringement. In *Flower* v. *Lloyd* (1876, W. N. 169, 230) and *Swan* v. *Edlin-Sinclair Tyre Co.* (1903, 20 R. P. C. 435) the Court strictly limited the inspection to scientific men, and excluded the plaintiff from being present.

In *Pigott* v. *The Anglo-American Telegraph Co.* (1868, 19 L. T. N. S. 46) it was alleged that an inspection would disclose important secrets. Giffard, V.-C., in refusing an order to inspect, said: "Of late years greater readiness has been shown by the equity Courts to allow inspection in patent cases than by the Courts of common law. But it has never been considered as a matter of right, nor have the equity Courts considered themselves as precluded from exercising a proper discretion in applications of this description. The Court ought to be satisfied of two things: that there really is a case to be tried at the hearing of the cause, and that the inspection asked for is of material importance to the plaintiff's case *as made out by his evidence*."

In *Batley* v. *Kynoch* (1874, L. R. 19 at p. Eq. 92) Sir James Bacon, V.-C., said: "Upon the single point which is raised before me, there can be no doubt that the plaintiff in such a suit as this is entitled to an inspection of the means which the defendants employ in the manufacture of the articles alleged to be violations of the plaintiff's patent, when such inspection is

(*b*) *Bovill* v. *Moore*, supra; *The Singer Sewing Machine Co.* v. *Wilson*, 1865, 12 L. T. N. S. 140; *Shaw* v. *The Bank of England*, 1852, 22 L. J. Ex. 26; *Batley* v. *Kynoch*, 1874, L. R. 19 Eq. 90; *Germ Milling Co.* v. *Robinson*, 1884, 55 L. J. Ch. 287; 1 R. P. C. 217; *Cheetham* v. *Oldham*, 1888, 5 R. P. C. 617.

essential for the purpose of enabling the plaintiff to prove his case; upon the materials before me that is not made out. There is no allegation by the plaintiff that he cannot make out his case without inspection. But there is on the part of the defendants a plain allegation that inspection is not necessary for the purposes of the suit; upon that only I must decide this question. I would rather not go into the other matters which have been referred to. The description in the specification and the allegation in the bill—but as I read both the description in the specification and the allegation in the bill—I find that the charge made by the plaintiff is that the cartridges, the right of manufacturing which is vested in him exclusively, have been imitated and copied by the defendant, and if that fact can be made out the plaintiff's case can be clearly established. The mode of making that out is by examination of the cartridges, the means by which they have been made, whether by a machine or hammer or a screw cannot signify in the least if the cartridges of the defendant when made are made upon the principle of the patent claimed by the plaintiff."

In *Drake* v. *Muntz Metal Co.* (1886, 3 R. P. C. 43), before statement of claim application was made to Bacon, V.-C., that the defendants by their proper officer should make an affidavit verifying the machines and processes used by the defendant company in bending metal tubes since the date of the plaintiff's patent and for inspection. The Vice-Chancellor said that sect. 30 (supra) did not give him power to direct an affidavit to be made, but ordered inspection of the machines.

Taking of samples for analysis.

The Court, in the case of *The Patent Type Founding Co.* v. *Walter* (1860, 8 W. R. 353) (*c*), assumed the jurisdiction to order the defendant to deliver to the plaintiff a sample of the type made by him so that the plaintiff might have the same analysed, for the purpose of ascertaining whether the composition was similar to the plaintiff's patented composition.

In that case it was also held that laches sufficient to defeat the plaintiff's right to an interlocutory injunction was no bar to an order on the same motion for inspection.

In *Webb* v. *Kynoch & Co. Ltd.* (1898, 15 R. P. C. at

(*c*) See also *Germ Milling Co.* v. *Robinson*, 1886, 3 R. P. C. 11.

p. 273) inspection was ordered of the defendants' works as one of the conditions for the refusal to grant an interlocutory injunction.

Mutual inspection.

In some cases, where it is necessary, the Court will order the defendant and the plaintiff to give **mutual inspection**, and to show both the patented machine and the alleged infringement at work, and to permit either party to take away any of the work or samples of the work which has been done in their presence (*d*).

Patent Office samples.

It is submitted that the Court could order the production of the **samples** which a patentee of a chemical invention is obliged to deposit **at the Patent Office** under sect. 2, sub-sect. 5, of the Act of 1907 (see p. 147, ante).

Whether the plaintiff will be entitled to see the alleged infringing machine at work or not will depend upon the circumstances of the case (*e*).

In a case where the defendant delivered to the plaintiff specimens of the alleged infringing articles, the latter was not allowed to see those articles in actual use on the defendant's premises (*f*).

In *McDougall* v. *Partington* (1890, 7 R. P. C. 351, 472) the plaintiff's right to inspection depended upon a contract which was the matter in dispute, and since he was unable to show that inspection was necessary to prepare his case, it was held that no inspection should be granted on the ground that the right depended upon the question to be determined at the trial.

Application. how made.

The application may be made on motion to the Court or by summons; it is usually made upon the application for an interim injunction, but it is immaterial at what stage of the proceedings the application is made. The evidence in support must be on affidavit, and a prima facie case of infringement must be made out, and it must be shown that the inspection is material to the plaintiff's case.

(*d*) *Davenport* v. *Jepson*, 1862, 1 N. R. 307; see also *The Germ Milling Co.* v. *Robinson*, 1886, 55 L. J. Ch. 288; 3 R. P. C. 11.

(*e*) *The Germ Milling Co.* v. *Robinson*, 1886, 3 R. P. C. 11; *Drake* v. *Muntz Metal Co.*, 1886, 3 R. P. C. 43.

(*f*) *Sidebottom* v. *Fielden*, 1891, 8 R. P. C. 266.

Costs of inspection.

The cost of an inspection depend on the circumstances, and are in the discretion of the Court (*g*). In *Ashworth* v. *English Card Clothing Co.* (1904, 21 R. P. C. 353) Joyce, J., allowed the costs of an inspection to the successful party, although it had taken place voluntarily and without an order of the Court, on the ground that circumstances showed that it had been necessary and proper.

New rule as to inspection of prior users.

Rule 18 of Order LIIIA., dealing with particulars of objections concludes thus: ". . . *No evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent and which is in existence at the date of the delivery of the particulars shall be receivable unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings.*"

The Court has always exercised power to order inspection of articles in the possession of the parties, but it generally happened that when an application was made to inspect an important "prior user" the defendant was in a position to say that the article was in the possession of a third party who, though willing to produce it at the trial, positively refused to allow inspection beforehand. This device is now, it is to be hoped, effectually rendered useless, for it is to be remembered (*h*) that if the third party refuses inspection the defendant is nevertheless bound to deliver a description and drawings.

VI. The Remedy.

The remedy sought or granted in an action for infringement may consist of an injunction, together with an account of sales and profits, or damages.

The Judicature Acts and the Rules which were made for the governing of the practice of the Courts introduced great

(*g*) *Mitchell* v. *The Darley Colliery Co.*, 1883, L. R. 10 Q. B. D. 457.

(*h*) See p. 338, *ante*.

changes in the method of procedure. The old practice of moving for an injunction by a suit in the Court of Chancery, and of trying the validity of the patent at common law, has disappeared; and in its place the patentee seeking to enforce his rights commences but **one action in which he claims, and if entitled to, obtains every remedy** which was formerly granted to him by the dual process.

Every patentee proceeding against an infringer must establish the validity of his patent and his title to an injunction; that being so, and the right to the injunction hanging so completely upon the question of validity, it is obvious that the power of both divisions of the High Court of Justice to grant complete and sufficient remedies and to try every question is of great advantage to persons in possession of patent rights.

Injunction based on threat to continue.

Injunction.—The **basis of an injunction is the threat,** actual or implied on the part of the defendant, that he is about to do an act which is in violation of the plaintiff's right; so that not only must it be clear that the plaintiff has rights, but also that the defendant has done something which induces the Court to believe that he is about to infringe those rights.

The fact that he has been guilty of an infringement of the patent rights will, under circumstances, be evidence that he intends to continue his infringement, but whether he has actually infringed the patent or not, it will be sufficient if he has **threatened to infringe it.** Actual infringement is merely evidence upon which the Court implies an intention to continue in the same course.

In *Frearson* v. *Loe* (1878, L. R. 9 C. D. at p. 65) Jessel, M.R. said: "I am not aware of any suit or action in the Court of Chancery which has been successful on the part of a patentee, without infringement having been proved; but, in my opinion, on principle there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think for this reason, where the defendant alleges an intention to infringe, and claims the right to infringe, the mischief done by the threatened infringement of the patent is very great, and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled

to claim from the Court from threatened injury, where that threatened injury will be very serious. No part of the jurisdiction of the old Court of Chancery was considered more valuable than that exercise of jurisdiction which prevented material injury being inflicted, and no subject was more frequently the cause of bills for injunction than the class of cases which were brought to restrain threatened injury, as distinguished from injury which was already accomplished. It seems to me, when you consider the nature of a patent right, that where there is a deliberate intention expressed, and about to be carried into execution, to infringe certain letters patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury. Of course it must be plain that what is threatened to be done is an infringement."

So in *Dowling* v. *Billington* (1890, 7 R. P. C. 191) two acts of infringement of the plaintiff's patent were proved, the first of which took place prior to the acceptance of the complete specification by the Comptroller, while the second was committed a few days after the commencement of the action, it was held by Chatterton, V.-C., whose decision was affirmed by the Court of Appeal, that neither of these acts constituted an actionable infringement; but inasmuch as the conduct of the defendant showed a deliberate intention to infringe, the plaintiffs were entitled to an injunction upon the principle laid down by Jessel, M.R., in *Frearson* v. *Loe* (*supra*).

Evidence of acts after action brought.

Unless to support a claim for an injunction and for the purpose of showing that the defendant has an intention of infringing in the future, **evidence of acts after action brought** is inadmissible. In *The Welsbach Incandescent Gas Light Co.* v. *Doulc* (1899, 16 R. P. C. 391) the plaintiffs attempted to supplement their evidence of an actual infringement having taken place by means of evidence of such acts since the issue of the writ. Bruce, J., refused to admit the supplementary evidence.

Where what has been done since action brought is different in any way from what was done before, and is relied on as evidence of the intention to infringe, the defendant must have clear notice of the nature of the infringement which he is

alleged to be contemplating. In *Shoe Machinery Co.* v. *Cutlan*, 1895, 12 R. P. C. at p. 367, Romer, J., said: "Two kinds of action may be brought by a plaintiff patentee. The one is based on this—that the defendant has infringed before action brought, and in respect of this the plaintiff is entitled to claim damages, or an account, and an injunction to prevent similar infringements in the future. The other action is based on the fact, not that the defendant has infringed, but that he threatens and intends to infringe; and in this case the plaintiff may claim an injunction to restrain the threatened infringement. Of course you may find both kinds of action combined in one, but they are distinct in themselves in several respects. In the first, the plaintiff has to give particulars of breaches, that is to say, of the infringement relied on; and by statute, except by leave of the Court or a judge, no evidence can be given at the hearing, of any breaches other than those stated in the particulars. In the other, of necessity, there can be no particulars of breaches; but to avoid unfairness to the defendant, care is always taken that he shall have fair notice as to the nature and particulars of the special infringement he is alleged to be contemplating; and then no doubt, if after action he commits that special infringement, or substantially that infringement, evidence of it can be given, as it is evidence to show that the plaintiff was right in his allegation that, at the date of action brought, the defendant was threatening and intending to infringe. I may add that if an action, as originally brought by a plaintiff patentee, is of the first class only, but he finds that the defendant has, since action brought, infringed in a way substantially different from his former infringements, leave would be given by the Court to the plaintiff in a proper case, and on proper terms, to amend his action, and to bring these subsequent infringements before the Court to be dealt with once and for all with the prior infringements."

Two kinds of action.

Actual infringement evidence of intention.

The actual infringement of the patent is taken by the Court to imply an intention to continue the infringement, notwithstanding any promises not to do so, unless it be proved beyond doubt that there can be no intention to continue infringing (see p. 368 *et seq.*, post), and an injunction will be granted. Vice-

Chancellor Shadwell, in *Losh* v. *Hague* (1837, 1 W. P. C. at p. 200), said: "If a threat had been used, and the defendant revokes the threat, that I can understand as making the plaintiff satisfied; but if once the thing complained of has been done, I apprehend this Court interferes, notwithstanding any promise the defendant may make not to do the same thing again" (*a*).

If the fact of actual infringement is relied upon, and not a mere threat, it will be necessary to show very clearly that what has been done amounts to an infringement. In *British United Shoe Machinery Co.* v. *Simon Collier, Ltd.*, 1909, 26 R. P. C., the defendants had purchased a machine provided with an extra appliance which was an infringement of the plaintiff's patent; they had no use for the appliance and never connected it to the machine. After action brought they returned the appliance to the manufacturers. It was clear that there was no intention to infringe at the date of the action, and counsel for the plaintiffs relied on the purchase of the machine and appliance for the purposes of trade as an infringement. The Court of Appeal (Cozens-Hardy, M.R., and Moulton, L.J., Buckley, L.J., dissenting), reversed the decision of Parker, J. (on this point) holding that there had been no actual infringement and that no injunction could be granted.

Mere possession is not threat.

In the case of *Adair* v. *Young* (1879, L. R. 12 C. D. 13), the defendant was the captain of a ship which was fitted with certain pumps which were an infringement of the plaintiff's patent. No act of using the pumps was proved; but it was shown that the ship was not supplied with other pumps. It was held that the possession of the pumps under such circumstances, although not of itself amounting to an infringement, was evidence upon which the Court would act that the defendant intended to use the pumps, should occasion require. And the Court, Brett and Cotton, L.JJ. (James, L.J., dissenting), granted an injunction.

Lord Justice James, in giving his reasons for dissenting, said: "I think that an injunction ought not to be granted against a man unless he has done something which he ought not to have done, or permitted something which he ought to have prevented.

(*a*) See also *Geary* v. *Norton*, 1846, 1 De. G. & S. 9.

Now, a master who comes on board ought not to be answerable on the ground that, when he takes command, there is on board a pump which infringes the patent. He does not, owing to his qualified possession, become at once an infringer. He had no power to take a pump out of the ship; he had nothing to do with putting it there, and he was not wrong in allowing it to remain there, for he could not lawfully remove it. An injunction, therefore, can only be granted on the principle of *quia timet*, and in applying that principle I think that it would be a right exercise of the discretion of the Court not to grant an injunction against a master who has done nothing wrong when there is no difficulty in finding and suing the owner of the ship."

The Court, however, seem to have been of opinion that the ground upon which an injunction should be granted is not whether the defendant has done anything wrong or not, but whether there was evidence of an intention to use the patented invention. The Court held that the circumstances of the case showed an intention in the captain to use the invention.

Sale. If the evidence relied upon for the injunction is the sale by the defendant of the patented article, and not the manufacture, the plaintiff must show that such patented article was not made by himself or his licensees (*b*).

The **principle upon which the Court grants an injunction** was clearly demonstrated in *Proctor* v. *Bayley* (1889, 6 R. P. C. 538). In that case the infringement complained of took place six years before the trial of the action. It was proved that the user continued only for a few months, after which the machines were abandoned as unsatisfactory. It was held by the Court of Appeal, reversing the decision of Bristowe, V.-C., that it was clear that the defendants had no intention whatever of continuing the wrongful act, and consequently that it was not a proper case in which an injunction should be granted. Cotton, L.J., in his judgment, said (at p. 541): "There is no doubt that it was a good patent, and we must also take it that the defendants have infringed; but the point is this: Is there any ground here which would justify the Court in exercising the extraordinary jurisdiction of the Court of Chancery in granting

(*b*) *Betts* v. *Willmott*, 1871, L. R. 6 Ch. 239.

an injunction? That, I think, has been a good deal lost sight of in the argument. **It is not because a man has done a wrong that an injunction will be granted against him.** If a man has done a wrong which will not be continued, at common law damages may be obtained for the wrong done, which the common law says is sufficient indemnity for that wrong; but then the Court of Chancery says this, in the exercise of its extraordinary jurisdiction: 'We will not be satisfied with that: we will grant an injunction, because a wrongful act has been done, in order to prevent that wrongful act;' and they grant an injunction where a wrongful act has been done, and the Court is satisfied of the probability of the continuance of the wrongful act. . . . But here, although the defendants did infringe the plaintiff's patent, we must consider all the circumstances of the case in order to guide us in the consideration of this: Ought the Court to draw the inference that there will be a continuance of the wrongful act so as to justify the Court in granting the extraordinary interference and the protection which is exercised by the Court of Equity?" (*c*).

Innocent carriers.

An action for an injunction may be brought against **innocent carriers of infringing articles.** In *Upmann* v. *Elkan* (1871, L. R. 7 Ch. 130) (*d*), which was a trade mark case, Lord Hatherley, L.C., in his judgment, said: "It has been argued that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods, which, though fraudulently marked, were not for their own use, nor to be sold by them for their own benefit, but were received merely for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine more dangerous or mischievous, or more fatal to the authority of the Court with respect to trade marks. If that argument prevailed, any persons being abroad, as was the case in this instance, and minded to commit frauds upon an English trade mark, could easily do so by sending

(*c*) Note also *Hudson* v. *Chatteris Engineering Co.*, 1898, 15 R. P. C. 438.

(*d*) And see *Washburn and Moen Manufacturing Co.* v. *Cunard Steamship Co.*, 1889, 6 R. P. C. 398.

their different consignments together to persons in the position of the defendants, who appear to be respectable agents and warehousemen, thereby committing an injury in a manner most convenient to themselves, and very mischievous to the person entitled to the benefit of the trade marks."

Consignees should be joined.

The above reasoning would apply equally well to infringements of letters patent. **The consignees of the goods should also be added,** even if out of the jurisdiction. In *The Washburn and Moen Manufacturing Co.* v. *The Cunard Steamship Co. and J. C. Parkes & Sons* (1889, 6 R. P. C. at p. 403) Stirling, J., said: "I conceive the action was properly brought in the first instance against the Cunard Steamship Company, who are within the jurisdiction, and the question which remains is, were Messrs. Parkes, who are out of the jurisdiction, the consignees, and, as it now turns out, the owners of the goods, proper parties to the action? If they were resident within the jurisdiction, I conceive there would be no question that they were. Where goods were alleged to constitute an infringement of a patent or were marked in such a way that a trade mark was infringed, it was the settled practice in the Court of Chancery to bring actions against carriers and others who had control of the goods, to restrain them from being dealt with, and upon the consignees of those goods being found out, to add them as parties, in order that the questions which arose might be decided once for all in the presence of the persons who were the real owners of the goods alleged to infringe." The carriers, however, will be absolved from all liability if they make full disclosure of the names of the consignors and consignees of the goods complained of.

Proper course where several infringers.

In cases where there are several infringers the plaintiff is not justified in commencing a vast multitude of actions and applying for injunctions in each.

His proper course is to "select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *in simili casu*, and say to them, '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 will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you.' I do not think any court could complain of a patentee for taking the course I am suggesting" (*e*).

Where one defendant only appears.

A question has arisen as to what should be done if on an action against two defendants for the same infringement one of them fails to appear. The defendant who appeared might succeed in establishing the invalidity of the patent, and the difficulty arises as to the position of the other defendant, since judgment for the defendant on the ground of invalidity is *inter partes* only, and does not affect the status of the patent.

On the whole, however, it may be said that injunction is an equitable remedy, and that it would be contrary to principle for the same tribunal which had pronounced a patent to be invalid to restrain a member of the public from doing what could not be an infringement.

In *Actien Gesellschaft für Cartonaggen Industrie* v. *Remus & Burgon* (1895, 12 R. P. C. 94), Chitty, J., refused to set down on motion for judgment against the defendant who had not delivered a defence, asking what would happen if the other defendant succeeded in upsetting the patent.

In *Savage* v. *Brindle and Another* (1900, 17 R. P. C. at p. 233) a motion for judgment against one defendant stood over until the trial; after the hearing he consented to an injunction, but the other defendant succeeded in upsetting the patent. Farwell, J., granted the injunction asked for.

General convenience looked to.

The **general balance of convenience** will be looked to in granting an injunction.

In *Hopkinson* v. *St. James and Pall Mall Electric Light Co.* (1893, 10 R. P. C. at p. 62) an injunction was granted but was suspended for six months, the defendants agreeing to keep an account on the ground that **great inconvenience** would

(*e*) Per Sir W. Page-Wood, V.-C., *Bovill* v. *Crate*, 1865, L. R. 1 Eq. at p. 391. See also *Foxwell* v. *Webster*, 3 N. R. 103.

be caused to the public by suddenly stopping the use of the three wire system.

In *The Leeds Forge Co.* v. *Deighton's Patent Flue Co.* (1901, 18 R. P. C. at p. 240) the injunction was suspended pending an appeal on the ground that to put it into force at once would throw a large number of workmen out of employment.

The injunction falls with the expiration of the patent (*f*), but where machines have been manufactured or articles made in infringement of patent rights, an injunction will be granted to prevent their use or sale, even after the patent has expired (*g*).

Injunction and subsequent amendment of specification.

In *Dudgeon* v. *Thomson* (1877, 3 A. C. 34) the plaintiff had obtained an injunction. Subsequently he amended his specification, and after this had been done took proceedings to enforce the injunction. The House of Lords held that he should have brought a new action, since the new specification might be open to objection, and was not the same as the old specification. It is submitted that this is no longer good law, on account of sect. 18, sub-sect. 9 of the Act of 1883, re-enacted as sect. 21, sub-sect. 7 of the Act of 1907 (see p. 184, *ante*).

In *Saccharin Corporation* v. *Dawson* (1902, 19 R. P. C. 169) and *The Same* v. *Jackson* (1903, 20 R. P. C. 611) the actions were brought upon several patents (see p. 323). It was impossible to say which patent had been infringed, but it was clear that one of them must have been. The injunction was granted for the life of the patent which would earliest expire.

A person against whom an injunction has been granted or who has given an undertaking in Court is liable to be committed should he be guilty of a breach of such injunction or undertaking, and a person aiding and abetting such a person and with knowledge of the injunction is also guilty of contempt (*h*), but an application for committal, involving as it does the liberty of the subject, will require the strictest proof in its support (*i*).

(*f*) *Daw* v. *Eley*, 1867, L. R. 3 Eq. 496.

(*g*) *Crossley* v. *Beverley*, 1829, 1 W. P. C. 119; *Crossley* v. *The Derby Gas Light Co.*, 1834, 4 L. J. Ch. 25.

(*h*) *Incandescent Gas Light Co.* v. *Sluce*, 1900, 17 R. P. C. at p. 175.

(*i*) *Dick* v. *Haslam*, 1891, 8 R. P. C. 196.

An injunction having been granted to restrain the defendant from infringing a patent for the manufacture of telephones, it was held to be a breach of the injunction to sell the separate parts of the patented telephones which anyone might put together (*k*).

Acquiescence and delay.

Positive acquiescence will bar the right of the patentee to apply for an injunction (*l*). But such acquiescence must amount to a representation to the defendant. Otherwise it is the general impression that laches do not bar the right to a perpetual injunction, although they certainly will prevent a plaintiff from obtaining an interlocutory order.

Damages or account.

Damages.—In addition to an injunction, the plaintiff may be entitled, when there has been actual infringement as distinguished from an intention to infringe, either to damages or to an account of sales and profits.

He is **not entitled to both damages and an account,** but he must elect which he will take (*m*).

Different from account of profits.

In taking an **account of profits,** the plaintiff condones the infringement and does not complain of it, but claims all the profits as though they had been made by a trustee for him (*n*).

Measure of damage.

The **measure of damage** is not the profit made by the infringer, but is the loss which the plaintiff has actually sustained (*o*). The question of damages is not synonymous with an account of profits, the basis of calculation being entirely different.

"The loss must be the natural and direct consequence of the respondent's acts" (*p*); consequently the damages will be the estimated loss of profit incurred by the plaintiff by reason of the sale by the defendant of articles which infringed the plaintiff's patent. Such a question must be one of considerable

(*k*) *United Telephone Co.* v. *Dale*, 1884, L. R. 25 Ch. D. 778.

(*l*) *Procter* v. *Bennis*, 1887, 36 Ch. D. at p. 759.

(*m*) *Neilson* v. *Betts*, 1871, L. R. 5 H. L. at p. 22; *De Vitre* v. *Betts*, 1873, L. R. 6 H. L. 319; *United Horsenail Co.* v. *Stewart*, 1886, 3 R. P. C. at p. 143; 5 R. P. C. at p. 266.

(*n*) See note (*m*) and *The Saccharin Corporation* v. *Chemicals Co.*, 1900, 17 R. P. C. 615.

(*o*) *United Horsenail Co.* v. *Stewart*, 1886, 3 R. P. C. at p. 143; 5 R. P. C. at p. 267.

(*p*) Per Lord Macnaghten, *United Horsenail Co.* v. *Stewart*, 1883, 5 R. P. C. at p. 268; 7 R. P. C. 152.

difficulty, and can only be decided by a fair businesslike view of all the circumstances of the case.

Commercial competition.

A probable result of the sale by the defendant of articles which infringe the plaintiff's patent is a reduction in price owing to the **commercial competition**, and a consequent loss of profit to the plaintiff; whether this source of damage may or may not be taken into consideration will depend upon the circumstances of the case.

There may be cases in which the whole profit of the plaintiff is derived from the granting of licences, and in such a case the damages might very properly be fixed at the amount which the defendants would have had to pay in royalties, as in such a case there could be no loss by reason of competition (*q*).

In the case of a patentee who is also a manufacturer the question of damages is more difficult, the use of royalties as a measure not being available and the profits of the defendant being immaterial. As Lord Watson said in *The United Horse-nail Co.* v. *Stewart* (1888, 5 R. P. C. at p. 267): "In that case the profit made by the infringer is a matter of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee; and however great his loss, he cannot escape from liability to make full compensation for the injury which his competition may have occasioned."

In *The United Horseshoe and Nail Co.* v. *Stewart* (1886, 3 R. P. C. 139; 4 R. P. C. 130; 5 R. P. C. 260) loss of profit arising from such competition was not allowed. In that case the patent in question was one for a machine to produce horseshoe nails more cheaply than had been done before. Consequently any one else could make nails in competition with the plaintiffs; they were only restrained from making them by means of that particular description of machine, and further the plaintiffs had always gone a little before the

(*q*) *Penn* v. *Pack*, 1867, L. R. 5 Eq. 81; *English and American Machinery Co.* v. *Union Boot and Shoe Machine Co.*, 1896, 13 R. P. C. 64; *The Pneumatic Tyre Co., Ltd.* v. *Puncture Proof Pneumatic Tyre Co., Ltd.*, 1899, 16 R. P. C. 209; *The British Motor Syndicate* v. *John Taylor & Sons, Ltd.*, 1900, 17 R. P. C. 723.

defendants in reducing their price, and so continually kept the price lower than that quoted by the defendants.

When it is sought to recover damages on account of the reduction in prices, it must be clear that the reduction in the plaintiff's prices has been the result of the defendant's competition, and not of the ordinary exigencies of trade (*r*).

In *The American Braided Wire Co.* v. *Thomson* (1890, 7 R. P. C. 152) the patent infringed was one for the manufacture of a particular form of bustle; no one else being able to put a similar bustle on the market without infringing that patent, the plaintiffs did not reduce their prices until compelled to do so by the defendants, and then only reduced them to the level quoted by the defendants. The official referee in his finding said: "But for the defendants' competition and their selling at lower prices, the plaintiffs would, subject to the allowances mentioned in paragraphs 2, 3, and 4, have made the sales made by the plaintiffs and also those made by the defendants at the plaintiffs' original prices." Taking all these circumstances into consideration, the Court of Appeal held that the finding of the official referee was reasonable and fair, and that the plaintiffs were entitled to the full amount so found, including the loss of profit arising from the competition of the defendants.

Regard had to plaintiff's establishment charges.

In *The Leeds Forge Co., Ltd.* v. *Deighton's Patent Flue Co.* (1908, 25 R. P. C. 209) it was held that in arriving at the damages due to competition, regard should be had to the fact that had the plaintiffs received the orders which in fact went to the defendants, they would have been able to make a profit larger than the profit actually made by themselves on similar articles, or by the defendants on the articles actually made in infringement, since the proportion borne on account of establishment charges by each article made would have been materially reduced.

In estimating the amount of damage by competition, or by injuring the reputation of the plaintiff's goods, it is of course impossible to name any precise sum, and it will always be a matter largely for individual judgment and discretion.

In *Ungar* v. *Sugg* (1891, 8 R. P. C. at p. 388), Wright, J.,

(*r*) *Alexander* v. *Henry*, 1895, 12 R. P. C. at p. 367.

said: "No one can doubt that in this case there was substantial damage, and the difficulty and impossibility of stating the precise ground for assessing it at any particular figure does not seem to be a sufficient reason for giving only a nominal sum"; and Lord Esher, M.R., in the Court of Appeal, said (1892, 9 R. P. C. at p. 117): "They were problematical damages, and had to be what is called guessed at: that is, not a mere guess, as if you were tossing up for the thing, but it must come to a mere question of what, in the mind of the person who has to estimate them, was a fair sum."

The fact that only part of the machine is an infringement is immaterial, since each thing produced by the assistance of such part is itself an infringement of the plaintiff's patent, and to that extent occasions damage by interfering with the plaintiff's trade (*s*).

Users liable for damages as well as manufacturers.

The fact that a patentee has recovered judgment and damages against a manufacturer of infringing articles does not preclude him from taking further proceedings against the purchasers of infringing articles from such manufacturer (*t*). But the damages recoverable in respect of each infringement must be confined to that infringement only. Therefore, as the damages recoverable from the user may be a merely nominal amount, it may be wiser to take an account of profits in this case (*u*).

Innocent infringers.

By sect. 33 of the Act of 1907, provision is made for the better protection of innocent infringers.

"*A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute*

(*s*) *The United Horsenail Co.* v. *Stewart*, 1886, 3 R. P. C. at p. 143; cf. *United Telephone Co.* v. *Walker*, 1887, 4 R. P. C. 63.

(*t*) *United Telephone Co.* v. *Walker*, 1887, 4 R. P. C. 63.

(*u*) See *Garioli* v. *Shepherd*, 1900, 17 R. P. C. 157.

notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:

"Provided that nothing in this section shall affect any proceedings for an injunction."

The section applies only to patents granted after January 1, 1908.

Prior to this Act it had been the law that ignorance of the existence of a patent was no excuse for infringement, and the infringer was liable to an injunction and to pay damages for such infringement.

The effect of the section is merely to affect the right of the patentee in so far as his remedy is concerned.

It is to be noticed that the part of the section referring to the marking of the patented article with the number and year of the patent does not necessarily make the fact of such marking notice to the whole world that there is a patent for the article—the circumstances of the infringer are the true criterion. A manufacturer of an infringement of a patent for a costly machine might induce an innocent purchaser to use that machine; the purchaser might never before have seen such a machine, although those sold by the patentee were properly marked. But the whole burden of proof is on the infringer, who is primâ facie liable to damages, and we submit that in the case of infringement by the use of tools in well-defined trades, the burden will not easily be discharged.

Burden of proof on infringer.

In aid of the inquiry as to damages, directed by the judgment for a perpetual injunction, **the defendant must give full discovery,** and will be required to set out the names and addresses of the persons to whom machines, made in infringement of the patent, have been sold (*x*); but not the names of the agents concerned in the transaction (*y*).

Discovery on inquiry as to damages.

Account of sales and profits.—In cases where it is deemed to the advantage of the plaintiff, he may elect, in lieu of damages, to take an account of sales and profits; that is, to condone the

Nature of account.

(*x*) *Murray* v. *Clayton*, 1872, L. R. 15 Eq. 115; *American Braided Wire Co.* v. *Thomson*, 1888, 5 R. P. C. 375; *Saccharin Corporation* v. *Chemicals Co.*, 1900, 17 R. P. C. 612.

(*y*) *Murray* v. *Clayton*, 1872, L. R. 15 Eq. 115.

infringement upon the footing that the defendant has been acting as the plaintiff's agent in selling or using the invention (*z*).

An **inquiry as to profits** is one which involves many questions of great difficulty, and in consequence is usually attended by a great expenditure both of time and money; "therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages rather than launch upon an inquiry as to profits" (*a*).

The plaintiff will not be allowed to claim an account **if he has tacitly permitted the defendant to infringe his patent,** relying upon an ultimate account of profits. In *Crossley* v. *The Derby Gas Light Co.* (1 W. P. C. at p. 120) Lord Brougham said: "It is a principle of equity, that a party who claims a right should not lie by, and by his silence or acquiescence induce another to go on spending his money and incurring risk, and afterwards, if profit has been made, come and claim a share in that profit without having ever been exposed to share in the losses which might have been sustained. Upon this the defendants rely; but it was to be considered, on the other hand, whether the plaintiff did not explain the delay which has taken place, and whether the conduct of the defendants has not been such as to lull the plaintiff's suspicions to sleep."

Where it appears at the trial that **the defendant has made no profit,** although the plaintiff may be entitled to damages, he will not be entitled to an account (*b*).

Innocence of infringer.

Where the defendant has acted in ignorance of the patent, and before action has offered to submit to an account and to pay to the plaintiff the amount of profits, the Court should exercise its discretion in disallowing costs (*c*), although it may grant the injunction. In such a case the plaintiff will proceed to an account at his peril, running the risk of nothing being found due.

(*z*) See p. 373, *ante*.

(*a*) Per Lindley, L.J., in *Siddell* v. *Vickers*, 9 R. P. C. at p. 163. And see Romer, J., in *The Automatic Coal Gas Retort Co.* v. *Salford*, 1897, 14 R. P. C. at p. 471.

(*b*) *Bacon* v. *Spottiswoode*, 1839, 1 Beav. 387.

(*c*) *Nunn* v. *D'Albuquerque*, 1865, 34 Beav. 595; *Redges* v. *Mulliner*, 1893, 10 R. P. C. 21, 28.

Sect. 33, set forth above (p. 376), will not excuse an innocent infringer from liability to account for profits.

Innocence will not excuse liability to account.

Prior to the Judicature Acts it was held a rule in courts of equity that, in consequence of the terms of 21 & 22 Vict. c. 27, no relief could be awarded for damages or an account, unless an injunction could be granted at the same time; all other relief being merely incidental to the injunction (*d*). Thus, where a patent had expired after bill filed, but before an injunction could be granted, the Court declined to consider the question of damages (*e*). But now, in pursuance of sect. 24, sub-sect. 6, of the Judicature Act, 1873, a court of equity may give full relief; and so, wherever a court of law would, prior to the passing of the Act, have granted damages or an account, similar orders will be made by either branch of the High Court of Justice, irrespective of the question of injunction.

Discovery to aid account.

After trial, and in pursuance of the terms of the judgment, if the plaintiff has been successful he is entitled to interrogate the defendant, or to require that the defendant should make and file an affidavit stating how many machines he has made or sold of the same construction as that supplied by him to A. or B., including such machines as are in his possession or power. The answer or affidavit of the defendant must be complete. In *Murray* v. *Clayton* (1872, L. R. 15 Eq. 115), a patentee of improvements in brick-cutting machines, who was a manufacturer of the machines by an agent at the agent's works and not a licensor, having obtained a perpetual injunction against the defendants (who were also manufacturers of brick-cutting machines) from infringement, the defendants were ordered to file an affidavit stating the number of machines made by them since the date of the patent, and the names and addresses of the persons to whom the same had been sold and of the agents concerned in the transactions. Upon motion to vary the order, it was held that the plaintiff was entitled to have discovery of the names and addresses of the purchasers, but not of the agents concerned,

(*d*) *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 1858, 4 K. & J. 727.

(*e*) *Betts* v. *Gallas*, 1870, L. R. 10 Eq. 392.

there being nothing to show that any agents had been employed.

In *Saccharin Corporation* v. *Chemicals Co.* (1900, 17 R. P. C. 612) the Court of Appeal decided that the plaintiff may demand discovery of the names of the defendants' customers, whether on an order for an account of profits or on inquiry as to damages.

It was held in *Watson* v. *Holliday* (1882, L. R. 20 Ch. D. 780) that the amount due on an account of profits could be proved in the bankruptcy of the defendant, although under sect. 31 of the Bankruptcy Act, 1869, a claim for damages could not.

Order for delivery up.

Order for delivery up or destruction.—After trial and judgment, and upon application for a perpetual injunction, when the nature of the infringing matter will permit of it, an order will be made that the articles (machinery or otherwise) be **delivered up to the plaintiff or destroyed** (*f*). This was done in *Plimpton* v. *Malcolmson* (ref. M.R., January 28, 1876, B. 381) (supra). But where by reason of the nature of the invention such an order would be unreasonable, it will not be granted (*g*). An inquiry will, when necessary, be directed as to the articles manufactured which are in the defendant's possession, and an order will be made that they be destroyed (*Betts* v. *De Vitre* (ref. V.-C. W., 1865, A. 119)). The defendant will also be ordered to make discovery upon oath of the articles or machinery which he may have in his possession, and which infringe the plaintiff's patent, so that they may be delivered up and destroyed (*h*). **The right of property in the articles** which infringe the patent remains in the infringer, although the Court may order the articles to be destroyed (*i*).

These mandatory orders are never made except after trial, and when the plaintiff has fully established to the satisfaction of the Court the validity of his patent and the fact of the defendant's infringement.

(*f*) *Frearson* v. *Loe*, L. R. 9 Ch. D. at p. 67.

(*g*) *United Telephone Co.* v. *London and Globe Co.*, 1884, L. R. 26 Ch. D. 776; *Siddell* v. *Vickers*, 1888, 5 R. P. C. 101.

(*h*) *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1884, 1 R. P. C. at p. 253; *Edison-Bell Phonograph Co.* v. *Smith*, 1894, 11 R. P. C. at p. 406.

(*i*) *Vavasseur* v. *Krupp*, 1878, L. R. 9 Ch. D. 351.

VII. The Trial.

Constitution of Court.

The constitution of the Court which is to hear and determine actions for infringement is provided for by sect. 31 of the Act of 1907 (substantially similar to sect. 28 of the Act of 1883):

"(1) *In an action or proceeding for infringement or revocation of a patent, the Court may, if it think fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court otherwise directs.*

"(2) *The Court of Appeal may, if they think fit, in any proceeding before them call in the aid of an assessor as aforesaid.*

"(3) *The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act.*"

Prior to the Act of 1883 either party had an absolute right to have the questions of fact decided by a jury, and the Court had no power to deprive them of this right (*a*).

In the case of *Saxby* v. *The Gloucester Wagon Co.* (1880, W. N. 28) Hawkins, J., ordered a patent case to be tried before an official referee, it being a case involving a "prolonged scientific examination," and in his opinion within sect. 57 of the Judicature Act, 1873. This practice has never been followed.

Actions for infringement and petitions for revocation are now almost invariably tried in the Chancery Division, although there is no rule of practice to prevent them from being tried in the King's Bench Division. It is to be noticed that it is only certain special matters that are to be tried before the selected judge. Actions for infringement are tried before any judge before whom the action comes in the ordinary way.

Assessor.

In *Hattersley* v. *Hodgson* (1905, 22 R. P. C. 229), an action in the King's Bench Division, an assessor was employed to assist the judge. When the case went to the Court of Appeal

(*a*) *Sugg* v. *Silber*, 1876, L. R. 1 Q. B. D. 362.

(at p. 240) the written statement of the assessor was read to the Court.

Independent experts have also been employed to make experiments and report to the Court in matters in which there was a conflict of testimony (*b*). "His duty is, instead of determining issues of fact, or of law, to find the materials upon which the Court is to act" (*c*).

Where the defendant alleged a **secret process** in an action for infringement, the hearing was conducted *in camerâ* and the shorthand notes of the trial impounded by order of the Court (*d*).

Jury. The grounds of application for a trial by jury would be that the evidence shows a **conflict of testimony** in material parts, or that **grave questions of credibility** are likely to arise, or that a **charge of fraud** is made against either party (*e*).

Cases have occasionally been tried before a jury at assizes (*f*), but the practice is not successful, and it is hardly likely to be followed in the future.

Mr. Hindmarch, at p. 291 of his celebrated work, says: "Few causes require so much care and industry in preparing for trial as patent actions, in which very nice points of law and difficult questions of fact must often be decided between the parties; and it will frequently happen that a party will succeed or fail in obtaining a verdict according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions and prepare the necessary proofs, a competent knowledge, not only of law, but also of science in general and the useful arts, is essentially requisite" (*g*).

(*b*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 1883, L. R. 24 Ch. D. 156; *Moore* v. *Bennett*, 1884, 1 R. P. C. 129; *North British Rubber Co.* v. *Macintosh*, 1894, 11 R. P. C. 477.

(*c*) Bramwell, L.J., in *Mellin* v. *Monico*, 1877, L. R. 3 C. P. D. at p. 149.

(*d*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 1883, L. R. 24 Ch. D. 156.

(*e*) *Lucas* v. *Miller*, 1900, 17 R. P. C. 165.

(*f*) *Westley* v. *Tolley*, 1894, 11 R. P. C. 602; *Alfred Appleby's Chain, Ltd.* v. *Albert Eadie Chain Co.*, 1899, 16 R. P. C. 618.

(*g*) See also Selborne, L.C., in *Patent Marine Inventions Co.* v. *Chadburn*, 1873, L. R. 16 Eq. at p. 448.

The Chancery of Lancaster Act, 1890, s. 3, enacts:—

Palatine Court.

"*From and after the passing of this Act the Court of Chancery of the County Palatine of Lancaster (in this Act called the Lancaster Chancery Court), shall, as regards all persons, bodies corporate, and property within or becoming subject to its jurisdiction, have and exercise the like powers and jurisdiction, and in a similar manner, and subject to the same restrictions in all respects, as the High Court in its Chancery Division now has and exercises, or may, under or by virtue of any Act of Parliament hereafter passed, and not expressly enacting to the contrary hereof, have and exercise, in respect of all persons, bodies corporate, and property within its jurisdiction.*"

The effect of this Act is to extend the meaning of the word "Court" in the Patents, &c. Acts, to the Palatine Court so far as it relates to actions for infringement.

A grant of letters patent gives to the patentee a right which extends over the whole of the United Kingdom, and only a small portion of that right lies in the district which is within the jurisdiction of the Palatine Court, consequently the Chancery of Lancaster Act, 1890, does not give to that Court power to adjudicate upon a petition for revocation of letters patent, since the whole of the property which is the subject of the petition does not lie within its jurisdiction.

County court.

A **county court** has no jurisdiction to try an action for infringement when the validity of the patent is in dispute (*h*).

Right to begin.

In an action for infringement the **plaintiff has the right of beginning and of replying**, notwithstanding that the burden of proof may really be on the defendant, as, for instance, where the case principally turns upon questions of prior user or prior publication, which are introduced by the defendant. It sometimes happened that this privilege, particularly in cases of conflicting evidence, was of great value, and for the purpose of snatching it from the plaintiff the defendant did not wait for the plaintiff to commence his action, but commenced proceedings himself by *scire facias* to repeal the patent, so as to place himself in the position of plaintiff. But, by sect. 26,

(*h*) *R.* v. *County Court Judge of Halifax*, 1891, 1 Q. B. 793; 1891, 2 Q. B. 263; 8 R. P. C. 338.

sub-sect. 7, of the Act of 1883, it was provided that in cases where it is sought to **revoke a patent,** "*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.*" This rule of practice is continued by Rule 12 of Order LIIIA.

Counterclaim for revocation.

The defendant now has a right to **counterclaim for revocation.** By sect. 32, "*A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the Rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.*"

In such a case the plaintiff naturally begins and has a right of reply. It must be remembered that a defendant is not obliged to counterclaim; he may if he so desires present an independent petition to revoke, but it has always been held that it is no ground for **postponing the trial of an action for infringement** that a petition has been presented by the defendant or any other person under sect. 26 to revoke the patent.

We have seen that proceedings for revocation are similar to, and for the same purpose as, *scire facias* prior to the Act of 1883. In *Muntz* v. *Foster* (1843, 2 W. P. C. 93, n.) it had been held that the fact of a writ of *scire facias* being pending was no ground for staying the action for infringement. Tindal, C.J., said: "As a general rule, a plaintiff has a right to have his cause go on for trial according to the ordinary course of business. Special circumstances may exist upon which the Court may see fit to interfere; but the present does not appear to us to be a case in which we ought to interfere by staying the proceedings in the action."

The ground of this decision was that the plaintiff in the action for infringement, being defendant in the proceedings by *scire facias*, had not the conduct of those proceedings, and that the defendant in the action for infringement might delay them; but where, in *Patteson* v. *Holland* (Hindmarch, 293), an action for infringement had been tried, and a rule *nisi* for a new trial

had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*.

And where a verdict had already gone for the Crown on *scire facias*, but a new trial was pending, the plaintiff was not permitted to proceed to trial with his action for infringement until the rule for the new trial in *scire facias* had been disposed of (*i*).

In *Westley Richards* v. *Perkes* (1893, 10 R. P. C. 181) the fact of infringement was admitted, and the case turned upon the validity of the plaintiff's patent. Kay, L.J., stopped the plaintiff's counsel after having made out a prima facie case, the burden of proof as to invalidity being on the shoulders of the defendant, and in that case the learned judge gave leave to the defendant's counsel to reply on the whole case. Probably this was owing to the fact that the point that the alleged anticipation was never published was not taken by the plaintiff's counsel until he replied generally to the defendant's case.

Burden of proof

The plaintiff must give evidence of the issues which he is bound to prove. He must prove his patent if the grant be denied. (In practice it is always admitted.) This is done by producing the patent itself, with the seal of the Patent Office attached to it. He must also prove the **specifications** (these are also always admitted in practice). Sect. 14, sub-sect. 1, provides that, "*A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom*"; or under sect. 79, if it be not convenient or possible to produce the original, "*Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there shall be admitted in evidence in all Courts in His Majesty's dominions,*

(*i*) *Smith* v. *Upton*, 1843, 6 M. & G. 251.

and in all proceedings, without further proof or production of the originals."

And in Ireland or Scotland where it may be inconvenient to obtain certified copies from the Patent Office recourse may be had to the provisions of sect. 80, "(1) *Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.*

"(2) *Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.*"

If the plaintiff sues as assignee, or under any derivative title, and his title is denied, the entry from the register of patents may be proved in the manner suggested by the 78th section.

Under the 96th section "*a certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.*"

For instance, if an entry in the register is denied by the defendant, he may prove its omission by a certificate under the 96th section.

If the fact of infringement is denied, the plaintiff must be ready with evidence that the defendant has made, used, or sold the articles or process, and any one of these acts, as we have already seen, will satisfy the allegation of infringement (*k*).

The burden of proving infringement is strictly on the plaintiff, and if he does not satisfactorily prove it there is no

(*k*) See p. 303, ante.

necessity for entering upon the defendant's case on other matters. The plaintiff must always give evidence, when the alleged infringement is the sale or use of an article, that it was not made by himself or his agents (*l*).

True and first inventor.

As to the burden of proof of the validity of the patent, when the defendant pleads that the grantee of the letters patent was not the true and first inventor, the onus of proof is entirely on him, and no evidence need be given by the plaintiff to establish a primâ facie case (*m*).

Novelty.

If it be pleaded that the invention was not new, it will be sufficient if the plaintiff gives some primâ facie evidence of novelty (*n*). It will be sufficient to call one or two persons acquainted practically with the trade to which the invention refers, to say that they never heard of it, or saw or heard of its having been put in practice or published before the date of the patent. Gibbs, C.J., said: "The first witness, a man of considerable experience, had never seen locks with the lips so perforated; primâ facie that is good evidence; but when the question is, whether this had existence previous to the patent, fifty witnesses proving that they never saw it before would be of no avail if one was called who had seen it and practised it" (*o*).

The plaintiff having given this primâ facie evidence, the burden of proof as to prior user or prior publication is shifted to the defendant, and if he would invalidate the patent he must prove his case.

We have previously discussed what amounts to prior user and prior publication (*p*). The evidence which the defendant brings must be complete and satisfactory, and the question is one of fact.

If the defendant has succeeded in establishing a case against the plaintiff, the latter will be permitted, before the defendant sums up, to adduce rebutting evidence. In *Penn* v. *Jack and Others* (1866, L. R. 2 Eq., at p. 317) Sir W. Page-Wood, V.-C., said: "I think the plaintiff is entitled to adduce evidence, in

(*l*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

(*m*) *Ward* v. *Hill*, 1901, 18 R. P. C. at p. 490.

(*n*) *Turner* v. *Winter*, 1787, 1 T. R. 606; 1 W. P. C. at p. 81; *Westley Richards* v. *Perkes*, 1893, 10 R. P. C. at p. 186.

(*o*) *Manton* v. *Manton*, 1815, Dav. P. C. at p. 350.

(*p*) See Ch. IV.

reply, for the purpose of rebutting the case set up by the defendants; and for this reason, that it is quite impossible for him to know what is the nature of the evidence which is to be produced. The defendants, who contest the validity of the invention, have in effect put in a plea denying the novelty of the plaintiff's patent; and the affirmative of the issue just raised in reality rests with the defendants, who are not obliged to give the names of their witnesses. How can the plaintiff possibly meet such a case until he hears the evidence for the defence, and knows what their witnesses will prove? I should be very sorry to have to put the parties to all the expense and delay of a new trial, which I should have to direct, if this evidence were excluded. Besides which, the witnesses are at hand and ready, and the sensible and obvious course is to examine them now. The practice at common law is stated in Taylor on Evidence; and it appears that where, as here, several issues are joined, the plaintiff may content himself with adducing evidence in support of those issues which he is bound to prove, reserving the right of rebutting his adversary's proofs, in the event of the defendant establishing a primâ facie case with respect to the issues which lie upon him. In support of this proposition, *Shaw* v. *Beck* (1853, 8 Ex. 392) is cited, where Parke, B., used the following expression: 'But Abbott, C.J., laid down what appears to me to be a more reasonable rule, by holding that the defendant was bound to prove his plea, and that the plaintiff might answer it by additional evidence.' Other instances are also mentioned, all showing the wide discretion given to the judge in allowing evidence to be given by the plaintiff in reply. The plaintiff has put in his letters patent as formal evidence of his title. The defendants then plead want of novelty, and give, in proof of the issues thus raised by them, special evidence, which the plaintiff is entitled to rebut, by evidence in reply. Regarding this case as one of an affirmative plea, the burden of proving which rests on the defendants, I feel bound to admit the evidence proposed to be given by the plaintiff in reply" (*q*).

(*q*) See also *Westley Richards & Co.* v. *Perkes*, 1893, 10 R. P. C. at p. 187.

Although the plaintiff may, as of right, rebut the case made by the defendant upon any issue which rests with the defendant, where the plaintiff has given such rebutting evidence, **the defendant will not be allowed to strengthen the case which he had made by adducing further evidence**; and this will apply with greater force when the defendant's counsel has summed up the evidence which has been offered (*r*).

Defect in specification.

When the defendant alleges that there is a **defect or insufficiency in the specification**, the burden of proving that there is such a defect is on the defendant, after the plaintiff has given prima facie evidence that the specification is sufficient.

We have seen that it is for the jury to say whether a specification is **sufficient** or **intelligible** or not; it is for the Court to place a **construction** upon the language used in the specification. The plaintiff must therefore be prepared with **evidence** as to the sufficiency of the specification; and in selecting this evidence the plaintiff cannot be better guided (as to the principle applicable) than by the judgment of Sir George Jessel in *Plimpton* v. *Malcolmson* (1876, L. R. 3 C. D. 531, see also pp. 103 et seq.). He must not select eminent engineers or celebrated chemists as the persons to whom the specification must be intelligible, but he must choose "ordinary workmen" in the particular branch of trade to which the invention refers—"not a careless man, but a careful man, though not possessed of that great scientific knowledge or power of invention which would enable him by himself unaided to supplement a defective description or correct an erroneous description." He may, of course, call eminent engineers, but their evidence can only be, "placing myself in the position of an ordinary workman I think it would or would not be intelligible or sufficient to me." As a matter of practice an expert engineer *is* nearly always called for the plaintiff and is asked in examination-in-chief whether "speaking as an ordinary workman" he considers the specification sufficient. When the witness has stated in his examination that an ordinary workman would make a certain machine from the description contained in the specification, it

(*r*) *Penn* v. *Pack*, 1866, L. R. 2 Eq. at p. 318.

is open to the counsel on the other side to cross-examine him upon the specification, taking it line by line for the purpose of showing that what he said in the first instance was incorrect, although that method of questioning would not be permitted on examination-in-chief. If the specification be not sufficiently clear to be understood by an ordinary workman, witnesses will not be allowed to be called to explain the intention of the patentee. The words "ordinary workman" are further explained at pp. 103, 115, supra.

Functions of expert witness.

An **expert witness** cannot be asked his opinion as to whether or not there has been **infringement.** That is a question for the jury, or the Court in the absence of a jury. But the expert may explain the nature of what the defendants have done, and he may be asked whether the elements claimed in the patentee's specification (as construed by the Court) are to be found in the defendants' apparatus (*s*).

An expert cannot be asked whether any given invention is "**subject-matter,**" for this is a question of law (*t*), but he may be asked whether the problem solved by the patentee involved any and what difficulties, and whether the solution offered is satisfactory. An expert may not be asked the "**nature of the invention,**" i.e., the ambit of the claim, for this is a question of construction for the Court alone (*u*).

The function of an expert was very clearly explained by Lindley, L.J., in *Brookes* v. *Steele and Currie* (1897, 14 R. P. C. at p. 73). "It is necessary to examine the patent, and to ascertain first what the patented invention really is; and secondly whether the defendants have used that invention. In this, as in all cases, the nature of the invention must be ascertained from the specification, the interpretation of which is for the judge, and not for any expert. 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

(*s*) See judgment of Lord Wensleydale, in *Seed* v. *Higgins*, 1860, 8 H. L. Cas. at p. 550.

(*t*) See p. 39, ante.

(*u*) See pp. 104, 105, ante.

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, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by a jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined."

Questions of Law and Questions of Fact.

(*A summary.*) (*x*)

Questions of law and fact.

We have seen that, as a rule, actions for the infringement of letters patent are directed to be tried before the Court without a jury. Still, under special circumstances, the parties, or either of them, may obtain an order to try before a jury. Under these circumstances it will be useful to consider again what are the questions which the Court should leave to the jury as matters of fact, and what are left to the decision of the Court as matters of law.

As to the **specification.** The construction is for the Court. The ambit of the claim is for the Court, and the rules of construction are similar to those which govern the construction of other documents.

It is for the jury to say whether the specification is **intelligible** or not, and it is for the Court to direct the jury as to the class of persons to whom it must be intelligible.

It is for the jury to say whether the specification is **sufficient** or not: that is, whether it contains a sufficient description of the invention; but it is for the Court to inform the jury the degree of sufficiency which the law requires in specifications.

The **novelty** of the invention is a question for the jury.

(*x*) See Index for separate headings.

Questions of prior user or prior publication are always questions of fact, and it is for the jury to compare what has been done before and what is set up as being new, and to say whether or not they are identical. And so any document which is said to amount to prior publication must be construed by the Court, but it is for the jury to compare it with the specification and to say whether the described matter is the same or not.

Subject-matter is a question of law for the Court.

The **utility** of the invention is also for the jury, subject to the directions of the Court as to the degree of utility which the law requires for the purpose of supporting the validity of a patent.

The question of **infringement** is a mixed question of law and fact. In *Seed* v. *Higgins* (1860, 8 H. L. C. at p. 565) Lord Wensleydale said: "The question of infringement is one of mixed law and fact. The construction of the specification is for the Court, with the aid of such facts as are admissible to explain written documents. In deciding whether there has been an infringement, there is a question of fact wholly for the jury, viz., what the defendants have done; and if scientific evidence is necessary fully to elucidate the case on either side, it is no doubt admissible, and in determinating the question of infringement the judge must apply what the jurymen find to be true. . . . The opinion of scientific witnesses is only admissible as proof of fact." In *De la Rue* v. *Dickenson* (1857, 7 E. & B. 755) Campbell, C.J., said: "There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact, mixed with law, which the judge is bound to submit to the jury."

VIII.—Certificate of Validity.

Sect. 35 of the Act of 1907 is as follows:—

Certificate of validity.

"*In an action for infringement of a patent, the Court may certify that the validity of the patent came in question; and if the Court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.*"

Similar provisions were contained in 5 & 6 Will. IV. c. 83, in sect. 43 of the Patent Law Amendment Act, 1852, and in sect. 31 of the Act of 1883.

The object of these sections is to prevent patentees of important inventions being ruined by successive actions which they might be obliged to bring to restrain infringements, manufacturers banding themselves together to defeat a patentee's rights in this manner.

The Act of William IV. cited above gave the patentee a right to treble costs, but this was taken away by 5 & 6 Vict. c. 97, which gave him full costs; and now, as we have seen, costs as between solicitor and client are substituted for full costs.

To acquire the protection of the section a certificate is requisite, and this should be applied for at the trial of the action, and the application must be made to the Court or judge who has tried the cause.

The Court has no power under the section to order full costs upon the first trial in which the validity of the patent came in question, the words of the statute being "in any subsequent action for infringement" (*a*).

When a certificate of validity has once been granted there is no need for another in a subsequent action upon the same patent (*b*).

But if the specification is amended after the granting of the

(*a*) *Penn* v. *Fernie*, 1866, L. R. 3 Eq. 308.

(*b*) *Edison* v. *Holland*, 1889, 6 R. P. C. 243.

Blakford v Cory-Grundy. xxxviii R.P.C 412.

certificate, the certificate will no longer hold good, and a new one must be applied for in any subsequent action (*c*).

Upon the trial of the second action the record of the first action with the endorsement must be produced, but not before the verdict, in such a manner as to prejudice the second trial (*d*).

It does not appear clear whether or not a certificate might be granted in an action to restrain threats that the validity of the patent came in question. This point arose in *Crampton* v. *The Patents Investments Co.* (1888, 5 R. P. C. 382), which was an action under sect. 32. In that case it was held that the defendant's patent was valid, and had been infringed; application was made by the counsel for the defendant for a certificate under sect. 31. Field, J. (p. 404), said: "I entertain great doubt whether I have jurisdiction, and I think the safer course will be for me to give a certificate without prejudice to the validity of it, if it should come into operation."

Court will protect the public.

In obtaining this certificate **the plaintiff and the country are the parties, not the defendant,** and the judge is bound to protect the interests of the country and to see that the certificate is not given when the validity of the patent has not in fact been proved to the satisfaction of the Court; otherwise there is nothing to prevent collusive actions being merely brought for the purpose of obtaining this valuable privilege—a privilege which can be used as an enormous lever, preventing persons from incurring the risk of a conflict with the patentee (*e*).

When granted.

The practice seems to be to grant the certificate where the plaintiff is quite ready to fight the validity of the patent, even though the fight should not actually take place through the non-appearance or the submission of the defendant; but the Court ought to be satisfied that the withdrawal of the defendant from the contest is not the result of collusion, and prima facie evidence should be given in such cases.

In *Haydock* v. *Bradbury* (1887, 4 R. P. C. 74) the validity

(*c*) *Brooks & Co., Ltd.* v. *Rendall, Underwood & Co., Ltd.*, 1907, 24 R. P. C. 17.

(*d*) *Newall* v. *Wilkins*, 1851, 17 L. T. 20.

(*e*) *Stocker* v. *Rogers*, 1843, 1 C. & K. 99; see also *Peroni* v. *Hudson*, 1 R. P. C. 261.

of the patent was put in issue by the defence, but the defendant not appearing at the trial, the validity of the patent was not seriously contested. Primâ facie evidence of validity was given, and judgment was given for the plaintiff and a certificate of validity granted (*f*).

In *The Delta Metal Co.* v. *Maxim Nordenfelt Co.* (1891, 8 R. P. C. 248), after the trial had been in progress for some days, the parties agreed to a compromise in the following terms:—"Judgment for plaintiffs on validity of patent. Plaintiffs to be at liberty to ask the judge for a certificate. Judgment for defendants on infringement. Plaintiffs to pay 300*l.* towards the defendants' costs. No other action to be brought on plaintiffs' patent against defendants or their customers."

Judgment was given upon the terms of the compromise. In answer to an application of plaintiffs' counsel for a certificate of validity, Collins, J., said: "I am not asked to pronounce any opinion, and I do not pronounce any opinion. It has unquestionably been brought in question, and you have arranged between yourselves how it is to be decided. You will hand the terms in—I do not do anything. I simply give judgment in accordance with the terms of your consent; that is all." Certificate granted.

In *Chadburn's Telegraph Co.* v. *Robinson* (1905, 22 R. P. C. 468) the action was brought upon two patents. As to one of them, the defendants submitted to an injunction before any evidence was given. Evidence was then given in support of the validity of both patents, and the witnesses were not cross-examined. The defendants then submitted, as the result of a compromise, to pay a fixed sum as damages and to become the licensees of the plaintiffs. Farwell, J., granted a certificate in respect of each patent.

