# THE LAW OF

# COPYRIGHT IN DESIGNS.

# THE LAW OF

# COPYRIGHT IN DESIGNS,

TOGETHER WITH THE

## PRACTICE RELATING TO PROCEEDINGS IN THE COURTS AND IN THE PATENT OFFICE,

AND

## A Full Appendix

OF

## STATUTES, RULES, AND FORMS, THE INTERNATIONAL CONVENTION, ETC., ETC.


BY

## LEWIS A. EDMUNDS, D.Sc., LL.B.,

OF THE INNER TEMPLE, BARRISTER-AT-LAW,
AUTHOR OF "THE LAW AND PRACTICE OF PATENTS FOR INVENTIONS,"
FELLOW OF THE CHEMICAL AND GEOLOGICAL SOCIETIES.

ASSISTED BY

T. M. STEVENS, M.A., B.C.L.,
OF GRAY'S INN, BARRISTER-AT-LAW.

MARCUS W. SLADE, B.A.,
OF THE INNER TEMPLE, BARRISTER-AT-LAW.



LONDON:

SWEET AND MAXWELL, LIMITED, 3, CHANCERY LANE,

Law Publishers.

MEREDITH, RAY, & LITTLER, MANCHESTER;
HODGES, FIGGIS & CO., AND E. PONSONBY, DUBLIN;
C. F. MAXWELL, MELBOURNE & SYDNEY.

1895.

N
E24Ac

LONDON:
BRADBURY, AGNEW, & CO. LD., PRINTERS, WHITEFRIARS.

# PREFACE.

THE fact that no work specially devoted to the Law of Designs, and attempting a complete treatment of the subject, has appeared for many years past, makes it unnecessary to offer any excuse for the production of this work, except in so far as in actual execution it may fall short of the object with which it has been written. This object is to present an exhaustive exposition of the English Law of Copyright in Designs.

Such scanty treatment as the Law of Designs has received at the hands of legal writers has generally been incidental to the treatment of other subjects. Treatises on the law of copyright in general, and on patents and trade marks, have referred to the subject, but a legal work dealing exclusively with the law of designs has not appeared for nearly half a century.

Although the law of copyright in designs has been thus neglected, the subject is of immense practical importance to the manufacturing and industrial undertakings of the country, and enormous commercial interests are now largely dependent on the protection afforded by the registration of Designs.

The number of designs annually registered is about 20,000.

The principal difficulties in writing on this branch of the law are the ambiguous character of many of the statutory

provisions, and the dearth of authoritative decisions. Where available the cases on analogous questions in patent and trade mark law have been called into use, and on many questions they may be safely followed as decisions which would probably be regarded by the Courts as conclusive on corresponding matters relating to designs.

The text contains, it is believed, all cases directly or indirectly relating to designs reported before the end of February, 1895. In the table of cases the references to all series of reports are, as far as possible, given. In the text, for want of space, this has not always been done.

Much care has been bestowed on the index, and every effort has been made to render it an efficient and convenient guide to the contents of the work.

This volume is the outcome of a plan formed soon after the publication of the Author's work on the "Law of Patents for Inventions," of preparing a companion volume to that treatise. But that plan would never have reached fruition without the co-operation of Mr. T. M. Stevens and Mr. M. W. Slade, barristers-at-law, who have, the former throughout the work, and the latter in the annotation to the Acts, with much ability and industry contributed to the production of this work.

Mr. E. W. Hulme, of the Patent Office Library, has given suggestions and assistance.

L. E.

1, Garden Court,
The Temple,
*March*, 1895.

# TABLE OF CONTENTS.



## PART I.

### LAW AND PRACTICE OF COPYRIGHT IN DESIGNS.

### CHAPTER I.



### CHAPTER II.



### CHAPTER III.



### CHAPTER IV.

## CHAPTER V.



## CHAPTER VI.



## CHAPTER VII.



## CHAPTER VIII.



## CHAPTER IX.



# PART II.

# APPENDICES.

## APPENDIX OF STATUTES.



## APPENDIX B.



## APPENDIX C.



## APPENDIX D.



## APPENDIX E.

# TABLE OF CASES.

Gea—Hun

**Ihl—Mar**

R.



S.

# PART I.

# THE LAW AND PRACTICE RELATING TO DESIGNS.

## CHAPTER I.

### HISTORY AND DEVELOPMENT OF LAW OF DESIGNS.

Prior to the year 1787 the inventor of a design had no means of acquiring any property therein or of preventing others from imitating his design; except that he might then, as he may now, in some cases obtain protection by the grant of a patent for an invention. This was expensive to procure, and in most cases, such was the technical nature of the law at the time, very difficult to uphold.

In the year 1787 the great development in the arts of designing and printing linens, cottons, calicoes and muslins led to the first Act of Parliament dealing with designs. It gave copyright to inventors of designs for linens, cottons, calicoes and muslins. Many subsequent Acts have since been passed, the principal of which are the Acts of 1842 and 1883, each of which was a consolidating and amending Act, and repealed all prior legislation. The law of designs is now substantially regulated by the Patents, Designs and Trade Marks Act, 1883, as amended by the Acts of 1885, 1886 and 1888.

Development of Design Law.

We propose, however, to give in this introductory chapter a sketch of the steps by which the law as to copyright in designs has by successive stages reached its existing form.

Act of 1787

The Act of 1787 (27 Geo. III. c. 38) was entitled "An Act for the encouragement of the arts of designing and printing Linens, Cottons, Calicoes and Muslins, by vesting the properties thereof in the Designers, Printers, and Proprietors, for a

limited time." It recited that it was expedient for the encouragement of the arts of designing original patterns for printing linens, &c., to vest the property thereof in the designers, printers and proprietors for a limited time, and enacted that from the 1st June, 1787, every person who should design or cause to be designed any new and original pattern for printing linens, cottons, calicoes or muslins should have the sole right of reprinting the same for the term of two months, to commence from the day of the first publishing thereof. It was further provided that the name of the printer or proprietor should be printed at each end of every piece, and that anyone knowingly printing, working, or copying or publishing, or exposing for sale such original pattern without the consent of the proprietor in writing, should be liable to an action for damages. Actions were to be brought within six months of the offence. The Act of 1787 was to continue in force till the end of the next session of parliament. By 29 Geo. III. c. 19 the Act was continued in force till 1794, and by 34 Geo. III. c. 23, passed in 1794, the term of two months was extended to three months, and the Act was made perpetual.

Protection for designs for fabrics of linen, cotton, &c.

Original term two months.

**Act of 1839** (2 *Vict.* c. 13).

The protection granted to linens, cottons, calicoes and muslins being found advantageous, an Act, 2 Vict. c. 13, was passed in 1839, extending the provisions of the Act of 1787 to fabrics composed of wool, silk and hair, and to mixed fabrics composed of any of the materials, linen, cotton, wool, silk or hair. The operation of the Act of 1787 was also extended to Ireland. It previously affected England and Scotland only.

Extension of Act of 1787 to fabrics consisting of wool, silk and hair.

**Act of 1839** (2 *Vict.* c. 17).

Hitherto the protection of the law had only been accorded to fabrics, and the designs to which copyright was given were ornamental in their nature. By the Act, 2 Vict. c. 17, passed in 1839, intituled "An Act to secure to proprietors of designs for *Articles of Manufacture* the copyright of such designs for a limited time," the scope of the copyright in designs was greatly extended. This Act introduced the system of registering designs, which, with modifications, is at the present day in force, and gave copyright for twelve months from the date of registration to the proprietor of new and original designs for the following purposes:—

Extension to articles of manufacture.

Registration introduced.

(1) For the pattern or print to be either worked into or worked on, or printed on or painted on, any article of manufacture,

being a tissue or textile fabric, except *lace*, and also except linens, cottons, calicoes, muslins, and any other article within the protection of the Acts already in force.

(2) For the modelling, or the casting, or the embossment, or the chasing, or the engraving, or for any other kind of impression or ornament, on any article of manufacture, not being a tissue or textile fabric.

(3) For the shape or configuration of any article of manufacture, except lace, and also except linens, cottons, calicoes, muslins, and any other article within the protection of the Acts already in force.

But the proprietor of any new design under (2), when applied to metals, was to have copyright for three years instead of twelve months.

Conditions of copyright.

Registration before publication.

Marking.

No person was to be entitled to the benefit of the Act unless the design had before publication been registered, and unless after publication of the design every article of manufacture published by him, on which such design was used, had thereon the name of the first registered proprietor, and the number of the design in the register, and the date of the registration thereof.

The "proprietor" was defined as follows :—

Proprietor defined.

The author of every such new and original design shall be considered the proprietor, unless he have executed the work on behalf of another person for a valuable consideration, in which case such person shall be considered the proprietor, and shall be entitled to be registered in the place of the author; and every person purchasing for a valuable consideration a new and original design, or the exclusive or the partial right to use the same for any one or more of the above-mentioned purposes, in relation to any one or more articles of manufacture, shall be considered as the proprietor of the design for all or any one or more such purposes, as the case happens to be.

Protection against piracy.

For protection against piracy of registered designs, it was enacted (sect. 3) that during the existence of such exclusive or partial right no person shall either do or cause to be done any of the following acts in regard to a registered design, without the licence or consent in writing of the registered proprietor thereof (that is to say),

No person shall use for the purposes aforesaid, or any of them, or print or work or copy, such registered design, or any original part thereof, on any article of manufacture, for sale:

No person shall publish, or sell or expose to sale or barter, or in any other manner dispose of for profit, any article whereon such registered design or any original part thereof has been used, knowing that the proprietor of such design has not given his consent to the use thereof upon such article:

No person shall adopt any such registered design on any article of manufacture for sale, either wholly or partially, by making any addition to any original part thereof, or by making any subtraction from any original part thereof:

Penalty. And if any person commit any such act he shall for every offence forfeit a sum not less than five pounds and not exceeding thirty pounds, to the proprietor of the design in respect of which such offence has been committed.

Recovery of penalties for piracy. The party injured by any such act was to recover such penalty either by an action of debt or on the case against the party offending, or by summary proceeding before two justices having jurisdiction where the party offending resided (sect. 4).

No action or other proceeding for any offence under the Act was to be brought after the expiration of six calendar months from the commission of the offence; and in such action or other proceeding every plaintiff or prosecutor was to recover his full costs (sect. 4).

Registration of designs. With regard to the registration of designs, it was enacted (sect. 6) that the said registrar should not register any design unless he was furnished with three copies or drawings of such design, accompanied with the name and place of abode of the proprietor thereof; and the registrar was to register all such copies successively, as they are received by him for that purpose, and on every such copy to affix a number corresponding to such succession, and to retain two copies, one of which he was to file in his office, and the other to hold at the disposition of the Board of Trade, and the remaining copy he was to return to the person by whom the same had been forwarded to him; and in order to give ready access to the copies of designs so registered, he was to keep a classified index of copies of designs.

Inspection of designs.

Classified Index.

Certificate of registration.

A certificate of registration of design was to be given to the proprietor by the registrar which was to be received in evidence without further proof.

Transfer of copyright and register thereof.

It was also provided that every person purchasing a new and original design might enter his title in the register; and that *any writing* purporting to be a transfer of such design, and signed by the proprietor thereof, shall operate as an effectual transfer; and that the registrar should, on request, and the production of such writing, insert the name of the new proprietor in the register.

Optional forms of transfer were given (sect. 4). The forms were:—

*Form of Transfer and Authority to register.*

I, *A. B.*, author [*or* proprietor] of design number having transferred my right thereto [*or if such transfer be partial*] so far as regards the making of [*describe the Articles of Manufacture with respect to which the right is transferred*] to *B. C.* of do hereby authorize you to insert his name on the register of designs accordingly.

*Form of Request to register.*

I, *B. C.*, the person mentioned in the above transfer, do request you to register my name and property in the said design, according to the terms of such transfer.

Consolidating and Amending Act of 1842 (5 & 6 *Vict.* c. 100).

Definition of design under Act of 1842.

The Act of 1842, which swept away all previous legislation on designs, came into force on the 1st September, 1842. By it copyright was granted (sect. 3) to any *new* and *original* design, whether such design be applicable to the *ornamenting* of any article of manufacture, or of any substance, artificial or natural, or partly artificial and partly natural, and that whether such design be so 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 such design may be so applicable, whether by printing, or by painting, or by embroidery, or by weaving, or by sewing, or by modelling, or by casting, or by embossing, or by engraving, or by staining, or by any other means whatsoever, manual, mechanical, or chemical, separate or combined. Sculpture and other things within 53

Geo. III. c. 71 and 54 Geo. III. c. 56, were excepted from the Act.

This definition, except that it is confined to *ornamental* designs, is very similar to that now in force, given in the Act of 1883, sect. 60, see p. 150.

Term of copyright dependent upon class of goods.

The term of copyright was, however, dependent upon the class of goods to which the design was applied (sect. 8). The classes of goods were :—

Classes under Act of 1842.

Class 1.—Articles of manufacture composed wholly or chiefly of any metal or mixed metals :

Class 2.—Articles of manufacture composed wholly or chiefly of wood :

Class 3.—Articles of manufacture composed wholly or chiefly of glass :

Class 4.—Articles of manufacture composed wholly or chiefly of earthenware :

Class 5.—Paper hangings :

Class 6.—Carpets :

Class 7.—Shawls, if the designs be applied solely by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics :

Class 8.—Shawls not comprised in Class 7 :

Class 9.—Yarn, thread, or warp, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced :

Class 10.—Woven fabrics, composed of linen, cotton, wool, silk, or hair, or of any two or more of such materials, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics ; excepting the articles included in Class 11 :

Class 11.—Woven fabrics, composed of linen, cotton, wool, silk, or hair, or of any two or more of such materials, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics, such woven fabrics being or coming within the description technically called furnitures, and the repeat of the design whereof shall be more than twelve inches by eight inches :

Class 12.—Woven fabrics, not comprised in any preceding Class :

Class 13.—Lace, and any article of manufacture or substance not comprised in any preceding Class.

The copyright was for the term of three years in respect of the application of any such design to ornamenting any article of manufacture contained in the first, second, third, fourth, fifth, sixth, eighth, or eleventh of the Classes following :

In respect of the application of any such design to ornamenting any article of manufacture contained in the seventh, ninth, or tenth of the Classes following, for the term of nine calendar months :

In respect of the application of any such design to ornamenting any article of manufacture or substance contained in the twelfth or thirteenth of the Classes following, for the term of twelve calendar months.

The copyright was conditional on registration before publication

in respect of the application of the design to some or one of the classes of goods named in the Act, and on the proper marking of all goods to which the design was applied.

The definition of "proprietor" (sect. 5) and provision for the transfer of the copyright (sect. 6) by writing were substantially the same as in the Act of 1839.

The remedies of the proprietor for piracy were practically the same as under the Act of 1839, but fraudulent imitations of designs were in express terms forbidden (sects. 7 and 8).

A new provision was introduced, giving the proprietor his election to bring an action for damages sustained by an infringement of his rights. Section 9 is as follows :—

Action for damages for piracy.

"Provided always, and be it enacted, that notwithstanding the remedies hereby given for the recovery of any such penalty as aforesaid, it shall be lawful for the proprietor in respect of whose right such penalty shall have been incurred (if he shall elect to do so) to bring such action as he may be entitled to for the recovery of any damages which he shall have sustained, either by the application of any such design or of a fraudulent imitation thereof, for the purpose of sale, to any articles of manufacture or substances, or by the publication, sale or exposure to sale, as aforesaid, by any person, of any article or substance to which such design or any fraudulent imitation thereof shall have been so applied, such person knowing that the proprietor of such design had not given his consent to such application."

This is practically repeated in the Act of 1883, sect. 59.

As in the Act of 1839, a registrar of designs was to be appointed, who was to register designs and grant certificates of registration (sects. 14, 15, 16). Power was given to a court of equity to rectify the register where it should appear that a person not the lawful proprietor had been registered as proprietor (sect. 10).

Inspection of register.

The public were not under the Act to be entitled to inspect the copies of designs at the Designs Office of which the copyright was still in force, except with the leave of the proprietor, or by special authorisation of the registrar, and under conditions preventing a copy being taken. Section 17 is as follows :—

The designs of which the copyright had expired might be inspected.

"That every person shall be at liberty to inspect any design whereof the copyright shall have expired, paying only such fee as shall be appointed by virtue of this Act in that behalf; but with regard to designs whereof the copyright shall not have expired, no such design shall be open to inspection, except by a proprietor of such design, or by any person authorized by him in writing, or by any person specially authorized by the registrar, and then only in the

presence of such registrar or in the presence of some person holding an appointment under this Act, and not so as to take a copy of any such design or of any part thereof, nor without paying for every such inspection such fee as aforesaid: Provided always, that it shall be lawful for the said registrar to give to any person applying to him, and producing a particular design, together with the registration mark thereof, or producing such registration mark only, a certificate stating whether of such design there be any copyright existing, and if there be, in respect to what particular article of manufacture or substance such copyright exists, and the term of such copyright, and the date of registration, and also the name and address of the registered proprietor thereof."

This provision was inserted in deference to the wishes of those interested in textile fabrics, it being alleged that if the designs were open to inspection the new designs would be copied or imitated, often in a way which would be difficult to prove to be a piracy. The substantial start in the market of the original designer might thus be lost.

Application of fees of registration.

It was provided that the fee for registering a design to be applied to any woven fabric mentioned or comprised in classes 7, 9, or 10 shall no exceed the sum of one shilling; that the fee for registering a design to be applied to a paper hanging shall not exceed the sum of ten shillings; and that the fee to be received by the registrar for giving a certificate relative to the existence or expiration of any copyright in any design printed on any woven fabric, yarn, thread, or warp, or printed, embossed, or worked on any paper hanging, to any person exhibiting a piece end of a registered pattern, with the registration mark thereon, shall not exceed the sum of two shillings and sixpence.

**Act of 1843** (*6 & 7 Vict. c. 65*).

Extension to designs having reference to *purpose of utility*.

The Act of 1843 extended still further the protection to designs by giving copyright for three years (sect. 1) from the date of registration to the proprietor of a new and original design for any article of manufacture having reference to some *purpose of utility*, so far as the design should be for the whole or part of the shape and configuration of such article. The designs within the Sculpture Copyright Acts, 38 Geo. III. c. 71 and 54 Geo. III. c. 56, were expressly exempted from the Act, as in previous legislation. The Act in other respects substantially incorporated the provisions of the Act of 1842, so far as applicable (sects. 3, 4, 6, 10). The registrar was to be appointed for all designs for articles of manufacture (sects. 7 and 8), and he was to exercise his discretion as to what were ornamental designs under the Act of 1842, and what

Discretion of registrar as to useful and ornamental designs.

useful designs under this Act. He might also refuse to register any design not intended to be applied to any article of manufacture, but only to a label, wrapper, or other covering. He might also refuse to register designs contrary to public morality or order. There was an appeal from the registrar to the Board of Trade (sect. 9).

Floorcloths and oilcloths were to be included in class 6 of the Act of 1842, sect. 5.

**Act of 1850** (13 & 14 *Vict. c.* 104). Designs within Sculpture Copyright Acts.

By the Act of 1850 designs within the Sculpture Copyright Acts might be registered with the Registrar of Designs, and the proprietors of the design were thenceforth to have the machinery of the Designs Act, 1842, for the recovery of penalties and the protection of their copyright. The term copyright was not altered, but the registration might be for the whole or any part of the term of the copyright.

But the more important object of the Act was to provide for the *provisional registration* of designs.

Provisional registration.

It was provided that designs which might be registered under the Designs Act, 1842, or the Designs Act, 1843, might be provisionally registered for the term of one year (sect. 1), which might be extended by the Board of Trade for a further six months (sect. 5).

During this term the proprietor of the design had the sole right and property in the design, and the penalties and provisions of the Acts of 1842 and 1843 for preventing piracy were available.

Publication during provisional registration.

During the continuance of the provisional protection the publication of the design would not avoid subsequent registration of the copyright, except that the design was not to be sold or exhibited for sale under pain of nullifying the provisional registration and consequent loss of copyright (sects. 3 and 4). Articles to which the design might be applied were to be marked "provisionally registered," and with date of registration (sect. 3).

Extension of copyright in ornamental designs.

The copyright in ornamental designs under the Designs Act, 1842, might be extended by the Board of Trade for an additional term not exceeding three years (sect. 9).

Designs for ornamenting ivory, &c., may be registered

Designs for the ornamenting of ivory, bone, papier maché, and other solid substances which were not already comprised in the classes numbered 1, 2, or 3, in the Designs Act, 1842, were to be

under Designs Act, 1842, for three years.

deemed and taken to be comprised within the class numbered 4 in that Act, and such designs were to be so registered accordingly (sect. 8).

**Act of 1858** (21 & 22 *Vict.* c. 57).

The Act of 1858 was passed to make further provision against piracy, and to extend the term of copyright given to designs applied

Extension of time of copyright in certain classes.

to articles in class 10 of the Designs Act, 1842, from nine months to three years, subject to this, that the term of the copyright should expire on the 31st December in the second year after the year in which the design was registered, whatever might be the day of such registration (sect. 3). Proceedings for damages for piracy might be commenced in the county court (sect. 8). Any person applying any "mark of registration" to any article to which

False marking.

a design was applied when the copyright had expired, or where there was no registration, or during the copyright, without the authority of the proprietor, was made liable to a penalty of ten pounds (sect. 7).

**Act of 1861** (24 & 25 *Vict.* c. 73).

Prior to the Act of 1861 the application of the design had to be made within the United Kingdom to obtain copyright. In pursuance of free trade principles the protection was now granted "whether the application thereof be done within the United Kingdom or elsewhere." It was also expressly provided that the previous Acts still in force should not be construed to apply to the subjects of Her Majesty only (sec. 2).

**Act of 1865** (28 *Vict.* c. 3).

The Act of 1865 provided for the protection of designs exhibited at industrial exhibitions certified by the Board of Trade. Exhibition at such industrial exhibition, or publication during the period thereof, of a design, was not to prejudice any subsequent registration of such design.

**Act of 1875** (38 & 39 *Vict.* c. 93).

The Act of 1875, which came into force on the 1st January, 1876 (sect. 1), transferred to the Commissioners of Patents the powers and duties of the Board of Trade under the Copyright of Designs Act (sect. 2), and gave the Commissioners power to make

General Rules by Commissioners of Patents.

general rules for the regulation of the Designs Office. The office of registrar as a separate office was abolished, his duties being transferred to the Commissioners of Patents.

Association of Designs and Patents in one office.

The Designs Office having been removed to the Patent Office on the transfer of the registration of designs from the Board of Trade to the Commissioners of Patents under the last-mentioned Act,

the administration of the Designs Office has since that time been closely connected with patents and trade marks.

Patents, &c., Act of 1883.

By the Patents, Designs and Trade Marks Act, 1883, 46 & 47 Vict. c. 57, the whole of the previous Acts relating to designs and trade marks were repealed and the provisions of that Act consolidating and amending all previous statutory enactments were substituted. Substantially the same object was effected with Patents, except that the Statute of Monopolies was left intact. The present law and practice of designs is entirely regulated by that Act as amended in a few details by the Patents, Designs, and Trade Marks Act of 1885, 48 & 49 Vict. c. 63, 1886, 49 & 50 Vict. c. 37, and 1888, 51 & 52 Vict. c. 50, and by the general rules of procedure issued under the Act of 1883. The rules now in force are the Designs Rules, 1890—1893.

Designs Law now entirely regulated by Acts of 1883, 1885, 1886, 1888, and Designs Rules.

Many ambiguities in Designs Law.

The decisions of the courts under these Acts, so far as they relate to designs, have been few, and many ambiguities still remain. They are principally due to the very incomplete nature of the provisions of the Act of 1883. Most of the decisions under the previous Acts are of value, as many of the sections of the new Act of 1883, relating to designs, are, with more or less modifications, re-enactments of sections of the repealed Acts. As will appear in the course of this work, the analogy of patent and trade mark decisions will often help the elucidation of points which have not been directly decided with reference to designs.

Analogy of Patent and Trade Mark Law.

# CHAPTER II.

## MEANING OF "DESIGN."

What is a design?

Statutory definition.

REGISTRATION and protection are given by the Act only to Designs. The first question, therefore, which arises is, What is a design? That question has never been satisfactorily answered. Sect. 60 of the Act (*a*) of 1883, purporting to contain a definition of design, says: "In and for the purposes of this Act, '*design*' means any *design* applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, 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, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six)."

The definition in this section (which is taken from 5 & 6 Vict. c. 100, s. 3 (save that that section had the words "to the ornamenting of" in front of the words "any article of manufacture") (*b*)). As a definition it is singularly valueless, for it begins "a *design* is a *design* applicable, &c." In fact, there is no attempt to define the word design, but only a statement as to how far, for the purposes of this Act, the word is to be taken in its ordinary meaning. It seems an attempt to limit the Act to certain classes of designs, leaving the public to discover for themselves what a design is.

(*a*) Throughout this work whenever we speak of the Act or the Act of 1883, we mean the Patents, Designs, and Trade Marks Act of 1883, 46 & 47 Vict. c. 57.

(*b*) The 6 & 7 Vict. c. 65, extended the scope of the Registration of Design Act, 1842, to make it embrace designs having reference to some purpose of utility.

Still, from the meaning given to the word in dictionaries, from the definition clause, and from the statements of various Judges, it is possible to form some notion of what designs the designs portion of the Act of 1883 is intended to deal with.

Dictionary definitions of design.

The following are some of the definitions of the word 'design' given by the Dictionaries :—

*The Century Dictionary*, 1889.

A plan or outline in general; any representation or statement of the main parts or features of a projected thing or act.

Artistic invention in drawing or sculpture.

The arrangement or combination of the details of a picture or statue in an edifice.

*Ogilvie*, ed. 1883.

1. A plan or representation of a thing by an outline; sketch; general view; first idea represented by visible lines, as in painting or architecture.
2. The realization of an artistic idea; specifically, the emblematic or decorative figuring upon embroidery, medals, fabrics, and the like.

*Webster*, ed. 1882.

A preliminary sketch, a representation of the main features of something to be executed.

The realization of an inventive or decorative plan, emblematic or decorative figures, as of a medal, &c.

*Dr. Johnson*, ed. by Latham, 1866.

1. Intention, purpose, scheme, plan of action.
2. Idea which an artist endeavours to execute.

*Richardson*, 1836.

To mark out, to frame or form, and thus to form in the mind, to scheme or plan, to intend, to purpose, to project.

Limitations of word design.

From the section, however, it appears that the only designs to which the Act has reference are those designs which, applied by any means whatsover to any article or substance, affect the *pattern, shape, configuration or ornamentation* of that article or substance, and do not come within the protection of the Sculpture Copyright Act, 1814. This, as we have said, limits the classes of

designs to which the Act is applicable, but does not define design (*c*).

In *Harrison* v. *Taylor* (*d*), the Judges spoke of an ornamental design as "something in the nature of a drawing, picture, or diagram applicable to the ornamentation of some article of manufacture," and as "any diagram, drawing, or representation of something which a draughtsman has for the first time produced."

Design only for pattern, shape, configuration, ornament.

But whether a satisfactory definition is found or not, the scope of the Act is clearly enough defined—protection is given only to designs for pattern, shape, configuration, and ornament.

Lord Herschell says, in *Hecla Foundry Co.* v. *Walker* (*e*), "I quite agree with what was said by Lord Shand in *Walker* v. *Falkirk Iron Co.*, that 'the Act in this branch gives protection only to the shape or configuration or to the design for the shape or configuration, in such a case as the present. The result of such protection may be, however, to secure important advantages, such as attend a mechanical contrivance, if these advantages should be the result, directly or indirectly, of the shape or configuration adopted.' But this is a mere incident. If such advantages are obtained, it is only because no shape not substantially the same, and which is therefore not an infringement, will achieve the same end."

Advantages of design a mere incident.

No distinction now between ornamental and useful designs.

The design is not the article of manufacture, but that which is applied to the article of manufacture (*f*). The old distinction between ornamental and useful designs made in the earlier Designs Acts (*g*) is now done away with, and both classes of designs are now treated alike. Whether a design is or is not useful is an entirely immaterial question under this Act. Mere utility, in the absence of originality in shape, configuration, or pattern, will not suffice to support registration, though of course the fact that a useful purpose is served will not prevent the invention from being a design (*h*). This may be exemplified by a remark of Pollock, B.,

Utility immaterial.

(*c*) *Holdsworth* v. *McCrea* (1867), L. R. 2 H. L. 380; 36 L. J. Q. B. 297.

(*d*) (1859) 29 L. J. Ex. 3; 4 H. & N. 815; 5 Jur. N. S. 1219.

(*e*) (1889) 14 Ap. Ca. 550; 59 L. J. P. C. 46; 6 R. P. C. 554.

(*f*) 5 & 6 Vict. c. 100, and 6 & 7 Vict. c. 65.

(*g*) *Norton* v. *Nicholls*, 28 L. J. Q. B. 225; 33 L. T. 131; 7 W. R. 720; 1 E. & E. 761; *Walker* v. *Falkirk Iron Co.*, 4 R. P. C. 390.

(*h*) *Cooper* v. *Symington* (1893), 10 R. P. C. 264.

in *Moody* v. *Tree* (*i*): "Now there may be many things which might be said to answer both purposes. A man might register a design for a doorway made with bronze, and made with a figure of the Apollo Belvedere, that might or might not be better or worse than a doorway that had preceded it; but it would be foreign to the question altogether whether it was properly the subject-matter of a design, and whether it was new as a design under this Act, although it had none of those advantages. The only question then would be this: you must use your eye and say, looking at the figure or the design, whether it is new or it is not, and beyond that you cannot go."

Advantages immaterial.

That a design is also good subject-matter for a patent is immaterial to the inventor who desires to take advantage of the cheaper though more limited protection afforded by this branch of the Act (*k*). But he must remember that no mechanical contrivance or principle (*l*), no process of manufacture (*m*), can be a design (*n*). If any advantages such as attend a mechanical contrivance are obtained, the invention is a design only so far as the result is brought about by the shape (*o*).

A design may be registered though it be also subject-matter for a patent.

Again, it should be remembered that an effect is not a design, but only the combination which produces the effect (*p*). Hence it may be said a colour is not a design. On the other hand, a portion of an article may be a design (*q*), and a combination also may be a design (*r*).

What is not a design.

The following are the cases which illustrate the above:—

Illustrative cases.

*Margetson* v. *Wright* (*s*). The design claimed here was a "pro-

(*i*) (1892) 9 R. P. C. 333, 335; and see Lord McLaren in *Walker* v. *Falkirk Iron Co.*, 4 R. P. C. 392.

(*k*) *Rogers* v. *Driver* (1850), 20 L. J. Q. B. 31; 16 Q. B. 102; *Hecla Foundry Co.* v. *Walker*, 4 Ap. Ca. 550; *Millingen* v. *Picken* (1845), 14 L. J. C. P. 254; 1 C. B. 808.

(*l*) *Margetson* v. *Wright*, 2 De G. & Smale, 420; *Hecla Foundry Co.* v. *Walker* (*sup.*); *Cooper* v. *Symington* (1893), 10 R. P. C. 264.

(*m*) *Walker* v. *Falkirk Iron Co.*, 4 R. P. C. 390.

(*n*) *Moody* v. *Tree*, (1892) 9 R. P. C. 333.

(*o*) *Hecla Foundry Co.* v. *Walker* (*sup.*); *Walker* v. *Falkirk Iron Co.*, 4 R. P. C. 390.

(*p*) *Grafton* v. *Watson* (1884), 50 L. T. (N. S.) 420; 51 L. T. (N. S.) 141.

(*q*) *Walker* v. *Falkirk Iron Co.*, 4 R. P. C. 390.

(*r*) *Norton* v. *Nicholls* (*sup.*); *Grafton* v. *Watson* (*sup.*).

(*s*) 2 De G. & Sm. 420.

Eyelet-hole case.

tector label," *i.e.* one containing an eyelet hole lined with metal, but the Court pronounced against it, considering that there was nothing in the article depending on the shape or configuration. The application was for an interlocutory injunction.

Ventilating bricks case.

*Rogers* v. *Driver* (*t*) was a case relating to ventilating bricks, their novelty and utility consisting in their being so shaped that when laid together in building, a series of apertures were left in the interior of the wall, in consequence of which the air was more freely admitted through the wall, and a considerable saving in the number of bricks required was effected. It was submitted for the defendant that this was not a subject for registration as a design, but the Court (Patteson, Coleridge, Wightman and Erle, JJ.) upheld the registration, Wightman, J., saying that the novelty invented "is in the shape and configuration of an ancient manufacture called a brick."

