

THE LAW OF
COPYRIGHT IN DESIGNS,

TOGETHER WITH THE

PRACTICE RELATING TO PROCEEDINGS IN
THE COURTS AND IN THE COMPTROLLER'S OFFICE,

THE PATENTS AND DESIGNS ACT, 1907,

AND

THE REPEALED ACTS, 1883—1888, COMPARED,

THE STATUTORY RULES AND FORMS,

AND THE INTERNATIONAL CONVENTION.

WITH NOTES

AND

A FULL APPENDIX OF

STATUTES, FORMS AND PRECEDENTS, WITH ILLUSTRATIONS.

SECOND EDITION.

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SIR JOHN FLETCHER MOULTON,

LORD JUSTICE OF APPEAL.

PREFACE.



THE necessity for a re-statement of the English Law of Designs has been emphasized by the passing of the recent Patents and Designs Act, which has consolidated the various statutory provisions previously in force, while leaving the large mass of judge-made law which had grown up around them for the most part untouched.

The subject of Copyright in Designs is of much practical importance to the manufacturing and industrial undertakings of the country. Great commercial interests are now largely dependent on the protection afforded. The number of designs registered last year was over 26,000, and is likely to be now increased under the new Act, which extends the term of protection from five to an optional fifteen years, and gives enlarged rights and advantages to all registered owners.

The present work was commenced last year, when the growth of the decisions on the old Acts already seemed to justify the issue of a fresh edition of Mr. EDMUNDS' work, issued in 1895, but its progress was delayed by the

introduction of Mr. Lloyd George's Bills for the Amendment and Consolidation of the Law relating to Patents and Designs. The amending Act introduced a large number of modifications in the existing law, and these and the provisions of the Acts then in force were all incorporated in the Consolidating Statute.

The Patents and Designs Act, 1907, and the New Designs Rules and Orders made under that Act, together with the numerous decisions of the Courts, have necessitated great alterations in the text; indeed, in many parts a complete re-writing of the work. Mr. BENTWICH has undertaken the entire responsibility and very considerable labour involved in this, with the result that this volume, though following the general scheme and outline of the original book, is practically a new work.

Where available the cases on analogous questions in the general Copyright law as well as on Patents and Trade marks have been referred to. On many questions they may be safely followed as decisions which would 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 Copyright reported up to April of the present year. In the Table of Cases the references to all the series of reports are, as far as possible,

given, the pages where a full statement of the facts or the judgment in any case is to be found being marked by heavier type. In the text only one reference is given (with the date of the decision), the official Patent Office Reports being selected wherever available.

The main principles of the law and rules of practice have been distinguished by a different arrangement of types from the decisions on which they are based, or which illustrate them, and a special point has been made of setting out the actual words of important judgments to avoid the necessity of constant reference to the reports themselves.

The system of providing diagrams in reports of Patents and Designs cases which has been inaugurated in the official Reports, has been followed by the utilization of some of these diagrams as illustrations of important cases of alleged infringement, anticipation, or insufficient marking; and the thanks of the Authors are due to the Comptroller and to the parties concerned in cases where no diagrams had previously been published for the permission to make use of these illustrations.

Head-notes have been provided to the different chapters to facilitate reference to any particular point, and these head-notes are repeated in the Table of Contents, which in a few pages thus furnishes a complete analysis of the entire work.

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.

The work has had the great advantage of perusal by Mr. RALPH GRIFFIN, Barrister-at-Law, the Registrar of Designs and Trade Marks, who has made many valuable suggestions, for which the Authors are greatly indebted. Mr. E. W. HULME, of the Patent Office Library, has also given kind assistance.

LEWIS EDMUNDS,

HERBERT BENTWICH.

THE TEMPLE,

May, 1908.

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THE LAW AND PRACTICE OF COPYRIGHT IN DESIGNS.

CHAPTER I.

HISTORY AND DEVELOPMENT OF LAW OF DESIGNS.

(The full references to all Reports will be found in the Table of Cases ante.)

- § 1. The first Copyright Act (1709), 8 Anno, c. 19.
- § 2. Development of Designs and demand for Legislation.
- § 3. Act of 1787 (27 Geo. III. c. 38). Protection for Fabrics of Linon, Cotton, &c.
- § 4. Act of 1839 (2 Vict. c. 13). Extension of Act to Wool, Silk, and Hair.
- § 5. Further Act of 1839 (2 Vict. c. 17). Extension to Articles of Manufacture—Registration and Marking introduced.
- § 6. Piracy defined and Penalties imposed.
- § 7. Provisions for the Registration of Designs and Transfer of Copyright.
- § 8. Consolidating Act of 1842 (5 & 6 Vict. c. 100). Definition of Design.
- § 9. Term of Copyright made dependent upon class of Goods.
- § 10. Action of Damages for Piracy. Provisions for Inspection of Register.
- § 11. Act of 1843 (6 & 7 Vict. c. 65). Extensions to Designs of Utility.
- § 12. Act of 1850 (13 & 14 Vict. c. 104). Extension to Designs within Sculpture Copyright Acts.
- § 13. Provisional Registration. Extension of Term for Ornamental Designs.
- § 14. Act of 1858 (21 & 22 Vict. c. 57). Extension of Term for Woven Fabrics. Penalties introduced for False Marking.
- § 15. Act of 1861 (24 & 25 Vict. c. 73). Extension of Protection to Designs wherever published.
- § 16. Act of 1865 (28 Vict. c. 3). Protection of Designs at Exhibitions.
- § 17. Act of 1875 (38 & 39 Vict. c. 93). Powers of Board of Trade transferred to Commissioners of Patents. Association of Patents and Designs.
- § 18. Act of 1883 (46 & 47 Vict. c. 47). Designs Laws consolidated and included in one Act with Patents and Trade Marks.
- § 19. Alterations introduced by the new Act.
- § 20. Amending Acts of 1885, 1886, 1888, and Designs Rules.
- § 21. Amending and Consolidation Acts of 1907 (7 Edw. VII. c. 28 and c. 29). Alterations in the Law and Extensions of Term of Copyright.
- § 22. The Designs Rules, 1908.
- § 23. Analogy of Law of Patents, Trade Marks, and Art Copyright.
- § 24. Provisions for International Copyright in Designs. The Convention.

§ 1. The first Copyright Act was a literary one, and was passed in 1709 (8 Anne, c. 19). This recognition

of property in the result of mental labour was followed at an interval of twenty-five years by the first statute for the protection of works of art, the Hogarth Act of 1734; but it was more than a quarter of a century later before the same principle was attempted to be applied to ornamental designs on articles of commerce, and it was not till the year 1787 that the first Designs Act (27 Geo. III. c. 38) was passed.

Before this time designers had no means of acquiring any property in their work or of preventing others from imitating it. Designs of a useful character might, as now, in some cases obtain protection by the grant of a patent as for an invention; but this was expensive to procure, and in most cases, such was the technical nature of the law at the time, very difficult to uphold.

§ 2. As in other branches of copyright law, the development of the art led to the demand for legislation; and it is a notable fact that the first statute was confined in its operation to the designing of patterns for printing linens, cottons, calicoes, and muslins which had then become staple products of the English market. This Act of 1787 was of an experimental nature, and was limited in duration, as was frequently the custom at that period with new legislation; but the advantages of the protection soon became manifest, and seven years later the Act was made perpetual.

From this small beginning the protection of copyright in designs has been gradually extended; as regards subject matter, from linens first to all fabrics, then to articles of manufacture, and finally to all substances artificial or natural; as regards character, from mere ornament first to pattern, shape, or configuration, then to purposes of utility, and finally to designs in general without even this qualification; as regards duration, from the original term of two months first to three months,

then to twelve months, then (as to most objects) to three years, and finally, for all, to five, with optional extensions up to fifteen, years; as regards extent, from England and Scotland, to which the original Act was restricted, first to Ireland, then to any country in which a registered design had been applied, and whether by subjects or aliens, and finally to all designs within the protection of the International Union.

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

§ 3. 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 remain in force only till the end of the next session of Parliament; but by 29 Geo. III.

c. 19, the Act was continued till 1794, and by 34 Geo. III. c. 23, the term of two months was extended to three months, and the Act was made perpetual. All these Acts extended only to England and Scotland.

§ 4. In the year 1839 the protection granted to linens, cottons, calicoes and muslins being found advantageous, and the printing of designs on fabrics and animal substances having developed, an Act (2 Vict. c. 13) was passed extending the provisions of the Act of 1787 to fabrics composed of wool, silk and hair, and to mixed fabrics composed of any of those materials with linen, cotton, or flax. The operation of the Acts was also extended to Ireland.

§ 5. In the same session of Parliament an even more important extension of copyright in designs was effected.

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, 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 law was greatly extended. This Act also 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 original designs for the following new purposes:—

- (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*.
- (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. (For such designs, when applied to metals, the term was extended to three years instead of twelve months.)

(3) For the shape or configuration of any article of manufacture, *except lace*.

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.

§ 6. For protection against piracy of registered designs, it was enacted (sect. 3) that during the existence of such exclusive or partial right no person should 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 (that is to say):—

- (a) 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:
- (b) 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 had been used, knowing that the proprietor of such design had not given his consent to the use thereof upon such article:
- (c) 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.

The penalty for every offence against these provisions

was a sum not less than five pounds and not exceeding thirty pounds, payable to the proprietor of the design, which might be recovered 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. 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).

§ 7. With regard to the registration of designs, it was enacted (sect. 6) that the 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 were 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. 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.

It was also provided that every person purchasing a new and original design might enter his title in the register; that *any writing* purporting to be a transfer of such design, and signed by the proprietor thereof, should 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.

§ 8. In the year 1842 (the same year which witnessed the passing after a long struggle of the great Literary Copyright Act which is still in force) the whole of the previous legislation on Designs was swept away, and an amending and consolidating Act passed. By this new Act (5 & 6 Vict. c. 100) copyright was granted (sect. 3) to any new and original design, whether such design were applicable to the *ornamenting* of any article of manufacture, or of any substance, artificial or natural, or partly artificial and partly natural, and whether such design were 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 might be so applicable, whether by printing, or painting, or by embroidery, weaving, or sewing, or by modelling, casting, embossing, or engraving, or by staining, or by any other means whatsoever, manual, mechanical, or chemical, separate or combined. Sculpture and other things within the Sculpture Acts of George III. were excepted from the Act.

This definition of the subject matter of Designs Copyright, except that it was confined to *ornamental* designs, was very similar to that now in force under the Act of 1907, sect. 93, and it is important to observe that it was the ornamental design which was protected, and not the article of manufacture to which it was applied, the incorporeal copyright in the design being always considered a separate entity from the corporeal substance to which it was applied.

§ 9. The term of copyright given by this Act was dependent upon the class of goods to which the design was applied (sect. 3). The classes of goods were thirteen in number and to all of them the term of protection was

extended to three years, except lace, which was restricted to twelve months, and printed shawls and woven fabrics (other than furniture) or coloured yarns and the like, to which only nine months' protection was given.

The copyright was, as in the previous Act, 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 (sect. 4).

The remedies of the proprietor for piracy were also practically the same, but fraudulent imitation of designs was now forbidden in express terms (sects. 7 and 8).

§ 10. A new provision was introduced, giving the proprietor his election to bring an action for any damages sustained by an infringement of his rights (sect. 9).

Power was also for the first time expressly 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).

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 (sect. 17).

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.

§ 11. The protection given to designs was still further extended in the following year by the Act 6 & 7 Vict. c. 65 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 (other than sculpture) 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. Protection was also given to ornamental designs for floorcloths and oilcloths which had not been covered by the previous Act. The Act in other respects substantially incorporated the provisions of the Act of 1842, so far as applicable. The registrar was to exercise his discretion as to what were ornamental designs under the Act of 1842, and what 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; or designs contrary to public morality or order. But an appeal was provided from the registrar to the Board of Trade (sect. 9).

§ 12. In the year 1850 the benefit of the Designs Act, 1842, was extended by the statute 13 & 14 Vict. c. 104, to designs within the Sculpture Copyright Acts, which had hitherto been excluded. On the registration of such designs with the Registrar of Designs, the proprietors were thenceforth to have the machinery of the Designs Act, 1842, for the recovery of penalties and the protection of their copyright. The extended term of copyright given by the Sculpture Acts was not altered, and the registration might be for the whole or any part of the term of such copyright (sects. 6 and 7).

§ 13. But the more important object of the Act was to provide for the *provisional registration* of designs. It was provided that designs which might be registered under the Designs Act, 1842, or 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 for preventing piracy were available.