In *Claughton* v. *Foster* (1904, 21 R. P. C. 17), the defendant agreed to take a licence from the plaintiff, and the certificate was refused.

(*f*) Also *United Phonograph Co.* v. *Young*, 1894, 11 R. P. C. 489; *Acetylene Illuminating Co.* v. *Midland Acetylene Syndicate*, 1900, 17 R. P. C. 534; *Brooks* v. *Lycett*, 1903, 20 R. P. C. 390; *Consolidated Pneumatic Tool Co.* v. *Churchill*, 1905, 22 R. P. C. 367.

In *Morris and Bastert* v. *Young* (1895, 12 R. P. C. 455) the defendants attacked the validity of the patent only on the assumption that it was wide enough to cover what they were doing. The House of Lords held that there was no infringement, and that the patent was valid on a narrow construction, and therefore refused a certificate of validity.

The meaning of the section was explained by Buckley, J., in *The New Inverted Gas Lamp Co., Ltd.* v. *Cope & Timmins, Ltd.* (1906, 23 R. P. C. at p. 116): "The section is one which simply empowers the Court to do something. . . . Of course that power is to be exercised upon judicial grounds, and I can quite understand that if a judge who finds it unnecessary to determine the validity because he finds no infringement, has, in point of fact, satisfied himself that the patent is valid, he might be induced by that to give a certificate that the validity came in question. It may be that if he, on the other hand, had found the opinion, although it was not necessary to decide it, that the patent was invalid, he would refuse it."

In that case, however, the learned judge refused a certificate of validity although he certified that the objections were reasonable and proper.

No certificate that the validity has come into question will be granted when the Court has declared that the patent is invalid (*g*).

No appeal will lie from a granting or refusing to grant a certificate that the validity of the patent came in question; such appeal not being from a judgment or order within sect. 19 of the Judicature Act (*h*).

The subsequent action.

"**In any subsequent action for infringement**": A certificate of validity granted in one action will not affect the costs in another, although decided at a later date, provided that the latter proceedings were instituted before the grant of the certificate in the earlier action (*i*).

(*g*) *Acetylene Illuminating Co.* v. *United Alkali Co.*, 1902, 19 R. P. C. 213.

(*h*) *Haslam* v. *Hall*, 1888, L. R. 20 Q. B. D. 491; 5 R. P. C. 144.

(*i*) *The Automatic Weighing Machine Co.* v. *The International Hygienic Soc.*, 1889, 6 R. P. C. at p. 480; *Saccharin Corpn.* v. *Anglo-Continental Co.*, 1900, 17 R. P. C. at p. 320.

"Unless the Court or judge trying the action certifies that he ought not to have the same." This clause gives unlimited discretion to the judge, a discretion which is exercised in view of the facts of each particular case; so where the second action was vexatious (*k*), or where litigation was the natural consequence of the vague and lax manner in which the specification had been drawn up (*l*), costs as between solicitor and client were refused (*m*).

In *Otto* v. *Steel* (1886, 3 R. P. C. at p. 120) solicitor and client costs were refused on the ground that the validity of the patent was attacked on new grounds entirely; but it is unlikely that that case will be followed at the present day (*n*).

The burden is on the defendant to show cause why he should not pay solicitor and client costs under this section (*o*).

The fact that the validity of the patent was not brought into question in the second action is merely one of the circumstances to be considered by the judge in exercising his discretion, and will not preclude the granting of solicitor and client costs. This is now decided, although in some older cases it had been doubted.

In two cases, however, where the issue in the second action was merely one of infringement, solicitor and client costs were refused by Farwell, J. (*p*).

IX. Certificates as to Particulars.

The new rule.

Rule 22 of Order LIIIa. re-enacts, with certain modifications, sub-sect. 6 of sect. 29 of the Act of 1883. *The rule is as follows:—On taxation of costs in any action or counterclaims*

(*k*) *Proctor* v. *Sutton Lodge Chemical Co.*, 1888, 5 R. P. C. 184.

(*l*) *Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 1891, 8 R. P. C. at p. 352.

(*m*) See also *Boyd* v. *The Tootal Broadhurst Lee Co.*, 1894, 11 R. P. C. at p. 185.

(*n*) See *Fabrique de Produits Chimiques* v. *Lafitte*, 1899, 16 R. P. C. 68.

(*o*) *United Telephone Co.* v. *Patterson*, 1889, 6 R. P. C. 142; see also *United Telephone Co.* v. *St. George*, 1886, 3 R. P. C. at p. 339; *The Welsbach Incandescent Gas Light Co.* v. *The Daylight Incandescent Mantle Co.*, 1899, 16 R. P. C. at p. 354.

(*p*) *Saccharin Corporation* v. *Dawson*, 1902, 19 R. P. C. at p. 173; *Edison-Bell Phonograph Co.* v. *Waterfield*, 1902, 19 R. P. C. at p. 330.

for infringement of patent, or in any petition for revocation of a patent under sect. 25 *of the Act, or in any counterclaim for revocation of a patent under sect.* 32 *of the Act, the following provision shall apply, that is to say :—*

If the action, petition, or counterclaim proceeds to trial on any patent, no costs shall be allowed in respect of any issues raised in the particulars of breaches or particulars of objections, and relating to that patent to the parties delivering the same respectively, except in so far as such particulars are certified by the Court to have been proven or to have been reasonable and proper, without regard to the general costs of the case; but, subject as aforesaid, the costs of the issues raised by the particulars of breaches and the particulars of objections shall be in the discretion of the taxing master. This may be compared with sub-sect. 6 *of sect.* 29 *of the Act of* 1883, *now repealed, which was as follows :— "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."*

Changes effected thereby.

Two principal changes have been effected, viz., (1) Certificates are now required in petitions for revocation as well as in actions for infringement (*a*), and (2) It is no longer necessary for the action to proceed to trial for the successful party to obtain the costs of his particulars (*b*).

It is important, therefore, to ask for a certificate that the particulars of breaches or of objections, as the case may be, were reasonable and proper. The application should be made at the conclusion of the trial, although the omission to do so does not preclude the successful party from obtaining it, provided he applies within a reasonable time, and he is subject to the costs incurred by the delay (*c*).

(*a*) *Gaulard and Gibb's Patent, Equipment Co.*, 1906, 23 R. P. C. 606.

(*b*) See *Middleton* v. *Bradley*, 1895, 12 R. P. C. at p. 392; *Cooper Patent Rail Joint Co.* v. *British Electric* 5 R. P. C. at p. 537.

(*c*) *Rowcliffe* v. *Morris*, 1886, 3 R. P. C. 145; *Duckett* v. *Sankey*, 1899, 16 R. P. C. 367.

Particulars of objections.

As to the particulars of objections, the practice is now well settled that when the action goes to trial, the Court will not certify unless the defendants can actually show that they are reasonable and proper; and so, where the action came on for hearing, and the plaintiff's case broke down by reason of certain of the particulars, the Court would not go through all the particulars with a view to ascertaining whether they were reasonable and proper, and a certificate was granted only as to those upon which the action was decided (*d*). And when the defendant succeeds on the issue of infringement and the issue of validity is not considered, the particulars of objections will not be certified.

But in some cases it may be reasonable that a number of specifications may be put to a witness *en bloc*, and if thereupon he concedes the point the certificate may allow each specification (*e*).

Where one of the items in the particulars of objections is relied on as an anticipation, but fails in this capacity, the Court may nevertheless certify for it, if it has been useful in illustrating the state of the art or otherwise (*f*).

And it may occur that costs incurred by a defendant in respect of an investigation into prior knowledge may be allowed as part of the costs of his defence in limiting the plaintiff's claim, although no certificate as to the particulars of the objections may have been granted (*g*).

Particulars of breaches.

Care must be taken at the trial to ask the judge to certify as to each particular breach mentioned in the particulars of breaches, and as to each particular objection; and no costs of witnesses, or of and incidental to such breach of objection as is not specially certified for, will be allowed (*h*).

The certificates granted under this rule must not be confused

(*d*) *Boyd* v. *Horrocks*, 1889, 6 R. P. C. p. 162; *Longbottom* v. *Shaw*, 1889, 6 R. P. C. 143, 510; *Acetylene Illuminating Co.* v. *United Alkali Co.*, 1902, 19 R. P. C. at p. 233; *Peter Pilkington, Ltd.* v. *Massey*, 1904, 21 R. P. C. 712.

(*e*) Per Swinfen-Eady, J., in *The Cooper Patent Anchor Rail Joint Co., Ltd.* v. *London County Council*, 1906, 23 R. P. C. at p. 297.

(*f*) *The Castner-Kellner Alkali Co.* v. *Commercial Development Co.*, 1899, 16 R. P. C. at p. 276.

(*g*) *Piggott & Co., Ltd.* v. *Corporation of Hanley*, 1906, 23 R. P. C. 639.

(*h*) *Honiball* v. *Bloomer*, 1854, 10 Exch. 538; see also *Losh* v. *Hague*, 1839, 5 M. & W. 387; *Longbottom* v. *Shaw*, 1889, 6 R. P. C. 510.

with the certificate under sect. 35. The object of the rule is to provide what costs shall be payable in the action itself, and the object of sect. 35 is to provide for the costs of future actions.

If the action does not proceed to trial the costs of the particulars are now in the discretion of the taxing master.

Where the defendant does not appear at the trial, there is little difficulty concerning the particulars of breaches, and the Court will usually certify apparently on the ground that the non-appearance is evidence that they are reasonable (*i*).

Apportionment of costs.

Where the plaintiff is successful on some issues and the defendant on some, the costs should be apportioned, the plaintiff receiving a certificate as to the particulars of breaches and the defendant as to the particulars of objections. In *Badische Anilin Fabrik* v. *Levinstein* (1885, L. R. 29 C. D. at p. 418; 2 R. P. C. at p. 118), in the Court of Appeal, Bowen, L.J., said:

"I am of opinion in this case that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result and be awarded to the successful party. It seems to me that without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that the parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable with regard to their own interest, and may help them in the conduct of the action, that they should raise issues in which, in the end, they are defeated, but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense. The order, therefore, I think ought to be as I have stated."

Costs will be apportioned both where the patent is held to be invalid and the acts alleged to be infringements proved (*k*),

(*i*) *Brooks* v. *Hall*, 1904, 21 R. P. C. 29; *Saccharin Corporation* v. *Skidmore*, 1904, 21 R. P. C. [illegible].

(*k*) Ibid. See also *Young* v. *Rosinthall*, 1884, 1 R. P. C. at p. 41; *Phillips* v. *Ivel Cycle Co.*, 1890, 7 R. P. C. at p. 85; *Binnington* v. *Hill*, 1891, 8 R. P. C. at p. 332; *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syn.*, 1894, 11 R. P. C. at p. 653.

and where the plaintiff fails on the issue of infringement and succeeds in upholding his patent (*l*), but in each of these cases the issues must be perfectly distinct (*m*), because in theory there is only one issue, viz., the infringement of the plaintiff's legal right (*n*).

In *Kaye* v. *Chubb* (1887, 4 R. P. C. at p. 300) Lord Esher, M.R., said: "Where a plaintiff brings an action on a patent and there is a real struggle, and an expensive struggle, as to whether there is an infringement or not, and the plaintiff proves the infringement, but fails because his patent is a bad one, I am not going to say that the person who has proved the infringement is not to have the costs of that issue; but in this particular case I cannot see that there are any material costs different from the costs of the cause which the defendants would be entitled to under the opinion to which I have finally come."

In cases of great difficulty the apportionment has been much simplified by the judge at the trial making an order that the entire taxed costs are to be divided between the parties in definite proportions (*o*).

Where the act of infringement was admitted before the trial the plaintiffs were not allowed any costs on that issue, their patent being held to be invalid (*p*).

Where the plaintiffs brought an action for infringement of two patents, but abandoned their case as to one of them at the trial of the action, it was held that the plaintiffs should pay all costs incurred by the defendants so far as occasioned by the claim to the patent so abandoned, although successful in the remainder of their action (*q*). And a similar apportionment may be made

(*l*) *Tweedale* v. *Ashworth*, 1890, 7 R. P. C. at p. 435; *The Sunlight Incandescent Gas Light Co.* v. *The Incandescent Gas Light Co.*, 1897, 14 R. P. C. at p. 775; *Dunlop Pneumatic Tyre Co.* v. *Wapshare Tube Co.*, 1900, 17 R. P. C. at p. 458; *Pilkington* v. *Massey*, 1904, 21 R. P. C. at p. 712.

(*m*) *Kaye* v. *Chubb*, 1887, 4 R. P. C. at p. 300; *Robertson* v. *Purdey*, 1907, 24 R. P. C. at p. 302.

(*n*) *Haskell Golf Ball Co.* v. *Hutchinson*, 1906, 22 R. P. C. 125.

(*o*) *Incandescent Gas Light Co.* v. *Sunlight Incandescent Co.*, 1896, R. P. C. at p. 345; *Monnet* v. *Beck*, 1897, 14 R. P. C. at p. 850.

(*p*) *Westley Richards* v. *Perkes*, 1893, 10 R. P. C. at p. 194.

(*q*) *Hocking* v. *Fraser*, 1886, 3 R. P. C. 3.

where the plaintiff succeeds on one patent and fails on another (*r*), or even where the plaintiff succeeds on one claim of a single patent and fails on the others (*s*).

Costs on higher scale.

Costs on the higher scale are only allowed in cases of exceptional difficulty (*t*).

In *Gadd* v. *The Mayor, &c. of Manchester* (1892, 9 R. P. C. at p. 535), Lindley, L.J., said: "I think costs on the higher scale ought not 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."

In *The Wenham Gas Co.* v. *The Champion Gas Co.* (1891, 8 R. P. C. at p. 320) costs on the higher scale were refused on the ground that the necessity for scientific evidence was largely due to the unfortunate wording of the specification.

Three counsel.

The principle upon which costs on the higher scale should be allowed and the costs of briefing three counsel were discussed, and the authorities considered, by Buckley, J., in *The Dunlop Pneumatic Tyre Co.* v. *The Wapshare Tube Co.* (1900, 17 R. P. C. at p. 459) (*u*), where both were allowed. But in the majority of cases in recent times they have been refused (*x*).

The practice has now arisen of leaving the question of allowing three counsel to the taxing master (*y*).

Costs of shorthand notes.

The costs of the **shorthand notes** are usually agreed between the parties before the trial commences, but in default of such an arrangement they will not be allowed unless they have been of material assistance to the Court in shortening the amount of time the case has taken, or otherwise (*z*).

(*r*) *Brooks* v. *Lamplugh*, 1898, 15 R. P. C. at p. 52.

(*s*) *Mouchel* v. *Coignet*, 1906, 23 R. P. C. 649.

(*t*) *Farbenfabriken vorm. F. Bayer & Co.* v. *Bowker*, 1891, 8 R. P. C. 389, 397; *Hopkinson* v. *St. James' Electric Light Co.*, 1893, 10 R. P. C. 46, 62.

(*u*) And see *Muirhead* v. *Commercial Cable Co.*, 1895, 12 R. P. C. at p. 64.

(*x*) On this point, see the list of authorities cited in *Bradford Dyers' Association* v. *Bury*, 1902, 19 R. P. C. 125.

(*y*) *Andrews' Patent*, 1907, R. P. C. at p 378.

(*z*) See, *e.g.*, *Castner-Kellner Alkali Co.* v. *Commercial Development Co.*, 1889, 16 R. P. C. at p. 275; *The Palmer Tyre Co., Ltd.* v. *Pneumatic Tyre Co., Ltd.*, 1889, 16 R P. C. at p. 496.

Public Authorities Protection Act.

Under the Public Authorities Protection Act, 56 & 57 Vict. c. 61, a public authority is entitled to costs as between solicitor and client, and this applies to actions for infringement (*a*).

No appeal as to costs.

Sect. 49 of the Judicature Act, 1873, provides that there shall be no appeal as to costs; but this was held not to apply where the costs were a matter of right, and not discretionary (*b*). Under the Rules of Court which were in operation prior to October 24, 1883, the question of higher or lower scale was a matter of right (*c*). Hence, in *Re Terrell* (1882, L. R. 22 C. D. 473) the Court of Appeal held that there was an appeal; but now it will be observed that the order is in the absolute discretion of the judge, and therefore it is submitted there is no appeal.

Directors of companies.

The directors of a limited company, whose servants have infringed a patent, may be ordered to pay costs personally.

In *Spencer* v. *The Ancoats Vale Co.* (1889, 6 R. P. C. 46) it was ordered that costs on the higher scale should be paid by the defendant company, and by the directors in the event of the company not paying (*d*).

Where an action is brought against two defendants and the case against one of them is settled, and the action proceeds against the other and judgment is recovered, then unless a special order as to costs is made no deduction on taxation will be made from the general costs of the action to represent the amount incurred as against the defendant whose case was settled (*e*).

Judgment having been recovered, minutes of judgment should be prepared. The minutes will be in accordance with one or other of the precedents given hereafter. We have drawn attention in previous pages to those points which should be

(*a*) *Chamberlain and Hookham* v. *Bradford*, 1900, 17 R. P. C. 762; *British Thomson-Houston Co.* v. *Manchester*, 1903, 20 R. P. C. at p. 471; cf. *New Conveyor Co.* v. *Edinburgh Commissioners*, 1904, 21 R. P. C. 147.

(*b*) *Turner* v. *Hancock*, 1879, L. R. 20 Ch. D. 303, C. A.

(*c*) Rules of S. C., 1875.

(*d*) See also *Betts* v. *De Vitre*, 1868, L. R. 3 Ch. 429.

(*e*) *Kelly's Directories, Ltd.* v. *Garin and Lloyds*, 1901, 2 Ch. 763; *Badische Anilin und Soda Fabrik* v. *Hickson*, 1906, 23 R. P. C. 149.

attended to in preparing these minutes. Care should be exercised, when an account is directed to be taken, that provision be made for the **payment of costs to the plaintiff up to and including the hearing,** otherwise the payment of all costs will be delayed until the final account has been taken, which in some cases has been known to amount to a delay of years.

Stay of judgment.

A stay will be put upon a judgment pending appeal when the matter at issue is of great importance, and when in the event of the judgment being reversed great injury would otherwise be incurred by the defendant; but in such cases the defendant is ordered to keep an account, and to bring his appeal without delay (*f*).

The usual course with regard to costs is for the solicitor to the successful party to give an undertaking to return the costs in the event of a successful appeal (*g*). In *Ackroyd & Best* v. *Thomas* (1904, 21 R. P. C. at p. 412), where the solicitors refused the undertaking, Joyce, J., stayed the payment of the costs, but refused to stay the taxation.

PRACTICE ON APPEAL.

Under Order LVIII. r. 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court, together will full discretionary power to receive further evidence upon questions of fact, such evidence to be either by oral examination in Court, by affidavit, or by deposition taken before an examiner or commissioner. Such further evidence may be given without special leave upon interlocutory application, or in any case as to matters which have occurred after the date of the decision from which the appeal is brought. Upon appeals from a judgment after trial or hearing of any cause or matter upon the merits, such further evidence (save as to

(*f*) *The North British Rubber Co.* v. *Macintosh*, 1894, 11 R. P. C. 477, 489; see also *Hocking* v. *Fraser*, 1886, 3 R. P. C. 3; *Kaye* v. *Chubb*, 1887, 4 R. P. C. 23; *Proctor* v. *Bennis*, 1887, 4 R. P. C. at p. 363; *Lyon* v. *Goddard*, 1893, 10 R. P. C. at p. 135; *Ducketts* v. *Whitehead*, 1895, 12 R. P. C. at p. 191. For form of order, see *Lyon* v. *Goddard*, 1893, 10 R. P. C. at p. 136.

(*g*) *The Ticket Punch Register Co.* v. *Colley's Patents, Ltd.*, 1895, 12 R. P. C. at p. 10.

matters subsequent as aforesaid) shall be admitted on special grounds only, and not without special leave of the Court.

As to **further evidence**, in *Hinde* v. *Osborne* (1885, 2 R. P. C. at p. 47), Lindley, L.J., said:—"The power given to the Court of Appeal to hear fresh evidence is an extremely valuable one, and is given by Order LVIII. r. 4. I cannot understand that as meaning that the Court of Appeal ought to grant leave to adduce fresh evidence, simply because a man has failed at the trial and he thinks he can get more evidence which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. There must be some ground shown to satisfy the Court that there is some evidence now forthcoming, which with due diligence he could not have got; and it must therefore, in accordance with the usual practice, be evidence, not merely swearing by affidavits or anything of that kind, but something in the nature of the production of a lost document, or something of that sort, which will not expose the parties to a mere flood of affidavits made up to meet the blots and defects which have been disclosed upon the first trial" (*h*).

As to amendment of pleadings and particulars, in *Cropper* v. *Smith* (1884, L. R. 26 C. D. at p. 710) Bowen, L.J., said: "Now, I think it is a well established principle that the object of Courts is to decide the rights of the parties, and not to punish them for mistakes they make in the conduct of their cases by deciding otherwise than in accordance with their rights. Speaking for myself, and in conformity with what I have heard laid down by the other Division of the Court of Appeal, and by myself as a member of it, I know of no kind of error or mistake which, if not fraudulent or intended to overreach, the Court ought not to correct, if it can be done without injustice to the other party. Courts do not exist for the sake of discipline, but for the sake of deciding matters in controversy, and I do not regard such amendment as a matter of favour or of grace."

(*h*) And see *Nadel* v. *Martin*, 1903, 20 R. P. C. 721. Instances where fresh evidence was allowed on appeal were *Britain* v. *Hirsch*, 5 R. P. C. 226; *Spencer* v. *Ancoats Rubber Co.*, 1889, 6 R. P. C. 46; *Blakey* v. *Latham*, 1889, 6 R. P. C. at p. 186.

In *The Shoe Machinery Co.* v. *Cutlan* (1895, 12 R. P. C. 530) the Court of Appeal refused to allow amendment of the particulars of objections by adding seven new anticipating specifications. They based their decision on the fact that no satisfactory explanation was forthcoming as to why these specifications had not been found before. But in *Pirrie* v. *York St. Spinning Co.* (1894, 11 R. P. C. at p. 431) the Court allowed a similar application, which was supported, however, by affidavits by the applicant's patent agents, that a diligent and careful search had been made, and that the new specifications could not have been discovered in spite of proper care.

On appeal to the House of Lords, it was held in a case where the Court of Appeal had held the specification bad and for the defendant on the infringement issue, but the House had reversed the decision on the specification and upheld it on the infringement issue, that each party must pay its own costs of the appeal (*i*).

(*i*) *Moore* v. *Bennett*, 1884, 1 R. P. C. at p. 148; Griff. P. C. at p. 161; see also as to costs on reversal of decision of C. A. by House of Lords, *The United Horse-nail Co.* v. *Stewart*, 1888, 5 R. P. C. 260, 269.

Judgment by consent should be by order after motion in open Court.

T. J. Smith & Sons v Sawrai Ram & Co
XXI R.P.C. 319.

Admissibility of evidence given in previous case B.T.H v. Bakhirkhanalakar Coke &. XLI R.P.C. 350.

Sec 38 A Act 1919
"Special". XXXIX R P C. 261.

Patent Agent. 29 R P C 653.

Judgment in default of appearance by Def
XLII R. P.C.
Order should be (1) struck out or enquiry as to dam
(2) reserve costs of enquiry (3) liberty to apply.
Motion for judgment in ch. div. other Divisions given

? Writ of prohibition. v C.G. 1931 2 Ch. 272
Ram Jiwan Singh.

APPENDIX.

STATUTES.

STATUTE OF MONOPOLIES (1623).

[21 Jac. I. c. 3.]

An Act concerning Monopolies and Dispensations of Penal Laws and the Forfeitures thereof.

For as much as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God 1610, publish in print to the whole realm, and to all posterity, that all grants and monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant, and agreeable to the ancient and fundamental laws of this your realm. And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature: yet, nevertheless, upon misinformations and untrue pretences of public good many such grants have been unduly obtained and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid: For avoiding whereof and preventing of the like in time to come, be it enacted, that all monopolies and all commissions, grants, licences, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty, to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenor or purport of any law or statute; or to give or make any warrant for any such

All monopolies, &c., shall be void.

dispensation, licence, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeiture limited by any statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money that is or shall be due by any statute before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution.

Monopolies, &c., shall be tried by the common laws of this realm.

2. That all monopolies, and all such commissions, grants, licences, charters, letters patent, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them, and of every of them, ought to be, and shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, &c.

3. That all person and persons, bodies politic and corporate whatsoever, which now or hereafter shall be, shall stand and be disabled, and incapable to have, use, exercise or put in use any monopoly, or any such commission, grant, licence, charter, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power, or faculty grounded or pretended to be grounded upon them, or any of them.

The party grieved by pretext of a monopoly, &c., shall recover treble damages and double costs.

4. That if any person or persons at any time after the end of forty days next after the end of this present session of parliament shall be hindered, grieved, or disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained by occasion or pretext of any monopoly, or of any such commission, grant, licence, power, liberty, faculty, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises, that then and in every such case the same person and persons shall and may have his and their remedy for the same at the common law by any action or actions to be grounded upon this statute; the same action and actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained; wherein all and every such person and persons

which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs: and in such suits or for the staying or delaying thereof, no essoign, protection, wager of law, aid; prayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance; and if any person or persons shall after notice given that the action depending is grounded upon this statute, cause or procure any action at the common law grounded upon this statute, to be stayed or delayed before judgment by colour or means of any order, warrant, power, or authority, save only of the court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or attaint; and then the said person and persons so offending shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the statute of provision and præmunire made in the sixteenth year of the reign of King Richard the Second.

What new patents to be good.

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

Proviso.

7. Provided also, that this Act or anything therein contained shall not in anywise extend or be prejudicial to any grant or privilege, power, or authority whatsoever heretofore made, granted, allowed, or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force.

Warrants granted to justices saved.

8. Provided also, that this Act shall not extend to any warrant or privy seal made or directed, or to be made or directed, by His

Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas and barons of the Exchequer, justices of assize, justices of oyer and terminer and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Charters granted to corporations saved.

9. Provided also, that this Act or anything therein contained shall not in anywise extend or be prejudicial unto the city of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent to them, or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them; or unto any corporation, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm erected for the maintenance, enlargement, or ordering of any trade or merchandise; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other; anything before in this Act contained to the contrary in any wise notwithstanding.

PATENTS AND DESIGNS ACT, 1907.

[7 EDW. VII., c. 29.]

ARRANGEMENT OF SECTIONS.

PART I.—PATENTS.

Application for and Grant of Patent.

SECT.

1. Application.
2. Specifications.
3. Proceedings upon application.
4. Provisional protection.
5. Time for leaving complete specification.
6. Comparison of provisional and complete specification.
7. Investigation of previous specifications in United Kingdom on applications for patents.
8. Investigation of specifications published subsequently to application.
9. Advertisement on acceptance of complete specification.
10. Effect of acceptance of complete specification.
11. Opposition to grant of patent.
12. Grant and sealing of patent.
13. Date of patent.
14. Effect, extent, and form of patent.
15. Fraudulent applications for patents.
16. Single patent for cognate inventions.

Term of Patent.

17. Term of patent.
18. Extension of term of patent.
19. Patents of addition.

Restoration of lapsed Patents.

20. Restoration of lapsed patents.

Amendment of Specification.

21. Amendment of specification by Comptroller.
22. Amendment of specification by the Court.

SECT.

23. Restriction on recovery of damages.

Compulsory Licences and Revocation.

24. Compulsory licences and revocation.
25. Revocation of patent.
26. Power of Comptroller to revoke patents on certain grounds.
27. Revocation of patents worked outside the United Kingdom.

Register of Patents.

28. Register of patents.

Crown.

29. Patent to bind Crown.
30. Assignment to Secretary for War or the Admiralty of certain inventions.

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31. Hearing with assessor.
32. Power to counterclaim for revocation in an action for infringement.
33. Exemption of innocent infringer from liability for damages.
34. Order for inspection, &c., in action.
35. Certificate of validity questioned and costs thereon.
36. Remedy in case of groundless threats of legal proceedings.

Miscellaneous.

37. Grant of patents to two or more persons.
38. Avoidance of certain conditions attached to the sale, &c., of patented articles.
39. Costs and security for costs.
40. Procedure on appeal to law officer.
41. Provision as to anticipation.

SECT.
42. Disconformity.
43. Patent on application of representative of deceased inventor.
44. Loss or destruction of patent.
45. Provisions as to exhibitions.
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47. Patent Museum.
48. Foreign vessels in British waters.

PART II.—DESIGNS.

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50. Registration of designs in new classes.
51. Certificate of registration.
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53. Copyright on registration.
54. Requirements before delivery on sale.
55. Effect of disclosure on copyright.
56. Inspection of registered designs.
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58. Cancellation of registration of designs used wholly or mainly abroad.

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60. Piracy of registered designs.
61. Application of certain provisions of the Act as to patents to designs.

PART III.—GENERAL.

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62. Patent Office.
63. Officers and clerks.
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65. Fees.

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66. Trust not to be entered in registers.
67. Inspection of and extracts from registers.
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69. Prohibition of publication of specification, drawings, &c. where application abandoned, &c.
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73. Exercise of discretionary power by Comptroller.
74. Power of Comptroller to take directions of law officers.
75. Refusal to grant patent, &c. in certain cases.
76. Annual reports of Comptroller.

Evidence.

77. Evidence before Comptroller.
78. Certificate of Comptroller to be evidence.
79. Evidence of documents in Patent Office.
80. Transmission of certified printed copies of specifications, &c.
81. Applications and notices by post.
82. Excluded days.
83. Declaration by infant, lunatic, &c.

Register of Patent Agents.

84. Register of patent agents.
85. Agents for patents.

Powers, &c. of Board of Trade.

86. Power for Board of Trade to make general rules.
87. Proceedings of the Board of Trade.
88. Provision as to Order in Council.

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89. Offences.
90. Unauthorised assumption of Royal arms.

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91. International and colonial arrangements.

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92. Provisions as to "the Court."
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94. Application to Scotland.
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97. Saving for prerogative.
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99. Short title and commencement.
SCHEDULES.

An Act to consolidate the enactments relating to Patents for Inventions and the registration of Designs and certain enactments relating to Trade Marks.

[28th August, 1907.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—

PART I.—PATENTS.

Application for and Grant of Patent.

Application.

1.—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person **(Act of 1883, sect. 4, sub-sects. 1 and 2, and Act of 1885, sect. 5).** *15.*

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner **(Act of 1883, sect. 5, sub-sect. 1).** *133.*

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification **(Act of 1883, sect. 5, sub-sect. 2).** *134.*

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed **(Act of 1885, sect. 2).** *135.*

2.—(1) A provisional specification must describe the nature of the invention **(Act of 1883, sect. 5, sub-sect. 3).** *92, 96, 138.*

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

Specifications.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed **(Act of 1883, sect. 5, sub-sect. 4).** *92, 102.*

(3) In the case of any provisional or complete specification, where the Comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification **(Act of 1883, sects. 3 and 4, and Act of 1886, sect. 2).** *125, 126, 138.*

(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed **(Act of 1883, sect. 5, sub-sect. 5).** *93—95, 126, 138.*

(5) Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the Comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification **(New).** *147.*

Proceedings upon application.

3.—(1) The Comptroller-General of Patents, Designs, and Trade Marks (hereinafter referred to as the Comptroller) shall refer every application to an examiner **(Act of 1883, sect. 6).** *135.*

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Comptroller so directs, bear date as from the time when the requirement is complied with **(Act of 1888, sect. 2).** *139.*

(3) Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted **(Act of 1888, sect. 2, sub-sects. 2 and 3).** *140.*

(4) The Comptroller shall, when an application has been accepted, give notice thereof to the applicant **(Act of 1888, sect. 4).** *140.*

Provisional protection.

4. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the

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invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection (**Act of 1883, sect. 14**). *95, 148.*

Time for leaving complete specification.

5.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months from the date of the application (**Act of 1883, sect. 8, sub-sect. 1; Act of 1902, sect. 1, sub-sect. 8**).

Provided that where an application is made for an extension of the time for leaving a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for, but not exceeding one month (cf. **Act of 1885, sect. 3; and Act of 1902, sect. 1, sub-sect. 8**). *145.*

(2) Unless a complete specification is so left the application shall be deemed to be abandoned (**Act of 1883, sect. 8, sub-sect. 2**). *146.*

Comparison of provisional and complete specification.

6.—(1) Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner (**Act of 1883, sect. 9, sub-sect. 1**). *140.*

(2) If the examiner reports that the complete specification has not been prepared in the prescribed manner, the Comptroller may refuse to accept the complete specification until it has been amended to his satisfaction (**Act of 1883, sect. 9, sub-sects. 1 and 2**). *140.*

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the Comptroller may—

(*a*) refuse to accept the complete specification until it has been amended to his satisfaction; or

(*b*) (with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date:

Provided that where the complete specification includes an invention not included in the provisional specification, the Comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left (**Partly new, cf. Act of 1883, sect. 9, sub-sects. 1 and 2**). *141.*

(4) A refusal of the Comptroller to accept a complete specification

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shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted **(Act of 1883, sect. 9, sub-sect. 3).**

(5) Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void **(Act of 1883, sect. 9, sub-sect. 4).** *146.*

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the Comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for, but not exceeding three months (cf. **Act of 1885, sect. 3).** *146.*

Investigation of previous specifications in United Kingdom on applications for patents.

7.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application **(Act of 1902, sect. 1, sub-sect. 1).** *141.*

(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 **(Act of 1902, sect. 1, sub-sect. 2).** *141.*

(3) If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification **(Act of 1902, sect. 1, sub-sect. 5).** *141.*

(4) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection is removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what, prior specifications ought to be made in the specification by way of notice to the public **(Act of 1902, sect. 1, sub-sect. 6).** *142.*

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Provided that the Comptroller, if satisfied that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent (**New**). *142, 143.*

(5) An appeal shall lie from the decision of the Comptroller under this section to the law officer (**Act of 1902, sect. 1, sub-sect. 7**). *145, 169, 170.*

(6) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connexion with, any such investigation or report, or any proceeding consequent thereon (**Act of 1902, sect. 1, sub-sect. 9**).

Investigation of specifications published subsequently to application.

8.—(1) An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior applications; and that section shall, subject to rules under this Act, have effect accordingly (**The whole of this section is new**). *144.*

(2) Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the Comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public. *144.*

(3) For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application. *144.*

(4) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament. *145.*

Advertisement on acceptance of complete specification.

9. On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specifications, with the drawings (if any), shall be open to public inspection (**Act of 1883, sect. 10**).

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Effect of acceptance of complete specification.

10. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification. Provided that an applicant shall not be entitled to institute any proceeding for infringement until a patent for the invention has been granted to him (**Act of 1883, sect. 15**). *95, 148.*

Opposition to grant of patent.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds :— *155, 168*

(*a*) that the applicant obtained the invention from him, or from a person of whom he is the legal representative; or (**Act of 1883, sect. 11, sub-sect. 1**), *156, 158*

(*b*) that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent; or (cf. **Act of 1883, sect. 11, sub-sect. 1**), *156, 160*

(*c*) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or (**New**), *157, 167*

(*d*) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, (**Act of 1888, sect. 4**), *156, 167*

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 opponent, if desirous of being heard, decide on the case (**Act of 1883, sect. 11, sub-sect. 2**). *168.*

(3) The decision of the Comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer

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with the consent of the Treasury may determine (**Act of 1883, sect. 11, sub-sect. 304**). *170.*

Grant and sealing of patent.

12.—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application, to the applicants jointly, and the Comptroller shall cause the patent to be sealed with the seal of the Patent Office (**Act of 1883, sect. 12, sub-sect. 1**).

(2) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, provided that—(**Act of 1883, sect. 12, sub-sect. 3**)

(*a*) Where the Comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a futher extension of four months after the said fifteen months shall be allowed for the sealing of the patent : (**Act of 1885, sect. 3**)

(*b*) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct : (**Act of 1883, sect. 12, sub-sect. 3 (a)**)

(*c*) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death : (**Act of 1883, sect. 12, sub-sect. 3 (b)**)

(*d*) Where in consequence of the neglect or failure of the applicant to pay any fee a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall, in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act (**New**).

Date of patent.

13. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application. Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification (**Act of 1883, sect. 13**). *149.*

Effect, extent, and form of patent.

14.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the

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United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man (**Act of 1883, sect. 12, sub-sect. 2; sect. 16**). *7, 385.*

Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only (**Act of 1883, sect. 36**). *190.*

(2) Every patent may be in the prescribed form (*7*) and shall be granted for one invention only (*135*), but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention (**Act of 1883, sect. 33**).

Fraudulent applications for patents.

15.—(1) A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection (**Act of 1883, sect. 35**). *28.*

(2) Where a patent has been revoked on the ground of fraud, the Comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked (cf. **Act of 1883, sect. 26, sub-sect. 8**). *28.*

Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted (**New**). *28.*

Single patent for cognate inventions.

16.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the Comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon (**New**). *136.*

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the Court or the Comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein (**New**). *136.*

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Term of Patent.

Term of patent.

17.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be fourteen years from its date (**Act of 1883, sect. 17, sub-sect. 1**).

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times; (**Act of 1883, sect. 17, sub-sect. 2**) provided that the Comptroller, upon the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for, but not exceeding three months (cf. **Act of 1883, sect. 17, sub-sects. 3 and 4**). *12.*

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement (**Act of 1883, sect. 17, sub-sect. 4 (b)**).

Extension of term of patent.

18.—(1) A patentee may, after advertising in manner provided by Rules of the Supreme Court his intention to do so, present a petition to the Court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent (cf. **Act of 1883, sect. 25, sub-sect. 1**). *219.*

(2) Any person may give notice to the Court of objection to the extension (cf. **Act of 1883, sect. 25, sub-sect. 2**). *239.*

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the Court (cf. **Act of 1883, sect. 25, sub-sect. 3**) *239.*

(4) The Court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case (cf. **Act of 1883, sect. 25, sub-sect. 4**). *220 et seq.*

(5) If it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases (*227*), fourteen years, or may order the grant of a new patent for such term as may be specified in the order and

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containing any restriction, conditions, and provisions the Court may think fit (cf. **Act of 1883, sect. 25, sub-sect. 5**).

Patents of addition.

19.—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired (**The whole of this section is new**). *64, 147.*

(2) Where an application containing such a request is made, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid. *147.*

(3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal. *147.*

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent. *64.*

Restoration of lapsed Patents.

Restoration of lapsed patents.

20.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller in the prescribed manner for an order for the restoration of the patent (**The whole of this section is new**). *151.*

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee. *152.*

(3) If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the Comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office. *152.*

(4) Where such notice is given the Comptroller shall notify the applicant thereof. *152.*

(5) After the expiration of the prescribed period the Comptroller shall hear the case and, subject to an appeal to the Court, issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such

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provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal. *153.*

Amendment of Specification.

Amendment of specification by Comptroller.

21.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment (**Act of 1883, sect. 18, sub-sect. 1**). *174.*

(2) The request and the nature of the proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment (**Act of 1883, sect. 18, sub-sect. 2**). *181.*

(3) Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case (**Act of 1883, sect. 18, sub-sect. 3**). *181.*

(4) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the Comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed (**Act of 1883, sect. 18, sub-sect. 5**). *181.*

(5) The decision of the Comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and, where there is no opposition, the Comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed (**Act of 1883, sect. 18, sub-sects. 3 and 4**).

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment (**Act of 1883, sect. 18, sub-sect. 8**). *174.*

(7) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be deemed to form part of the specification (cf. **Act of 1883, sect. 18, sub-sect. 9**). *184.*

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(8) This section shall not apply when and so long as any action for infringement or proceeding before the Court for the revocation of a patent is pending (**Act of 1888, sect. 5**). *186.*

Amendment of specification by the Court.

22. In any action for infringement of a patent or proceedings before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs, advertisement or otherwise, as the Court may think fit : *186*

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court, notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court (cf. **Act of 1883, sect. 19**). *174, 186.*

Restriction on recovery of damages.

23. Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge (**Act of 1883, sect. 20**). *189.*

Compulsory Licences and Revocation.

Compulsory licences and revocation.

24.—(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent (**Act of 1902, sect. 3, subsect. 1**). *244.*

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a primâ facie case has been made out, shall refer the petition to the Court, and, if the Board are not so satisfied, they may dismiss the petition (cf. **Act of 1902, sect. 3, subsect. 2**). *244.*

(3) Where any such petition is referred by the Board of Trade to the Court, and it is proved to the satisfaction of the Court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the Court to grant licences on such terms as the Court may think just, or,

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if the Court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the Court:

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default (cf. **Act of 1902, sect. 3, sub-sect. 3**). *246.*

(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 (**Act of 1902, sect. 3, sub-sect. 4**). *247.*

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(*a*) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; (cf. **Act of 1902, sect. 3, sub-sects. 5 and 6**) or *245*

(*b*) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process (**New**). *245.*

(6) An order of the Court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding (**Act of 1902, sect. 3, sub-sect. 7**). *247.*

Revocation of patent

25.—(1) Revocation of a patent may be obtained on petition to the Court. *248.*

(2) Every ground on which—

(*a*) a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by scire facias (**Act of 1883, sect. 26, sub-sect. 3**); (*248*) or

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

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section. *248, 249, 329.*

(3) A petition for revocation for a patent may be presented—

(*a*) by the Attorney-General or any person authorised by him ; *(251)* or

(*b*) by any person alleging—

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

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee ; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention **(Act of 1883, sect. 26, sub-sect. 4).** *250.*

Power of Comptroller to revoke patents on certain grounds.

26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed **(The whole of this section is new).** *258.*

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

(2) The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application ; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent. *259.*

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

parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent. *257.*

(4) Any decision of the Comptroller under this section shall be subject to appeal to the Court. *258.*

Revocation of patents worked outside the United Kingdom.

27.—(1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the Comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom **(The whole of this section is new, but cf. Act of 1902, sect. 3, sub-sect. 5).** *260 et seq.*

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

(*a*) forthwith; or

(*b*) after such reasonable interval as may be specified in the order,

unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent:

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

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

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

Register of Patents.

Register of patents.

28.—(1) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and

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addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed **(Act of 1883, sect. 23, sub-sect. 1).** *215.*

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

(3) The register of patents shall be primâ facie evidence of any matters by this Act directed or authorised to be inserted therein **(Act of 1883, sect. 23, sub-sect. 2).** *215, 385 (and see sect. 79).*

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office **(Act of 1883, sect. 23, sub-sect. 3).** *215.*

Crown.

Patent to bind Crown.

29. A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject:

Provided that any Government Department may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested **(Act of 1883, sect. 27).** *12.*

Assignment to Secretary for War or the Admiralty of certain inventions.

30.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention; and the Secretary of State or the Admiralty may be a party to the assignment (cf. **Act of 1883, sect. 44, as to the whole of this section).** *13.*

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State or the Admiralty on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State or the Admiralty **(Act of 1883, sect. 44, sub-sect. 2).**

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the Comptroller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret (**Act of 1883, sect. 44, sub-sect. 3**).

(4) If the Secretary of State or the Admiralty so certify the application and specifications, with the drawings (if any), and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State or the Admiralty (**Act of 1883, sect. 44, sub-sect. 4**).

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State or the Admiralty or of the law officer (**Act of 1883, sect. 44, sub-sect. 5**).

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the Comptroller be again kept sealed by him (**Act of 1883, sect. 44, sub-sect. 6**).

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty (**Act of 1883, sect. 44, sub-sect. 7**).

(8) Where the Secretary of State or the Admiralty certify as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the complete specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Comptroller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State or the Admiralty (**Act of 1883, sect. 44, sub-sect. 8**).

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State or the Admiralty as aforesaid (**Act of 1883, sect. 44, sub-sect. 9**).

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions

of this Act shall apply in respect of any such invention and patent as aforesaid (**Act of 1883, sect. 44, sub-sect. 10**).

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way (**Act of 1883, sect. 44, sub-sect. 11**).

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State or the Admiralty, or to any person or persons authorised by the Secretary of State or the Admiralty to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same (**Act of 1883, sect. 44, sub-sect. 12**).

(13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid (**New**).

Legal Proceedings.

Hearing with assessor.

31.—(1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it think fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury, unless the Court otherwise directs (**Act of 1883, sect. 28, sub-sect. 1**). *381.*

(2) The Court of Appeal may, if they think fit, in any proceeding before them, call in the aid of an assessor as aforesaid (**Act of 1883, sect. 28, sub-sect. 2**).

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act (**Act of 1883, sect. 28, sub-sect. 3**).

Power to counterclaim for revocation in an action for infringement.

32. A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the Rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent (**New**). *253.*

Exemption of innocent

33. A patentee shall not be entitled to recover any damages in

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respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent.

infringer from liability for damages.

Provided that nothing in this section shall affect any proceedings for an injunction (**New**). *376.*

34. In an action for infringement of a patent, the Court may on the application of either party make such order for an injunction, inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court may see fit (**Act of 1883, sect. 30**). *359.*

Order for inspection, &c., in action.

35. In an action for infringement of a patent, the Court may certify that the validity of the patent came in question; and, if the Court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client (**Act of 1883, sect. 31**). *393.*

Certificate of validity questioned and costs thereon.

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

Remedy in case of groundless threats of legal proceedings.

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 (**Act of 1883, sect. 32**). *268.*

Miscellaneous.

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any

Grant of patents to two or more persons.

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contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate (**New**). *197.*

Avoidance of certain conditions attached to the sale, &c. of patented articles.

38.—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

(*a*) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(*b*) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy (**The whole of this section is new**). *211.*

Provided that this sub-section shall not apply if—

(i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade. *213.*

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving

three months' notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade. *213.*

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding sub-section, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade. *214.*

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force. *215, 334.*

(5) Nothing in this section shall—

(*a*) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(*b*) be construed as validating any contract which would, apart from this section, be invalid; or

(*c*) affect any right of determining a contract or condition in a contract exerciseable independently of this section; or

(*d*) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair. *212.*

Costs and security for costs.

39.—(1) The Comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court (**New**). *169.*

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

(2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the Comptroller for the revocation of a patent, or giving notice of appeal from any decision of the Comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the Comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned (**New**). *170.*

Procedure on appeal to law officer.

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court (**Act of 1883, sect. 38**). *169.*

Provisions as to anticipation.

41.—(1) An invention covered by any patent applied for on or after the first day of January One thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification (**Act of 1902, sect. 2**). *80.*

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the Court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication (**New**). *74.*

Disconformity.

42. A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof (**New**). *100.*

Patent on application of representative of deceased inventor.

43.—(1) If the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention

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granted to, his legal representative (**Act of 1883, sect. 34, sub-sect. 1**). *15, 134.*

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention (cf. **Act of 1883, sect. 34, sub-sect. 2**). *134.*

Loss or destruction of patent.

44. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Comptroller, the Comptroller may at any time seal a duplicate thereof (**Act of 1883, sect 37**).

Provisions as to exhibitions.

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

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

(*b*) the application for a patent is made before or within six months from the date of the opening of the exhibition (**Act of 1883, sect. 39, sub-sect. 1**).

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the Comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order (**Act of 1886, sect. 3**). *85.*

Publication of illustrated journal, indexes, &c.

46.—(1) The Comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important (**Act of 1883, sect. 40, sub-sect. 1**).

(2) Provision shall be made by the Comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings (**Act of 1883, sect. 40, sub-sect. 2**).

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(3) The Comptroller shall continue, in such form as he deems expedient, the indexes and abridgments of specifications hitherto published, and shall prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he thinks fit (**Act of 1883, sect. 40, sub-sect. 3**).

Patent Museum.

47.—(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give (cf. **Act of 1883, sect. 41**).

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade (cf. **Act of 1883, sect. 42**).

Foreign vessels in British waters.

48.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man (**Act of 1883, sect. 43, sub-sect. 1**).

(2) This section shall not extend to vessels of any foreign State of which the laws do not confer corresponding rights with respect to the use of inventions in British while in the ports of that State, or in the waters within the jurisdiction of its Courts (**Act of 1883, sect. 43, sub-sect. 2**). *315.*

Part II.—Designs.

(*This Part of the Act is not relevant to this Work.*)

Part III.—General.

Patent Office and Proceedings thereat.

Patent Office. 5 Edw. 7, c. 15.

62.—(1) The Treasury may continue to provide, for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office (**Act of 1883, sect. 82, sub-sect. 1**).

(2) The Patent Office shall be under the immediate control of the

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Comptroller, who shall act under the superintendence and direction of the Board of Trade (**Act of 1883, sect. 82, sub-sect. 3**).

(3) Any act or thing directed to be done by or to the Comptroller may be done by or to any officer authorised by the Board of Trade (**Act of 1883, sect. 82, sub-sect. 4; and Act of 1902. sect. 4**).

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established (**New**).

Officers and clerks.

63.—(1) There shall continue to be a Comptroller-General of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the Comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks (**Act of 1883, sect. 83, sub-sect. 1**).

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament (**Act of 1883, sect. 83, sub-sect. 2**).

Seal of Patent Office.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence (**Act of 1883, sect. 84**).

Fees.

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade; so, however, that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule (**Act of 1883, sects. 24 and 56**).

Provisions as to Registers and other Documents in Patent Office.

Trust not to be entered in registers.

66. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied or constructive (**Act of 1883, sect. 85**). *215.*

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

Inspection of and extracts from registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (**Act of 1883, sect. 88; and Act of 1888, sect. 22**).

Privilege of reports of examiners.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed (**Act of 1883, sect. 9, sub-sect. 5; and Act of 1888, sect. 3**).

Prohibition of publication of specification, drawings, &c. where application abandoned, &c.

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connection with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the Comptroller (**Act of 1885, sect. 4; and Act of 1901, sect. 1, sub-sect. 2**; and see **sect. 91, sub-sect. 3 of this Act**). *146.*

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection or be published by the Comptroller (**New**).

Power for Comptroller to correct clerical errors.

70. The Comptroller may, on request in writing accompanied by the prescribed fee,—

(*a*) correct any clerical error in or in connexion with an application for a patent or in any patent or any specification;

(*b*) cancel the registration of a design either wholly or in respect of any particular goods in connexion with which the design is registered.

(*c*) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register or designs (cf. **Act of 1883, sect. 91, as to the whole of this section**).

Entry of assignments and transmissions in registers.

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the Comptroller shall, on request and on

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proof of title to his satisfaction, register him as the proprietor of a patent or design (**Act of 1883, sect. 87**).

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the Comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be (**New**).

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property (**Act of 1883, sect. 87**). *216.*

Rectification of registers by Court.

72.—(1) The Court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit. *217.*

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the Comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the Comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly (cf. **Act of 1883, sect. 90; and Act of 1888, sect. 23, as to the whole of this section**).

Powers and Duties of Comptroller.

Exercise of discretionary power by Comptroller.

73. Where any discretionary power is by or under this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard (**Act of 1883, sect. 94; and Trade Marks Act, 1905, sect. 73**).

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Power of Comptroller to take directions of law officers.

74. The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer for directions in the matter (**Act of 1883, sect. 95**).

Refusal to grant patent, &c., in certain cases.

75. The Comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality (**Act of 1883, sect. 86**).

Annual reports of Comptroller.

76. The Comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act (**Act of 1883, sect. 102**).

Evidence, &c.

Evidence before Comptroller.

77.—(1) Subject to rules under this Act in any proceeding under this Act before the Comptroller, the evidence shall be given by statutory declaration, in the absence of directions to the contrary; but in any case in which the Comptroller thinks it right so to do, he may take evidence vivâ voce in lieu of or in addition to evidence by declaration, or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit. *168.*

(2) In case any part of the evidence is taken vivâ voce, the Comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court (**The whole of this section is new**). *169.*

Certificate of Comptroller to be evidence.

78. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be 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 (**Act of 1883, sect. 96; and Trade Marks Act, 1905, sect. 73**). *386.*

Evidence of documents in Patent Office.

79. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals (**Act of 1883, sect. 89**; and **Trade Marks Act, 1905, sect. 73**). *385.*

Transmission of certified printed copies of specifications, &c.

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office. *386.*

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals (**Act of 1883, sect. 100**). *386.*

Applications and notices by post.

81. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by post (**Act of 1883, sect. 97**). *134.*

Excluded days.

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day (**Act of 1883, sect. 98**).

Declaration by infant, lunatic, &c.

83.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability. *135.*

(2) An appointment may be made by the Court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing (**Act of 1883, sect. 99**). *135.*

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

Register of Patent Agents.

Register of patent agents.

84.—(1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act (**Act of 1888, sect. 1, sub-sect. 1**).

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, One thousand eight hundred and eighty-eight, he had been bonâ fide practising as a patent agent, shall be entitled to be registered as a patent agent in pursuance of this Act (**Act of 1888, sect. 1, sub-sect. 3**).

(3) If any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds (**Act of 1888, sect. 1, sub-sect. 4**).

(4) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom (**Act of 1888, sect. 1, sub-sect. 5**).

Agents for patents.

85.—(1) Rules under this Act may authorise the Comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence, or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the Comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the Comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the Comptroller to refuse to recognise the company or firm as agent if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The Comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man

(The whole of this section is new).

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

Powers, &c., of Board of Trade.

86.—(1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act— Power for Board of Trade to make general rules.

(*a*) For regulating the practice of registration under this Act :

(*b*) For classifying goods for the purposes of designs :

(*c*) For making or requiring duplicates of specifications, drawings, and other documents :

(*d*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents :

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

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

(*g*) For regulating the keeping of the register of patent agents under this Act :

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

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the Comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules (**Act of 1883, sect. 101 ; and Act of 1888, sect. 1, sub-sect. 2**).

87.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or Proceedings of the Board of Trade.

before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified (**Act of 1883, sect. 25**).

Provision as to Order in Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order (**Act of 1883, sect. 104, sub-sect. 2**).

Offences.

Offences.

89.—(1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor (**Act of 1883, sect. 93**).

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds (**Act of 1883, sect. 105, sub-sect. 1**). *149.*

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design (**Act of 1883, sect. 105, sub-sect. 2**). *149.*

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on con-

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viction under the Summary Jurisdiction Acts to a fine not exceeding five pounds (**New**).

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds (**New**).

Unauthorised assumption of Royal Arms.

90.—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article (**New**).

(2) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such Arms to continue to use such trade mark (**Act of 1883, sect. 106**).

International and Colonial Arrangements.

International and Colonial arrangements.

91.—(1) If His Majesty is pleased to make any arrangement with the Government of any foreign State for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that State shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign State.

Provided that—

(*a*) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign State; and

(*b*) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country. *32.*

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(*a*) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(*b*) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design; or

(*c*) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905: Provided that—

(*a*) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign State, shall with the drawings (if any) be open to public inspection at the expiration of that period: and

(*b*) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4) *The provisions of this section shall apply only in the case of* those foreign States with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each State as the Order in Council continues in force with respect to that State (**Sub-sects 1, 2, 3, and 4 correspond with Act of 1883, sect. 103; Act of 1885, sect. 6; and Act of 1901, sect. 1, sub-sect. 2**).

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the order (**Act of 1883, sect. 104, sub-sect. 1**).

Definitions.

Provisions as to "the Court."

92.—(1) In this Act, unless the context otherwise requires, "the Court" means, subject to the provisions as to Scotland, Ireland, and

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the Isle of Man, the High Court in England (**Act of 1883, sect. 117, sub-sect. 1**).

(2) Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the Court, or a petition may be referred or presented to the Court, the appeal shall, subject to and in accordance with Rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final (**see the Patents Act, 1908, p. 453**), except in the case of an appeal from a decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed (**New**).

93. In this Act, unless the context otherwise requires,— Definitions.

"Law Officer" means the Attorney-General or Solicitor-General for England (**Act of 1883, sect. 93**):

"Prescribed" means prescribed by general rules under this Act (**Act of 1883, sect. 93**):

"British possession" does not include the Isle of Man or the Channel Islands (**Act of 1883, sect. 93**):

"Patent" means letters patent for an invention (**Act of 1883, sect. 93**):

"Patentee" means the person for the time being entitled to the benefit of a patent (**Act of 1883, sect. 93**):

"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 (**Act of 1883, sect. 93**):

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant (**Act of 1883, sect. 93**):

"Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined (**Act of 1883, sect. 93**): 54 Geo. 3, c. 56.

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"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural (**Act of 1883, sect. 93**):

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered (**Act of 1883, sect. 93**):

"Proprietor of a new and original design,"—

(*a*) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and

(*b*) Where any person acquires the design or the right to apply the design to any article, either exclusively of any person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(*c*) In any other case, means the author of the design; and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person (**Act of 1883, sect. 93**).

Application to Scotland, Ireland, and the Isle of Man.

Application to Scotland.

94. In the application of this Act to Scotland—

(1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the Court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts; and for the purposes of the provisions so applied "Court of Appeal" shall mean any Court to which such action is appealed (**Act of 1883, sect. 107**):

(2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff Court (**Act of 1883, sect. 108**):

(3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice

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existing at the commencement of this Act: **(Act of 1883, sect. 109, sub-sect. 1)**

(4) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court: **(Act of 1883, sect. 111, sub-sect, 1)**

(5) Notwithstanding anything in this Act, the expression "the Court" shall, as respects petitions for compulsory licences or revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the term of a patent mean such Lord Ordinary: **(New)**

(6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean Act of sederunt: **(New)**

(7) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification, shall be served on the Comptroller, and he shall rectify the register accordingly: **(Act of 1883, sect. 111, sub-sect. 2)**

(8) The expression "injunction" means "interdict" **(Act of 1883, sect. 46)**.

Application to Ireland.

95. In the application of this Act to Ireland—

(1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only: **(Act of 1883, sect. 110)**

(2) The provisions of this Act conferring a special jurisdiction on the Court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Ireland in any proceedings relating to patents or to designs; and with reference to any such proceedings the term "the Court" means the High Court in Ireland: **(Act of 1883, sect. 111, sub-sect. 1)**

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order,

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decree, or other authority for the rectification shall be served on the Comptroller, and he shall rectify the register accordingly: **(Act of 1883, sect. 111, sub-sect. 2)**

Isle of Man.

96. This Act shall extend to the Isle of Man, subject to the following modifications:—

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those Courts:

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court:

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted **(Act of 1883, sect. 112).**

Repeal, Savings, and Short Title.

Saving for prerogative.

97. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof **(Act of 1883, sect. 117).**

Repeal and savings.

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

(*a*) As respects the enactments mentioned in Part I. of that Schedule, as from the commencement of this Act;

(*b*) As respects the enactments mentioned in Part II. of that Schedule, as from the date when Rules of the Supreme Court regulating the matters dealt with in those enactments come into operation;

(*c*) As respects the enactments mentioned in Part III. of that schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation;

and the enactments mentioned in Part II. and Part III. of that

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Schedule shall, until so repealed, have effect as if they formed part of this Act:

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

Short title and commencement.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight.

SCHEDULES.

Section 65.

FIRST SCHEDULE.

FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

(a) Up to sealing.

	£	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 the sealing of the patent in respect of investigations as to anticipation				1	0	0
(b) Further before end of four years from date of patent.						
On certificate of renewal.....				50	0	0
(c) Further before end of eight years from date of patent.						
On certificate of renewal.....				100	0	0
Or in lieu of the fees of £50 and £100 the following annual fees :—						
Before the expiration of the 4th year from the date of the patent ...				10	0	0
" " 5th " " " ...				10	0	0
" " 6th " " " ...				10	0	0
" " 7th " " " ...				10	0	0
" " 8th " " " ...				15	0	0
" " 9th " " " ...				15	0	0
" " 10th " " " ...				20	0	0
" " 11th " " " ...				20	0	0
" " 12th " " " ...				20	0	0
" " 13th " " " ...				20	0	0

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

Section 98.

SECOND SCHEDULE.

ENACTMENTS REPEALED.

PART I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except sub-sections (5), (6), and (7) of section twenty-six, section twenty-nine, sub-sections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886 -	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. 7, c. 18.	The Patents Act, 1901 -	The whole Act.
2 Edw. 7, c. 34.	The Patents Act, 1902 -	The whole Act.
7 Edw. 7, c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (5), (6), and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (2) and (3) of section forty-seven and section forty-eight.

N.B.—Figures printed in italic type refer to the pages of the text in which the subject-matter of the section or sub-section is dealt with.

THE PATENTS AND DESIGNS ACT, 1908.

An Act to explain section ninety-two of the Patents and Designs Act, 1907. [1st August, 1908.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Explanation of 7 Edw. 7. c. 29, s. 92.

1. It is hereby declared that so much of sub-section (2) of section ninety-two of the Patents and Designs Act, 1907, as provides that the decision of a judge of the High Court to whom a petition is presented by virtue of that Act is to be final does not apply in the case of a petition for the revocation of a patent under section twenty-five of that Act.

Short title.

2. This Act may be cited as the Patents and Designs Act, 1908.

PATENTS, DESIGNS AND TRADE MARKS ACTS, 1883—1902, CONSOLIDATED.