Ventilator case.

This case contrasted with *The Queen* v. *Bessell* (*u*) (decided by three of the judges who decided the last case), enables the reader to form a good idea of the meaning of the term "design" as used in these Acts. The facts were as follows:—"The design registered consisted of an oblong pane of glass fixed in a metallic frame, which was inserted in an ordinary window frame, and hinged at the top so as to open to a greater or less extent by means of a straight screw, the head of which formed a pulley, over which were passed cords for the purpose of turning it, and so of either opening or shutting the ventilating pane. To prevent the downward draught of cold air consequent upon opening the ventilator, a half pane of glass was fixed in the lower portion of the frame in which the ventilating pane moved. The registration concluded thus, 'The part or parts of this design which are not new or original are all the parts taken *per se*, and apart from the purposes thereof. What is claimed as new is the general configuration and combination of the parts.' It was stated that the peculiar shape and configuration of these ventilators was new, and that no ventilator had before been made with such a shape or configuration.

One Dixon made a similar ventilator except that the pane was more nearly a square than an oblong, and the screw by which it was shut

(*t*) (1850) 20 L. J. Q. B. 31; 16 Q. B. 102.
(*u*) (1851) 20 L. J. M. C. 177; 16 Q. B. 810.

was curved instead of straight, and on trial the Court decided that the subject was not one for registration as a design. Patteson, J., said: (*x*)—"I do not profess to define what 'shape and configuration' is, but it certainly is not the same as a combination of parts. The design contemplated by the 6 & 7 Vict. c. 65, must be for a thing which has some particular shape which is productive of utility. The word 'configuration' can add very little to the idea conveyed by shape. It must be something visible to the eye. Now, there is here nothing peculiar or novel in the shape of the parts of this ventilator; but by putting them together and moving the screw by means of the cords, the window is opened in a more convenient manner than had been before done." Erle, J., said:—"The invention which is attempted to be protected is not within the meaning of the statute. It is a combination of means for the purpose of easily admitting air and avoiding a downward draught, and there is a skilful configuration to gain this end. The particular shape or configuration is wholly unimportant in producing that effect. A square or circular frame, or a straight or crooked screw, would produce exactly the same result. If the prosecutor does really show any configuration producing a useful result, then he fails in making out any infringement, because there is no doubt that the shape of the defendant's instrument varies materially from that registered, the one pane being nearly square and the other oblong, and the screw being straight in the one case and crooked in the other. What the prosecutor intended to protect was a combination producing a valuable result."

Basket case.

*Moody* v. *Tree* (*y*) is a later case. The design registered was for a picture of a basket, and underneath the basket was the statement "claim for pattern of a basket, consisting in the osiers being worked in singly, and all the but-ends being outside." The Divisional Court (Pollock and Vaughan Williams, JJ.) held that plaintiff had registered a process or mode of manufacture and not a design. Pollock, B. said "It appears to me to come to this:—that where you have a subject matter registered under the Designs Act as a design you have no right to enquire with reference to its utility, either *per se* or when compared with other designs which

(*x*) 20 L. J. M. C. 178.

(*y*) (1892) 9 R. P. C. 333.

have preceded it; because it is not the subject matter of a patent that is being discussed, but it is the subject matter of a design, and the Designs Act was intended to add to the Patent Act by making that which was not patentable the subject of a design. Now there may be many things which might be said to answer both purposes: A man might register a design for a doorway made with bronze, and made with a figure of the Apollo Belvedere, that might or might not be better or worse than a doorway that had preceded it; but it would be foreign to the question altogether whether it was properly the subject matter of a design, and whether it was new as a design under this Act, although it had none of those advantages. The only question then would be this: you must use your eye and say, looking at the figure or the design, whether it is new or it is not, and beyond that you cannot go." And Vaughan Williams, J., says, "In my view the design within the terms of that definition must be capable of an existence outside the article itself altogether. It must be something that one can apprehend and something which if one has it presented to one's eyes, one can see externally to the article to which it is to be applied or to which it is intended to be applied. If that view is right a mere mode of manufacture is not a design at all. It is not something which is capable of existence as a pattern, or as a shape or configuration, or as a piece of ornamentation to be applied to an article or class of articles."

Laced corset case.

In *Cooper* v. *Symington* (*z*) a laced corset was in question. The old laced corset had busks which were either sewn into the front of the corset or were laced in, so as to be easily removable by running lacing at the outer margin of the busks; in the former case the corset was sometimes fastened together by lacing the two inner margins of the busks, in the latter the means of fastening was by hooks and eyes. In the registered corset the busks were laced in and were thus easily removable, but the lacing was diagonal and was at the inner margin of the busks, and when closed this diagonal lacing gave the appearance of a corset being laced together, though the corset was really fastened by studs and clasps. The corsets when sold had placed on them a ticket with the words "new method for removing and re-fitting busks for

(*z*) (1893) 10 R. P. C. 264.

repairs, &c." Chitty, J., held that there was here no subject-matter for registration as a design.

*Walker, Hunter & Co.* v. *Falkirk Iron Co.* (*a*) is an important case. The registered design was for a "range fire-door with moulding on top, moulding forming part of range, shape to be registered." The fire-door was intended to fit into the range and the moulding on the top corresponded to and ran flush with the moulding on the front of the hob when the door was closed; the useful purpose was thus accomplished of closing the space between the hob-plate and the top of the fire-box. It was objected (1) the subject was one for a patent and not for registration, and (2) that the design was for a part of an article and not for a complete article, but both objections were over-ruled by Lord McLaren, and on appeal Lord Shand says:—"Now, it is quite true the subject of registration must not be an article of manufacture itself, but a design to be applied to an article of manufacture or substance for pattern, shape, or ornament, and also that the branch of the Statute which relates to the registration of designs does not afford or profess to afford protection to any mechanical principle or contrivance directly. The Act on this branch gives protection only to the shape or configuration, or to the design for the shape or configuration, in such a case as the present. The result of such protection may be, however, to secure important advantages such as attend a mechanical contrivance, if these advantages should be the result directly or indirectly of the shape or configuration adopted. Thus, in the present case, the new shape of fire-range door with the moulding as part of it has the particular advantages over the old shape of door which I have already noticed. These are not directly the subject of protection, but, inasmuch as they are dependent on and inseparable from the shape or configuration, they are indirectly secured by the registration of the design. It may be quite true that in place of registering the design for its shape and so gaining protection for a period of five years, the pursuers might rather have applied for Letters Patent and protection for the longer period of fourteen years for improvements in the manufacture of fire-doors for convertible fire-ranges, and have made not the mere shape but the mechanical action or contrivance

Range fire-door case.

(*a*) (1887) 4 R. P. C. 391.

the subject of protection by Letters Patent. But, assuming that such Letters Patent might have been obtained, and that there was novelty, not only sufficient to validate the registration of the design, but to create an effectual patent, this would not, in my opinion, lead to the result that the design was not a proper subject for registration." The other members of the Court (The Lord President, Lord Mure, and Lord Adam) agreed with him.

In *Hecla Foundry Co.* v. *Walker, Hunter & Co.* (*b*) the same subject came before the House of Lords. The same fire-door was in question. Lord Herschell, quoting with approval the above quoted remarks of Lord Shand, also said:—"By section 60 of the Patent and Designs Act of 1883, 'design' is defined as meaning any design applicable to any article of manufacture or to any substance, 'whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof.' In the present case the applicant declared that it was for 'the shape' that he desired registration. Under the Designs part of the Act of 1883, I do not think the object which the designer has in view in adopting the particular shape, or the useful purpose which the shape is intended to serve, or does serve, ought to be regarded in considering what is the design protected. The scheme of this part of the Act is entirely different from that relating to patents for inventions, where the object attained by the invention for which the patent is granted is, of course, very material to the inquiry what is its subject matter, and whether there has been an infringement. I cannot agree, therefore, that the registration was claimed, or could be claimed, 'not for the particular moulding' but for the form given by placing 'any suitable moulding' upon a fire-door in the described position, or that a privilege was granted 'for putting a moulding upon a fire-door in such a manner as to accomplish' a particular object. I think the protection was granted for the shape, and for that alone, and that in such a case, when an infringement is alleged, the only question is, whether the shape of that which is impeached is the same, or whether the one is an obvious imitation of the other, without reference to whether it does or does not accomplish the same useful end."

(*b*) (1889) 14 Ap. Ca. 550; 59 L. J. P. C. 46; 6 R. P. C. 554.

View of Westminster Abbey on spoons.

In *Saunders* v. *Wiel* (*c*) Cave, J., said:—"The design was one for the handles of spoons, and it purported to represent a particular view of Westminster Abbey. It was contended that that was not a design which could be registered. Section 60 of the Patents, Designs, and Trade Marks Act of 1883, defines a design as being a design applicable to any article of manufacture, or to any substance: 'Whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof.' Now this is a design of a spoon handle, which is applicable to the shape or configuration, and is undoubtedly for the ornament at the same time of the spoon, and I cannot see why such a design should not be registered. All the authorities appear to me to be in favour of the right to register it." And Lindley, L.J., says: (*d*)—"Now taking those two sections together, what we have to consider is this: Whether this registered design—for a design of some sort, of course, it is—is a design applicable for the pattern and for the shape to things in Class 1, and in particular forks and spoons, and whether it is a new or original design not previously published in the United Kingdom. Now, why is it not? Has such a design applicable to metals ever been seen before? If you ask that question, you are told this:—Yes, if you mean by design public buildings or if you mean cathedrals and churches, they are common enough: therefore, there is no novelty in the idea. But if you ask a little closer whether anybody has previously taken this particular aspect of Westminster Abbey and used it as a design applicable to things in Class 1 or to any things like it, the answer is 'No, that is new and never has been published before.' That answer seems to me to bring the plaintiffs' case within the Act of Parliament; and, I think, the answer to the argument adduced to us by Mr. Aston and Mr. Danckwertz is this: They go by steps and say the Abbey is not a design within the meaning of this Act of Parliament. In one sense, of course, it is a very valuable design. If an architect was thinking about building an abbey, having Westminster Abbey before him, it would be a very valuable design; but it is not a

(*c*) (1893) L. R. 1 Q. B. 470; 62 L. J. Q. B. 341; 9 R. P. C. 467 and 10 R. P. C. 29.

(*d*) 10 R. P. C. 32.

design within section 60 until you come to apply it as a design to some article of manufacture, and, therefore, you cannot say that abstractly, and as a general proposition, Westminster Abbey is a design. Then Mr. Aston says 'Well, but the photograph is.' The answer is the same. No, the photograph is not: until you apply it to something the photograph is not a design within this Act, whatever it may be in other Acts."

A photograph is not a design within the Acts.

# CHAPTER III.

## NOVELTY.

It is provided (*a*) that to qualify for registration a design must be "new and original and not previously published in the United Kingdom." A design which has been published is not novel; but the words are "new and original," coupled with the phrase "not previously published." It is clear that the invention of a design, kept secret, does not act as a bar to the registration of the same design by any subsequent independent inventor (*b*). What is requisite therefore to take a design out of the class of designs "new and original and not previously published" is that the same or substantially the same thing should have been produced previously in such manner as to become public property. In every case prior publication is fatal; previous invention uncommunicated to the public is not.

We shall therefore treat of the subject of Novelty here under the titles of—

(1.) "New and original," which involves the consideration of how far a given design is the same or substantially the same as other existing designs;
(2.) "Publication," which involves the consideration of what amount of publicity is in law sufficient to amount to previous publication.

In treating of these questions assistance can frequently be derived from patent law authorities.

(*a*) 1883, sect. 47 (1).
(*b*) See *Bentley* v. *Fleming*, (1844) 1 Car. & K. 587; *Lewis* v. *Marling*, (1829) 1 W. P. C. 493, 10 B. & C. 22.

## I. New and Original.

Whether any distinction was intended to be made between these terms does not seem clear. Manisty, J., on one occasion (*c*) used words which seemed to imply that he thought there was a difference in meaning between them. Speaking of a new combination of well-known parts, he said: "It was not what I think the Act of Parliament means by an original design—that is to say, suppose there had never been any ornamental tiles, and a designer had designed this very design—that would have been original." The matter does not seem to be very important.

Analogy of Patent Law not always to be followed.

In determining whether a given design is new and original, the cases on patents must not be followed too closely; there is no complete analogy in this respect between copyright in a design and in a patentable invention (*d*), and the Act will not be construed as strictly as in the case of patents (*d*). The rules relating to designs may be stated thus:—

The Novelty must be in the application of the Design.

1. The novelty required must be in the application of the design and not in the design itself—*i.e.* novelty in the idea is not necessary.

The leading case upon this point is *Saunders* v. *Wiel* (*e*). The facts were these: The plaintiffs registered a "pattern or shape of spoon or fork handle in metal." The registered design consisted of the shaft of a spoon, and on the top of it a representation of Westminster Abbey seen from a particular point of view; the two towers and the pinnacles were there, and the transept with buttresses. The design was copied from a photograph taken from a particular point of view. Cave, J., and the Court of Appeal decided in favour of the novelty of the design. Bowen, L.J., says (*f*): "The argument of Mr. Aston really does come to this, it seems to me, that what

(*c*) *Sherwood* v. *Decorative Art Tile Co.*, (1887) 4 R. P. C. 207, 209.

(*d*) *Harrison* v. *Taylor*, (1859) 29 L. J. Ex. 3, 4 H. & N. 815, 5 Jur. (N.S.) 1219; *Lazarus* v. *Charles*, (1873) 16 Eq. 117, 42 L. J. Ch. 507; *Moody* v. *Tree*, (1892) 9 R. P. C. 333, 334.

(*e*) (1892) 9 R. P. C. 467, 10 R. P. C. 29; (1893) 1 Q. B. 471; 62 L. J. Q. B. 341.

(*f*) 10 R. P. C. 33.

the Act requires is novelty in the idea itself. That is not the language of the section, in the first place. It is novelty or originality in the design: that is to say, in a combination calculated to produce a particular end—novelty in the way in which the idea is to be rendered applicable to some special subject-matter. . . . . You must regard it and test its novelty throughout as a novelty which is expected and demanded from a design which is intended to be applicable to an article of manufacture. When you get thus far, it is obvious, in the first place, that Westminster Abbey is not a design. The photograph is not a design. The photograph is that from which the design is taken, just as, if the step of the process of photography had been omitted, and the artist had gone straight to the Abbey, he would have made his design from the Abbey, but he would not have converted the Abbey into the design. It seems to me that the novelty and originality in the design, within this section, is not destroyed by its being taken from a source common to mankind, which was part of the ingenious argument of Mr. Aston. The novelty may consist in the applicability to the article of manufacture of a drawing or design which is taken from a source to which all the world may resort. Otherwise it would be impossible to take any natural or artistic object and to reduce it into a design applicable to an article of manufacture, without also having this consequence following, that you could not do it at all, in the first place, unless you were to alter the design so as not to represent exactly the original; otherwise, there would be no novelty in it because, it would be said, the thing which was taken was not new. You could not take a tree and put it on a spoon, unless you drew the tree in some shape in which a tree never grew; nor an elephant, unless you drew it and carved it of a kind which had never been seen. An illustration, it seems to me, that may be taken about this is what we all know as the Apostles' spoons. The figures of the Apostles are figures which have been embodied in sacred art for centuries, and there is nothing new in taking the figures of the Apostles, but the novelty of applying the figures of the Apostles to spoons was in contriving to design the Apostles' figures so that they should be applicable to that particular subject-matter. How does a public building differ from that? In no sense, it seems to me; and the photograph of a

public building does not differ. The answer to the whole case of the appellant is that it is not the natural object which is the design; that it is not the photograph which is the design. The novelty of the design consists in so contriving the copy or imitation of the figure, which itself may be common to the world, in such a manner as to render it applicable to an article of manufacture, and I think the learned Judge was quite right."

It is difficult to reconcile this with *Adams* v. *Clementson* (*g*), in which Malins, V.-C., held that a portrait of a well-known character, copied from a photograph, and applied as a design upon earthenware, was not a new and original design. This case was decided under 5 & 6 Vict. c. 100, and not under the present Act, but unless the wording of the former statute affected the result, it may be regarded as overruled. In any view, it can hardly be regarded any longer as an authority (*h*).

2. In the shape or configuration must be the novelty; a new method of appliance will not entitle a design to registration under sect. 47.

A new method of appliance will not be a novel design.

In *Cooper* v. *Symington* (*i*) it appeared that in corsets existent previous to the plaintiff's, busks were sewn in the front of the corset or were laced in, so as to be easily removable by running lacing at the outer margin of the busks. In the former case the corset was sometimes fastened by lacing together the two inner margins of the busks, in the latter the corset was fastened by hooks and eyes. In the plaintiff's corset the busks were laced in and thus easily removable, but the lacing was diagonal and was at the inner margin of the busks, and when closed this diagonal lacing gave the appearance of the corset being laced together, though the corset was really fastened by hooks and studs. Chitty, J., held that there was no difference in appearance and shape between the old and the plaintiff's corset, and that there was no novelty in the design sufficient to justify registration. The utility of the invention is not to be regarded (*k*); though the standard of originality to

(*g*) (1879) 12 Ch. Div. 714; 27 W. R. 379.

(*h*) See Bowen, L.J., in *Saunders* v. *Wiel, supra.*

(*i*) (1893) 10 R. P. C. 264. And see *Moody* v. *Tree,* (1892) 9 R. P. C. 333.

(*k*) *Moody* v. *Tree, supra.* But see *Tyler* v. *Sharpe,* (1893) 11 R. P. C. 35.

which an inventor must attain in order to get legal protection is in no case a high one (*l*).

Novelty means Substantial Difference from what has gone before.

3. A design is not novel unless it be substantially different to what has been produced before, having in view the purpose to which it is to be applied. This has been laid down in many cases.

"Tandem Collar" case.

Take, for example, *Le May* v. *Welch* (*m*). In that case, for a design known as the "Tandem Collar," it was claimed that there were these advantages: the height of the collar above the stud, the absence of a band, and the cutting away of the corners in segment shape, thus giving the neck greater freedom. In other collars produced these characteristics were to be found, though there were differences in the proportions of the several parts. The design was declared unfit for registration. Bowen, L.J., said: "It is not every mere difference of cut, every change of outline, every change of length, or breadth, or configuration, in a simple and most familiar article of dress like this, which constitutes novelty of design. To hold that would be to paralyse industry and to make the Patents, Designs, and Trade-marks Act a trap to catch honest traders. It cannot be said that there is a new design every time a coat or waistcoat is made with a different slope or a different number of buttons. Tailoring would become impossible if such were the law, and it does not appear to me that such is the law. There must be, not a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article." And Fry, L.J., says: "It has been suggested that unless a design precisely similar, and in fact identical, has been used or been in existence prior to the Act, the design will be novel or original. Such a conclusion would be a very serious and alarming one, when it is borne in mind that the Act may be applied to every possible thing which is the subject of human industry, and not only to articles made by manufacturers, but to those made by families for their own use. It appears to me that such a mode of interpreting the Act would be highly unreasonable, and that the meaning of the words 'novel or original' is this:

(*l*) See per Lord McLaren in *Walker* v. *Falkirk Iron Co.*, (1887) 4 R. P. C. 391.

(*m*) (1884) 28 Ch. Div. 24, where diagrams of the collars will be found; 54 L. J. Ch. 279; 51 L. T. (N. S.) 867; 33 W. R. 33.

that the design must either be substantially novel or substantially original, having regard to the nature and character of the subject-matter to which it is to be applied."

This case has been followed in *Smith* v. *Hope* (*n*) (a case relating to a design for scarves), and it is in accordance with *Windover* v. *Smith* (*o*), *Smout* v. *Slaymaker* (*p*), *Lazarus* v. *Charles* (*q*), and *McCrea* v. *Holdsworth* (*r*).

*McCrea* v. *Holdsworth* (*r*) was a case relating to infringement, but the principle is in point, viz., that a design to all appearance the same is not novel, though it may not be identical. Lord Hatherley, L.C., said: "If the designs are used in exactly the same manner, as I hold they are in this case, and have the same effect, or nearly the same effect, then of course the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the defendants from the consequence of their piracy."

If a slight difference in design were sufficient to entitle the inventor to registration, the advantages of the Act would be to a considerable extent lost; for the same principle on which it is determined whether there is or is not novelty, must be appealed to to settle whether an alleged infringement is or is not in fact an imitation.

Novel Combinations.

4. It is not necessary that every part of which the design is made up shall be new; a combination of known things may produce a new and original design. But the combination itself must be new; two old designs may be combined, but if combined in the old way, there is no novelty. The cases upon which this proposition is founded are:—

Honeycomb pattern case.

*Harrison* v. *Taylor* (*s*). It appeared that a well-known pattern, called the honeycomb pattern, consisted of a certain cellular arrangement of the surface in cells of a uniform size; and the plaintiff designed a pattern in which large and small honeycomb cells were arranged so that a border of the larger cells surrounded

(*n*) (1889) 6 R. P. C. 200.
(*o*) (1863) 32 L. J. Ch. 561; 32 Beav. 200.
(*p*) (1890) 7 R. P. C. 90.
(*q*) (1873) 16 Eq. 117; 42 L. J. Ch. 507.
(*r*) (1870) L. R. 6 Ch. App. 418; 23 L. T. (N. S.) 444.
(*s*) (1859) 29 L. J. Ex. 3, 4 H. & N. 815, 5 Jur. (N.S.) 1219.

an enclosed portion of the smaller cells; the jury found that the design was new and original; the Court of Exchequer set aside the verdict, but the Exchequer Chamber restored it. Wightman, J., said: "It is true all the component parts of it were old, but as to the drawing itself, no one had produced such a pattern as that before. It was said by one of the learned Judges of the Court below, that the constituent parts of it were old, and the novelty was only in the arrangement or combination. Why? A picture which contains within it a novel combination of old parts is a new drawing; and it seems to me, if no one else has ever combined them in the same manner, it would be a new design within the protection of this Act of Parliament. In my opinion, it was a question for the jury, whether substantially this was a new and original design."

Combination of two old designs held good.

*R.* v. *Firmin* (*t*). A button was made with the Royal Arms on it surrounded with a garter bearing the inscription "The Royal Mail Steam Packet Co.;" the simultaneously applying two old and known designs to the ornamentation of a button was declared to be a novelty. Coleridge, J., suggested (by way of example) that if a button were made with a picture of a jockey upon it, and another with the picture of a horse, a third with the pictures of the horse and jockey combined would make a new design.

Design in shawls case.

In *Norton* v. *Nicholls* (*u*) a design in shawls was in dispute, and the jury found that whilst each of the elements of the plaintiff's shawl was old the combination was new. Lord Campbell said: "We do not doubt that combination may be a 'design' within the meaning of the statute, and we adhere to the decision of this Court in *R.* v. *Firmin*, 'that a new and original combination to be protected as a design may be the result of simultaneously applying two old and known designs to the ornamenting of a button.' But, having regard to the language of the Act of Parliament and to the object of the Legislature, we think that the result of the combination to be protected as a design must be one design, and not a multiplicity of designs."

These decisions were under consideration in *Lazarus* v.

(*t*) 3 H. & N. 304 (n.); 15 J. P. 570.

(*u*) (1859) 28 L. J. Q. B. 225; 33 L. T. O. S. 131; 7 W. R. 420; 5 Jur. N. S. 1203; 1 E. & E. 761.

Double card-basket case.

*Charles* (*x*). The design in that case consisted of a double card basket, formed of a combination of two baskets, admitted to be separately old in design; and Malins, V.-C., refused to allow that there was any novelty justifying registration. *Harrison* v. *Taylor* (*y*) and *R.* v. *Firmin* (*z*) were cited, but the Vice-Chancellor considered that the facts were distinguishable, and he expressed himself reluctant to follow those cases unless "something novel were introduced in the combination." He preferred the decision in *Mulloney* v. *Stevens* (*a*), in the course of which Wood, V.-C., refused an interlocutory injunction on the ground that it was too doubtful whether the mere union of old designs by a button is a new and original design. And it is to be noted that the decision in *Harrison* v. *Taylor* was in reality but the decision of the jury. It is submitted, on the whole, that the proposition stated above represents the state of the law on this part of the question (*aa*).

Novelty is to be decided by the eye.

5. Novelty is a matter of fact (*b*). Ultimately it is to be decided by appeal to the eye. This has been stated over and over again, and reference may be made to the cases in the footnote (*c*). The Court may receive assistance from experts in this matter; in fact, though the opinion is formed from the eyesight, it must be, if necessary, from expert eyesight (*d*). The utility of the invention is not to be regarded (*e*), nor need the design have artistic merit (*f*).

(*x*) (1873) 16 Eq. 117.

(*y*) *Supra.* (*z*) *Supra.*

(*a*) (1864) 10 L. T. (N. S.) 190.

(*aa*) And see remarks of Chitty, J., in *In re Plackett's Design*, (1891) 9 R. P. C. 436; of Day, J., in *Heinrichs* v. *Bastendorff*, (1893) 10 R. P. C. 160. In *Hothersall* v. *Moore*, (1892) 9 R. P. C. 27, Bristowe, V.-C., gave an important judgment, in which all the cases are reviewed.

(*b*) *Harrison* v. *Taylor*, (1859) 29 L. J. Ex. 3; 4 H. & N. 815; 5 Jur. N. S. 1219.

(*c*) *Demartial* v. *Booth*, (1892) 9 R. P. C. 499; *Le May* v. *Welch*, *supra*; *Harrison* v. *Taylor*, *supra*; *Tyler* v. *Sharpe*, (1893) 11 R. P. C. 35; *Re Bach's Design*, 42 Ch. Div. 661; 6 R. P. C. 376; *Hecla Foundry Co.* v. *Walker*, (1889) 14 A. C. 550; *Re Plackett's Design*, (1892) 9 R. P. C. 436; *Moody* v. *Tree*, 9 R. P. C. 333.

(*d*) *Cooper* v. *Symington*, 10 R. P. C. 264; *Harrison* v. *Taylor*, *supra*; *Grafton* v. *Watson*, 50 L. T. (N.S.) 420.

(*e*) *Hecla Foundry Co.* v. *Walker.* (1889) 14 A. C. 550, 556; 6 R. P. C. 554; *Moody* v. *Tree*, *ubi supra.* But see *Tyler* v. *Sharpe*, 11 R. P. C. 35, a difficult case to understand.

(*f*) *Walker* v. *Falkirk Iron Co.*, (1887) 4 R. P. C. 390.

Application of old design to new substance not new and original.

6. If the design be old, its application to a new substance will not cause it to be a novelty.

In *Re Bach's Design* (*g*) a lamp shade made of china in the shape of a rose was registered in one class; a design for a lamp shade made of linen, also in the shape of a rose, had previously been registered in another class, and Kekewich, J., decided that, though the materials were different, there was no novelty in the china design (*h*).

Anticipation by Registration in a different class.

Further, if the design has already been registered in one class, registration of a similar design will not acquire the quality of novelty merely by registration in another class. Thus in *Re Read & Greswell's Design* (*i*) T. registered a design for the pattern and shape of a flower candle shade in imitation of a chrysanthemum in Class V. (articles composed of paper); subsequently R. & G. registered in Class XII. (general) a similar design. Chitty, J., said that R. & G.'s design was not new and original, and added: "The respondents' design is registered in Class XII., which is for goods not included in the other classes, and it is argued on their behalf that although their design may not by itself be new and original, yet that it is so within the meaning of sect. 47 of the Act. That argument comes to this, that where a new and original design is registered in one class, a rival designer is at liberty to take the design and transfer it bodily to another class, and register it in that class, or, if it be on the register, may maintain it there. I do not think this argument can be sustained. I suggested the case of a design registered for jewellery, and another trader finding this to be so, and that articles marked with such design were being put on the market, and people were becoming generally acquainted with the design, taking this design and registering it in some other class of goods, such as glass (Class IV.) or lace (Class IX.), a thing which in the case of many designs might easily be done. I am satisfied that it was not the intention of the Legislature to allow this to be done. The answer to the argument is to be found really in sect. 47 of the Act, where the words used are: 'Any new

(*g*) (1889) 42 Ch. Div. 661; 6 R. P. C. 376.
(*h*) And see *Mulloney* v. *Stevens*, (1864) 10 L. T. (N.S.) 190.
(*i*) (1889) 42 Ch. Div. 260; 58 L. J. Ch. 624; 61 L. T. 450; 6 R. P. C. 471. And see *Mulloney* v. *Stevens*, 10 L. T. (N.S.) 190.

or original design not previously published in the United Kingdom.' To be capable of being registered a design must be 'new or original' in fact, and not, as is suggested, 'new or original' as to some particular class of goods. It cannot be said to be new and original if it is already being applied to articles of an analogous character."

Previous application of a design in an analogous manner.

But these cases must be distinguished from *Walker* v. *Falkirk Iron Co.* (*k*). There a design was registered "for a fire-range door with moulding on the top, moulding forming part of range, shape to be registered." Lord Mure, expressing agreement with the other members of the Court who upheld the novelty of the design, said: "Now I think there is evidence to show that such a door as this was not unknown before in certain kinds of doors, but I am quite clear upon the evidence that it was new as applied to kitchen ranges." In *Bach's case* the old design was simply copied in a different material: in *Walker* v. *Falkirk Iron Co.* it was applied to a different purpose, making of the whole a new article.

## II. Publication.

### (a.) *By Prior User.*

Meaning of prior user.

When a design has been exhibited or publicly used, it is, as a general rule, no longer a subject for valid registration. Prior user means, not user by the public, but user in public (*l*); and it means a user other than a mere experimental user.

The decisions upon this branch of the subject are to be found mainly in cases dealing with patent disputes, but the principles therein laid down apply *mutatis mutandis* to designs. But where the validity of a patent is in dispute, it may sometimes be argued, that though used in public, knowledge of the invention does not necessarily become public property, as the means whereby the results are produced are not discoverable by mere inspection; such an argument cannot from the nature of the subject be used in a case relating to designs, and therefore decisions dealing with that part of patent law need not be dealt with here.

(*k*) (1887) 4 R. P. C. 390.
(*l*) See (e.g.) *Croysdale* v. *Fischer*, (1884) 1 R. P. C. 17.

The subject is illustrated in the following cases :— Cases on prior user.

*Smout* v. *Slaymaker* (*m*). On 26th April, 1887, Smout registered a design being a pattern of a fire-screen, made of palm leaves, to hold a flower-pot; the design consisted of three palm leaves tied together in the form of the ace of clubs; it was proved that fire-screens identical with Smout's design had been exhibited at an exhibition and also sold in Covent Garden before 1887; the design was ordered to be expunged from the register. Exhibition and sale.

*In the Matter of Sherwood's Design* (*n*). On 10th November a firm of manufacturers exhibited to a customer a new globe for a lamp stove, and afterwards supplied two new globes, which the customer exhibited on 17th November in his shop window; the globes had slip fittings. On 20th November the firm registered the design of the globe, but substituted a flange at the base instead of the slip fittings. Chitty, J., held that substitution was not a novelty, and that the publication before 20th November was fatal to due registration on that date.

*The Lifeboat Co. Limited* v. *Chambers Bros. & Co.* (*o*). Letters patent for a boat specially useful for lifeboat purposes were granted in November, 1887; it appeared that the boat had been exhibited before that date at one of the shipbuilding-yards at Glasgow, at the Royal Albert Docks, London, and at Portsmouth; invitations to the exhibition had been issued, and accounts of the exhibition appeared in the public press. No precautions were taken to ensure secrecy. Held (in the Court of Session in Scotland) that the invention had been used in public, and that the patent was bad.

The prior user is sufficient to avoid subsequent registration if it enabled the public to become acquainted with the design, a result which it seems must follow whenever a design is used or exhibited, for with the exhibition of a design every detail of it as a design may become known even to an unskilled person. Prior user sufficient to acquaint public with design.

Whether the public have seen the invention or not seems unimportant; the point is, was it so used that it might have been publicly seen? In *Carpenter* v. *Smith* (*p*) a patent had been taken out for a new lock; a similar lock had been used on a

(*m*) 7 R. P. C. 90.
(*n*) (1892) 9 R. P. C. 268.
(*o*) (1891) 8 R. P. C. 418.
(*p*) (1841) 11 L. J. Ex. 213; 9 M. & W. 300; 1 W. P. C. 530.

certain gate in a public place for over sixteen years, and Lord Abinger, C.B., laid it down to the jury that the use of a lock in such a situation that the public might see it, is a public use and exercise of the invention sufficient to avoid registration of the alleged new lock. This particular decision seems far fetched. But the same general principle appears to be applicable to designs.