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. Articles to which the design might be applied were to be marked "provisionally registered," with the date of registration (sect. 3).

Another new provision of great importance was that contained in sect. 9, by which 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.

Designs for the ornamenting of ivory, bone, papier maché, and other solid substances which were not already comprised in the enumeration of classes of protected articles in the Designs Act, 1842, were to be deemed and taken to be comprised within the class numbered 4 ("Articles of manufacture composed wholly or partially of earthenware") in that Act, and such designs were to be so registered.

§ 14. A further amending Act was passed in 1858 (21 & 22 Vict. c. 70), to make additional provision against piracy, and to extend the term of copyright given to designs applied to printed woven fabrics from nine months to three years. Any person applying any "mark of registration" to any article to which 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); proceedings for damages for piracy might be commenced in the County Court;

and the defendant in any such proceedings if he intended to rely as a defence on any objection to the copyright or to the title of the proprietor, was to give notice of such special defence, stating also the date and other particulars of the alleged anticipation or of any other objection (sect. 8).

§ 15. The previous Acts had all applied exclusively to designs to be applied to articles of manufacture or other substances made within the United Kingdom, but the extension of free-trade principles and the influence of the great exhibitions now called for the removal of these limitations, and by an Act of 1861 (24 & 25 Vict. c. 73), after reciting in the preamble that "*it is expedient that the provisions of the said recited Act (the Act of 1842) and of all Acts extending or amending the same should apply to designs and to the application of such designs, whether such application be within the United Kingdom or elsewhere,*" it was enacted that the protection given by the Acts should be extended to all copyrightable designs whether the application thereof was done within the United Kingdom or elsewhere, and whether the inventor or proprietor of the design was a subject of the Queen or not (sect. 1).

It was also expressly provided that all the Acts then in force should not be construed to apply to the subjects of Her Majesty only (sect. 2).

§ 16. A further movement was made in the same direction by an amending Act of 1865 (28 Vict. c. 3), which provided for the protection of designs exhibited at industrial exhibitions certified by the Board of Trade. Exhibition at such industrial exhibitions, or publication during the period thereof, of a design, was not to prejudice any subsequent registration.

§ 17. In the year 1875 (38 & 39 Vict. c. 93) the powers and duties of the Board of Trade under the Designs Acts were transferred to the Commissioners of Patents, who

were given power to make general rules for the regulation of the Designs Office, subject to the approval of Parliament. The office of registrar as a separate office was abolished, his duties and discretionary powers being transferred to the Commissioners.

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 this Act, the regulation of the copyright in designs has since that time been closely connected with patents and trade marks; but this is a purely artificial arrangement, and it is doubtful whether the principles attaching to the protection of designs do not approximate more closely to those affecting copyright in works of art, than to inventions with which designs are, for administrative purposes only, now associated.

§ 18. The new departure in administration thus inaugurated led to the inclusion of the law relating to copyright in designs in the Patents, Designs, and Trade Marks Act, 1883, which, with slight modifications, remained for the next quarter of a century the statutory law on the subject. By this Act (46 & 47 Vict. c. 17), the whole of the previous Acts relating to designs and trade marks were repealed, and new provisions 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.

§ 19. The principal alterations introduced by the new law were—(a) the extension of the term of copyright from three years to five years for all registrable designs, and the consequent abolition of the distinction between classes of designs except for registration and marking purposes (sect. 50); (b) exemption from for-

feiture of copyright for non-marking of articles where the proprietor could show that he had taken all proper steps (sect. 51); (c) a provision for cesser of the copyright in any design used in manufacture in any foreign country and not used in the United Kingdom within six months of its registration (sect. 54); (d) increase of the penalty for infringement to a sum not exceeding 50*l.* for each offence; (e) abolition of the distinction between ornamental and useful designs, and extension of the protection to designs (other than sculptures) of every kind, without regard to utility (sect. 60); (f) the introduction of a power to expunge or vary entries in the register at the instance of "any person aggrieved" (sect. 90); (g) power to make international arrangements, confirmed by Order in Council, for mutual protection of designs (sect. 103); and (h) omission of the old provisions for discretionary extension of the term of copyright, for the registration of works of sculpture, and for the provisional protection of designs.

§ 20. Slight modifications were made in this Act by amending Acts of 1885, 1886 and 1888, which included provisions for the extension of the protection given to designs exhibited at industrial exhibitions to such exhibitors when held out of the United Kingdom (49 & 50 Vict. c. 37, s. 3); for the right to inspect the original entry of any registered design where registration was refused by the Comptroller on the ground of identity (51 & 52 Vict. c. 50, s. 6); and for the limitation of the penalties recoverable in any proceeding in respect of any one design to 100*l.* (*ibid.* sect. 7).

Statutory rules and scheduled forms, with official instructions, were issued under these Acts regulating the practice on the registration, marking, and dealing with designs; and these rules and forms were judicially recognised as "practically part of the Act of Parlia-

ment" (a). They included provisions for the description of the nature of the design for which copyright was claimed; for the hearing of appeals by the Board of Trade from refusal of registration by the Comptroller; for the proof of title on transfers or other dealings with the copyright; and for the examination of designs proposed to be registered, and the issue of certificates as to non-imitation of registered designs.

§ 21. The decision of the Courts under these Acts and Rules were fairly numerous, owing principally to the very incomplete nature of the statutory provisions; but a large number of ambiguities and difficulties in practice still remained, and an attempt was made to remove these, with certain anomalies, by an Amendment Act for Patents and Designs (7 Edw. VII. c. 28), which, with a Consolidating Act (7 Edw. VII. c. 29), embodying all the statutory law, including these amendments, was passed, and received the Royal Assent on the 28th August, 1907, the new law coming into force on the 1st January, 1908.

The Patents and Designs Act, 1907, repealed, with a few temporary exceptions, the whole of the previous statutory provisions on the subject, including the provisions of the Amendment Act, which had thus practically no independent existence. It contains some important alterations of the old law relating to designs: (a) the term of copyright protection is extended to a possible fifteen years by optional renewals after the expiration of the first term of five years; (b) the penalty of loss of the entire copyright previously attached to the omission to mark articles bearing the registered design is reduced to stoppage of the remedy by way of penalties or damages

(a) Per the Lord Chancellor (Halsbury) in the House of Lords, *In re Rollason's Design* (1898), 15 R. P. C. 441. By sect. 101 (3) of the 1883 Act they were required to be judicially noticed.

in the absence of other notice to the infringer; (c) the failure to manufacture articles to which the registered design is applied exclusively or mainly within the United Kingdom will form ground for an application for cancellation or a good defence to an action for infringement; (d) the provisions, formerly applying only to patents, as to granting certificates of validity and for proceedings for the issue of threatening circulars or advertisements, are extended to designs; and (e) there are provisions for the creation of local branch offices for designs business, and other amendments in the practice on registration and on transfer of the copyright.

§ 22. The principal provisions of the new Act are subject to rules to be made and forms and regulations to be prescribed by the Board of Trade from time to time; and a first set of rules has now been issued, dealing with all questions of practice. The Rules of 1908 create separate classes for hosiery and checks and striped goods, and distinguish the classes for textile goods from all the other classes; a branch office is established at Manchester to deal with these with a separate Register; foreign owners are required to register an address for service in the United Kingdom; power is given to the Comptroller to amend applications and correct clerical errors on the Register; greater latitude is allowed for the mode of marking; a code of procedure is fixed for applications for cancellation on the ground of manufacture abroad; and a very complete set of forms for assignments and other dealings with registered designs is scheduled, with new provisions as to declarations and other evidence in support.

§ 23. Notwithstanding these alterations, most of the decisions under the previous Acts are of value, as many of the provisions of the new Acts of 1907, relating to

designs, are, with more or less modification, 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; and the authorities as to originality, infringement, and remedies under the Art Copyright Acts will also frequently be found to be in point.

§ 24. The provisions for international protection contained in the 1883 Act have been largely made use of, and immediately after its coming into force accession was given to the International Convention for the protection of industrial property which had been signed at Paris in the previous year on behalf of the principal European Governments. This Convention constituted a code for the mutual protection of patents, designs, and trade marks. The International Union has since been largely extended by the adhesion of other countries outside Europe (including the United States of America), and Orders in Council have been issued under sect. 103 of the old Act (continued by sect. 91 of the 1907 Act), applying its provisions to those countries which have extended similar protection to designs of British origin.

CHAPTER II.

MEANING OF "DESIGN."

(The full references to all the Reports will be found in the Table of Cases ante.)

- § 25. What is a Design?—Statutory Definition.
- § 26. Limitations in the Statutes.
- § 27. Dictionary Definitions.
- § 28. Scope of the Act of 1907.
- § 29. Judicial Decisions—Opinions of the Judges in *Harrison v. Taylor*, *Re Rollason's Design*, and *Re Bayer's Design*.
- § 30. No Distinction between Ornamental and Useful Designs (*Hecla Foundry Co. v. Walker*; *Moody v. Tree*).
- § 31. Design is that which is applied (*Re Clarke's Design*).
- § 32. Design may be Registered though also Subject Matter for Patent or Trade Mark (*Werner Motors v. Gamage's*).
- § 33. What is not a Design (*Nevill v. Bennett*).
- § 34. Illustrative Cases—Corset Cases (*Cooper v. Symington* and *Re Bayer's Design*)—Fire-door Cases (*Walker v. Falkirk Iron Co.* and *Hecla Foundry Co. v. Walker*)—Spoon-handle Case (*Saunders v. Wiel*)—Coffin-plate Case (*Re Rollason's Design*).
- § 35. Result of the Authorities.
- § 36. Classification of Designs.

§ 25. The first question which arose under the Act of 1883, and which remains unsolved by the new Act of 1907 (a), was, What is a design? That question has never been definitely answered, and only an approximation to a settlement of it is to be derived from the different judicial decisions under these and the preceding Acts. The definition of "design" given in the new Act (sect. 93) is stated in the following terms:—

"In this Act, unless the context otherwise requires, 'Design' means any *design* applicable to any article not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (54 Geo. III. c. 56),

(a) Throughout this work whenever we speak of the old Act or the Act of 1883, the Patents, Designs and Trade Marks Act of 1883 (46 & 47 Vict. c. 57), is meant, and whenever we speak of the new Act or the Act of 1907, the Patents and Designs Act, 1907 (7 Edw. VII. c. 29), is referred to.

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.”

§ 26. This definition, which is practically a copy of that in the 1883 Act (sect. 60), is taken from the old Act of 1842 (5 & 6 Vict. c. 100), s. 3, save that the initial words there were “any design applicable to the ornamenting of any article of manufacture” (*b*). Except for the great generality of its character, which may, in some cases, be a matter of some importance (*c*), the definition as a definition is singularly valueless, for it begins “a *design* is a *design* applicable, &c.” There is, in fact, 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 has been contended that the intention was to limit the Act to certain classes of designs, leaving the public to discover for themselves what a design capable of protection is; but a more generous view has been taken in recent cases, and in *Re Rollason's Design* (*d*) the House of Lords held that the object of the section was to make the word “design” “as extensive as it reasonably ought to be.”

From the meaning given to the word in dictionaries, from the definition clause, and from the statements of various Judges in decided cases, it is possible to form a fairly definite notion of what designs the protection of the Act is extended to.

§ 27. The following are some of the definitions of the word “design” given by the Dictionaries:—

(*b*) The Designs Act, 1843 (6 & 7 Vict. c. 65), extended the scope of the Designs Act, 1842, so as to make it embrace designs having reference to some purpose of utility.

(*c*) Per Lord Herschell in *Re Rollason's Design* (1898), 15 R. P. C. 441.

(*d*) *Supra*.

The Oxford Dictionary.

The combination of artistic details or architectural features which go to make up a picture, statue, building, &c.; the artistic idea as executed; a piece of decorative work, an artistic device.

Original work in a graphic or plastic art. Cf. Ruskin (*Two Paths*): "Design properly so called is human invention, consulting human capacity."

Webster, ed. 1900.

A preliminary sketch, an outline or pattern of the main features of something to be executed.

The realization of an inventive or decorative plan; especially a work of decorative art considered as a new creation, conception or plan shown in a completed work.

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.

Dr. Johnson, ed. by Latham, 1866.