(To Show the State oe the Law Prior to the Act of 1907.)

Being—

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.

48 & 49 Vict. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

49 and 50 Vict. c. 37.—An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.

51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Acts, 1883.

1 Ed. VII. c. 18.—An Act to amend the law with reference to International Arrangements for Patents.

2 Ed. VII. c. 34.—An Act to amend the law with reference to applications for patents and compulsory licences, and other matters connected therewith.

Note.—The general test of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in heavier type. The amending Act and section are quoted in the margin.

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords, spiritual and temporal, and Commons, in the present Parliament assembled, and by the authority of the same, as follows:—

PART I.—Preliminary.

Short title.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

Division of Act into parts.

2. This Act is divided into parts, as follows:—

Part I.—Preliminary.
Part II.—Patents.
Part III.—Designs.
Part IV.—Trade Marks.
Part V.—General.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the 31st day of December, 1883. Commencement of Act.

PART II.—PATENTS.

Application for and Grant of Patent.

4.—(1) Any person, whether a British subject or not, may make an application for a patent. Persons entitled to apply for patent.

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

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. *Act*, 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. Application and specification.

(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. Declaration.

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*, 1885, s. 2.

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required. Provisional specification.

(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. Complete specification.

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. The same drawings may accompany both specifications. *Act*, 1886, s. 2.

(5) A specification, whether provisional or complete, must com-

mence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

Reference of application to examiner.

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

Power for Comptroller to refuse application or require amendment.

Repealed *Act*, 1888, *s.* 2.

[**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 require that the application, specification, or drawings be amended before he proceeds with the application.*

(2) *Where the Comptroller 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 has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the Comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the Comptroller shall give notice to the applicants that he has so reported.*

(6) *Where the examiner reports in the affirmative, the Comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant.*]

Power of Comptroller to refuse application or require amendment.

Act, 1888, *s.* 2.

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) When 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 Comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

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

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

Time for leaving complete specification.

8.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within (*nine*) **six** months from the date of application.

Act, 1885, *s.* 3.

A complete specification may be left within such extended time, not exceeding one month after the said (*nine*) six months, as the Comptroller may on payment of the prescribed fee allow. (Time reduced to six months by Act, 1902, section one, subsection eight.)

When specification deemed abandoned.

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

Comparison of provisional and complete specification.

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

Power of Comptroller to refuse until amended.

(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.

Power of 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.

When specification void.

(4) Unless a complete specification is accepted within twelve

months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

Act 1885, *s.* 3. **A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the Comptroller may on payment of the prescribed fee allow.**

Reports of examiners to be private. *Act*, 1888, *s.* 3.

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

The Act of 1902. **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.**

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

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

(4) The provisions of sub-section five of section nine of the principal Act, as amended by any subsequent enactment, shall apply to reports under this section.

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

(6) If the Comptroller is not so satisfied, he shall, after hearing

the applicant, and unless the objection be removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what, prior specifications ought to be made in the specification by way of notice to the public.

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

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

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

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

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

Limitation as to anticipation.

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.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings (if any) shall be open to public inspection.

Opposition to grant of patent.

Time and grounds for.

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*

Repealed *Act*, 1888, s. 4.

ground of an examiner having reported to the Comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application], **or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,** but on no other ground.

Act, 1888, *s.* 4.

After notice Comptroller to decide.

(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.

Or on appeal, 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.

Who may obtain expert's assistance.

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

Sealing of patent.

When sealed.

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.

Great Seal abolished for patents.

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

Time for sealing.

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

Exceptions to limit.

(a) For legal proceedings.

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

(b) When applicant dead.

(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.

Extension of time for sealing.

Act, 1885, *s.* 3.

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine months and twelve months respectively, as the Comptroller may, on payment of the prescribed fee, allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be

allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Date of patent.

13. Every patent shall be dated and sealed as of the day of the application: provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

Application abandoned, specification not to be published. *Act*, 1885, *s.* 4.

When 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 [*this did not apply to applications under sect.* 103; *see Edw. VII. c.* 181 (1)].

Provisional Protection.

Provisional protection.

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

Protection by Complete Specification.

Effect of acceptance of complete specification.

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

Patent.

Extent of patent

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

Term of patent.

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

Ceases on failure of payments.

(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.

Exception by application to Comptroller.

(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.

Extension of time for payment upon terms.

(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) Period of extension.

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

(b) Damages for infringement in the interval.

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

Amendment of Specification.

Amendment of specification.

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

Advertisement of amendment and notice of opposition to be given.

(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.

Where notice given Comptroller decides.

(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.

Appeal to 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.

Where no notice Comptroller determines conditions of amendment.

(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. Appeal to law officer.

(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. No amendment allowed so as to enlarge or alter materially specification.

(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. Leave conclusive except in case of fraud; amendment forms part of specification.

(10) [*The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*] Repealed *Act*, 1888, *s.* 5.

(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.** Proceedings pending. *Act*, 1888, *s.* 5.

19.—(1) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed. Power to disclaim part of invention during action, &c.

20. Where an amendment by way of disclaimer, correction, or explanation has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge. Restriction on recovery of damages.

21. Every amendment of a specification shall be advertised in the prescribed manner. Advertisement of amendment.

Compulsory Licences.

22. *If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms*— Repealed. See Act of 1902, s. 3, substituted therefor.

(a) *The patent is not being worked in the United Kingdom; or*

(b) *The reasonable requirements of the public with respect to the invention cannot be supplied; or*

(c) *Any person is prevented from working or using to the best advantage an invention of which he is possessed,*

the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

The Act of 1902.

3. Section twenty-two of the principal Act (relating to the grant of compulsory licences by the Board of Trade) is hereby repealed, and the following provisions shall be substituted therefor:—

Amendment of law relating to compulsory licences.

(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent;

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

(3) Where any such petition is referred by the Board of Trade to the Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licences on such terms as the said Committee may think just, or, if the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by Order in Council:

Provided that no order of revocation shall be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default;

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard;

(5) If it is proved to the satisfaction of the Judicial Committee that the patent is worked or that the patented article is,

manufactured exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public have been satisfied the petitioner shall be entitled either to an order for a compulsory licence or, subject to the above proviso, to an order for the revocation of the patent;

(6) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, (a) any existing industry or the establishment of any new industry is unfairly prejudiced, or (b) the demand for the patented article is not reasonably met;

(7) An Order in Council directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceedings;

(8) His Majesty in Council may make rules of procedure and practice for regulating proceedings before the Judicial Committee under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council or any order made by the Judicial Committee under this Act may be enforced by the High Court as if it were an order of the High Court;

(9) The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but in awarding costs on any application for the grant of a licence the Judicial Committee may have regard to any previous request for, or offer of, a licence made either before or after the application to the Committee;

(10) For the purposes of this section three members of the Judicial Committee shall constitute a quorum;

(11) This section shall apply to patents granted before as well as after the commencement of this Act.

Register of Patents.

Register of patents.

23.—(1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and

Where to be kept, and contents.

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.

Is evidence.

(2) The register of patents shall be primâ facie evidence of any matters by this Act directed or authorised to be inserted therein.

Copies for filing.

(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 (see "Instructions to Applicants" and the Patents Rules, 1903 and 1905).

Fees payable.

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.

Power to reduce fees.

(2) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

Extension of Term of Patent.

Extension of term of patent on petition to Queen in Council.

25.—(1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

When applied for.

Entry of caveat.

(2) Any person may enter a caveat, addressed to the registrar of the Council at the Council office, against the extension.

Privy Council jurisdiction.

(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.

Powers of Judicial Committee.

(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. On their report extension granted on conditions.

(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. Power to make rules for such proceedings.

(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. Costs.

Revocation.

26.—(1) The proceeding by scire facies to repeal a patent is hereby abolished. Abolition of scire facias.

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

(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. How revocation obtained. Grounds of revocation.

(4) A petition for revocation of a patent may be presented by— Petition for revocation, who may present.

(a) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

(b) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

(c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims:

(d) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee:

(e) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5) The plaintiff must deliver with his petition particulars of the Plaintiff must deliver and be

Bound by particulars.

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.

Amendment of particulars.

(6) Particulars may be from time to time amended by leave of the Court or a judge.

Patentee though defendant has privileges of plaintiff at trial.

(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.

Where patent revoked for fraud, first true inventor may obtain patent.

(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 provision of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

Crown.

Patent to bind Crown.

27.—(1) A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.

Exceptions.

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

Legal Proceedings.

Hearing with assessor.

By Court.

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.

Court of Appeal or Privy Council may sit with assessors.

(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.

Assessor s fees.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

Delivery of particulars of breaches;

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.

of objections.

(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.

Grounds must be stated.

(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.

Evidence must not go beyond particulars.

(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.

Amendment.

(5) Particulars delivered may be, from time to time, amended, by leave of the Court or a judge.

Costs.

(6) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them, unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.

Order for inspection, &c. in action.

30. In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a judge may see fit.

Certificate and validity questioned.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of a patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

Remedy in case of groundless threats of legal proceedings.

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

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

Miscellaneous.

Patent for one invention only.

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

Patent on application of representative of deceased inventor.

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

Time and contents of application.

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

Patent to first inventor not invalidated by application in fraud of him.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Assignment for particular places.

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

Loss or destruction of patent.

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

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may, from time to time, make, alter, and rescind rules, regulating references and appeals to the law officers, and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.

Exhibition at industrial or international exhibition not to prejudice patent rights.

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibi-

tion 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.

Conditions: (a) Notice; (b) Patent must be applied for.

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

It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections 39 and 57 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 condition, 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.

Protection of patents and designs exhibited at international exhibitions. *Act*, 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.

Publication of illustrated journal, indexes, &c.

(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.

Copies to be on sale.

(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.

Continuation of publication.

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.

Patent Museum.

42. The Department of Science and Art may at any time require a

Power to require models on payments.

patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels in British waters.

43.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

Exception.

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

Assignment of Secretary for War of certain inventions.

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

Extent of 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.

Power of Secretary of State for War to keep invention secret on ground that it is in public interest to do so.

(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.

In which case specifications

(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. and documents are sealed up.

(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. For term of patent

(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. Delivery of packet under secretary of state's authority during term.

(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. At expiration.

(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. Foregoing sub-sections to apply where patent applied for but specifications not published.

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

(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. No copy of any secret specifications to be made public.

(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. Power of secretary of state to waive benefit of section.

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

Existing Patents.

Provisions respecting existing patents.

45.—(1) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences.

(3) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto, if this Act had not been passed.

Documents left at Great Seal Patent Office deemed left at Patent Office on commencement of this Act.

(4) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

Definitions.

Definitions of "Patent;" "Patentee;" "Invention;"

46. In and for the purposes of this Act—

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter 3, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention.

"Injunction" in Scotland.

In Scotland "injunction" means "interdict."

PARTS III. AND IV. RELATE TO DESIGNS AND TRADE MARKS RESPECTIVELY.

PART V.—GENERAL.

Patent Office and Proceedings thereat.

Patent Office.

82.—(1) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as the Patent Office.

(2) Until a new Patent Office is provided, the offices of the Commissioners of Patents for inventions and for the registration of

designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3) The Patent Office shall be under the immediate control of an officer called the Comptroller-General of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4) Any act or thing directed to be done by or to the Comptroller may, *in his absence*, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

"In his absence." Repealed by Act, 1902, s. 4

Officers and clerks.

83.—(1) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the Comptroller-General of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of Patent Office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of any trust expressed, implied or constructive.

Refusal to seal, &c., in certain cases.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design or trade mark, in the register of patents, designs or trade marks, as the case may be. The person for the time being entered in the register of patents, designs or trade marks, as proprietor of a patent, copyright in a design or trade mark, as the case may be, shall, subject to **the provisions of this Act and to** any rights 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.

Act, 1888, *s.* 21.

Inspection of and extracts from registers.
Act, 1888, s. 22.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sealed copies to be received in evidence.

89. Printed or written copies, purported to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.
Act, 1888, s. 23.

90.—(1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court 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 connection with an application for a patent, or for registration of a design or trade mark; or

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design or trade mark;

(c) Cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

Act, 1888, s. 24.

(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any

particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.

Alteration of registered mark.

92.—(1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

Notice to be given.

(2) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

Comptroller to alter in accordance with order.

(3) the Court grants leave, the Comptroller shall, on proof thereo and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Exercise of discretionary power by Comptroller.

94. Where any discretionary power is by this Act given to the Comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Power of Comptroller to take directions of law officers.

95. The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for direction in the matter.

Certificate of Comptroller to be evidence.

96. A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Applications and notices by post.

97.—(1) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

Proof.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as to days for leaving documents at Office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document, or to pay such fee, on the day next following such excluded day, or days if two or more of them occur consecutively.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments, left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

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

(a) For regulating the practice of registration under this Act;

(b) For classifying goods for the purposes of designs and trade marks:

(c) For making or requiring duplicates of specifications, amendments, drawings, 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. Alteration of forms.

(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. General rules :

(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. to be laid before Parliament and advertised.

(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. Annual reports of Comptroller.

102a.—(1) All things required or authorised under this Act to Proceedings of Board of Trade.

Act, 1888, s. 25.

be done by, to, or before the Board of Trade, may be done by, to, or before the President, or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate signed by the President of the Board of Trade that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks.

103.—(1) If her Majesty is pleased to make any arrangement with the government or governments of any foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such State shall be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the [*date of protection obtained*] **date of the application** in such foreign State.

Act, 1885, s. 6.

Time.

The Act of 1901, s. 1, sub-s. 1.

Provided that his application is made, in the case of a patent within (*seven*) **twelve** months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign State with which the arrangement is in force.

No protection prior to specification or registration.

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.

The Act of 1901, s. 1, sub-s. 2.

(2) **An application under that section** (*Sect.* 103) **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.**

Publication at or use in exhibition not to invalidate patent or trade mark.

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:

Application under this section to be made in same manner as ordinary application.

(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 [*but see Act of* 1901, *sect.* 1, *sub-sect.* 2, *above*]: 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:

Application of this section.

(4) The provisions of this section shall apply only in the case of those foreign States with respect to which her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State.

Provision for colonies and India.

104.—(1) Where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for her Majesty, from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

Effect of Order in Council.

(2) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105.—(1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

Definition of false representation under this section.

(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.

Penalty on unauthorised assumption of royal arms.

106. Any person who, without the authority of her Majesty, or any of the royal family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland, Ireland, &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

Definition of "Court of Appeal."

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109.—(1) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

Service in Scotland.

(2) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

General saving for jurisdiction of Courts.

111.—(1) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the term "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. Rectification of register.

112. This Act shall extend to the Isle of Man, and— Isle of Man.

(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: Jurisdiction of 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: Punishments.

(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. Offences and penalties treated as in England under this Act.

112a. "The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly. Jurisdiction of Lancashire Palatine Court. *Act.* 1888. *s.* 26.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

Repeal; Transitional Provisions; Savings.

113. The enactments described in the third schedule to this Act are hereby repealed. But this repeal of enactments shall not— Repeal and saving for past operation of repealed enactments, &c.

(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, Exceptions.

accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Former registers to be deemed continued.

114.—(1) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative

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

General Definitions.

General definitions.

117.—(1) In and for the purposes of this Act, unless the context otherwise requires,—

"Person." "Person" includes a body corporate:

"Court." "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." "Law officer" means her Majesty's Attorney-General or Solicitor-General for England:

"Treasury." "The Treasury" means the Commissioners of her Majesty's Treasury:

"Comptroller" means the Comptroller-General of patents, designs, and trade marks: "Comptroller."

"Prescribed" means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act: "Prescribed."

"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: "British possession."

"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. "Legislature."

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. "Summary conviction" as applied to Ireland.

Register of patent agents. *Act*, 1888, *s.* 1.

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.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

Forms A, B and C of this First Schedule are altered by the substitution of those given in the Patent Rules, 1903 (*post*).

Section 113.

THE THIRD SCHEDULE.

Enactments Repealed.

21 James 1, c. 3 (1623).—The Statute of Monopolies. In part; namely, sections 10, 11 and 12.

5 & 6 Will. 4. c. 62 (1835) [In part].—The Statutory Declarations Act, 1835. In part; namely, section 11.

5 & 6 Will. 4, c. 83 (1835).—An Act to amend the law touching letters patent for inventions.

2 & 3 Vict. c. 67 (1839).—An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."

5 & 6 Vict. c. 100 (1842).—An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.

6 & 7 Vict. c. 65 (1843).—An Act to amend the laws relating to the copyright of designs.

7 & 8 Vict. c. 69* (1844) [In part].—An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled "An Act for the better administration of justice in his Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely, sections 2 to 5, both included.

13 & 14 Vict. c. 104 (1850).—An Act to extend and amend the Acts relating to the copyright of designs.

15 & 16 Vict. c. 83 (1852).—The Patent Law Amendment Act, 1852.

16 & 17 Vict. c. 5 (1853).—An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.

16 & 17 Vict. c. 115 (1853).—An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.

21 & 22 Vict. c. 70 (1858).—An Act to amend the Act of the fifth and sixth years of her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.

22 Vict. c. 13 (1859).—An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.

24 & 25 Vict. c. 73 (1861).—An Act to amend the law relating to the copyright of designs.

28 & 29 Vict. c. 3 (1865).—The Industrial Exhibitions Act, 1865.

33 & 34 Vict. c. 27 (1870).—The Protection of Inventions Act, 1870.

* *Note.*—Sects. 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

33 & 34 Vict. c. 97 (1870).—The Stamp Act, 1870. In part; namely, section 65, and in the Schedule the words and figures, "Certificate of the registration of a design . . £5 0 0. And see section 65."

38 & 39 Vict. c. 91 (1875).— The Trade Marks Registration Act, 1875.

38 & 39 Vict. c. 93 (1875).—The Copyright of Designs Act, 1875.

39 & 40 Vict. c. 33 (1876).—The Trade Marks Registration Amendment Act, 1876.

40 & 41 Vict. c. 37 (1877).—The Trade Marks Registration Extension Act, 1877.

43 & 44 Vict. c. 10 (1880).—The Great Seal Act, 1880. In part; namely, section 5.

45 & 46 Vict. c. 72 (1882).—The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely, section 16.

PATENTS, ETC. ACT, 1885.

(48 & 49 Vict. c. 63.)

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

BE IT ENACTED by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment of sect. 5, sub-sect. 2.

2. Whereas sub-section 2 of section 5 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 2 of section 5 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.

Amendment of sects. 8 and 9. Time reduced to six months by Act of 1902.

3. Whereas under the principal Act a complete specification is required (by section 8) to be left within (*nine*) **six** months, and (by section 9) to be accepted within twelve months, from the date of application, and a patent is required by section 12 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*) **six** and twelve months respectively as the Comptroller may on the 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.

Abandoned application.

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

Joint patent.

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

Amendment of sect. 103, sub-sect. 1.

6. In sub-section 1 of section 103 of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

PATENTS, ETC. 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.*

[26th August 1886.]

WHEREAS by section 5 of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:

Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Title.

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.

Explanation of sect. 5, sub-sect. 4, of principal Act.

2. The requirement of sub-section 4 of section 5 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.

Extension of sect. 39 of principal Act.

3. Whereas by section 39 of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section 57 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 39 and 57 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, ETC. ACT, 1888.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[24th December, 1888.]

46 & 47 Vict. c. 57.

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 by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same as follows:

Register of patent agents.

1.—(1) After the first day of July, One thousand eight hundred and eighty-nine, a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act [see Register of Patent Agents Rules].

(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 101 of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bonâ fide practising as a patent agent, shall be entitled to be registered as a patent agent in pursuance of this Act.

(4) If any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Amendments of 46 & 47 Vict. 57.

S. 7 as to applications.

2. For section seven of the principal Act the following section shall be substituted, namely:—

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

S. 9, as to disclosure of reports of examiners.

3. In sub-section 5 of section 9 of the principal Act the words "other than an appeal to the law officer under this Act" shall be omitted.

S. 11, as to opposition to grant of patent.

4. In sub-section 1 of section 11 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."

S. 18, as to amended specifications.

5. For sub-section 10 of section 18 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."

(*Sections* 6—24 *refer to designs and trade marks only.*)

Proceedings of Board of Trade.

25. After section 102 of the principal Act the following section shall be added and numbered 102A; namely,

"(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to,

or before the President or a secretary or an assistant secretary of the Board.

"(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised on 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."

Jurisdiction of Lancashire Palatine Court.

26. After section 112 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."

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Commencement of 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.

Short title.

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.

THE PATENTS ACT, 1901.

(1 Ed. VII. c. 18.)

An Act to amend the Law with reference to International Arrangements for Patents. [17th August, 1901.]

BE IT ENACTED by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—

International arrangements 46 & 47 Vict. c. 57.

1.—(1) In the first proviso to sub-section one of section one hundred and three 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.

Short title, construction, and commencement.

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, one thousand nine hundred and two.

THE PATENTS ACT, 1902.

(2 Ed. VII. c. 34.)

An Act to amend the Law with reference to Applications for Patents and Compulsory Licences, and other matters connected therewith.

[18th December, 1902.]

BE IT ENACTED by the King's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Examination of previous specifications in United Kingdom on applications for patents. 46 & 47 Vict. c. 57.

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.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

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

(4) The provisions of sub-section five of section nine of the principal Act, as amended by any subsequent enactment, shall apply to reports under this section.

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

(6) If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection be removed by amending

the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what, prior specifications ought to be made in the specification by way of notice to the public.

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

(8) Section eight of the principal Act and section three 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. 48 & 49 Vict. c. 63.

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

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

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

Limitation as to anticipation.

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.*

Amendment of law relating to compulsory licences.

3. Section twenty-two 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;

(2) The Board of Trade shall cousider the petition, and if the parties do not come to an arrangement between themselves, the Board of Trade, if satisfied that a primâ facie case has been made out, shall refer the petition to the Judicial

Committee of the Privy Council, and, if the Board are not so satisfied, they may dismiss the petition ;

(3) Where any such petition is referred by the Board of Trade to the Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licences on such terms as the said Committee may think just, or, if the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by Order in Council ;

Provided that no order of revocation shall be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default ;

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard ;

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

(6) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, (a) any existing industry or the establishment of any new industry is unfairly prejudiced, or (b) the demand for the patented article is not reasonably met ;

(7) An Order in Council directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding ;

(8) His Majesty in Council may make rules of procedure and practice for regulating proceedings before the Judicial

Committee under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council or any order made by the Judicial Committee under this Act may be enforced by the High Court as if it were an order of the High Court;

(9) The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but in awarding costs on any application for the grant of a licence the Judicial Committee may have regard to any previous request for, or offer of, a licence made either before or after the application to the Committee;

(10) For the purposes of this section three members of the Judicial Committee shall constitute a quorum;

(11) This section shall apply to patents granted before as well as after the commencement of this Act.

Performance of Comptroller's duties.

4. In sub-section four of section eighty-two 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.

Short title and construction.

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.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

[*Ratifications exchanged at Paris, June* 6, 1884.]

ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland, constitute themselves into a union for the protection of industrial property.

ARTICLE II.

The subjects or citizens of each of the contracting States shall, in all the other States of the union, as regards patents, industrial designs or models, trade-marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

ARTICLE III.

Subjects or citizens of States not forming part of the union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the union, shall be assimilated to the subjects or citizens of the contracting States.

ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

ARTICLE V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ARTICLE VI.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

ARTICLE VII.

The nature of the goods on which the trade mark is to be used can, in no case, be an obstacle to the registration of the trade mark.

ARTICLE VIII.

A trade name shall be protected in all countries of the union, without necessity of registration, whether it form part or not of a trade mark.

ARTICLE IX.

All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

ARTICLE X.

The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of

origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods established in the locality falsely designated as the place of origin, shall be deemed an interested party.

ARTICLE XI.

The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade marks for articles exhibited at official or officially recognised international exhibitions.

ARTICLE XII.

Each of the high contracting parties agrees to establish a special Government department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

ARTICLE XIII.

An international office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the contracting States, shall be placed under the high authority of the central administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the union.

ARTICLE XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the union.

To this end conferences shall be successively held in one of the contracting States by delegates of the said States. The next meeting shall take place in 1885 at Rome.

ARTICLE XV.

It is agreed that the high contracting parties respectfully reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present Convention.

ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and the admission to all the advantages stipulated by the present Convention.

ARTICLE XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other contracting parties.

ARTICLE XIX.

The present Convention shall be ratified, and the ratification exchanged in Paris, within one year at the latest.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris, the 20th March, 1883.

(Signed)

(*Here follow the signatures of the Plenipotentiaries.*)

II.—*Final Protocol.*

On proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland for the protection of industrial property, the undersigned Plenipotentiaries have agreed as follows :—

(1) The words "industrial property" are to be understood in their

broadest sense; they are not to apply simply to industrial products, properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.) and to mineral products employed in commerce (mineral waters, &c.).

(2) Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the contracting States, such as importation patents, improvement patents, &c.

(3) The last paragraph of Article II. does not affect the legislation of each of the contracting States as regards the procedure to be followed before the tribunals and the competence of those tribunals.

(4) Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the union from the fact alone that it does not satisfy, in regard to the signs comprising it, the conditions of the legislation of that State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

(5) The organisation of the special department for industrial property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

(6) The common expenses of the international office instituted by virtue of Article XIII. are in no case to exceed for a single year a total sum representing an average of 2,000 francs for each contracting State.

To determine the part which each State should contribute to this total of expenses the contracting States, and those which may afterwards join the union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely:—

1st class	25 units.
2nd class	20 „
3rd class	15 „
4th class	10 „
5th class	5 „
6th class	3 „

These coefficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the

number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The contracting States are classed as follows with regard to the division of expense :—

1st class	France, Italy.
2nd class	Spain.
3rd class	Belgium, Brazil, Portugal, Switzerland.
4th class	Holland.
5th class	Servia.
6th class	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the international office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The international office will centralise information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement, which will be distributed to all the administrations. It will interest itself in all matters of common utility to the union, and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language dealing with questions regarding the object of the union.

The numbers of this paper, as well as all the documents published by the international office, will be circulated among the administrations of the States of the union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said administrations or by societies or private persons, will be paid for separately.

The international office shall at all times hold itself at the service of members of the union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The Administration of the country in which the next conference is to be held will make preparations for the transactions of that conference, with the assistance of the international office.

The director of the international office will be present at the meetings of the conferences and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the union.

The official language of the international office will be French.

(7) The present final protocol, which shall be ratified together with

the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as, the said Convention.

In witness whereof the undersigned Plenipotentiaries have drawn up the present protocol.

(Signed)

(*Here follow the signatures of the Plenipotentiaries.*)

III.—*Accession of Her Majesty's Government to the Convention signed at Paris, March* 20, 1883.

The undersigned, Ambassador Extraordinary and Plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that Her Britannic Majesty, having had the International Convention for the protection of industrial property, concluded at Paris on the 20th March, 1883, and the Protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that Convention to States not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the protection of industrial property, and to the said protocol, which are to be considered as inserted word for word in the present declaration, and formally engages, as far as regards the President of the French Republic and the other high contracting parties, to co-operate on her part in the execution of the stipulations contained in the Convention and protocol aforesaid.

The undersigned makes this declaration on the part of Her Britannic Majesty with the express understanding that power is reserved to Her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's Government.

In witness whereof the undersigned, duly authorised, has signed the present declaration of accession, and has affixed thereto the seal of his arms.

Done at Paris on the 17th day of March, 1884.

(L.S.) (Signed) LYONS.

IV.—*Declaration of Acceptance of Accession.*

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland having acceded to the International Convention relative

to the protection of industrial property concluded at Paris, 20th March, 1883, together with a protocol dated the same day, by the declaration of accession delivered by her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic, the text of which declaration is, word for word, as follows:—

(Here is inserted the text of No. III. in English.)

The President of the French Republic has authorised the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other high contracting parties, to assist in the accomplishment of the obligations stipulated in the Convention and the protocol thereto annexed which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the undersigned, duly authorised, has drawn up the present declaration of acceptance and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.) (Signed) JULES FERRY.

ADDITIONAL ACT MODIFYING THE INDUSTRIAL PROPERTY CONVENTION OF MARCH 20, 1883.

SIGNED AT BRUSSELS, DECEMBER 14, 1900.

ARTICLE I.

The International Convention of March 20, 1883, shall be modified as follows:—

1. Article III. of the Convention shall run as follows:—

"Art. III. The subjects or citizens of states which are not parties to the union shall be assimilated to the subjects or citizens of the contracting states, provided that they are domiciled in or have industrial or commercial establishments, real and effective, in the territory of one of the states of the union."

2. Article IV shall run as follows:—

"Art. IV. Any person who shall have duly applied for a patent, industrial design, or model or trade mark in one of the contracting states, shall enjoy, in order to admit of such request being lodged in the other states, during the periods of time mentioned below, a right of priority, the rights of third parties being reserved.

"Consequently, subsequent registration in one of the other states of the union, before the expiration of such periods of time, shall not be invalidated by any acts accomplished in the interval—either, for instance, by another registration, by the publication of the invention, or by the working of it, by the sale of patterns of the design or model, or by the use of the trade mark.

"The above-mentioned periods of time during which priority is guaranteed shall be twelve months for patents with respect to inventions, and four months for patents for industrial designs or models, as well as for trade or merchandise marks."

3. There shall be inserted in the Convention an Article IV. *bis*, in the following terms:—

"Art. IV. *bis*. Patents applied for in the various contracting states by persons admitted to the benefits of the Convention in the terms of Articles II. and III., shall be independent of the patents obtained for the same invention in the other states, whether such states be or be not parties to the union.

"This stipulation shall apply to patents already existing at the time when it shall come into effect.

"The same stipulation shall apply, in the case of the accession of

new states, with regard to patents in existence, either on one side or the other, at the time of accession."

4. The two following paragraphs shall be added to Article IX. :—

"In states the laws of which do not admit of seizure upon importation, prohibition of importation may take the place of such seizure.

"The authorities shall not be compelled to effect the seizure in the case of goods in transit."

5. Article X. shall run as follows :—

"Art. X. The stipulations of the preceding Article shall be applicable to every production which may falsely bear as indication of origin the name of a specified locality, when such indication shall be joined to a trade name of a fictitious character or used with intent to defraud.

"Any producer, manufacturer, or trader engaged in the production, manufacture, or trade of such goods, and established either in the locality falsely designated as the place of origin, or in the district where the locality is situated, is to be deemed a party concerned."

6. There shall be inserted in the Convention an Article X. *bis*, in the terms following :—

"Art. X. *bis*. Persons resorting to the countries referred to in the Convention (Articles II. and III.) shall enjoy in all the states of the union the protection accorded to nationals against dishonest competition."

7. Article XI. shall run as follows :—

"Art. XI. The high contracting parties shall, in conformity with the legislation of each country, accord temporary protection to inventions susceptible of being patented, and to industrial designs or models, as well as to trade marks or merchandise marks, in respect of products which shall be exhibited at official or officially recognised international exhibitions held in the territory of one of them."

8. Article XIV. shall run as follows :—

"Art. XIV. The present Convention shall be submitted to periodical revisions with a view to the introduction of amendments calculated to improve the system of the union.

"For this purpose, conferences shall be held successively, in one of the contracting states, between the delegates of the said states."

9. Article XVI. shall run as follows :—

"Art. XVI. States which are not parties to the present Convention shall be allowed to accede to it upon their request.

"The accession shall be notified through the diplomatic channel to

the Government of the Swiss Confederation, and by the latter to all the other states.

"It shall entail, as a matter of right, accession to all the clauses, as well as admission to all the advantages stipulated in the present Convention, and shall take effect one month after the dispatch of the notification by the Swiss Government to the other states of the union, unless a subsequent date have been indicated by the acceding state."

ARTICLE II.

The final protocol annexed to the International Convention of March 20, 1883, shall be completed by the addition of No. 3 *bis* in the following terms:—

"3 *bis*. The patent, in each country, shall not be liable to forfeiture on account of failure to utilise it, until after the expiration of at least three years from the date of the deposit of the application in the country concerned, and only provided the patentee cannot show reasonable cause for his inaction."

ARTICLE III.

The present additional Act shall have the same value and duration as the Convention of March 20, 1883.

It shall be ratified, and the ratifications shall be deposited at the Ministry for Foreign Affairs, Brussels, as soon as possible, and at the latest within a period of eighteen months from the date of signature.

It shall come into force three months after the protocol of deposit shall have been closed.

In witness whereof the respective plenipotentiaries have signed the present additional Act.

Done at Brussels, in a single copy, December 14, 1900.

(*Here follow the signatures of the Plenipotentiaries.*)

Procès-Verbal.

The contracting parties having unanimously agreed that the exchange of the ratifications of the additional Act to the Convention of March 20, 1883, signed at Brussels on December 14, 1900, shall be effected by means of the deposit of the respective instruments in the archives of the Belgian Ministry for Foreign Affairs, the present protocol recording the deposit has been, for this purpose, drawn up at the Ministry for Foreign Affairs this 3rd day of May, 1901.

(Signed)
LAWRENCE TOWNSEND.

On this day the ratification of the President of the United States of America has been deposited:—

In succession have been deposited.

(Signed)
JULES BOREL.

On the 5th August, 1901, the ratification of the Swiss Federal Council.

(Signed)
F. G. SCHACK DE BROCKDORFF.

On the 10th October, 1901, the ratification of His Majesty the King of Denmark.

(Signed)
CTE. DE TOVAR.

On the 5th November, 1901, the ratification of His Majesty the King of Portugal and the Algarves.

(Signed)
CONSTANTINE PHIPPS.

On the 6th December, 1901, the ratification of His Majesty the King of the United Kingdom of Great Britain and Ireland and of the British Dominions beyond the Seas, Emperor of India.

(Signed)
P. DE FAVEREAU.

On the 10th December, 1901, the ratification of His Majesty the King of the Belgians.

(Signed)
R. CANTAGALLI.

On the 12th December, 1901, the ratification of His Majesty the King of Italy.

(Signed)
S. MATSUGATA.

On the 21st April, 1902, the ratification of His Majesty the Emperor of Japan.

(Signed)
A. GERARD.

On the 23rd May, 1902, the ratifications of the President of the French Republic and of the Government of Tunis.

(Signed)
CTE. WRANGEL.

On the 5th June, 1902, the ratification of His Majesty the King of Sweden and Norway, on behalf of Sweden.

(Signed)
CTE. WRANGEL.

On the same day, the ratifications of His Majesty the King of Sweden and Norway, on behalf of Norway.

(Signed)
R. DE PESTEL.

On the 10th June, 1902, the ratification of Her Majesty the Queen of the Netherlands.

In conformity with Article 3 of the additional Act of the 14th December, 1900, the present protocol has been closed on this date.

The Belgian Minister for Foreign Affairs,
(Signed) P. DE FAVEREAU.

Brussels, June 14, 1902.

It not having been possible to deposit the ratifications of the President of the United States of Brazil, the President of the Dominican Republic, His Majesty the King of Spain, and His Majesty the King of Servia, within the stipulated period, the Governments of Belgium, Denmark, the United States of America, France, Great Britain, Italy, Japan, Norway, the Netherlands, Portugal, Sweden, Switzerland, and Tunis have unanimously agreed that the additional Act of December 14, 1900, shall, from September 14, 1902, take effect as regard themselves, and also as regards those of the other four signatory states whose ratifications may in the interval have been deposited.

Certified copy:

The Secretary-General
of the Belgian Ministry for Foreign Affairs,
(Signed) BARON LAMBERMONT.

Note.—Austria-Hungary acceded to the International Convention, Protocol, and Additional Act on January 1st, 1909, and from that date the provisions of sect. 91 apply to that country (Order in Council, May 17th, 1909).

THE PATENTS RULES, 1908.

DATED DECEMBER 17, 1907.

By virtue of the provisions of the Patents and Designs Act, 1907, hereinafter referred to as the "Act," the Board of Trade hereinafter referred to as the "Board," do hereby make the following rules:—

Short Title.

1. These rules may be cited as the Patents Rules, 1908. Short title.

Commencement.

2. These rules shall come into operation from and immediately after the 31st December, 1907, with the exception of such of them as relate to the procedure under section 8 of the Act, which shall come into operation at such date as the Board may by order direct. Commencement.

Interpretation.

3. In the construction of these rules— Interpretation.

"United Kingdom" includes the Isle of Man;

"Foreign application" means an application by any person for protection of his invention in a foreign state or British possession to which by any Order in Council for the time being in force the provisions of section 91 of the Act are applicable;

"Convention application" means an application in the United Kingdom under section 91 of the Act;

"Office" means the Patent Office;

"Journal" means the Illustrated Official Journal (Patents).

Fees.

4. The fees to be paid under the Act, so far as it relates to patents, shall be those specified in the list of fees in the first schedule to these rules. First schedule.

Forms.

5. The forms herein referred to are those contained in the second and third schedules to these rules, and such forms shall be used in all cases to which they are applicable, and shall be modified as directed by the Comptroller to meet other cases. Second schedule.

Documents.

Size, &c., of documents.

6. All documents and copies of documents, except drawings, sent to or left at the Office or otherwise furnished to the Comptroller or to the Board shall be written, type-written, 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.

Leaving and serving documents.

7. Any application, notice, or other document authorised or required to be left, made, or given at the Office, or to the Comptroller, or to any other person under the Act or these rules, may be sent by a prepaid or official paid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such sending or service, it shall be sufficient to prove that the letter was properly addressed and put into the post.

A letter addressed to a patentee at his address as it appears on the register of patents or at his address for service or to any applicant for or opponent to the grant, revocation, or restoration of a patent at the address appearing on the application or notice of opposition or given for service as hereinafter provided, shall be deemed to be sufficiently addressed.

Address for service.

8. Every applicant for and opponent to the grant of a patent or the revocation of a patent or the restoration of a lapsed patent or the amendment of a specification, and every person who shall hereafter become a patentee, shall give an address for service in the United Kingdom, and such address may be treated, for all purposes connected with the patent, as the actual address of such applicant, opponent or patentee.

If any patentee desires to have two addresses for service entered in the register, a request therefor shall be made on Patents Form No. 26.

The Comptroller may require any existing patentee, who does not reside in the United Kingdam, to give an address for service within the United Kingdom, and such address may be treated as the actual address of the patentee for all purposes connected with such patent.

Agency.

9. With the exception of the signing of the following documents, namely, applications for patents, or for the revocation of patents or the restoration of lapsed patents, requests for leave to amend applications, specifications, or letters patent, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, and surrenders of letters patent, all communications to the Comptroller under the Act and these rules relating to patents may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and resident or having a place of business in the United Kingdom. The Comptroller shall not be bound to recognise as such agent, or to receive further communications in respect of any business under the Act relating to patents from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the register of patent agents kept under the provisions of the Act, and not since restored, or any person who is proved to the satisfaction of the Board, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, or any company, which if it had been an individual, the Comptroller could refuse to recoguise as agent, or any company or firm, if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm. In any particular case the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent or other person. Agency.

Applications for the Grant of Patents.

10. An application for a patent, other than a patent of addition or a secret patent, shall be made on one of the Patent Forms, Nos. 1, 1A or 1B, as the case may be. An application for a patent of addition shall be made on Patents Form No. 1C, and an application for a secret patent on Patents Form No. 1D. Form of application.

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

Order of recording applications.

12. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

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

One invention.

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

Applications for separate patents by way of amendment.

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

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

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

(2) Where the same applicant has put in two or more provisional specifications for inventions which he believes to be cognate or modifications one of the other and the Comptroller is of opinion that such inventions are not cognate or modifications one of the other, the applicant may divide the complete specification left in connection with his application into such number of complete specifications as may be necessary to enable the application to be proceeded with as two or more separate applications for patents for different inventions.

Claims.

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

Applications under the International Convention.

Convention applications.

15. Every Convention application shall contain a declaration that foreign application has been made for protection of the invention to which such Convention application relates, and shall specify all the foreign states or British possessions in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a complete specification, and signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons be dead, the application must be signed by the legal representative of such dead person, as well as by the other applicants, if any.

Foreign specification, &c., to accompany application.

16. In addition to the specification left with every Convention application a copy or copies of the specification or specifications and drawings or documents filed or deposited by the applicant in the patent office of the foreign state or British possession in respect of the first foreign application, duly certified by the official chief or head of the patent office of such foreign state or British possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller must be left at the office at the same time as the application or within such further time thereafter not exceeding three months as the Comptroller may allow. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

An application for extension of time for leaving the copy or copies of the foreign specification or specifications, drawings or documents shall be made on Patents Form No. 5.

Public inspection.

17. If the complete specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall be open to public inspection at the expiration of that period.

Proceedings.

18. Save as aforesaid and as provided by rule 83, all proceedings in connection with a Convention application shall be taken within the times and in the manner prescribed by the Act or these rules for ordinary applications.

Drawings. (a)

General.

19. Drawings, when furnished, should accompany the provisional or complete specification to which they refer, except in the case

(*a*) NOTE.—Copies of instructions as to the preparation of drawings may be had on application to the Patent Office.

provided for by Rule 26. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed should appear in the specification itself.

Requirements as to paper, &c.

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

Size of drawing and arrangement of figures.

21. 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 figure is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary. The figures should be numbered consecutively throughout and without regard to the number of sheets, and should not be more numerous than is absolutely necessary. They should be separated by a sufficient space to keep them distinct.

Drawings to be suitable for reproduction.

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

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

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

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

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

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

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

Reference letters and figures, and index numerals used in conjunction therewith, must be bold, distinct and not less than one-eighth of an inch in height. The same letters should be used in different views of the same parts. Where the reference letters are

shown outside the figure, they must be connected with the parts referred to by fine lines.

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

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

Copies of drawings.

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

Marking of originals and true copies.

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

Delivery of drawings.

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

Provisional drawings used for complete specifications.

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

Extension of time for leaving complete Specification.

Extension of time for leaving complete specification.

27. An application for one month's extension of time for leaving a complete specification shall be made on Patents Form No. 6.

Procedure under Section 7 of the Act.

Power of Comptroller to post-date.

28. If after the leaving of any complete specification the Examiner reports that the nature of the invention is not sufficiently disclosed and defined to enable him to make the investigation prescribed by sub-section 1, and the Comptroller requires amendment of the specification and drawings, or any of them, the application shall, if the Comptroller at any time so direct, bear such date, subsequent to its original date and not later than the 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.

Provisional report in case of complete anticipation.

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

If the provisional report of the Examiner made under this rule be not reversed or altered, it may be deemed a final report, and the application shall be dealt with as provided by sub-section 4. If, however, such provisional report be reversed or altered, the investigation shall be continued, and a further report shall be made to the Comptroller, and the specification shall be dealt with as provided in sub-section 3 or sub-section 4, as the case may require.

Time for leaving amended specification.

30. 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.

Hearing by the Comptroller under sub-section 4.

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

Reference to prior specification.

32. When under sub-section 4 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows and shall be inserted after the claims :—

Reference has been directed in pursuance of section 7, sub-section 4, of the Patents and Designs Act, 1907, to specification No. of 1 .

Where the reference is inserted as the result of a provisional report under rule 29, a statement to that effect shall be added to the reference.

Procedure under Section 8 of the Act.

Procedure under section 8.

33. Where on the extended investigation provided for by section 8 of the Act it appears that the invention claimed in any specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall be informed of the result of such extended investigation, and shall, within two months from the date of the letter so informing him, apply for leave to amend his specification by way of disclaimer, stating specifically what amendments he is prepared to make in it to remove the objection of anticipation, or if he considers that no amendments are necessary, inform the Comptroller accordingly.

The Comptroller shall consider any amendments submitted by the applicant for this purpose, and may allow the necessary amendments to be made.

Hearing by Comptroller.

If, at the expiration of the said two months, or such further time as the Comptroller may allow, the Comptroller is not satisfied that the invention claimed by the applicant is not wholly or in part claimed in the specification or specifications cited, he shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant or without a hearing, if the applicant has not attended a hearing appointed, or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and if so, what, prior specification or specifications by way of notice to the public.

Reference to prior specification.

34. When, under sub-section 2, the Comptroller determines that reference to a prior specification ought to be made, by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:—

"Reference has been directed, in pursuance of section 8, sub-section 2, of the Patents and Designs Act, 1907, to Specification No. of 1 ."

Advertisement of amendments.

35. When, after any accepted specification has been published, any amendment has been made, or any reference inserted therein, under either of the last two preceding rules, notice thereof shall be advertised in the Journal.

Chemical Inventions.—Typical Samples and Specimens.

Chemical inventions—Typical samples and specimens.

36. Where under section 2, sub-section (5), of the Act, before the acceptance of the complete specification left on any application for a patent for a chemical invention, the Comptroller in any particular case considers it desirable to require typical samples or specimens to be furnished, such samples or specimens must, if so required by the Comptroller, be supplied in duplicate.

The fact that such samples or specimens have been furnished shall be notified to the public by a statement to that effect on the complete specification and in connexion with the advertisement of acceptance of same in the Journal.

The samples or specimens must, unless other directions are specially given, be supplied in glass bottles of a total height not exceeding 3 inches, and of an external diameter of 1½ inches, and the bottles must be securely closed by well-fitting stoppers, and sealed. Each bottle must have an adhesive or otherwise securely attached label bearing a description which clearly identifies the sample with the substance described in the specification. Labels which are not secured to the bottle by an adhesive should be 3 inches wide and not more than 4 inches long.

Where samples or specimens of colouring matters are required to be supplied, they must be accompanied by samples or specimens of materials printed or dyed with such colouring matters; such last-mentioned samples or specimens must be as flat as possible, and firmly attached to cards 13 inches long by 8 inches broad. The cards must bear a full description of the processes by which the respective dyed or printed effects were produced, including the compositions and strengths of the various baths, the temperatures, duration of treatment, degree of exhaustion of the dye baths, in the case of dyed fabrics the percentage of colouring matter fixed on, in the case of prints the composition of the printing paste, and other necessary information. This description must also clearly identify the substance used with that described in the specification.

Samples of poisonous, corrosive, explosive, or easily inflammable substances must be clearly marked as such.

Acceptance of Specifications.

Extension of time for accepting complete specification.

37. An application for extension of time for accepting a complete specification shall be made on Patents Form No. 7.

Notice and advertisement of acceptance.

38. On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise the acceptance of every complete specification in the Journal.

39. Upon such acceptance in the case of a complete specification the application and specification or specifications with the drawings (if any) may be inspected at the Office upon payment of the prescribed fee.

Inspection of specification.

Opposition to Grants of Patents.

40. A notice of opposition to the grant of a patent shall be given on Patents Form No. 8, and shall state the ground or grounds on which the person giving such notice (herein called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall be accompanied by an unstamped copy, which shall be transmitted by the Comptroller to the applicant.

Notice of opposition.

Copy for applicant.

Where the person giving notice of an opposition does not desire that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect, indicating so far as can conveniently be done the general nature of the amendments desired and the portions of the earlier specifications, if any, relied upon as necessitating such amendments.

Statement of amendments desired.

41.—(1) Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Office within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification or such further time as the Comptroller may in any special case allow, the opposition shall be deemed to be abandoned.

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

(2) Where the ground of the opposition is that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification, the notice of opposition should be accompanied by a written statement indicating so far as can conveniently be done in what respects the invention is alleged to be insufficiently or unfairly described or ascertained.

42. Except in the case provided for in Rule 41 (1), statutory declarations need not be left in connexion with an opposition, but the opponent may within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's complete specification, leave at the Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Opponent's evidence.

43. Within fourteen days from the delivery of such copies, the

Applicant's evidence.

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

Evidence in reply.

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

44. If the opponent does not leave 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 Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Opponent's evidence.

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

Evidence in reply.

Closing of evidence.

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

Hearing.

47. On completion of the evidence (if any), or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If either party does not desire to be heard he shall as soon as possible notify the Comptroller to that effect. If either party desires to be heard he must leave Patents Form No. 9 at the Office. The Comptroller may refuse to hear either party who has not left Patents Form No. 9 prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory declaration already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing, the Comptroller shall decide the case and notify his decision to the parties.

Sealing of Patent and Payment of Fee.

Sealing of patent and payment of fee.

48. If the applicant for a patent desires to have a patent sealed on his application, he shall within the period allowed by section 12

of the Act pay the sealing fee by leaving at the Office Patents Form No. 10, duly stamped.

Where in consequence of the neglect or failure of the applicant to pay such fee, a patent cannot be sealed within the period allowed by section 12, the applicant may apply to the Comptroller on Patents Form No. 11 or Patents Form No. 12, as the case may be, for an extension of such period not exceeding three months where the period allowed for the sealing of the patent expires after the commencement of the Act, and not exceeding three months after the commencement of the Act where the period allowed for the sealing of the patent expired before the commencement of the Act.

The Comptroller shall consider such application, and if the circumstances of the case appear to him to warrant the granting of the extension, he may seal the patent within such extended period.

Where the period allowed for the sealing of the patent has expired before the commencement of the Act, no proceedings shall be taken in respect of an infringement committed after the failure to pay the fee and before the sealing of the patent.

Form of Patent.

Form of patent.

49. A patent, except in the cases provided for in rules 50 and 51, may be in the Form A, in the third schedule to these rules.

Form of patent of addition.

50. A patent of addition may be in the Form B, in the third schedule to these rules.

Form of patent to legal representatives of deceased inventor and others.

51. Where after the commencement of the Act a patent is granted to the legal representatives of a deceased inventor, or in any case in which the applicants have asked to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in such patent as joint tenants, the form of the patent shall be modified so as to show clearly that the persons to whom the grant is made are to be treated for the purpose of the devolution not only of the legal but also of the beneficial interest in the patent as joint tenants.

Renewal Fees.

Renewal fees.

52. If a patentee intends, at the expiration of the fourth year from the date of his patent or of any succeeding year during the term of the patent, to keep the same in force, he shall before the expiration of such year pay the prescribed annual renewal fee by means of Patents Form No. 13. The patentee may pay all or any of such prescribed annual renewal fees in advance. An application for an enlargement of time for payment of any fee under this rule shall be made on Patents Form No. 14.

Certificate of payment of fee.

53. On due compliance with the terms of rule 52, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

Notice as to renewal fees.

54. At any time not less than one month before the date when any renewal fee will become due in respect of any patent, the Comptroller shall send to the patentee or patentees, whose names appear in the Register of Patents, at his or their address or addresses for service, or to the address of the person or persons who paid the last renewal fee, a notice reminding him or them of the date when such fee will become due, and of the consequences of the non-payment thereof.

Restoration of Lapsed Patents.

Restoration of lapsed patents.

55. Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Comptroller on Patents Form No. 15 for an order for the restoration of the patent. Every such application shall be accompanied by one or more statutory declarations verifying the statements contained in such application. If the Comptroller entertains the application, he shall advertise it in the Journal, and in such other manner as in his opinion is desirable. At any time within two months from the first of such advertisements in the Journal any person may give notice of opposition at the Office on Patents Form No. 16, and a copy of such notice shall be transmitted by the Comptroller to the applicant.

Opponent's evidence.

56. Where such notice is given the opponent shall within fourteen days after leaving the notice leave at the Office one or more statutory declarations verifying any evidence on which he relies in support of the grounds of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Further procedure.

57. Upon such declarations being left and delivered the provisions of rules 43, 46 and 47 shall apply to the case, and the further proceedings thereon shall be regulated in accordance with such provisions as if they were herein repeated.

Order.

58. In every order of the Comptroller restoring a patent, provisions shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent has been announced as void in the Journal. Such provisions shall restrain the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage :—

(1) In respect of any infringement of the patent which shall have taken place after the date on which the patent was announced in the Journal to be void and before the date of the order.

(2) In respect of the use or employment at any time thereafter of any mechanism, machine, machinery, process or operation actually made or carried on within the United Kingdom, or of the use, purchase, or sale of any article manufactured or made in infringement of the patent after the date of the said announcement and before the date of the order. Provided that such use, purchase, sale, or employment is by the person or corporation by or for whom such machine or machinery or article was bonâ fide manufactured or made, or such mechanism, machine, machinery, process, or operation was bonâ fide made or carried on, his or their executors, administrators, successors, or vendees, or his or their assigns respectively.

(3) In respect of the use, employment, or sale at any time thereafter by any person or corporation entitled for the time being under the preceding sub-section to use or employ any machine, machinery, mechanism, process, or operation, or any improved or additional machine, machinery, mechanism, process or operation, or of the use or sale of any article manufactured or made by any of the means aforesaid in infringement of the patent; provided that the use or employment of any such improved or additional machine, machinery, mechanism, process or operation shall be limited to the buildings, works or premises existing at the time being or afterwards erected of the person or corporation by or for whom such machine, machinery, mechanism, process or operation was made or carried on within the meaning of the preceding paragraph, his or their executors, administrators, successors or assigns.

Compensation.

59. The order shall further provide that if any person within one year after the date thereof make an application to the Board for compensation in respect of money, time, or labour expended by the applicant upon the subject-matter of the patent in the bonâ fide belief that such patent had become and continued to be void, it shall be lawful for the Board, after hearing the parties concerned or their agents, to assess the amount of such compensation if in their opinion the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid, and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

Amendment of Specification.

Request for leave to amend.

60. A request to the Comptroller for leave to amend a specification, except when such request is made under rule 33, shall be made on Patents Form No. 17. The request must be accompanied by a duly certified copy of the original specification and drawings, showing

in red ink the proposed amendment in such manner as to indicate clearly the alteration desired, and shall be advertised by publication of the request and the nature of the proposed amendment in the Journal, and in such other manner (if any) as the Comptroller may in each case direct.

Notice of opposition. Copy for the applicant.

61. A notice of opposition to the amendment shall be on Patents Form No. 18, and shall be accompanied by an unstamped copy, which copy shall be transmitted by the Comptroller to the applicant.

Opponent's evidence.

62. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Further proceedings.

63. Upon such declarations being left, and such copies being delivered, the provisions of rules 43, 46 and 47 shall apply to the case, and the further proceedings shall be regulated in accordance with such provisions as if they were herein repeated.

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

64. If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within two months from the date of the first advertisement of the application for leave to amend leave at the Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Further proceedings.

65. Upon such declarations being left, and such copies being delivered, the provisions of rules 45, 46 and 47 shall apply to the case, and further proceedings therein shall be regulated in accordance with such provisions as if they were herein repeated.

Requirements on amendment.

66. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Office a new specification and drawings as amended, to be prepared in accordance with rules 6 and 19 to 25.

Advertisement of amendment.

67. Every amendment of a specification shall be advertised forthwith by the Comptroller in the Journal, and in such other manner (if any) as the Comptroller may direct.

Compulsory Licences and Revocation of Patents.

Petition for grant of compulsory licence or revocation of patent.

68. A petition to the Board for an order under section 24 of the Act shall be made on Patents Form No. 20 and shall show clearly the nature of the petitioner's interest and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order, and the name and

address of the patentee and any other person who is alleged in the petition to have made default.

To be left with evidence at Office.

69. The petition and an examined copy thereof shall be left at the Office with a request on Patents Form No. 19, and shall be accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition together with any other documentary evidence in support, and the petitioner shall simultaneously with, or as soon as may be after the leaving of such petition, deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.

Opponent's evidence.

70. The persons to whom such copies are delivered by the petitioner may give notice of opposition on Patents Form No 21, and may, within fourteen days after being invited to do so by the Board, leave at the Office their affidavits or statutory declarations in answer, and if they do so shall deliver copies thereof to the petitioner; and

Evidence in reply.

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

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

Closing of evidence.

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

Power of Board of Trade to dismiss petition.

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

Arrangements between parties.

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

Reference of petition to the Court.

74. If the Board are not of opinion that there is a reasonable probability of any arrangement being come to between the parties and are satisfied that a primâ facie case has been made out by the petitioner, they shall refer the petition to the Court, with copies of

any affidavits, statutory declarations, or other documentary evidence which may have been furnished under the foregoing rules, and with certified copies of all entries in the Register of Patents relating to the patent in question, and any other information in the possession of the Board which it appears to them may be of service to the Court in ascertaining what persons should be made parties to the proceedings before the Court, and the Board shall give written notice to the parties that the petition has been referred to the Court.

Procedure under Section 26 of the Act.

Application under section 26 of the Act.

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

Procedure.

76. Upon such declarations being left and delivered the provisions of rules 43 to 47 shall apply mutatis mutandis to the furnishing of further evidence and to the hearing of the case before the Comptroller.

Surrender of patent.

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

Revocation of Patents worked outside the United Kingdom.

Revocation of patents worked outside the United Kingdom.

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

Procedure.

79. The patentee shall within fourteen days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evideuce, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what

place the patented article or process is manufactured or carried on in the United Kingdom; and setting out in the event of the article or process not being manufactured or carried on in the United Kingdom to an adequate extent, the reasons why it is not so manufactured or carried on. The patentee shall deliver, or cause to be delivered, copies of such evidence to the applicant, and furnish the Comptroller with evidence of such delivery.

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

Closing of evidence.

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

Hearing.

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

NOTE.—The following official notice appeared in the Illustrated Official Journal of Wednesday, May 12th, 1909.

PROCEDURE UNDER SECTION 27 AND PATENTS RULES 78—81.

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

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

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

applicant. Copies of such evidence should at the same time be delivered to the applicant.

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

(4) The Comptroller will then intimate to the parties whether, having regard to the circumstances of the case, he considers it desirable and intends to hold a preliminary hearing on the question whether a primâ facie case has been made in support of the allegations in the application or whether he intends in ordinary course to deal at one hearing with the whole case, including the further questions whether the patentee can prove that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or can give satisfactory reasons why the article or process is not so manufactured or carried on.

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

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

W. TEMPLE FRANKS,
Comptroller-General.

Note.—The above procedure, with the necessary modifications, will apply to applications under section 58 (DESIGNS).

Register of Patents.

Entry of grant.

82. Upon the sealing of a patent the Comptroller shall cause to

be entered in the Register of Patents the name, address, and calling of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the grant thereof, together with the address for service.

Entry in respect of Convention application.

83. The patent granted on any convention application shall be entered in the register as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application. The date of the application in this country shall also be entered in the register.

Alteration of address.

84. If a patentee send to the Comptroller on Patents Form No. 25 notice of an alteration in his name or address or address for service, the Comptroller shall cause the register to be altered accordingly, and may require the altered address to be in the United Kingdom.

Request for entry of subsequent proprietorship.

85. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to any interest therein, as mortgagee, licensee or otherwise, a request for the entry in the register of his name as proprietor of the patent, or of a notice of such interest, as the case may be, shall be addressed to the Comptroller, and left at the Office.

Form and signature of request.

86. Such request shall be on Patents Form No. 27 or Patents Form No. 28, as the case may be, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent, and in the case of a body corporate by its agent.

Particulars to be stated in request.

87. Every such request shall state the name, address, and calling of the person claiming to be entitled to the patent, or to any interest therein, as the case may be, and the particulars of the assignment, transmission, or other operation of law, by virtue of which he claims to have entered in the register his name as proprietor or a notice of such interest, so as to show the manner in which, and the person or persons to whom, the patent, or such interest therein as aforesaid, has been assigned or transmitted.

Production of documents of title and other proof.

88. Every assignment, and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the request, and he may call for such other proof of title as he may require for his satisfaction.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the Comptroller.

Copies for Office.

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

Entry of notice of interest.

90. The notice of interest in the patent of any person other than the proprietor entered in the register in pursuance of the request shall be such as may appear applicable to the circumstances of the particular case.

Entry of notification of document.

91. Where it is desired to enter in the register a notification of any document purporting to affect the proprietorship of a patent an attested copy of such document shall be left at the Office with a request on Patents Form No. 29 that a notification thereof may be entered in the register. The accuracy of such copy shall be certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Office if required for further verification.

Entry of date of payment of fees on issue of certificate.

92. Upon the issue of a certificate of payment under rule 53, the Comptroller shall cause to be entered in the register a record of the date of payment of the fee on such certificate.

Entry of failure to pay fees.

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

Hours of inspection of register.

94. The register of patents shall be open to the inspection of the public on every day on which the Office is open to the public during the time it is so open except at such times when the register is required for any purpose of official use.

Correction of Clerical Errors.

Correction of clerical errors.

95. A request for the correction of a clerical error in or in connexion with an application for a patent, or in any patent or specification, or in any matter which is entered upon the register of patents, shall be made on Patents Form No. 30.

Certificates.

Certificates and certified copies of documents.

96. A request for a certificate of the Comptroller as to any entry, matter or thing which he is authorised by the Act or any of these rules to make or do, shall be made on Patents Form No. 31.

Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

Secret Patents.

Secret patents.

97. When it has been decided by the Secretary of State for War

or the Admiralty that it is advisable to take out a secret patent for any invention assigned under section 30 of the Act, and an application for such patent has been made on Patents Form No. 1D, accompanied by a certificate of the Secretary of State or the Admiralty, under section 30 (3) of the Act, the Comptroller shall not communicate the application or any documents relating thereto to any member of his staff other than a deputy or special examiner or examiners, who shall make the required investigations and reports required by the Act to be made in the case of other applications for patents.