User in public.

*Stead* v. *Williams* (*q*) will further illustrate the statement that user in public is publication. In that case an invention for paving was in question, and it appeared that a pavement, said to be similar to the one in question, had been laid down in a small covered-in portico, a porch to the private house of Sir William Worsley. If the pavement so laid down had been found to be the same as that for which the patent was claimed, the patent would have been avoided by previous user. Cresswell, J., said: "I should say, in point of law, that makes an end of the patent, because that appears to have been introduced by Sir William Worsley, or to have been used by him in public—not concealed—no secrecy about it—made known to all persons who came to his house, so far as their ocular inspection could make them. It was intended to be public, not to be made a matter of merchandise certainly, but merely for his own private use; but the knowledge of it exposed to the public an article in public use, and continued to be used down to the time in question. Therefore, if you think that is the same thing in substance as that which the plaintiff claims, I think that it was publicly used before, and that he cannot have his patent. Whether it had been used by one or used by five, I do not think it makes any difference. If I am wrong in that respect, I have stated my opinion distinctly, and that may be corrected. I know that it has been matter of much controversy, whether that is so or not. I have seen some very sensible observations upon the subject, perhaps not altogether corresponding with the view I now take of it; but however, that is my opinion, that if you think that pavement made by Sir William Worsley is substantially the same thing as the plaintiff's, then your verdict should be for the defendants upon that issue" (*r*).

Pavement in private house.

(*q*) (1843) 2 W. P. C. 126, 136.

(*r*) A new trial was afterwards directed, but the principles stated in the above extract were not impugned. And see *Stead* v. *Anderson*, (1846) 2 W. P. C. 147.

Machinery used at works.

In *Re Adamson's Patent* (*s*) a contractor, engaged in the erection of a pier, used certain newly-invented machinery on the works for several months before applying for a patent, and during such user it was open to the view of the public; the Lord Chancellor decided that the invention had been publicly used, and refused a patent. Other examples of publication by user would be offering the article for sale (*t*), or making it in this country for exportation (*u*). In *Brereton* v. *Jackson* (*x*) a patent had been taken out for an improved tricycle; one witness stated that prior to the date of the patent he had ridden an identical machine in the public thoroughfare as far as Cheam, Coombe, and Malden, and had used it by day and night; Field, J., decided that there had been prior publication by user.

Tricycle ridden on public thoroughfare.

Abandoned user.

Use of an invention invalidates a subsequent patent, though the original user has been abandoned (*y*). Experimental user, though made in the presence of others than the inventor, and though continued up to the date of the patent, does not ordinarily amount to publication (*z*), and the coincidence of experiment with actual immediate profit is not *per se* sufficient to make the experimental user a publication (*a*).

Experimental user.

Experimental user with profit.

Use and manufacture in a workshop will or will not be publication, according to circumstances, depending mainly on whether the manufacture is carried on with secrecy or not: see *Bentley* v. *Fleming* (*b*), *Humpherson* v. *Syer* (*c*), and *Westley* v. *Perkes* (*d*).

User beyond the United Kingdom does not affect subsequent registration (*e*).

(*s*) (1856) 25 L. J. Ch. 456.

(*t*) *Oxley* v. *Holden*, (1860) 30 L. J. C. P. 68; 8 C. B. (N.S.) 666; *Hancock* v. *Somervell*, (1851) 37 Newton London Journal, 158.

(*u*) *Carpenter* v. *Smith*, (1841) 11 L. J. Ex. 213; 9 M. & W. 300; 1 W. P. C. 530, 536.

(*x*) (1884) 1 R. P. C. 165.

(*y*) *Household Co.* v. *Neilson*, (1843) 1 W. P. C. 700, 709.

(*z*) See *Cornish* v. *Keene*, (1835) 6 L. J. C. P. 225; 1 W. P. C. 508; *Jones* v. *Pearce*, 1 W. P. C. 122; *Household Co.* v. *Neilson*, (1843) 1 W. P. C. 673, 708; *Adamson's Patent*, (1856) 25 L. J. Ch. 456.

(*a*) *Newall* v. *Elliott*, (1858) 27 L. J. C. P. 337; 4 C. B. (N.S.) 293.

(*b*) 1 C. & K. 587.

(*c*) (1887) 4 R. P. C. 407.

(*d*) (1893) 10 R. P. C. 181.

(*e*) Act of 1883, sect. 47 (1). And see *Browne* v. *Annandale*, (1842) 1 W. P.

### (b.) *Publication in Books and Documents or to Individuals.*

Prior user only one form of publication.

Whilst a design may be unfit for registration because it has been previously used, it does not follow that every design can be registered merely if it has never yet been used. Publication in the United Kingdom without user is amply sufficient to make it impossible that the design should be validly registered. In the analogous case of patents this is so (*f*), and with regard to designs, this is expressly provided by sect. 47, sub-sect. (1).

Difference between publication by user and publication in books.

*Publication in Books.*—The meaning of "publication" must be obtained from the decided cases, and, for this purpose, those relating to patents may be referred to. Publication by prior user differs from publication in books, documents, &c. In the former case user in public alone is publication; in the latter, the publication must not only be such that the public (*i.e.*, a sufficient portion of the public (*i*)) may acquire the knowledge, but such that the design actually becomes part of the public knowledge (*k*). In the ordinary case of a description in a book published in England, it will be assumed that it comes to the public knowledge (*l*). In *Stead* v. *Williams* (*m*) Tindal, C.J., said, if published in England, "the publication makes the patent bad, but in each case publication is a question of fact—the existence of a single copy of a work, though printed, brought from a depository, where it has long been kept in a state of obscurity, would afford a very different inference from the production of an Encyclopædia or other work in general circulation. The question would be whether, upon the whole

Book published in England. Publication always a question of fact.

C. 433; *Rolls* v. *Isaacs*, (1878) 19 Ch. D. 268; 51 L. J. Ch. 170. But see *Lazarus* v. *Charles*, (1873) 16 Eq. 117, 122; 42 L. J. Ch. 507.

(*f*) *Patterson* v. *Gas Light and Coke Co.*, (1875) 3 A. C. 239; 47 L. J. Ch. 402.

(*i*) *Plimpton* v. *Spiller*, (1877) 6 Ch. Div. 412; 47 L. J. Ch. 212; *Plimpton* v. *Malcolmson*, *infra*.

(*k*) *Per* Pollock, B., in *Croysdale* v. *Fisher*, 1 R. P. C. 17. And see *Plimpton* v. *Malcolmson*, (1875–6) 3 Ch. Div. 531; 44 L. J. Ch. 257; mere lapse of time since the inventor made the design will be no bar to registration, provided it has not been published, *Bentley* v. *Fleming*, 1 Car. & K. 587.

(*l*) *Plimpton* v. *Malcolmson*, *supra*.

(*m*) (1843) 2 W. P. C. 126; 7 M. & G. 818; and see *Stead* v. *Anderson*, (1846) 2 W. P. C. 147.

evidence, there has been such a publication as to make the description a part of the public stock of information."

Publication in a book then will be publication sufficient to invalidate the registration of a design, *e.g.*, where the design has previously been described in an English book open to the world (*n*). Thus an alleged invention published in *Emerson's* book on Mechanics before the date of the patent obtained for it, was decided to be not patentable (*o*). The following cases may be referred to :—

Illustrative cases.

Four copies of a French book sold, one to librarian, held publication.

*Lang* v. *Gisborne* (*p*).—A book was written in French, and it appeared that in England four copies at least had been sold, one of them being to the librarian of the University Library, Cambridge. It was decided that the contents of that book had been published in England, so that the information contained in it had become common property. Sir John Romilly, M.R., said that, "a publication, however, takes place when a person who is the inventor of any new discovery, either by himself or by his agents, makes a written description of that, prints it in a book and sends it to a bookseller to be published in this country. It is not at all necessary to establish the fact that one volume of that book has been sold; as soon as an inventor informs the public of what his invention is and publishes that in a book, which he sends to a publisher to sell, the moment that book is exposed in the shop for the purpose of purchase, then that becomes a complete publication in point of law. I wish to state it as broadly as I can because, in case this matter should go further, it is desirable that there should be no ambiguity as to my opinion with respect to the law. That would be the effect if it were the publication of a book in England by an English inventor, and there is no difference when the inventor is a Frenchman or any other foreigner who publishes a book in his own language, but sends it over to a bookseller in this country for the purpose of being sold. As soon as the book comes to this country to be sold, and is offered for sale in the public shop of a bookseller,

Offer of books for sale in a public shop said to be publication *per* Romilly, M.R.

(*n*) *Cornish* v. *Keene*, (1835) 6 L. J. C. P. 225; 1 W. P. C. 508.

(*o*) *Rex* v. *Arkwright*, (1785) 1 W. P. C. 64; 1 Carp. P. C. 53; and see *Jones* v. *Berger*, (1843) 12 L. J. C. P. 179; 1 W. P. C. 544; *Harris* v. *Rothwell*, (1887) 35 Ch. Div. 416; 56 L. J. Ch. 459; 4 R. P. C. 225; *Stead* v. *Anderson*, 2 W. P. C. 151.

(*p*) (1862) 31 L. J. Ch. 769; 31 Beav. 133.

then that becomes a publication of the invention, assuming it to be a clear and accurate description of the invention in question. It would be impossible to arrive at any other result without producing the most inextricable difficulties in law. It would be difficult to ascertain how many persons had bought the book, though the purchase of the book would be nothing if they had not read the contents. It would be impossible to say to how many persons the purchaser had lent it, who had read it. In the present case it has been proved that a public library in one of the large universities in England had actually bought the book. It may be that a thousand persons had read it and considered it before this invention had taken place: but how can that by possibility be proved? The Courts would be involved in inextricable difficulty if the burthen of proof were thrown on a person who had made public an invention as far as he was able to make it public, to shew that the public themselves had appreciated it by buying the book or making it common to other persons."

In *Plimpton* v. *Malcolmson* (*q*), a book was deposited in the Patent Office library on 20 July, 1865, but in what part was unknown, and it was not catalogued nor entered in the list of donations. It was then taken to a private room and remained untouched, unread, and unlooked at till 1875. Jessel, M.R., held that the contents had not been published up to 1875. He said, "The case goes to this, that a book must be made public to such an extent as to be generally known among persons practising in such matters. It is, therefore, not merely publication, though, as a general rule, according to the *Household Coal and Iron Co.* v. *Neilson* (1 Webs. P. R. 673, 718, n.), when you say a book is published, and nobody contests it, you assume that several copies have been printed and circulated, unless somebody asserts the contrary. But, as regards the law, you must go a step further. Does that doctrine, therefore, apply to a case of this kind? There is one copy of the book which is all that has ever been printed or published, and that copy of the book was always kept in the back-parlour of the bookseller's shop, and never was seen, as far as the evidence went. Would that satisfy the doctrine? Clearly not. Even although a book was published, and, in the technical sense,

What amounts to publication in a book, *per* Jessel, M.R.

(*q*) (1876) 3 Ch. Div. 531; 44 L. J. Ch. 257.

published in England, it does not satisfy the conditions; it has not become part of the public knowledge; it is not knowledge in the possession of the public. And, therefore, if in the cases I have cited the patentee had given evidence to shew that the day after the publication in England of 500 copies, 499 had been destroyed, and the remaining one had been put aside by the bookseller in his back-parlour, and never circulated, though if somebody had asked him he would have been willing to sell the book, I am satisfied, from what I have read of the opinion of those learned Judges, they would all have decided that that was not made publicly known, so as to be part of the public possession and part of the public knowledge."

Referring to *Lang* v. *Gisborne* (*qq*), he says: "Suppose the bookseller had put one volume in his shop-window as exposed for sale for one day, and the next day by direction of the author, destroyed all the volumes, that would not do, and I do not think that Lord Romilly intended that it would. These are general observations, not to be read in that strict literal sense, but in this sense: that, if a man publishes a book, that is a large number of copies, and sends them to booksellers for sale, and they are, for a reasonable time, exposed in the window, so that you may infer the people have known and seen them, and may reasonably so infer, though you do not prove one has been sold—if the other side cannot prove that one has not been sold, you may reasonably infer that some of those books have been sold. If he means anything more than that, I humbly dissent from it; and I say that my decision is supported by the previous decisions to which I have referred, because I am clear that, if it were shewn that no copy had ever got into the hands of the public, and the public knew no more about it than seeing the back of the book in the bookseller's window, and every copy could be accounted for, and that none had been sold though exposed for sale, that would not be a sufficient publication to avoid a subsequent patent."

Book held not to be accessible to public.

*Plimpton* v. *Spiller* (*r*). The facts in this case were similar to those in the last-named: but in addition it was shewn that a sub-librarian had seen the book in a corridor open to the public leading into the public room of the old Patent library. When

(*qq*) 31 L. J. Ch. 769.
(*r*) (1877) 6 Ch. Div. 412; 47 L. J. Ch. 212.

the new Patent Office library was opened, the book was placed in a room upstairs, and not in the principal room. The Court of Appeal decided that the book had never been published in any sense in which it could be construed to be accessible to the public. James, L.J., said: "I should, if it were necessary, desire much further time to consider whether, even if it were proved that the book, one copy of which had been sent over as a present from a gentleman in America, was on the shelf in the library between the 20th of July and the 25th of August, that would be a sufficient publication, and would be such an addition to the stock of common knowledge in this country as would have prevented a man from being the first and true inventor of this patent; such an addition to the stock of common knowledge as a man was not entitled (to use the language of one of the cases) to deprive the public of." And Brett, L.J., says: "I cannot agree with Mr. Davey when he says that it is sufficient to shew that the thing has been printed in a book, and that the book has been so placed that it might have been known to the public. It must be not only printed in a book, but that book must be placed in such a position and so used that you may fairly infer or assume that the contents of the book have become known to a sufficient number of people. Therefore, when you prove that this book was put in the Patent Library, I care not into what part, I do not say that is no evidence of its having become known to the public, but I say that when you have other facts which shew that although it was put into the Patent Library the proper inference is that nobody ever did see it there or elsewhere, then, although it has been in one sense, if you please, published, or in one sense, if you please, intended to be dedicated to the public, all I can say is that the public have not been able to take advantage of the dedication or the publication, and therefore you do not shew that it was known to the public."

*Otto* v. *Steel* (*s*). One copy of a French treatise was placed in the British Museum library in 1863, and that one copy was the only one proved to be in England prior to 1876. The catalogue referred to it, and it was placed in its proper place in the library. Readers would find the book in the catalogue only under the author's name,

(*s*) (1885–6) 31 Ch. Div. 241; 55 L. J. Ch. 196; 3 R. P. C. 109.

and it was not placed in a part of the library where they could get at it without special assistance. Pearson, J. refused to find that the book had been published in such a manner that there was a reasonable probability that any person might have obtained knowledge from it, and, therefore, that the presence of the book in the Museum did not invalidate a patent granted in 1876 (*t*).

Book in British Museum and catalogued.

*Harris* v. *Rothwell* (*u*). Two specifications in German of German patents were deposited in the Patent Office library some two years before a patent for making the same article was granted in England. Entries of such specifications were duly published in the *Patents Journal* amongst German Patents, and described, a footnote stating that they might be consulted at the Patent Office library. The Court of Appeal, affirming Chitty, J., held, that the German patent had been published in England, and that the subsequent patent was therefore bad. Cotton and Lindley, L.JJ., were of opinion that had the existence of the description of the prior invention been unknown, the invention could not be said to have been previously published, and distinguished the present case from those above-named, as in the *Plimpton* cases the book was not known to be in the Patent Office library, nor in the *Otto* case was it known to be in the Museum library. Lopes, L.J., said: "Can the plaintiff's assignor be said to have increased the stock of human knowledge, to have given the public any information which they did not previously possess if, at the time of filing his specification, there existed in the library of the Patent Office, unreservedly open to the public, specifications describing in identical terms the same invention? The public were then possessed of the information contained in the plaintiff's patent; it was on the shelves of their public library—a library in the Patent Office—the place of all others devoted to information relating to inventions; the place to which anyone wanting information on such subjects would resort. Why should the public be precluded from the right of using the information of which they were then in possession? I think

German specifications at the Patent Office.

(*t*) And see *Heurteloup's Patent*, (1836) 1 W. P. C. 553. If a book is in the British Museum, is there a presumption that it has been read? Probably not. *Otto* v. *Steel*, 31 Ch. Div. 245; but see Jessel, M.R., in *Plimpton* v. *Malcolmson*, 3 Ch. Div. 560.

(*u*) (1887) 35 Ch. Div. 416, 56 L. J. Ch. 459, 4 R. P. C. 225.

directly the German specifications were deposited in the library of the Patent Office, and because unreservedly accessible to the public, there was a complete publication of the invention in this country, and it became the property of the public. If this case had been tried at Nisi Prius, and the defendant had given evidence of the deposit of these German specifications in the library at the Patent Office in the way mentioned in this case, I think the Judge should have at once told the jury that the evidence of prior publication, if they believed it, was conclusive, and they must find accordingly. In my opinion the depositing the specifications in the library of the Patent Office in the way described was itself a publication of the invention contained in them, and I think that the invention was then dedicated to and became the property of the public."

**Other cases of books in foreign language.**

Some questions may arise when the book is published in a foreign language. In the cases of *Lang* v. *Gisborne* (*x*) and *Otto* v. *Steel* (*y*) the publication was in French, but no point arose upon that. The same may be said of *Harris* v. *Rothwell* (*z*), where the specification, held to amount to prior publication, was written in German. In *Heurteloupe's Patent* (*a*), the deposit of a foreign work in the British Museum invalidated a similar patent subsequently obtained in England. In the *United Telephone Co.* v. *Harrison* (*b*), an invention was described in a paper, written in German, in a scientific journal, and was illustrated by figures. A copy of the journal was in the Patent Office library, and also in the library of the Institute of Civil Engineers, and there open to members and to certain others. It was catalogued only under the title "Journals." A telegraphic engineer saw this journal, and from the technical terms used, and the illustrations, was able to understand the invention; Fry, L.J., held, that the invention had been published.

**Effect of publication.**

The prior publication of a design will be a bar to registration of the subsequent one, if it substantially gave the information to the public (*c*). Nor is it necessary that the publication should be such

(*x*) 31 L. J. Ch. 769, 31 Beav. 133.

(*y*) 31 Ch. Div. 241; and see *Pickard* v. *Prescott*, (1892) 9 R. P. C. 195; L. R. A. C. 263.

(*z*) *Supra.*

(*a*) 1 W. P. C. 553.

(*b*) (1882) 21 Ch. Div. 720, 51 L. J. Ch. 705.

(*c*) See case cited above.

as to guide an ordinary member of the public how to make the design: it suffices if the information given enables those conversant with the subject to follow the method (*d*). On the other hand, a mere barren suggestion in a book will not prevent registration of a practical application of the idea. Grove, J., in *Philpott* v. *Hanbury* (*e*) says: "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. But if it reasonably discloses what the invention is, so that a person skilled in the trade can practise the invention from it, then I am of opinion that there is anticipation."

Sufficiency of publication.

The cases are difficult to reconcile, if the question be regarded as of one of law. The true rule seems to be that in each case the question is one of fact. The *Plimpton* cases and *Otto* v. *Steel* do not really conflict with *Lang* v. *Gisborne*, or with *Harris* v. *Rothwell*. In the two former cases, the book, though in the libraries, was never consulted, because really not accessible; in the latter cases, the books, if not consulted, were accessible. All that has to be determined is, whether the public had already the information professed to be given for the first time by the patentee. This is really a question to be answered by the jury, if there be one (*f*).

Summary of result of the cases.

*Publication to Individuals.*—Although a design has not been published in any book, it may still be incapable of registration, on the ground that it has been communicated orally or otherwise to some person who is not in a confidential relation to the inventor. The cases which follow shew that there is a publication whenever it is the fair conclusion from the evidence that some English people, under no obligation to secrecy, arising from confidence or good faith

(*d*) See remarks of Jessel, M.R., in *Plimpton* v. *Malcolmson*, 3 Ch. Div. 556, 558, 44 L. J. Ch. 257.

(*e*) (1885) 2 R. P. C. 33, 43.

(*f*) See 1 W. P. C. 719 (n).

towards the owner of the design, knew of it at the date when the application for registration was made (*g*). If, however, the person to whom the communication is made is under an obligation to secrecy, the statement to him will not be a bar to registration of the design, unless he breaks the confidence reposed in him (*h*).

Confidential publication. Communication to agent. Communication by agent to others.

In *Blank* v. *Footman* (*i*) the inventor of a design shewed it to and consulted Hummel, his sole agent, and the agent consulted another person, and also shewed it to two customers, and asked them for orders; Kekewich, J., decided that a registration subsequent to the date when the design was shewn to the customers was invalid. On the other hand, he decided that the communication to the agent would not affect a subsequent registration. He said, after quoting Bowen, L.J. (in *Humpherson* v. *Syer* (*k*)): "The patentee, whether it be a chemical patent or a scientific patent or a machinery patent, frequently (generally I might say) is unable to carry out the manufacture of the patented article in all its details himself personally. He must employ others, and for that purpose the Lord Justice says he is entitled to do so without in the slightest degree damaging his patented rights to claim protection, provided it is done confidentially. It is a step further to say that a man like Mr. Blank is entitled to take into his confidence a man like Mr. Hummel, who is only a commission agent, a man through whom the profits are to be made. He does not occupy, to my mind, a position at all similar to that of the shopman. But I think it is only a fair stretch of the same principle to say, as I have already said, that I think a man in Mr. Blank's position might consult with those through whom he would put goods on the market, particularly, as I say, having regard to the relation existing between them, and doing it confidentially, without avoiding his rights to be obtained by registration."

Publication by delivery of a sample.

In *Winfield & Son* v. *Snow Brothers* (*l*) it appeared that Major, a buyer for Messrs. Olney & Sons, suggested to plaintiffs to produce

(*g*) See Fry, L.J., in *Humpherson* v. *Syer*, (1887) 4 R. P. C. 414.

(*h*) *Ibid.* p. 416.

(*i*) (1888) 39 Ch. Div. 678, 57 L. J. Ch. 909, 36 W. R. 921, 59 L. T. N. S. 567, 5 R. P. C. 653.

(*k*) (1887) 4 R. P. C. 413.

(*l*) (1891) 8 R. P. C. 15.

lace of a certain pattern, and the plaintiffs had a design prepared, from which they manufactured a sample, and shewed it to Major. He gave an order for 12,000 yards, and took away a piece as a sample. The design was registered, and subsequently the bulk of the lace was delivered; it was decided by Hawkins, J., that the registration was bad, the disclosure to Major being a publication. The Judge said that the argument for the defendant was "that that which took place between Mr. Winfield and Mr. Major was no publication, but a mere confidential communication with a view to ascertaining from Mr. Major himself whether his suggestion made at their first interview had been carried out by the designer, and whether the specimen of lace manufactured from that design was such as to be likely to suit the spring market, with a view to registration of the design if his opinion were favourable. Had such been the sole character and object of the communication I should undoubtedly have held that it did not amount to such a publication as to defeat the subsequent registration, for I should, under such circumstances, have looked upon the production of the specimen of lace to Mr. Major as an exhibition of it with a view to seeking the advice of an experienced friend without any reference to the employment as buyer to the firm with which he was connected, and the more particularly should I have thought so had Mr. Major been made aware of the plaintiffs' intention to register the design." This case is an authority for saying that the fact of dealing commercially with a design amounts to a publication vitiating any subsequent registration (*m*).

Commercial dealing with design.

In *Heinrichs* v. *Bastendorff* (*n*) H., previously to registering his design, and whilst perfecting it, consulted D. (with whom H. had trade relations) and sent him samples for inspection. D. slightly altered the samples, and returned them; eventually, but after registration, D. bought some of the designed goods; Mr. Justice Day held, that there had been no publication under these circumstances.

Sample sent for inspection only.

*Brett* v. *Electric Telegraph Co.* (*o*). Plaintiffs obtained a patent on 11th February. On 25th January M. entered into an agreement

Confidential trial of invention.

(*m*) And see *Morgan* v. *Seaward*, (1836) 1 W. P. C. 170, 194, 195; 6 L. J. Ex. 153; 2 M. & W. 544.

(*n*) (1893) 10 R. P. C. 160.

(*o*) Norman on Designs, p. 7; *Times*, 24th May, 1847.

with the defendant company, authorising the company to use his invention, which was practically identical with that of the plaintiff's. By the terms of the agreement the company was to try the invention by use for a certain time, and then either adopt it, or refuse to use it permanently; in such case the company was to keep the invention secret from all persons whatever. It was decided that the transaction between the company and M. did not amount to publication so as to avoid the plaintiff's patent.

Design exhibited by traveller before registration.

*Hunt* v. *Stevens* (*p*). This case referred to a design for a gas chandelier, and it appeared that before registration the plaintiffs had been in the habit of placing the designs in the hands of their travellers, who took them about for the purposes of obtaining orders prior to their registration. This was held to be a prior publication of the design.

Gun made in open shop without any secrecy.

In *Bentley* v. *Fleming* (*q*), a machine was lent to a second person to have its quality tested, and that person used it for some weeks in a public work-room, and the Judge was of opinion that there had been no publication. The report, however, is very short, and the decision, it is submitted, cannot be much relied upon. In *Westley, Richards & Co.* v. *Perkes* (*r*), it appeared that a gun was made in open shop, without any injunctions as to secrecy; it was known to many of the workmen, and was sold. On these facts, Kay, L.J., found that the invention had been published. *Morgan* v. *Seaward* (*s*) was distinguished on the ground that in that case the engineer who was instructed to make the wheels there in question had instructions to act secretly, and did so.

In *Humpherson* v. *Syer* (*t*), S. took out a patent, and afterwards sent for Widmer, who was a tradesman making water waste preventers, and whom he instructed to make for him a thing to prevent the waste of water, and to discharge the water in a proper way; and he directed him to make it in accordance with a model which had been prepared by a young man named Clark in the service of the defendant. That had a valve, and also had a lever,

(*p*) W. N. (1878) 79.
(*q*) 1 Car. & K. 587.
(*r*) (1893) 10 R. P. C. 181.
(*s*) 1 W. P. C. 170, 2 M. & W. 544.
(*t*) (1887) 4 R. P. C. 407.

so that the outer cap might be raised; but he told him to make it without that cap at all. The question was whether, having regard to the fact that Widmer received those instructions, and received the information to make the machine like that of the plaintiff which the defendant was now making, that can be considered as a publication, having regard to the fact that Widmer had what he did make made in his public warehouse and exposed in his shop. Widmer was not a servant of S.'s, but a tradesman. Bowen, L.J., said: "I put aside questions of public use, and treat this as a question of whether there has been a prior publication; that is, in other words, had this information been communicated to any member of the public who was free in law or equity to use it as he pleased. Was Widmer a person to whom this communication had been made in a manner which left him free both in law and equity to do what he liked with the information. If so, the information, of course, had been given to a member of the public, and there was nothing further to serve as consideration for any patent. The question is not a very easy one to settle as regards Widmer in my view. It is perfectly true that Mr. Widmer said, and Mr. Syer adopts the view, that there was no secrecy about the employment of Mr. Widmer to make a particular article. But it seems to me one must look at the whole case, and ask oneself, not merely by the light of what they say were the oral instructions which passed between them, but also by the light of the understood relations between the two men, whether Widmer really could, in good faith, have disposed of the information which he received from Syer after he received it—whether he could have used it for his own purposes against the person who gave it him. I think when a man sends a patent to be made to a shop, you must take what passes orally; you must take all the circumstances of the case, and ask yourself whether there was any confidential relation established between the two parties—whether it was an implied term of the employment that the information should be kept by the shopman to himself, or whether he might afterwards, without any breach of good faith, use the matter, and use it as he chose." Fry, L.J., thus deals with the point: after finding on the evidence, that Widmer made the machine without any obligation to secrecy, he proceeded: "But supposing that I am wrong in that, and supposing

Breach of confidence may amount to publication.

that Widmer was under an obligation to secrecy, that obligation was broken by him, because he made the machine in the open shop. Now, I am at a loss to find any obligation of secrecy which it can be suggested that Widmer had placed upon the workmen of Widmer, and upon all the persons who passed through the shop, and if that is so, though there may have been a breach of confidence in making it in the shop, nevertheless, according to the law, as laid down by Lord Blackburn, if the public have become possessed of the invention by any means whatever, no such patent can be taken out. Therefore, I think the probability is so strong that it would be seen by the workmen in the shop some time during the interval between the 16th and the 26th, that on that ground again I think there is strong and cogent evidence to lead to the conclusion that there was publication of the very thing itself."

The publication of a design invalidates a subsequent registration only if the publication take place in the United Kingdom (*u*).

Registration is probably not publication.

Does registration amount to publication? The point was raised in *Read and Gresswell's Design* (*x*), but it became unnecessary to decide the point, and it was not decided. There is much to be said for the argument that registration is not publication. The register in the case of trade-marks is open (*y*), and registration is expressly declared to be publication (*z*); the registered designs are kept secret during the period of copyright (*a*). From this it may be inferred that the law is different in the case of designs and of trade-marks, and hence that registration is not publication. Certainly registration does not make the information relative to the design available to the public. On the other hand, a member of the public may, with the authorization of the Court, or of the comptroller, and on payment of a fee, inspect, but not copy, the design (*b*). It may be questioned, if such person does so see the design, whether there has been publication in the sense used in this chapter.

(*u*) Patents, &c., Act, 1883, sect. 47 (1); and see the patent case, *Rolls* v. *Isaacs*, (1878) 19 Ch. Div. 268, 51 L. J. Ch. 170.

(*x*) (1889) 42 Ch. Div. 260, 58 L. J. Ch. 624, 61 L. T. N. S. 450, 6 R. P. C. 471.

(*y*) 1883, sect. 88.

(*z*) (1887), sect. 75, (1888) sect. 17.

(*a*) 1883, sect. 52.

(*b*) 1883, sect. 52.

### (c) *Publication at Public Exhibitions.*

Publication at an industrial or international exhibition is provided for by sect. 57 of the Act of 1883, thus:—

"The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with; namely,—

(*a*) "The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and

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

And sect. 3 of the Act of 1886 provides:—

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

See notes to these sections, *post*, p. 144, and Forms, pp. 251, 260 in the Appendix. Also Designs Rules, 1890, r. 36, *post*, p. 184.

# CHAPTER IV.

## REGISTRATION.

Provisions as to registration.

REGISTRATION of a design is necessary to give copyright to the proprietor. The matters to which attention must be directed with regard to registration are to be found in sects. 47, 48, and 49 of the Act of 1883 and in the Designs Rules, whilst useful information may be found in the pamphlet issued by the Patent Office authorities entitled "Instructions to Persons who wish to register Designs" (*a*).

Application for registration, how made.

A person desiring to register a design must leave at or send to the Patent Office (1) an application for registration (*b*); (2) in such application a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design should be registered (*c*); (3) certain drawings, photographs, or specimens, sufficient, in the opinion of the Comptroller, for enabling him to identify the design (*d*). The prescribed fee is payable by impressed stamp on the form of application (*e*).

How documents to be transmitted to Patent Office.

The documents must be left at or sent by post to the Patent Office (*f*); in the latter case they must be included in a prepaid letter, and will be deemed to have been left or given at the time when the letter containing the same would be delivered in ordinary course of post (*g*). The letter must be addressed to "The Comptroller, Patent Office (Designs Branch), 25, Southampton Buildings, Chancery Lane, London" (*h*). In proving such sending

(*a*) See *post*, p. 263.
(*b*) (1883) Sect. 47 (2).
(*c*) (1883) Sect. 47 (3).
(*d*) (1883) Sect. 48 (1).
(*e*) (1883) Sect. 56; and Rule 3.
(*f*) (1883) Sect. 47 (2).
(*g*) (1883) Sect. 97; Rule 11.
(*h*) Rule 7.

it will be sufficient to prove that the letter was properly addressed and put in the post (*i*).

Time for doing things under Patents Acts.

It may also be observed that whenever (*k*) 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, in the Act 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.

## I. The Application (*l*).

Communications with regard to the application should be made to the Comptroller by the proprietor of the design or by some agent duly authorised by him, to the Comptroller's satisfaction; the application itself should be left at the Patent Office or be sent by post prepaid to the Comptroller (*m*). The application must be made in the forms prescribed, viz. Form E or Form O (*n*), or for lace E′, O′.