1. Intention, purpose, scheme, plan of action.

2. Idea which an artist endeavours to execute.

An excellent definition of the meaning of "design" was given by Grosskup, J., in the recent American case of *Pelouse Scale Co. v. American Cutlery Co.* (102 Fed. Rep. 916). "Design is that characteristic of a physical substance which, by means of lines, images, configurations and the like, taken as a whole, makes an impression, through the eye, upon the mind of the observer. The essence of a design resides, not in the elements individually, nor in their method of arrangement, but in the *tout ensemble*—in that indefinable whole that awakens some sensation in the observer's eye. Impressions thus imparted may be complex or simple; in one is mingled impressions of gracefulness and strength, in another impressions of strength alone. But, whatever the impression, there is attached in the mind of the observer, to the object observed, a sense of impression and character" (e).

(e) Cited in *Ruling Cases*, Vol. XXV., p. 266.

§ 28. From the section, however, it appears that the only designs to which the Act of 1907 has reference are those designs which are applicable to some article, the word “article” being defined to mean, as respects designs, “any article of manufacture and any substance, artificial or natural, or partly artificial or partly natural.” The following words as to designs being “applicable for the *pattern . . . shape . . . configuration . . . or ornament*” of such articles, do not introduce any further limitation. This, as we have said, restricts to some extent the classes of designs to which the Act is applicable, but it does not, and perhaps purposely does not, define design (*f*). But whether a satisfactory definition is found or not, the scope of the Act is clearly enough defined—protection is intended to be given to all industrial designs, whether for pattern, shape, configuration or ornament, and by whatever means they may be applicable.

§ 29. The following cases are illustrative of judicial views on the subject:—

In *Harrison v. Taylor (g)*, 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.”

In the more modern case of *Re Clarke’s Design (h)*, Lindley, L.J., after saying that for the purpose of interpretation the word “design” must be taken in its ordinary signification adopted the terse definition of “something marked out, a plan or representation of something” (*i*). And Lopes, L.J., in the same case gave a summary of the varieties of objects to which designs might be applied in the following terms: “A design within the Act may be some ornament printed or produced in the flat, such as woven or printed designs in textile fabrics, paper hangings, floorcloths, or the like, or

(*f*) *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380. But see *Re Rollason’s Design* (1898), 15 R. P. C. 441.

(*g*) (1859) 29 L. J. Ex. 3.

(*h*) (1896) 13 R. P. C. 351.

(*i*) Adopted by Warrington, J., in *In re Bayer’s Design* (1906), 23 R. P. C. 553.

patterns or designs etched or stamped, or cast or embossed or cut or otherwise produced in metal articles or glass or plastic material or furniture or tiles, or worked or woven as in lace; or it may be for artistic or beautiful shape in configuration as a lamp stand or lamp shade or iron railing or gate, or for shape in which no appeal is made to a sense of beauty, as in a new shape or configuration of a grate door or oil can or cravat; or the design may contain two or all of the foregoing elements, *i.e.*, ornament, pattern, shape and configuration.”

In the later case of *Re Rollason's Design (j)*, Lord Herschell, in pronouncing the judgment of the House of Lords, said: “The object of the Interpretation Clause (sect. 60 of the 1883 Act) is to make the word design in sect. 47 and the following sections *as extensive as it reasonably ought to be*. It was not intended to draw a sharp, hard and fast distinction between the design as being applicable for the ‘pattern’ or for the ‘shape or configuration’ or for the ‘ornament.’ The object in introducing the words, ‘whether applicable for the pattern or for the shape or configuration or for the ornament thereof,’ was to use words which would include everything which would ordinarily fall within the word ‘design,’ and to show that the word ‘design’ was not intended to be used in any technical sense as excluding anything that would ordinarily fall within it.”

In the most recent case, *Re Bayer's Design (jj)*, Fletcher Moulton, L.J., said: “Designs apply to nothing but that which the eye can tell entirely. Nothing in my opinion is a good design but that of which full knowledge is given when you have once shown to the eye what your design is. It may be shape, or configuration, that is given by a specimen, or by a proper drawing, and the eye can see it, and the eye can recognise whether it has been imitated. It may be by a pattern, to which the same applies. It may be by an ornament, to which the same applies. But in my opinion nothing beyond that can properly be called a ‘design’ within the meaning of this statute.”

§ 30. The old distinction between ornamental and useful designs made in the earlier Designs Acts (*k*) is now done away with, and both classes of designs are now treated alike. Whether a design is or is not useful is, so far as subject matter is concerned, an entirely immaterial question under the 1907 (as it was under the 1883) Act.

(j) *Supra*.

(jj) On appeal (1907), 24 R. P. C. 65.

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

More 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 (*l*).

In *Hecla Foundry Co. v. Walker* (*m*), Lord Herschell said: “I quite agree with what was said by Lord Shand in *Walker v. Falkirk Iron Co.* (*n*), 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.”

In *Moody v. Tree* (*o*), Baron Pollock expressed a similar view in the following terms: “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.”

So in *Re Clarke’s Design* (*p*), Lindley, L.J., in giving judgment in the Court of Appeal, said: “The statute applies to all such designs as are within it, whether they add to the utility of the articles to which they are applied or whether they do not. The question of utility is wholly immaterial in considering this Act of Parliament.”

§ 31. The design is not the article of manufacture, but that which is applied to the article of manufacture.

In the case of *Re Clarke’s Design*, previously quoted, Lindley, L.J., said: “The Act does not apply to the things to which a design is applied; the Act applies to the design applied to

(*l*) *Cooper v. Symington* (1893), 10 R. P. C. 264; *In re Bayer’s Design*, *supra*.

(*m*) (1889) 6 R. P. C. 554.

(*n*) (1887) 4 R. P. C. 90.

(*o*) (1892) 9 R. P. C. 333, 335; and see Lord McLaren’s judgment in *Walker v. Falkirk Iron Co.*, *supra*.

(*p*) (1896) 13 R. P. C. 351.

them. The distinction is obvious enough when the design is for a pattern or ornament; but when, as in this case, the design is for the shape of a thing, the distinction is reduced to the difference between the shape of a thing and a thing of that shape. A design applicable to a thing for its shape can only be applied to a thing by making it in that shape. A design for the shape of something is what is meant by sect. 60 when shape is in question; and a registered design for a shape of a thing is infringed if that thing is made in the shape shown by the registered design.”

§ 32. That a design is also good subject-matter for a patent is immaterial to the designer who desires to take advantage of the cheaper though more limited protection afforded by this branch of the Act (*q*). But he must remember that no mechanical contrivance or principle (*r*), no process of manufacture (*s*), can be a design (*t*). 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 (*u*).

Thus in *Werner Motors v. Gamage's, Ltd.* (*x*), where the plaintiffs had on the 18th November registered a design “for the pattern as shown of a motor cycle frame,” and had already on the 8th November applied for a patent for a frame for motor cycles, the same as that shown in the design, and the patent was in due course granted, and it was contended that the registration was invalidated by reason of the grant of exclusive rights in the article, it was held by Byrne, J., that the registration of the design was not invalidated by the patent because, first, the design was registered before the actual grant of the patent; secondly, that the right of copyright in a design is not a grant but is statutory; and thirdly, that rights under a patent and in a design are separate and distinct and may co-exist. And in confirming this decision, the Court of Appeal (at p. 621) added that “the applicant for a patent for an article and for registration of a design for the

(*q*) *Rogers v. Driver* (1850), 16 Q. B. 102; *Hecla Foundry Co. v. Walker* (1889), 6 R. P. C. 554; *Millingen v. Picken* (1845), 14 L. J. C. P. 254.

(*r*) *Margetson v. Wright* (1848), 2 De G. & Sm. 420; *Hecla Foundry Co. v. Walker*, *supra*; *Cooper v. Symington* (1893), 10 R. P. C. 264.

(*s*) *Walker v. Falkirk Iron Co.* (1887), 4 R. P. C. 390; *In re Bayer's Design* (1907), 24 R. P. C. 65.

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

(*u*) See § 34, *infra*, for a full statement of the cases cited.

(*x*) (1904) 21 R. P. C. 137, 621. For illustration of the design in this case, see Appendix F., Sheet 9, *post*, p. 431.

shape of a similar article is not under the Patents Act put to an election, but may secure both” (*y*).

So in the recent case of *Re Bayer's Design* (*z*), which was an application for removal of a design applicable to corsets on the ground (*inter alia*) that the design as registered incidentally described a mode of manufacture, and was therefore not good subject-matter. Warrington, J., said: “In a case like this *design and manufacture* are really *inseparable*. You cannot picture a corset having upon it particular lines which represent the joining of the several pieces by which it is made up, without describing in a sense the mode in which the corset is made. It seems to me, however, that the fact that, in making a design you incidentally describe a mode of manufacture, does not make a design less a design if it is in itself a design.” But in the Court of Appeal this judgment was reversed, and on a further appeal to the House of Lords, Lord Macnaghten, in delivering the judgment of the House of Lords, said: “Now, although a design, properly so called and duly registered, may incidentally protect a method of manufacture, it is clear that mere method of manufacture cannot be registered as a design under the Act.”

§ 33. Again, it should be remembered that a colour is not a design, nor is an effect a design, but only the combination which produces the effect (*a*). On the other hand, a portion of an article may be a design (*b*), and a combination also may be a design (*c*).

Thus in *Nevill v. Bennett* (*d*), a case in the Chancery of the County Palatine relating to textile goods, printed with a design made up from old materials for the Persian market, Hall, V.-C., said: “The question is not whether or not each detail is old; the question is whether the design as a whole is old, or whether it is new . . . you may have all the details old but the combination, the rearrangement, may be such that the effect is new, that the design is new.”

§ 34. The following cases illustrate the above rules (*e*):—

(*y*) So in America, where designs are made the subjects of patents, it has been held that one patent may be taken out for mechanical construction and another patent for the design of the same article: *Flowerwell v. Newcritten*, 88 Fed. Rep. 698, cited in *Ruling Cases*, Vol. XXV., p. 265.

(*z*) (1906) 23 R. P. C. 553; and on appeal (1907), 24 R. P. C. 65.

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

(*b*) *Walker v. Falkirk Iron Co.*, *supra*.

(*c*) *Norton v. Nicholls*, 28 L. J. Q. B. 225; *Grafton v. Watson*, *supra*.

(*d*) (1898) 15 R. P. C. 412.

(*e*) For leading cases decided under the old utility statutes, see *Margetson v. Wright* (1848), 2 De G. & Sm. 420; *Rogers v. Dricer* (1850), 16 Q. B. 102; and *Reg. v. Bessell* (1851), 16 Q. B. 810.

In *Moody v. Tree* (*f*), 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 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. . . . 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."

In *Cooper v. Symington* (*g*) 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 repairs, &c." Chitty, J., held that there was here no subject matter for registration as a design.

The last two cases were attempted to be distinguished in

(*f*) (1892) 9 R. P. C. 233.

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

the recent case of *Re Bayer's Design (h)*, which was also a corset case, the application for registration including the following passage under the heading, Statement of nature of design: “Shape or configuration of corset; the novelty consists in a corset having the gores or gussets cut horizontally and from the front of the busk towards the back of the corset, as shown in the representation.” The registered sketch showed a straight-fronted corset; and in giving judgment upholding the registration Warrington, J., said: “In the basket case a man registered a picture of a basket, but what he really claimed was not the basket in accordance with that picture but all baskets made in a particular way. I think the distinction between that case and this is, that in the present case you cannot, in making the design and in marking out the image of the corset, avoid showing the person to whom that design is presented how to make the article—in other words, to describe the mode of manufacture. In the case of the basket you could do so. It seems to me, therefore, that although this design may incidentally describe a mode of manufacture, it is properly regarded a design.” But in the Court of Appeal, *Moody v. Tree* was held to apply, and Buckley, L.J., in giving judgment, said: “In this case the design is either bad altogether, as having nothing new or original in it, or it is bad because it merely shows a picture of a single isolated article, and contains no design at all in the sense of suggestion of something which may be used to produce a particular form of corset, namely, a straight-fronted corset. If you read it as meaning that, then it appears to me plain to be a mode of manufacture and not a design.”

Walker, Hunter & Co. v. Falkirk Iron Co. (i) was also 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) that the subject was one for a patent and not for registration as a design, 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, with the concurrence of the other Judges, said: “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

(h) (1906) 23 R. P. C. 553, and on appeal (1907), 24 R. P. C. 65. For illustration of the design in this case, see Appendix F., Sheet 10, *post*, p. 432.

(i) (1887) 4 R. P. C. 391.

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. 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 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."

In *Hecla Foundry Co. v. Walker, Hunter & Co.* (k) the same subject came before the House of Lords; the same fire-door being again in question. Lord Herschell, quoting with approval the above quoted remarks of Lord Shand, also said: "By section 60 of the Patents 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

(k) (1889) 6 R. P. C. 554.

manner as to accomplish’ a particular object. I think the protection was granted for the shape, and for that alone.”