Unless and until such invention is re-assigned to the inventor by the Secretary of State or the Admiralty—

(1) No copy of any specification or any other document or drawing relating thereto shall in any manner whatever be published or open to the inspection of the public.

(2) The application for the patent, and the acceptance of any specification relating to the invention, shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under section 11 of the Act; but the Comptroller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the complete specification relating thereto.

(3) Every such secret patent shall be registered in a confidential register at the Office, and no details or particulars relating thereto shall at any time be published as required by the Act for ordinary patents. Nor shall any entry be made in the ordinary Register of Patents in respect of any such patent or any assignment thereof.

(4) No fees shall be payable in respect of any secret patent, and every such patent, notwithstanding the non-payment of such fees, shall remain in force for the full period of 14 years from its date.

Certificate of secrecy after application.

98. When an application has been made otherwise than as provided by the last preceding rule for a patent for an invention, and such application is still pending, and a certificate under section 30 (3) of the Act is furnished to the Comptroller by the Secretary of State or the Admiralty, the provisions of such rule shall, so far as is practicable, having regard to the date of such certificate, apply to such application and to all documents relating thereto.

Reassignment.

99. In the event of any secret patent being re-assigned to the inventor by the Secretary of State or the Admiralty, it shall be removed from the confidential register of secret patents; all fees that would have been thereafter payable if the same had not been a

secret patent shall be paid in respect thereof; and the patent shall remain in force only for the same term, and subject to the same conditions as to payment of fees and otherwise as if it had not been a secret patent.

Lost Patent.

Lost patent.

100. An application for a duplicate of a patent which has been lost or destroyed shall be made on Patents Form No. 32, and in accordance with the directions thereon.

Industrial or International Exhibitions.

Industrial or international exhibitions.

101. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where exhibition is held, may, after the Board have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Patents Form No. 33 of his intention to exhibit, publish or use the invention, as the case may be. For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

Exercise of Discretionary Powers by the Comptroller.

Exercise of discretionary powers by Comptroller.

Notice of hearing.

102. Before exercising any discretionary power given to the Comptroller by the Act or these rules adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.

Notice by applicant.

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

Comptroller may require statement, &c.

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

Decision to be notified to parties.

105. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be

notified by him to the applicant, and to any other person who appears to be affected thereby.

Statutory Declarations and Affidavits.

Form, &c., of statutory declaration and affidavit.

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

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

107. The statutory declarations and affidavits required by the Act and these rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

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

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

(*c*) If made out of His Majesty's dominions, before a British minister, or person exercising the functions of a British minister, or a consul, vice-consul, or other person exercising the functions of a British consul, or before a notary public, or before a judge or magistrate.

General.

Power of amendment, &c.

108. Any document for the amending of which no special provision is made by the Act may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

General power to enlarge time.

109. The times prescribed by these rules for doing any act, or taking any proceeding thereunder, other than the times for lodging evidence referred to in rules 68 to 74, or the times prescribed by rules 16, 41 and 55, may be enlarged by the Comptroller if he

thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms as he may direct.

Days and hours of business.

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

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

Excluded days.

111. Whenever the last day fixed by the Act, or by these rules, for doing any thing shall fall on a day when the Office is not open or on a Saturday, which days shall be excluded days for the purposes of the Act and these rules, it shall be lawful to do any such thing on the day next following such excluded day, or days if two or more of them occur consecutively.

Power to dispense with evidence, signature, &c.

112. Where, under these rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or to make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board, and upon the production of such other evidence, and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration or evidence.

Applications to and Orders of Court.

Applications to Court.

113. Four clear days' notice of every application to the Court under section 72 of the Act for rectification of the register of patents shall be given to the Comptroller.

Orders of Court.

Where any order has been made by the Court under the Act revoking a patent or extending the term of a patent or allowing a patentee to amend his specification or affecting the validity or proprietorship of a patent, the person in whose favour such order has been made shall forthwith leave at the office an office copy of such order together with Patents Form No. 34. The specification shall thereupon be amended or the register rectified or the purport of such Order shall otherwise be duly entered in the register as the case may be.

Repeal.

114. All general rules relative to patents heretofore made by the Board of Trade under the patents, Designs, and Trade Marks Acts, 1883 to 1902, and in force on the 31st day of December, 1907, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application or other matter then pending. Repeal.

Dated the 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

THE FIRST SCHEDULE.

LIST OF FEES PAYABLE IN RESPECT OF THE GRANT OF PATENTS AND OF OTHER MATTERS WITH RELATION THERETO.

	£ s. d.	£ s. d.	Corresponding Form.
1. On application accompanied by provisional specification ...	1 0 0		Patents Form No. 1, 1A, 1B, or 1C.
2. On filing complete specification thereafter	3 0 0		Patents Form No. 3.
		4 0 0	
or			
3. On application accompanied by complete specification.		4 0 0	„ „
4. On appeal from Comptroller to Law Officer. By appellant.		3 0 0	Patents Form No. 4.
5. For extension of time under Rule 16:—			
Not exceeding one month		2 0 0	Patents Form No. 5.
„ two months		4 0 0	„ „
„ three months		6 0 0	„ „
6. For extension of time for leaving complete specification not exceeding one month.		2 0 0	Patents Form No. 6.
7. For extension of time for acceptance of complete specification:—			
Not exceeding one month		2 0 0	Patents Form No. 7.
„ two months		4 0 0	„ „
„ three months		6 0 0	„ „
8. On notice of opposition to grant of patent. By opponent.		0 10 0	Patents Form No. 8.
9. On hearing by Comptroller. By applicant and by opponent respectively.		1 0 0	Patents Form No. 9.
10. On sealing of patent		1 0 0	Patents Form No. 10.

	£	s.	d.	Corresponding Form.
11. For extension of time for sealing of patent where period allowed for the sealing of the patent will expire after the commencement of the Act :—				
Not exceeding one month	2	0	0	Patents Form No. 11.
„ two months	4	0	0	„ „
„ three months	6	0	0	„ „
12. For extension of time for sealing of patent where period allowed for the sealing of the patent has expired before the commencement of the Act.	10	0	0	Patents Form No. 12.
On certificate of renewal :—				
13. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year.	5	0	0	Patents Form No. 13.
14. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year.	6	0	0	„ „
15. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year.	7	0	0	Patents Form No. 13.
16. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year.	8	0	0	„ „
17. Before the expiration of the 8th year from the date of the patent and in respect of the 9th year.	9	0	0	„ „
18. Before the expiration of the 9th year from the date of the patent and in respect of the 10th year.	10	0	0	„ „
19. Before the expiration of the 10th year from the date of the patent and in respect of the 11th year.	11	0	0	„ „
20. Before the expiration of the 11th year from the date of the patent and in respect of the 12th year.	12	0	0	„ „
21. Before the expiration of the 12th year from the date of the patent and in respect of the 13th year.	13	0	0	„ „
22. Before the expiration of the 13th year from the date of the patent and in respect of the 14th year.	14	0	0	„ „
23. On enlargement of time for payment of renewal fees :—				
Not exceeding one month	1	0	0	Patents Form No. 14.
„ two months	3	0	0	„ „
„ three months	5	0	0	„ „
24. On application for restoration of a lapsed patent.	20	0	0	Patents Form No. 15.
25. On notice of opposition to application for restoration of lapsed patent.	1	0	0	Patents Form No. 16.
26. On hearing by Comptroller. By applicant and by appointment respectively.	1	0	0	Patents Form No. 9.
27. On application to amend specification :—				
Up to sealing. By applicant	1	10	0	Patents Form No. 17.
After sealing. By patentee	3	0	0	„ „

		Corresponding Form.
	£ s. d.	
28. On notice of opposition to amendment. By opponent.	0 10 0	Patents Form No. 18.
29. On hearing by Comptroller. By applicant and by opponent respectively.	1 0 0	Patents Form No. 9.
30. On application to the Board of Trade for a compulsory licence. By person applying.	1 0 0	Patents Form No. 19.
31. On opposition to grant of compulsory licence. By opponent.	1 0 0	Patents Form No. 21.
32. On application to Comptroller to revoke a patent under section 26.	2 0 0	Patents Form No. 22.
33. On hearing by Comptroller. By applicant and by patentee respectively.	2 0 0	Patents Form No. 9.
34. On offer to surrender a patent under section 26	1 0 0	Patents Form No. 23.
35. On hearing by Comptroller. By applicant and by opponent respectively.	1 0 0	Patents Form No. 9.
36. On application under Section 27 to Comptroller to revoke a patent worked outside the United Kingdom.	2 0 0	Patents Form No. 24.
37. On hearing by Comptroller. By applicant and by patentee respectively.	2 0 0	Patents Form No. 9.
38. For altering name or address or address for service in register.	0 5 0	Patents Form No. 25.
39. For entry of two addresses for service in register.	0 5 0	Patents Form No. 26.
40. On request to enter name of subsequent proprietor in the register of patents.	0 10 0	Patents Form No. 27.
41. On request to enter notice of interest in the register of patents.	0 10 0	Patents Form No. 28.
42. On request to enter notification of a document in the register of patents.	0 10 0	Patents Form No. 29.
43. On request to Comptroller to correct a clerical error :—		
Up to sealing	0 5 0	Patents Form No. 30.
After sealing	1 0 0	" "
44. For certificate of Comptroller under section 78.	0 5 0	Patents Form No. 31.
45. For duplicate of letters patent	0 10 0	Patents Form No. 32.
46. On notice to Comptroller of intended exhibition of an invention under section 45.	0 10 0	Patents Form No. 33.
47. On notice of order of Court for amendment of specification or rectification of register.	0 10 0	Patents Form No. 34.
48. On postal request for printed specification ...	0 0 8	Patents Form No. 35.
49. Search or inspection fee	0 1 0	
50. For office copies ... ... every 100 words (but never less than one shilling)	0 0 4	
51. For office copies of drawings, cost according to agreement.		
52. For certifying office copies, MSS. or printed each	0 1 0	

Dated the 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

Approved:

JOSEPH A. PEASE,
J. H. WHITLEY,
Lords Commissioners of His Majesty's Treasury.

THE SECOND SCHEDULE.

	Forms.	Page.	Corresponding Fee.
Patents Form	No. 1.—Application for Patent	30	£1
"	No. 1A.—Application for Patent communicated from abroad.	32	£1
"	No. 1B.—Application for Patent under International and Colonial arrangements.	34	£1
"	No. 1C.—Application for Patent of Addition.	36	£1
"	No. 1D.—Application for Secret Patent...	38	—
"	No. 2.—Provisional Specification... ...	40	—
"	No. 3.—Complete Specification	41	£3
"	No. 4.—Appeal to Law Officer	42	£3
"	No. 5.—Application for extension of Time under rule 16.	43	£2, £4,
"	No. 6.—Application for extension of Time for leaving Complete Specification.	44	£2
"	No. 7.—Application for extension of Time for acceptance of Complete Specification.	45	£2, £4, or £6
"	No. 8.—Opposition to Grant of Patent ...	46	10s.
"	No. 9.—Notice that Hearing will be attended.	47	£1 or £2
"	No. 10.—Notice of Desire to have Patent sealed.	48	£1
"	No. 11.—Application for extension of Time for sealing of Patent, where period allowed for sealing of Patent will expire after commencement of Act.	49	£2, £4, or £6
"	No. 12.—Application where period allowed for the Sealing of the Patent has expired before the commencement of the Act.	50	£10
"	No. 13.—Application for Certificate of Payment or Renewal.	51	£5 to £14
"	No. 14.—Application for Enlargement of Time for Payment of Renewal Fee.	52	£1, £3, or £5
"	No. 15.—Application for Restoration of a lapsed Patent.	53	£20
"	No. 16.—Notice of opposition to an application for restoration of a lapsed Patent.	54	£1
"	No. 17.—Application to amend Specification.	55	£1 10s. or £3
"	No. 18.—Opposition to Amendment of Specification.	56	10s.
"	No. 19.—Application for Grant of Compulsory Licence or Revocation of Patent.	57	£1
"	No. 20.—Petition for Grant of Compulsory Licence or Revocation of Patent.	58	—
"	No. 21.—Opposition to Petition for Grant of Compulsory Licence or Revocation of Patent.	59	£1

Forms.	Page.	Corresponding Fee.
Patents Form No. 22.—Application to the Comptroller for an Order for the Revocation of a Patent under section 26 of the Act.	60	£2
,, No. 23.—Offer to Surrender a Patent ...	61	£1
,, No. 24.—Application for Revocation of a Patent under section 27 of the Act.	62	£2
,, No. 25.—Notice of Alteration of Name or Address or Address for Service in Register.	63	5*s.*
,, No. 26.—Request to enter two Addresses for Service in Register.	64	5*s.*
,, No. 27.—Request to enter Name upon the Register of Patents.	65	10*s.*
,, No. 28.—Request to enter Notice of Interest in the Register.	66	10*s.*
,, No. 29.—Request to enter Notification of Document in Register.	67	10*s.*
,, No. 30.—Request for Correction of Clerical Error.	68	5*s.* or £1
,, No. 31.—Request for Certificate of Comptroller.	69	5*s.*
,, No. 32.—Application for Duplicate of Patent.	70	£2
,, No. 33.—Notice of Intended Exhibition of Unpatented Invention.	71	10*s.*
,, No. 34.—Application for Entry of Order of Court.	72	10*s.*
,, No. 35.—On postal request for printed Specification.	73	8*d.*

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 1.

(To be accompanied by two copies of Patents Form No. 2 or of Patents Form No. 3.)

Application for Patent.

(*a*) I (or we) do hereby declare that I am (or we are) in possession of an invention the title of which is (*b*) that (*c*) claim to be the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of 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 the day of 19 .

(*d*)———

NOTE.—One of the two forms on the back hereof or a separate authorisation of agent should be signed by the applicant or applicants.

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) Here insert (*in full*) name, address and calling of applicant or applicants.

(*b*) Here insert title of invention.

(*c*) In the case of more than one applicant, state here who is or are the inventor or inventors.

(*d*) To be signed by applicant or applicants. In the case of a Firm, each member of the Firm must sign.

(1.) *Where application is made through an Agent* (*Rule* 9.)

I (or we) hereby appoint 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.

Dated the day of 19 .

*———

* To be signed by applicant or applicants.

(2.) *Where application is made without an Agent* (*Rule* 8.)

I (or we) hereby request that all notices, requisitions, and communications in respect of the within application may be sent to at

Dated the day of 19 .

†———

† To be signed by applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 1A.

(To be accompanied by two copies of Patents Form No. 2 or of Patents Form No. 3.)

Application for Patent for Invention Communicated from Abroad.

(*a*) I (or we) of do hereby declare that I am (or we are) in possession of an invention the title of which is (*b*) which invention has been communicated to me (or us) by (*c*) that I (or we) 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 (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 the day of 19 .

(*d*)———

NOTE.—One of the two forms on the back hereof or a separate authorisation of agent should be signed by the applicant or applicants.

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

(*a*) Here insert (*in full*) name, address, and calling of applicant or applicants.
(*b*) Here insert title of invention.
(*c*) Here insert name, address, and calling of communicator.
(*d*) To be signed by applicant or applicants.

———

(1.) *Where application is made through an Agent* (*Rule* 9).

I (or we) hereby appoint 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.

Dated the day of 19 .

*———

* To be signed by applicant or applicants.

———

(2.) *Where application is made without an Agent* (*Rule* 8).

I (or we) hereby request that all notices, requisitions, and communications in respect of the within application may be sent to at

Dated the day of 19 .

†———

† To be signed by applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 1B.

(To be accompanied by two copies of Patents Form No. 3.)

Application for Patent under International and Colonial Arrangements.

(*a*) I (or we) do hereby declare that I (or we) have made applications for protection of my (or our) invention of (*b*)
in the following Foreign States and on the following official dates, viz.; (*c*)
and in the following British Possessions and on the following official dates, viz.: (*d*)

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (*e*) 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 (*f*)

(*g*)———

NOTE.—One of the two Forms on the back hereof or a separate authorisation of agent should be signed by the applicant or applicants.

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

(*a*) Here insert (*in full*) name, address, and calling of applicant or applicants.
(*b*) Here insert title of invention.
(*c*) Here insert the name of each Foreign State, followed by the official date of the application in each respectively.
(*d*) Here insert the name of each British Possession, followed by the official date of the application in each respectively.
(*e*) Here insert the official date of the earliest foreign application.
(*f*) Here insert the official date of the earliest foreign application.
(*g*) Signature of applicant or of each of applicants.

(1.) *Where application is made through an Agent* (*Rule* 9).

I (or we) hereby appoint 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.

Dated the day of 19 .

*———

*To be signed by applicant or applicants.

(2.) *Where application is made without an Agent* (*Rule* 8).

I (or we) hereby request that all notices, requisitions, and communications in respect of the within application may be sent to at

Dated the day of 19 .

*_____

*To be signed by applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 1c.

(*To be accompanied by two copies of Patents Form No.* 2 *or of Patents Form No.* 3.)

Application for Patent of Addition.

(*a*) I (or we), , do hereby declare that I am (or we are) in possession of an invention the title of which is (*b*) that (*c*) claim to be the true and first inventor thereof; that the same is not in use by any other person or persons to the best of my (or our) knowledge and belief, and that the said invention is an improvement in or modification of my (or our) invention for which a patent was applied for on the , and numbered , [for which $^{\text{I was}}_{\text{we were}}$ the applicant] [of which $^{\text{I am}}_{\text{we are}}$ the patentee]; and I (or we) humbly pray that a patent may be granted to me (or us) for the said invention, and request that the term limited in such further patent for the duration thereof be the same as that of the original patent, or so much of that term as is unexpired.

Dated the day of 19 .

(*d*)_____

NOTE.—One of the two forms on the back hereof, or a separate authorisation of agent, should be signed by the applicant or applicants.

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

(*a*) Here insert (*in full*) name, address, and calling of applicant or applicants.
(*b*) Here insert title of invention.
(*c*) In the case of more than one applicant, state here who is or are the inventor or inventors.
(*d*) To be signed by the applicant or applicants. In the case of a firm, each member of the firm must sign.

(1.) *Where application is made through an Agent* (*Rule* 9).

I (or we) hereby appoint 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.

Dated the day of 19 .

*_____

* To be signed by applicant or applicants.

(2.) *Where application is made without an Agent* (*Rule* 8).

I (or we) hereby request that all notices, requisitions, and communications in respect of the within application may be sent to at

Dated the day of 19 .

†_____

† To be signed by applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

[PATENTS.] FORM 1D.

(*To be accompanied by two copies of Patents Form No.* 2 *or of Patents Form No.* 3, *and a certificate under section* 30 (3)).

Application for a Secret Patent.

(*a*) I (or we) , do hereby declare that I am (or we are) in possession of an invention the title of which is (*b*) that (*c*) claim to be the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my (or our) knowledge and belief; and I (or we) humbly pray that a secret patent may be granted to me (or us) for the said invention.

Dated the day of 19 .

(*d*)_____

NOTE.—One of the two forms on the back hereof, or a separate authorisation of agent, should be signed by the applicant or applicants.

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

(*a*) Here insert (*in full*) name, address, and calling of applicant or applicants.

(*b*) Here insert title of invention.

(*c*) In the case of more than one applicant, state here who is or are the inventor or inventors.

(*d*) To be signed by applicant or applicants. In the case of a firm, each member of the firm must sign.

(1.) *Where application is made through an Agent* (*Rule* 9).

I (or we) hereby appoint 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.

Dated the day of 19 .

*

* To be signed by applicant or applicants.

(2.) *Where application is made without an Agent* (*Rule* 8).

I (or we) hereby request that all notices, requisitions, and communications in respect of the within application may be sent to at

Dated the day of 19 .

†

† To be signed by applicant or applicants.

To be issued with Patents Forms Nos. 1, 1A, 1c or 1D.

PATENTS AND DESIGNS ACT, 1907.

[PATENTS.] FORM 2.

Provisional Specification.

(*To be furnished in Duplicate.*)

(*a*) (*b*) I (or we) do hereby declare the nature of this invention to be as follows:—(*c*)

(*a*) Here insert title verbally agreeing with that in the application form.
(*b*) Here insert (*in full*) name, address and calling of applicant or applicants as in application form.
(*c*) Here begin description of the nature of the invention. The continuation of the specification should be upon wide-ruled paper of the same size, on one side only, with a margin of one inch and a half on the left hand part of the paper. The specification and the duplicate thereof must be signed at the end and dated thus: "Dated the day of , 19 ."

PATENTS AND DESIGNS ACT, 1907.

[Where provisional specification or specifications have been left, quote No. or Nos., and date or dates.
No. ——
Date ——]

[PATENT, £3.] FORM 3.

Complete Specification.

(To be furnished in Duplicate—one unstamped.)

(*a*)

(*b*) I (or we)

do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:

(*c*)

NOTE.—In the preparation of the claim or claims careful attention should be paid to the terms of Rule 14 of the Patents Rules, 1908. Any unnecessary multiplicity of claims or prolixity of language should be avoided.

(*a*) Here insert title verbally agreeing with that in the application form.
(*b*) Here insert (*in full*) name, address and calling of applicant or applicants as in application form.
(*c*) Here begin full description of invention. The continuation of the specification should be upon wide-ruled paper of the same size, on one side only, with a margin of one inch and a half on the left hand part of the paper. The completion of the description should be followed by the words: "Having now particularly described and ascertained the nature of my (or our) said Invention and in what manner the same is to be performed, I (or we) declare that what I (or we) claim is:" After which should be written the claim or claims numbered consecutively. The specification and the duplicate thereof must be signed at the end and dated (thus): "Dated the day of , 19 ."

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £3.] FORM 4.

Form of Appeal to Law Officer.

(*a*) I (or we) hereby give notice of my (or our) intention to appeal to the Law Officer from (*b*) of the of the day of 19 , whereby he (*c*)
No. (*d*) of the year 1 (*d*)

Signature ———
Date ———

NOTE.—This notice must be sent to the Comptroller-General at the Patent Office, London, W.C., and an unstamped copy of the same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

(*a*) Here insert (in full) name and address of appellant or appellants.
(*b*) Here insert "the decision" or "that part of the decision," as the case may be.
(*c*) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.
(*d*) Insert number and year.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £2, £4 or £6.] FORM 5.

Form of Application for Extension of Time for Leaving Copy or Copies of the Foreign Specification or Specifications, Drawings or Documents under Rule 16.

I (or we) hereby apply for month extension of time for leaving copy or copies of the foreign specification or specifications, drawings or documents under Rule 16 in respect of application No. of 1 .

(*a*) ———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) To be signed by applicant or applicants or his or their agents.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £2.] FORM 6.

Form of Application for Extension of Time for Leaving a Complete Specification.

I (or we) hereby, in respect of application No. .. dated , apply for one month's extension of time in which to leave a Complete Specification.

(*a*) ——

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) To be signed by applicant or applicants or his or their agent.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £2, £4, or £6.] FORM 7.

Form of Application for Extension of Time for Acceptance of a Complete Specification.

I (or we) hereby apply for month extension of time for the acceptance of the Complete Specification upon application No. dated .

(*a*) ——

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) To be signed by applicant or applicants or his or their agent.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 10*s.*] FORM 8.

Form of Opposition to Grant of Patent.

[*To be accompanied by an unstamped copy.*]

*I (or we)

hereby give notice of my (or our) intention to oppose the grant of Letters Patent upon application No. of , applied for by

upon the ground†

My (or our) address for service in the United Kingdom is :—

‡ ———

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

* Here state (*in full*) name and address.

† Here state upon which of the grounds of opposition permitted by section 11 of the Act the grant is opposed. Where the ground or one of the grounds of opposition is that the invention has been claimed in any complete specification which is or will be of a prior date, the number and date of such prior specification should be stated. Where the person giving notice of an opposition does not desire that the patent should be refused, but merely that the specification should be amended by disclaimer or limitation, it is desirable that the notice of opposition should be accompanied or supplemented as soon as may be by a written statement to that effect indicating so far as can conveniently be done the general nature of the amendments desired and the portions of the earlier specifications if any relied upon as necessitating such amendments.

‡ To be signed by opponent or opponents.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1 or £2.] FORM 9.

Form of Notice that Hearing of Opposition before the Comptroller will be attended.

(*a*) I (or we) hereby give notice that the hearing in reference to will be attended by myself (or ourselves) or by some person on my (or our) behalf.

(*b*)———

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

(*a*) Here insert (*in full*) name and address.

(*b*) Signature.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 10.

Form of Notice of Desire to have Patent Sealed.

(*a*) 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, and request that the following may be entered on the Register as my (or our) address for service :—

(*b*)———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) Here insert name of applicant or applicants.
(*b*) Signature of applicant or applicants or his or their agent.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £2, £4, or £6.] FORM 11.

Form of Application for Extension of Time for the Sealing of a Patent where the Period allowed for the Sealing of the Patent will Expire after the commencement of the Act.

I (or we) hereby apply for months' extension of time for the sealing of a patent upon application No. , dated .

The circumstances and grounds upon which this extension is applied for are as follows (*a*):—

(*b*)———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) The circumstances and grounds must be stated in detail.
(*b*) To be signed by the applicant or applicants, or his or their agent.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £10.] FORM 12.

Form of Application for Extension of Time for the Sealing of a Patent where the Period allowed for the Sealing of the Patent has Expired before the commencement of the Act.

I (or we) hereby apply for an extension of time not exceeding three months after the commencement of the Act for the sealing of a patent upon application No. , dated .

The circumstances in and grounds upon which this extension is applied for are as follows (*a*):—

(*b*)——

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) The circumstances and grounds must be stated in detail.
(*b*) To be signed by the applicant or applicants, or his or their agent.

(When stamped this Form must be sent at once to the Patent Office.)

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £5 to £14.] FORM 13.

Application for Certificate of Payment or Renewal.

I (or we) hereby transmit the fee prescribed for the continuation in force of* Patent No. of 1 for a further period of .

It is requested that the address for service of the patentee in the United Kingdom shall be:—

Name †——
Address——

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert name of patentee.
† Here insert name and full address to which Certificate is to be sent.

(*This part of the Form to be filled in at the Patent Office.*)

Certificate of Payment or Renewal.

Letters Patent No. of 1 .

This is to certify that did this day of 19 , 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.)

The Patent Office, London.

* *See* section 17 of the Patents and Designs Act, 1907.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1, £3, or £5.] FORM 14.

Form of Application for Enlargement of Time for Payment of Renewal Fee.

I (or we) hereby apply for an enlargement of time for month in which to make the payment of upon my (or our) Patent, No. of 1 .

(*b*)——

To the Comptroller,
The Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*b*) Here insert name and full address to which receipt is to be sent.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £20.] FORM 15.

Form of Application for the Restoration of a Lapsed Patent under Section 20 of the Act.

I (or we) hereby apply for an order of the Comptroller for the restoration of the patent granted upon Application No. dated .

The circumstances which have led to the omission of the payment of the fee of (*a*) on or before the (*b*) are as follows:—(*c*)

(*d*)——

To the Comptroller,
The Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*a*) State amount of fee.
(*b*) State last day when fee was due.
(*c*) The circumstances must be stated in detail.
(*d*) To be signed by the applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 16.

Form of Notice of Opposition to an Application for the Restoration of a Lapsed Patent.

[To be accompanied by an unstamped copy.]

* I (or we) hereby give notice of opposition to the application for restoration of the patent granted upon Application No. dated for the following reason :—†

My (or our) address for service in the United Kingdom is :—

‡———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state (in full) name and address of opponent or opponents.
† Here state reason of opposition.
‡ To be signed by the opponent or opponents.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1 10*s.* or £3.] FORM 17.

Form of Application for Amendment of Specification otherwise than under Rule 33.

* I (or we) seek leave to amend the specification of Letters Patent No. of 1 , as shown in red ink in the certified copy of the original specification hereunto annexed.

† I (or we) declare that no action for infringement or proceedings before the Court for the revocation of the Letters Patent in question is pending.

My (or our) reasons for making this amendment are as follows :—

‡

My (or our) address for service in the United Kingdom is :—

§———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

N.B.—No amendment is permissible that would make the invention substantially larger or substantially different. *See* section 21 of the Act.

* Here state (in full) name and address of applicant or patentee.
† These words are to be struck out when Letters Patent have not been sealed.
‡ Here state reasons for seeking amendment ; and where the applicant is not the patentee, state what interest he possesses in the Letters Patent.
§ To be signed by applicant or patentee.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 10s.] FORM 18.

Form of Opposition to Amendment of Specification.

[*To be accompanied by an unstamped copy.*]

* I (or we) hereby give notice of opposition to the proposed amendment of the specification of Letters Patent No. of 1 for the following reason :— †

My (or our) address for service in the United Kingdom is :—

‡ ———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state (in full) name and address of opponent or opponents.
† Here state reason of opposition.
‡ To be signed by opponent or opponents.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 19.

Form of Application for Grant of Compulsory Licence or Revocation of Patent under Section 24 of the Act.

[*To be accompanied by an unstamped copy.*]

* I (or we) hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a licence to me (or us) by †

My (or our) address for service in the United Kingdom is :—

‡ ———

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. *See* Patents Form No. 20.

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state (in full) name and address of applicant or applicants.
† Here state name and address of patentee, and number and date of his patent.
‡ To be signed by applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

FORM 20.

Form of Petition for Grant of Compulsory Licence or Revocation of Patent.

To the BOARD OF TRADE.

THE PETITION of (*a*) 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 (*b*)

2. The nature of my (or our) interest in the matter of this petition is as follows :—(*c*)

3. (*d*)

The evidence (which I (or we) propose to leave at the Patent Office) accompanying this petition is as follows :—(*e*)

Having regard to the circumstances above stated, the petitioner alleges that the reasonable requirements of the public with respect to the invention patented as above stated have not been satisfied.

Your petitioner therefore pray that an order may be made granting to him (or them) a compulsory licence on the terms following, viz. :—(*f*)

or in the alternative that the said patent may be revoked.

(*g*) ———

NOTE.—In pursuance of the requirements of Rule 69, the petitioner must deliver to the patentee, and to any other person alleged to have made default, copies of the petition and of the affidavits or statutory declarations and other documentary evidence in support.

(*a*) Here insert (in full) name, address, and calling.

(*b*) Here insert title of invention.

(*c*) Here state fully the nature of petitioner's interest.

(*d*) Here state fully in detail the circumstances of the case under section 24 of the Act, and show that it arises by reason of the default of the patentee, or as the case may be, of any other person claiming an interest in the patent as exclusive licensee or otherwise.

(*e*) Here state what affidavits or statutory declarations together with any other documentary evidence will be left at the Patent Office with the petition as required by Rule 69.

(*f*) Here state the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

(*g*) Signature.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 21.

Form of Opposition to Petition for Grant of Compulsory Licence or Revocation of Patent under Section 24.

(*a*) I (or we) hereby give notice of opposition to the petition of for the grant of a compulsory Licence under Patent No. of 1 , or in the alternative, for the revocation of the said patent. The grounds upon which I (or we) oppose the said application are as follows, viz. :—(*b*)

My (or our) address for service in the United Kingdom is :—

(*c*)———

NOTE.—In pursuance of the requirements of Rule 70, copies of the affidavits or statutory declarations in reply to the evidence left with the petition must be delivered to the petitioner.

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

(*a*) Here state (in full) name and address of opponent or opponents.
(*b*) Here state fully the grounds of opposition.
(*c*) To be signed by the opponent or opponents.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £2.] FORM 22.

Form of Application to the Comptroller for an Order for the Revocation of a Patent under Section 26 of the Act.

* I (or we) hereby apply for an Order for the revocation of the patent granted upon Application No. dated on the following grounds : †

No action‡ for infringement or proceedings for the revocation of the patent are pending.

My (or our) address for service in the United Kingdom is :

§———

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

* Here state (in full) name and address of applicant or applicants, for revocation.

† The ground or grounds of an application for revocation under section 26 of the Act, must be any one or more of the grounds on which the grant of the patent might have been opposed. Where the ground or one of the grounds of opposition is that the invention has been claimed in any complete specification which is or will be of a prior date, the number and date of such prior specification should be stated.

‡ If such an action is pending in any Court the application cannot be made without the leave of the Court.

§ To be signed by the applicant, or applicants, for revocation.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £1.] FORM 23.

Form of Offer to Surrender a Patent under Section 26 of the Act.

* I (or we) hereby offer to surrender the patent granted upon Application No. dated .

No action‡ for infringement or proceedings for the revocation of the patent are pending.

My (or our) reasons for making this offer are as follows :

My (or our) address for service in the United Kingdom is :

†———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state (in full) name and address of patentee or patentees.
‡ If any action or proceedings are pending, state what is their nature.
† To be signed by the patentee or patentees.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £2.] FORM 24.

Form of Application for Revocation of a Patent under Section 27 of the Act.

I (or we)* hereby apply for the revocation of Letters Patent No. of 1 , on the ground that the patented article (or process) is manufactured [or carried on] exclusively or mainly outside the United Kingdom.

My (or our) address for service in the United Kingdom is :

†———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state (in full) name and address of applicant, or applicants, for revocation.
† To be signed by applicant, or applicants, for revocation.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 5s.] FORM 25.

Form of Notice for Alteration of a Name or an Address or an Address for Service in Register of Patents.

In the matter of Patent No. of

(*a*) I (or we) hereby request that name, address [or address for service] now upon the Register of Patents may be altered to (*b*)

(*c*)———

To the Comptroller,
The Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*a*) Here state (in full) name or names and address of applicant or applicants.
(*b*) Here insert name, or full address.
(*c*) Signature of applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 5s.] FORM 26.

Form of Request for entry of two Addresses for Service in Register of Patents.

In the matter of Patent No. of

(*a*) I (or we) hereby request that the two following addresses for service may be entered in the Register of Patents :—

(*b*) (1)
(2)

(*c*)———

To the Comptroller,
The Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*a*) Here state (in full) name or names and address of applicant or applicants.
(*b*) Here insert full addresses.
(*c*) Signature of applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 10*s.*] FORM 27.

Form of Request to enter Name of Proprietor upon the Register of Patents.

(*a*) I (or we) hereby request that you will enter my (or our) name (or names) in the Register of Patents as proprietor of Patent No. of 1 granted to (*b*) the title of which is (*c*)

I (or we) claim to be so entitled by virtue of (*d*)

And in proof whereof I (or we) transmit the accompanying (*e*) with an attested copy thereof.

My (or our) address for service in the United Kingdom is:—

(*f*) ———

(*g*) ———

To the Comptroller,

The Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

(*a*) Here insert (in full) name, address, and calling.
(*b*) Here give name and address of person to whom Patent was granted.
(*c*) Here insert title of the invention.
(*d*) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.
(*e*) Here insert the nature of the document.
(*f*) Signature.
(*g*) Here state in what capacity the signatory is acting.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 10*s.*] FORM 28.

Form of Request to enter in the Register of Patents a Notice of an Interest in a Patent.

(*a*) I (or we) hereby request that you will enter in the Register of Patents a notice of the following interest in a patent:—

I (or we) claim to be entitled (*b*) to an interest in Patent

(*a*) Here insert (in full) name, address, and calling.
(*b*) Here insert the nature of the claim, whether by way of Mortgage, Licence or otherwise.

No. of 1 , granted to (*c*) the title of which is (*d*) by virtue of (*e*)

And in proof whereof I (or we) transmit the accompanying (*f*) with an attested copy thereof.

My (or our) address for service in the United Kingdom is :—

(*g*) ——

(*h*) ——

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*c*) Here give name and address of person to whom Patent was granted.
(*d*) Here insert title of the invention.
(*e*) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.
(*f*) Here insert the nature of the document.
(*g*) Signature.
(*h*) Here state in what capacity the signatory is acting.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 10*s*.] FORM 29.

Form of Request to enter Notification of Document in the Register of Patents.

I (or we) HEREBY transmit an attested copy of (*a*) under Patent No. of 1 , as well as the original document for verification, and I (or we) have to request that a notification thereof may be entered in the Register.

(*b*) ——

(*c*)

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) Here insert a description of the nature of the document, giving its date and the names and addresses of the parties thereto.
(*b*) Signature.
(*c*) Here insert full address of party benefiting under the document.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 5*s.* or £1.] FORM 30.

Form of Request for Correction of Clerical Errors.

I (or we) hereby request that the following clerical error (*a*) in the (*b*) No. of 1 , may be corrected in the manner shown in red ink in the certified copy of the original (*b*) hereunto annexed.

(*c*) ——
(*d*) ——

To the Comptroller,
The Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*a*) Or errors.
(*b*) Here state, whether in application. specification or register.
(*c*) Signature.
(*d*) Address in full.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 5*s.*] FORM 31.

Request for Certificate of Comptroller.

In the matter of the Patent No. of 1
I (or we) of hereby request you to furnish me (or us) with your Certificate to the effect that (*a*)

(*b*) ——

Dated the day of 19 .

To the Comptroller,
The Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*a*) Here set out the particulars which the Comptroller is requested to certify.
(*b*) Name and full address to which certificate is to be sent.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, £2.] FORM 32.

Application for Duplicate of Patent.

Date.

I (or we) REGRET to have to inform you that the Patent dated* No. granted to for an invention the title of which is † has been ‡

I (or we) beg therefore to apply for the issue of a duplicate of such Patent §

‖———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert date, number, full name, and address of grantee or grantees.
† Here insert title of invention.
‡ Here insert the word "destroyed" or "lost," as the case may be, and state, in full, the circumstances of the case, which must be verified by statutory declaration.
§ Here state interest possessed by applicant, or applicants, in the Patent.
‖ Signature of patentee or patentees.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 10*s*.] FORM 33.

Notice of Intended Exhibition of an Unpatented Invention.

* I (or we) hereby give notice of my (or our) intention to exhibit a of at the Exhibition, which† on the day of 19 under the provisions of the Patents and Designs Act, 1907.

‡ I (or we) herewith enclose a brief description of my (or our) invention.

‖———

To the Comptroller,
The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state (in full) name and address of applicant or applicants.
† State "*opened*" or "*is to open.*"
‡ This description of invention should be accompanied by drawings if necessary.
‖ To be signed by the applicant or applicants.

PATENTS AND DESIGNS ACT, 1907.

[PATENT, 10*s.*] FORM 34.

Form of Application for Entry of Order of Court in Register.

(*a*) I (or we) hereby transmit an office copy of an Order of the Court with reference to (*b*)

(*c*)———

To the Comptroller,
The Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

(*a*) Here state (in full) name and address of applicant or applicants.
(*b*) Here state the purport of the order.
(*c*) Signature.

PATENTS AND DESIGNS ACT, 1907.

FORM 35.

Postal Request for Printed Specification.

To the Comptroller.

Please send one copy of Specification, No. Year to
(*Name in full*)———
(*Address*)———

[PATENTS, 7½*d.*] [½*d.*]

The Comptroller,
The Patent Office, 25, *Southampton Buildings,*
London, W.C.

THE THIRD SCHEDULE.

FORM A.

Form of Patent.

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

WHEREAS hath declared that he is in possession of an invention for that he claims to be the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

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

And whereas the said inventor (herein-after together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of his invention:

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

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

Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by Us and the same may be revoked and made void accordingly: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating

thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything herein-before contained: Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted: And lastly, We do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.

In witness whereof We have caused these our letters to be made patent and to be sealed as of the
one thousand nine hundred and

* ———

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

[Seal of Patent Office.]

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

FORM B.

Form of Patent of Addition.

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

Whereas hath declared that he is in possession of an invention for that he claims to be the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief, and that the said invention is an improvement in or modification of his invention for which a patent was applied for on and numbered and on which a patent (hereinafter called the original patent) has been granted for which he was the applicant (or of which he is the patentee).

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

And whereas the said inventor (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of his invention, and has requested that the term limited in such patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired:

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

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

Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for

revoking letters patent granted by Us, and the same may be revoked and made void accordingly: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of the said original letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything herein-before contained: Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.

In witness whereof we have caused these our letters to be made patent and to be sealed as of the
one thousand nine hundred and

* ———

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

[Seal of Patent Office.]
Dated the 17th of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

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

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

I. When any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall within 14 days from the date of the decision appealed against file in the Patent Office a notice of his intention.

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

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the Chief Clerk, Law Officers' Department at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or applicant as the case may be.

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

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, except with the leave of the law officer upon application for that purpose.

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

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

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

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an

order for payment under the provisions of section 40 of the Act.

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 Law Officers' Department.

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

JOHN L. WALTON,
Attorney-General.

W. S. ROBSON,
Solicitor-General.

Law Officers' Department,
11th December, 1907.

RULES OF THE SUPREME COURT (PATENTS AND DESIGNS), 1908. DATED JUNE 3, 1908.

ORDER LIIIA.

Procedure in Actions for Infringements of Patents and under the Patents and Designs Act, 1907.

1. In this Order:—

"The Act" means the Patents and Designs Act, 1907.

"The Comptroller" means the Comptroller-General of Patents, Designs and Trade Marks.

"The Court" includes the Judge of the High Court for the time being selected by the Lord Chancellor as the Court for the purpose of hearing appeals and petitions under the Act.

2. The Rules of the Supreme Court for the time being in force shall apply so far as may be practicable (unless by the Act or by these Rules otherwise expressly provided), to all proceedings before the Court under the Act. In particular, if the Court is for the time being a Judge of the Chancery Division, the provisions of Order 5, rule 9 (A) shall apply to all such proceedings, as being business assigned to the Court within the meaning of that rule.

3. In the case of petitions for the extension of the term of a patent under section 18 of the Act, the following rules shall apply:—

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

(*b.*) If the applicant's principal place of business is situated in the United Kingdom at a distance of fifteen miles or more from Charing Cross he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no such place of business, then if he carries on the manufacture of anything made under his specification in the United Kingdom at a distance of fifteen miles or more from Charing Cross he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no such place of business and carries on no such manufacture

in the United Kingdom, then if he resides in the United Kingdom at a distance of fifty miles or more from Charing Cross he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

(*c.*) The applicant shall in his advertisements state the object of his petition and shall give notice of the day (which if the Court is for the time being a Judge of the Chancery Division shall be an ordinary petition day) on which he intends to apply to the Court for a day to be fixed before which the petition shall not be in the paper for hearing (hereinafter called "the appointed day"), which first mentioned day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the "London Gazette." Every such advertisement shall state an address within the United Kingdom for service on the applicant of any document requiring service under this rule. He shall also give notice that notices of objection must be lodged as hereinafter provided before such day so named in the said advertisements. A copy of such advertisement shall be forwarded by the applicant to the Solicitor for the Board of Trade at the same time as the first advertisement is sent to the "London Gazette," and the Board of Trade shall thereupon cause such advertisement to be in inserted in the three following issues of the Illustrated Official Journal (Patents).

(*d.*) A petition under section 18 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the "London Gazette," and a copy of the petition must within the same time be furnished to the Solicitor to the Board of Trade. Such petition shall be made returnable for the day named in the advertisements.

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

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

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

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

(*i.*) The petitioner shall also lodge as hereinafter provided, not less than three weeks before the appointed day, two copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Court at the hearing. He shall also at the same time furnish three copies of the specification and of the said balance sheet to the solicitor of the Board of Trade, and shall upon receiving two days' notice give the solicitor to the Board of Trade or any person deputed by him for the purpose reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance sheet or from which the materials for making up the said balance sheet have been derived.

(*j.*) Any person desirous of opposing the prayer of a petition under section 18 of the Act shall lodge as hereinafter provided a notice that he intends so to oppose and giving an address in the United Kingdom for service of any document requiring service under this rule. Such person shall at the same time serve upon the petitioner a copy of such notice. Such notices shall be respectively lodged and served before the day named in the petitioner's advertisements as that on which he intends to apply to the Court for the appointed day to be fixed.

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

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

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

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

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

(*p.*) The petition shall not be entered in the list for trial until the expiration of the time limited for the lodging and service of the particulars of objections, and shall only be entered for trial on the lodging of an affidavit on behalf of the petitioner that all persons who have served him with notice of intention to oppose the prayer of his petition have been served with copies of the petition. The petition shall, if and so long as the Court is a judge of the Chancery Division and subject to any direction of the Court to the contrary be set down in the same manner as if it had been a witness action assigned to that judge and shall be marked in the witness list not before the of 190 being the appointed day.

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

(*r.*) All petitions, documents, and copies by these rules required to be lodged shall if and so long as the Court is a judge of the Chancery Division be lodged at the chambers of the judge, and subject as aforesaid shall be lodged with such person and at such place as the Court may from time to time direct.

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

(*t.*) The Comptroller if he elects or is directed to appear on the question of granting the prayer of any petition under section 18 of the Act shall not be required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Court.

(*u.*) The Court may in cases where opposition has been entered to the prayer of a petition under section 18 of the Act give costs to or against such opponents.

(*v.*) In the event of the Court refusing the prayer of the petition the Court shall not except under special circumstances give more than one set of costs amongst all the opponents.

(*w.*) The Comptroller-General and the Board of Trade shall not be entitled to any costs on or in relation to their appearance on or opposition to the granting of the prayer of a petition.

(*x.*) Service of any document requiring service under this rule may be made by enclosing such document in a prepaid registered letter and posting such letter to the person required to be served at his address for service.

4. All appeals to the Court from any decision of the Comptroller under sections 20, 26, or 27 of the Act shall be brought by petition presented to the Court within one calendar month of the decision of the Comptroller or within such further time as the Court may under special circumstances allow. Each such petition shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision. It shall also state concisely the grounds of the appeal, and no grounds, other than those so stated, shall, except with the leave of the Court to be given on such terms and conditions as may seem just, be allowed to be taken by the appellant at the hearing.

5. Every appeal to the Court under sections 20, 26, or 27 of the Act shall, if and so long as the Court is a judge of the Chancery Division, and subject to any direction of the Court to the contrary, be set down in the same manner as if it were a witness action assigned to such judge and be heard and disposed of in due course.

6. In all proceedings before the Court under sections 20, 26, and 27 of the Act, the evidence used shall be the same as that used at the hearing before the Comptroller and no further evidence shall be given except by the leave of the Court on application to be made to the Court at or before the hearing.

7. In all petitions referred by the Board of Trade to the Court under section 24 of the Act the following Rules shall apply:—

(*a.*) No evidence shall be given upon any issues other than those raised upon the original petition before the Board of Trade.

(*b.*) Every person who has given notice of opposition in accordance with the Patent Rules, 1908, shall be entitled to be heard on such petition, and the Court may direct the petition to be served or notice thereof to be given to such other person or persons as may be thought desirable.

(*c.*) The petition shall if and so long as the Court be a judge of the Chancery Division and subject to any direction of the

Court to the contrary be set down in the same manner as if it were a witness action assigned to such judge.

(*d.*) The petition shall be heard by the Court as a witness action and shall come on in due course in the witness list.

8. In all proceedings before the Court under the Act the Court shall have all the powers by the Act vested in the Comptroller and may make any order which might, or ought to, have been made by the Comptroller.

9. In all proceedings before the Court under the Act the costs of and incident thereto, including the costs of hearings before the Comptroller or the Board of Trade, as the case may be, shall be in the discretion of the Court (except as hereinbefore expressly provided in the case of petitions under section 18 of the Act).

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

11. Any person presenting a petition for the revocation of a patent under section 25 of the Act must deliver with his petition particulars of the objections to the validity of the patent on which he means to rely and no evidence shall, except by leave of the Court, be admitted in proof of any objection of which particulars are not so delivered.

12. The respondent to a petition for the revocation of a patent under section 25 of the Act shall be entitled to begin and give evidence in support of the patent and if the petitioner gives evidence impeaching the validity of the patent the respondent shall be entitled to reply.

13. In an action for infringement of a patent the plaintiff must deliver with his statement of claim particulars of the breaches relied upon.

14. In an action for infringement of a patent the defendant if he disputes the validity of the patent must deliver with his defence particulars of the objections on which he relies in support of such invalidity.

15. A defendant in an action for infringement of a patent who

under section 32 of the Act counterclaims in the action for the revocation of the patent shall with his counterclaim deliver particulars of any objection to the validity of the patent on which he relies in support of his counterclaim.

16. Particulars of breaches shall specify which of the claims in the specification of the patent sued upon are alleged to be infringed and shall give at least one instance of each type of infringement of which complaint is made.

17. Particulars of objections (whether delivered with the defence in an action for infringement of patent or with a petition for revocation under section 25 of the Act or with a counterclaim for revocation under section 32 of the Act) must state every ground upon which the validity of the patent is disputed and must give such particulars as will clearly define every issue which it is intended to raise.

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

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

19. Particulars of breaches and particulars of objection may from time to time be amended by leave of the Court upon such terms as may be just.

20. Further and better particulars of breaches or particulars of objections may at any time be ordered by the Court.

21. At the hearing of any action, petition or counterclaim relating to a patent no evidence shall except by leave of the Court (to be

given upon such terms as to the Court may seem just) be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.

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

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

23. Where an application is made by a patentee for leave to amend his specification by way of disclaimer under section 22 of the Act, the following rules shall apply :—

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

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

(*c.*) If the application be allowed to proceed the applicant shall forthwith serve the Comptroller with a copy of the notice of motion together with such copy specification as aforesaid and also a copy of the order allowing the application to proceed, and also with the name and address of the applicants' solicitor and the proposed amendment shall be advertised in the Illustrated Official Journal (Patents), such advertisement stating that any person desiring to oppose the

amendment must within fourteen days of the issue of the advertisement give notice in writing of such desire to the applicants' solicitors, whose name and address for that purpose shall be also stated in the advertisement. Any person giving such notice shall be entitled to be heard upon the hearing of the motion.

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

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

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

24. These rules may be cited as the Rules of the Supreme Court (Patents and Designs), 1908, and shall be read with the Rules of the Supreme Court, 1883.

Loreburn, C.
Alverstone, C.J.
H. H. Cozens-Hardy, M.R.
Roland L. Vaughan-Williams, L.J.
J. Gorell Barnes, P.
R. J. Parker, J.
Christopher James.

The 3rd day of June, 1908.

THE REGISTER OF PATENT AGENTS RULES, 1908.
DATED DECEMBER 17, 1907.

By virtue of the provisions of the Patents and Designs Act, 1907, hereinafter referred to as the Act, the Board of Trade, hereinafter referred to as the "Board," do hereby make the following rules:—

1. These rules may be cited as the Register of Patent Agents Rules, 1908.

Register to be kept.

2. A register of patent agents shall be kept by the Chartered Institute of Patent Agents (hereinafter called the institute), subject to the provisions of these rules and to the orders of the Board, for the registration of patent agents in pursuance of section 84 of the Act. The register of patent agents existing at the commencement of the Act shall be incorporated with and form part of the register of patent agents under the Act.

Contents of register.

3. The register shall contain in one list all patent agents who are registered under the Act and these rules.

Such list shall be made out according to the surnames of the registered persons, and shall also contain the full name of each registered person, with his address, the date of registration, and a mention of any honours, memberships, or other additions to the name of the registered person which the council of the institute may consider worthy of mention in the register. The register shall be in the Form 1 in Appendix A., with such variations as may be required.

Printed copies to be published annually, and to be evidence of contents of register.

4. The institute shall cause a correct copy of the register, but with the names arranged alphabetically, to be printed under their direction and published and placed on sale. Such correct copy shall be printed and published not later than the end of February in each year. A copy of the register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act or any Act repealed by the Act.

Registrar.

5. The institute shall continue in office or appoint a registrar, who shall keep the register in accordance with the provisions of the Act and these rules, and, subject thereto, shall act under the directions of the institute, and the Board.

Registration of persons who were

6. A person who is desirous of being registered in pursuance of the Act, on the ground that prior to the 24th day of December, 1888, he

patent agents prior to the passing of this Act.

had been *bonâ fide* practising as a patent agent, shall produce or transmit to the Board a statutory declaration in the Form 2 in Appendix A.; provided that the Board may, in any case in which they shall think fit, require further or other proof that the person had prior to the passing of the Act been *bonâ fide* practising as a patent agent. Upon the receipt of such statutory declaration, or of such further or other proof to their satisfaction, as the case may be, the Board shall transmit to the registrar a certificate that the person therein named is entitled to be registered in pursuance of the Act, and the registrar shall on the receipt of such certificate cause the name of such person to be entered in the register.

Final qualifying examination for registration.

7. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board that prior to the 24th day of December, 1888, he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent unless he has passed, and produces or transmits to the registrar a certificate under the seal of the institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the institute shall from time to time prescribe.

Exemption of pupils and assistants from preliminary examination.

8. Any person who has been for at least five years engaged as a pupil or technical assistant to one or more registered patent agents, and any person for the time being entitled to practise as a solicitor of the Supreme Court of Judicature in England or Ireland, or as a law agent before the Court of Session in Scotland, shall be entitled to be registered without passing any examination other than the final examination provided for in the last preceding rule.

Qualifications of persons generally for registration.

9. Any person who is not qualified under rule 8 must, in order to be entitled to present himself for the final qualifying examination, be—

A person who has passed one of the preliminary examinations which the institute shall by regulation prescribe.

Final qualifying examinations to be held by the institute.

10. The institute shall hold at least once in every year, a final qualifying examination, which shall be the final qualifying examination required under rules 7 and 8; and the institute shall, subject to these rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters, that is to say—

(*a.*) The subjects for and the mode of conducting the examination of candidates;

(*b.*) The times and places of the examinations, and the notices to be given of examinations;

(*c.*) The certificates to be given to persons of their having passed the examinations;

(*d.*) The appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and

(*e.*) Any other matter or thing as to which the institute may think it necessary to make regulations for the purpose of carrying out this rule.

Corrections of names and addresses in register.

11. The registrar shall from time to time insert in the register any alteration which may come to his knowledge in the name and address of any person registered.

Erasure of names of deceased persons.

12. The registrar shall erase from the register the name of any registered person who is dead.

Erasure of names of persons who have ceased to practise.

13. The registrar may erase from the register the name of any registered person who has ceased to practise as a patent agent, but not (save as hereinafter provided) without the consent of that person. For the purposes of this rule the registrar may send by post to a registered person to his registered address a notice inquiring whether or not he has ceased to practise or has changed his residence, and if the registrar does not within three months after sending the notice receive an answer thereto from the said person, he may, within fourteen days after the expiration of the three months, send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the registrar; and if the registrar either before the second notice is sent receives the first notice back from the dead letter office of the Postmaster-General, or receives the second notice back from that office, or does not within three months after sending the second notice receive any answer thereto from the said person, that person shall, for the purpose of this rule, be deemed to have ceased to practise, and his name may be erased accordingly.

Erasure of name for non-payment of fees.

14. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice to pay his annual registration fee; and if such registered patent agent shall not within one month from the day named in such notice pay the registration fee so due from him, the registrar may erase his name from the register: Provided that the name of a person erased from the register under this rule may be restored to the register by direction of the institute or the Board on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the institute or the Board (as the case may be) may in each particular case direct.

Registrar to act on evidence.

15. In the execution of his duties the registrar shall, subject to these rules, in each case act on such evidence as appears to him sufficient.

Erasure of incorrect or fraudulent entries.

16. The Board may order the registrar to erase from the register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

Erasure of names of persons convicted of crimes, and persons found guilty of disgraceful conduct.

17. If any registered person shall be convicted in His Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanor, or, after due inquiry, is proved to the satisfaction of the Board to have been guilty of disgraceful professional conduct, or having been entitled to practise as a solicitor or law agent shall have ceased to be so entitled, the Board may order the registrar to erase from the register the name of such person. Provided that no person shall be adjudged by the Board to have been guilty of disgraceful professional conduct unless such person has received notice of, and had an opportunity of defending himself from, any charge brought against him.

Restoration by Board of erased name.

18. Where the Board direct the erasure from the register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the register, except by order of the Board.

The Board may in any case in which they think fit restore to the register such name or entry erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee, as the Board may from time to time fix, and the registrar shall restore the name accordingly.

Inquiry by Board of Trade before erasure of name from register.

19. For the purpose of exercising in any case the powers of erasing from and of restoring to the register the name of a person, or an entry, the Board may appoint a committee consisting of such persons as they shall think fit. Every application to the Board for the erasure from, or restoration to, the register of the name of any patent agent shall be referred for hearing and inquiry to the committee, who shall report thereon to the Board, and a report of the committee shall be conclusive as to the facts for the purpose of the exercise of the said powers by the Board.

Restoration by institute of erased name.

20. The name of any person erased from the register at the request or with the consent of such person shall, unless it might, if not so erased, have been erased by order of the Board, be restored to the register by the registrar on his application and on payment of such fee, not exceeding the registration fee, as the institute shall from time to time fix.

Appeal to Board of Trade.

21. Any person aggrieved by any order, direction, or refusal of the institute or registrar may appeal to the Board.

Notice of appeal.

22. A person who intends to appeal to the Board under these rules (in these rules referred to as the appellant) shall, within fourteen days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the institute a notice in writing signed by him of such his intention.

Case on appeal.

23. The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

Transmission of notice of appeal to Board of Trade.

24. The appellant shall also immediately after leaving his notice of appeal at the institute send by post a copy thereof with a copy of the appellant's case in support thereof addressed to the Secretary of the Board of Trade, 7, Whitehall Gardens, London.

Directions as to hearing appeal.

25. The Board may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal.

Notice of hearing of appeal.

26. Seven days' notice, or such shorter notice as the Board may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the institute and the registrar.

Hearing and decision of appeal.

27. The appeal may be heard and decided by the Board, and such decision may be given or order made in reference to the subject-matter of the appeal as the case may require.

Fees.

28. The fees set forth in Appendix B. to these rules shall be paid in respect of the several matters, and at the times and in the manner therein mentioned. The Board may from time to time alter any of, or add to, the fees payable under these rules.

Alteration of regulations.

29. Any regulation made by the institute under these rules may be altered or revoked by a subsequent regulation. Copies of all regulations made by the institute under these rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board, and if within twenty-eight days after a copy of any regulation has been so transmitted, the Board by an order signify their disapproval thereof, such regulation shall be of no force or effect; and if, after any regulation under these rules has come into force, the Board signify in manner aforesaid their disapproval thereof, such regulation shall immediately cease to be of any force or effect.

Report to Board of Trade.

30. The institute shall once every year in the month of March transmit to the Board a report stating the number of applications for registration which have been made in the preceding twelve months, the nature and results of the final examinations which have been held, and the amount of fees received by the institute under these rules, and such other matters in relation to the provisions of these rules as the Board may from time to time require.

Commencement.

31. These rules shall come into operation from and immediately

after the 31st December, 1907, and all general rules relative to the register of patent agents in force on the 31st December, 1907, shall be and are hereby repealed as from that date without prejudice nevertheless to anything done under such rules or to any application or other matter then pending.

Dated the 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

APPENDIX A.

FORM 1.

Form of Register.

Name.	Designation.	Address.	Date of Registration.

FORM 2.

Form of Statutory Declaration.

PATENTS AND DESIGNS ACT, 1907.

Register of Patent Agents pursuant to Section 84.

I, *A. B.* [*insert full name and in the case of a member of a firm add,* "a member of the firm of "], of , in the county of , Patent Agent, do solemnly and sincerely declare as follows :—

1. That prior to the 24th December, 1888, I had been *bonâ fide* practising in the United Kingdom as a patent agent.

2. That I acted as patent agent in obtaining the following patents :—

[*Give the official numbers and dates of some patents for the United Kingdom in the obtaining of which the declarant acted as patent agent.*]

3. That I desire to be registered as a patent agent in pursuance of the said Act.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at .

APPENDIX B.

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 30th of each year, in respect of the year commencing January 1st following.	Do. do.	2 2 0
On entry of a candidate for the final qualifying examination.	At time of entering name.	Do. do.	2 2 0

Dated the 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade

MEMORANDUM FOR INVENTORS.

WAR OFFICE,
6th August, 1904.

In consequence of the numerous claims for compensation for loss of time and for expenses incurred by private individuals in working out inventions of various kinds, as well as for rewards in consequence of the use of such inventions, the Army Council consider it necessary to make known the following regulations:—

1. By section 27 of the "Patents, Designs, and Trade Marks Act, 1883," it is enacted as follows:—

"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."

"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 service 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."

2. Persons who desire to submit any invention for consideration should do so by letter addressed to the Secretary, War Office, London. The letter should state the nature of the invention; whether patented or not; if patented, it should quote number and date of patent. It should also state whether the person who offers it for consideration desires to make any claim for remuneration in connection with it. In the absence of such a statement, it will be assumed that no such remuneration is expected.

3. Expenses or loss of time incurred before or after the submission of an invention will give no claim unless authority for such expenses has been previously given by signed letter from this office, and the liability will be strictly confined to the limits of expenditure authorised in such letter.

4. Should the invention be adopted into the service, the person or persons who submitted the same may be required to furnish two copies of all designs, drawings, or particulars relating to the invention which may be desired by the War Department, as well as any patterns which may be considered necessary; and it is to be under-

stood that all such drawings, designs, and patterns will be absolutely at the disposal of his Majesty's Government for all purposes whatever. Reasonable prices will be paid by the War Department for the designs, drawings, and patterns supplied.