Name, address, and signature of applicant.

The applicant should give his full name and address and an indication of his trade or business. The applicant must sign the application either in person or by an authorised agent, but this may be dispensed with by the Comptroller, with the sanction of the Board of Trade, if he is satisfied that from any reasonable cause such person is unable to sign; and the Comptroller may in such case, upon the production of other evidence, and subject to such terms as the Board of Trade may think fit, dispense with the document (*o*).

The application for registration and all other documents sent to

(*i*) (1883) Sect. 97 (2); Rule 11.
(*k*) (1883) Sect. 98.
(*l*) Stamped forms may be obtained at various places; see *post*, p. 263.
(*m*) Rules 6, 7.
(*n*) (1883) Sect. 47 (2); and Rule 4, p. 187, *post*. See Appendix, pp. 247, 253.
(*o*) Rule 29. And see (1883) sect. 99, which deals with declarations, &c., when the applicant is an infant, &c.

or left at the Designs Branch of the Patent Office must be written, printed, copied, or drawn upon strong wide-ruled foolscap paper (on one side only) of the size of 13 inches by 8 inches, leaving a margin of not less than one inch and a half on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand (*p*).

Registration dates from the day upon which the application for registration is received by the Comptroller (*q*).

## II. Statement of the Nature of the Design.

Description of design.

The description of a design need not be elaborate as in the case of specification of the patent (*r*), but it must state whether the design is applicable for the pattern, or for the shape, or for the configuration, or for any two or more of such purposes as the case may be, and generally should state enough to enable the Comptroller to give such information as is required by sect. 53.

Classes of goods.

Also it should state the means by which it is applicable (*s*). The section provides that the application must contain a statement of the nature of the design, and of the class or classes of goods in which the applicant desires that the design should be registered.

Registration by sample under old law.

Under the Acts of 1842 and 1843 an applicant was not allowed to register a design without accompanying the registration with a written description or some drawing or plan of it. By the statute —21 & 22 Vict. c. 70, the registration of a pattern or portion of an article of manufacture to which a design is applied, instead or in lieu of a drawing or description in writing, was made valid. But in view of the terms of sect. 47 (3) of the Act of 1883 and of the prescribed form E, it is submitted that now no registration can be

(*p*) Rule 8. The Comptroller may, in any particular case, vary these requirements as he may think fit.

(*q*) Rule 20.

(*r*) *Holdsworth* v. *McCrea*, (1867) L. R. 2 H. L. 380; 36 L. J. Q. B. 297. In the Instructions to Persons who wish to Register it is stated that a lengthy explanatory statement is undesirable, *see post*, p. 63.

(*s*) Rule 9.

valid unless the application contains a statement of the nature of the design. Undoubtedly an applicant may furnish exact representations or specimens of the design (*t*), and these may take the place of drawings or photographs, though not, it seems, of a written description; and in his own interest it would be better for the person who desires to register a design to give a written description, as if the registration be by sample only, there can ordinarily be no infringement unless the whole design be reproduced. The following cases may be referred to on this matter.

*Norton* v. *Nicholls* (*u*), (commenced in 1858, and therefore before the stat. 21 & 22 Vict. c. 70, came into force). The plaintiff had attempted to register for a shawl a design consisting of a combination of five points, and the plaintiff had left a shawl with the registrar with an intimation that it was to be applied to a particular class, but with no other information as to the nature of his claim. Lord Campbell, C.J., said: "We are clearly of opinion that the registration is defective. This registration consisted in merely leaving with the registrar an entire shawl manufactured according to the combination relied upon, with an intimation that it was to be applied to Class 8. We by no means say that there may not be a good registration by simply leaving with the registrar a copy of the design to be registered. Take the example of paper-hanging, Class 5. A section of the paper having the design impressed upon it would clearly disclose the claim of the inventor, and would fully put the registrar in possession of all the information he ought to have to enable him to perform the duties imposed upon him. But the plaintiff, by leaving one of his shawls with the registrar, gives no information of the nature of his claim, and cannot, we think, be said to have registered his 'design.' He intended by this act to claim each of the five points or separate designs, and he was equally at liberty to claim any other parts of the shawl allowed to be old. The colours on both sides were essentially as much parts of the shawl, or of the *combination*, as any of the five points which he claimed at the trial. What shall

What was sufficient information of nature of design.

(*t*) Sect. 48 (I).

(*u*) (1859) 28 L. J. Q. B. 225; 33 L. T. 131; 7 W. R. 720; 1 E. & E. 761.

be considered an infringement of the supposed combination? Is the defendants' shawl an infringement, although it varies the colours on both sides? Would it be an infringement if it included only four of the five points, and would it be so if it included only one of them? With respect to copyright of designs no specification is required as in the case of patents for inventions; but section 17 of the 5 & 6 Vict. c. 100, after empowering all the world to inspect the registered design when the copyright has expired, gives a right, under certain circumstances, before the copyright has expired, to an inspection of the registration, and requires the registrar, on the application of certain persons, to give to such persons 'a certificate stating whether there be any copyright existing of particular designs, and if there be in respect to what particular article of manufacture or substance such copyright exists.' If an application were made to a registrar by a shawl manufacturer respecting the five points of the plaintiff's shawl, separately or in combination, or the use of the colours of the Victoria Tartan, what answer could he make?"

Requirements for registration.

*Holdsworth* v. *McCrea* (*x*) came before the House of Lords, and it was decided that, (1) the same nicety is not required in registering patterns or designs as in describing inventions sought to be protected under the patent laws; (2) that the provisions of 5 & 6 Vict. c. 100, and 21 & 22 Vict. c. 70, are complied with by a person who leaves with the registrar copies of his design, though without any written description specifying precisely what is the extent of his claim; but (3) if what is claimed as the design consists, according to the pattern, of different parts, any one of which might be deemed a design, his registration of the whole pattern amounts to a claim of the combination, and not of any of the parts thus combined, any one of which, therefore, taken separately, is not protected by the registration.

The second proposition in this case is, it is submitted, altered by sect. 47, sub-sect. (2) of the Act of 1883. But if not, the third proposition shows the desirability of making a written statement of what is claimed when registration is applied for.

(*x*) (1867) L. R. 2 H. L. 380; 36 L. J. Q. B. 279.

Lord Chelmsford said (*y*): "Now the designer is under this disadvantage, that when he registers a pattern of material, there is no infringement unless it is exactly copied." And Lord Westbury, speaking on the same matter, said (*z*): "The only thing which it is here necessary to point out, as well for warning to inventors as for the protection of the public, is this, that if a design, as exhibited in a pattern, is filed and registered by an inventor, without any farther limitation or description than that which is given by the design itself, it protects the entire thing and the entire thing only; and the protection cannot, at pleasure, be made applicable one day to the entirety, and another day to the separate integral parts or elements of the entire design. It must be considered that the protection of the statute is invoked for the entire thing that appears upon the register, and is applicable to nothing but the exact copy of the thing so registered." But the meaning of these words has been explained in *McCrea* v. *Holdsworth* (*a*) by Lord Hatherley, L.C. He said: "Their Lordships seem to have meant that the designer is not bound, as in a patent case, to distinguish the new from the old, and is allowed to register his pattern without distinguishing what is new from what is old; but if he chooses to put it in that way, it will not be protected as against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner, as I hold they are in this case, and have the same effect, or nearly the same effect, then of course the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the defendants from the consequences of the piracy."

Registration by sample under old law.

In *Thom* v. *Sydall* (*b*) it was argued that registration by sample enabled the proprietor to produce any number of varieties of the same pattern; but the Court would not accede to this, and laid down that if the whole is claimed as the design, and the registra-

(*y*) p. 384.

(*z*) p. 388.

(*a*) (1870) L. R. 6 Ch. 418, 420; 23 L. T. N. S. 444.

(*b*) (1872) 26 L. T. N. S. 15. And see *Grafton* v. *Watson*, (1884) 50 L. T. N. S. 420; 51 L. T. N. S. 141.

tion is by sample, there can be no infringement unless the whole design be reproduced.

Care required in stating nature of the design.

*Barran* v. *Lomas* (*c*) illustrates the care required in properly describing the design for which registration is claimed. An ornamental braid had been registered, and the designer had produced at time of registration a photo of a jacket with the braid upon it, and this, he said, was a copy of the design. The members of the Court, whilst upholding the claim in this particular case, said that a man may register his design with a particular thing, but he cannot afterwards be heard to say that he claims the design as distinct from the thing. Thus when a new pottery design is registered as a new shape, it frequently is intended to be used with some new ornament, and the whole is registered together; such registration will not protect the ornament. In the case of the braid, Jessel, M.R., said that the prudent course would be to state in words that the braid is the design claimed, and that the jacket is placed in the photo merely by way of illustration, and is not intended to be part of the registered design. Such disclaimer must be clearly expressed at the time of registration, as no part of the description of the design as registered can afterwards be rejected (*d*).

Purpose of design to be specified.

Notwithstanding all this, no elaborate specification by the author of the design is either required or allowed. The statement must be such as is contemplated by the Rules, and such as is provided for by the prescribed form (*e*). Lord Shand, in *Walker, Hunter & Co.* v. *The Falkirk Iron Co.* (*f*), said: "The statute, sect. 47, sub-sect. 3, provides that the application for registration must contain a statement of the nature of the design, as well as of the class or classes of goods in which the applicant desires the design may be registered. This infers that the applicant shall settle the purpose or object for which the design is to be registered—pattern, shape, or ornament—and accordingly in the Board of Trade rules, issued in reference to the statute, it is provided by Rule 9, that the

(*c*) (1880) 28 W. R. 973.
(*d*) *Smout* v. *Slaymaker*, (1890) 7 R. P. C. 90.
(*e*) *Post*, p. 247.
(*f*) (1887) 4 R. P. C. 390, 395.

applicant, in stating the nature of the design, shall state whether it is applicable for pattern, shape, or configuration of the design. I see no reason to doubt that when a controversy of this kind arises as to infringement of a design, and it becomes necessary to determine whether protection was given to the design for pattern, shape, or ornament, or for any two or more of these purposes, either party may refer to the application for registration for a definition or description of the purpose of registration, and the Court will, if necessary, order the evidence on this subject to be produced, and such evidence should go far to decide the controversy."

## III. Copies of Design.

Drawing, photographs, &c., or exact representations or specimens to be furnished.

The 48th section provides that in addition to the application there shall be sent to the Comptroller the prescribed number of copies of drawings, photographs, or tracings of the design, sufficient, in the opinion of the Comptroller, for enabling him to identify the design. Instead of such copies, the applicant may furnish exact representations or specimens of the design (*g*). Rule 9 prescribes that "an application for the registration of a design shall be accompanied by a sketch or drawing, or by three exactly similar drawings, photographs, or tracings of the design, or by three specimens of the design." The Instructions to Persons who wish to Register (*h*), following the Rules, provide (*inter alia*):

The official instructions.

"An application for the registration of a design, and all drawings, sketches, photographs, or tracings of a design, and all other documents sent to or left at the Patent Office (Designs Branch), or otherwise furnished to the Comptroller or to the Board of Trade, shall be written, printed, copied, or drawn upon strong wide-ruled foolscap paper (on one side only), of the size of 13 inches by 8 inches, leaving a margin of not less than one inch and a half on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. The Comptroller may in any particular case vary the requirements of this rule as he may think fit: Rule 8. An applica-

Requirements of Patent Office.

(*g*) See above.

(*h*) *Post*, p. 263.

tion for the registration of a design shall be accompanied by a sketch or drawing, or by three exactly similar drawings, photographs, or tracings of the design, or by three specimens of the design, and shall, in describing the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable. When sketches, drawings, or tracings are furnished they must be fixed. When the articles to which designs are applied are not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs shall be furnished: Rule 9.

Comptroller may sometimes refuse drawings.

Sect. 48, sub-sect. (2) enables the Comptroller to refuse any drawing, photograph, tracing, representation or specimen which is not, in his opinion, suitable for the official records; but by sect. 94 of 1883 and by Rule 12 he must give the applicant an opportunity of being heard (*i*).

Articles to which the Design are applied are not to be sold until proper drawings have been deposited.

If the three copies, drawings, &c., are not sent with the application, it will not follow that the registration will be refused. It is indeed contemplated that sometimes but one drawing, &c., may be sent, and the Official Instructions state that if it be desired to secure a date of registration at once, one sketch of the design (sufficient to identify the same) may be sent with the application form, but no certificate can be issued until three exact drawings, photographs, or specimens have been sent in substitution for the sketch. Sect. 50, sub-sect. (2) of the Act of 1883 provides: "Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Comptroller may erase his name from the register, and thereupon his copyright in the design shall cease." From this it may be inferred that the registration dates from the time the application, accompanied by a single sketch, is received by the Comptroller, and this is so provided by Rule 20. After registration, the proprietor may exhibit or otherwise deal with his design, but he may not sell it until the

(*i*) See *infra*, and Rules 12—19. And see Act of 1883, sect. 47 (b).

prescribed number of drawings or sketches have been supplied (*k*). The proprietor must be notified by the Comptroller of any decision (*l*).

Certain provisions are made for the transmission of certified copies of all specifications, drawings, and amendments left at the Patent Office 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 (*m*).

## IV. Fees.

Power to prescribe fees on registration is given by sect. 56 of the Act of 1883, and the Board of Trade, with the sanction of the Treasury, have fixed the Table of Fees as set forth in Schedule I to the Rules (*n*).

## V. Classes.

On application the applicant must state the class or classes of goods in which he desires that the design may be registered (*o*). For the purpose of the registration of designs, goods are classified in fourteen classes. These are set out in the Third Schedule to the Rules (*p*).

Distinction of Classes 13 and 14.

In one case the difference between Classes 13 and 14 was considered, and Bristowe, V.-C., said that he had come to the conclusion that there was a substantial difference between the two classes No. 13 and No. 14, and that piece goods are "intended to denote goods commonly known as piece goods, measured by the piece and sold by the piece, and should be classified under No. 13; and that goods which, though woven in the piece, are subdivided in pattern

(*k*) See notes to this section, *post*, p. 136.
(*l*) Rules 12—14.
(*m*) Act of 1883, sect. 100.
(*n*) See *post*, p. 185.
(*o*) Act of 1883, sect. 47 (3). There are similar provisions as regards trade-marks; see sect. 62 (3). On account of the difference in the nature of a design and of a trade-mark, the cases dealing with the classification of the latter are not very useful in elucidating the law of designs. The trade-mark decisions may be found in Kerly on Trade-Marks, pp. 88, 89.
(*p*) Rule 5, and Sch. III. to the Rules. See *post*, p. 185.

by cross lines or other demarcations, showing that they would be sold not by measurement but by number, as per dozen, fall within the class of handkerchiefs and shawls, and ought to be registered under Class 14 (*q*).

Set of Designs.

The registration may be of single designs or may be of a set, *i.e.* of any number of articles ordinarily on sale together, irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article.

In any case of doubt as to the class in which a design ought to be registered, the Comptroller may decide the question (*r*); but if the decision be adverse to the applicant, the Comptroller must at the applicant's request hear him (*s*). In case of doubt or difficulty the Comptroller may apply to either of the law officers for directions in the matter (*t*).

Copyright in design limited to class or classes in which registered.

The protection granted by the Act to any design is limited to a prohibition of any imitation thereof in the class or classes in which it is registered (*u*), *e.g.* the registration of a design in Class 13 is not infringed if the alleged imitation is applied to goods in Class 14 (*x*). In *Re Read & Greswell's Design* (*y*), Chitty, J., says that the copyright in a design conferred by the Act is "limited to the goods in the class or classes in which the design is registered, and this is clearly the case, for under sect. 58, which gives a special remedy by penalty for the infringement of a registered design, the registered proprietor cannot proceed against the infringer in respect of goods outside the class in which the design is registered, and for this reason, that the person registering having knowingly confined the registration to one class of goods, has by so doing impliedly given notice to all the world that they are at liberty to use the design for goods not included in the class or classes, for a person may register a design in more than one class."

(*q*) *Hothersall* v. *Moore*, (1892) 9 R. P. C. 27, 38.
(*r*) (1883) Sect. 47 (5).
(*s*) (1883) Sect. 94 ; Rule 12.
(*t*) (1883) Sect. 95.
(*u*) (1883) Sect. 58.
(*x*) *Hothersall* v. *Moore* (*supra*).
(*y*) (1889) 42 Ch. Div. 260, 261 ; 58 L. J. Ch. 624 ; 61 L. T. N. S. 450 ; 6 R. P. C. 471.

Registration in more than one class.

If, then, there be any doubt in which class the design should be registered, it will be advisable for the proprietor to exercise the power given by the Act, and register it in more classes than one (*z*). A separate application, together with three representations, is necessary for each class. Conversely he may, by application in writing to the Comptroller (accompanied by the prescribed fee), obtain permission to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design to be registered (*a*).

After registration in one class, subsequent registration in another class is not permissible if the application be for an analogous purpose.

It should be remembered that though the protection does not extend beyond the particular class in which the design is registered, yet that it is not open to a person to register a similar design in another class. The registered proprietor may not proceed for infringement if the imitator uses the design for a class of goods in connection with which the proprietor has not registered; but the latter cannot have registration allowed to him, as his invention is not new and original. In *Read & Greswell's Design* (*b*), T. registered a design in Class 5 in Schedule III., viz. "Articles composed wholly or partly of paper (except hangings)," for the pattern and shape of a flower candle shade in imitation of a chrysanthemum. Afterwards R. & G. registered an identical design in Class 12, viz. "Goods not included in other classes." It was argued for R. & G. that where a new and original design is registered in one class, a rival designer is at liberty to take the design and transfer it bodily to another class, and register it in that class. Chitty, J., said that such an argument could not be sustained. T.'s copyright doubtless was limited to goods in Class 5, but nevertheless R. & G. could not register the design in any other class. The Judge said: "I suggested the case of a design registered for jewellery, and another trader finding this to be so, and that articles marked with such design were being put on the market, and people were becoming generally acquainted with the design, taking this design and registering it in some other class of goods, such as glass (Class 4) or lace (Class 9), a thing which in the case of many designs might easily be done. I am satisfied that it was not the

(*z*) (1883) Sect. 47 (4).
(*a*) (1883) Sect. 91; (1888) Sect. 25.
(*b*) *Supra*.

intention of the Legislature to allow this to be done. The answer to the argument is to be found really in sect. 47 of the Act, where the words used are: 'Any new or original design not previously published in the United Kingdom.' To be capable of being registered a design must be 'new or original' in fact, and not, as is suggested, 'new or original' as to some particular class of goods. It cannot be said to be new and original if it is already being applied to articles of an analogous character."

Registration in different classes.

With regard to registration in different classes, *Re Bach's Design* (*c*) may be consulted. There Kekewich, J., decided that a design already on the register may be registered in another class for an article applied to a different purpose, but not for an article merely of a different material. A design for a lamp shade in the shape of a rose made of linen had been previously registered in one class, and the Judge ordered removal from the register of a design for a lamp shade of a similar shape made of china afterwards registered in another class. The Judge said: "There are many cases in the books in which the Court has upheld registration, as for cotton goods in one class, of a design which had already been applied to goods of a different character altogether in another class, and I do not think it necessary to hold or even to intimate that possibly the design of a rose may not be registered for some other entirely different purpose, that is to say, with reference to some other quality of goods in a different class. But the Act does not say, and I think cannot have intended to say, that by selecting a different class a man may register as applied to the same things, say lamp shades, what has been already registered with reference to that thing, lamp shades, merely varying the material in which the lamp shades have been made" (*d*).

## VI. Refusal of Comptroller to Register.

No opposition to registration in Design.

As regards application to register, design cases differ from patent and trade-mark cases. When a patent is applied for, an opportunity for opposition is provided (*e*); so when the registration

(*c*) (1889) 42 Ch. Div. 661; 6 R. P. C. 376.
(*d*) And see *ante*, Chap. III., "Novelty."
(*e*) (1883) Sect. 11.

of a trade-mark is asked for (*f*). Such is not the case with designs; there is no provision for opposition.

Discretion of Comptroller to refuse registration.

The Comptroller considers the application, and may, if he thinks fit, subject to appeal to the Board of Trade, refuse to register any design presented to him for registration (*g*). There are no special directions given by the Acts as to the grounds upon which he must refuse to register, save that sect. 86 provides that he may refuse to register a design of which the use would, in his opinion, be contrary to law or morality. The 6th section of the Act of 1888 seems to contemplate that a design identical with another already registered will be refused. Hence it may be inferred that the refusal to register a design is a matter in the discretion of the Comptroller, subject to appeal as mentioned below (*h*). Of course the discretion must be judicially exercised, but it seems that assuming this is so, there is no restriction as to the grounds upon which the refusal may be based (*i*).

Procedure before Comptroller.

But before exercising his discretionary power adversely to the applicant for registration, the Comptroller shall give the applicant who requires it an opportunity of being heard personally or by agent (*k*). The applicant has one month from the date of the Comptroller's objection within which he may require to be heard. The matter then proceeds as follows (*l*): (1) The Comptroller sends to the applicant ten days' notice of a time when the hearing will take place; (2) Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to the Comptroller whether or not he intends to be heard upon the matter; (3) The case is heard on the appointed day, and the decision of the Comptroller is then notified to the applicant.

(*f*) (1883) Sect. 69.

(*g*) (1883) Sect. 47 (6).

(*h*) *Post*, p. 64.

(*i*) See *Eno* v. *Dunn*, (1890) 15 A. C. 252; 58 L. J. Ch. 604; 63 L. T. N. S. 6; 39 W. R. 161; 7 R. P. C. 311—a trade-mark case. From the dicta in some of the cases, it might be assumed that such is the case as regards the refusal to register trade-marks. See Lords Watson and Herschell in *Eno* v. *Dunn*. But see Lindley, L.J., in the *Somatose case*, (1894) 1 Ch. 645; 63 L. J. Ch. 257; 11 R. P. C. 89. The point is considered in Kerly on T. M., p. 64.

(*k*) (1883) Sect. 94; Rule 12.

(*l*) Rules 12—14.

Appeal to Board of Trade.

Any person aggrieved by the refusal of the Comptroller to register may appeal to the Board of Trade, and the Board of Trade shall, if required, hear the applicant and the Comptroller, and may make any order determining whether, and subject to what conditions, if any, registration is to be permitted (*m*). By the 82nd section of the Act of 1883 the Board of Trade has conferred upon it a general superintendence over the Patent Office and the Comptroller, and he is bound to obey the Board's directions, though it is not under the power given by that section that the appeal is heard, but under the express provisions of sect. 47 of the same Act.

Procedure on appeal to Board of Trade.

The steps in the appeal procedure are these (*n*): (1) The applicant must within one month from the date of the decision appealed against, leave at the Patent Office, Designs Branch, two notices of intention to appeal, one of such notices being stamped with a fee of 1*l.* (*o*); (2) The notice must be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof. The statement of the case is to be written upon foolscap paper (on one side only) with a margin of two inches on the left-hand side; (3) A copy of the notice must be sent by the applicant forthwith to the Secretary of the Board of Trade.

The Board of Trade may, upon receipt of the notices, give such directions (if any) as they may think fit for the purpose of hearing the appeal; and they will give seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for hearing the appeal. The notice will be given to the Comptroller and to the applicant (*p*).

Costs of appeal.

There are no costs of the appeal, as they are not provided for by the Acts or Rules, and it may be taken that the applicant pays his own, whether successful or not.

Amendments.

The Comptroller may allow any document to be amended, and any irregularity in procedure to be corrected, if in his opinion this can be done without detriment to the interests of any person (*t*).

(*m*) (1883) Sect. 47 (6) and (7).
(*n*) Rules 15—17; and see Form F, *post*, p. 248.
(*o*) See Form F, *post*, p. 248.
(*p*) Rules 18, 19.
(*t*) Rule 30.

He may extend the time prescribed by the Rules for doing any act or taking any proceeding thereunder (*tt*). Any such amendment or extension will be in the discretion of the Comptroller, and subject to such terms as he shall think fit (*u*).

## VII. Certificate of Registration.

When the Comptroller determines to register a design, he shall, as soon as may be, send the applicant a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office (*x*). The registration dates from the day of application, but actual registration does not take place until the certificate is sealed (*y*); and if but one drawing or specimen has been sent with the application, the certificate will not be issued until the three drawings, &c., have been forwarded. The form of the certificate is that prescribed in Form G (*z*).

Copies where certificate lost.

In case of loss of the original certificate, or in any other case in which he may deem it expedient, the Comptroller may grant copies of the certificate (*a*). The fee for each copy is one shilling, and the application should be made in the prescribed form, viz. H or I, according to circumstances (*b*).

## VIII. Miscellaneous.

Amendments.

Amendments may be allowed in certain particulars as the Comptroller may think fit, and upon such terms as he may impose (*c*). Extensions of time are dealt with in Rule 31. The Comptroller may, on request in writing (Form M (*d*)), accompanied by the prescribed fee (five shillings), (a) correct any clerical error in or in connexion with an application for registration of a design (*e*); or (b) correct any clerical error in the name, style, or address of the registered proprietor of a design (*e*); or (c) permit an applicant for registration of a design to amend his application by omitting any

(*tt*) Rule 31.
(*u*) Rules 30, 21.
(*x*) Rule 10. And see (1883) sect. 49.
(*y*) Rule 20.
(*z*) *Post*, p. 248.
(*a*) (1883) Sect. 49 (2).
(*b*) *Post*, p. 248.
(*c*) Rule 30.
(*d*) *Post*, p. 252.
(*e*) (1883) Sect. 91.

particular goods or classes of goods in connexion with which he has desired the design to be registered (*f*).

For International and Colonial arrangements, see Act of 1883, sect. 103, as amended by the Act of 1885, sect. 6, *post*, p. 166.

Special provision for persons under disability, *e.g.* for infants, lunatics, is made by sect. 99 of the Act of 1883 (*g*).

(*f*) (1888) Sect. 24.
(*g*) *Post*, p. 162.

# CHAPTER V.

## THE REGISTER.

It is provided that there shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of the proprietors (*a*) of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed (*b*).

No notice of any trust, express, implied, or constructive, shall be entered upon the register or be received by the Comptroller (*c*). It has been decided, on sect. 23 of the Act of 1883 (the corresponding section of that portion of the Act which relates to patents), that equitable assignments may be entered on the register, not as in themselves legal assignments, but as documents which affect proprietorship (*d*). A. and B., joint owners of certain patents, wrote to C., "In consideration of your services as . . . . we hereby agree to give you one-third share of the patent, the same to take effect as from this date." A. and B. then deposited the letters patent with C., and C. registered the letter above set out; and the Court of Appeal held that the letter was an immediate equitable assignment of an interest in the patent, and was properly entered on the register (*d*).

The registration of the name of the original proprietor must take place upon the sealing of the certificate of registration, though the date of application will be the day from which the registration will

(*a*) See next chapter.

(*b*) (1883) Sect. 55 (1).

(*c*) (1883) Sect. 85.

(*d*) *Stewart* v. *Casey*, (1892) L. R. 1 Ch. 104; 61 L. J. Ch. 61; 9 R. P. C. 9. But see dicta of Kekewich, J., in *Haslett* v. *Hutchinson*, (1891) 8 R. P. C. 457, 463, which *query*.

date (*dd*). The Comptroller must enter on the register the name (*e*), address, and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller (*f*).

Subsequent proprietors are entitled to be placed upon the register. Sect. 87 of the Act of 1883 (which empowers the proprietor to assign or grant licences) provides: "Where a person becomes entitled by assignment, transmission, or other operation of law, to . . . . copyright in a registered design, . . . . 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 . . . . copyright in the design . . . . in the register of . . . . designs." The Rules provide:—

Rules as to entry in register of assignments, &c.

Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design either exclusively or otherwise, a request for the entry of his name in the register as such proprietor of the design, or as having acquired such right, as the case may be (hereinafter called the claimant), shall be addressed to the Comptroller, and left at the Patent Office, Designs Branch.

Every such request shall, in the case of an individual, be made and signed by the person requiring to be registered as proprietor; and in the case of a firm or partnership, by some one or more members of such firm or partnership, or, in either case, by his or their agent respectively duly authorised to the satisfaction of the Comptroller; and in the case of a body corporate, by their agent authorised in like manner.

Every such request shall state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law by virtue of which the request is made, so as to show the manner in which and the person or persons to whom the design has been assigned or transmitted, or the person or persons who has or have acquired such right as aforesaid, as the case may be.

(*dd*) Rule 20.
(*e*) A body corporate may be registered by its corporate name: Rule 26.
(*f*) Rule 20. And see forms, *post*, pp. 250, 251.

Every such request shall be accompanied by a statutory declaration to be thereunder written verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the design or the right to apply the same, as the case may be, as claimed by such request.

The claimant shall furnish to the Comptroller such other proof of title as he may require for his satisfaction.

Rule 29 allows the Comptroller to dispense with evidence under certain circumstances.

The fee payable is the same fee as on original registration (*g*). The form of application is Form K in the appendix to the Rules (*h*); save that where the design is a lace Form K′ must be used. It may be doubtful whether an assignment must be in writing; certainly such was the case under the older Acts (*i*), and it is submitted that the law is still the same. Such seems to have been the view of Wright, J., in *Wooley* v. *Broad* (*k*). It will be necessary to complete the original registration before an assignment can be registered (*i*).

On death of the proprietor the executor or administrator is entitled to be registered; on bankruptcy the right devolves upon the trustee in bankruptcy.

## Inspection of the Register of Designs.

Sect. 88 of the Act of 1883 provides that every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of the Act and to (*l*) such regulations as may be prescribed.

During the existence of the copyright in a design, the design itself cannot be inspected except (*m*) (1) by the registered proprietor; or (2) by a person authorised in writing by him; or (3) by a person authorised by the Comptroller or by the Court. And

(*g*) Rules, Sched. I.
(*h*) *Post*, pp. 250, 251.
(*i*) *Jewitt* v. *Eckhardt*, (1878) 8 Ch. D. 404.
(*k*) (1892) 1 Q. B. 806; 61 L. J. Q. B. 259; 9 R. P. C. 208.
(*l*) (1888) Sect. 22.
(*m*) (1883) Sect. 52 (1).

any of these persons must furnish such information as may enable the Comptroller to identify the design; must inspect in the presence of the Comptroller or of an officer acting under him; must pay the prescribed fee, viz. one shilling for every quarter of an hour (*n*). No copy may be taken of the design, nor of any part of it (*o*).

But where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered (*p*).

Also when the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee (*q*). The fees are set out in the Rules, Schedule I. (*r*). Rule 33 gives power to the Comptroller to notify by a placard posted at the Patent Office the days and hours when inspection may take place.

### Rectification of the Register.

It is provided by sect. 90 of the Act of 1883, as amended by sect. 23 of the Act of 1888, that "the Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person *or of any other particulars* (*s*) 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 costs of the proceeding as the Court thinks fit."

From this it will be seen that the grounds upon which the register may be rectified include the omission without sufficient cause of the name of any person, but this provision will not enable a person whose design has been refused by the Comptroller to appeal to the Court. An appeal of such a kind must be to the

(*n*) (1883) Sect. 52 (1), and Rules, Sched. I.
(*o*) (1883) Sect. 52 (1).
(*p*) (1888) Sect. 6.
(*q*) (1883) Sect. 52 (2).
(*r*) *Post*, p. 185.
(*s*) These words were inserted by the Act of 1888.

Board of Trade (*t*), and this provision cannot be evaded under cover of an application to rectify the register (*u*).

Grounds for rectification.

The grounds upon which an entry will be varied or expunged are, in general, similar to those upon which the Comptroller ought in the first instance to refuse registration. Thus the Court has expunged entries on the ground that the person registered had no title enabling him to register, *Guiterman's Design* (*x*); that the design is not novel or has been previously published, *Smith* v. *Hope* (*y*), *Le May* v. *Welch* (*z*), *Re Read & Greswell's Design* (*a*), *Smout* v. *Slaymaker* (*b*). Also rectification may be ordered on the ground that the entries in the register have been caused by misrepresentation (*c*).

The Court may expunge any entry or may rectify by varying the entry (*d*). An improper entry should be expunged, and not rectified (*e*). And there seems to be no power to substitute one name as registered proprietor for another, except under the rules governing assignments, transmissions, &c. (*f*). In *Re Rivière's Trade-Mark* (*g*), Cotton, L.J., said: "In my opinion, whatever might be the result of striking off the name of Rivière & Co., yet the application to substitute that of the applicants could not be acceded to. Because, in my opinion, even without going so far as to say that in no case where the name of a person improperly on the register as owner of a mark is struck off, the name of the person properly

Substitution of one name for another not usually ordered.