In *Saunders v. Wiel* (*l*), in which the design was one for the handles of spoons, and purported to represent a particular view of Westminster Abbey, it was contended that this was not a design which could be registered, but the contention was rejected by the Courts. Lindley, L.J., said (*m*): “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.”

In the more recent case of *Re Rollason’s Design* (*n*), the design was for a set of coffin plates, and this was registered as applicable “for the pattern,” and in giving judgment upholding the registration, Lindley, M.R., said: “The first question is to consider what is the design. This design was for coffin plates. The design is contained in the drawing which is registered with the Comptroller at the Patent Office. . . . That registered drawing is the design, and nothing else. It is no part of this Act of Parliament that the person registering a design should say and describe minutely, or at all, how it is to be made or how it is to be carried out, and it appears to me immaterial in considering this Act of Parliament whether a design can be copied in more ways than one or not. There may be various methods of producing a coffin plate of this particular design and this particular pattern. . . . We have nothing to do with the mode in which you are making the pattern; that has nothing to do with it at all. The thing is the pattern—the design which is shown here, and nothing else.”

§ 35. The net result of all the cases is that (subject to the other provisions of the Act) protection is given

(*l*) (1893) 9 R. P. C. 467, and on appeal 10 R. P. C. 29.

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

(*n*) (1887) 14 R. P. C. 909, and, on appeal to the House of Lords, 15 R. P. C. 441. For illustration of the design in this case, see Appendix F., Sheet 7, *post*, p. 429.

under the name of "Design" to every combination of lines producing when applied to any substance or article of manufacture either pattern, shape, configuration, or ornament, by whatever means such pattern, etc., may be so produced.

§ 36. The classification of substances and articles of manufacture for the application of designs to which copyright may be obtained under the Rules, shows the universality of subjects to which the Act applies (o). It is as follows :—

- Class 1.—Articles composed wholly or chiefly of metal, not included in Class 2.
- „ 2.—Jewellery.
- „ 3.—Articles composed wholly of wood, bone, ivory, papier maché, or other solid substances not included in other classes, or of materials in which such substances predominate.
- „ 4.—Articles composed wholly of glass, earthenware, or porcelain, bricks, tiles, or cement, or in which such materials predominate.
- „ 5.—Articles composed wholly of paper (except paper hangings), card-board, mill-board or straw-board, or in which such materials predominate.
- „ 6.—Articles composed wholly of leather or in which leather predominates and bookbinding of all materials.
- „ 7.—Paper hangings.
- „ 8.—Carpets and rugs in all materials, floorcloths, and oilcloths.
- „ 9.—Lace.
- „ 10.—Hosiery.
- „ 11.—Millinery and wearing apparel, including boots and shoes.
- „ 12.—Ornamental needlework on muslin or other textile fabrics.
- „ 13.—Printed or woven designs on textile piece goods (other than checks or stripes).
- „ 14.—Printed or woven designs on handkerchiefs and shawls (other than checks or stripes).
- „ 15.—Printed or woven designs (on textile piece goods or on handkerchiefs or shawls) being checks or stripes.
- „ 16.—Goods not included in other classes.

(o) Schedule IV. to the Rules of 1908. The classes agree generally with those under the old Act, except that Classes 9 and 10 were formerly in one class (9) and a new class (15) is formed for checks and stripes which were previously included in the old Classes 13 and 14 comprising textile piece goods and handkerchiefs and shawls respectively. Classes 11, 12 and 16 under the Rules of 1908 were numbered 10, 11 and 12 respectively under the old Rules.

CHAPTER III.

NOVELTY.

(The full references to all the Reports will be found in the Table of Cases ante.)

- § 37. General Rules as to Novelty—Effect of Publication.
- § 38. Distinction between “New” and “Original” (*Sherwood v. Decorative Art Tile Co.*).
- § 39. Differences from Patent Law.
- § 40. Novelty in the application of the Design (*Saunders v. Wiel*).
- § 41. New method of Appliance not a Novelty (*Cooper v. Symington*).
- § 42. Utility immaterial as to Subject Matter (*Tyler v. Sharpe*).
- § 43. Novelty involves substantial difference from what has gone before—Tandem-collar Case (*Le May v. Welch*)—Lamp-shade Case (*Re Clarke's Design*).
- § 44. Novelty arising from Combinations of Old Designs—Honeycomb Pattern Case (*Harrison v. Taylor*)—Card-basket Case (*Lazarus v. Charles*).
- § 45. Test of the Eye—Motor-cycle Frame Case (*Werner Motors v. Gamage's*).
- § 46. Application of Old Designs to New Substances—Lamp-shade Cases (*Re Buch's Design* and *Re Read and Greswell's Design*).
- § 47. Application to New Purposes (*Walker v. Falkirk Iron Co.*).

§ 37. The Act of 1907 provides (as did the Act of 1883) that to qualify for registration a design must be “new or original and not previously published in the United Kingdom” (a). A design which has been published is no longer novel, and no copyright in such a design can be obtained even by an independent author. The words of the Act are “new or original,” coupled with the phrase “not previously published”; but it is clear that the production of a design which has never been published does not act as a bar to the registration of the

(a) Sect. 49 (1).

same design by any subsequent independent author (*b*). What is requisite therefore to take a design out of the class of designs "new or 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. Novelty is essential in every case. In every case also prior publication is fatal; previous production uncommunicated to the public is not.

But the new Act has introduced (*c*) two exceptions to these rules in favour of the proprietor of a design already on the register in respect of one or more classes of goods by providing that the application of such a proprietor to register in one or more other classes shall not be refused nor the registration invalidated (*a*) on the ground of the design not being a new and original design by reason only that it was so previously registered, (*b*) on the ground of the design having been previously published by reason only that it has been applied to goods of any class in which it was so previously registered.

These two exceptions apply only in the case of proprietors already on the register, and we shall therefore, in the first instance, treat generally of the subject of what is "new or original," which involves the consideration of how far a given design is the same or substantially the same as other existing designs; and in a separate chapter (*d*) of "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 the authorities on art copyright and patent

(*b*) See *Bentley v. Fleming* (1844), 1 Car. & K. 587; *Lewis v. Marling* (1829), 1 W. P. C. 493.

(*c*) Sect. 50.

(*d*) See p. 46, *infra*.

law in which similar considerations arise as the basis of title.

§ 38. Whether any distinction was intended to be made between the terms “new” and “original” does not seem clear; but the Act does not require that the design shall be both new and original to entitle it to registration. It will apparently be sufficient to prove that a design is new without inquiring as to its originality (*e*).

In the case of *Sherwood v. Decorative Art Tile Co.* (*f*), Manisty, J., used words which seemed to imply that he thought there was a difference in meaning between the two terms. 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. But I am satisfied this is a new design; the arrangement and effect of it is new. It is really a combination of well-known parts; but so new as to be a new design.”

On the other hand, it has always been recognised that the novelty which is required is something which falls considerably short of originality in the ordinary sense, and that a design need only be new in its application to the substances in the class in which it is registered, though possibly old for goods of a different description.

In *Re Clarke's Design* (*g*), Lindley, L.J., said: “What, then, is the test to be applied to a case such as that before us? The design must be new or original with reference to the kind of article for which it is registered; meaning by kind of article not the class of article mentioned in the schedule to the rules, but the kind of article having regard to its general character and use. A design may be new for a coal scuttle, but not for a bonnet. On the other hand, a design for a shade of a gas lamp can hardly be new if it was old for an oil lamp. There must be some novelty or originality in the shape, as applied to sources of light, in order that a design for the shape of a lamp can be protected.”

(*e*) See, however, sect. 93 (as to proprietorship) where the words used are “new and original.”

(*f*) (1887) 4 R. P. C. 207, 209.

(*g*) (1896) 13 R. P. C. 351.

So in *Re Rollason's Design* (h), the point was discussed by Chitty, L.J., who said: "The principal question is whether Rollason's design as registered is a new or original design. I take it that there may be a distinction, and as the Act has used two different words, there is some distinction between 'new' and 'original.' It might be shown in this way: Every design which is original is new, but every design which is new is not necessarily original. There are very few designs which are entirely new. Hardly any could be produced. They are made up from the old, and several exhibits have been put before us to show what the old was. It is acknowledged in the argument for Mr. Rollason, that his is made up of several old designs which he has combined together. The result of the combination may be to make a novel design, and I think in this case there is sufficient material for us to decide that these old things in combination present to the eye a new design."

§ 39. In determining whether a given design is new or 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 the monopoly in a patentable invention, and the Act will not be construed as strictly as in the case of patents (i).

The distinction was very clearly brought out in the leading case of *Werner Motors v. Gamage's, Ltd.* (k), where the plaintiffs had registered a design "for the pattern as shown of a motor cycle frame," and had at the same time applied for the grant of a patent for the frame which had been duly granted. At the trial Byrne, J., said: "There is nothing inconsistent between a grant for a patent and a coincident right and existence of a statutory right to a design. The object of and privilege conferred by letters patent are wholly different from the object of and privileges conferred by statute to a design by registration. They may be co-existent, and the rights conferred do not clash. The patent rights may be infringed notwithstanding the design, and the design may be infringed though patent rights may not be touched. A design may be copied exactly without a patent for the subject being infringed, and a patent may be easily infringed without

(h) (1897) 14 R. P. C. 909. See also *Hutchisons Ltd. v. St. Mungo Co.* (1907), 24 R. P. C. 265.

(i) *Harrison v. Taylor* (1859), 29 L. J. Ex. 3; *Lazarus v. Charles* (1873), 16 Eq. 117; *Moody v. Tree* (1892), 9 R. P. C. 333. For the distinction between an invention and a design, see the judgment of Moulton, L.J., in *Re Bayer's Design* (1907), 24 R. P. C. at p. 76.

(k) (1904) 21 R. P. C. 137, and, in the Court of Appeal, *ibid.* 621.

touching rights to a design. The two rights are separate and distinct in title as well as in substance." This decision was confirmed by the Court of Appeal, where Romer, L.J., in the course of his judgment, said: "It was suggested, however, that though two independent persons might, under the circumstances I have indicated, have independent rights in the patent and the design, yet the same person could not hold both. I do not on consideration see sufficient reason for so deciding. . . . Consider the case of a patentee who files his provisional specification. He may be in doubt whether his patent will ultimately be held good, though he hopes and believes that it is good; but he is perfectly certain, at any rate that so far as the design of the article is concerned, it is perfectly novel, and that he is entitled to have that design registered. Therefore, after filing his provisional specification, he applies for the registration of the design, and the design is duly registered, and he acquires rights under that registration."

In *Re United States Playing Cards Co.'s Application (l)*, Swinfen Eady, J., held that registration as a design and registration as a trade mark were not mutually exclusive, and that it was no objection to an application to register what was claimed to be a trade mark that the subject-matter of the application was also capable of being registered as a design.

Subject to these general observations, the rules relating to designs may be stated thus:—

§ 40. The novelty required is in the application of the design and not in the design itself, *i.e.*, novelty in the idea, or even in the combination of lines constituting the design, is not necessary if the application is novel.

The leading case upon this point is *Saunders v. Wiel* (No. 2) (*m*). The facts were these:—The plaintiffs registered a design as for 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 with its two towers and pinnacles, 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., said: "The argument really comes to this, it seems to me, that what 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 pro-

(l) 77 L. J. Ch. 204; [1908] 1 Ch. 197.

(m) (1892) 9 R. P. C. 467, and on appeal, 10 R. P. C. 29. See also *Harrison v. Taylor*, *supra*, and *Thom v. Sydall* (1872), 26 L. T. (N. S.) 15.

duce 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 stop 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. 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. 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 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" (n).

In the recent case of *Hutchisons Ltd. v. St. Mungo Manufacturing Co. (o)*, the plaintiffs had registered a design for a

(n) It is difficult to reconcile this with *Adams v. Clementson* (1879), 12 Ch. Div. 714, 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 can hardly be regarded any longer as an authority.

(o) (1907) 24 R. P. C. 265.

golf ball showing a brambled ball having round each of its six poles a small circular smooth raised band having lettering incised on it; the brambles being arranged in concentric circles round the poles. Concentric brambling round six poles had been previously employed, but never in conjunction with name circles round the same six poles. Held, that the design was novel; that it was not necessary that it should be novel *and* original; and that it was validly registered.

§ 41. Where the claim is neither for pattern nor ornament a new method of appliance or manufacture will not entitle a design to registration. In the shape or configuration must be the novelty.

Cooper v. Symington (*p*) is the leading case. There 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.