5. No claim for reward for an invention will be held to be established unless the invention has been adopted into the service, and all designs, drawings, patterns, and particulars required by the War Department have been supplied, under the conditions mentioned above.

6. All claims for remuneration will be carefully considered; but any award which may be made will only be payable to the claimant when approved by the Treasury, and money is available from funds voted by Parliament for such purposes.

7. The above rules do not apply to inventions patented by such Government employés as are required to obtain official permission before taking out a patent, with regard to whom special regulations are in force.

E. W. D. WARD.

INSTRUCTIONS TO APPLICANTS FOR PATENTS.

1. General.—The grant of patents is now governed by the Patents and Designs Act, 1907, and the Patents Rules, 1908. For information as to obtaining copies of the Act and Rules, *see* page 616.

2. Who may apply for a Patent in the United Kingdom.—Any person, whether a British subject or not, may make an application for a patent, provided that he is the true and first inventor, or applies jointly with the true and first inventor or inventors, or has received the invention from abroad.

Any person who has made a previous application for a patent in any of the foreign states or British possessions with which arrangements for mutual protection of inventions (see par. 21) have been made may obtain priority in the United Kingdom. (See page 595.)

Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly. The true and first inventor (or inventors) must be a party (or parties) to the application, except in the case of an invention received from abroad or of an application under the international or colonial arrangements.

A company (body corporate) or a firm or partnership, may apply for a patent as joint applicant with the inventor, but not as sole applicant, unless the application is made in respect of an invention communicated from abroad or under the international or colonial arrangements. In the case of a company the application should be made under its seal.

If an inventor dies without making an application for a patent for an invention, his legal representative may apply for a patent for such invention.

3. What may be patented.—Patents are only granted for inventions the subject-matter of which is "a manner of manufacture" within the meaning of section 93 of the Patents and Designs Act, 1907. For example, the rights of an author in the production of a book are protected by copyright and not by a patent.

Applications for patents would not be accepted in the following cases:—

(*a.*) Where no material product of a substantial character is realised or affected by the alleged invention, or where the only material product is a printed sheet, ticket, coupon, or its equivalent, for use in carying out some scheme of business or the like.

(*b.*) Where it is proposed to use, modify, or imitate natural conditions existing on the earth's surface, there being no invention as to the means or apparatus applied to these purposes.

A patent cannot be granted for an invention the use of which is contrary to law or morality. For example, a patent would not be granted for a lottery.

An application for a patent must be restricted to one invention. Several distinct matters are not deemed to constitute one invention merely because they are all applicable to or may form parts of an existing machine, apparatus, or process.

4. Manner of Applying for a Patent.—All applications and communications must be made in English.

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

No models are required.

Applications for patents should be left at the Patent Office by hand or sent by post, addressed to the Comptroller, The Patent Office, 25, Southampton Buildings, London, W.C.

Applicants must use the appropriate stamped forms (see par. 5) as fees cannot be paid by cheque or money order or in cash.

5. Patent Forms and Fees.—The following is a list of the forms and fees relating to patents. (*Here follows a list as in the Patents Rules.*)

Stamped forms can be obtained on personal application at the Inland Revenue Office (Room 32), The Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C., or, at a few days' notice and upon prepayment of the value of the stamp, at any money order office in the United Kingdom.

Patent Forms Nos. 1, 1A, 3, and 10 *already stamped* and 2 are *usually kept on sale* at the undermentioned places:—

The London Chief Office.	Charing Cross Branch Office, W.C.
Eastern District Office, 206, Whitechapel Road, E.	Lombard Street Branch Office, E.C.
South Eastern District, 239, Borough High Street.	North Western District Office, 28, Eversholt Street, Camden Town, N.W.
	Post Office, 44, Parliament Street, S.W.

and the chief post office of the undermentioned cities and towns:—

In England and Wales.			
Accrington.	Bacup.	Blackburn.	Burnley.
Altrincham.	Barnsley.	Bolton.	Burslem.
Ashton-under-Lyne.	Bath.	Bournemouth.	Bury.
	Bedford.	Bradford.	Cambridge.
	Birkenhead.	Brighton.	Cardiff.
	Birmingham.	Bristol.	Carlisle.

Chatham.
Cheltenham.
Chester.
Coventry.
Croydon.
Darwen.
Derby.
Devizes.
Dewsbury.
Doncaster.
Dorchester.
Driffield.
Droitwich.
Dudley.
Durham.
Exeter.
Gloucester.
Goole.
Greenwich.
Halifax.
Hanley.
Hartlepool.
Huddersfield.
Hull.
Ipswich.
Keighley.
Kidderminster.
Leamington.
Leeds.
Leicester.
Lichfield.
Lincoln.
Liverpool.
Macclesfield.
Manchester.
Middlesbrough.
Newcastle.
Newport (Mon.).
Northallerton.
Northampton.
Norwich.
Nottingham.
Nuneaton.
Oldbury.
Oldham.
Plymouth.
Pontypridd.
Portsmouth.
Preston.
Reading.
Redditch.
Rochdale.
Rotherham.
Rugby.
Salford.
St. Helens.
Scarborough.
Sheffield.
Southampton.
Stafford.
Stalybridge.
Stockport.
Stockton-on-Tees.
Stoke-on-Trent.
Stourbridge.
Stroud.
Sunderland.
Swansea.
Tamworth.
Truro.
Tunstall.
Wakefield.
Walsall.
Warrington.
West Bromwich.
Widnes.
Wigan.
Wolverhampton.
Woolwich.
Worcester.
York.

IN SCOTLAND.

Aberdeen.
Dundee.
Edinburgh.
Glasgow.
Greenock.
Inverness.
Leith.
Perth.

IN IRELAND.

Belfast.
Dublin.
Galway.
Limerick.
Waterford.
Wexford.

If it should not be convenient to apply in either of the ways above specified, the stamped forms can be ordered by post from the Controller of Stamps, Room 5, Inland Revenue Office, Somerset House, London, W.C. In this case a bankers' draft or a money or postal order payable to the Commissioners of Inland Revenue and crossed Bank of England, to cover the value of the stamp and the cost of transmitting the form in a registered envelope by post, must be forwarded to Somerset House with the application for the form. Cheques will not be accepted.

6. Documents required on Application for a Patent.—An application for a patent consists of an application form and a specification (either provisional or complete). The forms must bear the prescribed stamp fees, and the specification should be in duplicate. The application must be made on one of six forms:—

Patents Form No. 1.—For ordinary applications.
" " 1A.—For applications for patents for inventions communicated from abroad to someone in the United Kingdom.
" " 1B.—For applications under the international and colonial arrangements.
" " 1C.—For applications for patents of addition.
" " 1C*.—For applications for patents of addition under the international and colonial arrangements.
" " 1D.—For applications for secret patents under section 30.

An application can either be made by direct communication with the office or through an agent duly authorised to the satisfaction of the Comptroller and resident or having a place of business in the United Kingdom or the Isle of Man. The application must be signed by the applicant or applicants, and, unless an agent is employed, an address for service in the United Kingdom must be given.

In an ordinary case an application for a patent may be made in either of two ways:—

(1.) The applicant may apply in the first instance with a provisional specification, using Patents Form No. 1 (stamped 1*l.*), accompanied by two Patents Forms No. 2 (unstamped); and may leave his complete specification (stamped 3*l.*) at any later period within six months, or, with application for extension of time on Patents Form No. 6 (stamped 2*l.*), within seven months.

(2.) The applicant may leave his complete specification at the time of making his application, using Patents Form No. 1 (stamped 1*l.*), accompanied by two Patents Forms No. 3 (one copy stamped 3*l.* and one unstamped).

Communication from Abroad.—In cases of applications for patents for inventions communicated from abroad, the person to whom the invention is communicated will be treated in all respects as the actual applicant, and the patent will be issued to such person. Assignment to the communicator can subsequently be effected in the usual manner (see par. 17).

Application under the International and Colonial Arrangements (see par. 21).—An application in the United Kingdom for a patent having priority of date under the international and colonial arrangements must be made within 12 months from the date of the *first* foreign or colonial application and be accompanied by a complete specification. The application must be in the name of and signed by the person or persons by whom the first foreign or colonial application was made, and should be accompanied (in addition to the specification) by copies of the specification and drawings or documents filed in the patent office of the foreign state or British possession in respect of the first foreign or colonial application duly certified by the official chief of such patent office, or otherwise verified to the satisfaction of the Comptroller; and if the specification be in a foreign language, by a translation verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

If an extension of time is required for leaving the copies of the foreign specification and drawings or documents, application should

be made on Patents Form No. 5, duly stamped. Such extension may be for one, two or three months, but cannot exceed three months.

Patent of Addition.—An applicant or patentee may apply for a patent to be called a "Patent of Addition" in respect of any improvement or modification of his invention. The patent of addition if granted will be granted for the unexpired term of the original patent and no renewal fees will be payable on such patent of addition.

Single Patent for Cognate Inventions.—An applicant who has put in two or more provisional specifications for inventions which are cognate or modifications one of the other and has obtained concurrent provisional protection for them may put in one complete specification in respect of all such applications; and if the whole of the inventions are such as to constitute a single invention, he may obtain a single patent thereon (see section 16 of the Act).

The title of the invention should cover the whole subject-matter and is not intended to be the name under which the invention is to be sold.

In the title of the invention the following forms are not allowable :—

(*a.*) Fancy names or of titles, *e.g.*, "The Simplex Wheel"; "The Hercules Braces."

(*b.*) The use of the inventor's name, or of the word "Patent."

(*c.*) The abbreviation "*etc.*" This should be replaced by words expressing whatever is intended to be covered by the term, or by the phrase "and the like."

The specifications and all other documents, except drawings (see par. 7), must be written or printed in large and legible characters with deep permanent ink on one side only of sheets of strong white paper measuring approximately 13 inches by 8 inches, leaving a margin of at least one inch and a half on the left-hand side thereof; and the signatures of the applicants or agents must be written in ink in a large and legible hand, and the several sheets should be fastened together at the top left-hand corner. At the top of the first page of a specification a space of about 2 inches should be left blank. The work of the Office is facilitated when specifications are printed or typewritten.

Provisional Specification.—The provisional specification must contain the full name, address, and calling of each applicant, and the title of the invention, all of which must be identical with those given on the application form.

It must be begun on Patents Form No. 2, and continued if necessary on foolscap paper. It must fairly describe the nature of the

invention and be accompanied by drawings if required (see par. 7). The applicant should in this document give a clear description of the invention, but he need not enter into minute details as to the manner in which the invention is to be carried into effect, and no claims are necessary. The specification must be dated at the end, and signed by each applicant or by the authorised agents. The duplicate must be an exact copy.

Unless a complete specification, stamped 3*l.*, is left within 6 months, or with extension of time 7 months (see Patents Form No. 6), from the date of application, an application for a patent is deemed to be abandoned.

Complete Specification.—The complete specification must contain the full name, address, and calling of each applicant, and the title of the invention, all of which must be identical with those given on the application form, and, if a provisional specification has been filed, with those on Patents Form No. 2.

The complete specification must be begun upon Patents Form No. 3 (stamped 3*l.*), and continued, if necessary, on foolscap paper. The duplicate must be an exact copy, but unstamped. The specification should contain a full and detailed description of the invention, of such a nature that the invention could be carried into practical effect by a competent workman from the directions of the document alone. The specification must be accompanied by drawings if required (see par. 7).

A complete specification left after a provisional specification should refer to the number and date of the provisional specification, should contain a full and detailed description of the invention, independent of the description given in the provisional specification, and should be confined to substantially the same invention as described in the provisional specification.

It is necessary at the end of the complete specification to make a distinct and proper statement of claims, which must be clear and succinct as well as separate and distinct from the body of the specification. The claims should be preceded by the prescribed preamble given on Patents Form No. 3, and should form in brief a clear statement of that which constitutes the invention, and inventors should be careful that their claims include neither more nor less than they desire to protect by their patent. Any unnecessary multiplicity of claims or prolixity of language should be avoided.

Claims should not be made for the efficiency or advantages of the invention.

The specification must be dated at the end, and signed by each applicant or by the authorised agents.

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

Drawings, when furnished, should accompany the provisional or complete specification to which they refer, except in the case when those left with a provisional are referred to in the complete specification. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letter-press of the specification when printed should appear in the specification itself.

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 way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings must not be used.

Drawings must be on sheets which measure 13 inches from top to bottom and are either from 8 inches to $8\frac{1}{4}$ inches or from 16 inches to $16\frac{1}{2}$ inches wide, the narrow sheets being preferable.

If there are more figures than can be shown on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large figure is required, it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary. The figures should be numbered consecutively throughout and without regard to the number of sheets, and should not be more numerous than is absolutely necessary. They should be separated by a sufficient space to keep them distinct, and should be placed in an upright position on the sheet.

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

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

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

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

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

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 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.

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.

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

8. Official Examination.—On the receipt of an application, the Examiner will report whether the nature of the invention is fairly described, whether the application, specification and drawings (if any) have been prepared in the prescribed manner, whether the title sufficiently indicates the subject-matter of the invention, whether the specification comprises one invention only, and, in the case of a complete specification left after a provisional specification, whether the invention in the complete specification is substantially the same as in the provisional specification. If this report be adverse, the

Comptroller may refuse to accept the application, or may require that the application, specification or drawings be amended before he proceeds with the application, and he may direct that the application be post-dated.

When a complete specification has been filed, a search is made to ascertain whether the invention claimed has been wholly or in part anticipated in any published specification (other than a provisional specification not followed by a complete specification) filed pursuant to any application made in the United Kingdom within the preceding fifty years. If any such anticipation be found and the applicant is unable to amend his specification as required, the patent will only be granted after the insertion in the complete specification of a reference to the prior specification by way of notice to the public. The official search is not, of course, exhaustive and must not be regarded as being in any way a guarantee of the validity of the patent.

9. Acceptance of Complete Specification.—The complete specification must be accepted within 12 months or with extension of time 13, 14, or 15 months from the date of application aud if not so accepted the application becomes void and cannot be further proceeded with.

On the acceptance of a complete specification, the Comptroller gives notice thereof to the applicant, and the acceptance is advertised in the Illustrated Official Journal of Patents.

Any person (other than the applicant) wishing to be informed as soon as a complete specification is accepted, should forward a Patents Form No. 31 requesting such information.

10. Public Inspection of Specifications.—The provisional specification (if any) and the complete specification are not open to public inspection, for searches or for copying, until after the acceptance of the complete specification, except in the case of an application made under the international or colonial arrangements, where the complete specification, if not already accepted, becomes open to public inspection at the end of 12 months from the date of the first foreign application. The specifications of abandoned or void applications (except in the case of void applications under the international or colonial arrangements) are not printed or open to inspection.

Upon the acceptance of a complete specification, the application, specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee of one shilling.

Specifications are printed fifteen days after the advertisement of the acceptance of the complete specification.

11. Opposition to the Grant of a Patent.—A patent is granted, subject to the payment of a sealing fee, upon an application which passes the prescribed stages and is unopposed.

Under section 11 of the Act, the grant of a patent may be opposed at any time within two months from the date of the advertisement in the Illustrated Official Journal of the acceptance of the complete specification; on the ground of the applicant having obtained the invention from the opponent, or from a person of whom he is the legal representative; or on the ground that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent; or on the ground that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification *but on no other ground.*

A notice of opposition to the grant of a patent must be made on Patents Form No. 8, and must state the ground or grounds on which the person giving such notice intends to oppose the grant, and must be signed by him. Such notice must state his address for service in the United Kingdom, and be accompanied by an unstamped copy to be transmitted by the Comptroller to the applicant.

12. Sealing of Patent.—Except in cases of appeal to the law officer, of opposition, or of the death of the applicant, a patent must be sealed within 15 months, or, if extension of time has been allowed for leaving or accepting a complete specification, 19 months from the date of the application for the patent. A sealing fee of 1*l.* is payable, and should be paid by leaving at the Patent Office Patents Form No. 10, stamped 1*l.*

Great care must be taken to ensure that the form, duly stamped, is left at the Office at such a date as to permit of the sealing of the patent within the prescribed time. The applicant for a patent is advised to pay the sealing fee after the date of the acceptance of the complete specification and before the expiration of the period allowed

for opposition. If this be done, the patent will as a rule be sealed about 10 weeks after the date of the acceptance of the complete specification. If the payment has been omitted, application may be made to the Comptroller on Patents Form No. 11 for an extension of time for one, two, or three months to make such payment, but no extension can be allowed beyond three months.

13. Duration of Patent and Payment of Renewal Fees for the Continuance of Patent.—Every patent (other than a patent of addition) is granted for the term of 14 years from the date of application, subject to the payment, before the expiration of the 4th and each succeeding year during the term of the patent, of the prescribed fee. The patentee may pay all or any of such prescribed annual fees in advance.

Payment must be made by way of Patents Form No. 13 duly stamped, which must be sent to the Patent Office for entry of the payment in the register. The production of letters patent at the Patent Office on payment of these fees is not required.

As the payment of these renewal fees is regulated by Act of Parliament, a fee cannot be received a *single day* after it is due ; but if the payment has been omitted, application may be made to the Comptroller, on Patent Form No. 14, for an enlargement of time of one, two, or three months, as the case may be, to make such payment, but no enlargement can be allowed beyond three months.

14. Extension of Term of Patent.—Under section 18 of the Act, a patentee may after advertising in manner provided by Rules of the Supreme Court, petition the Court for an extension of the term of his patent, but such petition must be presented at least six months before the time limited for the expiration of the patent. Notice may be given to the Court of opposition thereto.

15. Restoration of Lapsed Patents.—Under section 20 of the Act, application may be made to the Comptroller on Patents Form No. 15 by a patentee for an order for the restoration of a patent which has become void owing to the failure to pay a renewal fee within the prescribed time. The application is required to be advertised and notice of opposition thereto may be given on Patents Form No. 16.

16. Amendment of Specification.—Under section 21 of the Act, if no action for infringement or proceeding before the Court for the revocation of a patent is pending, a complete specification may be amended by way of disclaimer, correction, or explanation, but no

amendment will 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. A request for leave to amend must be made on Patents Form No. 17 and signed by the applicant or the registered proprietor of the patent, and must be accompanied by a certified printed copy of the specification, showing clearly in red ink the proposed amendments. A printed copy of any published specification may be obtained from the Patent Office, 25, Southampton Buildings, W.C., price 8*d*., including inland postage. The fee for certifying the printed copy is one shilling. Care should be taken to indicate clearly what part of the printed description it is proposed to omit, and at what points interlineations are to be inserted. Additional matter which cannot be written upon the printed copy should be written upon a separate sheet and attached to the print.

It should be remembered that the proposed amendments, whether allowable or not, are made public and advertised, and that this publication may be a bar to obtaining a valid patent for matter disallowed by way of amendment. No amendment of a provisional specification is allowed under section 21; but clerical errors therein may be corrected (see par. 18).

Anyone wishing to be informed as soon as an application for amendment of a specification is entered, should forward a Patents Form No. 31 (see par. 19) with a request for such information.

A notice of opposition to the amendment of a specification must be made on Patents Form No. 18.

17. Assignments, Licences, &c.—Deeds of assignment of patents, and other documents affecting the proprietorship of patents, licences to manufacture or use patented inventions, are required by section 28 of the Act to be entered in the register at the Patent Office. No document can, however, be recorded until the patent to which it relates has been actually sealed. Every document sent for registration must be duly stamped in accordance with the provisions of the Stamp Act, 1891, and must be accompanied by an attested copy written upon foolscap paper (on one side only) and bearing a 1*s*. impressed stamp, and by the appropriate stamped Form of Request, Patents Forms No. 27, 28, or 29 as the case may be. Names of individual members of firms should be set out on the Form of Request.

18. Correction of Clerical Errors.—A request for the correction of a clerical error in or in connexion with an application for a patent, or in any patent or specification, or in the name or address of the proprietor

of any patent, or in any matter which is entered upon the register of patents, should be made on Patents Form No. 30.

19. Certificates.—A request for a certificate of the Comptroller as to any entry, matter or thing which he is authorised by the Act or Rules to make or do, should be made on Patents Form No. 31.

Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Office, or of or from registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

20. Exhibition of Unpatented Inventions. — Any person may exhibit an unpatented invention at an exhibition certified by the Board of Trade as industrial or international during the period of the holding of the exhibition, without prejudice to his subsequent patent rights, provided (*a*) that he gives the prescribed notice on Patents Form No. 33 to the Comptroller of his intention so to exhibit it, and (*b*) that the application for a patent be made within six months from the date of the opening of the exhibition. In the case of exhibitions held out of the United Kingdom, no notice of intention to exhibit is required to be given to the Comptroller.

For the purpose of enabling the invention to be subsequently identified, the inventor must furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may require.

21. International and Colonial Arrangements.—An International Convention for the Protection of Industrial Property exists between the following States:—

Austria.
Belgium.
Brazil.
Cuba.
Denmark with the Faröe Islands.
France with Algeria and colonies.
Germany.
Great Britain with Australia, Ceylon, New Zealand, and Trinidad and Tobago.
Hungary.
Italy.
Japan.
Mexico.
Netherlands with the Dutch East Indies, Surinam, and Curaçoa.
Norway.
Portugal with the Azores and Madeira.
Santo Domingo.
Servia.
Spain.
Sweden.
Switzerland.
Tunis.
United States of America.

Copies of the text of the Convention, and of the Additional Act modifying the Convention, may be purchased for 2*d.* and 1*d.*, respectively, from Messrs. Wyman & Sons, Ltd., Fetter Lane, E.C., or through any bookseller.

Under this Convention, an applicant for a patent in any one of the contracting states may obtain priority in any of the other states.

Similar arrangements, for the mutual protection of inventions, designs, and trade marks, have been made between Great Britain on the one side, and each of the following states and colonies on the other :—

Ecuador (designs and trade marks only). Greece (designs and trade marks only). Honduras. Paraguay. Roumania (designs and trade marks only). Uruguay.

An International Office, in connection with the Convention, has been established at Berne, Switzerland, which publishes a monthly periodical, entitled "La Propriété Industrielle." The yearly subscription (including postage) for all countries within the Postal Union is 5 francs 60 centimes, and should be forwarded by money order to L'Imprimerie Co-opérative, Berne.

22. Miscellaneous Matters relating to Patents and the Patent Office :—

(*a.*) *Information by Post.*—Any person wishing to know whether a particular patent is still in force, the name of the present proprietor of a patent, or any similar details, may obtain an extract from the Register of Patents upon stating the number and year of the patent and forwarding the fee of one shilling by postal order. No information with reference to unpublished specifications can be given to any person other than the applicant.

(*b.*) *Full-size Copies of Drawings.*—Full-size copies of drawings printed by photo-lithography may be obtained at the undermentioned rates :—

No. of Copies.	Whole sheets Imperial (30 × 22)	Half-sheets Imperial. (15 × 22)	Foolscap size. (13 × 16)	Half-foolscap size. (13 × 8)
	s. d.	*s. d.*	*s. d.*	*s. d.*
Single copies ...	25 0	15 0	15 0	10 0
Not exceeding—				
6 copies ...	28 0	18 0	17 0	12 0
12 „ ...	30 0	20 0	18 6	13 6
25 „ ...	32 0	22 0	20 0	15 0

If a satisfactory photograph cannot be obtained from the original drawing, an extra charge will be made to cover the expense of making a tracing.

When the original drawings are coloured there will also be an extra charge for colouring the copies.

(*c.*) *Advice on Patent Matters, &c.*—The Patent Office does not undertake to give legal advice or opinions on any subject connected with patent law which, like other laws, is left to the interpretation of professional men; nor does the Patent Office examine specifications or other documents before they are filed.

Searches (other than those made in pursuance of the Act) cannot be undertaken by the Patent Office, but must be made by the person requiring information, or by his agent.

The Patent Office cannot recommend any particular patent agent for employment by applicants, but a List of Registered Patent Agents may be obtained from Messrs. Eyre and Spottiswoode, Ltd., East Harding Street, E.C., or through any bookseller. Price (including postage) 1*s.* 1*d.*

(*d.*) *Application for Assistance, Reduction of Fees, &c.*—It is not within the power of the Comptroller to comply with any of the following requests:—

For pecuniary assistance to obtain patents.
For reduction or remission of any fee.
For purchase or acquirement of any interest in patented or other inventions.
For recommendation of any invention for purchase or use by a Government department or by the public.

(*e.*) *Use of the Word "Patent."*—The marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article is not to be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent. Any person who falsely represents that an article sold by him is a patented article is liable for every offence on summary conviction to a fine not exceeding five pounds. In a case decided by a police magistrate, it was held, however, that a person was entitled to mark goods with the word "patent" after the complete specification had been accepted. (See section 89 of the Act, and Reports of Patent Cases, vol. xiii., No. 17.)

(*f.*) *Use of the Royal Arms.*—The grant of a patent is not to be deemed to authorise a patentee to use the royal arms or to place the royal arms on any patented article.

(*g.*) *Patent Medicines.*—Communications with respect to the preparation and supply of medicine stamps appropriated to a particular medicine, or as to the liability to stamp duty of so-called "patent medicines," should be addressed to the Secretary (Stamps and Taxes), Inland Revenue, Somerset House, London, W.C.

The use of medicine stamps does not have the effect of letters patent.

23. Applications for Patents, &c., in the British Colonies and Foreign States.—Applications for colonial or foreign patents, &c. must be made to the Government of the colony or foreign state in which protection is desired. A collection of colonial and foreign patent, design, and trade mark laws and rules may be seen in the Free Library of the Patent Office.

24. Patent Office Museum.—The contents of the Museum were transferred in 1883 to what is now the Victoria and Albert Museum at South Kensington, where they have been added to the general science collections of that Museum. All communications relating to the Museum should be addressed to the Secretary, Board of Education, South Kensington, London, S.W.

25. Patent Office Library.—The Free Library of the Patent Office, 25, Southamption Buildings, Chancery Lane, London, W.C., is open daily, from 10 a.m. to 10 p.m., except on Sundays, Christmas Day, Good Friday, and Bank Holidays. On the day observed as His Majesty's birthday, Christmas Eve, Easter Eve, and Whitsun Eve, the Library is closed at 4 p.m.

In addition to the Printed Specifications, Indexes, and other publications of the Patent Office, the Library contains a collection of the leading British and foreign scientific journals, transactions of learned societies, and text-books of science and art, and the full or abridged patent specifications of the following countries:—Argentine Republic, Austria, Barbados, Belgium, Canada, Cape Colony, Denmark, Finland, France, Germany, Grenada, Hungary, Italy, Japan, Mauritius, Mexico, Natal, New South Wales, New Zealand, Norway, Portugal, Queensland, Russia, St. Lucia, St. Vincent, South Australia, Straits Settlements, Sweden, Switzerland, Trinidad, United States of America, Victoria, Western Australia.

26. Patent Office Publications.—These (see pages 616—622) may be consulted daily at the Free Public Library of the Patent Office; at the Science and Art Department, South Kensington; and at the free libraries, &c., named on pages 608—615. They are also on sale at the Patent Office, 25, Southampton Buildings, W.C., and will be forwarded by post on receipt of the price and of the postage (if any is charged). *Sums amounting to 6d. or more must be remitted by postal or post office order payable to the Comptroller-General.* Postage stamps sent in payment of any amount exceeding *5d.* will be returned. Deposit accounts may be opened, the minimum deposit being *2l.*

In searching for the invention of any particular person, the Name

Indexes, published as part of the Illustrated Official Journal of Patents, should be consulted. In searching for patents in connection with a particular subject, the Abridgment Class and Index Key should first be consulted to ascertain where the subject is classified in the Patent Office publications. The corresponding abridgment volumes, each of which is furnished with name and subject indexes, should then be examined. In the case of recent specifications for which abridgment volumes have not been published, the annual and monthly Indexes and the Illustrated Official Journal must be consulted. Searches (other than those made in pursuance of the Act) cannot be undertaken by the Patent Office.

In ordering specifications, the price of which is 8*d.* each, the number and year of the patent must be given.

Unless a wrong number has been supplied through an error on the part of the Patent Office, specifications or other publications cannot be exchanged.

27. Specifications of Foreign and Colonial Patents.—Specifications of foreign and colonial patents are not sold by the Patent Office. Applications for these should be made to the Patent Office of the country in which the patent was granted.

28. Lists of Places receiving Donations of Patent Office Works.

A.—*Places in the United Kingdom receiving a complete set of the publications of the Patent Office, including the Specifications, on condition that they shall be daily accessible to the public, for reference or for copying*, free of all charge.

Belfast—Public Library, Royal Avenue.
†Birmingham — Reference Library, Patent Department, Eden Place.
Bolton—Little Bolton Library.
Bradford, Yorkshire — Free Library, Darley Street.
Bristol — Central Public Libraries, College Green.
Cardiff—Central Free Library, Reference Department.
Derby—Public Library and Museum.
Dublin—National Library of Ireland, Kildare Street.
Dundee—Public Library, Albert Institute.
†Glasgow — Stirling's and Glasgow Public Library, Miller Street.
Halifax — Public Library, Akroyd Park.
†Horwich — Mechanics' Institute Library.
Huddersfield—Public Library and Art Gallery.
Hull—Central Public Library, Albion Street.
Ipswich—Free Library, High Street.
†Keighley—Public Library.
†Leeds—Free Public Library.
Leicester—Central Municipal Library, Bishop Street.
Liverpool — Free Library, William Brown Street.
London—Free Library, London Street, Bethnal Green (*from* 1891).
†Manchester—Free Library, Deansgate.
Newcastle-upon-Tyne — Public Library, New Bridge Street.

† This library also receives a set of specifications of United States patents (from 1893).

Nottingham — Central Free Public Library.
Oldham—Free Library, Union Street.
Preston—Harris Free Public Library and Museum.
Rochdale — Free Public Library, Esplanade.
Salford—Free Library, Peel Park.
†Sheffield — Free Public Library, Surrey Street.
Swansea—Public Library.
Wolverhampton — Municipal Science and Technical School.

B.—*Public Offices, &c., in the United Kingdom, and British Colonies and Foreign States receiving a complete set of the Publications of the Patent Office.*

Public Offices, &c.

London—
British Museum.
Science Library, South Kensington Museum.
†Edinburgh—Royal Scottish Museum.
Dublin—Public Record Office.
Isle of Man—Douglas—Rolls Office.

British Colonies, &c.

Australia—
New South Wales—Sydney—Public Library.
South Australia—Adelaide—Public Library.
Victoria — Melbourne — Commonwealth Patent Office.
Public Library.
Western Australia—Perth—Public Library.
Canada—
Ontario—Ottawa—Patent Office.
Toronto—Public Library.
India—
Bombay—Patent Office, Secretariat.
Calcutta—Patent Office, Imperial Secretariat.
Madras—Patent Office, Secretariat.
New Zealand — Wellington—Patent Office.

Foreign States.

Austria—
Vienna—Patentamt (*from* 1893).
Technische Hochschule.
Belgium — Brussels — Ministère de l'Industrie.
Denmark—Copenhagen—Patent Office (*from* 1893).
France — Paris — Office National des Brevets d'Invention et des Marques de Fabrique.
Germany—
Berlin—Kaiserliches Patentamt.
Königliche Technische Hochschule.
Baden — Carlsruhe — Technische Hochschule (*from* 1876).
Bavaria — Munich — Polytechnische Verein.
Prussia—Aachen—Königliche Technische Hochschule.
Berlin—Königliche Bibliothek.
Hanover — Polytechnische Schule.
Saxony — Dresden — Technische Hochschule.
Italy—
Naples—Royal Institution for the Encouragement of Science (*from* 1852).
Rome—Ufficio delle Privative Industriali.
Japan—Tokyo—Patent Office (*from* 1884).
Mexico—Mexico—Patent Office (*from* 1904).
Norway — Christiania—Patent Office (*from* 1884).
Russia—St. Petersburg—Bibliothèque Impériale.
Sweden—Stockholm—Patent Office.
United States—
Washington, D.C.—Patent Office.
Illinois — Chicago — Free Public Library.
Maryland — Baltimore — Peabody Institute.
Massachusetts — Boston — Free Public Library.
Missouri — St. Louis — Mercantile Library.
New York—Albany—State Library.
Ithaca — Cornell University.
New York City—Astor Library.
Ohio—Cincinnati—Public Library.
Pennsylvania — Philadelphia — Franklyn Institute.
Pennsylvania—Pittsburg—Carnegie Library.
Wisconsin — Madison — Historical Society.

† This library also receives a set of specifications of United States Patents (from 1893).

C.—*Places in the United Kingdom receiving the Abridgments of Specifications, and, if an asterisk is affixed, the Illustrated Official Journal of Patents also.*

*Aberdeen—Public Library.
*Accrington—Public Library.
*Alloa—Public Library.
Alnwick—Scientific and Mechanical Institution.
*Ashton-under-Lyne—Public Free Library.
*Aston, near Birmingham—Aston Manor Public Library.
Ayr—Carnegie Public Library.

*Bangor—Free Library.
*Barrow-in-Furness—Free Public Library and Museum.
*Basingstoke—Mechanics' Institute and Club.
*Batley—Carnegie Public Library.
*Birkenhead—Central Public Library.
*Blackburn—Free Library and Museum.
Blyth—Mechanics' Institution.
*Bootle—Free Public Library.
*Brighton—Public Library, Museum, and Fine Art Galleries.
*Burnley—Mechanics' Institution.
Burslem—Wedgwood Institute.

*Canterbury—Free Library.
Cardiff—South Wales Institution of Engineers, Park Place.
Carlisle—Public Library.
Cheltenham—Public Library.
*Chester—Free Library, St. John Street.
Colchester—Public Library.
*Colne—Public Library.
*Cork—Carnegie Free Library.
Coventry—Free Library.
*Crewe—Mechanics' Institution.

*Darlington—Technical College.
*Darwen—Public Library.
*Devonport—Free Public Library.
*Dewsbury—Public Free Library.
*Doncaster—Free Library.
*Dumbarton—Free Public Library.

Ebbw Vale—Literary and Scientific Institute.
*Exeter—Royal Albert Memorial College, Museum, and Public Library.

Frome—Literary and Scientific Institution.

Glasgow—
  *Athenæum.
  *Institution of Engineers and Shipbuilders in Scotland, 207, Bath Street.
  *Royal Philosophical Society, 207, Bath Street.

*Gloucester—Public Library, Brunswick Road.
Guernsey—Guille-Allés Library. Market Place.

Halifax—Mechanics' Institute, Crossley Street.
*Handsworth—Central Library.
*Hanley—Public Free Library.
*Harrogate—Public Library.
*Heywood—Public Free Library.

*Inverness—Public Library.

*Kettering—Free Public Library.
Kidderminster—Free Library.
*Kilmarnock—Dick Institute, Kilmarnock Public Library and Museum.
Kirkcaldy—Beveridge Free Library.

Lancaster—Public Library, Storey Institute.
Leeds—
  *Association of Engineers.
  *University.
*Lincoln—Public Library.
London—
  *Brixton Oval, Tate Central Library.
  *Camberwell Central Library, Peckham Road, S.E.
  *Canning Town Free Public Library, Barking Road, E.
  *Chartered Institute of Patent Agents, Staple Inn Buildings, Holborn, W.C.
  Chelsea Public Libraries.
  *East London College, People's Palace, Mile End Road, E.
  *Guildhall Library, E.C.
  *Imperial Institute.
  *Institution of Civil Engineers, Gt. George Street.
  *Institution of Mechanical Engineers, Storey's Gate, St. James's Park, S.W.
  *London Institution, Finsbury Circus.
  *Society of Arts.
  *Southwark Central Library, Walworth Road, S.E.
  *The Law Society, Chancery Lane.
  *Walthamstow Public Library.
  *Wandsworth Public Library.
  *War Office, Whitehall.
  *West Ham Public Library, Stratford.
  *Westminster Free Public Library, Great Smith Street.
  *Wimbledon Free Library.

*Lowestoft—Public Library.

Manchester—
*Municipal School of Technology.
*The Manchester Chemical Club.
University.
*Merthyr Tydfil—Free Library.
*Middlesbrough—Public Free Library.

*Newcastle-upon-Tyne—North of England Institute of Mining and Mechanical Engineers.
*Newport, Monmouth—Free Library.
*North Shields—Tynemouth Public Library.
*Norwich—Free Library.
*Nottingham—Mechanics' Institution.

Oswestry — Free Public Library, Guildhall.

*Penzance—Free Library.
*Peterhead—Public Library.
*Pontypridd—Free Library.
*Portsmouth—Central Public Library, Town Hall.

*Reading — Free Public Library Museum and Art Gallery.
*Redruth—Free Library.
*Rhyl—Carnegie Free Library.
*Richmond, Surrey — Free Public Library.
Rotherham—Free Public Library.
Saffron Walden—Literary and Scientific Institution.
*St. Helen's—Public Library, Gamble Institute.
Saltaire—Shipley—Public Library.
Scarborough—Mechanics' and Literary Institute, Vernon Place.
*Shrewsbury—Free Public Library.
*South Shields—Public Free Library.
*Stockport—Public Library.
Stockton-on-Tees—Free Library.
Stowmarket—The Institute.
*Swansea—Royal Institution of South Wales.
*Swindon, New—G.W.R. Mechanics Institution.

*Walsall—Free Library.
*Warrington—Municipal Museum.
*Wednesbury—Free Library.
*West Bromwich—Free Library.
*West Hartlepool—Public Library.
*Weston-super-Mare — Free Public Library.
Whitby—Museum.
*Whitehaven—Free Public Library.
*Woolwich—Ordnance Factories.
*Worcester—Public Library, Victoria Institute.
*Workington — Public Library and Carnegie Lecture Hall.

D.—*Places abroad receiving the Abridgments of Specifications, and if an asterisk is affixed, the Illustrated Official Journal of Patents also.*

British Colonies, &c.

Canada—Quebec—Montreal—
*Council of Arts and Manufactures of Quebec.
Society of Civil Engineers.
*Manitoba — Winnipeg — Public Library.
*Cape Colony—Cape Town—Colonial Secretary's Office.
*Malta — Valetta—Chief Secretary's Office.
*Mauritius — Colonial Secretary's Office.
New South Wales—Sydney—Patents Library.
*New Zealand—
Auckland Free Public Library.
Christchurch Free Public Library.
Dunedin Free Public Library.
*Tasmania—Hobart Public Library.
Transvaal — Johannesburg — Seymour Technical Library.
Queensland — Brisbane — Public Free Library, William Street.
Victoria—Ballarat—School of Mines.

Foreign States.

France—
Paris—*Bibliothèque Nationale.
British Chamber of Commerce.
Germany
*Alsace — Mühlhausen — Société Industrielle.
*Gotha—Ducal Friedenstein Collection.
Strasburg—Imperial and Provincial Library of the University.
*Hungary—Budapest—Patent Office.
Netherlands — Delft — Polytechnic School.
*Peru—Lima—Escuela de Ingenieros.
*Russia—Riga—Polytechnic School.
*Spain—Madrid—Patent Office.
Switzerland—
*Berne—Bureau International pour la Protection de la Propriété Industrielle.
*Zurich—Federal Polytechnic School.
United States—
*California — San Francisco — Mechanics' Institute.

United States—*contd.*
Connecticut — Newhaven — Free Public Library.
Illinois — Urbana — University of Illinois.
Indiana—Crawfordsville — Wabash College.
Terre Haute — Rose Polytechnic Institute.
Massachusetts—Boston — American Academy of Arts and Sciences.
Springfield—City Library Association.
Michigan--*Detroit--Public Library.
*Lansing—State Library.
Minnesota—Saint Paul—Minnesota Historical Society.
*New Jersey—Newark—Free Public Library.
United States—*contd.*
New York—*American Institute of Mining Engineers.
*American Society of Civil Engineers.
Brooklyn Public Library.
Ohio—Cleveland Public Library.
Pennsylvania—Philadelphia—Engineers' Club, 1317, Spruce Street.
Philadelphia—Law Association.
Pittsburg — Mercantile Library Association.
Scranton — Young Men's Christian Association.
Washington — Tacoma — City Library.
*Wisconsin — Milwaukee Public Library.

E.—*Places receiving some special portion of the Publications of the Patent Office.*

Belfast—The Linen Trade Board.
Birmingham—Mason College.
Glasgow — Incorporated Weaving, Dyeing, and Printing College.
Leek—The Nicholson Institute.
Liverpool—Admiralty.
Chemical Laboratory, University College.
London—Admiralty.
Federated Institutes of Brewing.
Home Office.
Institute of British Carriage Manufacturers.
Institute of Electrical Engineers.
Institution of Naval Architects
Iron and Steel Institute.
London--*contd.*
Local Government Board—Inspector of Foods, &c.
Microscopial Society.
Photographic Society.
St. Bride Foundation Institute.
Society of Chemical Industry.
Surveyors' Institution.
Manchester—
Municipal Technical School.
Society of Dyers and Colorists.
Plymouth—Free Public Library.
Waltham Abbey—Gunpowder Factory.
Woolwich—
Explosives Committee.
Ordnance Committee.

F.—*Places in the United Kingdom receiving the Illustrated Official Journal of Patents.*

Accrington—Mechanics' Institution.
Airdrie—Public Library.
Altrincham—Free Library and Technical School.
Arbroath—Public Library.
Barnsley—Free Public Library, Harvey Institute.
Bath — Victoria Art Gallery and Reference Library.
Belfast—Queen's College.
Beverley—Public Library.
Birmingham—
Association of Mechanical Engineers.
Chamber of Commerce.
Blackpool—Free Library.
Blackrock (Co. Dublin) — Public Library.
Bolton-upon-Dearne—Carnegie Public Library.
Bournemouth — Central Public Library.
Branksome—Public Library.
Brechin—Public Library.
Bristol—
Literary and Philosophical Club.
School of Science, Merchants' Hall.
Burnley—Corporation Free Library.
Burton-on-Trent—Public Library.
Bury—Public Library.
Cambridge—
Free Library.
Philosophical Library.
University Library.
Carnarvon—Free Library.
Chorley—Free Public Library.
Croydon — Central Free Public Library.

Dalton-in-Furness—Public Library.
Darlington — Edward Pease Public Library.
Denbigh—Free Reading Room.
Dublin—Department of Agriculture.
Dudley—Free Library.
Dundalk—Free Library.
Eastbourne—Central Library.
Eccles—Public Library.
Edinburgh—
Advocates' Library.
Public Library.
Elgin — Public Library, Cooper Park.
Enfield—Small Arms Factory.
Erdington—Public Library.
Erith—Public Library.
Falkirk—Public Library.
Falmouth—Free Public Library.
Gainsborough—Public Library.
Galashiels—Public Library.
Glasgow—Royal Exchange.
Goole—Free Library.
Gravesend—Public Library.
Great Yarmouth—Free Library and Museum.
Greenock—Public Library.
Handsworth—Public Library, Birchfield Branch.
Hawick—Public Library.
Heckmondwike—Public Free Library.
Hereford—Free Library.
High Wycombe—Free Library.
Holyhead—Public Library.
Horbury—Carnegie Free Library.
Houghton-le-Spring — Church Institute.
Huddersfield—Technical School.
Hyde—Public Library.
Jersey—Public Library.
Leamington Spa—Public Free Library, Avenue Road.
Llanelly—Free Public Library.
Lockerbie—Public Library.
London—
Acton Public Library.
Aeronautical Society of Great Britain.
Austrian Embassy.
Battersea Public Library, Lavender Hill.
Bermondsey Public Libraries—
Central Public Library.
Rotherhithe Public Library.
Bishopsgate Institute.
Board of Trade.
Borough Polytechnic Institute, S.E.
Bow Library.
Brewing Trade Review.
British Horological Institute.
Camberwell—Livesey Library, Old Kent Road, S.E.
Central Young Men's Christian Association, 186, Aldersgate Street.
London—*contd.*
Clerkenwell — Central Public Library.
"Coach Builders' and Wheelwrights' Art Journal."
"Cold Storage and Ice Trades Review."
Deptford—Public Library.
Ealing — Public Library. Walpole Park.
East Ham—Central Library.
Edmonton—Public Library.
Electrical Engineering.
Electrician.
"Engineering Review."
Fulham Public Libraries—
Free Public Library.
Free Public Library, North Branch, Lillie Road.
Free Public Library. South Branch, Wandsworth Bridge Road.
G.P.O. Controller of Factories.
G.P.O. West. Engineer-in-Chief.
German Embassy.
Hackney—Central Public Library.
Hammersmith—Carnegie (Central) Library.
Hampstead — Central Public Library.
Harlesden—Public Library.
Herne Hill — Carnegie Public Library.
Hornsey—Central Public Library.
Hounslow—Public Library.
Branch Library, Isleworth.
Inland Revenue Department.
Institution of Automobile Engineers.
Islington Public Libraries.
Journal of Gas Lighting.
Kensington Public Libraries.
Brompton Branch.
Central Library, High Street.
North Kensington Branch, Ladbroke Grove.
Kilburn Public Library.
Lewisham Public Libraries—
Brockley Branch Library.
Central Library.
Forest Hill Branch Library.
Lee — Manor House Branch Library.
Lower Sydenham Public Library.
London Chamber of Commerce.
"Page's Magazine."
Pharmaceutical Society of Great Britain.
Plaistow—Passmore Edwards Public Library.
Polytechnic, Regent Street.
Poplar Public Libraries—
Bromley Library.
Central Library, High Street.
Cubitt Town Library.

London—*contd.*
" Power."
Putney—Newnes Public Library.
Royal Institution.
Shoreditch Public Libraries—
Haggerston Branch Library.
Hoxton—Pitfield Street Library.
Society of Patent Agents.
Southwark—New Kent Road District Library.
Southwark — Passmore Edwards Library, Borough Road, S.E.
Stepney Public Libraries—
Limehouse Public Library.
Mile End Public Library.
Whitechapel Library.
Stoke Newington Public Library.
Tate Library, Streatham.
Tottenham Public Library.
Tottenham Public Library, St. Ann's Road Branch.
Treasury.
University of London.
West Ham—Municipal Technical Institute.
West Norwood Library.
Willesden Green Public Library.
Wood Green Public Library.
Longton—Sutherland Institute.
Loughborough—Public Library.
Luton—Free Library.
Macclesfield — Free Library, Town Hall.
Malvern—Public Library.
Mansfield—Free Public Library.
Middleton — Manchester — Free Library.
Motherwell—Public Library.
Nelson—Free Library.
Newburgh, Fife—Laing Free Library.
Newcastle-on-Tyne—N.E. Coast Institution of Engineers and Shipbuilders.
Newport, Mon.—Chamber of Commerce.
Newport, Salop—Literary Institute.
Newton Abbot—Free Public Library.
Newry—Chamber of Commerce.
Northampton—Public Library.
Northwich — Brunner Free Public Library.
Oldbury—Public Library.
Oxford—
Bodleian Library.
Public Library.
Perth—Sandeman Public Library.
Peterborough—Public Library.
Plumstead—Public Library.
Radcliffe—Public Library.
Rathmines—Public Library.
Rawtenstall—Public Library.
Rothwell—Public Library.
Rugby—Public Library.
Salisbury—Free Library.
Sheffield—Chamber of Commerce.
Southall—Public Library.
Southend-on-Sea—Public Library.
Southport—Atkinson Free Library.
Stamford—Public Library.
Stirling—Public Library.
Stoke-on-Trent—English Ceramic Society.
Stony Stratford—Church Institute.
Stroud—Free Library.
Sunderland—
Equitable Industrial Society, Limited.
Public Free Library.
Thetford—Mechanics' Institution.
Thirsk—The Institute.
Thornaby-on-Tees—Public Library.
Todmorden—Free Library.
Torquay—Public Library.
Wallsend—Industrial Co-operative Society.
Watford—Public Library.
Wigan—
Corporation Library.
Mining and Technical College.
Willenhall—Free Library.
Wolverton—Science and Art Institute.
Woolwich—
Public Library.
Royal Arsenal Association of Foremen.
Royal Arsenal—Chief Inspector.
Royal Artillery Institute.
Wrexham—Free Public Library.
York—Free Library.

G.—*Places abroad receiving the Illustrated Official Journal of Patents.*

(a) British Colonies, &c.

Australia—
New South Wales — Sydney — Engineering Association.
South Australia—Adelaide — Commissioner of Trade Marks.
Victoria — Melbourne — Australian Institute of Patent Attorneys (Incorporated).
Victoria—Melbourne— Department of Mines.
Victoria—Melbourne — Postmaster-General's Office.
British Guiana — Georgetown, Demerara—Government Secretary's Office.
Canada—
Ontario — Kingston — School of Mining.
Ottawa—Exchequer Court.
Toronto—Bureau of Agriculture.
Canadian Institute.
Manitoba—Winnipeg — Library of Parliament.
Cape Colony — Kimberley Public Library

Cape Colony—*Port Elizabeth Public Library.*
Ceylon—Government.
India—
Bombay—"Indian Textile Journal" Co.
"Indian Industries and Power."
Calcutta—"Indian and Eastern Engineer."
Wellington, Nilgiris—Cordite Factory.
New Zealand—Wellington—Geological Survey.
Rhodesia—Salisbury—Patent Office.
Transvaal—Johannesburg—South African Association of Engineers.
Pretoria—Patent Office.
Trinidad—Government.

(b) Foreign States.

Argentine Republic—Buenos Ayres—Patent Office. "Patentes y Marcas."
Austria-Hungary—
Prague-Deutsche Technische Hochschule.
Vienna—"Austrian Trade Journal."
"Der Electro Techniker."
Belgium—
Brussels—Association de la Presse Technique.
Société Belge d'Electriciens.
Fontaine L'Eveque—"La Revue Chimique."
Brazil—"The Brazilian Engineering and Mining Review."
Chili—Santiago—Sociedad de Fomento Fabril.
Finland—Industristyrelsen.
France—
Marseilles—Société Scientifique Industrielle.
Paris—Association des Chimistes.
"D'Electricien."
"La Revue d'Electrochimie et d'Electrometallurgie."
France—contd.
Paris—"Le Mois Scientifique et Industriel."
"L'emouvement industriel."
"Les Brevets de Sucrerie."
"Revue des Produits Chimiques."
Société Anonyme de Publications Industrielles.
Société Nationale d'Agriculture.
Germany—
Berlin—*American Chamber of Commerce.*
Zeitschrift fur Werkzeugmaschinen und Werkzeuge.
Braunschweig—Technische Hochschule.
Munich—Deutsches Muscum.
Stuttgart—Bibliothek der Musterlagers.
Japan—Tokyo—Society of Mechanical Engineers.
Switzerland—Berne—Bureau de la Propriété Intellectuelle.
United States—
Colorado—Denver State Library.
New York—American Institute of Electrical Engineers.
New York—American Railway Association.
New York—"Engineer" Publishing Co.
New York—"India Rubber World."
"Municipal Journal and Engineer."
"Patent and Trade Mark Review."
Pennsylvania—Harrisburg—State Library of Pennsylvania.
Pennsylvania—Pittsburg—Engineers' Society of Western Pennsylvania.
Pennsylvania—State College—Carnegie Library.
Washington—Smithsonian Institution.

H.—*Places receiving the Trade Marks Journal only.*

Edinburgh—Fishery Board for Scotland.
Jamaica—Spanish Town—Registrar-General.
London—
"British and Colonial Druggist."
Custom House.
Netherlands—The Hague—Office de la Propriété Industrielle.
Queensland—Brisbane—Register of Trade Marks.
Wolverhampton—Chamber of Commerce.
United States—New York—The United States Trade Mark Association.

29. List of Patent Office Publications.

Sold at the Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C.

(See page 607, paragraph 26.)

I.—Acts and Rules.

Patents and Designs Act, 1907, 5½*d.*, by post 7*d.*
Act, 1908, ½*d.*, by post 1*d.*
Patents Rules, 1908, 5*d.*, by post 6*d.*
Designs Rules, 1908, 4*d.*, by post 5*d.*
Designs Rules, 1908 (2nd set), 1*d.*, by post 1½*d.*
Trade Marks Act, 1905, 3*d.*, by post 4*d.*
Trade Marks Rules, 1906, 5*d.*, by post 6½*d.*
Register of Patent Agents' Rules, 1908, 1*d.*, by post 1½*d.*

II.—Specifications.

Price, 8*d.* each, including inland postage. Postage for foreign countries usually ½*d.* each.

1617—1852.

Specifications of Inventions, Disclaimers, &c., from 1617 to Sept. 30, 1852, comprised in 13,561 numbers.

1852—1883.

Specifications of Inventions, Disclaimers, &c., from Oct. 1, 1852, to end of 1883, comprised in about 130,000 numbers.

1884 *and subsequent years.*

Accepted Complete Specifications, Amendments, &c., under the Patents, Designs, and Trade Marks Acts, 1883 and 1907.

III.—Indexes.

1617—1852.

Name Index. 5*s.*, by post 5*s.* 6*d.*
Subject-matter Index. 2 vols. 10*s.*, by post 10*s.* 10*d.*

1852—1883.

Name Index.
1852—1856, 1846—70. 2*s.* 6*d.* each yearly volume, by post 2*s.* 10*d.*
1871—1873. 2*s.* each yearly volume, by post 2*s.* 3*d.*
1857—63, 1871—83. *Out of print.*
Subject-matter Index.
1852—1855. 5*s.* each yearly volume, by post 5*s.* 4*d.*
1856—1883. *Out of print.*
Name Index.
1884 *and subsequent years.*
1884. *Out of print.*
1885—1888. 2*s.* each yearly volume, by post 2*s.* 4*d.* 1887. *Out of print.*
1889—1908. *See* Illustrated Official Journals, Nos. 52, 108, 160, 212, 265, 317, 370, 423, 475, 527, 579, 631, 683. 735, 786, 838, 891, 943, 995, and 1046, 6*d.* each, by post 8*d.* Journals Nos. 108, 160, 212, and 423, *out of print.*
Number Index of Proceedings Advertised on Complete Specifications and Patents.
1901—1907. *See* Illustrated Official Journals, Nos. 687, 739, 790, 842, 894, 946, and 998, 6*d.* each, by post 8*d.*
Subject - matter Index of Accepted Complete Specifications dated in the Years named.
1884. 7*s.*, by post 7*s.* 5*d.*
1885—1886. *Out of print.*
1887—1890. 3*s.* 4*d.* each yearly volume, by post 3*s.* 8*d.*
1891—1906. 2*s.* each yearly volume, by post 2*s.* 3*d.*
Monthly Subject-matter Index of Accepted Complete Specifications.
Consolidated in March, June, September, and December. 1*s.* each part. Annual Subscription, 5*s.*, by post 7*s.* 6*d.*

IV.—Journals.

I. Illustrated Official Journal (Patents). Published every Wednesday, 6*d.*, by post 8*d.* Annual subscription, including postage, 1*l.* 15*s.*; quarterly subscription, 8*s.* 9*d.*
Contents:—Official Notices—Applications for Patents — Acceptances of Specifications—Amendments of Specifications—Patents Sealed — Renewal Fees Paid — Patents void—Applications Abandoned, &c.—Specifications, &c. Published — Designs Registered — Illustrated Abridgments of Current Specifications — and Reports of Patent, &c. Cases.
II. Trade Marks Journal. Published every Wednesday, 6*d.*, by post 8*d.* Annual subscription, including postage, 1*l.* 15*s.*; quarterly subscription, 8*s.* 9*d.*.

CONTENTS: — Illustration of Trade Marks applied for, and the Names and Callings of Applicants.

Annual subscriptions must date from 1st January. Other subscriptions must be for periods of not less than three months, and date from 1st of January, April, July or October.

ILLUSTRATED OFFICIAL JOURNAL (Abridgments of Specifications).
1888—1906. 1*l.* 6*s.* each.

TRADE MARKS JOURNAL.
1876—1887. Nos. 1 to 509. 1*s.* each number.
1888. Nos. 510 to 561. 1*s.* 6*d.* each number.
1889—1908. Nos. 562 to 1605. 6*d.* each number, by post 8*d.*

REPORTS of Patent, Design, and Trade Mark Cases.
1884—1886. Vols. 1—3. 6*d.* each number, or 10*s.* each volume.
1887—1888. Vols. 4—5, 1*s.* each number or 20*s.* each volume.
1889—1908. Vols. 6—24, 6*d.* each number.
Digest of Cases reported in Vols. 1—5, 1*s.* each.
Digest of Cases reported in Vols. 6—25, 6*d.* each.
Consolidated Digest of Cases reported in—
Vols. 1—10, 5*s.* each, by post 5*s.* 5*d.*
Vols. 11—16, 5*s.* each, by post 5*s.* 4*d.*
Vols. 17—22, 5*s.* each, by post 5*s.* 4*d.*

V.—CATALOGUE OF THE PATENT OFFICE LIBRARY.

Vol. I. Authors. 1898. 1*l.* 6*s.*; by post 1*l.* 6*s.* 8*d.*
Vol. II. Subjects. 1883. 15*s.* 8*d.*; by post 16*s.* 2*d.* (*New edition in preparation.*)

GUIDES TO THE PATENT OFFICE LIBRARY.

6d. each, including inland postage.

1. Key to classification of Patent Specifications of France, Germany, Austria, Norway, Denmark, Sweden, and Switzerland. 2*nd Edition*, 1905.
2. Fine and Graphic Arts (including Photography). Subject List. 2*nd Edition.*
3. Laws of Industrial Property and Copyright. Subject List.
4. Guide to the Search Department of the Patent Office Library. With Appendices. 3*rd Edition.*
5. Key to the German Patent Classification, 1900. (*For revised classification, dated* 1904, *see No.* 1 *above.*)
6. Chemistry and Chemical Technology. Subject List.
7. Chemical Industries, *including* Destructive Distillation, Mineral Oils and Waxes, Gas-lighting, Acetyline; Oils, Fats, Soaps, Candles, and Perfumery; Paints, Varnishes, Gums, Resins; Paper and Leather Industries. Subject List.
8. Class List and Index to the Periodical Publications in the Patent Office Library. 2*nd Edition.*
9. Domestic Economy, Foods, and Beverages, *including* the culture of Cacao, Coffee, Barley, Hops, Sugar, Tea, and the Grape. Subject List.
10. Textile Industries and Wearing Apparel, *including* the culture and Chemical Technology of Textile Fibres. Subject List.
11. General Science, Physics, Sound, Music, Light, Microscopy and Philosophical Instruments. Subject List.
12. Architecture and Building Construction. Subject List.
13. Mineral Industries, &c. Subject List.
14. Electricity, Magnetism, and Electro-Technics. Subject List.
15. Agriculture, Rural Economy, and Allied Sciences. Subject List.
16. Heat and Heat Engines (*excluding* Marine Engineering). Subject List.
17. Aerial Navigation and Meteorology. Subject List.
18. Military and Naval Arts (*including* Marine Engineering). Subject List.

New Series.

AA—BE. Reference works (Biography, Bibliography, Topography, &c.). Subject List. (*Others in preparation.*)

VI.—ABRIDGMENT CLASS AND INDEX KEY.

(*Issued December*, 1899.)

(Showing Abridgment Classes and Index headings to which inventions are assigned in the Official Publications of the Patent Office.) (*Out of print.*)

1*s.*, *by post* 1*s.* 6*d.*

APPENDIX. (*Issued June*, 1905.)

Showing additions and alterations in the ABRIDGMENT CLASS AND INDEX KEY. 1*s.*, *by post* 1*s.* 4*d.* (*Out of print.*)

VII.—ABRIDGMENTS OF SPECIFICATIONS.

(A).—*Illustrated* volumes of Abridgments of Specifications in accordance with the classification in the ABRIDGMENT-CLASS AND INDEX KEY have been published, or are in course of preparation, for ten consecutive periods, dealing completely with all specifications published from 1617 to the present date. There are 146 volumes for each of these ten periods. Price 1*s.* per volume, including inland postage.

LIST OF ILLUSTRATED VOLUMES.