(*t*) (1883) Sect. 47.

(*u*) *Re the Trade-Mark Normal*, (1886) 35 Ch. Div. 231; 56 L. J. Ch. 519; 56 L. T. N. S. 250; 35 W. R. 464; 4 R. P. C. 123. Sect. 90 of the Act of 1883 applies to patents, designs, and trade-marks alike, therefore assistance in construing it may be obtained from cases on all three subjects.

(*x*) (1886) 55 L. J. Ch. 309.

(*y*) (1889) 6 R. P. C. 200.

(*z*) (1884) 28 Ch. Div. 24; 54 L. J. Ch. 279; 51 L. T. N. S. 867; 33 W. R. 33.

(*a*) (1889) 42 Ch. Div. 260; 58 L. J. Ch. 260; 61 L. T. N. S. 450; 6 R. P. C. 471.

(*b*) (1890) 7 R. P. C. 90.

(*c*) *Baker* v. *Rawson*, (1889) 45 Ch. Div. 519.

(*d*) An example of this is to be found in the trade-mark case, *Baker* v. *Rawson*, (1889) 45 Ch. Div. 519.

(*e*) Per Kekewich, J., in *Haslett* v. *Hutchinson*, (1891) 8 R. P. C. 457.

(*f*) *Ante*, p. 68.

(*g*) (1885) 55 L. J. Ch. 545; 53 L. T. N. S. 237.

entitled to the mark may be substituted, yet in my view, as a rule (and I do not know a case where there would be an exception), where any one applies in the first instance to be publicly registered as the proprietor of a trade-mark, the prescribed formalities should be adopted." In *Rust & Co.'s Trade-Mark* (*h*), Arthur Rust by mistake registered a trade-mark of his firm in the name of "Arthur Rust, trading as T. W. Rust & Co.," and the firm of T. W. Rust & Co. moved successfully to rectify the register by cancelling the name of A. Rust and inserting in the register the names of all the partners trading under the firm's name. Here, it will be observed, the registered proprietor had applied in the firm's name as well as his own. In *Re Farina's Trade-Mark* (*i*) the partner applied in his own name only, and substitution, by way of rectification, of the firm's name was refused. In *Re Greenlees' Trade-Marks* (*k*) *Farina's case* was followed, and Stirling, J., stated that the right course would be for the partner whose name was upon the register to assign to the firm (*l*). It is submitted that these cases would be followed under corresponding circumstances relating to designs. In *Re Guiterman's Design* (*m*) an agent for a company owning designs was wrongfully registered as proprietor: the Court expunged the agent's name from the register, but refused to substitute the name of the company for that of the agent. It is to be observed, however, that the application was made by counsel for the agent, and not by the successful applicant, and no reasons for his refusal were given by the Judge. And the reasons which have led the Court to refuse to substitute the name of the proper proprietor for that of the person improperly registered are not as strong in the case of the register of designs (upon which names are placed by the Comptroller without hearing opposition) as is the case with the register of trade-marks.

Change of name of owners.

Where there is a change, not of ownership, but of the name of the owners, variation by way of addition of the new name has been allowed even in the case of a trade-mark (*n*).

(*h*) (1880) 44 L. T. N. S. 98; 29 W. R. 393.
(*i*) (1881) 44 L. T. N. S. 99; 29 W. R. 391.
(*k*) (1892) 9 R. P. C. 93.
(*l*) (1883) Sect. 87.
(*m*) (1886) 55 L. J. Ch. 309.
(*n*) *Re Patent Plumbago Crucible Co.'s Trade-Mark*, (1890) 7 R. P. C. 282.

Costs.

The costs are in the discretion of the Court; and there seems to be no fixed rule as to the order to be made in this regard. The party who is unsuccessful will generally have to pay them. The Comptroller will usually be allowed his costs of appearance.

Costs of Comptroller.

Damages on rectification of register.

Sub-sect. (2) of sect. 90 gives power to the Court to award damages to the party aggrieved. Judging from the reported cases on designs, this has seldom, if ever, been done. In a recent case under a similar section of the Companies Act, 1862 (*o*), Lindley, L.J., said that it appeared to him that the Court had no jurisdiction to make the company pay damages under the section, except in cases where an order for rectification is made.

Persons entitled to apply for rectification, "any person aggrieved."

The persons entitled to demand rectification, if there be due cause, is "any person aggrieved." There has been at different times much discussion as to who falls within this description.

In the case of *Rivière's Trade-Mark* (*p*), Selborne, L.C., says: "The first observation which I have to make is, that I do not find on the face of the Act of Parliament itself any particular limitation of the sense in which the word 'aggrieved' is to be understood, when a person alleging himself to be aggrieved undertakes to bring the case within any one of the conditions on which a right to apply to rectify the register is given to a person aggrieved. Of course if it could be shown *à priori*, that in point of law persons in a certain situation could not be aggrieved, then the conclusion would be right, that the Court must refuse to hear them on the merits; but, unless that can be demonstrated, I find nothing in the Act of Parliament which limits and defines the kind of grievance which may entitle a man to apply. I entirely agree with what has been said, that it must be a legal grievance; it must not be a '*stet pro ratione voluntas*'; the applicant must not come merely saying, 'I do not like this thing to be done;' it must be shown that it tends to his injury or to his damage in the legal sense of that word." And Cotton, L.J., said: "Now undoubtedly the grievance must be a grievance which the law recognises as one in respect of which a party can complain in a Court of justice, and not a merely senti-

(*o*) Sect. 35; *Ottos Kopje Diamond Mines*, (1893) L. R. 1 Ch. 618; 62 L. J. Ch. 166.

(*p*) (1884) 26 Ch. Div. 48; 53 L. J. Ch. 455, 578; 50 L. T. N. S. 763; 32 W. R. 390.

mental grievance; but is it possible for us to say *à priori* that, assuming (though I by no means decide) the applicant to be a person who, having regard to the business which he carries on and the place where he carries it on, cannot register that which the respondents have registered, he cannot be aggrieved?"

In *Re Apollinaris Co.'s Trade-Marks* (*q*) the Court of Appeal (per Fry, L.J.) laid down that the object of limiting the power of application to the Court to a person aggrieved is to exclude the common informer, and those desiring to interfere from sentimental motives only; and whilst a grievance in the sense intended by the Act does not mean mere annoyance, yet it is not necessary that the applicant should prove that he is suffering serious damage.

Persons aggrieved.

One of the latest cases dealing with the meaning of "aggrieved" is *Re Powell's Trade-Mark* (*r*), in the course of which Bowen, L.J., said: "Persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that. In the *Apollinaris case* it was pointed out not as a complete or exhaustive definition that people would be aggrieved if they were in the same trade and dealt in the same article. To my mind, it is equally true that persons would be aggrieved if they are in the same trade, and might reasonably be expected to deal in the same article, though not prepared to prove at the moment that they had formed a clear determination to do so. Supposing that this mark ought not to be on the register, it hampers those who are in the trade and who might wish to consider the question of embarking in another branch of the trade if lawfully entitled to do so. It would be, to my mind, an unbusinesslike construction to place on the term 'aggrieved,' to say that it could only be applicable to those who actually had formed a fixed and crystallized intention of dealing in the particular article if permitted to do so. If a man is hampered in his arrangements of business matters in the future by the fact that a trade-mark is on the register which

(*q*) (1891) 2 Ch. 186; 61 L. J. Ch. 625; 65 L. T. N. S. 6; 8 R. P. C. 137.

(*r*) (1893) 2 Ch. 388; 10 R. P. C. 195; 62 L. J. Ch. 848; 69 L. T. N. S. 60; 41 W. R. 627. Affirmed by the House of Lords, (1894) A. C. 8; 11 R. P. C. 4.

ought not to be there, he is a person who, to my mind, is sufficiently aggrieved to come within the section."

Summary of persons aggrieved.

Thus the following are persons aggrieved: those who are engaged in a business and who desire to deal in a design which they allege to be improperly on the register (*s*); proprietors of designs registered before the design which it is desired to remove, and who allege they have been interfered with by the subsequent registration (*t*); persons attacked in an action for infringement (*u*). In *Horsley & Knighton's Patent* (*x*) one of two joint patentees was enabled as an aggrieved party to move to expunge an entry prejudicial to him and entered on the initiative of his co-patentee (*y*).

Procedure on application for rectification.

To rectify it is necessary to make application to the Court, *i.e.* to the High Court of Justice in England, and preferably to the Chancery Division (*z*). This will be so even when the registered proprietor is domiciled in Scotland or Ireland (*a*). The Court may in any proceeding in this regard decide any question necessary or expedient, and may direct an issue to be tried for the decision of any question of fact. It would ordinarily be an abuse of the process of the Court to bring an action for rectification (*b*); nor will the Court grant the relief on a counterclaim (*c*). The proper method of procedure is either by motion or by summons. The latter is not always the cheaper, and if it be obvious that the case must eventually be adjourned to Court, it will often be better to proceed by motion (*d*). If the application to rectify be the answer to an action for infringement, the course is to take out a

? By motion or summons.

(*s*) *E.g.*, *Smith* v. *Hope*, (1889) 6 R. P. C. 200; *Re Bach's Design*, (1889) 42 Ch. Div. 661; 6 R. P. C. 376; *Re Apollinaris Co.'s Trade-Marks*, (1891) 2 Ch. 186; 61 L. J. Ch. 625; 65 L. T. N. S. 6; 8 R. P. C. 137; Talbot's T. M. 1894; 63 L. J. Ch. 264; 11 R. P. C. 77.

(*t*) *E.g.*, *Re Read & Greswell*, 42 Ch. Div. 260.

(*u*) *Great Tower Tea Co.* v. *Smith*, (1889) 6 R. P. C. 165; *Re Apollinaris Co.'s Trade-Marks*, *supra*; *Re Ralph*, (1883) 25 Ch. Div. 194; 53 L. J. Ch. 188; 49 L. T. N. S. 504; 32 W. R. 168.

(*x*) (1869) 8 Eq. 475; 39 L. J. Ch. 157.

(*y*) And see *Green's Patent*, (1857) 24 Beav. 145; *Morey's Patent*, (1858) 25 Beav. 581; 6 W. R. 612.

(*z*) (1883) Sect. 117.

(*a*) *Re King & Co.'s Trade-Mark*, (1892) 2 Ch. 462; 62 L. J. Ch. 153; 10 R. P. C. 350.

(*b*) Per Bowen, L.J., in *Pinto* v. *Badman*, (1891) 8 R. P. C. 181, 187.

(*c*) *Ibid.*

(*d*) The form of a notice of motion is given *post*, p. 257.

summons in the action, or to move to rectify. The application is often not heard as a motion, but is ordered to be placed in the list of witness actions (*e*). If there be no action pending, the application, if made by summons, must be made by originating summons (*f*).

Notice to be given.

Rule 27 provides that four clear days' notice of every application to the Court under sect. 90 of the Act shall be given to the Comptroller. As a rule the persons who are affected should be served in the ordinary way prescribed for motions (*g*) or summons (*h*); as no special procedure is prescribed by the Acts or rules as to service on parties of notices of application to expunge a design, it has been said that if such notice of the intended application be given as natural justice requires it will suffice (*i*). Thus where the registered proprietor of a trade-mark was domiciled in Ireland, and could not be served with notice of motion, it was held sufficient to send him a copy of the notice, with a letter informing him that proceedings had been commenced which might affect his interest (*k*). Kay, L.J., said: "The Act has left, and I think designedly left, as free a hand as possible to the Courts which have to entertain these applications under the Act in respect of procedure" (*l*).

Comptroller to have notice of order made.

The order for rectification (*m*) must direct that due notice of the order be given to the Comptroller (*n*). And the person in whose favour the rectification is made, must forthwith leave at the Patent Office an office copy of the order (*o*). The register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the register, as the case may be (*p*). If a name is to be

(*e*) This was done in (*e.g.*) *Re Read & Greswell's Design*, *supra*, and in *Re Bach's Design*, *supra*.

(*f*) (1893) Order LIV. rule 4 (b), (c), (d); Forms, App. K, Nos. 1a, &c.

(*g*) R. S. C. (1883) Order LII.

(*h*) R. S. C. (1893) Order LIV. rule 4 (e).

(*i*) *Re King & Co.'s Trade-Mark*, (1892) 2 Ch. 462; 62 L. J. Ch. 153; 67 L. T. N. S. 33; 40 W. R. 580; 9 R. P. C. 350.

(*k*) *Ibid.*

(*l*) *Ibid.* p. 490.

(*m*) See Forms, *post*, p. 258.

(*n*) (1883) Sect. 90 (3).

(*o*) Rule 28.

(*p*) Rule 28. When the rectification is required in pursuance of any proceeding in a Court in Scotland or Ireland, see sect. 111, *post*, p. 170.

removed, the register is rectified by striking out the name with pen and ink, and adding, "By order of the Court of , dated, &c., this name has been erased."

There is an appeal from the decision of the High Court to the Court of Appeal; and for purposes of procedure it is treated as an appeal from a final order (*q*). Appeal is as from final order.

## Miscellaneous.

The Comptroller is empowered (a) to correct any clerical error in or in connexion with an application for a design (*r*); or (b) to correct any clerical error in the name, style, or address of the registered proprietor (*r*). The application must be in writing, in Form M (*s*), and must be accompanied by a fee of five shillings (*t*). Correction of clerical errors by Comptroller.

Sect. 55 (2) of the 1883 Act provides that the register of designs shall be *primâ facie* evidence of any matters by this Act directed or authorised to be entered therein.

Sect. 89 of the Act of 1883 makes sealed copies purporting to be certified by the Comptroller evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals. Such certified copies, sealed with the seal of the Patent Office, are to be given to any person who requires them, and paying the prescribed fee (*u*). And 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 by 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 (*x*). Certified copies of register, &c., by Comptroller.

Falsification of the register, or of documents purporting to be copies of the register, or using any such documents, is made a misdemeanour (*y*). Falsification of register.

(*q*) See *Re Rivière's Trade-Mark*, 26 Ch. Div. 48, 53. For matters relating to rectification, cf. sect. 35 of the Companies Act, 1862, and the notes thereon in Buckley on the Companies Acts.

(*r*) (1883) Sect. 91.

(*s*) *Post*, p. 252.

(*t*) Rules, Sched. I.

(*u*) (1883) Sect. 88. For fee, see the schedule to the Rules, *post*, p. 185, Forms I and J, *post*, p. 249.

(*x*) (1883) Sect. 96.

(*y*) (1883) Sect. 93.

# CHAPTER VI.

## THE PROPRIETOR.

Definition of proprietor.

THE registration is to be made on the application of any person claiming to be the proprietor of any new or original design (*a*), and in sect. 61 a definition of the word "proprietor" is given. It runs as follows: "The author of any new and original design shall be considered the 'proprietor' thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise."

Persons who may be proprietors.

From this it will be seen that there are five classes of persons who may be considered proprietors: (1) the author of the design; (2) a person who employed the author to execute the work for good and valuable consideration; (3) a person acquiring the design for good or valuable consideration; (4) a person acquiring the right to apply the design to articles, &c.; (5) persons on whom the design or these rights may devolve.

Speaking of those included in (2), Malins, V.-C., in *Lazarus* v. *Charles* (*b*), said: "I take it that where a person is engaged in any ornamental business, and has a workman in his employ

(*a*) (1883) Sect. 47 (1).

(*b*) (1873) 16 Eq. 117; 42 L. J. Ch. 507; and see *Re Heinrich's Design*, (1892) 9 R. P. C. 73. And as regards the rights of a master to the book in which his servant has entered his inventions, see *Makepeace* v. *Jackson*, (1814) 4 Taunt. 770.

under him, who makes a design which is new and original, that design would become the property of his master by virtue of the relations that exist between them."

The case of *Lazarus* v. *Charles* (*bb*) is a good illustration of the limits within which the claims of persons demanding registration under (3) will be allowed. The plaintiffs had seen a design in a shop in Frankfort, and they entered into a contract with the designer and manufacturer at Frankfort, to purchase from him baskets of the design in question, which they imported into this country. The Vice-Chancellor decided that they were not proprietors. He said: "Here it is admitted that the plaintiffs are not the designers of the article, and though they stated in the original bill that they were the designers, a different version is given of the plaintiffs' right in their subsequent affidavit, and it now turns out that they saw the design in a shop at Frankfort, and that they brought it over to this country; but they state that they entered into an agreement with the manufacturer at Frankfort that they would purchase these baskets from him. This shows at once that the plaintiffs are not entitled to any merit of invention; they only did as any one else might do, that is, they purchased the articles, but they gave no consideration to entitle them to be the proprietors of the design under the terms of the Act, for the agreement to purchase the articles from the manufacturer can form no consideration within the meaning of the statute. Therefore they are not the designers of the article, nor are they entitled to be the proprietors by virtue of having purchased the design for valuable consideration. That is, in my opinion, a fatal objection to the plaintiff's title."

A person acquiring the right, for good or valuable consideration, to apply the design is a proprietor, whether he uses the right exclusively of any other person or otherwise. Under these words may be included an assignee of the registered design (*c*). The procedure relating to assignment is dealt with *post* (*d*).

Licensees also may be registered as proprietors (*e*), and unless Licensees.

(*bb*) See previous note.
(*c*) See *Jewitt* v. *Eckhardt*, (1878) 8 Ch. Div. 404.
(*d*) P. 80, and see *ante*, p. 68; and see (1883) sect. 55 and sect. 87.
(*e*) *Jewitt* v. *Eckhardt* (*supra*).

they are so registered they cannot proceed against infringers (*f*). But a person engaged as exclusive agent for sale with power to register the designs in his own name for protection, is not entitled to registration as proprietor, when there is given no right to manufacture in accordance with the design, or to apply the invention to goods manufactured elsewhere; for this see *Re Guiterman's Registered Design* (*g*). In *Jewitt* v. *Eckhardt* (*gg*), by a verbal contract made in July, 1877, C., an American manufacturer, purported to sell to the plaintiff the exclusive right to sell in England an article newly designed and then about to be manufactured, and also to obtain such protection for the same as he could do under English law, it being stipulated that the plaintiff should obtain the article exclusively from C.: by the same contract C. agreed to sell to the plaintiff the first twenty cases of the article for the price agreed upon, which was to cover both the right and the goods. In September, 1877, the cases were delivered in England to the plaintiff, who paid the money due under the contract. Meanwhile, in August, 1877, the plaintiff had obtained registration of the design under 5 & 6 Vict. c. 100, and the copyright therein was granted to him for the term of three years. In an action to restrain the alleged infringement by the defendant of the plaintiff's copyright: held, on the evidence, that the plaintiff had not acquired under the contract the right to apply the design to a manufactured article, so as to entitle him to register it in his own name under the Act: held, also, that the plaintiff's right (if any) to protection could not have accrued till the completion of the purchase.

Licences and assignments must be in writing.

It is necessary to registration of assignees or licensees that the assignment or licence should be in writing. Such was expressly decided in *Jewitt* v. *Eckhardt* (*gg*) under the former Act, and it is submitted that the law is still the same (*h*). The assignment or licence cannot be registered until the original proprietorship has been registered (*gg*). Jessel, M.R., in *Jewitt* v. *Eckhardt* (*gg*), says: "It would have this very singular consequence if you could. If a licence by the author or the sole proprietor of a design be granted before

(*f*) *Wooley* v. *Broad*, (1892) 1 Q. B. 806; 61 L. J. Q. B. 259; 9 R. P. C. 208.
(*g*) (1886) 55 L. J. Ch. 309.
(*gg*) *Jewitt* v. *Eckhardt*, *ante*, p. 79.
(*h*) Wright, J., in *Wooley* v. *Broad*, (1892) 1 Q. B. 806; 9 R. P. C. at p. 212.

registration, and the licensees had a right to register and to publish, nobody else could register it afterwards, and the original proprietor would lose his right, which would be a singular result. Whereas, if the provision of the Act is, as I think it is, to have registration on the part of the author and proprietor before he grants out the partial interests, then there is no difficulty, because every man who gets a partial interest registers under the 6th section, and that grant must be in writing."

On death of the proprietor, the property in the design goes to his personal representatives, and they become the proprietors.

It is also worthy of observation that in disputed cases the burden of proving proprietorship is on those who claim it (*i*).

(*i*) *Hothersall* v. *Moore*, (1892) 9 R. P. C. 27 ; *Re Heinrich's Design* (*supra*).

# CHAPTER VII.

## MARKING.

Marking of articles.

**In order to prevent infringement through ignorance of registration, it has been provided that "before delivery on sale of any article to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article" (*a*).**

Cesser of copyright on failure to mark.

R^d^. for Classes 1—12.

**And Rule 32, as amended by the Designs Rules, 1893, prescribes that the proprietor shall, if the article is included in any of the Classes 1 to 12 (*b*), cause the article to be marked with the abbreviation "R^D^." and if the article is included in Classes 13 or 14 (*b*), cause each such article to be marked with the abbreviation "REG^D^." On any article other than lace shall be placed the number appearing on the certificate of registration.**

Reg^d^. for Classes 13 & 14.

Marking essential.

**The Act will be construed strictly (*c*). But it has been decided that if an article in Classes 1 to 12 is marked "REG^D^.," the copyright in the design is not lost, inasmuch as the greater will include the less (*d*). The substitution of "R^D^." for "REG^D^." on goods in Classes 13 and 14 would probably be fatal.**

**The copyright will be lost for want of marking even though the sale be made abroad (*e*). And though but one article be sold without a mark, the copyright may be lost to the proprietor (*f*).**

Differences

**The wording of this section is not the same as that of the cor-**

(*a*) (1883) Sect. 51.

(*b*) See Schedule III. to the Rules, *post*, p. 186.

(*c*) *Pierce* v. *Worth*, (1868) 18 L. T. N. S. 710.

(*d*) *Heinrichs* v. *Bastendorff*, (1893) 10 R. P. C. 160.

(*e*) *Saranzin* v. *Hamel*, (1863) 32 L. J. Ch. 380; 7 L. T. N. S. 560; 32 Beav. 145.

(*f*) *Hunt* v. *Stevens*, (1878) W. N. 79.

responding section under the former Acts. It is now provided that the mark must be upon the articles "before delivery on sale"; under 5 & 6 Vict. c. 100, it was provided that the mark must be upon the article "after publication." The difference would seem to be that whereas exhibiting a design without a mark (*e.g.* exhibition by travellers with a view to getting orders) would have caused a forfeiture of copyright under the old Act, under the present law that action will not cause forfeiture.

Difference between the repealed Acts and the present Act as to marking.

But mere desire and intention to comply with the Act will not avail, if as a fact the article is delivered on sale unmarked. This is illustrated by the case of *Wooley* v. *Broad* (*g*). The facts were that W., the registered proprietor of lace designs, agreed to sell to W. & Co., and did sell, lace manufactured by W. according to the design, in the brown or unfinished state; W. & Co. were to have the exclusive right to sell the lace manufactured according to the design in the finished state. W. & Co. agreed to register the design in W.'s name, and to mark the lace before putting it on the market. Lord Coleridge held that the transaction between W. and W. & Co. amounted to a "delivery on sale," and that the lace being unmarked, the copyright in the design had been lost.

Mere desire and intention to mark ineffectual.

The proviso "unless the proprietor shows that he took all proper steps to ensure the marking of the goods" (*h*), was not in the former Designs Acts. Under these it was decided that a proprietor who had ordered from a maker plates with the proper words and numbers, but who had sold an article before the plates had arrived, had lost his copyright (*hh*). It is submitted that even the proviso would not protect in such a case.

Proviso in favour of a proprietor who takes proper steps to mark the goods.

In one case the proprietor instructed the manufacturer to stamp the proper mark upon the articles, and furnished him with a die, but the manufacturer by inadvertence stamped them with another die, and the proprietor sold some of the articles without observing and error; Pearson, J., decided that the copyright was not lost, and that the proprietor was protected by the proviso (*i*). But in

Wrong number used for mark.

(*g*) L. R. 2 Q. B. 307; 61 L. J. Q. B. 808; (1892) 9 R. P. C. 429.
(*h*) (1883) Sect. 51.
(*hh*) *Pierce* v. *Worth*, *supra*.
(*i*) *Wittman* v. *Oppenheim*, (1884) 27 Ch. Div. 260; 54 L. J. Ch. 56; 50

that case the letters "R$^{D}$." were stamped on the article, though the numbers were incorrect. In the course of his judgment, Pearson, J., said: "The next question is, what is the meaning of the words 'unless the proprietor shows that he took all proper steps to insure the marking of the article.' I can understand that this proviso would hit the case of the marking being imperfect, deficient, for instance, in a number or part of a number. But in a great many cases which might arise I should find it far more difficult to decide what the words meant, and I hope that it may fall to the lot of some other Judge than myself to deal with such cases when they arise. Taking the words literally, they would extend to such a case as this—if the proprietor of a design employed a manufacturer to make a large quantity of the articles for him, and gave him directions to put the proper mark on them, and the manufacturer omitted to put any mark at all on them—I do not intend to decide the point now, it is not necessary that I should do so, but—so far as I can see at present, the whole of those goods might be sold in the market without any mark at all, and yet the copyright would not be forfeited, if the saving clause is to be read literally."

In *Wooley* v. *Broad* (*k*) it appeared that the lace was never sold retail in the brown state, that on finishing the lace goes through several processes, and that if a ticket with the registration made were put on the brown lace, it would have to be taken off during the finishing operation, otherwise it would be destroyed. Also it was proved that the agreement was that W. & Co. should see to the proper marking before putting the lace on the open market. Nevertheless it was decided that the plaintiff had not brought his case within the proviso.

**Failure to mark by wearing out of mould.**

In *Johnson* v. *Bailey* (*l*), two designs for earthenware teapots were registered; on the bottom of each teapot was a raised parallelogram with some marks thereon which could not be deciphered, but which were said by the proprietor of the design to

L. T. N. S. 713; 32 W. R. 767. In this case it was also decided that in a proper case the proprietor of a design registered under 5 & 6 Vict. c. 100, may now obtain the advantage of this proviso.

(*k*) *Supra.*

(*l*) (1893) 11 R. P. C. 21.

be "R$^{D}$." and the number. It further appeared that the teapots were made in moulds which had at the bottom a hollow parallelogram with "R$^{D}$." and the figures embossed. The mould was liable to wear out. The proprietor had given precise instructions to his workmen that each teapot should bear the prescribed mark, and he believed that his instructions had been carried out. It was decided that the proprietor had not done sufficient to bring his case within the proviso; it is not sufficient to prove general instructions; he should have seen that his instructions were carried out, either by inspection of each teapot, or in some other manner. The Court of Session added that it is not possible to give any definition of general application of the meaning of the words of the statute, "all proper steps to ensure the marking of the article." Every case must be judged according to its own special facts, and the question is one for the jury to answer (*m*).

It is the duty of the proprietor to put the mark upon the article. A licensee may be a proprietor (*n*), and any sale by him of an article without the registration mark will cause forfeiture of the copyright. The same result may be caused by the neglect of a co-owner. Under the old Acts the interest of the person who published without the mark was alone affected by the want of mark.

Removal of mark by purchaser. Illegible mark.

But if the mark be properly placed on an article, the copyright will not be affected though the mark be removed by any person not being the proprietor (*o*) (*e.g.* by the purchaser); nor though the mark has become illegible. In *Fielding* v. *Hawley* (*p*) it was decided that if during the process of manufacture, *e.g.* by firing and glazing, the mark becomes in some cases illegible, it having been properly there originally, the protection is not lost. But if the mark has never been properly applied the case is different (*q*).

Method of marking.

It is sometimes difficult to say in what manner the mark should be applied. The following rules, it is submitted, represent the law

(*m*) P. 24.

(*n*) (1883) Sect. 60.

(*o*) Coleridge, J., in *Heywood* v. *Potter*, (1853) 22 L. J. Q. B. 133; 20 L. T. N. S. 207; 1 E. & B. 439; *Saranzin* v. *Hamel*, (1863) 32 L. J. Ch. 380; 7 L. T. N. S. 660; 32 Beav. 145.

(*p*) (1883) 48 L. T. N. S. 639.

(*q*) See *Johnson* v. *Baily*, (1893) 11 R. P. C. 21.

as it now stands: (1) The marks may be put on by making the same in or upon the material itself or by attaching thereunto a label with the marks upon it (*r*). (2) The article sold is alone the thing to be marked (*s*). (3) If the article is sold in long strips, each strip must be marked; if it be sold in small pieces, each piece must be marked (*t*).

The following cases are illustrative:—

Butter dish and cover.

*Fielding* v. *Hawley* (*u*). A design was registered for a butter-dish and cover, the cover being separate from the dish, and the entire design being upon it; the dish was marked. It was held that this was sufficient, inasmuch as the dish and cover together formed the article sold.

Book of designs need not be marked.

*De la Branchardière* v. *Elvery* (*x*). The plaintiff, the registered proprietor of a registered design for lace collars, published a book containing copies of the design. It was decided that the non-marking of the copies in the book was not a breach of the requirements of the statute, which made marking of the "articles" compulsory.

Paper-hangings.

*Heywood* v. *Potter* (*y*). The designs in question were applicable to paper-hangings, and the plaintiff had sold unmarked patterns. The ordinary custom was to sell paper-hangings in pieces of twelve yards each, and the plaintiff had caused the proper mark to be placed upon each piece of twelve yards, but not upon the patterns which had been cut off from the twelve yards pieces. The patterns were sold. Lord Campbell, C.J., and Wightman, J., considered that the plaintiff had not complied with the Act as regards marking; Coleridge, J., was of a contrary opinion. Coleridge, J., admitted, however, that the patterns were articles of manufacture within the literal sense of the Act, and it has been decided that the

(*r*) *Blank* v. *Footman*, (1888) 39 Ch. Div. 678; 57 L. J. Ch. 909; 36 W. R. 921; 59 L. T. N. S. 567; 5 R. P. C. 653. This was expressly provided by sect. 4 of the Act of 1842.

(*s*) *Blank* v. *Footman* (*supra*); *Fielding* v. *Hawley*, (1883) 48 L. T. N. S. 639; *De la Branchardière* v. *Elvery*, (1849) 18 L. J. Ex. 381; 4 Ex. 380.

(*t*) *Heywood* v. *Potter*, (1855) 22 L. J. Q. B. 133; 20 L. T. N. S. 207; 1 E. & B. 439; *Blank* v. *Footman* (*supra*); *Hothersall* v. *Moore*, (1892) 9 R. P. C. 27.

(*u*) *Supra.*

(*x*) *Supra.*

(*y*) *Supra.*

Designs Acts are to be construed strictly (*z*). It is submitted, therefore, that the view of the majority of the Court would be fully accepted. In *Fielding* v. *Hawley* (*a*), Field, J., said: "If a manufacturer takes a large piece and cuts it up into smaller pieces as samples or otherwise, then of course each must be marked." Under the present Act this would be so only if the samples were sold.

*Blank* v. *Footman* (*b*). The design was one for trimmings; there was no mark upon the trimmings, but they were sold in pieces of 144 yards in length, and round each piece was a label bearing the proper mark. This was held to suffice. Kekewich, J., said: "It has not been argued that the trimming itself ought to be marked, and it would be impossible, and it is admitted that it would be impossible, to say where and how often it should be marked. It is obvious that you could not mark every quarter of an inch, and that even if you could do it, you could not in lace work like this preserve the thing if you were to stamp it with marks. Therefore it is not suggested that this ought to be done, but it is said that every article, however small, ought in some way to show that it is a registered design. That to my mind is entirely a misconstruction of the 51st section. The Act may or may not go far enough, but the Act says that a mark is to be placed before delivery on sale of any articles to which a registered design is to be applied. The marking is to be caused to be done by the proprietor of the design. If the proprietor of this design does not sell those articles of dress to which the trimmings are affixed, the section lays no liability upon him to mark those articles of dress. What is to be marked by him is the article to which a registered design has been applied—that is the trimming. If he sells it in pieces of 144 yards he must mark the pieces of 144 yards. If on the other hand he sell small pieces, whether for patterns or for use, he must mark each small pattern in some manner in which those things can be conveniently marked, as, for instance, by tying on a label or by printing something on the packet in which it is. But he is not bound to mark any thing but that which he sells, and that is the

Trimmings.

(*z*) *Pierce* v. *Worth*, (1868) 18 L. T. N. S. 710; and see *Johnson* v. *Baily*, (1893) 11 R. P. C. 21.