§ 42. The utility of the design is not to be regarded so far as subject-matter is concerned (*q*), though it may be some evidence of originality (*r*). The standard of originality to which a new design must attain in order to entitle it to protection as a novelty is in such cases not a high one (*s*), and the question of artistic merit is not material.

In *Tyler v. Sharpe* (*t*), the owner of a design for water-

(*p*) (1893) 10 R. P. C. 264; *Moody v. Tree* (1892), 9 R. P. C. 333. And see *In re Buyer's Design*, on appeal (1907), 24 R. P. C. 265.

(*q*) *Moody v. Tree*, *supra*.

(*r*) *Tyler v. Sharpe* (1893), 11 R. P. C. 35.

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

(*t*) (1893) 11 R. P. C. 35. See also *Nevill v. Bennett* (1895), 15 R. P. C. 412, and the observations of Vaughan Williams, J., in *Re Buyer's Design* (1907), 24 R. P. C. at p. 73, to the same effect.

closet basins claimed for infringement of his design by a competing pattern; and it was contended for him that the defendants, by adopting the same shape, had given evidence of its novelty. Romer, L.J., in giving judgment for the plaintiff, said: "I am much impressed, in considering that matter, by the undoubted fact, established before me, that directly this design was put on the market it at once acquired considerable popularity and a large sale, and that the so-called anticipations of that design, so far as proved before me, were never practically sold at all. The plaintiff's design has distinct advantages over the prior designs for similar articles put in evidence on behalf of the defendant—advantages of importance to a manufacturer on a question of utility; such advantages as cheapness of manufacture, strength of the article, and so forth."

So in *Harper v. Wright & Butler (u)*, where the plaintiffs had registered two designs for stoves, the second being a modification of the first with some improvements, including an enlarged base; and it was contended by the defendants that this second design could not be supported as novel or original, having regard to the existence of the first, on which it was founded, and that it was not in the public interest that a person who had registered a design could, by insignificant variations from time to time, extend the term for which he obtained protection. Herschell, C., in dismissing this contention, said: "I cannot see that the public is in the slightest degree affected if those alterations and modifications are immaterial, slight, and unimportant, and do not make the thing, as a whole, a desirable thing which the public will seek to become the owners of. If they do, what better proof can you have that it was a new and original design, of which the person designing ought to be entitled to have the benefit?"

Again, in *Re Rollison's Design (x)*, the question turned on differences between two coffin plates which, in the Court below, were held not to be sufficient to constitute novelty; but in the Court of Appeal and the House of Lords a different view was taken, and Lord Herschell, in giving the judgment of the House of Lords, said: "Having got at the design, and bearing in mind that it is not a design in the abstract but a design for coffin plates, the question, the simple question and the whole question, is whether it is new or original. If we take it that this design is for a coffin plate, with a sunk centre or a raised edge, the case is comparatively easy; because I

(u) (1895) 12 R. P. C. 483.

(x) (1897) 14 R. P. C. 893, 909.

think, from that point of view, it is not certainly anticipated by either the exhibit which has a depressed centre and has more or less of a shell pattern at the edges, or by S.'s, which has no depressed centre at all. You cannot analyse the difference. You might find many differences and yet come to the conclusion that the designs were the same; you might find but few differences and yet come to the conclusion that the designs were different. Very often a very successful design may be one in which the difference from previous designs can, on analysis, be shown to be very slight, where nevertheless the result is to make the one so much more pleasing than the other that it is a successful design."

§ 43. 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; and it is obvious that if a slight difference in design were sufficient to entitle the author to registration, the advantages of the Act would be to a considerable extent lost; for the same principle must be applied to cases of alleged infringement, where small differences would, in that case, be sufficient to protect from the charge of imitation (*y*).

In *Le May v. Welch* (z), 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

(*y*) See the cases as to infringement collected in Ch. VIII., *post*. And see *Hutchisons Ltd. v. St. Mungo Manufacturing Co.* (1907), 24 R. P. C. 265.

(*z*) (1884) 28 Ch. Div. 24, where diagrams of the collars will be found. But see *In re Morton's Design* (1899), 17 R. P. C. 117, and *Pearson v. Wilkinson* (1906), 23 R. P. C. 738.

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: 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* (a) (a case relating to a design for scarves), and it is in accordance with the principles laid down in the older cases of *Windover v. Smith* (b), *Lazarus v. Charles* (c), and *McCrea v. Holdsworth* (d).

In *Re Clarke's Design* (e), a design for a lamp for electric lighting, which consisted as to its lower part of a reflecting screen, old as applied to oil or gas lamps, and as to its upper part of a ventilating top not substantially differing from the top of an old lamp, was held not to have sufficient novelty to support the registration, and Lindley, L.J., in giving judgment, said: "If, when registered, the design was not new or original for all lamps, if the shape was common for such lamps as were used before electric lighting was invented, the design is one to which the Act does not apply, and the design ought to be expunged. Where a design is composed of old parts and is registered, the designing as one whole is what is protected, not the design for some or one of the component parts taken separately from any of the others; and it is not necessary to distinguish what is old from what is new. But treating the design as a design for the shape of the two parts in combination, the view which I take of the evidence brings this case within the principle expounded by this Court in *Le May v. Welch*. There is nothing really new or original in the shape of the kind of article to which the registered design is made

(a) (1889) 6 R. P. C. 200.

(b) (1863) 32 L. J. Ch. 561.

(c) (1873) 16 Eq. 117.

(d) (1870) L. R. 6 Ch. App. 418.

(e) (1896) 18 R. P. C. 351.

applicable. I have come to the conclusion that this design being for shape, and shape only, though now in its application to electric lamps, was old in its application to other lamps, and was not one to which the Act applied."

In *Re Rollason's Design (f)*, where a design had been registered for the pattern of certain coffin plates, and it was contended that this pattern was not novel, having been anticipated by a design of S., another maker, the registration was upheld by the Court of Appeal on the ground of substantial difference from previously existing designs for the purpose.

In the recent case of *Pearson v. Wilkinson (g)*, a registered design for the bodies of perambulators made with a rounded end turned over was challenged by the production of similar forms in cradles and bassinets, but the novelty of the design was upheld by Kekewich, J., who said: "I have had produced before me two articles to which I must pay attention, one marked 'G' and the other 'A'. As regards 'A' . . . the evidence goes to show that it was not meant to be a perambulator, and was never used as a perambulator. It was made, one witness said, for a cradle, which I cannot help thinking is wrong. I have not looked it up in the dictionaries, but in common parlance a cradle is a receptacle for a child with rockers. Of course, this might be put on rockers without difficulty. It is more like what is known in modern terms as a bassinet. It is not a perambulator: though it might be converted into one. It might be put upon wheels with very little ingenuity, but it is not made for that. Therefore it seems to me, according to the authorities, into which I need not go, to be undoubtedly no anticipation. If that is true as regards 'A' it is certainly true as regards 'G,' except that here the article was made as a perambulator. Again, we have the bellied end. There is nothing in it, but it is not turned to advantage by turning over the end towards the child. Looking at it now as I see it, it slopes outwards, not inwards. So that there is no anticipation."

In *Hutchisons Ltd. v. St. Mungo Manufacturing Co. (gg)*, a design for a golf ball, varying only in small but still distinctive features from previous patterns, was held to be novel as applied to those goods, and to be validly registered, although it did not require ingenuity to produce it, and was not really original.

§ 44. It is not necessary that every part of which the

(f) (1897) 14 R. P. C. 909. See also *Werner Motors v. Gamage's, Ltd.*, 21 R. P. C. 627. For illustrations, see Appendix F., Sheets 7 and 9, *post*, pp. 423, 425.

(g) (1906) 23 R. P. C. 738. For illustration, see Appendix F., Sheet 5, p. 427.

(gg) (1907) 24 R. P. C. 265.

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.

R. v. Firmin (h). 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.

Harrison v. Taylor (i). In this case 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 new pattern in which large and small honeycomb cells were arranged so that a border of the larger cells surrounded 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."

These decisions were under consideration in *Lazarus v. Charles (k)*. 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* and *R. v. Firmin* were cited, but the Vice-Chancellor considered that the facts were distinguishable, and he expressed himself reluctant to follow those cases unless

(h) (1851) 3 H. & N. 304 (n.).

(i) (1859) 29 L. J. Ex. 3.

(k) (1873) 16 Eq. 117.

“something novel were introduced in the combination.” He preferred the decision in *Mulloney v. Stevens* (*l*), in 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 was a new and original design.

But in *Sherwood v. Decorative Art Tile Co.* (*m*), where the design for a tile was made up of a floriated pattern surrounded by an old geometrical border, the novelty of the combination was upheld, Manisty, J., in giving judgment, saying: “It is clear to my mind, at all events, that the plaintiff’s design which is now in question was a new combination—a new arrangement of old parts. . . . It is really a combination of old parts, but so new as to be a new design.”

In the more recent case of *Nevill v. Bennett* (*n*), the design was of a pattern to be printed on textile goods, and its novelty was challenged by the defendants, who alleged anticipation; but, in upholding the validity of the design, Hall, V.-C., said: “That this was new and original is obvious from this, amongst other things, that the defendants themselves, as soon as a piece of this design came into their possession (on the instructions of a merchant trading in the same market), went to their designer and said, ‘Design us a design of this kind.’”

So in *Re Bayer’s Design* (*nn*), Vaughan Williams, L.J., in giving judgment, said: “I agree with what has been said that the conduct of the appellants themselves in their production of corsets, which are in accordance with the corset here represented, is itself some evidence to show that the nature of this corset was such that, not having themselves used a corset of that shape before, and seeing this corset, and being people engaged in the trade, they thought that there was sufficient in this corset to make it desirable that they also for the first time should make corsets in accordance with this pattern, and I think there is very considerable evidence in this case in support of the allegation of novelty” (*o*).

§ 45. Novelty is a question of fact (*p*), the ultimate

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

(*m*) (1887) 4 R. P. C. 207.

(*n*) (1898) 15 R. P. C. 412.

(*nn*) (1907) 24 R. P. C. 65.

(*o*) 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; and in *Rivett v. Grimshaw* (1894), 11 R. P. C. 351. The cases *contra* are *Norton v. Nicholls* (1859), 28 L. J. Q. B. 225; *Hothersall v. Moore* (1892), 9 R. P. C. 27 (an important judgment of Bristowe, V.-C., in which all the cases are reviewed); and *Re Clarke’s Design* (1896), 13 R. P. C. 351.

(*p*) *Harrison v. Taylor* (1859), 29 L. J. Ex. 3.

test being the appeal to the eye (*q*). 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, expert eyesight (*r*).

In the case of *Birkin v. Pratt* (*s*), which was for infringement of registered designs for lace, after the first witness had been called for the plaintiff, the judge (Romfer, J.) suggested that two independent experts on each side should be called, and on plaintiff's counsel submitting that, in such a case, the question of infringement must depend on the trade and the judgment of experts, he said, "the judge will decide after hearing the experts."

In *Werner Motors v. Gamage's, Ltd.* (*t*), where the question of anticipation arose in respect of motor cycle frames, it was contended that expert evidence was only permissible in respect of matters requiring explanation from a scientific point of view, and that a witness could not be asked questions dealing with the functions of the machine, but Byrne, J., admitted the evidence and directed the expert to point out in the actual machine and also in the alleged infringement each of the parts shown in the registered drawings; and objection being raised to a further question whether the registered design had been applied to the motor cycle complained of, the judge suggested that the question should be whether the witness found all the parts represented in the design in the alleged infringement, and this was admitted as to shape and relative position, and the expert also gave evidence, without objection, that he saw no design referred to in the particulars of objections like the registered design in configuration and geometrical arrangement of parts one to another.

In *Re Bayer's Design* (*tt*), the judgment of the Court went on the question of subject-matter, and in dealing with this, Fletcher Moulton, L.J., said: "In the classic decision of

(*q*) This has been stated as a ground of decision over and over again, and reference may be made to the following authorities:—*Demartial v. Booth* (1892), 9 R. P. C. 499; *Tyler v. Sharpe* (1893), 11 R. P. C. 35; *Hecla Foundry Co. v. Walker* (1889), 14 A. C. 550; *Re Plackett's Design* (1892), 9 R. P. C. 436; *Moodie v. Tree* (1892), 9 R. P. C. 333; *Re Morton's Design* (1891), 17 R. P. C. 117; *Re Bayer's Design* (1906), 23 R. P. C. 553.

(*r*) *Cooper v. Symington* (1893), 10 R. P. C. 264; *Grafton v. Watson* (1884), 50 L. T. (N. S.) 420.