1. Acids, alkalies, oxides, and salts, inorganic.
2. Acids and salts, organic, and other carbon compounds (*including* dyes).
3. Advertising and Displaying.
4. Aeronautics.
5. Agricultural appliances, farmyard and like (*including* the housing, feeding, and treatment of animals).
6. Agricultural appliances for the treatment of land and crops (*including* gardening appliances).
7. Air and gas engines.
8. Air and gases, compressing, exhausting, moving, and otherwise treating.
9. Ammunition, torpedoes, explosives and pyrotechnics.
10. Animal-power engines and miscellaneous motors.
11. Artists' instruments and materials.
12. Bearings and lubricating-apparatus.
13. Bells, gongs, foghorns, sirens, and whistles.
14. Beverages (*excepting* tea, coffee, cocoa, and like beverages).
15. Bleaching, dyeing, and washing textile materials, yarns, fabrics and the like (*excepting* dyes).
16. Books (*including* cards and card-cases and the like).
17. Boots and shoes.
18. Boxes and cases (*excepting* trunks portmanteaus, hand and like travelling bags, baskets and hampers, and other wickerwork).
19. Brushing and sweeping.
20. Buildings and structures.
21. Casks and barrels.
22. Cements and like compositions.
23. Centrifugal drying, separating, and mixing machines and apparatus.
24. Chains, chain cables, shackles, and swivels.
25. Chimneys and flues (*including* ventilating-shaft tops).
26. Closets, urinals, baths, lavatories, and like sanitary appliances.
27. Coin-freed apparatus and the like.
28. Cooking and kitchen appliances, bread-making and confectionery.
29. Cooling and ice-making (*including* refrigerators and ice-storing).
30. Cutlery.
31. Cutting, punching, and perforating paper, leather, and fabrics (*including* the general treatment of paper after its manufacture).
32. Distilling, concentrating, evaporating and condensing liquids (*excepting* steam-engine condensers).
33. Drains and sewers.
34. Drying.
35. Dynamo-electric generators and motors (*including* frictional and influence machines, magnets, and the like).
36. Electricity, conducting and insulating.
37. Electricity, measuring and testing.
38. Electricity, regulating and distributing.
39. Electric lamps and furnaces.
40. Electric telegraphs and telephones.
41. Electrolysis (*including* electro-deposition *and* electroplating).
42. Fabrics, dressing and finishing woven and manufacturing felted (*including* folding, winding, measuring and packing).
43. Fastenings, dress (*including* jewellery).
44. Fastenings, lock, latch, bolt, and other (*including* safes and strong-rooms).
45. Fencing, trellis and wire netting.
46. Filtering and otherwise purifying liquids.
47. Fire, extinction and prevention of.
48. Fish and fishing.
49. Food preparations and food-preserving.
50. Fuel, manufactures of.
51. Furnaces and kilns (*including* blowpipes and blowpipe burners; smiths' forges and rivet hearths; *and* smoke and fumes, treating).
52. Furniture and upholstery.
53. Galvanic batteries.
54. Gas distribution.
55. Gas manufacture.
56. Glass.

57. Governors, speed-regulating, for engines and machinery.
58. Grain and seeds, treating (*including* flour and meal).
59. Grinding, crushing, pulverising, and the like.
60. Grinding or abrading, and burnishing.
61. Hand tools and benches for the use of metal, wood, and stone workers.
62. Harness and saddlery.
63. Hats and other head coverings.
64. Heating (*excepting* furnaces and kilns; *and* stoves, ranges, and fireplaces).
65. Hinges and hinge-joints, and door and gate furniture and accessories (*excepting* fastenings, lock, latch, bolt, and other).
66. Hollow-ware (*including* buckets, pans, kettles, saucepans, *and* water-cans).
67. Horse shoes.
68. Hydraulic engineering.
69. Hydraulic machinery and apparatus (*excepting* pumps and other means for raising and forcing liquids).
70. India-rubber and gutta-percha, (*including* plastic compositions *and* materials of constructive utility other than metals and stone).
71. Injectors and ejectors.
72. Iron and steel manufacture.
73. Labels, badges, coins, tokens, and tickets.
74. Lace-making, knitting, netting, braiding, and plaiting.
75. Lamps, candlesticks, gasaliers, and other illuminating apparatus (*excepting* electric lamps).
76. Leather (*including* treatment of hides and skins).
77. Life-saving (marine) and swimming and bathing appliances.
78. Lifting, hauling and loading (*including* lowering, winding, *and* unloading).
79. Locomotives and motor vehicles for road and rail (*including* portable and semi-portable engines).
80. Mechanism and mill gearing.
81. Medicine, surgery, and dentistry.
82. Metals and alloys (*excepting* iron and steel manufacture).
83. Metals, cutting and working.
84. Milking, churning, and cheese-making.
85. Mining, quarrying, tunnelling, and well-sinking.
86. Mixing and agitating machines and appliances (*excepting* centrifugal machines and apparatus).
87. Moulding plastic and powdered substances (*including* bricks, building and paving blocks, and tiles *and* pottery).
88. Music and musical instruments.
89. Nails, rivets, bolts and nuts, screws, and like fastenings.
90. Non-metallic elements.
91. Oils, fats, lubricants, candles, and soaps.
92. Ordnance and machine guns.
93. Ornamenting.
94. Packing and baling goods.
95. Paints, colours, and varnishes.
96. Paper pasteboard, and *papier-mâché*.
97. Philosophical instruments *including* optical, nautical, surveying, mathematical, *and* meteorological instruments.
98. Photography.
99. Pipes, tubes, and hose.
100. Printing, letterpress and lithographic.
101. Printing, other than letterpress or lithographic.
102. Pumps and other means for raising and forcing liquids (*excepting* rotary pumps).
103. Railway and tramway vehicles.
104. Railways and tramways.
105. Railway signals and communicating apparatus.
106. Registering, indicating, measuring, and calculating (*excepting* signalling and indicating by signals).
107. Roads and ways.
108. Road vehicles.
109. Ropes and cords.
110. Rotary engines, pumps, blowers, exhausters and meters.
111. Sewage, treatment of, (*including* manure).
112. Sewing and embroidering.
113. Ships, boats, and rafts, Div. I.
114. ——————————Div. II.
115. ——————————Div. III.
116. Shop, public-house, and warehouse fittings and accessories.
117. Sifting and separating.
118. Signalling and indicating by signals (*excepting* railway signals and communicating apparatus).
119. Small-arms.
120. Spinning (*including* the preparation of fibrous materials *and* the doubling of yarns and threads).
121. Starch, gum, size, glue, and other stiffening and adhesive materials.
122. Steam engines (*including* details common to fluid pressure engines generally).

123. Steam generators (*excepting* furnaces).
124. Stone, marble, and the like, cutting and working.
125. Stoppering and bottling (*including* bottles, jars, and like vessels).
126. Stoves, ranges and fireplaces.
127. Sugar.
128. Table articles and appliances.
129. Tea, coffee, cocoa, and like beverages.
130. Tobacco.
131. Toilet and hairdressing articles, and perfumery.
132. Toys, games, and exercises.
133. Trunks, portmanteaus, hand and like travelling, bags, baskets, hampers and other wickerwork.
134. Umbrellas, parasols, and walking-sticks.
135. Valves and cocks.
136. Velocipedes.
137. Ventilation.
138. Washing and cleaning clothes, domestic articles, and buildings.
139. Watches, clocks, and other time-keepers.
140. Waterproofs and similar fabrics.
141. Wearing apparel.
142. Weaving and woven fabrics.
143. Weighing apparatus.
144. Wheels for vehicles (*excepting wheels for* locomotives and tramway and traction engines, railway and tramway vehicles; *and* toys).
145. Wood and wood-working machinery.
146. Writing instruments and stationery and writing accessories (*including* educational appliances).

LIST OF PERIODS.

1617—1854. (*In Preparation*).
1855—1866.
1867—1876.
1877—1883.
1884—1888.
1889—1892.
1893—1896.
1897—1900.
1901—1904.
1905—1908. (*In Course of Publication.*)

NOTICE.—Volumes in course of publication can be obtained sheet by sheet, as printed, by payment in advance of a subscription of 2*s.* for each volume, including inland postage. The sheets already printed can be seen in the Patent Office Library and in some of the principal provincial libraries.

(B). — *Unillustrated* volumes of Abridgments of Specifications from 1617 to 1866. For the period before 1855, reference may be made to the *unillustrated* series of abridgments, but it must be borne in mind that this series is not in accordance with the above classification and does not deal completely with all the published specifications belonging to that period. The price of each volume in this series is 2*s.* including inland postage.

LIST OF UNILLUSTRATED VOLUMES.

(*The numbers within brackets following the titles are the serial numbers of the volumes.*)

Acids, alkalies, oxides, and salts :— (40.) 1622—1866.
Aeronautics. (41.) 1815—1866.
Agriculture :—
———Div. I. — Field implements. (81.) 1618—1866.
———Div. II. — Barn and farmyard implements (*including* the cleansing, drying, and storing of grain). (82). 1636—1866.
———Div. III. — Agricultural and traction engines. (83.) 1618—1866.
Aids to locomotion. (7.) 1691—1856.
Air, gas and other motive-power engines. (62.) 1635—1866 (*out of print*).
Anchors. (69.) 1796—1866.
Artificial leather, floorcloth, oil-cloth, oil-skin, and other waterproof fabrics. (80.) 1627—1866.
Artists' instruments and materials. (54.) 1618—1866.
Bleaching, dyeing, and printing calico and other fabrics and yarns. (14.) 1617—1857.
Books, portfolios, card-cases, &c. (43.) 1768—1866.
Brewing, wine-making and distilling alcoholic liquids. (99.) 1634—1866.
Bricks and tiles. (22.) 1619—1860.
Bridges, viaducts, and aqueducts. (36.) 1750—1866.
Brushing and sweeping. (57.) 1699—1866.
Carriages and other vehicles for common roads. (98.) 1625—1866.
Carriages and other vehicles for railways. (46.) 1807—1866.
Casks and barrels. (74.) 1797—1866.
Chains, chain cables, &c. (90.) 1634—1866.

Cooking, bread-making and confectionery. (61.) 1634—1866.
Cutting, folding, and ornamenting paper. (12.) 1639—1866.
Drains and sewers. (1.) 1612—1866.
Dressing and finishing woven fabrics, and manufacturing felted fabrics. (91.) 1620—1866.
Electricity and magnetism, their generation and applications. (15.) 1766—1857.
Electricity and magnetism:—
——Div. IV. — Electric lighting, igniting, and heating. (95.) 1839—1876 (*out of print*).
——Div. V.—Electrodeposition and electrolysis. (96.) 1805—1876.
——Div. VI. — Electric motive-power engines and similar apparatus. (97.) 1837—1876.
Farriery. (53.) 1719—1866.
Firearms and other weapons, ammunition, and accoutrements. (10.) 1588—1858.
Fire engines, extinguishers, escapes, alarms, &c. (88.) 1625—1866.
Furniture and upholstery. (39.) 1620—1866.
Grinding grain and dressing flour and meal. (78.) 1623—1866.
Harbours, docks, canals, &c. (77.) 1617—1866.
Hinges, hinge-joints, and door-springs. (59.) 1775—1866.
Hydraulics. (32.) 1617—1866.
Ice-making machines, ice safes, and ice houses. (85.) 1819—1866.
Lace-making, knitting, netting, braiding, and plaiting. (29.) 1675—1866.
Lamps, candlesticks, chandeliers, and other illuminating apparatus. (44.) 1637—1866.
Letterpress and similar printing. (13.) 1617—1857.
Locks, latches, bolts, and similar fastenings. (60.) 1774—1866.
Manufacture of iron and steel. (6.) 1620—1866.
Manufacture of paper, pasteboard, and *papier-mâché*. (11.) 1665—1857.
Manure. (3.) 1721—1855.
Marine propulsion (*excluding* sails). (5.) 1618—1857.
Masts, sails, rigging, &c. (73.) 1625—1866.
Medicine, surgery, and dentistry. (25.) 1620—1866.
Metallic pipes and tubes. (70.) 1741—1866.
Metals and alloys (*excepting* iron and steel). (18.) 1623—1859.
Milking, churning, and cheese-making. (72.) 1777—1866.
Mining, quarrying, tunnelling, and well-sinking. (71.) 1618—1866.
Music and musical instruments. (26.) 1694—1866.
Nails, rivets, bolts, screws, nuts, and washers. (58.) 1618—1866.
Needles and pins. (45.) 1755—1866.
Oils, fats, lubricants, candles, and soaps. (27.) 1617—1866.
Optical, mathematical, and other philosophical instruments. (76.) 1636—1866.
Paints, colours, and varnishes. (50.) 1618—1866.
Photography. (19.) 1839—1859.
Plating or coating metals with metals. (23.) 1637—1860.
Pottery. (24.) 1626—1861.
Preparation and combustion of fuel. (30.) 1620—1865 (*out of print*).
Preparation and use of tobacco. (42.) 1721—1866.
Preparation of india-rubber and gutta-percha. (16.) 1791—1866.
Preparing and cutting cork, bottling liquids, &c. (56.) 1777—1866.
Preservation of food. (4.) 1691—1855.
Production and applications of gas. (17.) 1681—1858.
Purifying and filtering water. (79.) 1675—1866.
Railways. (33.) 1803—1866.
Railway signals and communicating apparatus. (38.) 1840—1866 (*out of print*).
Raising, lowering and weighing. (31.) 1617—1866.
Roads and ways. (35.) 1619—1866.
Saddlery, harness, stable fittings, &c. (34.) 1625—1866.
Safes, strong room, tills, &c. (64.) 1801—1866.
Sewing and embroidering. (2.) 1755—1866.
Ship-building, repairing, sheathing, launching, &c. (21.) 1618—1860.
Skins, hides, and leather. (55.) 1627—1866.
Spinning. (28.) 1624—1863 (*out of print*).
Starch, gum, size, glue, &c. (100.) 1717—1876.
Steam culture. (8.) 1618 — 1856 (*see also* Agriculture, Divs. I. and III).
Steam engines. (49.) 1618—1859 (in 2 Vols.)
Steering and manœuvring vessels. (75.) 1763—1866.
Sugar. (48.) 1663—1866.
Tea, coffee, chicory, chocolate, cocoa, &c. (87.) 1704—1866.
Toys, games, and exercises. (51.) 1672—1866.

Trunks, portmanteaus, boxes, and bags. (84.) 1635—1866.
Umbrellas, parasols, and walking-sticks. (47.) 1786-1866.
Unfermented beverages, ærated liquids, mineral waters, &c. (86.) 1774—1866.
Ventilation. (52.) 1632—1866.
Washing and wringing machines. (89.) 1691—1856.
Watches, clocks, and other time-keepers. (9.) 1661—1856.
Water closets, earth closets, urinals, &c. (63.) 1775—1866.
Wearing apparel. — Div. I. — Head coverings. (65.) 1637—1866.
———Div. II.—Body coverings. (66.) 1671—1866.
———Div. III. — Foot coverings. (67.) 1693—1866.
———Div. IV. — Dress-fastenings and jewellery. (68.) 1631—1866.
Weaving. (20.) 1620—1859.
Writing instruments and materials. (37.) 1635—1866.

FORMS IN PROCEEDINGS IN AN ACTION FOR INFRINGEMENT.

1. Indorsement on Writ.

The plaintiff claims:—

(1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's letters patent No. of .

(2) Damages for such infringement, or, at the option of the plaintiff, an account of the profits derived by the defendant from such infringement.

(3) That the defendant be ordered to deliver up to the plaintiff or to destroy all articles made in infringement of the said letters patent.

(4) Costs.

2. Notice of Motion for Interlocutory Injunction.

In the High Court of Justice.
Chancery [*or* King's Bench] Division.

Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

Take notice that this honourable Court will be moved [*if short notice of motion*, by leave granted] on the day of , or so soon thereafter as counsel can be heard, by Mr. , of counsel for the above-named plaintiff, that an injunction may be awarded against the defendant to restrain the said defendant, his servants or agents, until the trial of this action or further order, from either directly or indirectly making, using, or putting in practice the invention described in the specification and drawings filed under the letters patent granted to the plaintiff [*or* assignor, *or* other predecessor in title of plaintiff], and numbered , or that such further order may be made in the premises as to the Court may seem meet.

3. Affidavit in Support of Notice of Motion.

[*Title as above.*]

I, of , the above-named plaintiff, make oath and say,

1. Letters patent dated [ ] were granted to me under the Grant.

seal of the Patent Office for an invention entitled "improvements, &c., &c.," for a period of fourteen years from the day of .

Novelty. 2. At the time when the said letters patent were granted to me the said invention was new as to the public use and exercise thereof within this realm.

First inventor. 3. I am the true and first inventor of the said invention [*or* John Smith *or other* predecessor in title of the plaintiff, was the true and first inventor of the said invention].

Utility. 4. The said invention is of great public utility.

Validity. 5. [*State any particular facts, such as a previous action, search as to validity, or long user, which have a tendency to cause a presumption of the validity of the patent.*]

Infringement. 6. On the day of the defendant infringed the plaintiff's said patent by manufacturing [selling or using], &c. (*a*).

7. [The articles sold by the defendant were not manufactured by me or by my licensees or agents.]

Exceptional injury. 8. I believe that the defendant means to continue the infringement of the said letters patent, whereby my trade is greatly injured; persons refusing to purchase the patented articles from me [*or* I am unable to grant licences, *or state any other grounds of special damage arising by reason of the continued infringement*].

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4. Interlocutory Order to Restrain Infringement of Patent.

FORM 1.

Upon motion, &c., by counsel for the plaintiff, and upon hearing counsel for the defendant [*or* reading an affidavit of service of notice of this motion on the defendant; *or, if moved ex parte before the defendant has appeared,* the writ of summons issued in this action on the day of] [*enter affidavits in support and in opposition, if any*], and the plaintiff, by his counsel, undertaking to abide by any order this Court may make as to damages, in case this Court should hereafter be of opinion that the defendant shall have sustained any, by reason of this order, which the plaintiff ought to pay [*if so,* and also undertaking to accept short notice of motion to

Interlocutory injunction. dissolve the injunction hereby awarded], let an injunction be awarded to restrain the defendant T. until further order, from manufacturing any tube expanders similar to the tube expander which has been purchased by the defendant B., as in the plaintiff's writ mentioned, or otherwise constructed so as to imitate or resemble

(*a*) Affidavits in support by persons who have purchased the infringing articles should be adduced.

the roller expanding tool described in the specification in the plaintiff's letters patent in the said writ mentioned, and to restrain the defendants T. and B., their agents, &c., from selling or offering for sale, or otherwise parting with the custody of any tube expanders, or parts of any tube expanders, which have been so manufactured by the said defendant T. Liberty to either party to apply to expedite the hearing (*b*).

FORM 2.

On usual undertaking as to damages, let an injunction be awarded against the defendants S. and C., to restrain the said defendants, their servants, &c., until the trial of this action or further order, from either directly or indirectly making, using, or putting in practice the invention described in the specification and drawings filed under the letters patent, granted to N., dated the, &c., and numbered 2190, and now vested by assignment in the plaintiff, or any part thereof, except as to any skates made by the plaintiff, or his agents or agent (*c*).

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5. Interlocutory Injunction for Infringement refused on Terms.

Upon motion, &c., for injunction to restrain &c., and the defendant, by his counsel, undertaking to keep an account of all moneys received or to be received by him, by reason of the sale or use of the parlour or roller skates in the writ mentioned, this Court does not think fit to make any order upon the said motion, but does order that the costs of the said motion be costs in the cause (*d*). Refusal on terms.

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6. Inspection, Notice of Motion for.

[*Title as before.*]

Take notice that this honourable Court will be moved [*if in the Chancery Division*, before his lordship, Mr. Justice], on the part of the plaintiff, that the plaintiff, his solicitors and agents, and/or two scientific witnesses, to be named in the notice hereinafter mentioned, may be at liberty at all seasonable times, and as often as may be requisite, upon giving three days' previous notice in writing to the defendants' solicitors, to enter into and upon the business premises of the defendants, where the process of decorating or printing tin or metal plates is carried on by the defendants as stated in the plaintiff's statement of claim in this action, and to inspect and examine there the whole of the process by which such Scientific witnesses.

(*b*) *Dudgeon* v. *Thompson*, M.R., 24th March, 1874, A. 723.
(*c*) *Plimpton* v. *Spiller*, M.R., 16th March. 1876, B. 424.
(*d*) *Plimpton* v. *Malcolmson*, M.R., 4th March, 1875, B. 421.

printed and decorated tin and metal plates are manufactured by
Take samples. the defendants; and to take, on paying the reasonable charges of the defendants for the same, samples of such plates, and upon and during such inspection to make such observations as may be necessary and expedient for the purpose of obtaining full information and evidence of the mode by which such plates are manufactured by the defendants; and that the defendants may be ordered to permit the plaintiff, his solicitors and agents, and two persons to be named as aforesaid, to enter into and upon their said premises for the purposes aforesaid, and that the costs of this application may be
Costs. costs in the action (*e*).

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7. Inspection, where for a Process and to take Samples.

[*Title as above.*]

[*Formal parts as above*] to enter in and upon the business premises of the defendants, where the manufacture of is carried on by the defendants, as mentioned in the statement of claim in this action, and to inspect and examine there the machines used by the said defendants in the manufacture of , and the process by which is manufactured by the said defendants, and
Machines to be worked. that the said machines $\frac{\text{or}}{\text{and}}$ process may be put to work upon such inspection, and that the plaintiff, his servants or agents, may be at
Samples. liberty to take samples of the made or to be made by the said machines or process, upon paying to the defendants their reasonable charges for the same.

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8. Inspection of Plaintiff's Patented Process by Defendant.

[*Form of Order given in Griffin, P. C., at p.* 106.]

"That A. B. and one other indifferent person appointed by him and C. D., one of the defendant's solicitors, be at liberty at all such times and as often as in the opinion of the said A. B. be requisite, on giving 3 days' notice to the plaintiffs to enter into some business premises to be selected by the plaintiffs, where the process or mode of working referred to in the specification mentioned in the statement of claim can be seen at work, and to inspect and examine there the whole of the machinery fitted in such mill, and to take such samples of the finished and unfinished products of the working of such machinery as in the opinion of the said A. B. may be necessary for the purposes of this action, And it is ordered that such machinery be put to regular work upon such inspection. The costs of this application are to be costs in the action" (*f*).

(*e*) *Flower* v. *Lloyd*, 1876, A. 1254; as to inspection, see p. 359 *et seq.*

(*f*) *The Germ Milling Co.* v. *Robinson*, 55 L. J. Ch. 287; 3 R. P. C. at p. 14.

9. Inspection, and Order for Delivery by Defendant of Samples for Analysis.

[*Title as above.*]

[*Formal parts as above*] may be at liberty, upon giving three days' previous notice in writing to the defendant's solicitors, to enter upon the defendant's premises, and to inspect the type there used by the said defendant in his printing processes, as mentioned in the statement of claim in this action; and that the defendant may be ordered to permit the plaintiff, his solicitors and agents, and one person to be named as aforesaid, to enter upon his premises for the purpose aforesaid, and that said defendant may be further ordered to deliver to the plaintiff a competent part of the said type so used, on payment of a fair price for the same, and that the costs of this application may be costs in the action (*g*).

Samples for analysis.

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10. Order for Inspection of Defendants' Process by Experts.

Let I. and C., of, &c., be at liberty at all seasonable times, and as often as requisite, on giving three days' notice to the defendants, to enter into the business premises of the defendants, where the process of decorating or printing tin and metal plates is carried on by the defendants, as stated in the plaintiff's statement of claim, and mentioned in the said affidavits, or some of them, and to inspect and examine there the whole of the process by which such printed and decorated tin (*h*) and metal plates are manufactured by the defendants, and to take, on paying the reasonable charges of

Order for experts.

(*g*) This was the notice of motion in *The Patent Type Founding Co.* v. *Walter*, reported at 5 H. & N. 192; 29 L. J. Ex. 207; 6 Jur. N. S. 103; 1 L. T. Rep. N. S. 382. The samples of type in this case were required for the purpose of analysis.

Notice of motion for inspection must be supported by affidavit; a fair *primâ facie* case of validity and infringement must be made out. The order for inspection is frequently made upon the application for interlocutory injunction, and is sometimes made to include a cross order that the plaintiff shall permit the defendant to see and inspect the patented machine at work, and also to take samples: *Amies* v. *Kelsey*, 22 L. J. Q. B. 84. The affidavit should show that there is such property or machinery as is required to be inspected, that the inspection is necessary for the purpose of the action: *Shaw* v. *Bank of England*, 22 L. J. Ex. 26. It should also show what the patent is for, so that the Court or judge may see that there is necessity for the inspection. The order will not be granted on the plaintiff's application unless the Court is satisfied that it is essential to enable him to prove his case: *Batley* v. *Kynoch*, L. R. 19 Eq. 90; *Meadows* v. *Kirkmann*, 29 L. J. Ex. 205. In *The Singer Manufacturing Company* v. *Wilson*, 13 W. R. 560, the Court refused to give the plaintiff inspection of the defendant's stock before judgment, but ordered the defendant to verify by affidavit all the different kinds of sewing machines which he had sold since the last disclaimer entered by the plaintiff, and to produce one of each sort for inspection.

(*h*) No order will be made on this application for the inspection of books, for which a separate order must be obtained: *Vidi* v. *Smith*, 3 E. & B. 969.

the defendants for the same, samples of such plates, and upon and during such inspection to make such observations as may be necessary and expedient for the purpose of obtaining full information and evidence of the mode by which such plates are manufactured by the defendants (*i*).

Full information.

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11. Statement of Claim.

FORM 1.

1. The defendant has infringed and threatens to infringe the plaintiff's letters patent, No. , of , granted for an invention entitled " ." Particulars of breaches are delivered herewith.

2. The plaintiff claims:—

(1) An injunction to restrain the defendant, his servants and agents, from infringing the said letters patent.

(2) An inquiry as to the damages sustained by the plaintiff by reason of such infringement, or, at the option of the plaintiff, an account of the profits made by the defendant.

(3) That the defendant may be ordered to deliver up forthwith to the plaintiff all articles in his possession or power made in infringement of the said letters patent, or that the said articles may be ordered to be destroyed.

(4) Costs.

Signed
Delivered.

Statement of Claim.

FORM 2.

In the High Court of Justice.

Chancery [*or* King's Bench] Division.

Writ issued .

Between A. B. and C. and C. D. . . Plaintiffs,

and

E. F. . . . . Defendant.

Statement of Claim.

Assignment. . The plaintiff C. D., by virtue of an assignment dated day of , 18 , and duly registered, is the owner of certain letters patent, No. , of 18 , granted to X. Y. for "Improvements in the extracting mechanism of drop-down small arms," of

License. which the said X. Y. is the first and true inventor. The plaintiffs A. B. and C. are the sole licensees under the said letters patent.

2 The defendant is a gun manufacturer carrying on business at in the county of .

(*i*) *Flower* v. *Lloyd*, C. A., 5th July, 1876, A. 1254.

3. The defendant has for some time past manufactured and sold both guns and gun actions fitted with ejecting mechanism made in infringement of the plaintiffs' letters patent as appears in the particulars of breaches delivered herewith.

The plaintiffs claim:—

1. An injunction to restrain the defendant, his servants and agents, from making, using and vending guns containing ejector mechanism or portions thereof made in infringement of the plaintiffs' letters patent, or made so as to be a mere colourable imitation of the invention therein contained. Injunction.

2. An account of profits or, at the option of the plaintiffs, an inquiry as to damages. Account or damages.

3. Destruction of or delivery up by the defendant to the plaintiffs of all guns or portions of guns made in infringement of the plaintiffs' rights. Destruction or delivery of infringing articles.

4. Costs.

Signed.
Delivered the day of 19 .

Statement of Claim.

FORM 3.

[*Formal parts as above.*]

1. By assignment dated day of , and duly registered, Y. Y. assigned to the plaintiff certain letters patent granted to him for an invention entitled "Improvement in Ruffling Mechanism for Sewing Machines," dated day of , and numbered .

2. The defendant has infringed and threatens to infringe the said letters patent in the manner and at the times mentioned in the particulars of breaches delivered herewith.

3. The plaintiff claims:—(as above).

Statement of Claim.

FORM 4 (*pleas to be used where specification has been amended*).

1. The defendant has infringed and threatens to infringe the plaintiff's letters patent No. , of , granted for an invention entitled " ." Particulars of breaches are delivered herewith.

2. On the day of the plaintiff applied at the Patent Office for leave to amend the specification describing the said invention, and such leave was duly granted on the day of (*or* on the

day of in an action entitled the Hon. Mr. Justice granted to the patentee leave to amend his complete specification). The specification as originally filed was framed in good faith and with reasonable skill and knowledge.

Claim for Costs in Statement of Claim.

FORM 5.

[*To be used where a certificate of validity has been granted in a previous action.*]

The plaintiff claims full costs, charges and expenses as between solicitor and client. In an action brought by the plaintiff against X. for infringement, Mr. Justice certified that the validity of the patent came into question.

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12. Particulars of Breaches.

FORM 1.

In the High Court of Justice,
Chancery [*or* King's Bench] Division.
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

The following are the particulars of the breaches complained of in the statement of claim herein :—

Using. 1. The defendant on or about the day of at his factory at , in the county of , manufactured acetate of soda by the process and with the use of the machinery and appliances which form the subject-matter of all of the claiming clauses in the specification of the plaintiff's patent.

Selling. 2. On the day of the defendant sold to John Smith, of , one parcel containing tons of acetate of soda manufactured by the defendant by the process and with the use of the machinery and appliances which form the subject-matter of the plaintiffs' patent. The plaintiff will rely upon this sample as an instance of the type of the infringement committed by the defendants.

Signed.
Delivered the day of .

To
Defendant's solicitor.

Particulars of Breaches.—Where two or more types of Infringement complained of.

FORM 2.

[*Formal parts as above.*]

1. The defendant, on or about the day of , manufactured at his factory at , in the county of , sewing machines, which sewing machines contained shuttles which are infringements of the third claiming clause of the complete specification of the plaintiff's patent.

The defendant, on or about the day of , at his shop at , in the county of , sold a sewing machine which contained such a shuttle to .

The plaintiff will rely upon this machine as an instance of this type of infringement committed by the defendant.

2. The defendant, on or about the day of , in his workshop at , in the county of , by himself, his servants or agents, manufactured sewing machines, which sewing machines contain parts for bobbin-winding which are an infringement of the fifth claiming clause of the complete specification of the plaintiff's patent.

The defendant on or about the day of at his shop at sold a sewing machine, which contained a bobbin-winding apparatus, to .

The plaintiff will rely upon this machine as an instance of this type of infringement committed by the defendant.

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13. **Statement of Defence and Counterclaim** (*see* p. 329).

[N.B.—*One set of Particulars of Objections will serve Defence and Counterclaim.*]

In the High Court of Justice,
Chancery [*or* King's Bench] Division,
Mr. Justice .

Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

1. The defendant denies that the plaintiff is the legal owner of the letters patent sued on.

2. If the defendant has manufactured (sold *or* used) the articles (*or* process) as alleged in the particulars of breaches, the same were manufactured (sold *or* used) by leave and license of the patentee under the following circumstances :—(*set forth particulars*).

3. The defendant has not infringed the said letters patent as alleged, or at all.

4. The said letters patent are invalid for the reasons appearing in the particulars of objections delivered herewith.

See pp. 248, 260.

5. The defendant will rely, as a defence, upon the fact that the patented article (*or* process) is manufactured (*or* carried on) exclusively (*or* mainly) outside the United Kingdom : (viz., to the extent of (*fraction*) or thereabouts of the entire output in the countries of).

See pp. 248, 244.

6. The defendant will rely, as a defence, upon the fact that the reasonable requirements of the public with respect to the patented article (*or* process) have not been satisfied inasmuch as :—

(a) The patentee has neglected to manufacture and supply the patented article (*or* certain parts thereof, viz. :) (*or* to carry on the patented process) to an adequate extent having regard to the demand for the article (*or* product) whereby the trade or industry of (*name trade or industry*) has been and is unfairly prejudiced (*set forth particulars of prejudice*); *or*

(b) The patentee has refused to supply the article (*or* product) upon reasonable terms. The patentee has insisted upon the following unreasonable terms, viz. :—(*set forth terms*) and by reason of the said terms the trade or industry of (*set forth trade or industry*) has been and is unfairly prejudiced :—(*set forth particulars of prejudice*) ; *or*

(c) The patentee has refused to grant licences to manufacture (use *or* sell) the said invention upon reasonable terms (*or* at all). The patentee has insisted upon the following unreasonable terms :—(*set forth terms*) and by reason of (such refusal to grant licences) such terms the trade or industry of (*name it*) has been and is unfairly prejudiced ; *or*

(d) The patentee insists upon the insertion of conditions in contracts for the purchase (hire *or* use of, *or* the using *or* working of) the patented article (*or* process) whereby the trade or industry of (*name it*) is unfairly prejudiced. The objectionable terms are as follows :—(*set them forth*). The said trade or industry is unfairly prejudiced for the following reasons :—(*state them*).

See p. 215.

7. The defendant will rely as a defence upon the fact that in a contract dated the day of and made between the patentee of the one part and of the other part, which contract was in force when this action was commenced, there existed the following conditions, which have been rendered void by the Statute 7, Ed. VII. c. 29, p. 38 :—

(*Set forth the objectionable clauses.*)

See p. 376.

8. As an answer to the plaintiff's claim for damages, the defendant will rely upon the fact that at the date of the alleged infringement,

he was not aware nor had he reasonable means of making himself aware of the existence of the plaintiff's letters patent.

Counterclaim (*see* p. 253).

The defendant repeats paragraphs (4, 5, 6 *above*) of his defence and counterclaims for revocation of the plaintiff's letters patent.

The defendant is entitled (*see* p. 250) to counterclaim for revocation by reason that :—

(a) The defendant is duly authorised by His Majesty's Attorney-General for England.

(b) The letters patent sued on were obtained in fraud of the defendant's rights (*or* in fraud of the rights of X. through whom the defendant claims). Particulars of the said fraud are as follows :—(*set them forth*) (*k*).

(c) The defendant (or X., through whom the defendant claims an interest in the business of carried on at) had prior to the date of the said letters patent publicly manufactured (sold *or* used) the articles as claimed in the claiming clauses (No.) of the specification of the said letters patent, as set forth in paragraph of the particulars of objections delivered herewith.

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14. Particulars of Objections in an Action for Infringement or Petition for Revocation (*see* p. 335).

In the High Court of Justice,
Chancery [*or* King's Bench] Division.
Mr. Justice
Between A. B. . . . . Plaintiff.
and
C. D. . . . . Defendant.
(*Or Title of Petition.*)

Take notice, that the defendant (*or* petitioner) will, on the trial of this cause, rely on the following objections to the validity of the letters patent sued upon :—

1. The said (*name the original patentee*) was not the true and first inventor of the alleged invention. The true and first inventor thereof was J. S. of .

2. The said alleged invention was not new at the date of the said letters patent. It had been published :—

(*k*) Note that this ground is considerably wider than the corresponding ground allowed by section 11 of the Act of 1883. which was as follows : "on the ground of the applicant having *obtained the invention from him*, or from a person of whom he is the legal representative." The new section is wide enough to cover any kind of fraud.

(a) By the public manufacture (sale *or* use) of (*articles*) constructed in accordance with the said invention from the year to the present day at by the defendant (*or some other, naming him*) of . Articles so manufactured are now in existence and may be inspected by the plaintiff at

(b) By the public manufacture (sale *or* use) of (*articles*) constructed in accordance with the said invention from the year to the at by J. S. of . The said articles are no longer in existence. A description and drawings of the said articles are delivered with these particulars.

(c) By the public manufacture (sale *or* use) of (*product*) by means of the patented process at by of from the year until the year . A description of the said process and drawings of the apparatus used accompanies these particulars. The process is no longer in use, but the apparatus is in the possession of . The defendant will endeavour to obtain inspection of the apparatus by the plaintiff.

(d) By the deposit in the Patent Office Library of the following specification of letters patent granted in foreign countries :—

Name.	Date and Number.	Country.	Claims of plaintiffs' specification against which relied on.

(e) By the publication of the following specifications of British letters patent.

Name.	Date and Number.	Parts relied on.	Claims of plaintiffs' specification against which relied on.

(f) By the deposit in the Library of the British Museum in the year of a work bearing the title " " by and in particular by the passage commencing at p. l. and ending at p. l. .

3. The said alleged invention was not proper subject-matter for letters patent having regard to the common general knowledge at the date thereof. The defendant will rely upon the specifications set forth under paragraph 2 hereof as part of the common general knowledge of the art.

4. The said alleged invention was not useful.

5. The specification is insufficient to enable the invention properly to be carried into effect. The plaintiffs will rely upon the passage p. l. to p. l. , wherein no sufficient directions are given for (*state particulars of insufficiency*).

6. The specification gives directions which are misleading and dangerous. If the directions on p. , l. to p. , l. are carried out an explosion is liable to occur (*or other reasons*).

7. The subject-matter of the said letters patent was the subject-matter of a prior grant of letters patent to J. S., dated and numbered which letters patent were and are good and valid.

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15. Order for Further and Better Particulars of Objections.

Let the defendants on or before the day of deliver to the plaintiffs further and better particulars of the matters alleged in paragraph of the particulars of objections giving :—

(a) A description, accompanied by drawings, of the prior user alleged.

(b) The names and addresses of the persons by whom the articles mentioned are alleged to have been manufactured.

(c) The claims against which each of the prior publications alleged.

(d) The pages of the prior publications relied on.

And in default of the delivery of such particulars let the said paragraph be struck out.

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16. Order for Liberty to amend Particulars of Objections by adding Fresh Objections upon Terms.

Let the plaintiff, within six weeks from the date of this order, elect whether he will discontinue this suit, and if the plaintiff shall elect to discontinue this suit, and shall give notice thereof to the defendants within six weeks from the date of this order, refer it to the taxing master to tax the defendants their costs up to and including the 23rd February, 1875 (*delivery of the original particulars of objection*), and to tax the plaintiff's cost of this suit subsequently to the said 23rd February, 1875, to the date of this order, and the taxing master is to set off the costs of the plaintiff and of the

defendants to be so respectively taxed, and certify to which of them the balance after such set-off is due, and let such balance be paid by the party from whom, to the party to whom the same shall be certified to be due. And if the plaintiff shall not give notice to the defendants of his discontinuance of this suit within the time aforesaid let the defendants be at liberty to add to the particulars of objections to the validity of the plaintiff's letters patent, &c., which have been already delivered by the defendants, the following further objections to be relied on by the defendants at the hearing of this cause, viz. (*particulars of new objections proposed to be introduced by amendment*). And let defendants, Moules, &c. Co., pay to the plaintiff, A. F. Baird, his costs of this application to be taxed, &c., liberty to apply (*l*).

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17. Notice of Motion for Leave to amend Specification where Action for Infringement, or Petition for Revocation Pending.

In the High Court of Justice,
Chancery [*or* King's Bench] Division.
Mr. Justice.

(Title of action or petition.)

Take notice that this Honourable Court will be moved on at o'clock or soon thereafter as counsel can be heard, by counsel on behalf of the plaintiff (*or* respondent) that the plaintiff (*or* respondent) be granted leave to amend the complete specification upon which his letters patent No. of were granted, by (*state nature of amendment which is limited to disclaimer*) as indicated in red ink in the King's Printer's copy of the specification delivered herewith.

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18. Order allowing Application to amend to Proceed.

This motion coming before the Court on the day of and upon hearing counsel for the plaintiff (*or* respondent) and counsel for the defendant (*or* petitioner), and upon reading the copy of the specification with the proposed amendments indicated thereon the Court doth order that the application of the plaintiff (*or* respondent) be allowed to proceed and that this motion shall stand for hearing in the non-witness (witness) list on the day of (*fix day late enough to allow of applicant fulfilling requirements of Ord. LIII*A., r. 23), and the plaintiff (*or* respondent) shall within days deliver to the defendant (*or* petitioner) copies of the affidavits in support of his

(*l*) See *Baird* v. *Moules, &c. Co.*, L. R. 17 Ch. D. 139, n.

application ; and the defendant (*or* petitioner) shall within days of such delivery deliver to the plaintiff (*or* respondent) copies of his affidavits in answer ; and in the event of any third party giving notice of opposition to the amendment in accordance with the Statute and Rules in that behalf made and provided the plaintiff (*or* respondent) shall within days of receipt of such notice deliver to such person copies of the affidavits in support of his application, and such person shall within days of such delivery deliver to the plaintiff (*or* respondent) and to the defendants (*or* petitioners) copies of his affidavits in opposition, and within days of such delivery the plaintiff (*or* respondent) shall deliver to such person copies of his affidavits in reply to the opposition.

And the costs of this motion up to and including this order shall be the defendant's (*or* respondent's) costs in the cause (*or as directed*).

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19. Final Order allowing Amendment of the Specification on Terms.

This motion coming on for final hearing in the non-witness list on the day of and upon hearing counsel on behalf of the plaintiff (*or* respondent), counsel on behalf of the defendant (*or* petitioner), and counsel on behalf of A. B. an opponent to the opposition, and counsel on behalf of C. D. an opponent and counsel on behalf of the Comptroller-General of Patents and upon reading the specification and proposed amendments and the pleadings and particulars in the action (*or* petition) of and the affidavits of P., Q., S., T., and R., and upon the plaintiffs (*or* respondents) undertaking to seek no relief from the defendants (*or* petitioners) or from purchasers from them in respect of anything done prior to the date of the notice of motion on this application the Court doth Order that the said specification be amended by (*state amendment*) ; and it is Ordered that the plaintiffs (*or* respondents) pay to the defendants (*or* petitioners) and the Comptroller-General their costs of this application, and that the opponents A. B. and C. D. (*costs as directed*). And it is Ordered that the defendant may within days amend his defence and particulars of objections (and the petitioner shall within days hereof elect whether he shall withdraw his petition and in the event of such withdrawal the respondent shall pay to the petitioner his costs of the petition up to the date of such withdrawal *or as directed*).

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20. Minutes of Judgment for Plaintiff in Default of Defence, Order for Inquiry as to Damages, Injunction and Costs.

Let the defendants, Robert F. Chisholm and Joseph Lawrence,

trading as *R. F. Chisholm and Co.*, their servants and agents, be restrained during the continuance of the letters patent, No. 14,563 of 1890, and any extension thereof, from infringing the said letters patent, of which the plaintiff company are owners. Let an inquiry be made as to the damages sustained by the plaintiff company by reason of the infringement of the said letters patent by the defendants. Order payment by the defendants of the amount awarded within fourteen days after such amount has been ascertained. Let the defendants deliver up to the plaintiffs all tyres and parts of tyres in their possession or power made in infringement of the said letters patent. Let it be referred to the taxing master to tax the plaintiffs' costs of this action up to and including this judgment as between solicitor and client. Let the costs of the inquiry as to damages be reserved. Liberty to apply (*m*).

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21. **Final Judgment—Recital of Evidence—Injunction—Inquiry as to Damages—Order for Destruction—Costs as between Solicitor and Client—Liberty to apply.**

The following Order was settled by the late Master of the Rolls, Sir George Jessel, personally, in the case of Plimpton v. *Spiller, reported L. R. 6 Ch. D. 412.*

In the High Court of Justice, 1876. P. 69.
Chancery Division.

Thursday the 19th day of April, 1877.

Master of the Rolls.
Mr. Clowes, Reg.

Between J. L. P. . . . . Plaintiff,
and
A. F. S. and T. C. . . . Defendants.

Evidence. Certificate.

This action, coming on for trial the 11th and 12th days of April, 1877, and this day before this Court, in the presence of counsel for the plaintiff and the defendants, upon hearing an order, dated the 4th August, 1876, an affidavit of A. F. S. filed the 15th March, 1876; an affidavit of J. I., filed the 16th February, 1877, the bill, answers, orders, records for trial, and the certificate of the Master of the Rolls, the judge before whom the questions of fact were tried, that the validity of the letters patent of the 25th day of August, 1865, granted to A. V. N., and numbered 2190 hereinafter mentioned, came in question in the cause of P. *v.* M., 1875, P. 39, and upon hearing the said letters patent, and a certified printed copy of the specifications and drawings, filed under the said letters patent, and

(*m*) *Pneumatic Tyre Co.* v. *Chisholm*, 1896, 13 R. P. C. at p. 489.

the indenture of assignment, dated the 10th day of January, 1866, and made between the said A. V. N., therein described, of the one part, and the plaintiff, J. L. P., of the other part, and registered in the Great Seal Patent Office on the day of the date thereof, the printed shorthand note of the evidence taken orally before this Court on the trial of the said action of P. *v.* M., 1875, P. 39; of A. V. N., F. J. B., J. I., J. L. P., E. A. C., R. C. M., W. W. H. and E. J. C. W. and the exhibits marked 1, 2, and 4, then produced; the examination of H. J. A., W. B. P., W. G. A., A. F. S., J. I., T. M. W., G. B., C. P. B. S., E. E., W. S. M. and H. L., taken orally before this Court, on the 11th, 12th, and 19th days of April, 1877, and the exhibits marked: 1. 2. 4. A. B. C. D. E. F. G. H. I. L. M. N. O. P. E. E. 2. S. 1. S. 2. E. E. 1. E. E. 3. W. S. M. 1. W. 1. and W. 2. and the two catalogues and donation book produced to W. G. A., and the volume of the year 1863, of Jewitt's Book of Illustrations to the Report of the American Commissioners of Patent, and the "Scientific American" for the years 1863 and 1865; the records from the Court of Bankruptcy of an assignment, dated the 11th August, 1865, by W. S. M., for the benefit of his creditors, and of a composition deed by the said W. S. M., in the year 1869, and what was alleged by counsel on both sides, and this Court being of opinion that the plaintiff has proved the breaches complained of, in the particulars of breaches delivered by him in this action, doth order that an injunction be awarded to restrain the defendants, their servants, agents, and workmen during the continuance of the letters patent, granted to A. V. N., dated the 25th day of August, 1865, and numbered 2190, and any extension of the term thereof, from using, or exercising, or causing or permitting to be used or exercised, the invention described in the hereinbefore mentioned specification and drawings, filed under the said letters patent, and from selling, letting for hire, or making any profitable use, or permitting the sale, letting for hire, or profitable use of any roller or runner skates not made by the plaintiff, or his licensees, and having applied thereto rollers or runners in manner described and for the purposes mentioned in the said specification, or fitted with any apparatus for causing the skate to run in a curved line, in the manner described in the said specifications and drawings, or differing therefrom only colourably, and by the substitution of mere mechanical equivalents, and it is ordered that it be referred to the official referee in rotation, to inquire what sum of money is fit to be awarded to the plaintiff, to be paid by the defendants in respect of any damage sustained by the plaintiff up to the day of the date of this order, from the manufacture, sale, or letting for

Proof of breaches.

Injunction.

Mechanical equivalents.

Inquiry as to damages.

hire, of skates, being the same as the "Spiller" Skates, and "Wilson" Skates, in the pleadings in this action, and in the said order dated the 4th August, 1876, mentioned, or of any other skates made in infringement of the said letters patent, or otherwise from the sale, or use by the defendants of the said invention, or any apparatus in imitation of, or being only a colourable deviation from the said invention. And it is ordered that the defendants, A. F. S. and T. C., do pay to the plaintiff, J. L. P., such sum of money as upon such inquiry shall be found fit, to be awarded to the plaintiff for such compensation as aforesaid, within twenty-one days after service of the official referee's report of the result of the said inquiry. And it is ordered, that the defendants, A. F. S. and T. C., do deliver up on oath to the plaintiff, or break up, or otherwise render unfit for use, all roller skates, or parts of roller skates so manufactured, or let for hire by, or by the order, or for the use of the defendants in infringement of the said letters patent as aforesaid, which are in the possession, custody, or power of the defendants, or either of them, or their, or either of their, servants or agents. And it is ordered, that the said defendants, A. F. S. and T. C. do pay to the plaintiff, J. L. P., his full costs, to be taxed by the taxing master as between solicitor and client, including all costs, charges, and expenses. And any of the parties are to be at liberty to apply, as they may be advised.

Payment of amount.

Destruction.

Full costs.

Liberty to apply.

W. C.

Entered.
G. L.

Registrar's Office, Entering Lib. B. Seal.

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22. Judgment for Perpetual Injunction under the Patent Law Amendment Act, 1852, restraining Infringement of Patent for Machinery after Trial of Issues by a Jury—Discovery—Account of Profits—Certificate for Full Costs.

And the parties having, on the day of , proceeded to a trial of the questions of fact directed to be tried by the order dated, &c., before this Court by a jury, when the jury found that [*finding for the plaintiff upon all the issues*]. And upon reading the letters patent, dated, &c., and the complete specification, dated, &c., in the writ respectively mentioned, an affidavit of the plaintiffs', &c. [*enter evidence*], this Court doth order [*and*] decree [*and adjudge*] that an injunction be awarded to restrain the defendant, O., his agents, servants, &c., during the subsistence [*continuance*] of the plaintiffs' letters patent in the writ mentioned, or any extension thereof, from manufacturing, or selling, or disposing of, or using

Findings of jury.

Evidence.

Injunction.

any machine of the same construction as that supplied to him by the W. B. Co., in the said writ mentioned, or only colourably differing therefrom, or being an infringement of the plaintiffs' said patent, and from in any way infringing the plaintiffs' said patent; and it is ordered that the defendant, O., do, within [*seven*] days after service of this decree, make and file an affidavit stating what machines of the same construction as that supplied by him to the said W. B. Co., including such machines, are in his possession or power; and the plaintiffs are to be at liberty to inspect and mark the same for the purpose of identification. And it is ordered that an account be taken of the profits made by the defendant by making, using, selling, or disposing of the machines supplied by him to the said W. B. Co., or any other machine of the same construction therewith, or otherwise by an infringement of the plaintiffs' patent. And it is ordered that the defendant, O., do, within one month after the date of the chief clerk's certificate, pay unto the plaintiffs, N. and C., what shall be certified to be the amount of such profits. Direction for certificate that the validity of the plaintiffs' patent came in question. And it is ordered that the defendant, O., pay to the plaintiffs their costs of this cause up to and including this hearing, and their costs of the trial by jury of the questions of fact directed to be tried by the said order, dated, &c., including the costs of a special jury; such costs to be taxed, &c. Liberty to apply in chambers touching subsequent costs, and otherwise to apply as advised (*n*).

Order to inspect and mark.

Account.

Costs.

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23. Certificates necessary under Order LIIIa., Rule 22.

[*Form of judgment for perpetual injunction, accounts of profits and damages as above.*]

It is certified that the plaintiff has proved to the satisfaction of the Court the breaches mentioned in the particulars of breaches delivered by him, and numbered respectively 1, 2, 3, 4, and 5, and that the particulars numbered 6 and 7 were, in the circumstances of the case, reasonable and proper.

[*Form of judgment for defendant as above.*]

It is certified that the defendant has proved to the satisfaction of the Court the objections mentioned in the particulars of objections delivered by him, and numbered respectively 1, 2, 3, 4, and 5, and that the objections numbered 6 and 7 were, in the circumstances, reasonable and proper.

(*n*) *Needham* v. *Oxley*, V.-C. W., 24th June, 1863, 1395.

24. Certificate of Validity under Sect. 35 of the Patents and Designs Act, 1907.

I hereby certify, pursuant to the 35th section of the Patents and Designs Act, 1907, that upon the trial of this action, the validity of the letters patent, in the pleadings mentioned, dated the day of , and numbered , granted to , amended by disclaimer allowed the day of , and now vested in , came into question.

Dated this day of .

Signature of Judge .

FORMS IN AN ACTION TO RESTRAIN THREATS.

25. Indorsement on Writ.

The plaintiff's claim is :—

Injunction. 1. For an injunction restraining the defendant from, by circulars, advertisements, or otherwise, threatening to take legal or other proceedings against persons manufacturing, using, or selling an alleged invention of the defendant, to wit, . The said threats being to the prejudice of the plaintiff.

Damages. 2. For damages in respect of the injury sustained by the plaintiff by reason of the circulars, advertisements, or other threats of the defendant to take legal or other proceedings against persons manufacturing, using, or selling the said alleged invention.

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26. Interlocutory Injunction to restrain Threats.

Upon motion, &c., let an injunction be granted to restrain the defendant personally, or by his servants, agents, and workmen, by circulars, letters, or otherwise, from threatening any person with legal proceedings or liability in respect of the manufacture, use, sale, or purchase of a certain tap union of which the plaintiff was the patentee, and from interfering by such threats or otherwise with the manufacture, use, sale, or purchase of the plaintiff's invention (*o*).

[*Another Form.*]

A particular circular. Upon motion, &c., let an injunction be granted to restrain the defendant personally or by his servants, agents, and workmen, until further order, from issuing the circular dated 15th December,

(*o*) *Challender* v. *Royle*, L. R. 36 Ch. D. 425.

1888, and from, by means of circulars, letters, or otherwise, threatening any person with proceedings or liability in respect of the following papers manufactured by the plaintiff (*r*).

Other forms in an action to restrain threats are similar to those given under the heading of "Forms in an Action for Infringement."

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27. Form of Injunction.

This Court doth order and adjudge that the defendants *Parker and Smith*, their agents, travellers, and servants, be perpetually restrained from threatening the plaintiff or his customers with legal proceedings for the alleged infringement by him or them of the defendants' letters patent No. , of , by reason of the manufacture, sale, or use, of the plaintiff's hair-binder, known as the "Peigne Attache" or "Simple Attache" hair-binder (being the exhibit V. M. 1 produced to the plaintiff at the trial), and from circulating, by letters, advertisements, or other means any statements to the effect that the plaintiff's said hair-binder is made in infringement of the defendants' said letters patent (*s*).

FORMS IN A PETITION TO THE HIGH COURT FOR REVOCATION.

28. Petition for Revocation

In the High Court of Justice,

Chancery [*or* King's Bench] Division.

In the matter of letters patent granted to of , dated , and numbered , and in the matter of the Patents and Designs Act, 1907, sect. 25.

To his Majesty's High Court of Justice.

The humble petition of

SHEWETH as follows :—

1. Your petitioner is duly authorised by his Majesty's Attorney-General in England to present this petition (*if so, if not*, your petitioner claims to be entitled to present this petition by reason of the matters appearing hereafter in paragraphs 9 *or* 10, *which set forth the circumstances* (see p. 250)).

2. Your petitioner is a manufacturer of cigar cases, and has gained

(*r*) *Colley* v. *Hart*, 6 R. P. C. 17. 1903, 20 R. P. C. at p. 774.
(*s*) *Mountain* v. *Parker and Smith*,

a high reputation in the trade and with the public for his goods. Your petitioner has recently commenced to manufacture and has entered into contracts with retailers to supply to them quantities of cigar cases made with spring clips to hold each cigar in place.

3. The respondent is a manufacturer of cigar cases who carries on his manufacture at , in Belgium, and thence imports large numbers of cigar cases to his place of business at , Fleet Street, London.

4. The respondent claims to have a monopoly in the right to manufacture and sell cigar cases with spring clips of whatever construction, and bases his claim upon letters patent granted to him on the day of , and numbered , of .

5. The said letters patent are wholly invalid by reason of the matters set forth in the particulars of objections accompanying this petition.

6. By reason of the wide and comprehensive claims made in the specification, the retailers are afraid to purchase the goods manufactured by your petitioner and some have asked to be released from their contracts.

7. (*Allegation that articles are wholly or mainly manufactured abroad in Belgium, as in Statement of Defence, Form No.* 13, *paragraph* 5.)

8. (*Allegations of default to supply demand, as in Statement of Defence, Form No.* 13, *paragraph* 5.)

9. The said letters patent were obtained in fraud of the rights of your petitioner:—On the day of . your petitioner purchased from J. S. his goodwill and business of manufacturing cigar cases, together with the right to join with him in applying for letters patent for an invention which was the same as the invention subsequently patented by the respondent. The respondent was at the time an employee of the said J. S. and applied for and obtained the said grant of letters patent without the consent of the said J. S. or of your petitioner (*or other allegations of fraud*).

10. Prior to the date of the said letters patent your petitioner had publicly manufactured and sold articles constructed according to the alleged invention subsequently patented by the respondent (as set forth in the particulars of objections accompanying this petition).

The form of Particulars of Objections is similar to that used in an action for infringement.

FORMS USED IN OBTAINING THE FIAT OF THE ATTORNEY-GENERAL.

29. The Memorial of the Petitioner (see p. 252) (*t*).

In the matter of the Patents and Designs Act, 1907,
and
In the matter of letters patent granted to A. B. for an invention entitled No. of .

(*Set forth in numbered paragraphs all the matters alleged in the petition, amplifying them in detail. It is desirable that a bonâ fide statement should be made as to the state of affairs, and the memorial is not to be treated as in the nature of a mere pleading. Set forth also matters of this kind.*)

1. On the day of , the said (*naming the respondent*) commenced an action for infringement of the said letters patent against your memorialist, and on the day of , Mr. Justice gave judgment pronouncing the said letters patent invalid, but holding that had they been valid the articles manufactured by your memorialist would have infringed them.

Grantee of letters patent.

2. Your memorialist is the grantee of letters patent No. of , for an invention entitled , the infringement alleged in the hereinbefore-mentioned action (which was admitted) consisted in manufacturing cigar cases in accordance with the specification of the said letters patent of , and it is impossible to use your memorialist's said invention of without infringing the said letters patent of (*naming the respondent*), assuming the said letters patent to be valid.

Hampered in trade.

3. Your memorialist is seriously hampered in his trade by reason that no persons who are estopped as aforesaid from denying the validity of the said letters patent, by reason of licences granted to them by the said (*respondent*), can purchase from your memorialist cigar cases made in pursuance of his said letters patent of .

Documents.

4. The following documents are sent herewith :—

The specification of A. B. No. of 19 .
C. D. No. of 19 .
No. of 19 .

Copy writ, pleadings, and objections in the action.
Copy judgment of Mr. Justice , dated .

Application.

5. Your memorialist humbly requests you will authorise him to petition the Court for revocation of the said letters patent of (*the respondent*) of .

(*t*) On Judicature paper.

30. Declaration of Applicant verifying Statements in his Memorial to his Majesty's Attorney-General (*u*).

In the matter of the Patents and Designs Act, 1907,
and
In the matter of letters patent granted to for an invention entitled No. , dated .

I , of , do solemnly and sincerely declare as follows :—

That the several statements contained in the paper writing now produced and shown to me and marked A., purporting to be a memorial addressed by myself to his Majesty's Attorney-General of England (*or* Ireland, *or* Lord Advocate of Scotland), are true as therein set forth.

That the questions proposed to be raised by the petition and particulars of objections upon which revocation of the said letters patent is sought, are not and cannot be raised in any legal proceedings now pending in the United Kingdom.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at .

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31. Certificate of Solicitor (*v*).

In the matter of the Patents and Designs Act, 1907,
and
In the matter of letters patent granted to for an invention entitled No. , dated .

Between A. B. . . . Petitioner,
and
C. D. . . . Respondent.

I, of , solicitor for the above-named petitioner, do hereby certify that the said petitioner is a fit and proper person to be a petitioner in this matter, and that he is competent to answer the costs of all proceedings in connection with the said petition.

(*u*) On Judicature paper. (*v*) On foolscap.

FORMS IN PETITION FOR EXTENSION OF TERM OF PATENT

(See Ord. LIIIa., R. 3).

32. Advertisement of Intention to present Petition.

In the High Court of Justice,
Chancery Division.
Mr. Justice Parker.
In the matter of the Patents and Designs Act, 1907,
and
In the matter of letters patent granted to , of , and bearing date the of , and numbered .

Notice is hereby given that it is the intention of to present a petition to the High Court of Justice praying that the term of the said letters patent may be extended. And notice is further given that on the day of at , or so soon thereafter as counsel may be heard, the said intends to apply to the Court for a day to be fixed before which the petition shall not be in the paper for hearing. Notices of objection must be lodged before the date above mentioned at the chambers of Mr. Justice Parker, Room No. . Documents requiring service upon the said pursuant to the Rules of the Supreme Court, Order LIIIa., rule 3, may be served at the office of the solicitor to the said .

Dated this day of .

Solicitor to the said .

Address for service .

Petition.

In the High Court of Justice,
Chancery Division.
Mr. Justice Parker.
In the matter of the Patents and Designs Act, 1907,
and
In the matter of letters patent dated the day of , numbered and granted to A. B., of , for the invention of "."

To his Majesty's High Court of Justice.

The humble petition of A. B., of , and of C. D. of ,

SHEWETH as follows :—

1. On the day of letters patent numbered , were granted to your petitioner A. B., for an invention entitled

2. Your petitioner C. D. has become entitled to a half share in the said letters patent under the circumstances hereinafter appearing.

SET FORTH (a.) *The history of the Art with special reference to the invention.*

(b.) *The special utility and advantages of the invention.*

(c.) *The circumstances under which the patent was obtained and the rights of C. D. created.*

(d.) *All information relating to foreign patents.*

(e.) *The rights of third parties, such as licensees, etc.*

(f.) *The difficulties with which the patentee has had to contend in getting his invention taken up.*

(g.) *The fact of insufficient remuneration, generally stated without special reference to accounts.*

Your petitioners have given public notice by advertisement caused to be inserted in the "London Gazette" and in metropolitan and provincial newspapers pursuant to the rules in such cases made and provided, that it is their intention to apply to this Honourable Court for an extension of the term of the said letters patent.

Your petitioners therefore humbly pray that the said letters patent may be extended for a further term of fourteen years, or for such other term as to this Honourable Court shall seem fit.

And your petitioners will ever pray, &c.

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33. Affidavit as to Advertisements.

[*Heading as above.*]

I, of , solicitor, make oath and say as follows :—

1. I am acting as solicitor for the petitioners A. B. and C. D. in the petition for extension of the above-mentioned letters patent.

2. Pursuant to the directions given by the Honourable Mr. Justice Parker, I caused the advertisement of which a copy is contained in the Schedule hereto to be inserted in the issues of the "London Gazette" of [*date*] and in the issues of [*name papers and give dates*].

Copies of the issues of the said newspapers containing the said advertisements are now produced to me and marked . respectively.