(*a*) *Supra.*

(*b*) *Supra.*

exact consequence of the decision in *Fielding* v. *Hawley*. There the Court held that whether it was a small piece or a large piece he must mark the piece sold, and so I say—he must mark the piece sold and need not mark anything else. That is the obligation the law lays upon him, and it seems to me that in this case the obligation has been complied with."

Dusters.

*Hothersall* v. *Moore* (*c*) was a case relating to a design for dusters. The dusters were made up into pieces which could be cut up into twelve dusters, and a gummed label, having upon it the proper mark, was attached to each piece. As it was proved that the piece was intended to be cut up into twelve dusters, Bristowe, V.-C., came to the conclusion that there were twelve articles in each piece and not one, and that the marking was defective.

There might be some difficulty in following the decision so far, for the registration was of the piece, the goods were sold by the piece, and the piece was marked. It might therefore well be argued that the article sold had the mark upon it. But it seems that the piece was made with the intention that it should be cut into twelve pieces and so sold, and the Court found as a fact that the proprietor himself was actually cutting up these pieces into individual dusters, and was having them hemmed and prepared for sale. The decision amounted to a finding of fact that the so-called pieces were in reality twelve articles.

(*c*) *Supra*.

# CHAPTER VIII.

## INFRINGEMENT.

Effect of Registration

THE effect of registration is to give the registered proprietor of the design a copyright for five years from the date of registration (*a*), that is, from the date of the receipt of the application for registration by the Comptroller (*b*). This means that the registered proprietor shall have the exclusive right to apply the design to any article of manufacture or to any substance in the class or classes in which the design is registered (*c*). Pending the existence of the copyright in the design, therefore, it is the right of the registered proprietor to have infringement prevented.

It is necessary in the first place to determine what is infringement.

### INFRINGEMENT.

The first part of sect. 58 of the Act of 1883, as amended by sect. 7 of the Act of 1888, runs thus :—

(*a*) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply or cause to be applied such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural ; and

(*b*) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

(*a*) (1883) Sect. 50 (1).
(*b*) Rule 20.
(*c*) (1883) Sect. 60.

Different position of a manufacturer and vendor of a pirated design.

This section makes a very considerable difference in the position of an infringer, depending upon whether he be a manufacturer of the article or merely a vendor of it. In the former case innocence is not an excuse, in the latter case it is.

Position under repealed Act of 1842.

Under the Act of 1842 it was forbidden to publish, sell, or expose for sale, "after having received, either verbally or in writing, or otherwise from any source other than the proprietor of such design, knowledge that his consent had not been given, or after having been served with, or had left at his premises a written notice, signed by such proprietor or his agent to the same effect (*d*). Under this section it was decided that a notice from the proprietor is not sufficient unless it expressly state that the proprietor of the design has not given his consent to the application of the design, and which does not state whether the proprietor intends to sue either for the application of the design to an article of manufacture, or for the sale of such article with the design applied; the notice should have specified the real claim intended to be made (*e*). Under the present Act an express notice is not required; it is sufficient to constitute a piracy by a vendor if the vendor can be in any way shown to be aware that the proprietor has not given his consent to the use of the design in question. But the case just mentioned is valuable as an example of the kind of knowledge that must be proved to exist (*f*).

And under the existing Acts.

The notice required to affect a vendor.

The sub-section (*b*) of the 58th section is intended to protect a retail dealer, or dealer selling goods and not being himself the manufacturer of them, so that if he sell goods of which he has no knowledge that they are registered he does no wrong; but if he sells them after knowledge is brought home to him that the designs are registered and that the proprietor is not an assenting party to their sale by him he became liable (*f*).

Cases on knowledge of vendor.

In *Smith* v. *Lewis, Roberts & Co.* (*g*), the facts were these: On 17th May, 1887, the plaintiff's solicitors wrote to the defendants, "Mr. Robert Smith informs us that it has come to his knowledge that you have in your warehouse exposed for sale, and have been in the habit

(*d*) 5 & 6 Vict. c. 100, s. 7.
(*e*) *Norton* v. *Nicholls*, (1859) 28 L. J. Q. B. 225; 33 L. T. 131; 7 W. R. 720.
(*f*) *Smith* v. *Lewis, Roberts & Co.*, (1888) 5 R. P. C. 611, 614.
(*g*) *Supra.*

of selling, Leno canvas striped goods, the patterns of which have been registered by our client. On his behalf we have to request you within seven days from this date to supply us with a full statement showing the quantity of goods which you have sold, the quantity you have in stock, the name of the manufacturer. If this information is not given within the time mentioned our instructions are to commence an action against you forthwith." Some of the goods were sold for the defendant on 21st May, he being then away from business, but on his return he stopped the sale; it was, however, not till 6th June that the defendants became convinced that they had been dealing in goods of the plaintiff's registered design. Bristowe, V.-C., found for the defendants. He said (*h*): "In this case the retail dealer is selling goods for a considerable period of time, and he had no claim made against him on the ground that the goods were registered goods at all. In order to bring the case within the Act of Parliament, I think it must be necessarily shown that the retail dealer knew at the time of the exposition for sale that the design applied to the goods exposed for sale was applied without the consent of the registered proprietor. Now surely it is necessary that the person giving the first notice should give such a notice, if it is in writing at all, as to be intelligible to the person charged, so that he may know what is alleged against him. . . . . He must have the particular thing explained to him which it is claimed has the right of registration." The Vice-Chancellor said that the letter of notice was too vague, as it did not contain any pattern of the design, nor state any detail of what was claimed.

A notice held too vague.

The result seems to be that a vendor who has not actually applied the design to goods, but who is selling goods to which the design has been applied, will not be guilty of piracy unless it can be shown that he was publishing or selling with knowledge of the facts; and knowledge will not be imputed to him on the strength of the receipt of notice, unless the notice clearly specifies the design alleged to be infringed. He is not bound to regard rumours, nor, provided he acts with *bona fides*, to follow up with inquiries an ambiguous notice. On the other hand, he certainly will not be allowed to escape, even if he received no direct notice at all, if

Notice to show knowledge must be explicit.

(*h*) Page 615.

the Court is of opinion that he had other knowledge that the goods he is selling are infringements of a registered design.

Liability of agent.

A person acting as agent for another may be liable for infringement, if he publish or exposes for sale goods to which the design has been applied, and if he is aware that the proprietor has not given his consent to this (*i*).

Sale by vendees of licensee.

If the proprietor grants a licence to make goods to which the registered article has been applied, the vendees from the licensee do not infringe if they in turn sell the articles, though they know that the registered proprietor has not given his consent to their so doing. The licence involves consent to sale by vendees of the licensee (*k*).

Three classes of infringement.

The section seems to point to three classes of infringement, viz. (a) Application of the design for the purpose of sale; (b) Application of any fraudulent imitation of the design for the purposes of sale; (c) Application of any obvious imitation of the design for the purposes of sale (*l*). Copyright in a design being conferred by statute, and the Patents Acts, 1883 to 1888, forming a complete code as to actions for infringement (*m*), it follows that unless the application of the design falls in one of these classes, there is no infringement. Hence there seems to be nothing to prevent an imitation of a design unless the purpose for which the imitation is made be the sale of the article to which the design is applied.

No infringement unless sale purposed.

Imitation.

"Imitation" is a word used in different senses. If it be taken to mean an exact copying of the design, it is undoubtedly an infringement. But if it mean a fair imitation of it, accompanied by original work, so that the old design and the new design are different substantially, there may be no infringement. In *Thom* v. *Sydall* (*n*) it was said by Wickens, V.-C., that the mere fact that defendants had worked upon the plaintiff's design constituted no case to show that patterns registered by sample have been infringed by the de-

(*i*) *Moet* v. *Couston*, 33 Beav. 578; 10 L. T. (N. S.) 395; *Upmann* v. *Elkan*, 7 Ch. 130; 41 L. J. Ch. 246; 25 L. T. (N. S.) 813; 20 W. R. 131; *Nobel's Explosives Co.* v. *Jones*, (1880) 17 Ch. Div. 721, 742 (affd. 8 App. Cas. 4); 49 L. J. Ch. 726.

(*k*) *Thomas* v. *Hunt*, (1864) 17 C. B. N. S. 183.

(*l*) "Obvious" imitation was not mentioned in 5 & 6 Vict. c. 100, s. 7.

(*m*) *Wooley* v. *Broad*, (1892) L. R. 1 Q. B. 806; 9 R. P. C. 208.

(*n*) (1872) 26 L. T. N. S. 15.

fendants. In *Barran* v. *Lomas* (*o*) the late Master of the Rolls said that a fair imitation of an original kind is not an infringement.

Obvious imitation.

The words "obvious imitation" were construed in the case of *Grafton* v. *Watson* (*p*). Mr. Justice Chitty said that "obvious imitation" was such an imitation as would strike the eye (assisted if need be with expert evidence) as clearly taken from the original design. To test this, the designs need not be put side by side; it is permissible to look first at one and then at the other, or to look at them both a little distance off. If then they seem the same, so much so that from memory they are indistinguishable, there is an obvious imitation and therefore an infringement. So there is an obvious imitation if when the designs are used on dress or on furniture, they would without minute inspection be taken to be identical. If, on the other hand, on inspection the designs are found to be identical, there would not be an "obvious imitation," but an actual copy (*q*).

Fraudulent imitation.

A fraudulent imitation is imitation with knowledge that the pattern is a registered design, and without any sufficient invention on the part of the imitator (*r*). In *Sherwood* v. *Decorative Tile Co.* (*s*), Manisty, J., quotes some remarks of Cotton, L.J., adding some of his own. He says: "It may not be easy, I do not say it is impossible, to define in words exactly what is meant by a fraudulent imitation. I think the word was introduced for the very purpose of meeting the case of an imitation, not an obvious imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud. For instance, having before your mind and before your eye the design of another and introducing into your design some differences in order, if possible, to avoid coming within the Act of Parliament; and I do not think I can do better (seeing that I have not had time to write a judgment, and I think it very desirable to give one without writing it) than read a few lines from Lord Justice Cotton's judgment in *Grafton* v. *Watson* as applicable to

(*o*) (1880) 28 W. R. 973.

(*p*) (1884) 50 L. T. N. S. 420; 51 L. T. N. S. 141.

(*q*) 50 L. T. N. S. 420; and see *Sherwood* v. *Decorative Tile Co.*, (1887) 4 R. P. C. 207.

(*r*) Cotton, L.J., in *Grafton* v. *Watson*, (1884) 51 L. T. N. S. 141; *Barran* v. *Lomas* (*supra*).

(*s*) *Supra.*

this point. In that case there was an application (it was a very strong thing in such a case to grant an injunction) for an injunction before trial to restrain the defendant from using the plaintiff's design. Lord Justice Cotton says: 'These designs obviously were seen by the defendants before they gave instructions for preparing their designs; and it is remarkable that though there is undoubtedly a certain dissimilarity, yet to the eye there is, as is admitted, such a general similarity as to produce the appearance of imitation, as was said by the counsel for the defendants, when you hold it at a certain distance.' That is just the argument that has been used in this case. In that case the counsel admitted that the defendants had seen the plaintiff's design, and in this case they wish me to come to the conclusion that they had not seen it, and I shall comment upon that in a few moments. Let me see how the Lord Justice proceeds: 'Undoubtedly there are differences, but when one looks at the designs one sees that the places where the light ground is covered with the dark colour (I call all colour dark as compared with the light ground) in the intervals of what is called the dominant ornament are very much the same both in those patterns of the plaintiffs', which are said to be imitated by the defendants, and in the defendants' patterns; and the subordinate arrangement, although entirely old, is so arranged with reference to the dominant as in substance to produce something like a similarity, and that I think upon the evidence is a *primâ facie* case on behalf of the plaintiffs if it is fraudulent. Fraudulent imitation to my mind must mean this: if a man knowing that the pattern is a registered design goes and imitates it, and does that without any sufficient invention on his own part, that would be a fraudulent imitation, if in fact it is an imitation. There may be an imitation which is unconscious, that is to say, not an imitation in the sense of copying—a producing of the same effects without knowing of the registered design, but when the registered design is known, then, if there is imitation, the burden of proving that the registered design was not copied is, to my mind, thrown on the person who produces the pattern like that which is imitated. It is not fashion, or anything of that sort, that is to be protected, the design is to be protected. In my opinion there is here a *primâ facie* case of imitation, and without such further explanation as may be given by the

Unconscious imitation.

defendants, such *primâ facie* imitation is, in my opinion, within the meaning of the Act a fraudulent imitation.' It was a strong thing to grant the injunction before trial, but it establishes this, that where you find these minor differences alluded to by the Lord Justice, and find what he points out, and which really exist in this case, then there is a *primâ facie* case."

Infringement a question of fact.

Infringement is a question of fact and is a matter left to the jury (*t*). Though witnesses may be examined, and should be heard if desired by the parties (*u*), the point is one to be determined by the eye (*x*). The question of novelty, apart from questions of priority, and so far as similarity or identity of designs is concerned, and the question of infringement raise almost precisely the same kind of consideration, and the decisions dealt with in the chapter on novelty may be referred to here (*y*). Hence an application for infringement is often met with an application to expunge from the register for want of novelty the design alleged to have been infringed, and much of the evidence and arguments will apply to action and motion alike (*z*).

What amounts to infringement.

Appearance the same.

When infringement is alleged it is necessary to prove, not that the imitating article is identical in all respects with the registered article, but that it is to all appearance the same. In *Holdsworth* v. *McCrea* (*a*) Lord Westbury said that when a pattern is registered as a whole anything which is a facsimile is an infringement, anything which produces it in its integrity; but that which is different in shape or form or in the relative positions of the different parts, which is not a reproduction of it, would not be an infringement. Dealing with the same case, and with these words, Lord Hatherley said (*b*) that what was meant was that "the designer is

(*t*) As in *Chard* v. *Cory*, (1892) 9 R. P. C. 423.

(*u*) *Mitchell* v. *Henry*, (1880) 15 Ch. D. 181; 43 L. T. N. S. 186.

(*x*) *Grafton* v. *Watson*, (1884) 50 L. T. N. S. 420; 51 L. T. N. S. 141; *Hothersall* v. *Moore*, (1892) 9 R. P. C. 27; *Demartial* v. *Booth*, (1892) 9 R. P. C. 499; *Holdsworth* v. *McCrae*, (1867) L. R. 2 H. L. 380; *Hecla Foundry Co.* v. *Walker*, (1889) 14 A. C. 550, 556; 6 R. P. C. 554; *Mitchell* v. *Henry* (*supra*); *Sherwood* v. *Decorative Tile Co.* (*supra*).

(*y*) *Ante*, p. 23.

(*z*) *E.g.*, see *Le May* v. *Welch*, (1884) 28 Ch. Div. 24; 54 L. J. Ch. 279; 51 L. T. N. S. 867; 33 W. R. 33.

(*a*) (1867) L. R. 2 H. L. 380, 386.

(*b*) (1870) 6 Ch. 418; 23 L. T. N. S. 444.

not bound, as in a patent case, to distinguish the new from the old, and is allowed to register his pattern without distinguishing what is new from what is old; but if he chooses to put it in that way, it will not be protected against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner, as I hold they are in this case, and have the same effect, or nearly the same effect, then of course the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the defendants from the consequences of their piracy."

Lace. And see *Barran* v. *Lomas* (*c*), in which Jessel, M.R., said that the production of an article containing an alteration which does not substantially change the design is still an infringement; thus, if one register lace, worked in the shape of animals and trees with dots between, another designer cannot escape the penalties of infringement if he vend the same design though with the omission of the dots.

Kitchen-range door. In *Walker* v. *Hecla Foundry Co.* (*d*) the design in question was one for a door for a convertible kitchen range—a rectangular door with a moulding cast on the top of it. The alleged infringement was a rectangular door surrounded by a moulding, and except that the moulding had a different section from the moulding of the former door, if the doors were represented in a drawing, there would be nothing to distinguish the designs. But there was a difference when the doors were looked at in section. It was decided that there was an infringement, and on appeal this was confirmed. The case was affirmed by the House of Lords (*e*), and Lord Herschell said (*f*): "It seems to me, therefore, that the eye must be the judge in such a case as this, and that the question must be determined by placing the designs side by side, and asking whether they are the same, or whether the one is an obvious imitation of the other. I ought, perhaps, to qualify this by saying that, as a design to be registered must, by sect. 47,

Eye the judge.

(*c*) 28 W. R. 973.

(*d*) (1887) 5 R. P. C. 365; in the House of Lords (1889) 14 A. C. 550; 6 R. P. C. 554.

(*e*) (1889) 14 A. C. 550.

(*f*) Pp. 555, 556.

be a 'new or original design, not previously published in the United Kingdom,' one may be entitled to take into account the state of knowledge at the time of registration, and in what respects the design was new or original, when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial. Applying the test which I have laid down, I have come to the conclusion that there has been a violation of the respondents' rights. There are, no doubt, certain distinctions between the door shown on their drawing and that manufactured by the appellants. But to establish this is not enough to free them from liability. By sect. 58 of the Act, it is not lawful for any person to apply either the design 'or any obvious imitation thereof' in the same class of goods in which the design is registered. It is impossible in such a case as the present to give reasons for the opinion formed. I can only say that to me it appears, without doubt, that the door complained of is an obvious imitation of the registered design."

But if there be a real and substantial difference, there is no piracy. Thus in *Walker* v. *Scott* (*g*) plaintiff registered a tin oil-can for cyclists rounded at the edges; defendant sold an oil-can similar to the plaintiff's save that the edges were sharp. It was decided that since the only novelty in the plaintiff's can was the rounded edges, and as the defendant had not copied these, there had been no piracy.

Attempts to imitate without infringement.

It sometimes happens that a trader orders his designer to produce a design after the style of one already registered by a rival trader, but so that it may not infringe that design. If the designer can accomplish this, there is of course no piracy, but if the Court discovers an attempt such as this to sail as near as possible, it will narrowly look into the result, and the burden of proving that there has been no infringement will be heavy upon the defendant (*h*).

Intention immaterial except as to fraud.

If there be an infringement, *bonâ fide* intention not to infringe will not protect (*i*), though fraudulent imitation will in such case be rebutted. The question of infringement depends upon what a

(*g*) (1892) 9 R. P. C. 482.

(*h*) *Grafton* v. *Watson* (per Cotton, L.J.), 51 L. T. N. S. 141.

(*i*) Lord Shand in *Walker* v. *Hecla Foundry Co.*, (1888) 5 R. P. C. 365, 367; *Mitchell* v. *Henry*, (1880) 15 Ch. Div. 181; 43 L. T. N. S. 186.

man does, not on what he intends (*k*). The sale of a single article without permission is sufficient to found the action (*l*).

## Remedies for Infringement.

Penalties. Not exceeding £50 or £100 in all.

Any person who infringes shall "be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum on a simple contract debt by action in any Court of competent jurisdiction; provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds" (*m*). The power to determine the amount of the penalty rests with the Court, save that a maximum is fixed.

In *Sherwood* v. *Decorative Art Tile Co.* (*n*), Manisty, J., had a case before him in which the infringers had sold 100 tiles, wrongful imitations of the plaintiff's designs, and he fixed the penalty at 50*l*., saying that it could not have been meant by the Legislature that on a sale of 100 tiles the penalty could be 5,000*l*.; and the Act of 1888 now provides that the sum forfeited in respect of any one design shall not exceed 100*l*. It is submitted that this must mean that the amount shall not exceed 100*l*. in respect of each offence of which the accused is found guilty in the one action. Under the Copyright Act of George III. it has been decided that two penalties may be recovered for infringement on the same day, if the facts of sale be independent and distinct (*o*).

If there are no aggravating circumstances, the penalty will be light. Such was the case in *Saunders* v. *Wiel* (*p*), where Cave, J., said: "The next question is what sum of money ought I to give by way of judgment. This is a penalty. That has been decided in this very case. It is an action for a penalty, and the maximum sum is 50*l*. for each occasion. Now a penalty is punishment, and punishment is to be awarded in proportion to what it is that the offender has done, and no doubt if he has done it under circum-

Penalty is punishment. Principles of Assessment.

(*k*) *Stead's Patent*, (1847) 2 W. P. C. 123, 156.
(*l*) *Cole* v. *Saqui*, (1888) 5 R. P. C. 491, 493.
(*m*) Act of 1883, s. 58, as amended by Act of 1888, s. 7.
(*n*) (1887) 4 R. P. C. 207.
(*o*) *Brooke* v. *Milliken*, (1789) 3 T. R. 509.
(*p*) (1892) 9 R. P. C. 467, 470; 1893, L. R. 1 Q. B. 470; 62 L. J. Q. B. 341.

stances of aggravation the punishment ought to be heavier. If he has done it under circumstances of mitigation, the punishment ought to be lighter, and in one of the cases which has been already decided on this statute, the Court has drawn attention to that circumstance, and said that where the piracy results from accident or from mistake, then the Judge may reduce the penalty: the Judge has the power of reducing the penalty to a merely nominal one, and in that way of not confounding the innocent with the guilty. In this case no circumstances of aggravation have been brought before me at all. I do not know what it costs to produce this particular article—the particular design. I do not know what the profit is upon selling these spoons. I do not know to what extent it has been done by the defendant. There are no circumstances of aggravation at all. On the other hand there are no circumstances of mitigation. The defendant has not shown me that the resemblance was accidental, or that it was due to a mistake; he has not shown me the extent to which he has used it, and that he has stopped its further use or anything of that kind. Therefore, I am left by both parties entirely in the dark as to how I should limit this penalty. Under the circumstances, I think I must give a nominal penalty which, if further piracy goes on, would of course be a very good ground for increasing it in a subsequent case. Two cases have been proved. I do not know that there are any more, and in respect of those two cases I think it is sufficient if I give the nominal penalty of 20*s.* in each case, making 40*s.* altogether."

Damages.

The penalty may not be sufficient to recoup the proprietor for the damage done to him by the infringement. The 59th section of the Act of 1883 therefore enacts that, "Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application."

Plaintiff bound to elect whether penalties or damages claimed.

The plaintiff may be called upon to elect whether he proceeds under sect. 58 or under sect. 59 (*q*).

The damages suffered must be proved, and if this is not done, the proprietor must remain contented with the penalty inflicted.

Inquiry as to damages.

An inquiry as to damages may be ordered. In *Davenport* v. *Rylands* (*r*) Vice-Chancellor Page-Wood said: "The inquiry will be in the form, 'what damage the plaintiff has sustained,' and not 'what damage, if any,' he has sustained, as it would be in the case of a trade-mark. There is this difference between the case of a trade-mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow [illegible] the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee" (*s*).

No remedy except under Statute.

As the right to ownership in a design is conferred by the statute, and the way in which it is to be protected is also named in the statute, no remedy save that conferred by statute can be had (*t*).

But injunction may be granted on general principles.

Nevertheless the Court can by injunction restrain infringement.

If the legal right cannot be made effectual by an action for damages, the Court will, in the exercise of its discretion, grant an injunction restraining the piracy (*u*). In determining whether an injunction should be granted, the Court acts upon the general principle applicable to the granting of injunctions. And if a design has been infringed there is a *primâ facie* right to an in-

(*q*) *Saunders* v. *Weil* (No. 1), (1892) L. R. 2 Q. B. 321; 62 L. J. Q. B. 37; 9 R. P. C. 459.

(*r*) (1865) 1 Eq. 302, 308; 35 L. J. Ch. 204.

(*s*) And see *United Horse-Shoe and Nail Co.* v. *Stewart*, (1888) 13 A. C. 401, 408; 5 R. P. C. 260; *American Braided Wire Co.* v. *Thompson*, (1890) 44 Ch. Div. 274; 59 L. J. Ch. 425; 7 R. P. C. 47.

(*t*) See Mayne on Damages (5th ed.), 500; and see *Wooley* v. *Broad*, (1892) L. R. 1 Q. B. 806; 9 R. P. C. 208.

(*u*) *Wilkins* v. *Aikin*, 17 Ves. 425. The statutory remedy does not prevent the granting of an injunction; *Cooper* v. *Whittingham*, (1880) 15 Ch. Div. 501; 49 L. J. Ch. 752; 43 L. T. N. S. 16; 28 W. R. 720.

junction (*x*), the reason being that it is to be presumed that the infringer intends to go on infringing. Also if there has been no infringement, but an intention to infringe is shown, an injunction will be granted (*y*). It is not necessary to show that damage has been caused by the piracy to the proprietor (*z*). And the proprietor is entitled to an injunction restraining not only sale, but manufacture of articles to which the design is applied with intent to sell at the expiration of the copyright (*a*). An injunction has been granted in a patent case though the patent was about to expire in a few days, the intention being to prevent the manufacture of pirated goods with a view to throwing them on the market the moment the patent should expire (*b*).

Intention to infringe sufficient.

If the person who infringes undertakes not to repeat his infringement, or if there is reason to suppose on any other ground that the defendant will not infringe in future, the Court will or will not make an order for injunction, according to the other circumstances of the case. In *Geary* v. *Norton* (*c*) an injunction was given against tradesmen selling articles which infringed the plaintiff's design, though the defendants promised to commit no infringement in future. In *Millington* v. *Fox* (*d*) the defendant innocently used the plaintiff's trade-mark, and did not intend to use it again, but the Court granted an injunction. These two last named cases were explained by Cotton, L.J., in *Proctor* v. *Bayley* (*e*), where he says that the injunctions in *Geary* v. *Norton* (*c*) and *Millington* v. *Fox* (*d*) were granted because there was some reason to fear at the date of the filing of the bills that the plaintiffs were not safe. In *Proctor* v. *Bayley* (*e*) the Court came to the conclusion that though the defendant had infringed the patent, it could not be inferred that

Grounds on which an injunction will be granted.

Effect of undertaking not to repeat infringement.

(*x*) *Proctor* v. *Bayley*, (1889) 42 Ch. Div. 390; 59 L. J. Ch. 12; 38 W. R. 100.

(*y*) *Ibid.*

(*z*) See (*e.g.*) *Adair* v. *Young*, (1879) 12 Ch. Div. 13 (a patent case).

(*a*) *McCrea* v. *Holdsworth*, (1848) 2 De G. & Sm. 496.

(*b*) *Crossley* v. *Beverley*, (1829) 3 C. & P. 513; 1 Russ. & My. 166; 1 W. P. C. 119; *Sheriff* v. *Coates*, 1 Russ. & My. 159.

(*c*) 1 De G. & Sm. 9.

(*d*) (1838) 3 My. & Cr. 338; 1 De G. & Sm. 9. And see *Losh* v. *Hague*, (1837) 1 W. P. C. 200.

(*e*) (1889) 42 Ch. Div. 390, 400; 59 L. J. Ch. 12; 38 W. R. 100.

he had any intention to infringe again, and that with proper inquiry the plaintiff might have known this: upon this finding an injunction was refused. Fry, L.J., added that a "foolish attempt to justify a past act does not raise any presumption that they intend to repeat it."

The balance of convenience followed when an interlocutory injunction is applied for.

When an interlocutory injunction is asked for, and a *primâ facie* case is made out by the proprietor of the design, the Court will either grant the injunction or will order the application to stand over until the trial. If the former course be followed, the plaintiff will be required to give the usual undertaking as to damages; if the latter be adopted, the defendant will be ordered to keep an account. The balance of convenience determines what ought to be done (*f*). "It must be seen in what way the rights of the parties may best be protected and the least loss to any party caused" (*g*). An injunction has this advantage, that it may have an effect in preventing third parties infringing. But where there is grave doubt as to the title (*h*), or where there is a serious conflict as to the originality of the design (*i*), or where the plaintiff has delayed his application, the Court will not willingly interfere by way of interlocutory injunction.

Account may be ordered pending action.

In *Mitchell* v. *Henry* (*k*) the plaintiffs alleged that the defendants had imitated their trade-mark, and the Court of Appeal, finding that there was a serious conflict of evidence, refused an interlocutory injunction, but ordered the defendant to keep an account. James, L.J., said (*l*): "Then with regard to the balance of convenience and inconvenience, it seems to me by far the most convenient course that no injunction should be granted, and that the motion should stand over to the hearin the defendants undertaking to keep an account. The plaintiffs can protect themselves, as they have to a great extent already done, by circular. Moreover, the pendency of these proceedings will be perfectly well known.

(*f*) *Smith* v. *Chatto*, (1875) 31 L. T. N. S. 775; *Hildesheimer* v. *Dunn*, (1891) 64 L. T. N. S. 452.

(*g*) Lord Cottenham in *Bacon* v. *Jones*, (1839) 4 My. & Cr. 438.

(*h*) *Spottiswoode* v. *Clark*, (1846) 2 Phil. 154.

(*i*) *Sheriff* v. *Coates*, (1830) 1 Russ. & My. 159. And see *Read* v. *Richardson*, (1881) 45 L. T. 54 (a trade-mark case); *Mitchell* v. *Henry* (*infra*).

(*k*) (1880) 15 Ch. Div. 181; 43 L. T. N. S. 186.

(*l*) 15 Ch. Div. 191.

Every large purchaser in Bradford or elsewhere will know of them, and will know that he will incur liability if he makes himself a party to any continued infringement of the plaintiffs' rights, should those rights be established at the hearing. If that should be the result of the action, the defendants who undertake to keep an account will be liable to pay to the plaintiffs every farthing of the profits they make by the sale of goods by which the plaintiffs' mark is infringed, and will find themselves in this position, that they will have been using a trade-mark which they will be prevented from using afterwards, and so will lose all the reputation they have been acquiring in the meantime. Then, again, the plaintiffs will be relieved from the necessity of giving an undertaking to abide by any order as to damages if the defendants should prove successful at the hearing. Therefore on the balance of convenience and inconvenience, and having regard to the fact that the decision of the Master of the Rolls was in favour of the defendants, which ought not to be overlooked on an interlocutory application, I am of opinion that the better way will be to let the motion stand till the hearing, the defendants keeping an account."

Some considerations which determine balance of convenience.

In *Grafton* v. *Watson* (*m*) an interlocutory injunction was granted. The defendant admitted having copied the plaintiff's design so far as he legitimately could do so without infringing, and Chitty, J. (affirmed by the Court of Appeal), thought that probably the infringement had not been avoided. Moreover, it appeared that the season was short, and an injunction would alone prove a real remedy to the plaintiff if his contention should eventually turn out to be correct.

There is no express provision for delivery-up of pirated articles, but in the case of *McCrea* v. *Holdsworth* (*n*) Knight-Bruce, L.J., ordered the delivery-up of the articles to the plaintiff for destruction. In *Colburn* v. *Simms* (*o*) the Court said that there was no right at common law to the delivery-up of pirated copies of books; but in *Hole* v. *Bradbury* (*p*) Fry, J., said that the Court could

Delivery up of pirated articles.

(*m*) (1884) 50 L. T. N. S. 420; 51 L. T. N. S. 141.
(*n*) 2 De G. & Sm. 497.
(*o*) (1843) 2 Hare, 543; 12 L. J. Ch. 388.
(*p*) 12 Ch. Div. 886; 48 L. J. Ch. 673.

under its general jurisdiction order the delivery-up for destruction of all the articles manufactured contrary to the plaintiff's copyright. Under the Copyright Act express power is given to the Court to make such an order, but the Judge in the last named case did not proceed under the Act, and it is submitted that the decision is applicable to infringement of designs.

# CHAPTER IX.

## THE ACTION FOR INFRINGEMENT.

It is proposed in this chapter to deal with those particulars only in which actions for the infringement of a design differ from other actions. The rules for an action of this class must be taken to be the same as those of any action save where it is otherwise stated.

### The Court.

Remedy now in.

Under the older Acts the penalties might have been recovered before the police magistrate. It is now provided that the registered proprietor may recover "such sum as a simple contract debt by action in any Court of competent jurisdiction" (*a*). The proper Court then would be the High Court, or if he claim a sum not exceeding 50*l*. he could sue in the County Court (*b*). Design actions are not assigned to any particular division of the High Court, and the plaintiff is therefore free to choose. Should he desire to try his action locally at the assizes, or should he desire a trial by jury, the Queen's Bench Division will be chosen. In other cases, and especially where an application to rectify the register is to be made in connection with the same matter, the Chancery Division may be found the more convenient. Where there are cross actions or motions or different actions, the powers of the Court to consolidate and transfer can be used to bring the whole together matter to an issue (*c*). There are now no rules as to local venue, and the place of trial is determined as in other actions (*d*).

(*a*) (1883) Sect. 58.