(*s*) (1895) 12 R. P. C. 371. For illustrations of the designs in this case, see Appendix F., Sheet 12, *post*, p. 434.

(*t*) (1903) 21 R. P. C. 141.

(*tt*) (1907) 24 R. P. C. 65.

Lord Hershell, in the *Hecla Foundry case*, he pointed out that ‘the eye is the judge of infringement,’ and if the eye is the judge of infringement, it must be because the eye is the competent judge of that which is infringed. I am satisfied, therefore, that nothing but that which can be matter for the eye to see can be a good subject of design.”

§ 46. If the design be old, its application to a new substance for a similar purpose to that for which the design was previously used, will not cause it to be a novelty. And if the design has already been registered in one class, it cannot generally be registered in another class as a novelty, even for an entirely different purpose.

(This is, however, subject to the two exceptions in favour of proprietors already on the register introduced by sect. 50 of the new Act, which declares that a registration in a new class or classes by such a proprietor of a design already registered in one or more other classes, shall not be invalidated by reason only that it was so previously registered or by reason only of its having been published by being applied to goods of any such other class.)

In *Re Bach's Design (u)* 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 (*x*).

In *Re Read & Greswell's Design (y)* 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

(u) (1889) 6 R. P. C. 376.

(x) And see *Mulloney v. Stevens* (1864), 10 L. T. (N. S.) 190.

(y) (1889) 6 R. P. C. 471. And see *In re Clarke's Design* (1896), 13 R. P. C. 351.

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. 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."

§ 47. But these cases must be distinguished from cases where the design is not simply copied in a different material, but is applied, with other materials, to a different purpose, making of the whole a new article. For in such cases the registration of the design will not be invalidated by reason of its previous use.

In *Walker v. Falkirk Iron Co.* (z) 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* (zz) 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.

So in *Varley v. Keighley Iron Works* (a), the plaintiffs, as owners of a registered design for a pressure bar for wringing and mangling machines, brought an action for infringement, which the defendants denied, alleging also that the plaintiffs' registered design was not good subject-matter for registration, and was anticipated by various prior publications. Judgment was given for the plaintiffs, Mathew, J., holding that although there was nothing novel about the mode in which the pressure was applied, which was the same in all the machines, the plaintiffs' "pattern" was novel, and had been exactly copied by the defendants, and he awarded a penalty of 50%.

(z) (1887) 4 R. P. C. 390.

(zz) (1889) 6 R. P. C. 376.

(a) (1897) 14 R. P. C. 169. For illustration of the design in this case, see Appendix F., Sheet 8, *post*, p. 430.

CHAPTER IV.

PUBLICATION.

(The full references to all Reports will be found in the Table of Cases ante.)

- § 48. Different Modes of Publication.
- § 49. Prior User. Exception in favour of Registered Proprietors.
- § 50. Exhibition for sale (*Re Sherwood's Design* ; *Harper v. Wright and Butler*).
- § 51. User sufficient to acquaint Public (*Carpenter v. Smith* ; *Stead v. Williams*).
- § 52. Experimental User.
- § 53. Manufacture in Workshop (*Humpherson v. Syer*).
- § 54. Modifications introduced by Act of 1907.
- § 55. Analogy of Copyright Cases (*Prince Albert v. Strange*, etc.).
- § 56. Analogy with Works of Sculpture.
- § 57. Summary of Copyright Authorities.
- § 58. Publication in Books and Documents.
- § 59. Differences from Publication by User—Romilly, M.R., in *Lang v. Gisborne* ; Jessel, M.R., in *Plimpton v. Malcolmson*.
- § 60. Sufficiency of Matter Published (*Philpott v. Hanbury*).
- § 61. Publication to Individuals (*Blank v. Footman*)—Commercial dealing with Design (*Heinrichs v. Bustendorff*)—Provisions of the new Act.
- § 62. Publication out of the United Kingdom.
- § 63. Registration not Publication ?
- § 64. Publication at Public Exhibitions.
- § 65. Notification required to secure Exemption.

§ 48. The second condition necessary to qualify a design for registration is that it shall not have been previously published in the United Kingdom (a). Publication for this purpose may have been either (a) by prior user, (b) in books or documents, (c) by communication to third persons, or (d) at public exhibitions.

§ 49. 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,

(a) Act of 1907, sect. 49 (1).

but user in public (*b*); and it means a user other than a mere experimental user.

The decisions upon this branch of the subject are to be found largely in cases dealing with patent disputes, but the principles laid down in these cases apply generally *mutatis mutandis* to designs. Where, however, 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 public user will be found generally to disqualify for registration. The analogy of art copyright is perhaps a little nearer to copyright in designs, and the authorities on that subject will afford assistance in dealing with the questions of what constitutes "publication."

The exception introduced by sect. 50 (b) of the new Act in favour of proprietors of designs registered in one class, enabling them to effect registration of the same design in another class or classes subsequently without being prejudiced by the first registration or application of the design thereunder, is of general importance in considering questions arising under the head of "prior publication."

§ 50. The general rule that prior user by exhibition for sale of goods bearing a design which is subsequently registered will invalidate such subsequent registration is illustrated in the following cases:—

Smout v. Slaymaker (c). On 26th April, 1887, the plaintiff registered a design being a pattern of a fire-screen, made of palm leaves, to hold a flower-pot; the design consisted of

(*b*) See, e.g., *Croysdale v. Fischer* (1884), 1 R. P. C. 17; *Gill v. Coutts* (1896), 13 R. P. C. 137; and *Betts v. Neilson* (1871), 3 Ch. 429; 5 H. L. 1.

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

three palm leaves tied together in the form of the acc of clubs. It was proved that fire-screens identical with the plaintiff'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.

Re Sherwood's Design (c). 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 the 17th November in his shop window; the globes had slip fittings. On the 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 the substitution of the flange for the slip fittings was not sufficient to constitute a new or original design, and that the publication before the 20th November was fatal to the registration on that date.

Harper v. Wright and Butler (d). The plaintiffs were the registered proprietors of two designs for stoves, one registered on the 25th April, 1891, and the other registered on the 20th June, 1892. The designs registered in each case represented upright hexagonal stoves, decorated with a cathedral window; the second being a modification in some details of the first and having an enlarged base. The defendants contended *inter alia* that the second design was, previously to registration, published by the registration of the first design and by the sale of stoves made according to that design, but the Court of Appeal held that the differences between the two designs were sufficient to constitute a new and original design and that the defence of prior publication failed. Lord Herschell, in giving judgment, said: "It is not a design identical with the design already registered. No doubt it is largely founded upon it. That is stated. It professes to be largely founded upon it, but you may have a new design, though the design is founded upon one which you have previously registered. Nothing has been produced which to my mind shows that there was such a common knowledge before the date of the second registration as to prevent that design, then registered, being a new and original design."

§ 51. 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 publicly 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.

(c) (1892) 9 R. P. C. 268.

(d) (1895) 12 R. P. C. 483.

On the analogy of the patent cases, whether the public have actually seen the invention or design or not seems unimportant; the point is, was it so used that it might have been publicly seen?

In *Carpenter v. Smith* (e), a patent had been taken out for a new lock; a similar lock had been used on a 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 was a public use and exercise of the invention sufficient to avoid registration of the alleged new lock.

This decision was adopted and followed in the more recent Scotch case of *Gill v. Coutts* (f), where the plaintiff, a paint manufacturer, obtained in 1891 a patent for a paint in which collodion was used combined with a metallic powder to form a lacquer for gilding purposes, and the Sheriff-substitute found it proved that prior to this a third person had used the combination as a paint and lacquer, but only for his own purposes, and held on this that it did not amount to a public user. But on appeal to the Court of Session his decision was reversed, the Court holding, in accordance with the English authorities, that "public use" means "a use in public and not by the public," and that the use made of the paint was of this character; so that the patent was void.

Stead v. Williams (g) further illustrates the rule 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. Cresswell, J., in directing the jury, 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 ocular inspection could make them cognisant. 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 it 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

(e) (1841) 11 L. J. Ex. 213.

(f) (1896) 13 R. P. C. 125.

(g) (1843) 2 W. P. C. 126, 136. See *Re Taylor's Patent* (1896), 13 R. P. C. 150, to the same effect.

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.”

In *Re Adamson's Patent* (*h*), 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.

The Lifeboat Co., Ltd. v. Chambers Bros. & Co. (*i*). 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.

In *Brereton v. Jackson* (*k*), 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.

§ 52. Use of an invention invalidates a subsequent patent, though the original user has been abandoned (*l*), and this applies equally to a design. On the other hand, experimental user, though made in the presence of others than the inventor, and though continued up to the date of the patent (or registration), does not ordinarily amount to publication (*m*). But the coincidence of experiment with actual immediate profit will ordinarily make the experimental user a publication (*n*).

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

(*i*) (1891) 8 R. P. C. 418.

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

(*l*) *Household Co. v. Neilson* (1843), 1 W. P. C. 700, 709; *Huggenbracher v. Watson* (1897), 14 R. P. C. 349, 621.

(*m*) See *Cornish v. Keene* (1835), 1 W. P. C. 508; *Jones v. Pearce*, 1 W. P. C. 122; *Household Co. v. Neilson*, *supra*; *Electric Plating Co. v. Holland* (1901), 18 R. P. C. 521; *Adamson's Patent* (1856), 25 L. J. Ch. 456.

(*n*) *Newall v. Elliott* (1858), 27 L. J. C. P. 337.

§ 53. 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.

In *Bentley v. Fleming* (o), 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* (p), 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* (q), where the contrary was held, 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* (r), S., the patentee of an improved water-waste preventer, alleged infringement by the defendant, who pleaded anticipation, and alleged that some weeks before the date of the plaintiff's patent he (the plaintiff) had had a model of a waste preventer, similar to that in question, made by a person in his employ, and handed it to one Widmer, who was a tradesman making water-waste preventers, with instructions to make for him a thing to prevent the waste of water, in accordance with that model. 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 could 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. The patent was declared invalid, and in giving judgment 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

(o) 1 C. & K. 587; *Germ Milling Co. v. Robinson* (1886), 3 R. P. C. 254.

(p) (1893) 10 R. P. C. 181.

(q) (1836) 1 W. P. C. 170.

(r) (1887) 4 R. P. C. 407.

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." Fry, L.J., after finding on the evidence that Widmer made the machine without any obligation to secrecy, said: "But supposing that I am wrong in that, and supposing 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 was 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, if the public have become possessed of the invention by any means whatever, no such patent can be taken out."

§ 54. The effect of the above decisions is largely modified, as regards designs, by the provisions of the new Act of 1907, s. 55, which declares that "the disclosure of a design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration is obtained subsequently to the disclosure."

§ 55. The leading copyright cases (*t*) are of importance in connection with the general question of what amounts to a publication as well as on the nature of authors' right before publication; and it is submitted that the principles laid down in them apply to copyright in designs equally with other branches of copyright property. They amount

(*t*) For a full discussion of the right before publication, see Scrutton on Copyright (Edit. 1903), p. 161 *et seq.* And see the considered judgment of Swinfen Eady, J., in *Mansell v. The Valley Printing Co.*, reported in the Times Law Report, 7th Feb., 1908, in which all the authorities were reviewed.

to this, that the author has a right, apart from statute, to prevent publication of his work; that an unlicensed use by a third person is no publication by the author; and that where the right arises (or is lost) on the first publication, the *terminus à quo* from which the statutory protection runs (or on which it fails) is “the moment the eye of the public is *allowed*, by the author, to rest on it.”

In *Prince Albert v. Strange* (u), the plaintiff was the late Prince Consort, and it appeared that he and her late Majesty Queen Victoria had occasionally for their amusement made drawings and etchings, being principally of subjects of private and domestic interest to themselves, and that they had made impressions of those etchings for their own use and not for publication; that, for greater privacy, such impressions had been, for the most part, made by means of a private press kept for that purpose, and the plates themselves had been ordinarily kept by her Majesty under lock, and the impressions had been placed in some of the private apartments at Windsor, and in such apartments only; that the defendants had in some manner obtained some of such impressions, which had been surreptitiously taken from some of the plates, and had thereby been enabled to form a gallery or collection of such etchings, of which they intended to make a public exhibition without the permission of her Majesty or the plaintiff, and against their will. It was held that there had been no publication of the plaintiff's works, and an injunction was granted to restrain the acts complained of by Knight Bruce, V.-C., whose decision was subsequently confirmed on appeal. The Vice-Chancellor, in the course of his judgment, said:—
 “The author of manuscripts, whether he is famous or obscure, high or low, has a right to say of them, whether light or heavy, saleable or unsaleable, that they shall not, without his consent, be published; and, I think, to use a dishonest knowledge of them for the purpose of composing and publishing, and so to compose and publish a catalogue of them, amounts to a publication of them within the principle of the rule. Assuming the law to be so, what is its foundation in this respect? It has not reference to any considerations peculiarly literary. Those with whom our common law originated had not, probably, among their many merits, that of being patrons of letters, but they knew the duty and necessity of protecting property, and with that general object

(u) (1849) 18 L. J. (N. S.) Ch. 120.

laid down rules providently expansive—rules capable of adapting themselves to the various forms and modes of property that peace or cultivation might discover or introduce.