The Schedule above referred to

(*Set forth copy of advertisement.*)

34. Notice of Opposition to Petition.

[*Heading as above.*]

Notice is hereby given that J. K. and Co., Ltd., of , intend to oppose the petition for extension of the term of the above-mentioned letters patent presented on the day of and returnable on the day of , and require due notice of all proceedings in reference to the above-mentioned letters patent.

Dated this day of .

(Signed.)

Solicitors for and on behalf of J. K. and Co., Ltd., aforesaid.

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35. Notice of Grounds of Objection.

[*Heading as above.*]

Notice is hereby given of the several grounds of the objection of J. K. and Co., Ltd., of to the granting of the prayer of the said petition, that is to say :—

1. The said letters patent are null and void, and a judgment was given against the validity of the said letters patent in a certain cause in the Court of , wherein the petitioner was plaintiff and defendant. — Patent held invalid in a court of law.

2. The said letters patent were revoked by the judgment of the Court of , in a petition for revocation presented by . — Patent revoked.

3. The alleged invention was not new at the date of the said letters patent. The opponent will refer to the following publications in support of this contention [*set them forth*]. — Want of novelty.

4. The alleged invention is of no use to the public, or not of so much public utility as to be a sufficient consideration for any prolongation of the term granted by the said letters patent. — Want of utility.

5. The said petitioner does not possess sufficient merit to entitle him to a prolongation of the term granted by the said letters patent. — Denial of merit.

6. The said petitioner is not entitled to (the whole of) the privilege granted by the said letters patent (by assignment or otherwise). — Title of petitioner.

7. The petitioner has been sufficiently remunerated and rewarded for all his expenses, labour, and ingenuity respecting the said invention. — Remuneration.

8. If the petitioner has failed to obtain a sufficient amount of remuneration or reward he has only failed to do so in consequence of his own gross negligence. — Negligence of petitioner.

Negligence in restraining infringements.

9. The petitioner has permitted infringements of the said letters patent, and has not taken any proceedings to restrain such infringements.

Insufficiency of specification.

10. The specification of the said letters patent does not sufficiently describe the nature of the invention or the manner in which the same is to be performed.

Denial of statements in petition.

11. The allegations contained in the said petition are not true in substance or in fact.

Dated the day of .

(Signed) ———

Solicitors for said J. K. and Co., Ltd.

SOME HINTS FOR DRAFTING ASSIGNMENTS AND LICENCES.

(1) Assignment.

Recitals.

1. Act of Assignment.
2. Consideration:—

(a.) Cash payment or cash and shares.

(b.) Annual fixed royalty, so long as patent is not revoked or declared invalid (*x*) (*coupled with covenant numbered* 14).

(c.) Royalty upon each article made (and sold) so long as patent is not revoked or declared invalid (*x*) (*coupled with covenant numbered* 14).

(d.) Provision for minimum royalty per annum, to cease if patent revoked or declared invalid (*x*).

(e.) Any other consideration agreed upon between the parties.

Covenants.

3. Covenant by assignor as to validity (*very onerous and seldom inserted*). Alternatively covenant that assignor has done no act or thing or omitted to do any act or thing whereby the patent might be revoked under sect. 27 of the Act of 1907, nor done any act prior to or subsequently to the date of the patent which might render the patent liable to revocation under sect. 25 (*y*).

4. Covenant by assignor to assign future improvements. ("*Improvements" should be defined,—the following definition is suggested:* "Improvements shall mean any manufacture, the use of which if by persons other than the owner of the letters patent hereby assigned, or their licensees, would involve an infringement of the said letters patent.") (*z*)

5. Covenant by assignor to instruct assignee or his servants in the manufacture, with such provisions for remuneration, &c., as may be agreed.

6. Covenant by assignee to keep accounts and permit inspection of books (not necessary when the consideration is a fixed sum).

7. Covenant by assignee to pay the consideration punctually.

8. Covenant by assignee to pay renewal fees and not to do or omit to do any act or thing whereby the patent might become void, or revocable under sect. 27 of the Act of 1907, or whereby a compulsory licence or revocation might be ordered under sect. 24. (*This is necessary only when the assignor retains an interest by way of royalties or otherwise.*) (*a*)

(*x*) See p. 207.
(*y*) See p. 196.
(*z*) See p. 199.
(*a*) See p. 196.

9. Covenant by assignee not to amend the specification without the consent of the assignor, such consent not to be withheld unreasonably. (*This may be necessary where the assignor retains an interest by way of royalties, or otherwise, which ceases on the patent being declared void. The assignee might amend the specification and thereby render the patent void, and on the other hand it may be necessary to amend to preserve the validity.*)

10. Covenant by assignee not to re-assign without the consent of the assignor.

11. Covenant by assignee to do his best to push the invention and to supply the public to the extent of the demand. (*This is often necessary when the assignor is paid by royalties, and the assignee carries on a rival process or manufacture and acquires the patent merely to maintain a monopoly and prevent competition.*)

12. Covenant by assignee that he will not by exporting to foreign countries, where foreign patents exist for the same invention, infringe such foreign patents or imperil their validity.

13. Covenant by assignor that in dealing with foreign patents he will make provision for the prevention of importation into this country, and for the protection of the assignee (*b*).

14. Covenant by assignee that he will sue infringers and that he will defend the validity and existence of the patent, and that he will use his best endeavours in all courts and at all times to maintain its validity and existence for the full term for which it was granted. (*Necessary when the consideration is a reserved royalty with or without a provision for a minimum.*)

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(2) Assignment for a District.

(*The same covenant as in an ordinary assignment will apply, but the following should be added :—*)

A covenant by the assignee that he will not apply to amend the specification without the consent of all the other owners.

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(3) Agreement for a General Licence (*not usually under seal*).

(1) Grant of licence for term of patent or less.

(2) Consideration :—

(a.) A cash payment—cash or shares.

(b.) An annual fixed royalty, so long as patent is not revoked or declared invalid (*c*).

(c.) Royalty upon each article made and sold so long as patent is not revoked or declared invalid (*c*).

(*b*) See p. 316. (*c*) See p. 207.

(d.) Provision for minimum royalty (*rarely required in an ordinary renewal licence*).

(e.) Any other consideration agreed upon between the parties.

(3) Warranty of validity by grantor (*should not be inserted save in extraordinary circumstances*). Alternatively recite that grantor has done nothing and knows of nothing which would render the patent invalid.

(4) Agreement by grantor to communicate all "improvements" (*see clause 4 of assignment*) which he may make or which shall come into his possession, and that the licensee shall have the full use of such improvement during the term of the licence, with or without further payment, as may be agreed, *or* the obligation to communicate improvements may be mutual and may extend to all other licensees under the letters patent (*d*).

(5) Agreement by grantor to instruct licensee and his servants in the manufacture with such provision for remuneration as may be agreed.

(6) Provision for keeping accounts, inspection of books and payment of royalties.

(7) Agreement by grantor to pay renewal fees and neither to do nor omit to do any act or thing whereby the patent might become void or revocable under sect. 27 of the Patents Act, 1907, or whereby a compulsory licence or revocation might be ordered under sect. 24 (*e*).

(8) Agreement by licensee not to export, and in sofar as he is able, to prevent exportation of the patented article to foreign countries where the patents exist for the same article.

(9) Conditions as to selling prices, &c., with a declaration that any breach of these conditions will constitute infringement. (*But beware of making terms which might bring into operation sections* 24 *or* 38).

Agreement by grantor that in granting future licences he will bind the future licensees by a similar clause.

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(4) **Exclusive Licence** (*may be under seal or not*).

(1) Grant of exclusive licence for term of patent or less.

(2) Consideration :—

(a.) A cash payment, cash or shares.

(b.) An annual fixed royalty so long as patent is not revoked or declared invalid.

(c.) Royalty upon each article made (and sold) so long as patent is not revoked or declared invalid.

(*d*) See p. 199.

(*e*) See pp. 204, 205.

(d.) Provision for minimum annual royalty to cease if patent revoked or declared invalid, or if minimum not paid, licence to become general only.

(e.) Any other consideration agreed upon.

(3), (4), (5), (6), (7) and (8) *As in general licence.*

(9) Provision that neither party is to do or omit to do any act or thing whereby the patent might become void, or revocable under sect. 27 of the Act of 1907, or whereby a compulsory licence or revocation might be ordered under sect. 24.

(10) Agreement by licensor, that in dealing with foreign patents he will make provision for the prevention of importation into this country, and for the protection of the assignee (*f*).

(11) Agreement by licensee not to export or permit exportation of the patented article to countries or colonies where patents exist for the same invention.

(12) Agreement by the licensor not to amend the specification of the invention without the consent of the licensee, such consent not to be unreasonably withheld.

(13) Agreement by the licensor to lend his name for the purpose of proceeding against infringers, on being properly secured by the licensees against liability for costs (*g*).

(14) Agreement by the licensees to finance and carry on proceedings against infringers and to defend proceedings directed against the validity or existence of the patent.

(*f*) See p. 316.

(*g*) See p. 320.

A FEW PRECEDENTS FOR THE TRANSFER OF INTERESTS IN LETTERS PATENT.

Sale of Patent Rights to a proposed Company.

1. *Preliminary Agreement with Promoter.*

AN AGREEMENT MADE THIS day of , 19 , Between A. B. of , C. D. of , and E. F. of hereinafter called the vendors of the first part, and X. Y. of hereinafter called the promoter of the other part. WHEREAS the vendors are the owners of certain letters patent dated and numbered , for an invention entitled . AND WHEREAS it is intended that the promoter shall procure forthwith the incorporation by registration under the Companies Acts, 1862 to 1893, of a company to be called Limited, and that the vendors shall for the considerations hereinafter mentioned sell and assign the said letters patent to the said Limited. AND WHEREAS a print of the memorandum and articles of association of the Limited has been approved by the parties hereto and is annexed to this agreement. Now it is agreed as follows :—

Agreement to assign to company.

1. The promoter shall and will forthwith procure the incorporation under the above-mentioned Acts of the said Limited, and shall and will duly register as the memorandum and articles of association of the said company the memorandum and articles of association hereinbefore referred to and which are set forth in the *schedule* hereto.

Promoter to procure incorporation.

2. With as little delay as possible after incorporation the vendors shall execute and the said promoter shall procure the execution by the said Limited of a contract similar to that set forth in the schedule hereto or such other contract as the parties hereto and the Limited shall agree upon.

Assignment to be executed by company.

3. If the promoter shall not before the day of 19 , perform his part of this agreement, then it shall be lawful for the vendors or either of them to determine the same by giving notice in writing of such determination to the promoter, and if the said Limited shall at that time have been incorporated also to the said Limited.

Notice of determination.

SCHEDULE.

2. *Agreement to Assign to the Company.*

AN AGREEMENT MADE THIS day of , 19 , Between A. B. of , C. D. of , and E. F. of , hereinafter called the vendors of the one part, and the Limited hereinafter called the purchasers of the other part. WHEREAS the vendors are the owners of certain letters patent dated and numbered and entitled . AND WHEREAS by agreement dated and made between the vendors of the one part and therein called the promoter of the other part, it was agreed that for certain considerations therein and herein mentioned the vendors should sell the said letters patent to the purchasers. Now it is agreed as follows :—

Recital of above agreement

1. The vendors shall upon the completion of the purchase as hereinafter provided for, assign unto the purchasers the said letters patent and all the right, title and interest of the vendors therein free from all incumbrances save as regards assignments for districts and licences already granted as hereinafter mentioned, and the vendors shall do all things necessary and execute all documents necessary for rendering the said assignment valid and effectual.

to assign.

2. The purchasers shall pay to the vendors on or before the day of the sum of £ in cash, and shall allot to the vendors or to such other person or persons as the vendors shall nominate fully paid up shares in the vendors' company, and immediately upon such payment being made and the said shares being allotted the vendors shall assign the said letters patent as in the first clause hereof provided.

Payment of cash and allotment of shares.

3. The said assignment shall be subject to assignments for districts and licences in the schedule hereof mentioned, but such assignment shall include all the rights and benefits from time to time hereafter accruing to the vendors under or by virtue of such assignments for districts or licences.

Assignment subject to licences, &c.

4. The vendors do not warrant or represent the validity of the said letters patent.

No warranty of validity.

5. Should the said purchase price not be paid or the shares not be allotted on or before the said day of the vendors shall be entitled to interest upon the said purchase price and upon the nominal value of the said shares after the rate of 5 per cent. per annum until payment and allotment, or at their option to determine this contract by notice under their hands delivered at the registered office of the company. PROVIDED ALWAYS that the vendors shall not be entitled to sue for or recover damages against the purchasers in respect of the breach of the said agreement.

Determination upon default.

6. The said A. B. shall be deemed the agent of the said C. D. and E. F. for the purpose of receiving the said purchase-money and shares and giving an effectual discharge for the same.

SCHEDULE.

Agreement to Obtain and Assign Letters Patent for an Invention in Consideration of a Sum of Money and Delivery of Certain Number of the Patent Articles (*h*).

AN AGREEMENT MADE THE day of , Between (*inventor*) of, &c., of the one part and (*purchaser*) of, &c., of the other part. WHEREAS the said (*inventor*) claims to have invented a new and improved kind of , a plan or drawing of which is hereunto annexed. AND WHEREAS the said (*purchaser*) has arranged with the said (*inventor*) for the sale to him of the benefit of the said invention in the manner and upon the terms hereinafter expressed. NOW WITNESS that in consideration of the sum of £ to the said (*inventor*) now paid by the said (*purchaser*) the receipt whereof is hereby acknowledged and also in consideration of the agreements hereinafter contained on the part of the said (*purchaser*) he the said (*inventor*) hereby agrees with the said (*purchaser*) in manner following (that is to say) that he the said (*inventor*) will at any time or times hereafter within the term of fourteen years to be computed from the day of the date of these presents upon the request and at the cost of the said (*purchaser*), his executors, administrators, or assigns, take and use all such steps, means, and proceedings as shall be requisite or proper for obtaining, and use his the said (*inventor*)'s utmost endeavours to obtain, in the name of him the said (*inventor*), a patent for the sole and exclusive making, using, exercising, and vending of the said invention within the United Kingdom of Great Britain and Ireland, and the Isle of Man, as the said (*purchaser*), his executors, administrators, and assigns, may desire, during the term or terms for which patents for inventions are usually granted. AND FURTHER, that the said (*inventor*), his executors or administrators, will at any time or times after obtaining any such patent upon the request and at the cost of the said (*purchaser*), his executors, administrators, or assigns, make, do, and execute all such assignments, deeds, matters, and things, as the said (*purchaser*), his executors, administrators, and assigns, shall reasonably require for assigning, and transferring unto the said (*purchaser*), his executors, administrators, and assigns, for his or their absolute benefit, the said patent,

Parties.

Agreement to obtain and assign patent.

Recital of invention.

Testatum.

In consideration of a sum and of the purchaser's covenants, inventor covenants with purchaser, to solicit grant of letters patent;

and to assign letters patent;

(*h*) Extracted by permission of the publishers from Bythewood and Jarman's Conveyancing.

to instruct purchaser in the invention.

and the full benefit and advantage thereof; AND FURTHER, that he the said (*inventor*) will, at any time or times hereafter, upon every reasonable request of the said (*purchaser*), his executors, administrators, or assigns, more particularly and sufficiently describe to him or them, or his or their agents or workmen, either in writing or by personal explanation and instruction, or otherwise, the nature of the said invention, and in what manner the same, and every part thereof, and every process relating thereto, are to be performed or carried into effect and used; AND FURTHER, that he the said (*inventor*), his executors or administrators, will not, nor shall any person or persons claiming by, from, through, or under him or them, at any time or times hereafter, during the term of fourteen years to be computed from the day of the date of these presents, without the consent or license of the said (*purchaser*), his executors, administrators, and assigns, either alone or in co-partnership, or in any other manner howsoever, directly or indirectly, make or assist in the making of any of the new and improved kind hereinbefore mentioned, or in the construction of which the aforesaid invention shall be used; or (except by any specification or specifications which may have to be executed and enrolled for the purposes of the application for the said patent) describe either in writing or otherwise, to any person or persons other than the said (*purchaser*), his executors, administrators, or assigns, the nature of the said invention, or in what manner the same is to be performed or carried into effect, or give any information, or do or permit or be party or privy to, any act, matter, or thing whereby or by means whereof the same respectively may be known by any person or persons other than as aforesaid, or whereby or by means whereof the said (*inventor*) may be prevented or hindered from obtaining the said patent for the purposes hereinbefore mentioned. AND FURTHER, that he the said (*inventor*) has not at any time or times heretofore described, either in writing or otherwise, to any person or persons other than the said (*purchaser*), the nature of the said invention, or in what manner the same is to be performed or carried into effect, or given any information, or done or permitted, or been party or privy to, any act, matter, or thing, whereby or by means whereof the same respectively may have been or may be known by any person or persons other than as aforesaid, or whereby or by means whereof he may be prevented or hindered from obtaining the said patent for the purposes hereinbefore mentioned; AND FURTHER, that he the said (*inventor*) will, at any time or times hereinafter, upon every request and at the cost of the said (*purchaser*), his executors, administrators, or assigns, make, do, execute, and perfect

Not to use invention without purchaser's licence;

nor, except by specification, to disclose invention;

that inventor hath not disclosed invention and is not prevented from obtaining patent;

for further assurance,

all such lawful acts, deeds, disclaimers, amendments, and other matters and things, for the better or more satisfactorily or effectually sustaining or maintaining such patent as aforesaid, and assuring the same, and the full benefit thereof, and of the said invention unto the said (*purchaser*), his executors, administrators, and assigns, as by him or them shall be reasonably required. AND in consideration of the agreements hereinbefore contained on the part of the said (*inventor*), he the said (*purchaser*) hereby agrees with the said (*inventor*), his executors and administrators, that he the said (*purchaser*), his executors or administrators, will, within the space of one year, to be computed from the day of the date of the patent to be so obtained as aforesaid, at his or their cost, make and deliver, for and to the said (*inventor*), his executors and administrators, complete, perfect, and well made and finished, of the new and improved kind hereinbefore mentioned. AND WILL, from time to time and at all times hereafter, save, defend, and keep harmless and indemnified the said (*inventor*), his heirs, executors, and administrators, and his and their estates and effects whatsoever and wheresoever, of, from, and against all costs and charges to be incurred or sustained in, about, or in anywise relating to the obtaining of the said patent, and the preparing any specifications which may be necessary for the purposes of the application for the same, and of, from, and against all claims and demands on account thereof. PROVIDED ALWAYS, and it is hereby agreed and declared, that the solicitor or agent to be employed in obtaining the said patent, and in preparing any such specification or specifications as aforesaid, shall be appointed by the said (*purchaser*), his executors, administrators, or assigns; AND THAT the said (*inventor*), his heirs, executors, or administrators, shall not be answerable or accountable for any neglect or default of such solicitor or agent, anything hereinbefore contained to the contrary thereof in anywise notwithstanding.

purchaser agrees to make a certain number of articles, and deliver them to the inventor;

to ndemnify inventor from costs of obtaining letters patent.

Proviso that purchaser is to appoint solicitor, or agent, and that inventor shall not be responsible for his default.

As witness, &c.

Agreement between Joint Owners of a Patent for Partition.

AN AGREEMENT MADE THE day of 19 , Between A. B. of the one part, and C. D. of of the other part.

WHEREAS the said A. B. and C. D. are joint owners of certain letters patent dated and numbered and entitled

AND WHEREAS they have agreed to divide the special licence, full power, sole privilege, and authority by the said letters patent granted in the manner and upon the terms hereinafter appearing. Now it is agreed as follows:—

Agreement to divide.

Assignment of district to A. B.

1. The said A. B. shall be solely entitled henceforth to use, work and vend the invention forming the subject-matter of the said letters patent in the following counties and shall be solely entitled within the said counties to grant assignments for districts or special or general licences upon any terms which the said A. B. shall see fit, and the said C. D. shall, whenever required to do so by the said A. B., execute a valid assignment of all his interest in the said letters patent within the said counties to the said A. B.

Assignment of district to C. D.

2. The said C. D. shall be solely entitled henceforth to use, work and vend the said invention in the following counties , and shall be solely entitled within the said counties to grant assignments for districts or special or general licences upon any terms which the said C. D. shall see fit, and the said A. B. shall, whenever required to do so by the said C. D., execute a valid assignment of all his interest in the said letters patent within the said counties to the said C. D.

Neither party to account.

3. Neither party shall be bound to account to the other for any profits, royalties, or payments received by him with respect to the using, vending, or working the said invention within the counties or districts assigned to him hereby.

Payment of fees, &c.

4. The said C. D. shall from time to time and as they become due pay the fees for the continuance and renewal of the said letters patent, and shall be entitled to recover one moiety of the sums of money so paid from the said A. B.

Future patents elective.

5. This agreement and all the provisions thereof shall apply to any letters patent obtained or acquired by either party hereto for any improvements upon the said patented invention, and neither party shall be bound to make any payments in respect of any such improvements to the other. PROVIDED ALWAYS, that immediately after applying for any such letters patent the party seeking to obtain the same shall give notice in writing to the other of the said improvement and full particulars respecting the same, together with a copy of the specification filed, and thereupon the other party shall elect whether he shall take the benefit of the said invention or not, and if he elects to take the benefit thereof shall from time to time pay to the party applying for such letters patent one moiety of all the costs, fees, and charges incurred in obtaining or seeking to obtain such letters patent, and then the said letters patent and the said invention shall be deemed to be within this agreement, but should he elect not to pay the said moiety of costs, fees, and charges, then he shall be deemed to have abandoned all claim to the said letters patent and invention, and the party applying for such letters patent shall thenceforth be the sole owner thereof.

6. Neither party shall apply for leave to amend the specifications to any letters patent within this agreement without the consent of the other first had and obtained. No amendment without consent.

7. So far as practicable this agreement shall apply to and be binding on the executors, administrators, or assigns of the parties hereto.

Agreement for Working and Selling an Invention, in respect of which an Application for a Patent has been made, for the Joint Benefit of the Inventor and another Person (*i*).

AN AGREEMENT made the day of , 19 , Between (*inventor*), of, &c., of the one part; and (*capitalist*), of, &c., of the other part. Parties.

WHEREAS the said (*inventor*) has made an application, dated the day of , 18 , number , for a patent for an invention of (*title of invention*), which application was accompanied by a complete specification: Recitals of application for patent; of acceptance of specification;

AND WHEREAS the said complete specification has been accepted: AND WHEREAS the parties thereto have agreed to enter into the arrangements hereinafter mentioned in respect of the said invention and application, and the patent to be obtained thereupon. of agreement for arrangement as to working, &c., the invention.

NOW THESE PRESENTS WITNESS that it is hereby agreed as follows, that is to say :— *Testatum.*

1. The said (*capitalist*) shall immediately upon the execution of these presents, pay to the said (*inventor*) a sum of £ , to be applied by him towards the expenses of working and developing the said invention. Agreement. Capitalist to contribute sum for expenses.

2. In consideration of the payment so agreed to be made as aforesaid, and of the agreements on the part of the said (*capitalist*) hereinafter contained, the said (*inventor*) shall use his best endeavours to perfect the said invention and to obtain the grant of the said patent in his own name, and shall, whenever required by the said (*capitalist*) after the granting of such patent, assign the same, so that the same premises may be legally and beneficially vested in the said parties hereto as tenants in common in equal shares, and the said parties hereto shall as well before as after such assignment, be entitled to the said patent in the shares aforesaid. Inventor to endeavour to obtain patent, and assign the same when required.

3. The said (*inventor*) without any further remuneration than the monies hereinafter agreed to be paid by the said (*capitalist*), will communicate to the said (*capitalist*) all improvements which the said (*inventor*) has already invented, discovered, or made, or may Inventor to communicate improvements.

(*i*) Extracted by permission of the publishers from Bythewood and Jarman's Conveyancing.

during the continuance of the said patent, or of any other patent which may become subject to the provisions of these presents, invent, discover, or make in, or in connection with the said invention; and also all improvements, whether patented or not, in or in connection with the said invention, of which the said (*inventor*) shall become the owner, or have the control.

Inventor to apply for foreign and colonial patents.

4. The said (*inventor*) will also, at the expense in the first instance of the said (*capitalist*), such expense to be considered as an advance, and to be reimbursed as hereinafter mentioned, apply for and endeavour to obtain in such foreign countries, or British colonies, or dependencies, as the said (*capitalist*) shall think proper, and shall require, the like privilege for the invention comprised in the application, and for any such improvements as aforesaid; and will, as far as practicable, at the request and expense, in the first instance, of the said (*capitalist*), such expense to be considered as an advance, and to be reimbursed as hereinafter mentioned, render all such foreign and colonial patents, and the said improvements available for the exclusive use of the said parties hereto in equal shares; and execute and do every act, deed, and thing which may be necessary or expedient for effectually vesting the same in the said parties hereto in the shares aforesaid.

Capitalist to make advances for working and developing nvention.

5. The said (*capitalist*) shall advance from time to time such monies as he shall think fit for working and developing the patent to be obtained on the aforesaid application numbered , or the said foreign and colonial patents or like privileges, or any such patents for improvements as aforesaid (all which patents and privileges are collectively referred to as the "said patents"), and for defraying the costs and expenses of obtaining and completing the said patents respectively, and keeping the same on foot, and for protecting or defending the same from, or obtaining damages or other compensation for infringements or otherwise defending the said patents, or of obtaining renewals and extension of the term of the said patents, or amending the specification thereof, or working or developing the working comprised in the said patents (hereinafter referred to as the said patented inventions), or introducing the same to the public, or exercising or using the said patented inventions, or any of them, or any parts thereof respectively, or for any purpose whatever in connection with the said patents, or any of them; and the said advances, and also the aforesaid sum of £ shall be repaid to the said (*capitalist*) as hereinafter mentioned; and if there shall at any one time during the continuance of this agreement be owing to the said (*capitalist*) in respect of such advances in the aggregate, the sum of £ , or upwards, then

any excess of such advances over the sum of £ , shall carry interest at the rate of £5 per cent. per annum from the date when such excess shall have become due to the said (*capitalist*) until the same shall be paid.

Charge of advances on patents.

6. All advances made by the said (*capitalist*) as aforesaid, and all interest shall be, and the same are hereby charged upon the said patents as a first charge upon the same.

Application of royalties, proceeds of sale of patent rights, &c.

7. All monies which shall be received by way of royalties, or otherwise, as the consideration for any licence granted for the use of the said patented inventions, or any of them, or any part thereof respectively, or which shall be received as the proceeds of the sale, or other disposition of the said patents, or any share or interest therein, or which shall be received in respect of any working, using, or exercising by or on behalf of the said parties hereto, or either of them, of the said patented inventions, or any of them, or any part thereof respectively, or which shall in any manner whatever arise, or be received out of, or in respect of the said patents, or any of them, all which monies are hereinafter referred to as "the proceeds of all the said patents," shall be applied as follows:—that is to say, in the first place, in payment of the costs and charges incurred with the consent of the said (*capitalist*) attending the license, sale, disposition, or working in respect of which the same respectively shall be received; and in the next place, and as a charge upon the said proceeds of the said patents, and in priority to any other payments hereinafter mentioned, in payment to the said (*capitalist*) of all advances made by the said (*capitalist*) as aforesaid with the interest thereon, in the events, and at the rate, and in manner aforesaid; and in the next place, in payment of all expenses of working the said patents (hereinafter referred to as the patent expenses, and defined as hereinafter mentioned); and the balances which shall remain of the proceeds of the said patents, after making the same payments aforesaid, shall be divided between the parties hereto in equal shares

Definition of "patent expenses."

8. For the purposes of this agreement the expression "patent expenses" shall mean and include all monies which, with the consent of the said (*capitalist*), shall be expended for any of the purposes mentioned in the 5th clause of these presents, which shall not have been defrayed by monies advanced by the said (*capitalist*).

Reserve fund.

9. There shall be set aside yearly out of the aforesaid proceeds of the said patents and premises, after payment of the said costs, charges, and interest (if any), and of the said patent expenses, such a sum not exceeding £ in any one year, as the said (*capitalist*) shall think proper, as a reserve fund for meeting contingencies, and providing monies for working and developing the patents, or for

any of the purposes mentioned in the 5th clause of these presents, and such reserve fund may from time to time be drawn upon and applied for any of the purposes aforesaid, as and whenever the said (*capitalist*) shall think fit.

Inventor to devote attention to working patent.

10. The said (*inventor*) shall give as much time and attention as may be necessary for working and developing the said patented inventions, and shall use his best endeavours to promote the success thereof, but the said (*capitalist*) shall not be bound to give more time or attention thereto than he shall think proper.

Neither party to grant licences, &c., without consent of the other.

11. During the continuance of the arrangement hereby made, neither of the said parties hereto shall, without the consent of the other of them grant, or agree to grant any licence for working the patented inventions, or any of them, or any part thereof, or sell or dispose of his share or interest in the said patents or any of them, or any part thereof, or use or exercise the said invention, or make any payment, or incur any expenses, debts, or liabilities in respect of the said patents or patented inventions, and in case any payment, debt, or liability shall be so made or incurred without such consent, the same shall be made or incurred on the separate and individual account of the party making or incurring the same, and shall be borne by him exclusively, without any right to resort to the proceeds aforesaid of the said patents, and the other of the said patents hereto shall be indemnified by him in respect of the same.

Inventor alone to work the patent; rendering accounts to capitalist.

12. The said patents, patented inventions, and premises shall be worked, and the business thereof shall be carried on in the name of the said (*inventor*) alone as patentee; and proper accounts shall be kept by him of all payments made, and monies received, and liabilities incurred in respect thereof, and of all transactions relating thereto, and all monies received in respect of licences, sales and dispositions or otherwise in respect of the said patents, shall be paid into a bank to an account to be kept in the joint names of the said parties hereto, and shall not be paid out except upon the joint cheque of both parties. The books of account and other documents shall be kept in the custody of the said (*inventor*) at his office or such other place in London as the said parties hereto may agree upon, but so as that the said (*capitalist*) may at any time have access thereto. The accounts relating to the said patents, patented inventions, and premises shall be made up and balanced half-yearly on the day of , and the day of , or oftener if the said parties hereto shall so agree.

Inventor to take all proceedings necessary for

13. The said (*inventor*) shall, during the continuance of the arrangements hereby made, take all such proceedings as the said (*capitalist*) shall require for keeping up the said patents and

protecting and defending the same from and obtaining damages or other compensation for infringement or otherwise defending the said patents or any of them, obtaining renewals or extensions of the term of the said patents or any of them, or amending the specifications thereof, and the costs and expenses of all such proceedings as last aforesaid shall be defrayed in the first instance by the said (*capitalist*), and shall be considered as advances by him within the meaning of the 5th clause of these presents, and so far as not defrayed by the said (*capitalist*) shall be considered as part of the patent expenses as hereinbefore defined.

protecting patents.

14. Nothing herein contained shall be construed as constituting a partnership between the said parties hereto.

Clause negativing partnership.

15. The arrangement hereby entered into shall remain in force until the expiration of the term of the patent to be granted in respect of the said application numbered aforesaid, and of any renewal or extension thereof, and during any further patents, whether British, colonial, or foreign, to be obtained for the said invention, or any such improvements as aforesaid in case both the said parties hereto shall so long live. PROVIDED ALWAYS that it shall be lawful for the said (*capitalist*) at any time hereafter to determine the said arrangement upon giving to the said (*inventor*), or leaving for him at his last known place of business or abode in England, calendar months' previous notice in writing of an intention so to do; And in the event of the said arrangement being determined by the death of either party, or by notice as aforesaid, the said patents and any extension or renewal thereof, and the proceeds of the said patents to be received in respect of any licences, sales, working, or using of the patented inventions which have been granted, effected, or taken place previously to such determination as aforesaid shall, subject to the payment thereout of the costs, charges, advances, interest, and patent expenses as aforesaid (subject to any charge thereon under the provisions hereinbefore contained in favour of the said (*capitalist*) for unpaid advances and interest) belong to the said parties hereto in equal shares, and each of the parties hereto, or their respective executors, administrators, or assigns, shall thenceforward be at liberty and entitled to work, use, and exercise the said patented inventions, and to grant licences (not being exclusive licences) for working and using the same, or to sell, assign, or otherwise dispose of his share and interest in the said patents without being liable to account to the other of such parties, his executors, administrators, or assigns, for the profits, royalties, or monies to be derived from the same.

Duration of arrangement.

Proviso for *determining* arrangement by notice.

As witness, &c.

Assignment of a Patent.

THIS INDENTURE MADE THE day of 19 , Between A. B. of of the one part, and C. D. of of the other part.

WHEREAS by letters patent under the seal of the Patent Office, numbered and dated day of 19 , and entitled "Improvements, &c. ," his Majesty the King gave and granted unto the said A. B., his executors, administrators, and assigns, his Majesty's especial licence, full power, sole privilege and authority, that he the said A. B., his executors, administrators, and assigns, and every of them during the term therein expressed should and lawfully might make, use, exercise, and vend his said invention within the United Kingdom of Great Britain and Ireland and the Isle of Man, and the whole profit and advantage from time to time accruing by reason of the said invention during the term of years therein mentioned to have, hold, exercise and enjoy the said licence, power, privileges, and advantages thereinbefore granted unto the said A. B., his executors, administrators, and assigns for and during and unto the full end and term of fourteen years from the date of the now reciting letters patent next ensuing subject to the conditions and provisoes therein contained. AND WHEREAS the said A. B. has agreed for the sum of £ to assign unto the said C. D. the said invention and the said letters patent and all the licence, power, privilege and advantage thereby granted, and any extension of the same, together with all improvements and additions useful to the manufacture the subject-matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the said A. B.

General recitals.

Testatum. NOW THIS INDENTURE WITNESSETH that in pursuance of the said agreement and in consideration of the sum of £ , this day paid by the said C. D. to the said A. B. (the receipt whereof is hereby acknowledged) he the said A. B. *as beneficial owner* (*k*),

(*k*) By the Conveyancing Act, 1881, s. 7 (a), it is provided, "In a conveyance for valuable consideration, other than a mortgage, the following covenant by a person who conveys and is expressed to convey as beneficial owner (namely) : 'That, notwithstanding anything by the person who so conveys, or any one through whom he derives title, otherwise than by purchase for value, made, done, executed, or omitted, or knowingly suffered, the person who so conveys, has, with the concurrence of every other person, if any, conveying by his direction, full power to convey the subject-matter expressed to be conveyed, subject as, if so expressed, and in the manner in which it is expressed to be conveyed, and that notwithstanding anything as aforesaid that subject-matter shall remain to and be quietly entered upon, received and held, occupied, enjoyed and taken by the person to whom the conveyance is expressed to be made, and any person deriving title under him, and the benefit thereof shall be received and taken accordingly, without any lawful interruption or disturbance by the person who so conveys or any person conveying by his direction or rightfully claiming, or to claim by,

doth hereby assign unto the said C. D., his executors, administrators and assigns, all that the said special licence, full power, sole privilege and authority, and the said invention and all and every of the rights, privileges, profits, benefits, commodities and advantages in and by the said hereinbefore recited letters patent granted, together with the said hereinbefore recited letters patent, and also all the right, title, interest, claim and demand whatsoever of him the said A. B., his executors, administrators and assigns, or any of them, to apply and petition for, obtain and procure a prolongation, or extension of the said licence, privilege and authority, and of the said term of fourteen years granted by the said hereinbefore recited letters patent, and to apply and petition for, obtain and procure any new or other letters patent to be granted for any new or additional term or term of years.

Habendum.

TO HAVE, HOLD, AND RECEIVE, take, exercise and enjoy the said especial licence, sole privilege and authority, invention, letters patent, rights, privileges, and all and singular the premises hereby assigned or intended so to be unto and by the said C. D., his executors, administrators and assigns for and during all the rest, residue and remainder which is now to come and unexpired of the

through, under, or in trust for the person who so conveys, or any person conveying by his direction, or by, through, or under any one not being a person claiming in respect of an estate or interest subject whereto the conveyance is expressly made, through whom the person who so conveys derives title otherwise than by purchase for value; and that freed and discharged from or otherwise by the person who so conveys sufficiently indemnified against all such estates, incumbrances, claims and demands other than those subject to which the conveyance is expressly made as either before or after the date of the conveyance, have been or shall be made, occasioned or suffered by that person or by any person conveying by his direction or by any person rightfully claiming by, through, under or in trust for the person who so conveys or by, through, or under any person conveying by his direction or by, through or under any one through whom the person who so conveys derives title otherwise than by purchase for value, and further that the person who so conveys and any person conveying by his direction and every other person having or rightfully claiming any estate or interest in the subject-matter of conveyance other than an estate or interest subject whereto the conveyance is expressly made by, through, under, or in trust for the person who so conveys or by, through, or under any person conveying by his direction or by, through, or under any one through whom the person who so conveys derives title otherwise than by purchase for value will from time to time, and at all times after the date of the conveyance on the request and at the cost of any person to whom the conveyance is expressed to be made or of any person deriving title under him execute and do all such lawful assurances and things for further or more perfectly assuring the subject-matter of the conveyance to the person to whom the conveyance is made and those deriving title under him subject as if so expressed and in the manner in which the conveyance is expressed to be made as by him or them or any of them shall be reasonably required: (in which covenant a purchase for value shall not be deemed to include a conveyance in consideration of marriage).'" It has been suggested therefore that the use of the words in a patent conveyance might be held to imply a covenant for validity. It is perhaps better to use a simple covenant for title only.

said term of fourteen years granted and created by the said hereinbefore recited letters patent and for and during all other the term right and interest of him the said A. B., under or by virtue of the said hereinbefore recited letters patent or otherwise howsoever to and for the sole use, benefit and advantage of the said C. D., his executors, administrators and assigns.

Covenant as to validity

And the said A. B. for himself, his heirs, executors, and administrators doth covenant with the said C. D., his executors, administrators and assigns, by these presents in manner following (that is to say), that notwithstanding any act, deed, matter or thing by the said A. B. done, executed or permitted, the said hereinbefore recited letters patent are at the time of sealing and delivery of these presents, good, valid and sufficient in the law for all and every of the purposes therein mentioned and expressed, and that the same letters patent or the grant therein expressed or contained have not been and are not surrendered, forfeited or become void or voidable in anywise whatsoever (*l*).

and as to specification being sufficient, &c.

And that the specification filed by the said A. B. at the Patent Office pursuant to the conditions upon which the hereinbefore recited letters patent were granted, well and sufficiently describes and ascertains the nature of the invention mentioned in the said letters patent, and in what manner the same is to be performed, and that the same specification was truly and duly made and filed according to and well, truly, fully and sufficiently performed and complied with the conditions in that behalf in the same hereinbefore recited letters patent expressed and contained.

In witness.

Additional Recitals.

Substituted recital of agreement for a sum down and future payments. *See* Covenant and conditions in such a case.

AND WHEREAS THE SAID A. B. has agreed for the sum of £ , and for other sums by way of percentage as hereinafter mentioned, and subject to the contracts on the part of the said C. D. hereinafter contained to assign (&c., as before).

Foreign and colonial patents recital.

AND WHEREAS the said A. B. has applied for and obtained letters patent or a brevet d'invention, for the said invention in the following foreign states and countries . . . . . and in the

(*l*) It is obvious that this is a stringent covenant on the part of the patentee, inasmuch as it renders him responsible should it hereafter appear for any reason, such as anticipation, &c., that the letters patent were invalid. This covenant and the next should be carefully considered before they or either of them are inserted.

following British Colonies . . . . . whereby the said A. B., his executors, administrators and assigns, have acquired the sole right, privilege and authority to work, use, or vend the said invention in the said foreign States and British colonies for the terms of years limited respectively by the said letters patent and brevet d'invention, and whereas in consideration of the sum of money hereinbefore expressed, the said A. B. has agreed to assign the said letters patent and brevet d'invention to the said C. D.

AND WHEREAS the said A. B. has represented himself to the said C. D. to be to the best of his knowledge, information and belief, the true and first inventor of the said invention within this realm.

True and first inventor.

AND WHEREAS the said A. B. has assigned the said letters patent and all the rights, powers, privileges and advantages of him the said A. B. in the said letters patent and the said invention for the counties of to G. H., his executors, administrators or assigns, and for the counties of to J. K., his executors, administrators or assigns, &c., &c.

Previous assignments for districts (*m*),

AND WHEREAS the said A. B. contemplates and intends to assign the said letters patent and all the rights, powers, privileges and advantages of him the said A. B. in the said letters patent and the said invention for other districts so soon as a purchaser shall be found therefor.

and of intention to assign for other districts.

AND WHEREAS the said A. B., by indenture dated , has granted a licence unto E. F. of , his executors, administrators and assigns, to manufacture, use and vend the said invention during the continuance of the said letters patent or any extension or renewal thereof, upon certain terms and conditions as to the payment of royalties and otherwise in the said indenture made and provided (*n*).

Recital of licence granted.

AND WHEREAS the said A. B. has agreed in consideration of the sum of £ to assign unto the said C. D., benefit of the said letters patent so far as the same relates to the counties of , but not elsewhere, and so far as the same relates to the said

Substituted recital of agreement to assign for a district.

(*m*) See special covenant necessary in such cases as to applications to amend, &c., &c.

(*n*) This may be varied by reciting "an exclusive licence" or "an exclusive licence for the county of ——."

counties, all the licence, power, privilege and advantage thereby granted, and any extension of the said letters patent together with all improvements and additions useful to the manufacture the subject-matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the said A. B.

Assignment for a county (*o*).

NOW THIS INDENTURE WITNESSETH that in pursuance of the said agreement, and in consideration of the sum of £ this day paid by the said C. D. to the said A. B. (the receipt whereof is hereby acknowledged) the said A. B., *as beneficial owner*, doth hereby assign unto the said C. D., his executors, administrators and assigns, all that the special licence, full power, sole privilege and authority, and the said invention, and all and every the rights, privileges, profits, benefits, commodities and advantages in and by the said hereinbefore recited letters patent granted so far as the same relate to the counties of , and not elsewhere.

Foreign and colonial patents (*p*).

TOGETHER WITH all licence, powers, privileges, and advantages granted to the said A. B., his executors, administrators, and assigns: by virtue of the said recited letters patent and brevets d'invention for foreign States and British colonies.

Assignment of benefit of licences.

TOGETHER WITH all the rights, royalties, benefits and advantages of the said A. B., under and by virtue of the said recited licence granted by the said A. B. unto E. F., his executors, administrators, and assigns.

Additional Covenants. (*See* Recitals.)

Covenant as to percentage when such is stipulated for by vendor.

AND THE SAID C. D. hereby covenants with the said A. B. that if and so soon as the said C. D., his executors, administrators, or assigns, shall have received out of the net profits (to be calculated as hereinafter mentioned) arising from or by means of the said invention, or such improvements as aforesaid (patents for which improvements shall have been assigned to or become vested in the said C. D., his executors, administrators, or assigns), or from or by means of any sales, or licences, or dispositions of, or dealings with the same invention, or patented improvements, or otherwise, from,

(*o*) See proviso restricting actions for infringement.

(*p*) See covenants as to maintaining such foreign patents.

or by means of the using, exercising, vending, or making the said invention, or any such patented improvement as aforesaid, or the said patent, the sum of £ , he the said C. D., his executors, administrators, or assigns, shall pay to the said A. B., his executors, administrators, or assigns, at the times and in the manner hereinafter mentioned, such a sum or sums of money as shall be equal to a percentage of £ per cent. upon the net profits (to be calculated as hereinafter mentioned), arising as aforesaid, from the time when the said C. D., his executors, administrators, or assigns, shall have received the aforesaid sum of £ , and thenceforth during the remainder of the period in which the said patent hereby assigned or any such patent for improvements as aforesaid as shall be assigned to or become vested in the said C. D., his executors, administrators, or assigns, shall continue in force. AND FURTHER, that the said C. D., his executors, administrators, or assigns, will so soon as he or they shall have received from the net profits arising as aforesaid the sum of £ thenceforth twice in every year on the day of , and the day of , or within 14 days thereafter respectively, furnish to the said A. B. an account showing the amount for the half year in respect of which the account is furnished, of the net profits arising as aforesaid; and shall within one calendar month after the date up to which such half-yearly account is furnished, pay to the said A. B., his executors, administrators, or assigns, the percentage by the said account appearing to be due.

Covenant not to apply for leave to amend applicable to assignments for a district (*r*).

AND THE SAID C. D. covenants with the said A. B. that he the said C. D., his executors, administrators and assigns, will not apply for leave to amend, or amend, or cause to be amended, the said specification or the drawings thereof, in any way whatsoever without the consent of the said A. B., his executors, administrators, or assigns, in writing, first had and obtained—such consent not to be unreasonably withheld (*q*).

(*q*) In some cases where the district assigned is large a converse covenant on the part of the assignor should be inserted.

(*r*) A great difficulty is introduced by section 36 of the Act of 1883, re-enacted as section 14 sub-section 1 of the Act of 1907. "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." It will be observed that under this section a patentee can create innumerable patentees, all with coequal rights, not only amongst themselves but with the original patentee, but still all possessing only one original patent and one specification. It was clearly not the intention of the legislature that the specification might be split up and amended in one country and not in another and so on; but on the other hand the whole validity and value of a patent may very often depend upon the question of amendment or non-amendment — if one assignee amends he might by doing so

Covenants having regard to sections 24 and 27.

AND THE SAID C. D. covenants with the said A. B. that he the said A. B., his executors, administrators and assigns, will not do any act or thing or omit to do any act or thing the doing or omission of which would render the said letters patent liable to be revoked under section 27 of the Patents and Designs Act, 1907, or whereby revocation or a compulsory licence might be ordered under section 24 of the said Act.

Covenants by assignor as to taking future patents in assignment for a district only.

AND THAT IN CASE he, the said A. B., shall obtain letters patent in respect of any improvements, additions to, or discovery useful to the manufacture the subject-matter of the said recited letters patent, he shall, at the expense of the said C. D., his executors, administrators, or assigns (if and when requiring him to do so), execute and do all such assurances and things as shall be necessary or convenient for vesting the same letters patent, and the exclusive benefit thereof, *for the said counties* in the said C. D., his executors, administrators, or assigns.

Covenant to pay fees on renewal when patent assigned for a district only.

AND ALSO THAT HE THE SAID A. B., his executors, administrators, or assigns, will pay all fees necessary for the renewal of the said letters patent (*s*) respectively during the respective terms comprised therein one calendar month at least before the times provided by the Patents, &c., Act, 1883, or the rules made in pursuance thereof in that behalf, but in case of non-payment thereof as aforesaid, will, if required by the said C. D., his executors, administrators, or assigns, permit him or them to pay the same, and any sum if so paid by him or them shall be repayable on demand, together with interest thereon at the rate of 5 per cent. per annum from the time of payment thereof and until repayment, and shall, together with the interest aforesaid, be a charge upon the interest of the said A. B. and his executors, administrators, or assigns, in the said letters patent respectively.

Covenant to communicate and assign future improvements.

AND THE SAID A. B. hereby covenants with the said C. D. that the said A. B. will without any further remuneration or royalties communicate to the said C. D. all improvements which the said A. B. may during the continuance of the said patent invent, discover, or make for or in connection with the said invention, and also all improvements, whether patented or not, of which the said

ruin all the others; on the other hand by refusing to consent to an amendment he might do the same thing. The author has drafted a precedent clause which might do for some instances, but it is chiefly introduced to call the attention of conveyancers to the difficulty of the position.

(*s*) There is no implied covenant to pay fees. (See p. 196, *ante.*)

A. B. shall become the owner or of which the said A. B. shall have the control, and will, so far as practicable, at the request and expense of the said C. D., render the same available for the exclusive use of the said C. D., and do every act, deed, and thing which may be necessary or expedient for obtaining and perfecting patents for all or any such improvements, and for assigning or vesting the same to or in the said C. D.

AND IT IS HEREBY FURTHER AGREED AND DECLARED between and by the said parties hereto as follows :—

Conditions to be inserted when a percentage is to be paid as well as a sum down.

1. For the purpose of calculating the moneys to be derived as aforesaid, there shall be deducted from the gross moneys received from or by means of the said inventions, or such patented improvements as aforesaid, or any sales, or licences, or other dispositions and dealings with the same, or otherwise, from, or by means of the using, exercising, vending, or working the invention, or patented improvements, or patent, which moneys are hereinafter called the gross receipts, all costs, charges, losses, damages, and expenses whatsoever, which the said C. D., his executors, administrators, or assigns, may have already paid or incurred, or may hereafter pay or incur, in or about the obtaining, or endeavouring to obtain, or the keeping in force any such patent for improvements as aforesaid, or the assigning the same to the said C. D., his executors, administrators, or assigns, or in or about the introducing to the public the said patents, inventions, and patented improvements, or any of them, or in or about any such sales, licences, or other dispositions, or dealings as aforesaid, or in or about any legal or other proceedings, which may be taken for the purpose of restraining infringement of the said patents, or any of them, or for recovering damages for infringements, or which may be taken in respect of any sale, or proposed sale of the said patents, or any interest therein, or any licence or proposed licence for working the said invention and patented improvements, or any of them, or any part thereof; or generally in any manner in or about the said patents, or any of them, or the using, exercising, vending, or working the said invention, or patented improvements, or any of them, or patents, all which costs, charges, losses, damages, and expenses are hereinafter referred to as patent expenses, together with interest at the rate of £ per cent. per annum, upon such patent expenses respectively from the time of the payment thereof, and the difference between the gross receipts for any half-year and the patent expenses for the same half-year, shall be the net profits arising as aforesaid, upon which the percentage aforesaid is to be paid.

Keeping accounts.

2. Proper books of account shall be kept by the said C. D., his executors, administrators, and assigns, in which true, plain and perfect entries shall be made of all the payments, expenses, and gross receipts aforesaid, and such books of account shall at all reasonable times be open to the inspection of the said A. B., his executors, administrators, or assigns, or any agent duly appointed by him or them in writing.

Assignee not to be bound to apply for patent for improvements.

3. Nothing herein contained shall be construed as obliging the said C. D., his executors, administrators, or assigns, to obtain, or endeavour to obtain, any patent for any such improvements as aforesaid, or to accept any assignment of any patent for such improvements, or to pay the stamp duty upon, or to defend, or maintain the said patent hereby assigned, or any such patent for improvements as aforesaid, which may be assigned to, or become vested in him or them, in performance of the covenants in that behalf hereinbefore contained, or to take any steps for restraining infringement of the same patents, or any of them, or recovering damages for any infringement, or to make any sale or sales of the said patents, or any interest therein, or to grant any licence or licences for the use of the said invention, or any such patented improvements as aforesaid, or any part thereof respectively, or in any manner to use, exercise, vend, or work the said invention, improvements or patents, or any of them; it being hereby expressly agreed and declared that the said C. D., his executors, administrators or assigns, is and are and shall be the absolute owners of the said patent hereby assigned and of any patent or patents for improvements, which may be assigned to or vested in him or them as aforesaid, or which he or they may under the covenants aforesaid require to be assigned to him or them; and that the said C. D., his executors, administrators, or assigns, shall not in regard to the said patents, or any of them, be subject to any control or interference whatsoever of the said A. B., his executors, administrators, or assigns.

Assignor not to assign interest without consent.

4. During the continuance of the said patent hereby assigned, and during the continuance of any patent or patents for improvements which may be assigned to or become vested in the said C. D., his executors, administrators, or assigns, as aforesaid, the said A. B., his executors, administrators, or assigns, shall not sell or dispose of the percentage payable to him or them as aforesaid without the consent in writing of the said C. D., his executors, administrators, or assigns; nor shall the said C. D., his executors, administrators, or assigns, sell or dispose of the said patents, or any of them, without the consent in writing of the said A. B., his executors, administrators, or assigns.

Assignee not to reassign without consent.

5. Nothing herein contained shall be considered as constituting a partnership between the said parties hereto. — No partnership.

6. Nothing herein contained shall be construed as a warranty by the said A. B., of the novelty or utility of the said invention, or of the validity of the said patent hereby assigned. — No warranty of validity.

PROVIDED ALWAYS, and it is hereby further agreed and declared, that no action at law or equity shall be brought by the said C. D. against any person or persons to restrain infringements or to recover damages in respect of the mere user of (*collar-studs made in pursuance of the said patented invention*) within the said county of , provided that such user be not for profit or for sale, or in the way of trade. — Proviso to be inserted in assignment for a district of certain inventions (*t*).

Non-exclusive Licence to use Patented Invention in consideration of an Annual Payment and the Purchase of the Patented Articles from the Inventor.

THIS INDENTURE made the day of , 19 , between A. B., of , hereinafter called the patentee of the one part, and C. D., of , hereinafter called the licensee of the other part. — Parties.

WHEREAS the patentee is in possession of and entitled to the full benefit of certain letters patent dated and numbered for an invention entitled : AND WHEREAS the patentee has agreed to grant to the licensee a licence to use the said invention at , in the course of his trade and business as a upon the terms and conditions hereinafter set forth. NOW THIS INDENTURE WITNESSETH that in pursuance of the said agreement and in consideration of the payments and covenants hereinafter reserved, contained, and on the part of the licensee to be paid and performed, he the patentee grants to the licensee full and free licence and authority during all the residue now to come and unexpired of the term of fourteen years by the said patent, to use the said invention in the course of his trade and business as a , upon the terms and conditions following, that is to say : — Recitals.

1. The licensee shall pay to the patentee upon the execution of this indenture the sum of £ , and further shall once in every year during the continuance of the said letters patent, including — Payments by licensee.

(*t*) It is evident that some such proviso as this is of the utmost importance, when the patent is for an article of common use. The words of section 36 are :—"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." It would create great confusion and injury to all parties if a man travelling from London to York were liable to actions by different assignees of the districts through which he travelled on account of wearing a particular collar-stud.

any extended term thereof, pay the sum of £ , the first of such payments to be made on or before the day of , 19 .

Covenant to purchase patented articles.

2. The licensee shall purchase of the patentee and the patentee shall sell and deliver to the licensee all the (*here insert name and description of patented articles*) which the licensee shall from time to time require, paying for the same after the rate of per (*dozen or gross*) with net cash within one month after delivery.

Covenant not to manufacture or sell.

3. The licensee shall not manufacture or vend any of the said , but shall only be entitled to use the same in the course of his trade or business, and the licensee shall not purchase or otherwise acquire any of the said other than of the patentee.

Power to licensee to determine licence.

4. The licensee shall be at liberty upon giving months' notice in writing to the patentee to determine the licence and all the terms and conditions thereof, provided always that upon any such determination the licensee shall deliver to the patentee free of charge all the which at that time shall be in his possession, or in the possession of any of his servants, agents, or customers.

Covenant by licensee to render assistance to patentee in actions.

5. In the event of the infringement of the said patent by any person or persons the licensee shall at the cost of the patentee render to him all the information and assistance in his power to enable the patentee to restrain further infringements of the said patent, and to recover damages for any past infringements thereof:

Proviso patentee not to be bound to take action.

Provided always that nothing herein contained shall be construed as placing the patentee under any obligation to take proceedings for the purpose of restraining or recovering damages for infringements, or as in any manner exonerating the licensee from payment of the amounts and observance of the covenants herein reserved and contained by reason that the profits of the licensee from the use of the said invention may be diminished on account of such infringements being permitted.

Determination of licence on default by licensee.

6. Should the licensee make default in the payment of the annual sum hereinbefore provided for, within twenty-one days after the same shall have become due, or commit any breach of the covenants herein contained as on his part to be observed, it shall be lawful for the patentee by writing under his hand to give to the licensee, or leave at his usual or last known place of business in England, notice of the patentee to determine this present licence, and thereupon this licence shall be deemed to be determined, and the licensee shall deliver to the patentee as soon as practicable, free of charge, all the which at that timo shall be in his possession or in the possession of any of his servants, agents or customers.

Determination on patent

7. If during the continuance of the licence hereby granted the said patent shall be pronounced to be invalid by a decision of the House

of Lords, these presents shall be void as to the future operations thereof, but without prejudice to any rights or liabilities which shall be then subsisting on either side with respect to any prior breach of any of the covenants and agreements herein contained. being declared invalid.

8. If while this licence is in force the patentee shall at any time grant any licence or premium to any other person or persons for the use of the said invention in the United Kingdom, and shall reserve any annual payment or charge any price for the said lower than the annual payments and price reserved under and by virtue of this indenture, then at the annual payments and price thenceforward payable to the patentee shall be reduced to an amount equal to the lowest price reserved and payable for the use of the said invention by such other person. Reduction of payments to level of other licences.

9. The patentee shall be at liberty from time to time, and at all times hereafter, without the consent or concurrence of the licensee, to apply for and procure the amendment of the specification or specifications of the said invention, whether by way of disclaimer, amendment or explanation. Power of patentee to amend specification.

10. The word patentee herein shall include the patentee, his executors, administrators, or assigns, *and he shall be deemed to covenant as beneficial owner* (*u*), *with like effect as if this indenture were a conveyance within the meaning of the Conveyancing and Law of Property Act*, 1881. The word licensee shall include the licensee, his executors, administrators, and assigns. Transmission clause and cost as "beneficial owner."

11. Nothing in this indenture contained shall preclude or estop the licensee from disputing the validity of the said patent after the determination of the licence by notice or otherwise. Licensee not to be estopped after determination of licence.

12. If any dispute, question or difference shall arise between the parties to these presents, touching these presents or any clause or thing herein contained, or the construction hereof, or any matter in any way connected with these presents, or the operation hereof, or the rights, duties, or liabilities of either of the said parties, hereto in connection with the premises then and in every or any such case the matters in difference shall be referred to two arbitrators or the umpire, pursuant to and so as with regard to the mode and consequences of the reference, and in other respects to conform to the provisions in that behalf contained in the Common Law Procedure Act, 1854, or any other subsisting statutory modification thereof, and upon every or any such reference the arbitrators and umpire shall respectively have power to examine the parties and witnesses upon oath or affirmation, and either to fix, settle, Arbitration clause.

(*u*) See note, p. 666, *ante*.

and determine the amount of costs of the reference and award respectively or incidental thereto to be paid by both parties or either party, or to direct the same to be taxed either as between solicitor and client, or otherwise to direct and award when, by and to whom such costs shall be paid.

As witness, &c.

Exclusive Licence for a District.

THIS INDENTURE MADE THE day of 19 , between A. B., of , hereinafter called the grantor of the one part, and C. D., of , hereinafter called the grantee of the other part.

Recitals. WHEREAS the grantor is the registered legal owner of certain letters patent dated and numbered granted for an invention entitled . AND WHEREAS the grantor has agreed to grant to the grantee the sole and exclusive licence to make, use, exercise, or vend the said invention within the counties of , upon the terms and conditions hereinafter appearing. NOW THIS INDENTURE WITNESSETH and it is agreed as follows:—

Grant. 1. The grantor *as beneficial owner* (*x*) and with like effect as if these presents were a conveyance, doth hereby grant unto the grantee, his executors, administrators and assigns, the sole and exclusive licence to make, use, exercise, or vend the said invention within the counties of and during the continuance of the said letters patent or any extended time thereof, together with all improvements and additions useful to the manufacture the subject-matter of the said letters patent now already in the knowledge or possession of or which may hereafter be made by the grantor.

Consideration and royalty reserved. 2. The grantee shall, upon the execution of these presents, pay to the grantor the sum of £ , and shall further pay to the grantor during the continuance of the licence, once in every year, on the day of , or within twenty-one days thereafter, the sum of £ by way of annual royalty. PROVIDED ALWAYS that in the event of the said letters patent being judged invalid by any court of competent jurisdiction and within months of the said judgment, the grantor, his executors, administrators, or assigns, shall not have done all things necessary for the purpose of appealing from the said judgment, or in the event of the said letters patent having been adjudged invalid by the House of Lords, then that these presents shall be deemed to be cancelled, and all payments

(*x*) See note, p. 589.

accruing thereafter from the grantee to the grantor shall cease, but without prejudice to the recovery by the grantor of any monies then already due.

Grantor not to amend.

3. The grantor shall not, without the consent of the grantee, his executors, administrators or assigns, in writing first had and obtained, apply for leave to amend the specification to the said letters patent in any way whatsoever (*y*).

Grantee to be at liberty to determine.

4. The grantee shall be at liberty upon giving months' notice in writing to the grantor to determine this licence and all the terms and conditions thereof, and thereupon the said letters patent for the district hereinbefore defined, and all the rights and privileges thereby granted, shall revert to the grantor absolutely, and the annual payments hereinbefore provided for shall cease.

As to actions.

5. The grantee shall be at liberty either in his own name or in the name of the grantor, or both, as he may be advised, to bring any action or proceeding for the purpose of restraining the infringement of the said letters patent within the district hereinbefore defined. PROVIDED ALWAYS that before in any way making use of the name of the grantor in any such action or proceeding the grantee shall give security to the satisfaction of the grantor to indemnify him in respect of any costs or damages which he may become liable for by reason of any such action or proceeding.

Payment of fees, &c.