(*b*) County Court Act, 1888, s. 56. But see the judgment of Kay, L.J., in *Reg.* v. *The County Court Judge of Halifax*, (1891) L. R. 2 Q. B. 263; 60 L. J. Q. B. 550; 65 L. T. N. S. 104; 39 W. R. 545; 8 R. P. C. 338.

(*c*) R. S. C. Ord. XLIX.

(*d*) R. S. C. Ord. XXXVI. rr. 1, 1a.

## Parties.

Persons who may sue.

The plaintiff must be a registered proprietor, and if any person other than the registered proprietor be made plaintiff, the action fails, subject to the exercise of the powers of amendment possessed by the Court (*e*). The meaning of proprietor is to be found in sect. 61 of the Act of 1883 (*f*), from which it would seem that the original author, the licensee, the assignee, or the partial assignee may all be registered as proprietors.

Licensees, Assignees.

Supposing that A. is the author of a design, and he licenses B. to use it, and assigns half his rights to C., according to the section A., B., and C. would all be proprietors, and might be registered. If D. infringes, A., B., and C., would each be entitled to sue him. And it would seem that as each person has the right of property, he would be entitled to bring his action without joining his co-proprietors, and could obtain whatever damages he may have suffered.

The hardship on D. is not so great as may at first glance appear. He would have to pay such damage to each as each had suffered; and if the suits were for penalties, the maximum amount would be 100*l*. (*g*), the exact amount being in the discretion of the Court. Moreover, application could be made to consolidate the actions (*h*), or to hear them together, or to treat one as a test action (*hh*). Under the Patents part of the Act it has been decided that an assignee may sue (*i*), and that the owner who has mortgaged by assignment can sue alone (*j*), but that a licensee of a patentee cannot sue alone (*k*). A licensee of the proprietor of a design, being a proprietor as defined by sect. 61, can sue (*l*);

(*e*) R. S. C. Ord. XVI. rr. 1—13.

(*f*) And see *ante*, Chap. LXXVIII.

(*g*) (1888) Sect. 7.

(*h*) R. S. C. Ord. XLIX. r. 8.

(*hh*) *Amos* v. *Chadwick*, (1878) 9 Ch. D. 459; 47 L. J. Ch. 871; 39 L. T. N. S. 50; 26 W. R. 840.

(*i*) *Walton* v. *Lavater*, (1860) 29 L. J. C. P. 275; 8 C. B. N. S. 162.

(*j*) *Van Gelder* v. *Sowerby*, (1890) 44 Ch. Div. 374; 59 L. J. Ch. 583; 7 R. P. C. 41. And on the subject of the proper plaintiff in patent actions, see the author's Law and Practice of Letters Patent, Chap. XIV.

(*k*) *Heap* v. *Hartley*, L. R. 42 C. D. 461; 58 L. J. Ch. 790.

(*l*) See *Jewitt* v. *Eckhardt*, 8 Ch. Div. 404. But see the patent case of *Heap* v. *Hartley*, (1889) 42 Ch. Div. 461; 58 L. J. Ch. 790; 6 R. P. C. 495; which shows that but for the definition clause the licensee cannot sue.

in *Wooley* v. *Broad* (*m*) he was not allowed to do so, but in that case he had not been registered as proprietor. A trustee, if he be registered as proprietor, should be plaintiff (*n*); the register does not contain notice of any trust, express, implied, or construc-tive (*o*).

Proof of registration.

The proof of registration is the certificate (*p*). It has been decided under the Copyright Act, 1842, that books could be ordered to be delivered up to the registered proprietor, though he was not registered until after the commencement of the action (*q*). And in a trade-mark case an assignee of the registered proprietor was allowed to bring an action in his own name, without having registered the assignment. It is submitted that the law is different as regards designs (*r*).

Agents and principals.

The defendant must be the infringer, though if the infringer be an agent, his principal (*s*) will be liable also, though the agent will not escape (*t*). See *Betts* v. *De Vitre* (*u*) where directors were declared personally liable for the infringement of a patent by a workman; *Yonge* v. *Ward* (*x*) where a principal was made liable for the infringement of the agent, though ignorant of what his agent was doing. The patent cases throw light upon this point, but do not always apply; innocence of infringement may be a defence to an action relating to a design (*y*), it will not be so in one dealing with a patent. Again, user may be an infringement in patent cases, in design cases there is infringement only if there be application of the design to any article for the purposes of sale (*y*).

(*m*) (1892) L. R. 1 Q. B. 806; 9 R. P. C. 208.

(*n*) And see R. S. C. Ord. XVI. r. 8.

(*o*) (1883) Sect. 85; and see *ante*, p. 67.

(*p*) *Sarazin* v. *Hamel*, (1863) 32 L. J. Ch. 378, 380; 7 L. T. N. S. 560; 32 Beav. 145; and see *Hildesheimer* v. *Dunn*, (1891) 64 L. T. N. S. 452, under the Copyright Acts.

(*q*) *Isaacs* v. *Fiddemann*, (1880) 42 L. T. N. S. 395.

(*r*) (1883) Sects. 58, 59; *Wooley* v. *Broad*, (1892) L. R. 1 Q. B. 806; 9 R. P. C. 208.

(*s*) *Mallett* v. *Howitt*, W. N. (1879) 107.

(*t*) And see *Nobel Explosives Co.* v. *Jones & Co.*, (1880) 17 Ch. Div. 721, and 8 App. Ca. 4; 49 L. J. Ch. 726.

(*u*) (1868) 3 Ch. 429; 34 L. J. Ch. 289.

(*x*) (1869) 21 L. T. N. S. 480.

(*y*) (1883) Sect. 58.

Infringement by several persons at the same time.

The following, taken from the author's work on Patents, applies to designs:—"Besides the question as to whether any of these statutory limitations apply to his case, a patentee has frequently to consider how he ought to act when his patent is being infringed by several persons at the same time. Under these circumstances, the patentee has several difficulties to face and to choose between. He may take proceedings against one infringer successfully, but the others are not bound by the issue of such an action (*z*), and the consequence is that the patentee may have to establish his case from the beginning against any fresh person who chooses to impugn the patent and to contest its validity upon the same or different grounds, besides laying himself open to a charge of laches. Upon the other hand, even if he proceed by separate action, against the several infringers at the same time, he may still have to defend the validity of his patent in a number of distinct proceedings, in each of which it may be impeached upon different grounds; and he will also render himself liable to a charge of vexatious and oppressive litigation. In the case of *Bovill* v. *Crate* (1865, L. R. 1 Eq. 391), Wood, V.-C., suggested a way out of these difficulties:—'After getting information of case after case of infringement (the patentee) might 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 do not object on the ground of delay, I do not mean to file bills against all of you at once.'"

## The Writ.

Notice before issue of writ not necessary.

When a cause of action has arisen, it is not necessary to give notice before issuing the writ; and, as speed is often very desirable in matters relating to the infringement of copyright in designs, immediate issue of a writ will often be justifiable (*a*). But when it

(*z*) *Walker* v. *Hecla Foundry Co.*, (1887) 5 R. P. C. 71, 367.

(*a*) See *Upmann* v. *Elkan*, (1871) L. R. 12 Eq. 146, and 7 Ch. 130; 41

is intended to proceed against an infringer for publishing or exposing for sale a substance to which a protected design has been applied, "knowing that the same has been so applied without the consent of the registered proprietor," notice should, if possible, be given before issue of the writ, in view of the defence of *bonâ fide* ignorance.

The writ should be indorsed for an injunction if one be required; and if time be of importance, leave to serve the notice of motion with the writ should be asked for. If delivery-up is required, this also should be asked for.

For indorsement of writ, see *post*, p. 250.

## Pleadings.

Orders XIX. to XXV. of the Supreme Court Rules deal with this subject. The Forms in the Appendix to the Rules do not contain any form strictly applicable to actions for the infringement of designs; but in Appendix C, Forms 6 and 7 give the form of a statement of claim for relief from infringement of a patent and copyright respectively, and Form 8 applies to the infringement of a trademark. In Section VI. of Appendix D will be found the Forms of Defence corresponding to these. The form of pleading intended to apply to actions in relation to designs may be deduced from these.

A form of statement of claim is given *post*, p. 250; a form of defence *post*, p. 251. Forms of claim and defence.

It will be enough to say in this place that the statement of claim should in general contain allegations: (1) That the plaintiff is the registered proprietor of a duly registered design; (2) That the defendant has infringed his right by applying for the purposes of sale or by offering for sale an article to which the design or an obvious or fraudulent imitation of it has been applied; (3) That the consent of the proprietor has not been obtained; and if the action be for offering for sale only, then (4) That the defendant knew that the consent of the proprietor had not been obtained (*b*). There Allegations in statement of claim.

L. J. Ch. 246; 25 L. T. N. S 813; 5 R. P. C. 131. See below, under heading "Costs," *Upmann* v. *Forester*, (1883) 24 C. D. 231, 52 L. J. Ch. 946; 49 L. T. N. S. 122; 32 W. R. 28.

(*b*) *Wooley* v. *Broad*, (1892) 1 Q. B. 806; 9 R. P. C. 209, 212; *Leader* v. *Strange*, (1849) 2 Car. & Kir. 1010.

seems to be no reason to plead compliance with the statute otherwise than by alleging that the design and proprietorship have been duly registered. It is for the defendant to plead non-compliance with any of the requirements if he desires to have the questions raised (*c*).

## Defences to the Action.

A defendant may (a) deny infringement; or (b) attack the design; or (c) allege that the Act has not been complied with.

The defence should traverse all statements in the claim which it is desired not to admit, and if a defence of consent to the use of the design be intended to be put in, this should be pleaded. If the case for the defendant be that there is no subject-matter for a design, or that there is other reason why the design ought not to have been registered, it would be well to apply to rectify the register (*d*).

Stated more fully, the main defences specially applicable to an action for infringement of a design are these :—

Denial of infringement.

(1) No infringement. See *ante*, Chap. VIII., "Infringement" (*e*). This defence involves that the alleged imitation is in reality different to design registered by the plaintiff.

(2) That the infringement (if any) took place abroad. This is really the same as a denial of any infringement, as infringement consists in the production for sale of the article in this country (*f*). But if the article be made abroad and be imported for sale, there would be an infringement (*g*).

Not subject matter.

(3) That the design is not proper subject-matter for registration within the meaning of the Act. See *ante*, Chap. II., p. 12.

Novelty denied.

(4) That the design is not new and original. *Ante*, Chap. III., p. 23.

Prior publication alleged.

(5) Prior publication. *Ante*, p. 32.

(*c*) *Sarazin* v. *Hamel*, (1863) 32 L. J. Ch. 378.

(*d*) *Ante*, p. 70.

(*e*) Page 89.

(*f*) *Potter* v. *Braco de Prater Printing Co.*, (1891) 8 R. P. C. 218.

(*g*) See (*e.g.*) *Nobel Explosives Co.* v. *Jones*, (1880) 17 C. D. 721 ; 8 App. Ca. 4 ; 49 L. J. Ch. 726 ; *Elmslie* v. *Boursier*, (1869) 9 Eq. 217 ; 39 L. J. Ch. 328, which are patent cases, but which may be referred to on this subject.

(6) That the design was never properly registered. It is not a defence to an action for infringement that the design was registered in the wrong class (*h*). But it is a defence to show that it was not registered in the class or classes of goods to which the alleged infringer's goods belong (*i*). As to registration.

(7) That the articles to which the design has been applied are not properly marked. See *ante*, Chap. VII., p. 83. Articles not marked.

(8) That the plaintiff is not registered proprietor. See *ante*, Chap. VII., p. 82; and *ante*, p. 106, "Parties." Plaintiff not proprietor.

(9) That the defendant did not apply the design, and sold the articles in ignorance of the plaintiff's rights. Ignorance.

(10) *Res Judicata.* But a decision does not determine the validity or invalidity of the design and its registration except as between the parties to the action (*k*). *Res judicata.*

(11) *Leave and Licence.* And a licence to one to manufacture is a licence to his vendees to sell it (*l*). But the publication of a book of designs by the owner of the copyright does not of itself give licence to the purchaser to apply the designs to articles for the purpose of sale (*m*). Leave and licence.

(12) *Lapse of Time.* The registered proprietor is entitled to copyright during five years from the date of registration (*n*), and it would be a defence that the alleged infringement was committed after the lapse of that time (*o*). Copyright in design expired.

Sect. 54 of the Act of 1883 provides for the cesser of the copyright in a design in another case, viz. "if a registered design is used in manufacture in any foreign country, and is not used in this Special defence under sect. 54 of Act of 1883.

(*h*) *Lowndes* v. *Browne*, (1848) 12 Ir. L. R. 293.

(*i*) *Re Read & Greswell's Design*, (1889) 42 Ch. Div. 260; 58 L. J. Ch. 624; 61 L. T. N. S. 450; 6 R. P. C. 471.

(*k*) *Walker* v. *Hecla Foundry Co.*, (1887) 5 R. P. C. 71, 365.

(*l*) *Thomas* v. *Hunt*, (1864) 17 C. B. N. S. 183.

(*m*) *De la Branchardière* v. *Elvery*, (1849) 18 L. J. Ex. 381; 4 Ex. 380. Where one of two part owners in copyright gave licence without consulting the other, see *Powell* v. *Head*, (1879) 12 Ch. Div. 686; 48 L. J. Ch. 731; 41 L. T. N. S. 70.

(*n*) (1883) Sect. 50. Sect. 53 of the Act of 1883 enables a person to obtain information as to the continuance or cesser of the copyright.

(*o*) As to attempts to get advantage after expiration of the five years, by claiming the trade name of a design, see *Cheavin* v. *Walker*, (1877) 5 Ch. Div 850; 46 L. J. Ch. 686; 36 L. T. N. S. 938.

country within six months of its registration in this country, the copyright in the design shall cease.

Statute of Limitations.

There is no provision in the present Acts that proceedings for infringement shall take place within any given period. The Statute of Limitations therefore applies as in ordinary cases (*p*).

Estoppel of licensee.

A licensee cannot always avail himself of all the above defences. So long as the licence continues he is estopped contesting the validity of the design he is licensed to use, whether the licence be by deed, or not (*q*).

## Particulars.

No statutory particulars of breaches or objections.

Unlike in actions relating to the infringement of patents, there are no special statutory provisions relating either to particulars of breaches or to particulars of objections (*r*). But under the R. S. C., Ord. XIX. r. 7, particulars may be ordered (*s*). If the particulars be given, and they go beyond the defence or claim, as the case may be, the party giving the particulars is bound by his pleading (*t*).

In a patent case, *Sykes* v. *Howarth* (*u*), the particulars for breaches alleged divers sales between certain dates, and "in particular" to two named persons, the statement of defence admitted sales to a third person. Fry, J., held that notwithstanding the form of the particulars he must admit the evidence relating to the sale to this third person, as the case of the third person was within the literal meaning of the particulars, and if they tended to embarrass, the defendant could have avoided any difficulty on this head by applying for further and better particulars.

Amendment of particulars.

A party will ordinarily be allowed to amend his particulars at any time upon such terms as may be just. In patent practice there is a well settled rule that a defendant, on being allowed to amend his particulars of objections, will be put upon terms to allow the plaintiff time to elect to discontinue the action, and if it be so

(*p*) The Designs Act, 1842, limited the time to twelve months from the commission of the offence.

(*q*) See *Crossley* v. *Dixon*, (1863) 32 L. J. Ch. 617 ; 10 H. L. C. 293. And see the author's book on Patents, 269 *et seq.*, where the exceptions may be found stated.

(*r*) For patents, see (1883) sect. 29.

(*s*) See notes to the rule in the Annual Practice.

(*t*) *Macnamara* v. *Hulse*, Car. & M. 471.

(*u*) (1879) 12 Ch. Div. 826 ; 48 L. J. Ch. 769.

discon··ued, he will ordinarily be allowed his costs incurred subsequent to the date of the delivery of the first particulars (*x*). North, J., declared that he would adopt this practice in designs cases (*y*). Even in patent actions this rule, though all but invariably followed, is not binding on the Court (*z*). And with regard to designs, the Court of Appeal has expressly stated that the discretion of the Court is unfettered (*a*). In *Wooley* v. *Broad* (*a*) the action was ready for trial at assizes to be held at Nottingham, and about a week before the date of the assizes the defendant discovered certain facts, and gave information of them to the plaintiff. The plaintiff objected to evidence of these, the defendant took out a summons for leave to give further particulars, and the Judge at the assizes, to whom the summons was referred, gave leave unconditionally; on appeal his decision was affirmed by the Divisional Court and ultimately by the Court of Appeal.

Forms of particulars are given *post*, p. 251.

Such particulars should be given as with the pleadings give the opposite party a fair idea of the case intended to be made against him (*b*). Particulars of want of novelty or of prior publication must be drawn with greater detail and accuracy than particulars of infringement (*b*). Infringements may be fairly presumed to be within infringer's knowledge.

### Inspection—Discovery—Interrogatories.

The Rules of the Supreme Court, Orders L. and XXXI., deal with this subject. The following remarks, taken in the main from the author's work on Patents, apply on the whole to designs, though the cases upon which they are founded are chiefly patent cases.

#### (a) *Inspection.*

Under the Rules of the Supreme Court, 1883, Ord. L., the widest powers of ordering an inspection are conferred on the

(*x*) *Edison Telephone Co.* v. *India Rubber Co.*, (1880) 17 Ch. Div. 137.

(*y*) *Morris, Wilson & Co.* v. *Coventry Machinist Co.*, (1891) L. R. 3 Ch. 418; 60 L. J. Ch. 524; 8 R. P. C. 353.

(*z*) *Pascall* v. *Toupe*, (1890) 7 R. P. C. 129. And see *Lang* v. *Whitecross Iron Co.*, (1890) 7 R. P. C. 389.

(*a*) *Wooley* v. *Broad*, (1892) 2 Q. B. 317; 61 L. J. Q. B. 808; 9 R. P. C. 429.

(*b*) *Ledgard* v. *Bull*, (1886) 11 A. C. 648.

various divisions of the High Court. The only practical limit to the discretion of the Court is the necessity of the information claimed for the purposes of the trial (*c*).

Samples may now be taken, observations made, and experiments conducted (*d*).

An application for inspection may be made and in exceptional cases will be granted *ex parte* (*e*); it may be made at any time during the progress of an action, even before the delivery of claim (*f*), and the express terms of Ord. L. r. 6 leave no doubt that an adverse order for inspection may be made upon the plaintiff in an action for infringement (*g*).

Under Ord. L. r. 3, the Court may now authorize any person for the purpose of inspection to enter any land or building in the possession of any party. Obedience to an order for inspection may, therefore, be asserted forcibly, and not simply as before by process of contempt (*h*).

The application in the Chancery Division should be made by motion to the Court, and notice of motion should be given (*i*).

In the Queen's Bench Division the application is to a Judge in Chambers (*k*).

Laches sufficient to defeat the plaintiff's right to an interlocutory injunction are no bar to an order on the same motion for inspection and samples (*l*).

In order to succeed on an application for inspection, the applicant must show by affidavit—

(*c*) Where the right to inspection appears to depend on the determination of any issue or question in the cause, the Court may if it thinks fit order that such issue shall be determined first, and reserve the question as to the inspection. Ord. XXXI. r. 20.

(*d*) Ord. L. r. 3; cp. *Badische Anilin, &c.* v. *Levinstein*, 24 Ch. D. 146; 52 L. J. Ch. 704; 48 L. T. N. S. 822; 31 W. R. 913; *Germ Milling Co.* v. *Robinson*, (1885) 3 P. O. R. 11.

(*e*) *Hennessy* v. *Bohmann*, W. N. (1877) 14.

(*f*) See R. S. C. Ord. L., r. 6.

(*g*) *Germ Milling Co.* v. *Robinson*, (1886) 3 P. O. R. 11; *Cheetham* v. *Oldham*, (1888) 5 R. P. C. at p. 623; *Sidebottom* v. *Fielden*, (1891) 8 R. P. C. 266.

(*h*) *East India Co.* v. *Kynaston*, (1821) 3 Bligh. 153, 163, 166.

(*i*) *Habershon* v. *Gill*, W. N. (1875) 231; D. C. F. 653.

(*k*) Ord. LIV. r. 12.

(*l*) *Patent Type Founding Co.* v. *Walter*, (1860) Johns. 727; 29 L. J. Ex. 207.

Affidavit in support of application for inspection.

1. That he is the registered proprietor of a design, and what it is (*m*).

2. That the defendant has probably infringed.

The Court will not grant an order for the inspection of a machine upon an affidavit "that the machine used by the defendants is the same for which the plaintiff has obtained a patent." The affidavit ought, at least, to state that there is such a machine, and that the plaintiff has reason to believe it is an infringement (*n*), and should set forth the grounds of such belief (*o*).

*Primâ facie* evidence of infringement will be sufficient (*p*).

3. That the inspection sought for is material to his case (*q*).

If the *primâ facie* evidence above referred to is satisfactory, an order for inspection will be made, almost as of course (*r*).

When inspection refused.

Inspection will, however, be refused where, in the opinion of the Court—

(1) There is no case to try at the hearing (*s*) ;

(2) The effect of an order would be to oppress the defendant, or make him disclose more than was necessary for the purposes of the cause (*t*).

An objection that an order for inspection would lead to the disclosure of trade secrets will not generally prevail if the case for inspection is otherwise satisfactory (*u*). The Court will, at the proper time, protect the defendant from an improper disclosure of his secret (*u*).

Contents of order for inspection.

The order for inspection (*x*) usually specifies the number of inspec-

(*m*) *Meadows* v. *Kirkman*, (1860) 29 L. J. Exch. 205.

(*n*) *Shaw* v. *Bank of England*, (1852) 22 L. J. Ex. 26.

(*o*) *Germ Milling Co.* v. *Robinson*, (1884) 1 P. O. R. 217.

(*p*) *Shaw* v. *Bank of England, ubi supra ; Singer Manufacturing Co.* v. *Wilson*, (1865) 13 W. R. 560 ; *Batley* v. *Kynock*, (1874—75) L. R. 19 Eq. 90, 92 ; 44 L. J. Ch. 89 ; *Cheetham* v. *Oldham*, (1888) 5 R. P. C. 617.

(*q*) *Piggott* v. *Anglo-American Telegraph Co.*, (1868) 19 L. T. N. S. 46.

(*r*) *Singer Manufacturing Co.* v. *Wilson*, (1865) 13 W. R. 560.

(*s*) *Piggott* v. *Anglo-American Telegraph Co., ubi supra.*

(*t*) *Singer Manufacturing Co.* v. *Wilson, supra ; Cheetham* v. *Oldham*, (1888) 5 P. O. R. 617.

(*u*) *Renard* v. *Levinstein*, (1864—65) per Wood, V.-C., 10 L. T. N. S. 95 ; *Cheetham* v. *Oldham*, (1888) 5 P. O. R. 617.

(*x*) See Seton, 561, etc.

tions allowed (*y*), the names of the inspectors, and the notice to which the person against whom the order is made shall be entitled (*z*).

### (b) *Discovery of Documents and Interrogatories.*

The existing law as to discovery is contained in Ord. XXXI. of the Rules of the Supreme Court, 1883, as altered by the Rules of November, 1893. Its chief provisions, so far as relate to actions of infringement, are as follows :—

The plaintiff or defendant in a designs action may, by leave of the Court or a Judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties (*a*). Interrogatories which do not relate to any matters in question shall be deemed irrelevant, notwithstanding that they might have been admitted on cross-examination (*b*). On an application for leave to deliver interrogatories, the particular interrogatory proposed to be delivered shall be submitted to the Court or Judge. In deciding upon such application, the Court or Judge shall take into account any offer which may be made by the party sought to be interrogated, to deliver particulars, or to make admissions, or to produce documents relating to the matters in question, or any of them, and leave shall be given as to such only of the interrogatories submitted as the Court or Judge shall consider necessary either for disposing fairly of the cause or matter or for saving costs (*c*). The Court or a Judge has the same power to prevent premature discovery as to prevent premature inspection (*d*).

The costs of discovery, by interrogatories or otherwise, must be secured in the first instance by the applicant (*e*).

A defendant against whom an order for discovery is made must

(*y*) *Heathfield* v. *Braby*, Seton, 561. But see *Germ Milling Co.* v. *Robinson*, (1886) 3 P. O. R. 11.

(*z*) Pemberton, p. 236.

(*a*) Rule 1.

(*b*) Rule 1.

(*c*) Ord. XXXI. r. 2.

(*d*) Rule 20.

(*e*) Rule 25.

answer, technically and categorically, every question which can assist the plaintiff in making out his title to relief (*f*).

The following illustrations will show at once the application and the limits of this rule :—

A defendant denying infringement must answer everything tending to show the fact of infringement, but not questions which assume that infringement has taken place, and answers to which will be obtained at the hearing, provided that infringement be then established (*g*). Illustrations.

Although, when discovery is a matter of indifference to the defendant, the Court does not weigh in golden scales the question of materiality or immateriality, still, when the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other, it is bound to protect the defendant against undue inquisition into his affairs (*h*).

A plaintiff has no right to inquire by interrogatories into the defendant's case, or to ask for the names of the witnesses whom he intends to produce, or the names of persons to whom he has sold articles similar to the articles alleged to be an infringement (*i*).

Reports and letters obtained from their officers by a company which had been warned, but not threatened, with actual litigation in respect of an alleged infringement of a patent, were held not to be privileged (*k*).

(*f*) *Swinborne* v. *Nelson*, (1852—53) per Romilly, M.R., 22 L. J. Ch. 331 ; 16 Beav. 416, 417 ; *Elmer* v. *Creasy*, (1873) L. R. 9 Ch. 69 ; 43 L. J. Ch. 166.

(*g*) *De la Rue* v. *Dickinson*, (1857) per Wood, V.-C., 3 K. & J. 398 ; *Lister* v. *Norton*, (1885) 2 P. O. R. 68 ; *Lea* v. *Saxby*, 32 L. T. N. S. 731.

(*h*) *Moore* v. *Craven*, (1870) L. R. 7 Ch. 94, 96, n. ; *Daw* v. *Eley*, (1865) 1 Eq. 38 ; 2 H. & M. 725. As to administering interrogatories to a plaintiff, see *Hoffmann* v. *Postill*, (1869) L. R. 4 Ch. 673 ; *Edison, &c. Co.* v. *Holland*, (1888) 5 P. O. R. 213 ; W. N. 31 ; *Morris* v. *Edwards*, (1890) 15 App. Ca. 309 ; 60 L. J. Q. B. 292 ; 63 L. T. N. S. 26.

(*i*) *Daw* v. *Eley*, *ubi supra*.

(*k*) *Westinghouse* v. *Midland Rail. Co.*, (1883) 48 L. T. N. S. 98, 462 ; and cp. *Haslam Co.* v. *Hall*, (1888) 5 P. O. R. 1.

In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies, that he who is bound to answer must answer fully.

There is, however, this difference: A plaintiff is not entitled to discovery of the defendant's case, whereas a defendant may ask any question tending to destroy the plaintiff's claim (*l*).

It must be noted, however, that when an action for infringement of a design is brought for penalties under sect. 58 of the Act of 1883, the defendant need not answer interrogatories (*m*). Whether the law is the same if the action is brought for damages under sect. 59 is not quite certain (*n*).

### Method of Trial.

There is no rule specially applicable to design actions. The parties are therefore placed as litigants in any other action as regards right to a jury. Speaking of trial of patent cases by jury, Lord Selborne said in the *Patent Marine Inventions Co.* v. *Chadburn* (*o*): "It is to be observed that such cases almost always involved questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the Judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence, in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the Judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a Judge as by any jury. It very rarely happens, if it ever does, when the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the Judge, the direction of the Judge."

(*l*) *Hoffmann* v. *Postill*, (1869) L. R. 4 Ch. 673.

(*m*) *Saunders* v. *Wiel*, (1892) 2 Q. B. 321; 62 L. J. Q. B. 37; 9 R. P. C. 459.

(*n*) *Ibid.* Day, J., seems to think the plaintiff cannot administer interrogatories.

(*o*) (1873) L. R. 16 Eq. 447.

These remarks are applicable to design cases, though their force is somewhat lessened. Often the sole question to be determined is whether the one design is an imitation of the other, a matter to be settled by reference to the eye. In view of the considerable divergence of opinion which frequently manifests itself in imitation cases, many may prefer to take the decision of the twelve in preference to that of one man.

There is no absolute right to a jury, but on application the Court will often order a trial by jury (*p*).

## Costs.

The ordinary rules as to costs are those to be found in R. S. C. Ord. LXV. When any action, cause, matter or issue is tried with a jury, the costs follow the event, unless the Judge shall for good cause otherwise order (*q*). In other cases the costs are awarded in the discretion of the Court (*r*). By the County Courts Act, 1888, if in an action founded on contract the plaintiff shall recover a sum less than twenty pounds, he shall not be entitled to any costs of the action, and if he shall recover a sum of twenty pounds and upwards, but less than fifty pounds, he shall not be entitled to any more costs than he would have been entitled to if the action had been brought in a county court. If in an action founded on tort the plaintiff shall recover a sum less than ten pounds, he shall not be entitled to any costs in the action; and if he shall recover a sum of ten pounds and upwards, but less than twenty pounds, he is to be entitled to county court costs only (*s*). But whether the action be on contract or on tort, a Judge of the High Court may certify that there was sufficient reason for bringing the action in the High Court, or may otherwise by order allow costs on the High Court scale (*s*). As the penalty for infringement is fixed at fifty pounds, it must often happen that a sum not exceeding fifty pounds is recovered in an action for infringement of a design. But when the validity of the design or its registration is attacked, it is suggested

Costs on recovery of sums not exceeding £50.

(*p*) R. S. C. Ord. XXXVI. rr. 4, 5, 6.

(*q*) Ord. LXV. r. 1.

(*r*) *Ibid.* For an instance of its exercise, see *Sherwood* v. *Decorative Tile Co.* (1887) 4 R. P. C. 207.

(*s*) 51 & 52 Vict. c. 43, s. 116.

that the Court will usually certify for costs, as in reality a right of property far exceeding fifty pounds in value may be in question (*t*).

Costs of distinct issues.

When there are distinct issues to be decided, the costs of each are dealt with separately if the Court thinks fit. In *Winfield* v. *Snow* (*u*) one of the pleas was "prior publication," and this was decided favourably to the defendant. The Judge gave the general costs of the action and the cost of the issue disposed of to the defendant, reserving the costs of the other issues. In *Blank* v. *Footman & Co.* (*x*) the defendant raised several defences, and upon one of them (publication) the Judge found for the defendant, on another (marking) for the plaintiff; other defences were simply pleaded and were not argued out. Kekewich, J., said: "I have, as sitting in equity, full power over the costs, and I do not consider this analogous to a patent case, if that would make any difference. The difficulty which I feel as a Judge, and always felt when at the Bar, is this: the defendant is entitled to put his back against the wall and to fight from every available point of advantage. I think that it would be extremely hard on defendants if as a rule they were told at the end of the trial, 'You have beaten the plaintiff, but because you have raised some points on which you have not succeeded you shall not have all the costs of the action.' And it is obvious that it might lead to lengthening trials if counsel understood that unless they fought out every point the clients would not be allowed their costs even in a successful case. On the other hand, it is a useful rule that where there is a distinct issue on which the generally successful party has failed and that issue has really no immediate connection with those upon which the party has succeeded, then he ought not to have the costs of that issue which presumptively ought never to have been raised. As regards the fifth and sixth defences, though perhaps they might as well have been left out, still they were fair points to raise, and on the principle I have mentioned I do not think that the defendants ought to be mulcted in costs, because succeeding on the whole they have not succeeded on them. But as regards the marking,

Principle of apportionment of costs of issues *per* Kekewich, J.

(*t*) Such a certificate was given (*e.g.*) in *Chard* v. *Cory*, (1892) 9 R. P. C. 423.

(*u*) (1891) 8 R. P. C. 15.

(*x*) (1888) 39 Ch. Div. 678; 57 L. J. Ch. 909; 59 L. T. N. S. 567; 36 W. R. 921; 5 R. P. C. 653.

that issue has been argued out, and there has been evidence directed to it, and I have held distinctly in favour of the plaintiff on that point. I think that the plaintiff ought to have the costs of that issue as against the general costs of the action."

In one case, where the plaintiff moved for an injunction, and defendant moved to rectify the register, and both motions failed, each was dismissed with costs (*y*). In *Cooper* v. *Symington* (*z*) the plaintiffs moved for an injunction, but failed to obtain it, for the reason that their invention was not subject-matter for registration as a design; the defendants denied infringing, but could not sustain this defence, and the motion for an injunction was refused without costs; but the motion of the defendants to rectify the register was allowed with costs.