“Such being, as I believe, the nature and foundation of the common law as to manuscripts, independently of Parliamentary additions and subtractions, its operation cannot, of necessity, be confined to literary subjects; that would be to limit the rule by the example. Wherever the produce of labour is liable to invasion in an analogous manner, there must be, I suppose, a title to analogous protection or redress. Such I consider the case of mechanical works or works of art executed by a man for his private use; whatever protection those, or some of those, may have by the Act of Parliament, they are not, I apprehend, deserted by the common law. The principles and rules which it applies to literary compositions and manuscripts must, to a considerable extent, be applicable to these also.”

In *Jeffreys v. Boosey* (*v*) (a music case), the question of the continuance after publication of the common law right arose, and some of the judgments are of special value in this connection, because of the analogy drawn between the law as to inventions and copyrights. In particular Lord St. Leonards said:—

“I never could, in my own mind, distinguish between the right to an invention after the publication of that invention and the right to the description of that invention after the publication of that description. If a mechanical genius should invent a machine of the greatest importance to mankind, it is admitted—nobody attempts to insist or to argue otherwise, and it has always been considered as settled—that after he has disposed of even a single copy of it, it may, so far as the common law is concerned, be copied and made use of without restriction by the purchaser, or by any person who properly obtains possession of it. Now, I do not see how you are to estimate differently different kinds of genius, or how you can say that a man who invents a machine of the greatest importance to the State shall not have any right the moment he disposes of a single copy of that article, but that a man whose mind brings forth a certain collection of words shall be entitled to an absolute property in it for all time, even after he has published it and let the world at large have it. It appears to me, therefore, and always has so appeared, that there is no such common law right either in the one case or in the other; . . . The common law does give a man who has composed a work a right to that composition, just as he has a right to any other part of his personal property; but the

question of the right of excluding all the world from copying, and of himself claiming the exclusive right of for ever copying his own composition, *after he has published it to the world*, is a totally different thing." Erle, J., dealt with the general question of authors' rights before publication in the following terms:—"The nature of the right of an author in his works is analogous to the rights of ownership in any other personal property, and is far more extensive than the control of copying after publication in print, which is the limited meaning of copyright in its common acceptation, and which is the right of an author, to which the statute of Anne relates. Thus, if after composition the author chooses to keep his writings private, he has the remedies for wrongful abstraction of copies analogous to those of an owner of personality in the like case. He may prevent publication; he may require back the copies wrongfully made; he may sue for damages if any are sustained; also if the wrongful copies were published abroad, and the books were imported for sale without knowledge of the wrong, still the author's right to his composition would be recognized against the importer and such sale would be stopped."

So in *Turner v. Robinson* (x) it was held that the exhibition of a picture at an exhibition where the taking of copies was forbidden did not amount to a publication; but in giving judgment the Lord Chancellor distinguished between such works and sculptures as to which the statutory copyright runs (y) from the "first putting forth or publishing the same," adding: "In the statutes bestowing protection upon works of sculpture, the *terminus a quo*, from which the protection commences, is the publication of the work, that is, from the moment the eye of the public is allowed to rest upon it. Many large works in this branch of art which decorate public squares and other places are of course so published, but there are others not designed for such purposes which could never be published in any other way than in exhibitions; therefore I apprehend that these works of sculpture must be considered as published by exhibition at such places as the Royal Academy and Manchester, so as to entitle them to the protection of the statutes from the date of publication."

§ 56. The analogy of designs with works of sculpture is particularly close, and it will be remembered that until the Act of 1883 sculptures might, at the option of

(x) (1860) 10 Ir. Ch. 374.

(y) 54 Geo. III. c. 14.

the proprietor, be registered under, and so secure the protection of, the Designs Act. There are similar provisions in the statutes affecting both classes of works as to marking before the putting forth or publishing, and the above-quoted dictum of the Lord Chancellor in *Turner v. Robinson*, as to what constitutes publication of sculptured works, found an application quite recently which may, in similar circumstances, be extended to designs cases.

In *Britain v. Hanks* (z) the plaintiffs claimed as proprietors of original metal models of horses and soldiers used for toy purposes which, for the purposes of the Sculpture Copyright Act, 1814, had been stamped with the name of one of the proprietors and a date, which it transpired was a few days before the day when the articles were actually put in the plaintiffs' show-room for sale. It was held, however, that the protection of the Act attached on the date of stamping for the purpose of publication, and that the effect of the section (a) which required the date to be put on the protected article "before the same shall be put forth or published," was that the date must not be misleading.

So in *Dalgleish v. Jarvie* (b) under the old Designs Act (5 & 6 Vict. c. 100), s. 4, it was considered doubtful whether the condition that the design should be registered before publication thereof was limited to publication of the design after its application to some article of manufacture, or whether the nine months' protection given by the Act dated from the publication of the design itself.

§ 57. The general result of the authorities on this question is summarised in Copinger's Law of Copyright (c) in the following terms: "The question of publication does not depend on the number of copies sold or given away, because the sale of one copy only is as clearly a publication as is the sale of ten thousand. Nor can it be essential that a single copy be disposed of before the work can be said to be published, for the work is

(z) (1902) 86 L. T. 765.

(a) 54 Geo. III. c. 56, s. 1.

(b) (1850) 20 L. J. Ch. 475.

(c) 4th ed. (1904), pp. 88, 89.

published when it is publicly offered for sale. The act of publication is the act of the author, and cannot be dependant upon the act of a purchaser. Printing does not amount to publication, for it is obvious that it may be withheld from the public long after it is in print. To constitute publication it is necessary that the work shall be exposed for sale or offered gratuitously to the general public, so that any person may have an opportunity of enjoying that for which copyright is intended to be secured.”

To this has to be added the fact that in *White v. Geroch (d)*, the Chief Justice (Abbott) declared that a sale of copies of a work in manuscript (that is, before any copies were offered to the public generally) amounted to a publication of the work, and it will be seen that the analogy with Designs Copyright is at least close if not complete.

§ 58. Whilst a design may be unfit for registration because it has been previously used, it does not follow that every original design can be registered merely because there has never yet been any public user. Publication in the United Kingdom, without user, is, as a general rule, sufficient to make it impossible that the design should afterwards be validly registered. In the analogous case of patents this has been held so on the construction of the statute (e); and with regard to designs, it is expressly provided by the words “not previously published” in sect. 49, sub-sect. (1), of the Act.

§ 59. Publication by prior user differs from publication in books, documents, etc., in that in the former case, user in public alone is publication; in the latter, the publication must not only be such that the public

(d) (1819) 2 B. & Ald. 298.

(e) *Patterson v. Gas Light and Coke Co.* (1875), 47 L. J. Ch. 402.

(*i.e.*, a sufficient portion of the public (*e*)) may acquire the knowledge, but such that the design actually becomes part of the public knowledge (*f*).

In the ordinary case of a description in a book published in England, it will be assumed that it comes to the public knowledge (*g*). Publication in a book, then, will be sufficient without further evidence to invalidate the registration of a design, but only where the description of the design has been in an English book open to the world (*h*).

In *Stead v. Williams* (*i*), Tindal, C.J., said: "The publication, if it takes place in England, 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 evidence, there has been such a publication as to make the description a part of the public stock of information."

In *Lung v. Gisborne* (*k*) 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

(*e*) See the cases of *Plimpton v. Spiller* (1877), 47 L. J. Ch. 212; and *Plimpton v. Malcolmson* (1875), 44 L. J. Ch. 257, *infra*.

(*f*) Per Pollock, B., in *Croysdale v. Fisher*, 1 R. P. C. 17. And see *Plimpton v. Malcolmson*.

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

(*h*) *Cornish v. Keene* (1835), 6 L. J. C. P. 225.

(*i*) (1843) 2 W. P. C. 126; and see *Stead v. Anderson* (1846), 2 W. P. C. 147.

(*k*) (1862) 31 L. J. Ch. 769.

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 (l). 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, 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."

In *Plimpton v. Malcolmson* (m), a book was deposited in the Patent Office Library on 20th 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* (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." Referring to *Lang v. Gisborne* (o), he said: "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

(l) *Sed query*. See observations of Jessel, M.R., in *Plimpton v. Malcolmson*, *infra*, and of James and Brett, L.JJ., in *Plimpton v. Spiller*, *infra*.

(m) (1876) 44 L. J. Ch. 257.

(n) 1 W. P. C. 673, 718 (n.).

(o) 31 L. J. Ch. 769.

salo, 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 shown 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."

Plimpton v. Spiller (p). The facts in this case were similar to those in the last-named; but in addition it was shown 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 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., said: "I cannot agree with Mr. Davey when he says that it is sufficient to show 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 show 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 show that it was known to the public.”

Otto v. Steel (q). 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, 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 (r).

Harris v. Rothwell (s). 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: “Why should the public be precluded from the right of using the information of which they were then in possession? I think directly the German specifications were deposited in the library of the Patent Office, and became unreservedly accessible to the public, there was a complete publication of the invention in this country, and it became the property of the public. In my opinion the depositing the specifications in the library of the Patent Office in the way described was

(q) (1885-6) 3 R. P. C. 109. And see *Pickard v. Prescott* (1892), 9 R. P. C. 195.

(r) And see *Heurteloupe's Patent* (1836), 1 W. P. C. 553.

(s) (1887) 4 R. P. C. 225.

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.”

In the *United Telephone Co. v. Harrison* (t), 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.

The cases are difficult to reconcile, if the question be regarded as one of law. The true rule seems to be that in each case the question is one of fact; *i.e.*, in the words of Tindal, C.J., in the case first cited (u), “whether, upon the whole evidence, there has been such a publication as to make the description a part of the public stock of information.” The *Plimpton Cases* and *Otto v. Steel* do not really conflict with *Lang v. Gisborne* or with *Harris v. Rothwell*. In the 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 and could have been. All that has to be determined is, whether the public had already the means of getting the information professed to be given for the first time by the claimant. This is really a question to be answered by the jury in each case (x).

§ 60. The prior publication of the description of a design will therefore, on the analogy of these cases, be a bar to any subsequent registration, if it substantially gave the information to the public necessary to constitute

(t) (1882) 51 L. J. Ch. 705.

(u) *Steud v. Williams*, ante, p. 58.

(x) See 1 W. P. C. 719 (n.).

the design. It is not necessary that the publication should be such as to guide any 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 (*y*). On the other hand, a mere barren suggestion in a book will not prevent registration of a practical application of the idea.

In *Philpott v. Hanbury* (*z*), Grove, J., said: "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."

§ 61. 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 show that there is a publication whenever it is the fair conclusion from the evidence that some member or members of the general public in England, under no obligation to secrecy, arising from confidence or good faith towards the owner of the design, knew of it before any application was made for registration (*a*). If, however, the

(*y*) See remarks of Jessel, M.R., in *Plimpton v. Malcolmson*, 44 L. J. Ch. 257.

(*z*) (1885) 2 R. P. C. 33, 43; *Thompson v. Macdonald* (1890), 8 R. P. C. 5. But see *Hills v. Evans*, 31 L. J. Ch. 457.

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

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. According to Fry, J., if such a person broke the confidence reposed in him the validity of the registration might be impeached (*b*); but any doubt on this point has now been removed by the new Act of 1907, which provides that the disclosure of a design in breach of good faith shall not invalidate the copyright (*c*).

In every case the fact of dealing commercially with a design amounts to a publication vitiating any subsequent registration; and this applies wherever the substance of the design has been published, notwithstanding alterations in details, unless these are of a material character (*d*). To this rule, however, a further exception has been introduced by a clause in sect. 55 of the new Act, which exempts *textile fabrics* from its general operation in the following words: “the acceptance of a first and confidential order for goods bearing a new or original textile design shall not be deemed to be a publication of the design sufficient to invalidate the copyright, if registration is obtained subsequently to the acceptance.”