6. The grantor shall pay all fees necessary for the renewal and maintenance of the said letters patent during the term comprised therein one calendar month at least before the times provided by the Patents, &c., Act, 1883, or the rules made in pursuance in that behalf thereof, and in case of non-payment thereof as aforesaid, the grantee shall be at liberty to pay the same and to deduct any moneys so paid by him from the annual payments hereinbefore provided for, or to recover the same from the grantor at the grantee's option.

7. Should the grantor during the continuance of this licence obtain letters patent in respect of any improvements, additions to, or discovery useful to the manufacture of the subject-matter of the said letters patent, he shall at the expense of the grantee grant to him an exclusive licence to make, exercise, use, or vend the invention, the subject-matter of the said further letters patent within the said district, without any extra or additional payment on the part of the grantee. PROVIDED ALWAYS that the grantor shall not be

(*y*) See last preceding precedent for the converse—in a general licence the patentee should reserve power to amend, but in an exclusive licence it is obviously otherwise.

bound to maintain or keep in force the said further letters patent by payment of the prescribed fees or otherwise.

Default in payment of royalty.

8. Should the grantee make default in the payment of the annual royalty reserved by the second clause hereof as therein provided, it shall be lawful for the grantor to serve upon the grantee by leaving the same at his last known place of business or abode notice in writing determining these presents, and thereupon the licence hereby granted shall cease, but without prejudice to the right of the grantor to sue for and recover any arrears of the said annual royalty which may then be due.

No warranty of validity.

9. The licensor, notwithstanding anything herein to the contrary, shall not be deemed in any way to warrant or represent the validity of the said letters patent.

In witness, &c.

Mortgage of a Patent.

Parties. THIS INDENTURE MADE the day of 19 , Between A. B. of , hereinafter called the mortgagor of the one part, and C. D. of , hereinafter called the mortgagee of the other part.

Recitals. WHEREAS the mortgagor is the registered owner of certain letters patent dated 19 and numbered for an invention entitled "Improvements, &c. ." AND WHEREAS the mortgagee has agreed to lend to the mortgagor the sum of £ to be secured together with interest thereon by mortgage of the said letters patent as hereinafter expressed.

Testatum. NOW THIS INDENTURE WITNESSETH that in consideration of the sum of £ this day paid by the mortgagee to the mortgagor (the receipt whereof is hereby acknowledged) the mortgagor doth covenant with the mortgagee that he the mortgagor will pay to the mortgagee on the day of 19 , the sum of £ together with interest thereon at the rate of £ per cent. per annum.

Assignment. AND THIS INDENTURE ALSO WITNESSETH that for the consideration aforesaid the mortgagor *as beneficial owner* doth hereby assign to the mortgagee the said letters patent and the sole and exclusive benefit thereof and all extensions thereof and all the rights, privileges, profits, benefits, commodities and advantages by the said letters patent granted to have and to hold the same to the mortgagee subject to the proviso for redemption hereinafter contained.

Proviso for redemption. PROVIDED ALWAYS that if the mortgagor shall pay to the mortgagee the sum of £ with interest for the same at the rate aforesaid then that the mortgagee will at any time thereafter at the request and cost of the mortgagor re-assign to him the said letters patent and the sole and exclusive benefit thereof. And

the mortgagor doth hereby covenant with the mortgagee that if the said sum of £ or any part thereof shall remain unpaid after the said day of 19 , he the mortgagor will pay to the mortgagee so long as the said sum of £ or any part thereof shall remain unpaid interest upon such sum as shall from time to time remain unpaid after the rate of £ per cent. per annum by equal half-yearly payments on the day of and the day of in every year. PROVIDED ALSO that if the mortgagor shall on every day of and day of until the day of 19 , or within days after the said days respectively pay to the mortgagee all interest then due and shall perform and observe all the covenants on his part to be performed or observed then the mortgagee will not before the day of 19 call in the principal sum aforesaid or any part thereof. PROVIDED ALSO that the mortgagor shall not before the day of 19 compel the mortgagee to receive the said principal sum or any part thereof. And that the mortgagor during the continuance of the security will take all steps necessary for the protection of the said letters patent and maintaining the same in full force and effect and for the prevention of any infringement thereof and will pay all fees necessary for the continuance of the said letters patent one calendar month at least before the same shall become due and payable and will whenever required to do so produce to the mortgagee or his agent the receipts for the said fees and in default of the mortgagor taking any such steps as aforesaid or protecting the said letters patent from infringement or making payment of the said fees it shall be lawful for the mortgagee to do or pay the same either in his own name or in the name of the mortgagor as he the mortgagee shall elect and to sue for and recover from the mortgagor any costs, charges or expenses which he may incur in so doing or at his option to allow the same to remain on the security hereof as monies advanced as aforesaid. PROVIDED ALWAYS that until the mortgagee shall become entitled to exercise the power of sale to be implied herein the mortgagor shall be at liberty to use and work the said invention without interruption from the mortgagee and also may (but so that he shall in each case give to the mortgagee days at least notice in writing of his intention so to do and of the particulars thereof) with the consent of the mortgagee in writing but not otherwise grant licences to use and work the said invention as from the dates thereof respectively for the whole or any part of the term comprised in the said letters patent. AND FURTHER the mortgagor shall within fourteen days after the execution of every

Mortgagor to be at liberty to use and work invention, and grant licences.

Mortgagor to supply copy to mortgagee.

such licence furnish the mortgagee with a copy of the same. PROVIDED ALSO that *from and after* the time when the mortgagee shall first become entitled to exercise the statutory power of sale to be implied herein but subject to any licences which may have been granted as hereinbefore authorised it shall be lawful for him alone to work the said invention and to grant licences in respect thereof or to assign the said letters patent and invention for districts or otherwise to deal with the same in any manner that he shall think fit. And the mortgagor DOTH HEREBY FURTHER COVENANT with the mortgagee that he will communicate to the mortgagee during the continuance of this security all improvements which he may discover or make in connection with the said invention and also all improvements which during the said time he shall have control of or acquire by purchase or otherwise and whether patented or not and such improvements and letters patent if any shall be deemed to be comprised within this security and the mortgagor will execute all documents and do all things necessary to extend the operation of this security to all such improvements or letters patent. AND THAT during the continuance of this security the mortgagor will not without the consent of the mortgagee first had and obtained amend or apply for leave to amend the specifications to the said letters patent or either of them in any way whatsoever. AND LASTLY that it shall be lawful for the mortgagee if the monies secured hereby shall not have been repaid within one year from the expiration of the term of fourteen years for which the said letters patent were originally granted to apply for an extension of such term in his own name or in the name of the mortgagor or of both of them as he shall think fit and the mortgagee shall do all acts and things and execute all documents and prepare all accounts necessary for such application. And it is hereby declared that except where the context requires a different interpretation, each of the expressions "the mortgagor" and "the mortgagee" shall whenever used herein be also applicable as far as possible to the executors, administrators and assigns of the person designated thereby.

Proviso for foreclosure.

Communication of improvements.

As to amendments.

As to application for extension.

Transmission clause.

In witness, &c.

The British Patents to be acquired by the Company have been reported upon by Mr. E. R. Royston Follow of the Chartered Institute of Patent Agents, and his Report has been submitted, with the Patents o Mr. Thomas Terrell, K.C., who has given the following opinion :—

AUTOMATIC TELEPHONE PATENTS—STROWGER SYSTEM.

I have carefully considered the specifications sent to me for my opinion. They comprise a complete system of Automatic Telephony A) with three wires, (B) with two wires, and I have selected the following for special examination as being the most important. 18,747 ? 1902, 26,801 of 1906, 30,458 of 1909, 1298, 1299, 1418, 1419, 1421, 1422 and 1428 of 1910, 7876, 7877, and 7878, whose dates of pplication are 1910, but which bear date 1911. I have also read the report of Mr. E. R. Royston on the state of the art, and I have ad the benefit of the expert explanations of Mr. Mellinger when I have desired it. The inventions disclosed in the said specifications ppear from Mr. Royston's report to be novel. In my opinion there is good subject matter for Letters Patent and the several Letters atent are valid.

NEW COURT, TEMPLE, 13*th November*, 1911.

THOS. TERRELL.

REPORT OF THE TRIAL OF THE APPLICATION TO REVOKE HATSCHEK'S PATENTS

(Reported 1909, 26 R. P. C. 228, and 100 L. T. 809).

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

Before Mr. Justice Parker.

March 3rd, 4th, and 26th, 1909.

In the Matter of an Application for the Revocation of Hatschek's Patents No. 6455 of 1900 and No. 22,139 of 1900.

Patent.—Application for Revocation.—Patented process carried on exclusively outside the United Kingdom.—Satisfactory reasons not given.—Patents revoked.—Appeal to Court dismissed.—Patents and Designs Act, 1907, *section* 27.—*Patents Rules*, 1908.

An application was made under section 27 of the Patents and Designs Act, 1907, by Z., a general merchant carrying on business in London, to revoke two patents granted in 1900 to H., an Austrian, on the ground of non-working in the United Kingdom. The application was opposed by H. and his exclusive licensees under a licence granted in 1906. It was not contested that the patents had not been worked in the United Kingdom, but it was contended that satisfactory reasons had been given for the non-working. It was held by the Comptroller-General, that the patents should be revoked forthwith, and costs were awarded to the applicant.

The patentee and licensees appealed. The principal reasons alleged by the appellants as "satisfactory" were the existence of the exclusive licence granted before the Act, the expenditure before the Act of a large sum on a factory in Belgium, that no one was anxious to manufacture here, and that, apart from the patent, the industry could not be established here.

Held, by Parker J. (*z*), that sub-section (1) of section 27 does not include every case in which the patented article or process is manufactured or carried on to a greater extent outside than inside the United Kingdom; if the article or process be manufactured or carried on within the United Kingdom, not only to a substantial extent, but to an extent as substantial as may reasonably be expected having regard to what is done abroad, the state of circumstances contemplated by sub-section (1) does not exist; that the words "patented article" are not confined to articles either made in or imported into this country, nor is the comparison instituted by sub-section (1) between what is done in this country and abroad respectively by the patentee, his licensees and agents, but the comparison is between the extent to which the article or process, the subject of the patent, is manufactured or carried on in this country, and the extent to which it is manufactured or carried on abroad, whether the articles so manufactured or resulting from the process are or are not imported into this country. *Held*, further, that if the state of circumstances contemplated by sub-section (1) has arisen, the

(*z*) Before judgment was given the appeal in *Bremer's* case had been argued. That appeal was adjourned for further evidence, and is reported 26 R. P. C. 449; the decision of the Comptroller-General is reported earlier in the same vol.

patentee is on his defence, and must either prove that the article or process is manufactured or carried on in the United Kingdom to an adequate extent, or give satisfactory reasons why it is not; that it is left to the Comptroller, subject to an appeal to the Court, to determine in each case and having regard to all the circumstances whether "adequacy" is established or "satisfactory" reasons are shown. The policy of section 27 is directed to secure fair play between foreign industries and the industries of this country, and not to secure to the latter, during the period of the patent, a protection which they would not enjoy if no patent had been granted. *Held*, further, that, except for the year of grace given by the section, it puts all patentees in the same position, whether the patent be granted before or after the Act, but that to a limited extent there may be reasons which would be satisfactory in one case and not in the other. *Held*, also, that under all the circumstances of the case, the revocation of the patent and the refusal to suspend it were justified.

The appeal was dismissed with costs, including the costs of the Attorney-General.

The meanings of the expressions "adequate" and "satisfactory" considered. Observations on the Patent Rules governing the Procedure under section 27.

On the 6th of April, 1900, letters patent (No. 6455 of 1900) were granted to Ludwig Hatschek, of Voeklabruck, Upper Austria, for "a process of manufacture of imitation stone plates, slabs or tiles." On the 5th of December, 1900, letters patent (No. 22,139 of 1900) were granted to the said L. Hatschek for a similar invention.

Both patents were for a process of manufacturing imitation stone plates, slabs, or tiles. The invention claimed in the earlier specification was "a process of manufacture of thin imitation stone plates, slabs, or tiles, the main feature of such process being that a fibrous material, preferably asbestos, is mixed with an adhesive substance such as cement, hydraulic lime or the like in the ordinary mixing apparatus of paper or cardboard works, and that such mixture is then further operated upon by the machines used in the cardboard manufacture, the shape or surface outline of the plates being subsequently varied by means of presses if desired, substantially as set forth."

The later specification described and claimed substantially the same invention but in greater detail. The drawing showed an ordinary form of cylinder paper machine. The claims in this specification were "1. A process for the manufacture of plates and slabs of artificial stone, in which a greatly diluted mixture of hydraulic binding substances and finely divided fibrous materials are fed from an endless cloth or band, in the manner of pasteboard-making machines, to one or more rollers in order to be pressed; such mixture being

delayed in setting if desired, substantially as described. 2. A mode of carrying out the process claimed in Claim 1, in which the mixture is fed to the pressing rollers in very thin layers, in order that the fibres will be placed mostly in the direction of the plane of the slab or plate and to avoid as much as possible placing them vertically thereto, substantially as described. 3. A further mode of carrying out the process claimed in Claim 1, in which the mixture is wound by an endless cloth or band, on to a drum, a number of times, until the desired thickness of material has been obtained, substantially as described. 4. A further mode of carrying out the process claimed in Claim 1, in which the fibrous materials are subjected to a suitable chemical or preliminary treatment, substantially as described. 5. In the process claimed in Claims 1—4, the preliminary treatment of fibrous vegetable materials with silicates, substantially as described. 6. In the process claimed in Claims 1—4, the preliminary treatment of fibrous mineral materials by roughening the surface thereof, substantially as described. 7. A process for the manufacture of plates and slabs of artificial stone from hydraulic binding substances and fibrous materials, substantially as described."

Applications were made under section 27 of the Patents and Designs Act, 1907, for the revocation of these patents by Charles William Zerenner, of Norfolk House, Laurence Pountney Hill, in the City of London, general merchant, on the ground in each case that the process was carried on exclusively outside the United Kingdom. These applications were opposed by the patentee and the Société Anonyme Eternit, a Belgian company, who were sole licensees of the patents.

At a preliminary hearing on the 6th of October, 1908, application was made on behalf of the respondents for an extension of time in which to file the evidence required by Patent Rule 79, and an extension of fourteen days was granted.

Declarations were filed by Joseph de Meulemeester, director of the Belgian Company, and George Croydon Marks, a member of the firm of Marks and Clerk, patent agents, and also a declaration by the applicant. The application came on for hearing before the Comptroller on the 26th of November, 1908, when G. Croydon Marks, J. de Meulemeester and C. W. Zerenner gave evidence viva voce, and were cross-examined.

On behalf of the patentee and the licensees it was admitted that the manufacture had not been carried on in the United Kingdom, but it was submitted that satisfactory reasons had been given why it was not so carried on. These reasons are stated below in the arguments on behalf of the appellants.

The Comptroller reserved his decision, which was given on the 9th of December, 1908, revoking the patents and awarding costs to the applicant (ante, pp. 3 et seq.). The evidence was stated in the decision of the Comptroller, as follows :—

"The Société Anonyme Eternit became licensees of both patents under a licence dated the 26th of January, 1906, granted by Mr. Hatschek. The principal evidence on their behalf has been given by Mr. Joseph de Meulemeester, who has made a declaration in the case, and has also attended the hearing and been examined orally. In his declaration he is termed 'a director,' and it was explained by his counsel that this term abroad has the same meaning as 'general manager' in this country. In paragraph 3 of his declaration he says :—'Soon after the granting of the above-mentioned licence the company commenced the erection of a factory in Belgium for the manufacture of goods according to the process.' This statement does not appear to be quite correct. The factory was commenced some time before the grant of the licence, and it appears from the balance sheet of the company that a considerable portion of its cost had been defrayed in the year ending the 31st of July, 1905, whereas the licence was not granted until the 26th of January, 1906. From his evidence given at the hearing it seems that the works were entirely ready for manufacture in the month of April, 1906 ; that the company commenced to manufacture in that month ; but that the first negotiations between Hatschek and the company began before August, 1905. In reply to the question whether the factory was erected in Belgium with a view of supplying the English market, he said that at the outset there was no question of that, but that whilst the works were under construction the English licence was negotiated for, and was then taken into account in the construction. He was unable, however, to say how much more capital was expended on the factory in consequence of the intention to supply the English market than would have been expended if it had not been proposed to supply that market. The witness also admitted that it would be difficult to ascertain to what extent the expenditure on the factory was increased by this consideration; nor could he state whether it would have been necessary to enlarge the works for the purpose of the English sale.

" He further affirms in his declaration that, in consequence of the erection of this factory, the company have always been and are now in a position to meet fully and satisfactorily all demands in the United Kingdom for articles made according to the patented process ; that the factory has been sufficient to enable the company to deal with the whole of its trade both in the United Kingdom and in

other countries; and that if the patents were revoked and factories were established in England for carrying on the process, it would not be possible to produce the articles made according to the process as cheaply in such factories in Great Britain as is done now in Germany, France and Belgium, owing to the cost both of labour and materials; aud that the goods made in such factories in England could not be supplied to the trade and public at such low figures as are now offered by the company, or as could be offered by the French and German manufacturing companies if they were free to import such goods into the United Kingdom. At the hearing, however, he admitted that the asbestos used by the company was obtained partly from Canada and partly from Russia, and that there would probably be no great difference in the cost of the material in England and Belgium for the qualities of the asbestos that the company used in manufacture; and that he did not know the exact cost of cement in this country, but he was under the impression that there was a difference of about 10 francs a ton. As regards labour, he explained that a very large proportion, about 90 per cent., of the people employed by the company were mere unskilled labourers. No details were given as to their wages, but the general allegation was made that labour was cheaper in Belgium than in Great Britain. The proportion of slabs manufactured at his factory in Belgium which come to the English market may be taken to be about one-sixth of the total amount of the sale everywhere, and about one-half of what is not imported into England is consumed in Belgium. He further alleged that it is necessary to manufacture a certain quantity of the goods to a certain scale in order that the cost of manufacture should not be too high, but that he could only give an approximate estimate of the quantity and scale necessary. In his opinion it would be necessary to manufacture 500,000 square metres annually in order to work on acceptable conditions. In reply to the question what he meant by 'acceptable conditions,' he said, 'in order to have a gross profit of about 25 per cent.,' but that it was rather difficult to explain what net profit would be required.

"The only other witness on behalf of the patentees was Mr. Croydon Marks, who stated in his declaration, that on or about the 13th of July last, his firm received instructions from patent agents in Belgium on behalf of the company to insert advertisements in various British journals, intimating that the owners of the patents were desirous of disposing of the same, or of entering into a working arrangement with firms in Great Britain likely to be interested in the process covered by the patents. His firm was also instructed to communicate with various British firms for the purpose of granting

licences under the patents, or of selling them, the object of these advertisements and offers being to secure, if possible, some proper and sufficient arrangement for the manufacture of the process covered by the patents within the United Kingdom, having regard to the terms of section 27. Copies of the advertisements and replies to the offers are annexed as exhibits to his declaration.

"In his examination he said that he knew of no better firms than those to which he wrote, and that he knew of no journals which would circulate amongst those likely to be interested better than those he had advertised in. In reply to a question by the counsel for the applicant as to whether the firms and people whom he addressed personally were not brickmakers, he stated that one, Messrs. Doulton & Co., were not brickmakers, but tile makers and makers of terra cotta and imitation stone, and that the articles which he had seen manufactured under the patent were imitation tiles of which Doultons were one of the leading makers in the country. In reply to the question whether he thought that the offers were bonâ fide offers, and that the company wished to sell the patents, he answered that they certainly wished to sell them so far as his firm were concerned, and that his firm had no instructions that this was to be an attempt to evade the Act. They were instructed to obtain a licensee if they could."

"In this connection it is to be observed that Mr. Hatschek could not have granted a licence without contravening the terms of his present licence to the company, inasmuch as he is precluded by it from granting anyone else a licence in regard to this manufacture for Great Britain and Ireland, and that the effect of a sale to any British manufacturer by him and the company of their patent rights outright would have been to close the British market to the Belgian company, a more serious result than the revocation of their patents seems likely to entail on them. Mr. Marks' firm were acting on behalf of the company, and apparently without any instructions from Mr. Hatschek. No offer was received by them in response to these advertisements and communications."

On behalf of the application to revoke, Mr. Zeremner in his declaration states that the company were founded in the year 1905 for the purpose, as is disclosed in their constitution, of acting as sole licensees under the patents in Belgium, and to exercise certain rights of the patentees in Holland and the Congo Free State; and that they were not formed for the purpose of importing goods into the United Kingdom, or with any intention that goods manufactured by them should be introduced into this country. On examination, I find from article 7 of the constitution that the object of the company was,

firstly, to obtain exclusive licences for producing the slabs for Belgium; secondly, the exclusive right of applying Mr. Hatschek's trade marks for Holland and the Congo Free State; and, thirdly, the right of exportation of the products, to what countries is not stated. Mr. Zerenner contends in his declaration that no part of the cost of the factory was incurred for the purpose of anticipating the supply of goods manufactured for the United Kingdom, but that the supply to the United Kingdom depended upon there being a surplus of goods not required in Holland, Belgium, and elsewhere. He also denies that the company have since the grant of the licence been, and are now, in a position to meet fully and satisfactorily all the demands in the United Kingdom for articles made under the patents; but submits that a consideration of this question is in fact irrelevant to the consideration whether or not there should be a revocation of the patents. He lays stress on the fact that no steps were taken by the patentees before July last with a view of getting the patents worked in the United Kingdom, and urges that the steps taken were not calculated to effect the purpose required by the Act, and that the patentees do not adequately supply the trade in England, but on the contrary, by alleging infringements and threatening harassing litigation, endeavour to keep up artificial prices for such goods as they sell in the United Kingdom, and prevent the real demand for articles of this nature being properly supplied to the British public freely at reasonable prices. He believes that if the patented articles were manufactured in the United Kingdom with the facilities which this country affords for material and labour, the trade and demand could be supplied in a proper manner; but no steps can be taken to attain this object, while the patents remain in full force and effect, by any persons other than the licensees, who have heretofore neglected to take any such steps."

"In his examination at the hearing, he maintained that it was practicable to manufacture goods under the patents commercially in this country; that he could find people who would be willing to engage in the manufacture, and had already been in negotiation with some, whose names he would not communicate at the present juncture, unless required to do so; that he thought that the goods could be manufactured and sold cheaper than they are at present being sold by the company, and he based his assertion on twenty-five years' experience; that Portland cement was really an English invention and was manufactured on a large scale here, and as far as the other ingredients were concerned, namely, asbestos, he did not think that any Continental nation, either France, Germany, or Belgium, had any advantage over Great Britain. In connection with

this statement I may say that I find from page 344 of Vol. I. of the Annual Statement of the Trade of the United Kingdom with Foreign Countries and British Possessions for the year 1907, that in that year the amount of cement exported from this country for building and engineering purposes was 764,264 tons, and that its value was estimated at 1,267,532*l.*, whilst it also appears from page 142 of the same volume that the amount imported into the country that year was 114,372 tons; of which 103,149 tons came from Belgium; the estimated value of the amount imported from Belgium being 129,139*l.* It also appears from the figures given that the export trade in cement from this country greatly increased and the import trade in cement considerably diminished between 1903 and 1907."

The respondents appealed.

Astbury, K.C. and *Shaw* (instructed by Burn and Berridge) appeared for the appellants; *Montgomery* (instructed by Faithful and Owen) appeared for the applicant; Sir *W. S. Robson*, K.C., A.-G., and *Sargant* (instructed by the solicitor for the Board of Trade) appeared for the Crown.

Astbury, K.C. and *Shaw* for the appellants.—This appeal involves a matter of great importance to patentees, manufacturers and British traders. We submit that the Comptroller has misconstrued section 27 of the Patents and Designs Act, 1907, and misconceived the intention of the Act. On the basis that there is manufacture abroad to a greater extent than in this country, the Comptroller has, irrespective of circumstances, revoked the patent forthwith. This is inconsistent with sections 24 and 27. The patentee had patents abroad as well as here. He granted licences abroad, and among others to a firm at Poissy. Zerenner was acting as the agent of the French licensees here for some time. In 1905 the patentee entered into negotiations with the Société Anonyme Eternit (Belgian Licensees) to license them for England in addition to Belgium. It was at this time that they gave orders for the erection of a factory in Belgium. An exclusive licence was executed in the year 1906. They spent about 36,000*l.* in erecting a factory in 1906 in Belgium to supply not only Belgium but this country. As the licence was exclusive, the patentee could not manufacture. The Comptroller has assumed that the Act puts on a patentee an obligation to manufacture here within twelve months after the Act. There is no obligation under the Act on a patentee to manufacture at all. The patentee here could not manufacture on account of the licence. After the passing of the Act a notice was sent out by the Patent Office to all foreign patentees as to the year of grace. In July, 1908, the licensees instructed Messrs. Marks and Clerk to advertise the patents for sale or for firms willing

to take up the manufacture. No answer was obtained to the advertisements, showing that no British manufacturer wished to take the matter up. There is no evidence that the British market is not properly supplied. It takes only one-sixth of the production of the Belgian factory. The interest of manufacturers and the interest of consumers are kept apart in the Act. Section 27 was passed in the interests of British manufacturers and indirectly in the interests of employees. We submit that section 24 is in the interest of consumers and section 27 in the interest of manufacturers. Section 24 is a narrower section; "any person interested,"—*i.e.*, a consumer—may apply under it. Sub-section 5 defines what the reasonable requirements of the public are. The section deals with the case of a person who wants an article and cannot get it on reasonable terms. The reward of the inventor is not to be at the expense of persons who ought to be allowed to use the invention. Under section 27 "any person" may apply, but he must make out a primâ facie case of exclusive or substantive manufacture abroad. Assuming that he has established that the article is made exclusively abroad, then the patentee may prove "adequate extent" or "satisfactory reasons." It may be better not to work here, or it may be impossible to do so, as for instance in the case of a patent forcyanide reduction of gold. It is a satisfactory reason that before the Act the patentee has granted an exclusive licence. [PARKER, J. referred to the definition of "patentee" in section 93.] "Patentee" must include the patentee. [PARKER, J.—If it also includes an exclusive licence, can it be a satisfactory reason that one of them is excluded by contract from manufacturing here?] A retrospective Act does not disturb vested rights without express provisions, *Hough* v. *Windus*, L. R. 12 Q. B. D., 224, at pp. 234 and 237; *In re Athlumney, ex parte Wilson*, L. R. (1898), 2 Q. B. 547, at p. 551. [PARKER J.—This Act does interfere with certain vested interests.] The Act does not interfere with existing licences. The want of any answer to the advertisements shows that no manufacturer would take up the manufacture here; that is a "satisfactory reason." If the patent is revoked, there is an end of the chance of manufacture here, because the foreign supply is sufficient for the demand here. The policy of the Act is to encourage foreigners to patent their inventions here. "Adequate extent" means adequate for the purpose or object of the section. *Heydon's* case (*a*) shows that you have to inquire, first, what was law before the Act, what was the mischief, what is the remedy provided and the reason of the remedy? In the "Solio" case (*b*) (L. R. (1898), A. C. 571) the report of the Commission of 1887, appointed

(*a*) 3 Rep. 18.

(*b*) *Eastman's Photographic Materials Co.'s Application*, 15 R. P. C. 476.

to consider proposed alterations of the trade marks law, was referred to. There is no document of the kind here. It is common knowledge that the object was to encourage manufacture here. The Comptroller has in his decisions referred to decisions of the German Courts. But the German law is different. It puts upon a patentee a direct obligation to manufacture within three years. There is no obligation under the Act to work at all; if there is no manufacture at all anywhere, section 24 does not apply. [PARKER, J. referred to the words in section 6 of the Statute of Monopolies, "so as also they be not contrary to the law nor mischievous to the State." There are two ways they may be mischievous—there is the consumer's point of view and the manufacturer's point of view. You argue that section 27 was to prevent patents being used to the prejudice of trade?] Yes. Inventors must be encouraged. Per contrà you do not want to pay too high a price. The State does not wish to give the inventor too high a price, but wishes to give him enough to recompense him fairly for his invention. Section 24 is a redraft of a section in the Act of 1902. Then in 1907 the Legislature wanted to protect the manufacture also, and section 27 was inserted. If a patentee is unable, owing to climate, raw material, or matters affecting the industrial population, to produce an article here at the same price as abroad, this is a satisfactory reason under section 27. As a rule we make things cheaper here, but there are certain things we cannot make cheaper here. [PARKER, J.—I have here only to decide if there are satisfactory reasons. Would you tell me shortly what they are?] They are—(1) the exclusive licence granted for value before the Act; (2) having regard to the evidence, the only possible mode of fostering an industry is to maintain the patent; revocation would destroy its chance; (3) the licensees in 1906 spent 36,000*l.* in erecting factories in Belgium to supply the markets, including the British market they cannot be expected to build another factory at once; (4) the Belgian factory satisfies section 24, and that has operated to prevent persons here wishing to manufacture in competition; the licence allows manufacture here by the licensees or under licence from them (5) the evidence proved that no one is either anxious or willing to manufacture here; (6) the retrospective effect of the Act requires strictness of construction. Licences granted before the Act are not affected by section 27. We submit that the decision of the Comptroller ought to be reversed or a considerable time given to allow the patentees and licensees in conjunction to take steps to start an industry here. [The decision of the Comptroller was read and later decisions in *Johnson's Patent*, Vol. XXVI., p. 52; *Bremer's Patent* p. 114; and *Hogner's Patent*, p. 149; were referred to.] All the cases

were decided substantially on the same ground, namely, that there is a direct obligation on the patentee to manufacture, and to at least 51 per cent. [PARKER, J.—Suppose that the patentee gives whole-world licences to persons in several countries, including England, but the manufacturer here is undersold, so that the trade is nipped, is that a satisfactory reason? I am putting a case where the trade is as far as possible free.] Supposing that the licences were all granted before the Act, the beneficial result which the section was intended to bring about is impossible, so that the reasons are satisfactory. [PARKER, J.—Supposing that the matters are subsequent to the Act?] Then the patentee has done something after the Act. [PARKER, J.—Is the patentee bound to use his patent protectively, or is the object only to remove improper fetters on trade? Suppose a patentee gives free licences to anyone?] The section is aimed at the improper use of patents to stifle an industry—thus transferring it abroad. It is not intended that the section should be protective in the sense that he should only use the patent for British manufacture. [PARKER, J.—If a patentee grants general licences in various countries he has parted pro tanto with the monopoly and the result may be that the article cannot be produced in this country. Is he at liberty to do that?] A patentee who grants licences in this country after the Act can protect himself by stipulating that the main manufacture should take place in this country. He might have a difficulty in saying that there are satisfactory reasons. But the position is very different if the licences are granted before the Act. After the Act a patentee ought not to do any act of commission where by the manufacture cannot be carried on in this country. But mere inactivity is not sufficient. The general object is to foster industries in this country. [PARKER, J.—By means of the monopoly? If that is so, it may not be sufficient for a patentee to say that he has granted no foreigner more than he has granted in this country.] As to the Statute of Monopolies, we refer to Frost, Vol. I., p. 23. We ask for the reversal of the decision, or if there are no satisfactory reasons, that further time should be given to us to manufacture here. [The evidence was then read.]

Montgomery for the respondent—[PARKER, J.—In this case it is perhaps not necessary to decide what "adequate" means, although the word may have some bearing on what is a satisfactory reason.] When the primary condition is satisfied the onus is thrown on the patentee. As to the reasons alleged—(1) The licence contemplated the establishment of factories in this country and there was nothing to prevent the licensees, the real beneficial owners, from doing so. (2) There is no evidence that the only mode of fostering the industry is

to maintain the patent. Then it is said that there is not a demand in this country sufficient to make manufacture successful. But the trade has not been pushed as it would be if the manufacture were here. This is a building material for which there should be a good demand. (3) It is a mere suggestion that the licensees cannot afford to build a factory in this country. They did not ask for time before the Comptroller. (4) There is no valid ground for the distinction made between sections 24 and 27. There is no hard-and-fast line. "Adequate" is not necessarily to satisfy the demands only in this country. [PARKER, J.—Does it mean adequate to satisfy the demands in this country or adequate for trade purposes, or does it mean a fair proportion of the total manufacture having regard to all the circumstances?] It means, I should say, a fair proportion of the whole manufacture having regard to all the circumstances. The section intends that the trade should be fairly treated in this country. [PARKER, J.—Suppose you find that before the Act the patentee contracted not to exercise his rights in this country?] That could not be a satisfactory reason—"satisfactory" means from a public point of view. For "adequate" you must compare it with what would be under free trade conditions. [PARKER, J.—Then you would assent that the mere fact that under free trade conditions the patentee has not exercised his patent rights in this country is not enough to revoke the patent?] I agree that may be so. Under a monopoly the test which exists in free trade is not available, and a patentee may have a whim to manufacture in a particular country. [PARKER, J.—One might say it is a satisfactory reason if the absence of trade is accounted for in a rational way without calling in anything the patentee has done as a monopolist? You say that here the patentee has not proved that the absence of trade in this country is not due to his having granted an exclusive licence for this country?] Yes, he has shown no other causes. Section 27 aims at the restoration of free trade conditions if no satisfactory reasons are given. (5) There is no evidence as to this, even if it is material. As to (6)—— [PARKER, J.—I do not think that there is much in that—the patent was granted on the terms that if in the opinion of the Privy Council it is contrary to the public advantage it may be revoked. Section 27 is intended to carry out the intention of the Statute of Monopolies.] Here the Act is clearly retrospective. A year is given to comply with it. As to time—[PARKER, J.—The object is to give the patentee an opportunity of coming forward notwithstanding that the time has expired.] Here only trivial steps were taken and not until within one month before the year of grace expired.

Sargant for the Crown.—The Attorney-General appears under

section 27 (4), and desires to support the decision. The Court has to fill in the details of a legislation which only sketches out the broad outlines. The Attorney-General desires that vested interests should not be interfered with, except so far as the Act compels that to be done. [PARKER, J.—Under the form in which a patent was granted up to the date of the last Act, a patent has always been revocable if proved to be generally inconvenient.] But a fresh condition, if there was not a clear expression of the law before, has been introduced, with regard both to future patents and to existing patents. A question has been raised whether the section is to protect free trade or is protective of British manufacturers. The Attorney-General will not contend that the sub-section should be construed as giving a protection to an industry by virtue of a monopoly, which otherwise does not exist. If a trade would not otherwise flourish in this country, it is submitted that the section does not throw on the patentee the onus of making it flourish in the United Kingdom. The Act goes as far as this, to prevent the foreign manufacturer using his monopoly to put the British manufacturer at a disadvantage. Taking the case put of free licences all round to manufacture and sell here, in that case I do not see that the patentee's rights are necessarily gone. But there might be free licences given in this market, and an exclusive licence, say in Belgium, so that there was free competition here, but the foreign licensee having an advantage by his exclusive licence; that may have to be considered hereafter. It occurs to a degree here, because persons who might have wished to manufacture would have to compete with the Belgian licensees. [PARKER, J.—You say the patentee must show on the question of satisfactory reasons, that he has not hampered the British trade, and need not show that he has actually fostered it.] No; for instance, by a lower royalty. It is said that there is no obligation on the patentee to work, but it does not matter whether there is an obligation to work or not. Here there is a fresh condition imposed. In a lease a proviso for re-entry is just as effective although there may be no positive personal covenant to do the act in question. The condition must be fulfilled as strictly as if a personal obligation were added. As to what are satisfactory reasons, these may be divided into two classes—(1) permanent; (2) temporary. An illustration of a permanent reason is climatic conditions not allowing profitable manufacture. A temporary reason might be financial depression, or small means, or the necessity for interesting wealthy manufacturers which required time. In such cases the result might be that the Comptroller would in his discretion give further time. It is on the patentee to establish either permanent or temporary satisfactory

reasons. A patentee may give an advantage to foreign manufacture by active personal interest abroad (without, for instance, imposing a larger royalty in this country), and by taking no active steps in this country. In this state of things, could it be said that he had given satisfactory reasons by simply offering to manufacturers at large the opportunity of making here? In this respect the patentee is somewhat in the same position as if he came for an extension. In that case he has to show that he has taken all reasonable steps, having regard to the circumstances, to establish the manufacture here. He ought in the absence of conditions such as climate or something of the same kind to show that he has made definite active efforts here. In this case the patentee interested himself actively abroad and only issued general advertisements, &c., at a late date. [PARKER, J.—Suppose a patentee after the Act licences abroad with a stipulation that he will not licence here, so that the non-working in England is due to his own action; that would not be a satisfactory reason. Would it, if done before the Act?] I think not, but the whole circumstances might have to be considered. But more consideration may have to be applied where the dealings are before the Act. In this case the licensee is really the patentee. The licence provided for this country. In the case put it would be at least incumbent on patentee and licensee to show that they had tried to come to terms together to work as if their interests had not been divergent. If by complicated dealings it has become impossible to arrange, there may be a reason. The patentee and licensee together must for the purpose of this section be regarded as the patentee, and generally they ought to do what a patentee ought to do. Here there has been no serious attempt to work comparable with what has been done in Belgium. There was no effective intention of working shown, and no application to the Comptroller for time. [PARKER, J.—When the state of affairs contemplated by sub-section (1) is shown, the patentee is put on his defence, and satisfactory must mean—independently of what he has done or left undone in the exercise of his patent rights.] Yes.

Shaw in reply.—I cannot agree that it is not necessary to consider the meaning of "adequate." "Adequate" sets the standard. It is deliberately chosen, being different from "exclusively" or "mainly." It may mean much less than 51 per cent. The section must mean adequate for the legitimate protection of the manufacturer or trader. Here no manufacturer or trader wishes to make. [PARKER, J.—The moment you get the conditions of sub-section (1) you put the patentee on his defence. The patentee may say that although the manufacture is mainly abroad, the manufacture here is as much as one may reasonably expect.] If it is as much as you may reasonably

expect under all the circumstances, you do not want any reason. If on the facts no manufacturer would embark on the manufacture here, unless under the protection of a patent, that is enough. This is not a working section, it does not apply where the patent is worked nowhere. [PARKER, J.—If there is only a patent in this country, manufacturers can work abroad at once, and directly they do so the patentee might come within the section.] There may be a question there whether that is manufacture of the patented article; a difficulty may arise on that. The section gives a discretion. It is "may" and not "shall." So that the special circumstances may always be considered, although the patentee does not get within any rule. [PARKER, J.—If "satisfactory" involves that the patentee has succeeded in his defence, then the patent would not be revoked, but if his reasons are unsatisfactory he is in default, and what else is there to take into consideration?] It is difficult to put a concrete case. [PARKER, J.—Suppose it was said that the time had not been long enough, that would be a case for delay. Here the reason alleged is one which you cannot remedy.] A code may grow up as to what is a satisfactory reason, and a patentee might not come within it. It might be a patentee's own stupidity, although there was a legal default; then "may" would allow the Comptroller not to do a hardship. I am relieved from the protectionist argument, that is conceded on behalf of the Attorney-General. As to the licence having been granted before the Act, the position is quite different from the case of a licence granted after the Act. The question of the position of a patentee who manufactures exclusively abroad was fought out in *Badische Anilin* v. *Thomson* (21 R. P. C. 473). [The arguments and judgment were referred to.] [PARKER, J.—After referring to the three considerations put forward as to the grant of letters patent—The modern one is the disclosure. In modern times no jurisdiction by the Privy Council had been exercised. In the time of the Stuarts they did not exercise it and fixed "tolls" or royalties. If the old form of grant and jurisdiction existed now, it may be, that although the objection would not have been good at common law, it might be sufficient to induce the Privy Council to declare the patent void. The jurisdiction of the Privy Council has fallen into disuetude and the inconvenience had been felt and this section had been enacted to meet and remedy that state of things.] The case cited is a declaration of the law in 1904. In 1906 this patentee acts on this state of the law and grants a licence; it does not affect this question that the licence covers manufacture in this country. It is in the power of the licensees to manufacture. I propose to show that there is good reason why they do not. The

facts show that manufacture cannot be satisfactorily established in this country. The public as consumers are not in fact prejudiced. Section 24 deals with the care of the consumer's interest. Even if there were compulsory working, there would be satisfactory reasons for not revoking the patent. It is now the ninth year of the patent. As to time, the licensees do not wish to erect a factory in England, but they are attempting to come to working arrangements.

Judgment was reserved and was delivered on the 26th of March.

PARKER, J.—Before dealing with the facts of this case, I propose to make certain general observations on the construction to be placed upon section 27 of the Patents and Designs Act, 1907. I think this course will be convenient, not only for the purpose of the proceedings now pending before the Comptroller, but for the enlightenment of patentees whose patents may hereafter be attacked under the provisions of this section, and who at the present moment labour under the disadvantage of not knowing certainly the circumstances in which such an attack is possible or the nature of the evidence to be adduced to meet it. Some of the points on which I shall touch were not raised in this case, but they have been argued fully in another case (*c*) which I have had before me, and which I have adjourned for further evidence, and I have devoted a considerable time to the study of the section, being fully aware of its importance both to the patentees and to the public. Whatever difficulty there may be in ascertaining the precise meaning of some of the expressions in section 27, it is at least clear that a patentee, since that section became law, cannot be certain of retaining his patent rights after the period mentioned in the section, unless his patented process is being worked or his patented article is being manufactured within the United Kingdom to an extent which the section describes as adequate, or unless he can give satisfactory reasons why this is not the case. The mischiefs which section 27 and section 24 of the Act were intended to meet are well known. It was felt to be intolerable that letters patent for inventions which create monopolies, and are therefore in themselves contrary to the spirit of the common law as being restraints on trade, and which were only excepted from the operation of the Statute of Monopolies for the encouragement of trade and inventions useful in trade, and in consideration of the disclosure of such inventions to the public, should be used (as they had in fact been used) to prevent the development of new industries or to fetter existing industries in this country. Sections 24 and 27 of the Act are intended to prevent this being any longer possible. Section 24

(*c*) See note on p. 684.

deals primarily with cases where the trade of this country has been injured by an abuse of the monopoly conferred by the patent, irrespective of anything which is being done abroad. Section 27 deals primarily with cases where the object or effect of the use of such rights in the way they have been used has been to favour the development of industries abroad at the expense of industries in the United Kingdom. The sections may sometimes overlap, but this is the broad dividing line between them.

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

The first question is this, What is the state of circumstances the existence of which imposes this serious liability on a patentee? In the words of sub-section (1) it is whenever "the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom." There is no difficulty in the use of the word "exclusively," but the use of the word "mainly" gives rise to the difficulty. The sub-section may, and it was argued that it did, include every case in which the patented article or process is manufactured or carried on to a greater extent outside than inside the United Kingdom. If it is the true meaning, then in every case in which more than 50 per cent. of the patented articles manufactured anywhere are manufactured abroad, the patentee can be called upon to justify the use he has made of his monopoly and to defend his patent rights. I cannot think that this is the true meaning of the sub-section. However great may be one's belief in the industrial supremacy of the inhabitants of these islands, it would at least be somewhat arrogant to assert that wherever the manufacture of a patented article in the United Kingdom is less than one-half of the total manufacture of the whole world, there arises a presumption that British trade has not had fair play—a presumption that the

patentee has been abusing his monopoly. If the patented article be manufactured in the United Kingdom to as great an extent as can reasonably be expected having regard to the industrial development of other countries, I do not think any presumption against the patentee can fairly arise, nor do I think that the Legislature intended it should arise. The word "mainly" is used in the sub-section in close connection with and as an alternative to the word "exclusively," and having regard to this fact, I do not think that a process or article can be said to be mainly carried on or manufactured abroad, merely because it is carried on or manufactured abroad to a somewhat greater extent than within the United Kingdom. For example, if the total manufacture in the United Kingdom were 1,200 and the total manufacture elsewhere 1,250, giving a total of 2,450 in all, I do not think it could be said that the manufacture was mainly abroad within the meaning of the section; to come within the sub-section the disparity must, in my opinion, be greater than a mere small percentage, and indeed if the article be manufactured or the process be carried on within the United Kingdom, not only to a substantial extent, but to an extent as substantial as may reasonably be expected, having regard to what is done abroad, I do not think the state of circumstances is that contemplated by sub-section 1.

It was further agreed before me that sub-section (1) institutes a comparison, not between the extent to which an article or process, the subject of a British patent, is manufactured or carried on in this country and the extent to which it is so manufactured or carried on abroad, but between the number of patented articles made abroad, either in accordance with the specification, or by means of the process described in the specification and imported into this country, and the number of such articles so made in this country. This argument was based on the use of the word "patented," it being contended that the use of this word showed that the legislature was only referring to what was done within the area of the monopoly created by the patent, and that the manufacture of the articles or the carrying on of the processes abroad did not come within the area of the monopoly unless and until the goods manufactured, or the goods resulting from the process, were imported into this country. I cannot conceive that if the legislature had meant this it would not have said it in plainer words. In my opinion, therefore, the sub-section institutes a comparison between the extent to which the article or process, the subject of the patent, is manufactured or carried on in this country, and the extent to which it is manufactured or carried on abroad, whether the articles so manufactured or resulting from the process so carried on abroad are or are not

imported into this country. I have come to this conclusion more easily because the real strength of the argument to the contrary consisted in considering how far-reaching would be the effect of the section if I gave the words in the section their prima facie meaning, and at the same time held that whenever the article or process was manufactured or carried on to a greater extent abroad than in the United Kingdom, the case was within sub-section (1). As I have already held that this is not so, there is nothing to justify me in departing from the plain words.

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

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

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

The question was much discussed as to whether anything more could be required of a patentee than to deal with this and other countries on the same terms and in the same manner, or whether the

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

It follows from what I have said above that "adequate" cannot mean simply adequate to supply the demand in this country, or be considered only with reference to the demand in this country for the patented article or the article produced by the patented process. The demand in this country may in some cases not only be a demand for the patented article but a demand for the patented article as made by a particular firm or as made abroad. If, for example, the patent be for a new article, and such article be manufactured both here and abroad, and part of the demand here be for the article made abroad, because it is got up more to the taste of a section of the public, I do not think that the manufacture here could on that account alone be said to be inadequate. To so hold would, in effect, be to force a patentee to use his patent rights to exclude altogether the import of foreign goods. I agree that the demand and supply in this country

are to be considered, though they are not the only facts to be considered upon the question of adequacy. If there was insufficient manufacture here to meet the demand for the home-made article, it might well be that the manufacture might be held to be inadequate, but, even if there were no demand here at all, the manufacture might be inadequate because the rights of the patentee might have been so exercised as to preclude the growth of a demand by the imposition of unreasonable prices or unreasonable terms for licences, or simply because the patentee had wholly neglected this country in his efforts to develop a foreign trade. Every case must be considered on its own merits and with reference to its own attendant circumstances.

It was suggested that if a patentee could prove that an industry in a patented article or founded on a patented process could not be carried on in this country or as profitably as it could be carried on abroad owing to difference in the cost of material or labour, or other local conditions, he would have given a satisfactory reason within the meaning of the section. I do not think this suggestion is entirely correct. Certainly the fact that persons who were carrying on the industry in this country would make smaller profits than persons carrying it on abroad would, in my opinion, be no satisfactory reason at all. I can conceive cases in which a patentee having obtained a patent may find it impossible to work it in the United Kingdom because of the nature of the invention, or because of local conditions which prevail here, but not in other countries, although these cases must, I think, be rare, and may be exceedingly difficult to prove. The extra cost of labour or material may well be counterbalanced by superior skill or in other ways. But it can never, in my opinion, be sufficient for a patentee, defending himself under the section, to prove that he cannot now start an industry with any chance of profit. The question really is: could he have done so if he had used his monopoly fairly as between home and foreign trade, or if he had devoted the time and money which he has expended in developing a foreign industry to developing a home industry? It may well be that having developed the industry abroad and given foreigners several years' start, he may find it difficult, if not impossible, to develop an industry on the same lines here, and yet such an industry might well have arisen but for the preference he has given to foreign countries. It was also suggested that the section only contemplates revocation, if revocation would lead to the establishment of a new industry or the further development of an existing industry in this country, so that if the patentee had by an abuse of monopoly succeeded in precluding the possibility of such establishment or development, his patent ought not to be revoked. I dissent entirely from

this suggestion. I see no reason why the section should not have been intended to penalise a patentee who has abused his monopoly and by a revocation of the patent this country becomes at any rate free from restraint on its trade which is opposed to the spirit of its common law. I desire next to say a word or two upon the arguments addressed to me in support of the proposition that patentees who obtained their patents before the Act of 1897 are in a better position than patentees who obtain their patents after the passing of that Act. These arguments were all founded on this suggestion, that patentees who obtained their patents before the Act had vested interests, and that in default of a provision for compensation I ought to construe the Act, as far as I reasonably can, so as to preserve these interests. Let us see whether there is really any substance in these arguments. The only express provision in favour of patentees who obtained their patents before the Act consists in the one-year limit, a sort of period of grace in which the patentee may, if he desires to save his patent, take means to secure that his patented article is manufactured or his patented process carried on in this country. In all other respects the Act puts all patentees in the same position whether they obtained their patent before or after the Act. It is, in my opinion, impossible to construe the provisions of the statute in one way as to patents acquired before the Act, and in another way as to patents acquired after the Act. All patentees are subjected to the same liabilities. The only possible distinction between patentees who obtained their patents before and patentees who obtained their patents after the Act is that the Comptroller or Court might possibly accept as satisfactory, in the case of the former, reasons for not manufacturing this article or carrying on the process in this country which would be regarded as unsatisfactory in the case of the latter. I am of opinion that to a limited extent there may be reasons satisfactory in the one case which would not be satisfactory in the other, but I totally dissent from the contention that, if a patentee has before the Act precluded himself by contract from working his patent in this country, the existence of such a contract is a satisfactory reason within the meaning of the section for not working here. As I have said before, no such reason can be satisfactory which does not operate independently of any misuse which the patentee has made of his property. There is an historical reason for making no distinction in this respect in favour of existing patents. The mischiefs aimed at by the section arose to a great extent, at any rate, from the patentee exercising his exclusive right of sale without exercising his exclusive right of manufacture, contenting himself with preventing manufacture by others in this country and importing

articles manufactured abroad. The Statute of Monopolies reserves only the right of the Crown to grant for fourteen years the sole right of working or making the invention, and says nothing about the sole right of sale. The Crown has, however, always granted by virtue of this reservation the sole right of sale as well as the sole right of working and making. This has been held to be justified on the ground that the sole right of sale is an ancillary right to the sole right of the manufacture, and it might possibly at one time have been open to the Courts to refuse to protect the sole right of sale unless exercised as an aid to the sole right of manufacture in this country. The form of letters patent granted by the Crown has, however, invariably so far as I can discover, contained a clause providing that if at any time during the term of the patent it should be made to appear to the King or any six or more members of his Privy Council, that the grant was prejudicial or inconvenient to the King's subjects, the letters patent should be void. There is an instance of this clause in a patent granted in 1618, several years before the Statute of Monopolies, and cited in the case of the *Attorney-General* v. *Simpson* (1901, 2 Chancery, at pages 675 and 676), and it appears from that case that the Privy Council entertained jurisdiction under the clause to regulate charges made by the patentee. (See the same case in the House of Lords, 1904 Appeal Cases, at page 483.) In my opinion, letters patent have always been voidable under this clause if worked by the patentee to the prejudice or inconvenience of the King's subjects in general, and but for the fact that the jurisdiction of the Privy Council under this clause has fallen into disuse, a patentee by abusing his monopoly would always have incurred the risk of losing his patent rights. This, I think, affords a good reason for the fact that modern legislation, designed to prevent the abuse of patent rights, has never drawn any distinction between existing patents and patents to be granted in future. This was the case with regard to the compulsory licence clause of the Act of 1902, which enabled the Privy Council to revoke a patent in every case in which the patent was worked or the patented article manufactured exclusively or mainly outside the United Kingdom, unless the patentee could show that the reasonable requirements of the public had been satisfied and which provided that such reasonable requirements should not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent, or manufacture his patented article in the United Kingdom to an adequate extent, or to grant licences on reasonable terms, any existing industry or the establishment of any new industry was unfairly prejudiced or the demand for the patented article was not unreasonably met. These

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

Lastly, I desire to make one or two observations on the patent rules which govern the procedure before the Comptroller under section 27 of the Act. As those rules at present stand, the applicant applies for revocation, merely stating in the application that the patented article is manufactured or the patented process is worked exclusively or mainly abroad, and he need give no evidence in support of his statement; though the onus of satisfying the Comptroller of the truth of these statements rests in the first instance, in my opinion, at any rate, on him. The application is served on the patentee, who has thereupon within 14 days to declare on oath whether the statement is or is not correct; and if he says the statement is incorrect, he must further declare on oath to what extent and in what place the patented article or process is manufactured or carried on within the United Kingdom; and, if such extent is inadequate, the reasons for the inadequacy. The applicant has a certain time to file, but need not file, statutory declarations in answer; and then the matter comes before the Comptroller, there being possibly up to this point no evidence that the case is within the section at all, for neither party is bound to give evidence of any manufacture abroad. The question whether the patent is or is not to be revoked is disposed of at the same hearing, and I am told that the patentee has to open his case and give his evidence before the applicant gives any evidence at all. This procedure clearly, and in my opinion, wrongly, puts the patentee on his defence before the Comptroller has been satisfied by the applicant that the state of affairs contemplated by sub-section (1) has arisen; and such a procedure, besides being, in my opinion, most unfair to the patentee, is obviously open to very serious abuse. Even if

the patented article or process is not manufactured or carried on abroad at all, yet, if anyone makes an application under this section, the unfortunate patentee has to disclose, perhaps to some competitor or intending competitor, particulars of his business which he may not desire to disclose, and to give evidence in defence of his conduct before any case raising a presumption against him has been made out. If, for example, the patent belongs to a firm like Messrs. Armstrong & Co., and is for some improvement in some small part of the mechanism of, say, a machine gun, any one desiring to find out how many of such machine guns were manufactured in this country might make the necessary application for revocation; and, without tendering any evidence that the case was within the section, force the patentee to disclose on oath the extent to which the article protected by the patent was manufactured in this country. Having obtained that information, he might elect to withdraw the application. Inasmuch as an application under the section can be made by any one, whatever may be his motive, and the section in effect penalises patentees who have abused their monopoly, it is, in my opinion, all the more necessary, in order to prevent the section being improperly used, to insist that every applicant shall give at any rate primâ facie evidence of the existence of the state of affairs contemplated by sub-section (1), before the patentee is put to the trouble and expense of finding out and proving the extent to which the patented process or article is manufactured or carried on in this country or abroad, and of explaining and justifying everything he has done since the grant of his patent. It must be remembered that not only can any person apply under the section, but he can apply from time to time as he pleases. Failure on one application would be no bar to another application a year later, and although the section was no doubt passed in the interests of the public, still, if it be worth while retaining any patent system at all in this country, it ought, I think, to be construed to give reasonable protection to patentees; and for this purpose the applicant, who may be a mere common informer, ought to be required to prove, what even a common informer has to prove, namely, some case requiring an answer. In my opinion the proper course for the Comptroller to pursue when he receives an application under section 27 is, to inquire whether the patentee admits that the state of affairs contemplated by sub-section (1) has arisen. If this is not admitted, he should inquire into the matter in the presence of both parties; and the applicant, being the person on whom the onus lies, should be the first to tender evidence. It may well be that the patentee knows nothing about what is being done abroad nor what is being done in this country in the way of

manufacturing the patented article or carrying on the patented process. There is no particular reason why he should know what is being done abroad, unless he has foreign patents or is himself manufacturing the article or carrying on the process abroad. Even as to the extent to which the article or process is being manufactured or carried on here, he may have no information; for he may have sold licences outright, and not confined the use to the reservation of royalties. I do not say that he may not in the course of the inquiry be compelled to say what he does know; but at least the applicant ought at first to be called upon to make out some case requiring an answer, and at any rate until he has given some evidence that the case is within the section, I do not see what answer is required. If, on the other hand, the patentee admits that the state of affairs contemplated in sub-section (1) has arisen, or if after inquiry the Comptroller is satisfied that it has arisen, the patentee may fairly be called on to state, first, what his defence is, and then to prove it. It would be convenient that, in stating what the defence is, the patentee should state the reasons on which he intends to rely, if the extent to which the patented article or process is manufactured or carried on is inadequate, and the particular facts on which he intends to rely, if he contends that it is adequate. As a general rule I think that on appeal the patentee ought to be confined to his case as made before the Comptroller, and not allowed to set up a fresh case or adduce further evidence. In one case which I have heard I did allow further evidence to be adduced, but only on the ground that, until I had construed the Act, patentees could hardly be expected to realise the nature of the burden thrown on them by the section and the nature of the evidence required to discharge it. But I do not think any such indulgence ought to be granted as a general rule.

I should like to point out that, even as the Patent Rules now stand, it appears to me that the Comptroller can call upon the applicant for evidence of the truth of the statement contained in the application, enlarging the time for the patentee to put in his evidence till this is done; and if the applicant does not furnish evidence sufficient to call for an answer, may refuse to proceed further with the matter. Similarly, he can, I think, enlarge the time for filing evidence which can only be relevant for the patentee's defence, until he is satisfied that there is a case for calling on the patentee to defend himself. But, under these circumstances, it appears to be desirable that the Rules should be altered. It must be remembered that the section is in its nature a penal section, that the patentee is on his trial, that mere accusation raises no presumption of guilt, and that the Comptroller is a Court exercising judicial functions. It is not

merely the case of a departmental inquiry. The Comptroller is in the position of a judge, and not of a commissioner employed to take evidence and with power to summon before him and examine any person he pleases. The procedure, therefore, I think, should be clearly specified in the Rules, and should be a procedure adapted to the circumstances, having regard to the onus which the Act throws on the applicant and the patentee respectively.

I come now to the facts of this particular case. The patents in question were granted in 1900 for inventions relating to a process of manufacturing thin imitation stone slabs or tiles—I need not describe the process. The important point is that, though in commercial operation in Germany, France and Belgium, it has never been worked in this country. Clearly, therefore, the patentee is put on his defence; and the only question is whether he has given satisfactory reasons for this state of affairs. It appears that, having in 1900 obtained his patent rights and corresponding patents in the countries I have mentioned, he devoted himself to the establishment abroad of industries in which the patented process was carried on—using the monopoly conferred upon him by his patents in this country, not for the purpose of establishing a new industry here, but in order to secure to some foreign licensee the monopoly of selling in this country articles manufactured abroad. In my opinion, a new industry might have arisen in this country but for the manner in which the patentee has exercised his patent rights; but it is quite enough to say that there is no satisfactory evidence that a new industry would not have arisen here if the patentee had exercised his patent rights fairly as between this country and foreign countries. Nothing has been proved either as to the relative cost of material, or wages, or as to difference in local conditions, which points to the economic impossibility of such an industry having grown up in the United Kingdom if no preference had been conferred on foreigners. Possibly a manufacturer in this country might have had to be content with smaller profits than a manufacturer abroad; but even this is not proved. It was said that the demand here was too small to justify the expense entailed in laying down the necessary plant; but there is no evidence, or at any rate, no satisfactory evidence, that the demand would have not been much greater than it is but for the manner in which the patentee has used his monopoly. It is to my mind abundantly clear that, if these patents had been granted after the passing of the Act of 1907, they ought to have been revoked. And the only question is whether, having regard to the fact that they were granted in 1900 and to what occurred before the passing of the Act of 1907, any indulgence ought to be granted to the patentee. It is to be observed

that, on the 26th of January, 1905, the patentee granted what is, in effect, an exclusive licence for this country to a manufacturing company in Belgium. The licence provided that the Belgian company might either import into this country the goods made by them in Belgium, or erect factories here; but the patentee precluded himself from granting licences here. The licensee has exercised the powers granted to him by the licence not to erect factories here, but to import his foreign-made goods into this country—excluding any competition between such goods and the goods made in this country or elsewhere abroad. The state of things which has resulted would, I think, have rendered the patent revocable under the Act of 1902; for it does not seem to me that the patentee could have discharged the onus imposed on him by that Act any more than, in my opinion he has discharged the onus imposed on him by section 27 of the existing Act. There is no reason, therefore, why the pateutee should be entitled to any indulgence, even if indulgence could be granted Stress was laid on the fact that the patentee, in conjunction with his licensee, has recently, in advertisements and circulars, expressed his willingness to sell or enter into working arrangements for the manufacture of goods in this country under the patented process. That was, however, done at the last moment; and I am not surprised that under the circumstances no one willing to buy or take a licence has been found. Even if it had been done forthwith after the Act and the possibility of a sale being made or licences granted had been made known much more thoroughly in this country, I do not think the fact that no one has been found willing to buy or take up a licence and manufacture here could have proved very much. I do, not know what the terms were under which the patentee and his licensee contemplated selling or granting licences, or whether the terms of the licences included protection against Belgian imports. If they did not, possibly manufacturers might very well be deterred by the fact that the Belgian firms had had so long a start that an intending purchaser or licensee might well be deterred also by the uncertainty of the patent remaining, under the circumstances, unrevoked for a sufficient time to start a new industry.

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

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

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