Costs on the higher scale.

Costs on the higher scale may be allowed in a fit case (*a*); but on application for an interlocutory injunction costs on the higher scale will not ordinarily be allowed, though the points raised be important (*b*). The costs of a motion, unless by agreement it is treated as the trial of the action, will usually be reserved; though if it is clear that the whole question is before the Court, and that the party defeated on the motion cannot succeed at the trial, costs will be given (*c*).

Costs when the defendant submits to an injunction.

If the defendant offers to submit to an injunction or promises no longer to infringe, it will depend upon circumstances whether he will be ordered to pay the costs incurred subsequently to his submission. The real point for determination is whether the plaintiff must go on with his proceedings or whether he is already sufficiently protected by the surrender of his opponent. This is practically the same as whether the acts of the defendant have disentitled him to an injunction (*d*). The plaintiff is generally entitled to go on if there be any doubt, at any rate until he has obtained his

(*y*) *Demartial* v. *Booth*, (1892) 9 R. P. C. 499.

(*z*) (1893) 10 R. P. C. 264.

(*a*) R. S. C. Ord. LXV. r. 9.

(*b*) *Grafton* v. *Watson*, (1884) 51 L. T. N. S. 141.

(*c*) *Walker* v. *Scott*, (1892) 9 R. P. C. 482.

(*d*) See *ante*, p. 100; *Proctor* v. *Baily*, (1889) 42 Ch. Div. 390; 59 L. J. Ch. 12; 38 W. R. 100; *Upmann* v. *Elkan*, (1871) 7 Ch. 130; 41 L. J. Ch. 246; 25 L. T. N. S. 813; 20 W. R. 131; *Millington* v. *Fox*, (1838) 3 My. & Cr. 338.

injunction (*e*), but the Court will use its discretion on the facts of each case.

The following cases are illustrative :—

Cases.

*Cooper* v. *Whittingham* (*f*). Here defendants were sued for infringement under the Copyright Act, 1842, and an injunction was asked for to restrain a sale ; defendants pleaded that when they received the copies they at once recognised the piracy, and determined not to sell. Jessel, M.R., made them pay the costs of the motion. He said : "As I understand the law as to costs it is this, that where the plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of costs—the Court has no discretion, and cannot take away the plaintiff's right to costs."

*Upmann* v. *Forester* (*g*). The defendant (a china merchant) purchased abroad, for his own private use, some cigars, which were consigned to him at the docks ; they bore a spurious brand, purporting to be that of the plaintiffs. When plaintiffs issued their writ and served a notice of motion for an injunction, the defendant stated to them that he had no intention of selling the cigars, offered all relief asked for by the writ, and, when the motion came on, agreed to an undertaking in the terms of the writ. Chitty, J., decided that the defendant must pay the costs, but added : "The result of my decision, however, will not be, as the defendant has suggested, that every purchaser of a small parcel of spurious goods incurs a liability to pay the costs of an action in the Chancery Division for infringing a patent or trade-mark. I cannot pass over the fact that there is in the present case a large consignment of goods—5,000 cigars is rather a large order for personal consumption—and the plaintiffs were justified in suspecting that so large a consignment was intended for distribution."

*Wittmann* v. *Oppenheim* (*h*). This was an action to restrain

(*e*) *Colbourne* v. *Sims*, (1843) 12 L. J. Ch. 338 ; 2 Ha. 543 ; *Nunn* v. *Albruquerque*, (1865) 34 Beav. 595 ; *Geary* v. *Norton*, (1846) 1 De G. & Sm. 9. And see *Fradella* v. *Weller*, (1831) 2 Russ. & My. 247.

(*f*) (1880) 15 Ch. Div. 501 ; 49 L. J. Ch. 752.

(*g*) (1883) 24 Ch. Div. 231 ; 52 L. J. Ch. 946 ; 49 L. T. N. S. 122 ; 32 W. R. 28. And see *Grace* v. *Newman*, 19 Eq. 623 ; 44 L. J. Ch. 298.

(*h*) (1884) 27 Ch. Div. 260 ; 54 L. J. Ch. 56 ; 50 L. T. N. S. 713 ; 32 W. R. 767. But as the defendant was merely the vendor, *semble* he ought not to

infringement of copyright in a registered design, and plaintiffs moved for an injunction. Defendant stated that he sold the lamps innocently, and that he received no notice that he was infringing until issue of the writ. Pearson, J., ordered the defendant to pay the costs. He said: "I should be very willing to make an order as to costs, but, looking at the decision in *Upmann* v. *Forester* (*i*), and to the rule there stated by Chitty, J., with which I entirely agree, I am afraid I have no choice. It is said that the plaintiffs issued their writ without notice to the defendant, and that the defendant, as soon as he had notice of the plaintiff's title, did his best to undo what he had done. But, at the same time, I cannot say that the plaintiffs were wrong in issuing their writ without notice, and after that the only offer which the defendant could properly make was to submit to an injunction and to pay the costs."

*American Tobacco Co.* v. *Guest* (*k*). In this case the owner of a registered trade-mark moved for an injunction to restrain infringement. The defendant, who had at one time made purchases from the plaintiff, bought a few articles from another firm, believing them to be the plaintiff's, and they offered to abide by any order made by the Court. Stirling, J., granted the injunction, but refused the plaintiff his costs. He said (referring to *Upmann* v. *Forester* (*l*)): "In that case, there being that large amount of goods, Mr. Justice Chitty made an order for payment of the costs. Here there are only 500 cigarettes, valued at 17*s.* 6*d.*, and, I think, that under those circumstances I am justified in excepting, as I think Mr. Justice Chitty would have excepted, this case from the operation of the rule which he laid down in *Upmann* v. *Forester*, by saying that there ought to be no costs."

In *Lyon* v. *Mayor, &c. of Newcastle-upon-Tyne* (*m*) plaintiff

have been put under an injunction, in the absence of knowledge that the plaintiff's design was registered. See sect. 58 (b) of the Act of 1883, also sect. 7 of the Act of 1842. And see *Smith* v. *Lewis, Roberts & Co.*, (1888) 4 R. P. C. 611, 617.

(*i*) *Supra.*

(*k*) (1892) L. R. 1 Ch. 630; 61 L. J. Ch. 242; 9 R. P. C. 218.

(*l*) *Supra.*

(*m*) (1894) 11 R. P. C. 218.

discovered that the Corporation of Newcastle were in possession of a machine made in infringement of his patent; the town clerk stated to the plaintiff that the Corporation did not dispute the patent, had never used the machine, and did not intend to use it, and undertook not to use it. The plaintiff's solicitors would not accept this nor any other undertaking, and moved for an injunction. On the undertaking being given to the Court, the motion was dismissed with costs.

# PART II.

## THE

# PATENTS, DESIGNS, & TRADE MARKS ACTS, 1883 TO 1888, CONSOLIDATED,

*(So far as they relate to Designs)*,

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. [25th August, 1883.]

**48 & 49 Vict. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [14th August, 1885.]**

**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. [25th June, 1886.]**

**51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [24th December, 1888.]**

NOTE.—The general text 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 this 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.

NOTE.—By Act 1888, s. 29, the principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

Division of Act into parts.

**2.** This Act is divided into parts, as follows :—

Part I.—PRELIMINARY.
II.—PATENTS.
III.—DESIGNS.
IV.—TRADE MARKS.
V.—GENERAL.

Commencement of Act.

**3.** This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

Act, 1888, s. 28.

**The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.**

NOTE.—There is no special provision as to time of commencement of the Acts of 1885 and 1886, so that they commence from the dates of those Acts, the 14th August, 1885, and the 25th June, 1886.

# PART II.

## PATENTS.

# PART III.

## DESIGNS.

### *Registration of Designs.*

Application for registration of designs.

**47.** (1.) The comptroller[1] may, on application[2] by or on behalf of any person[3] claiming[4] to be the proprietor[5] of any new or original[6] design[7] not previously published[8] in the United Kingdom, register[9] the design under this part of this Act.

(2.) The application[10] 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.

(3.) The application must contain a statement of the nature of the design,[11] and the class or classes[12] of goods in which the applicant desires that the design be registered.

(4.) The same design may be registered in more than one class.

(5.) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6.) The comptroller may, if he thinks fit, refuse to register[13] any design presented to him for registration, but any person aggrieved by any such refusal may appeal[14] therefrom to the Board of Trade.

(7.) The Board of Trade[15] shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

**Sect. 47.**

1 *The comptroller.*—An official appointed under this Act (sects. 82 and 83) with, so far as designs are concerned, similar powers and duties to the former registrar of designs (5 & 6 Vict. c. 100, s. 14; 6 & 7 Vict. c. 65, s. 7).

2 *Application.*—See *post*, subsections (2) and (3).

3 *Any person.*—This clearly includes a foreigner (*Guilerman's Design*, (1886) 55 L. J. Ch. 309, reported as *Ex parte Wild*, 2 Times R. 174). There was an express enactment in the Act of 1861 (24 & 25 Vict. c. 73, s. 1), that the privileges of the Designs Acts should extend to any proprietor, whether a British subject or not. The rights of a foreigner registered under this Act are subject to the provision in sect. 54, that he manufactures in this country within six months. "Person" includes a body corporate, sect. 117 and rule 26—and the singular includes the plural (52 & 53 Vict. c. 63, s. 1), so that joint owners may register.

4 *Claiming.*—It is no part of the comptroller's duty to adjudicate on the rights of rival claimants to the proprietorship of a design. Each claimant may register the design, and their respective rights can be settled by an application to the court under sect. 90, see *infra*.

5 *Proprietor.*—For the definition of "proprietor" see sect. 61.

6 *New or original.*—The corresponding words in all the earlier Acts and in sect. 61 of this Act, are new and original, so that the decisions under the previous Designs Acts are still law.

A distinction between "new" and "original" is drawn in *Sherwood* v. *Decorative Art Tile Co.*, (1887) 4 R. P. C. 207.

The novelty required by this Act is not novelty in the idea, but novelty in the design, that is, novelty in the way in which the idea is to be rendered applicable to some special subject-matter: *Saunders* v. *Wiel*, (1893) 10 R. P. C. 29, (1893) L. R. 1 Q. B. 471. See also *Harrison* v. *Taylor*, (1859) 4 H. & N. 815, 29 L. J. Ex. 3, 5 Jur. N. S. 1219; *Thom* v. *Sydall*, (1872) 26 L. T. N. S. 15, 20 W. R. 291. So that the mere fact that, what is applied to an article of manufacture is common property, does not render the design, which results from such application, bad for want of novelty: *Ibid.* The decision in *Adams* v. *Clementson*, (1879) 12 Ch. D. 714, 27 W. R. 379, under the earlier Acts is to be applied with care to the present Act: *Saunders* v. *Wiel*, *supra*.

The novelty of the object of the design, or the useful purpose which the shape or configuration of the design is intended to serve, is not to be considered: *Hecla Foundry Co.* v. *Walker*, (1889) 14 App. Ca. 550, 6 R. P. C. 554; *Windover* v. *Smith*, (1863) 32 L. J. Ch. 561, 32 Beav. 200; *Walker* v. *Hecla Foundry Co.*, (1887—8) 5 R. P. C. 71, 365;

*Sherwood's Design*, (1892) 9 R. P. C. 268; *Moody* v. *Tree*, (1892) 9 R. P. C. 233; *R.* v. *Bessell*, (1851) 16 Q. B. 810, 20 L. J. M. C. 177, 15 Jur. 773. Sect. 47.

Nor are the novelty of the means or instruments by which the design is produced: *Plackett's Design*, (1892) 9 R. P. C. 436.

The pattern, shape, configuration or ornament alone to be considered: *Hecla Foundry Co.* v. *Walker*, *supra*; *Rogers* v. *Driver*, (1850) 16 Q. B. 102, 20 L. J. Q. B. 31.

There is no complete analogy between patents and designs in the matter of novelty: *Harrison* v. *Taylor*, (1859) 4 H. & N. 815, 29 L. J. Ex. 3, 5 Jur. N. S. 1219; *Moody* v. *Tree*, (1892) 9 R. P. C. 233, 234; *Lazarus* v. *Charles*, 16 Eq. 117, 42 L. J. Ch. 507. For instance the combination of two old patterns in the same manner as that in which other patterns have been previously combined, may form a new and original design: *Ibid*: *Saunders* v. *Wiel*, *supra*; *Thom* v. *Syddall*, (1872) 26 L. T. 15, 20 W. R. 291.

So too the application to iron fire-doors of a moulding common in articles of wood has been held a new design: *Walker* v. *Falkirk Iron Co.*, (1887) 4 R. P. C. 390. See also *Hecla Foundry Co.* v. *Walker*, (1889) 14 App. Ca. 550.

For the rule in patent cases, see *Brook* v. *Aston*, 8 E. & B. 478, 28 L. J. Q. B. 175.

Fair imitation is not infringement: see sect. 58, notes.

But while the law has been construed with greater liberality with regard to novelty in designs than in patents, the same principle applies to both, and articles manufactured with only a slight alteration in form from articles already manufactured are not new or original: *Lazarus* v. *Charles*, (1873) L. R. 16 Eq. 117, 42 L. J. Ch. 507; *Le May* v. *Welch*, (1884) 28 Ch. D. 24, 54 L. J. Ch. 279, 51 L. T. N. S. 867, 33 W. R. 33; although a high standard of originality is not to be expected: *Walker* v. *Falkirk Iron Co.*, (1887) 4 R. P. C. 391.

A design must be either substantially new or substantially original, having regard to the subject-matter to which it is to be applied: *Le May* v. *Welch*, *supra*; *Smith* v. *Hope*, (1889) 6 R. P. C. 201.

"Subject-matter" in this connection means purpose to which it is to be applied: *Re Bach's Design*, (1889) 42 Ch. D. 661, 6 R. P. C. 376.

So that it follows that a design which has been registered in one class is not new or original when applied to articles of analogous character and registered in another class: *Read & Gresswell's Design*, (1889) 42 Ch. D. 260, 58 L. J. Ch. 624, 61 L. T. N. S. 450, 6 R. P. C. 471; *Bach's Design*, *supra*. A difference in material does not constitute novelty: *Ibid*. But an old design might be new or original if it

**Sect. 47.**

were applied to a different kind of article : *Walker* v. *Falkirk Iron Co.*, (1887) 4 R. P. C. 390.

It was held to be so doubtful whether four old designs applied to three ribbons and a button and made into a badge having of itself no novel shape were a new and original design under the Act of 1842, that an interlocutory injunction was refused : *Mulloney* v. *Stevens*, (1864) 10 L. T. N. S. 190.

The application of the same thing to the same purpose, although in an enlarged size, is not new and original : *Windover* v. *Smith*, (1863) 32 L. J. Ch. 561, 32 Beav. 200, decided under 6 & 7 Vict. c. 75.

But an alteration of the proportions of an old design may produce a new design : *Harrison* v. *Taylor*, (1859) 4 H. & N. 815—822, 29 L. J. Ex. 3, 5 Jur. N. S. 1203 ; *Holdsworth* v. *McCrea*, (1867) L. R. 2 H. L. 380.

And a new and original combination formed by simultaneously applying old and known designs to the same article is a new and original design : *Reg.* v. *Firmin*, (1851) 15 J. P. 570, 3 H. & N. 304 ; *Norton* v. *Nichols*, (1859) 1 E. & E. 761, 28 L. J. Q. B. 225, 33 L. T. 131, 7 W. R. 720, 5 Jur. N. S. 1203 ; *Harrison* v. *Taylor*, (1859), *supra* ; *Holdsworth* v. *McCrea*, L. R. 2 H. L. 380, 36 L. J. Q. B. 297 ; *Sherwood* v. *Decorative Art Tile Co.*, (1887) 4 R. P. C. 211 ; *Heinrichs* v. *Bastendorff*, 10 R. P. C. 160.

The combination must be formed of at least two different things, both capable of designation and of being designs : *Hothersall* v. *Moore*, (1892) 9 R. P. C. 27. The novelty must be in the combination : *Re Plackett's Design*, (1892) 9 R. P. C. 436.

Whether a design is novel or original is a question of fact : *Harrison* v. *Taylor*, 4 H. & N. 815, 29 L. J. Ex. 3, 5 Jur. 1203 ; and see *Moore* v. *Clarke*, 6 Jur. 648 (a copyright case).

In considering whether one design is an anticipation of another, as in considering whether one design is an infringement of another—for the rules which guide the court are the same in both cases : *Le May* v. *Welch*, (1884) 28 Ch. Div. 24 ; 54 L. J. Ch. 279, 51 L. T. N. S. 867 ; 33 W. R. 33 ; *Walker* v. *Falkirk Iron Co.*, (1888) 5 R. P. C. 71—the eye alone is the judge of the identity of the two things : *Holdsworth* v. *McCrea*, (1867) L. R. 2 H. L. 380 ; *Hecla Foundry Co.* v. *Walker*, (1889) 14 App. Ca. 550, 6 R. P. C. 554.

The test is not merely to look at the two designs side by side, but consideration should be given to what would be the effect supposing they were seen at different times or supposing they were looked at a little distance off : *Grafton* v. *Watson*, (1884) 50 L. T. 420.

In deciding this question of fact, viz., whether one design is an

anticipation of another, the court should have the assistance of experts—persons conversant with the particular trade : *Grafton* v. *Watson*, (1884) 50 L. T. 420 ; *Cooper* v. *Symington*, 10 R. P. C. 264.

7 *Design.*—For definition, see sect. 60, and *ante*, p. 12 *et seq.*

8 *Not previously published.*—For the purpose of seeing whether there has been any prior publication, the design is treated as original, and the question to be determined is whether the particular design has, prior to registration, been disclosed to any person not in a confidential relation to the proprietor : *Blank* v. *Footman*, (1888) 39 Ch. D. 678, 57 L. J. Ch. 909, 59 L. T. N. S. 567, 36 W. R. 921, 5 R. P. C. 653 ; *Winfield* v. *Snow*, (1891) 8 R. P. C. 15. The question is, is it a fair conclusion from the evidence that some person in the United Kingdom under no obligation to secrecy arising from good faith or confidence knew of the design prior to the registration ? If the answer is yes, there has been publication. See *Humpherson* v. *Syer*, (1887) 4 R. P. C. 414 ; *Hunt* v. *Stevens*, W. N. 1878, 79 ; *Westley* v. *Perkes*, (1893) 10 R. P. C. 181.

Following the analogy of patent cases the publication of the design in any picture or book, or the use or sale or public exhibition of an article to which the design has been applied, will be publication in the meaning of this sect. This will generally be a question of fact, see *ante*, p. 32 *et seq.*

For the effect of publication in foreign books : *Lang* v. *Gisborne*, (1862) 31 L. J. Ch. 769, 31 Beav. 133 ; *Harris* v. *Rothwell*, (1886) 35 Ch. Div. 341, 56 L. J. Ch. 459, 4 R. P. C. 225 ; and *United Telephone Co.* v. *Harrison*, (1883) 21 Ch. Div. 720, 51 L. J. Ch. 705 ; and see *ante*, p. 36.

Publication in libraries : see *ante*, p. 37 *et seq.*, and *Plimpton* v. *Malcolmson*, (1875) 3 Ch. D. 531, 44 L. J. Ch. 257 ; *Plimpton* v. *Spiller*, (1877) 6 Ch. D. 412, 47 L. J. Ch. 212 ; *Otto* v. *Steel*, (1885) 31 Ch. D. 241, 55 L. J. Ch. 196, 3 R. P. C. 109 ; and *Harris* v. *Rothwell*, *supra*.

Shewing a design to an expert or friend to get advice, is not publication. But if the person, who is consulted confidentially, changes his character from that of adviser to that of buyer, the character of the communication changes and is no longer confidential : *Winfield* v. *Snow*, *supra*.

Disclosure of the design to persons who are engaged to work out or manufacture the design is not publication : see sect. 61.

Under the old Acts it was doubtful whether the condition (5 & 6 Vict. c. 100, s. 4) that the design should be registered before publication thereof, was limited to publication of the design after it had been embodied and introduced into some fabric : *Dalglish* v. *Jarvie*, (1850) 20 L. J. Ch. 475, 2 Mac. & G. 231 : cf. *De la Branchardière* v. *Elvery*, (1849) 4 Ex. 381, 18 L. J. Ex. 380.

**Sect. 47.**

User in public (unless for experimental purposes) will be publication.

The question whether registration is publication was raised in *Read and Gresswell's Design*, (1889) 42 Ch. Div. 260, 58 L. J. Ch. 624, 61 L. T. N. S. 450, 6 R. P. C. 473, but not decided. The point is an open one, but it is submitted that it is not: registered designs are kept secret, sect. 52; thus differing from that of Trade Marks (sect. 88), registration in which is publication (see sect. 75), see also *Dalglish* v. *Jarvie*, *supra*.

For publication at exhibitions, see 1883, sect. 57, and 1886, sect. 3, and notes thereto, *post*, p. 143.

9 *Register.*—See sect. 55. For effect of registration, see sect. 50. As to the mode of registration, see rule 20.

The provisions of the Act of 1850 (13 & 14 Vict. c. 104), see *post*, p. 212, repealed by this Act, are not re-enacted.

10 *Application.*—As to drawings, &c., see sect. 48, *infra*, and rules 8, 9, *post*, p. 176.

An application must be made in Form E. or Form O. or (for lace) E.', O.', Rule of 1893, rule 4 (the forms in use now are those in the 2nd Schedule to the Designs Rules, 1890—93) and must be signed by the applicant or his agent (rule 8). The form must be stamped with the proper fee (rule 3, sect. 56). The fees are set out in 1st schedule to the rules (*post*, p. 185). Properly stamped forms can be obtained through any Money Order Office in the United Kingdom (see Instructions to Persons who wish to Register, *post*, p. 263).

An application may be amended: rule 30. Form for correction of clerical error Form M. *post*, p. 252; see also sect. 91, and Act 1888, sect. 24, *post*, pp. 159, 160.

Power is given to the comptroller to dispense with the signature to an application, and to make other relaxations of the rules upon good cause shewn: rule 29.

Registration dates from the day on which the Comptroller received the application: rule 20.

11 *The statement of the nature of the design* shall state whether it is applicable for the pattern, or for the shape, or for the configuration of the design; or for any two or more of such purposes, and the means by which it is applicable; where necessary a short technical description of the article, with the part or parts claimed to be new or original specially defined must be added (rule 9, Forms E. and O. marginal note, and Instructions to Persons who wish to Register, 6, (1), note: see *post*, p. 263).

The description of a design on the register must be of the exact form

in which it is intended to sell it, for no portion of the design claimed can be rejected and protection be still retained for the rest: *semble*, Wills, J., *Smout* v. *Slaymaker* (1890) 7 R. P. C. 90.

12 *Class or classes.*—Power given to the Board of Trade to make general rules for (*inter alia*) classifying goods for the purpose of designs: see sect. 101 (1) (6), *post*, p. 163. The various classes are given in the 3rd schedule, *post*, p. 186, and see rule 5. It is important for proprietors to register the design in every class of goods to which they may wish to apply it; for, though no other person would be able to make a valid registration in any other class: (*Read & Gresswell's Design*, (1889) 42 Ch. D. 260, 58 L. J. Ch. 624, 61 L. T. N. S. 450, 6 R. P. C. 471), a registered design is only protected from infringement in the class in which it is registered; and if the proprietor of a design registered in one class applies it to goods which fall within another class, the registration does not protect him for such goods (*Hollersall* v. *Moore*, (1892) 9 R. P. C. 27, 38. See also sect. 58.)

A design may be registered to be applied to a single article in a class or to a set of articles in a class: the term "set" includes any number of articles ordinarily on sale together, irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article. (See Schedule I., *post*, p. 185, and cf. Form O. note, *post*, p. 253). The fees payable vary in the different classes: Schedule I., *post*, pp. 185, 188.

In cases of doubt the Comptroller must decide as to the class: see sub-section 5 of this section.

13 *May refuse to register.*—Before exercising this power the comptroller must give the applicant an opportunity of being heard personally or by his agent, if he desires to be so heard (sect. 94 and rules 12—14). Power is given to the comptroller to correct irregularities in procedure, and to enlarge the times prescribed in the rules, upon terms, as he thinks fit. See rules 30 and 31.

The only direction given to the comptroller as to what designs he shall or shall not register is contained in sect. 86, which empowers him to refuse any design which, in his opinion, is contrary to law or morality; and by sect. 48 (2) the comptroller is empowered to refuse any drawing, &c., which is not suitable for the official records. But sect. 6 of the Act of 1888, *post*, p. 141, contemplates a design being refused on the ground of identity with a design already on the register.

Under the corresponding section, 62, (4), in the Trade Mark portion of the Act of 1883, it is apparently the law that the discretion of the comptroller is limited by the sections which specify what trade marks shall

Sect. 47. not be registered: sects. 69, 72, 73. See *Eno* v. *Dunn*, (1890) 15 A. C. 252, 58 L. J. Ch. 604, 63 L. T. N. S. 6, 39 W. R. 161, 7 R. P. C. 3—11; Sebastian, p. 361; Kerly, p. 64.

14 *Appeal.*—See rules 15—19, and sect. 102 *a.* (Act 1888, sect. 25). Under sect. 11, by which an appeal to the law officer from the comptroller in the case of an opposition to the granting of a patent is given, it has been decided that there is no appeal to the court. Under sect. 62, the corresponding section with reference to Trade Marks, the appeal is decided by the Court if the Board of Trade refers the matter, but it has been held, in a case where the Board of Trade refused to refer, that the Court had no power to deal with an application refused by the comptroller: *In re Trade Mark "Normal,"* 35 Ch. D. 231, 56 L. J. Ch. 519, 56 L. T. N. S. 250, 35 W. R. 464, 4 R. P. C. 123. Therefore it would seem that there is no appeal from a decision of the Board of Trade. And see per Chitty, J., *In re Trade Mark "Normal," supra.*

There being no provision as to costs, the applicant will in any event have to pay his own.

15 *Board of Trade.*—In the corresponding provision (sect. 62) with reference to Trade Marks, power is given to the Board of Trade to refer the appeal to the court.

All proceedings under this Act by and before the Board of Trade are regulated by sect. 102 a. (or Act of 1888, sect. 25.)

Drawings, &c., to be furnished on application.

**48.** (1.) On application[1] for registration of a design the applicant shall furnish to the comptroller the prescribed number[2] of copies of drawings, photographs, or tracings[3] of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens[4] of the design.

(2.) The comptroller may, if he thinks fit, refuse[5] any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.

1 *Application.*—See *ante*, sect. 47.

2 *Prescribed number.*—The number required to be furnished to the comptroller is three. See rule 9. If the full number be not sent with the

application, they must be sent before the delivery on sale of any article to which the design has been applied (Sect. 50). Sect. 48.

If it is desired to s· ·ure a date of registration at once, one sketch of the design (sufficiently definite to identify the same) may be sent with the application form. In this case the design, if accepted, will be registered as of the date on which it was received: but no certificate can be issued until three exact drawings, photographs or specimens have been sent in substitution for the sketch.

See instructions, *post*, p. 263. Also cf. sect. 50 (2), *infra*. Cf. the provisional registration of designs under the Act of 1850 (13 & 14 Vict. c. 104, *post*, p. 214).

3 *Drawings, &c.*—For rules as to these, see rules 8, 9, 11, and Instructions, *post*, p. 263. Amendment allowed: Rule 30, see also sect. 91.

4 *Specimens.*—The privilege of registering a specimen instead of a drawing was first given by the Act of 1858 (21 & 22 Vict. c. 70, sect. 5. Under the special words of this Act, read with those of the Act of 1842 (5 & 6 Vict. c. 100, sect. 15), it was decided that in the case of ornamental designs registration of the specimen alone was sufficient and no description in writing was necessary: *Holdsworth* v. *McCrea*, (1867) L. R. 2 H. L. 380, 36 L. J. Q. B. 297. Under the present Act a "statement of the nature of the design" must be sent with every application. See sect. 47, and this must be the case whether a specimen or a copy is supplied.

Under the Act of 1858 it was also decided that, if the design consisted of separate parts each of which might have been registered separately, the registration of the pattern was a claim for the entire design, comprehending the whole pattern and not of the separate parts: *Holdsworth* v. *McCrea*, *ubi supra*; *Grafton* v. *Watson*, (1884) 50 L. T. N. S. 42, affirmed, 51 L. T. N. S. 143. This would, perhaps, be the case under the present Act, if nothing is said to the contrary in the application; but an applicant now adds a description of the article defining the parts claimed as new: sect. 47 (3); see Instructions, *post*, p. 263.

5 *May refuse.*—See rules 12—19; sect. 94; sect. 47 (6), *ante*, p. 127.

**49.** (1.) The comptroller shall grant a certificate[1] of registration to the proprietor of the design when registered.[2] Certificate of registration.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy[3] or copies of the certificate.

**Sect. 49.**

1 *Certificate.*—Form G. Such certificate is *primâ facie* evidence of the entry on the register and the contents thereof: sect. 96. It is supplied in the first instance without an extra fee: rule 10. Such certificate is to be sent "when the comptroller determines to register": rule 10. But according to the practice of the Patent Office, if a date of registration merely has been secured by an application accompanied by a single sketch, no certificate will be issued until three exact drawings, photographs or specimens have been sent in substitution for the sketch: "Instructions," *post*, p. 263.

2 *When registered.*—The entry is not made in the register until the certificate of registration is sealed, but registration dates from the day on which the application is received by the comptroller (see rule 20).

3 *Copy.*—A copy will be given, if application be made, on a properly stamped request: Form H., rule 34. The fee is one shilling: see *post*, p. 185.

## *Copyright in Registered Designs.*

Copyright on registration.

**50.** (1.) When a design is registered,[1] the registered proprietor[2] of the design shall, subject to the provisions of this Act, have copyright[3] in the design during five years[4] from the date of registration.[5]

(2.)[6] Before delivery on sale[7] of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase[8] his name from the register, and thereupon his copyright in the design shall cease.

1 *When a design is registered.*—The copyright in designs depends absolutely on due registration and in this respect materially differs from the copyright in books, paintings, &c., of which the copyright is reserved to the author, and registration only affects the remedies given to the proprietor of the copyright against infringers of his rights.

Under the old design Acts a distinction was made between useful and ornamental designs, by this Act all designs are put on the same footing.

See sects. 47, 48, and 49, and notes.

Sect. 50.

2 *Proprietor.*—For definition, see sect. 61 and notes.

3 *Copyright.*—For definition, see sect. 60.

Copyright in designs is purely of statutory creation ; before the Act of 1787 (27 Geo. III. c. 38) the inventor of a design could obtain no protection for his invention : see the Preamble of that Act.

4 *Five years.*—Under the old designs Acts varying terms of protection in the different classes were granted, the longest of which was three years, though the Board of Trade had power to extend this term by another three years in the case of ornamental designs : 5 & 6 Vict. c. 100, s. 3 ; 6 & 7 Vict. c. 65, s. 2 ; 13 & 14 Vict. c. 104, s. 9.

5 *The date of registration.*—Registration is deemed to date from the date on which the comptroller received the application : rule 20.

6 It appears to be assumed in subsection (2) that a design is registered from the time an application, accompanied by a single sketch, is received by the comptroller. The instructions issued by the Office show that this is the reading which the Office authorities give to the section.

7 *Delivery on sale.*—The only thing forbidden is the actual delivery on sale of the completed article, so that apparently a person who has obtained a date of registration by sending in an application accompanied by a single sketch may freely exhibit his design, obtain orders or even send out patterns, provided he does not sell them : see sect. 51, note. He may also, it would seem, sell and assign his rights or give licenses.

8 *The comptroller may erase.*—It seems that the proprietor of a design, if he fail to comply with the requirements of this sub-section, does not lose his rights absolutely, as in the case of a failure to mark under sect. 51, but only if the matter is brought to the attention of the comptroller and he decides to erase the entry.

Any person affected by this subsection would have a right of being heard before the comptroller : rules 12—14 ; and a right of appeal to the Board of Trade : rules 15—19 ; sect. 102a. ; Act 1888, sect. 25.

Marking registered designs.

**51.** Before delivery on sale[1] of any[2] articles to which a registered design has been applied,[3] the proprietor[4] of the design shall cause each such article[5] to be marked with the prescribed mark,[6] or with the prescribed word or words or figures, denoting that the design is re-