The general rule is exemplified in the following cases:—

In *Blank v. Footman* (*e*), the plaintiff, who was a foreign manufacturer, having invented a design, showed it to and consulted Hummel, his sole agent in England, and the agent consulted another person, and also showed it to two customers and asked them for orders. Kekewich, J., decided that the communication to the agent would not have affected subse-

(*b*) In *Humpherson v. Syer*, at p. 416.

(*c*) 7 Edw. VII. c. 29, s. 55.

(*d*) *Winfield v. Snow*, *infra*, and *Hunt v. Stevens*, W. N. (1878) p. 79. See also *Oxley v. Holden* (1860), 30 L. J. C. P. 68.

(*e*) (1888) 5 R. P. C. 653.

quent registration, but that a registration subsequent to the date when the design was shown to the customers was invalid. On the former point, after quoting Bowen, L.J. (in *Mun- pherson v. Syer*), he said: "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."

In *Winfield & Son v. Snow Brothers* (*f*), it appeared that Major, a buyer for Messrs. Olney & Sons, suggested to plaintiffs to produce lace of a certain pattern, and the plaintiffs had a design prepared, from which they manufactured a sample, and showed 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 plaintiffs 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

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

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."

In *Re Sherwood's Design* (g), the owners of an unregistered design for a globe for a lamp stove sold two of the globes to a customer, who exhibited them in his window and afterwards adapted the same globe to improved fittings which added stability to the design, and this altered design was duly registered. Chitty, J., held that there had been a publication of the material part of the design, and that, the alterations not being of a substantial character, the registration was invalid.

In *Heinrichs v. Bastendorff* (h), 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.

In *Nevill v. Bennett* (i), the defendants alleged publication prior to registration in the following circumstances: In 1894 Foliadi (a dealer in Constantinople) sent a design to the plaintiffs as suitable for the Persian market. They submitted it to their designer, who put it into a suitable working form. Then, that being submitted to Foliadi, he approved it, and thereupon the plaintiffs gave it to their engraver, and that became the design which was ultimately registered. On this, when registered, Foliadi gave orders which the plaintiffs executed.

Hall, V.-C., upheld the registration, and in giving judgment, said: "In this case, where everything was private and there was mere collaboration between Foliadi and the plaintiffs, with a view to the design being put into a suitable and workable shape, which was to be the property of the plaintiffs, but to be engaged, as was said, for the use of Foliadi in the Persian market—to say that that private consultation, that private working together, amounted to prior publication seems to me to be entirely unfounded."

In *Werner Motors v. Gamage's, Ltd.* (j), a novel question of prior publication arose from the fact that the plaintiffs had before the registration of the design, which was for a motorcycle frame, applied for a patent for the same article, but the

(g) (1892) 9 R. P. C. 268. But see *Harper v. Wright and Butler* (per Herschell, L.C.) (1895), 12 R. P. C. 483.

(h) (1893) 10 R. P. C. 160.

(i) (1898) 15 R. P. C. 412.

(j) (1903) 21 R. P. C. 137, and, on appeal, 637.

registration was uphold, Vaughan Williams, L.J., in giving judgment, saying: "It is suggested in this case that the grant of the letters patent, having regard to the date of application, and therefore of the sealing, prevents the design being new and original within the meaning of sect. 47 of the Act of 1883. In the case of a stranger to the letters patent, this clearly would not be the result. Can it be the result in the case of a patentee who registers the design between the date of the provisional specification, without drawings, and a complete specification with a drawing identical with the design? I think not, unless one can say that the patentee is in some way estopped from asserting the truth that the design at the date of the application to register was new, because he subsequently obtained letters patent having a statutory date prior to that of the application to register the design. I have some doubt on this point, but on the whole I regret to say I cannot find an estoppel or any ground for putting the plaintiffs to an election between the letters patent and the copyright of the design."

§ 62. The publication of a design invalidates a subsequent registration only if the publication take place in the United Kingdom. This is an express provision of the Act which, in connection with designs, uses the words "not previously published *in the United Kingdom*" (*k*); but the same rule has always been applied to patents on the construction of the statutes (*l*). Publication abroad does not, therefore, necessarily invalidate a subsequent registration here if the work is still novel or original to the British public.

§ 63. Does registration amount to publication? The question was raised in *Read and Greswell's Design* (*m*), but it became unnecessary to decide the point, and it was not decided. There is much to be said for the argument that registration, so far as designs are concerned, is not publication; until, at all events, the entry is thrown open to the public. The register in the case of trade marks

(*k*) (1907) Sect. 49 (1).

(*l*) See the patent cases, *Brown v. Annandale* (1842), 1 W. P. C. 433; *Rolls v. Isaacs* (1878), 51 L. J. Ch. 170; and *Lazarus v. Charles* (1873), 16 Eq. 117.

(*m*) (1889) 6 R. P. C. 471.

is always open; there is no such provision in the case of registered designs, which on the contrary are kept secret during the whole term of copyright or for such shorter period (not being less than two years) as may be prescribed by the general rules in each case (*n*), and registration of marks is expressly declared to be publication. From this it may be inferred that the law is different in the case of designs and of trade marks, and hence that registration of the former is not, *ipso facto*, publication.

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(*o*), but this is only under limited conditions and for a special purpose, and it is submitted that in such cases the principles as to secrecy and confidence above considered would apply. It may be doubted therefore whether, if such a person does so see the design, there has been any such publication as would avoid a subsequent registration of a similar design.

The provisions of sect. 50 of the new Act exempting subsequent registration of a design by a proprietor who has already registered the design in another class, and declaring that no invalidity shall arise on the ground of such prior registration, are also to be borne in mind on this question.

§ 64 Publication at an industrial or international exhibition is provided for by sect. 59 (1) of the new Act (as it was 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

(*n*) Act of 1907, s. 56 (1). The Rules of 1908 fix the period at five years for designs in Classes 13, 14 and 15, and two years for all other designs. (Rule 69.)

(*o*) *Ibid.*

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—

- (a) “The exhibitor, before exhibiting the design or article, or publishing a description of the design, gives the comptroller the prescribed notice of his intention to do so; and
- (b) “The application for registration is made before or within six months from the date of the opening of the exhibition.”

And sub-sect. (2) of the same section provides for the extension of this protection to industrial and international exhibitions held out of the United Kingdom, by Order in Council, under the Act, exhibitors at such foreign exhibitions being thereupon relieved from the conditions, specified in the section, of giving notice to the Comptroller of intention to exhibit.

§ 65. In order to have an exhibition certified under this section application must be made by the authorities controlling the exhibition or by some person interested, to the Board of Trade, and evidence produced to satisfy the Board that the exhibition is of sufficient importance, and, generally, a proper subject for the certificate. Upon being so satisfied a certificate is issued. The Board of Trade communicates the issue of the certificate to the Patent Office, where a list of such certified exhibitions is kept.

The Designs Rules provide that a notice of intention to exhibit any design or article to which a design has been applied at an international exhibition certified

under these Acts shall be given by the intending exhibitor to the Comptroller, and for the purpose of identifying the design in the event of an application to register being subsequently made the applicant is to furnish the Comptroller with a brief description of the nature of the design, accompanied by a sketch or drawing (*p*).

(*p*) Rules of 1908 (No. 76).

CHAPTER V.

THE PRACTICE OF REGISTRATION.

(For the full references to all the Reports see Table of Cases ante.)

- § 66. Copyright before and after Publication—Statutory Provisions.
- § 67. The Application for Registration—Regulations as to Time.
- § 68. Application in Person or by Agent.
- § 69. Description of the Design—Specification of Class.
- § 70. Registration by Sample.
- § 71. Filing of Representations—Effect of Explanatory Notes.
- § 72. Sufficiency of Claim or Description—Illustrative Cases: *Norton v. Nicholls*; *Holdsworth v. McCrea*; *Barran v. Lomas*; *Re Rollason's Design*; *Re Bayer's Design*.
- § 73. Deposit of Copies or Drawings.
- § 74. Effect of Non-deposit—Abandonment of Registration.
- § 75. Sale of Articles to which Designs applied—Submission of Samples.
- § 76. Classes—Distinction between Classes 13 and 14.
- § 77. Registration of Sets of Designs.
- § 78. Power of Comptroller to decide Class.
- § 79. Protection limited to Class registered (*Re Read and Greswell's Design*).
- § 80. Subsequent Registration by Third Person in another Class (*Re Bach's Design*; *Re Clarke's Design*).
- § 81. Powers of Comptroller to refuse Registration.
- § 82. Procedure before Comptroller.
- § 83. Appeal to Board of Trade.
- § 84. Procedure on Appeal—Costs.
- § 85. Certificate of Registration—Copies where Original lost.
- § 86. Amendments, and Extension of time.
- § 87. Correction of Entries—Omission of particular Goods.
- § 88. Transmission of Copies of Entries to Scotland—Fees, &c.
- § 89. Special Provisions as to Designs for Goods in Classes 13, 14 and 15.

§ 66. On the analogy of other copyright property there may be said to be a copyright before publication in a design from the time of its invention or making (*a*), but registration of the design is necessary to give the protection of the statute to the proprietor. The matters

(*a*) See Copyright Cases, cited *supra*, pp. 53—55; and sect. 54 (1) (*a*) of the new Act corresponding with sect. 50 (2) of the Act of 1883.

to which attention must be directed with regard to registration are to be found in sects. 49 and 52 of the new Act and in the Designs Rules, whilst information as to the practical steps to be taken may be found in the pamphlet issued from the Comptroller's Office entitled "Instructions to Persons who wish to register Designs" (*b*).

§ 67. A person desiring to register a design must leave at or send to the Comptroller's Office (1) an application for registration in the prescribed form (*c*); (2) in such application a statement of the articles to which the design is to be applied, and the classes of goods in which the applicant desires that the design should be registered (*d*); (3) three (or in the case of a set or an application in Classes 13, 14, or 15, four) drawings, photographs, or tracings, or other representations of the design, or three (or four) specimens (*e*); (4) the prescribed fee, payable by impressed stamp on the form of application (*f*).

The documents must be left at or sent by post to the Comptroller's Office (*g*); or, in the case of goods in Classes 13, 14, or 15, either there or at the Manchester Branch Office (*gg*). If sent by post 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 (*h*). In proving such sending it will be sufficient to prove that the letter was properly addressed and put in the post (*i*).

(*b*) See *post*, Appendix C., p. 406.

(*c*) Rules of 1908, No. 13. For Forms, see Appendix B., *post*, p. 374.

(*d*) *Ibid.*, Nos. 17, 18.

(*e*) *Ibid.*, Nos. 20, 21.

(*f*) (1907) Sect. 65; and Rule 3, with Schedule I. (Nos. 1—5).

(*g*) (1907) Sect. 81; and Rules Nos. 2, 14.

(*gg*) Rule 80.

(*h*) Rule No. 9.

(*i*) This was formerly provided by the statute (Act of 1883, sect. 97 (2)), but it is now the accepted rule, and is part of the provisions of Rule 9.

Whenever the last day fixed by the Act, or by any Rule for the time being in force, for doing anything under the Act falls on any day specified in the Rules as an "excluded day" (*i.e.*, Christmas Day, Good Friday, the King's birthday, Saturdays and Sundays, days observed as holidays at the Bank of England, or days of public fast or thanksgiving, and other days which may from time to time be notified by a placard posted in a conspicuous place at the Comptroller's Office), it is lawful to do it on the day next following, not being an excluded day (*k*).

§ 68. Communications with regard to the application must be made to the Comptroller by the proprietor of the design or by some agent duly authorised by him, to the Comptroller's satisfaction (*l*). The Comptroller is not bound to recognise as such agent or to receive further communications from any person whose name has been removed from the register of agents kept under the Act (*m*). The application must be made in the forms prescribed, as set out in Schedule III. to the new Rules (*n*).

These forms contain certain marginal notes specifying the nature of the information to be given; and as the forms are an integral part of the Rules the notes have, like the Rules themselves, the force of statutory requirements (*o*).

The applicant must give his full name and address and an indication of his trade or business. He must sign the application either in person or by an authorised agent, but this may be dispensed with by the Comptroller, if he is satisfied that from any reasonable cause such person

(*k*) (1907) Sect. 82; and Rules Nos. 61, 65.

(*l*) Rule 12.

(*m*) Act of 1907, sect. 85; Rule No. 12.

(*n*) (1907) Sect. 49 (1); and Rule 14. For Forms, see Appendix B., pp. 373 *et seq.*

(*o*) *In re Rollason's Design* (1898), 15 R. P. C. 441.

is unable to sign; and the Comptroller may in such case, upon the production of other evidence, and subject to such terms as he may think fit, dispense with the document (*p*).

Registration dates from the day upon which the application for registration is received by the Comptroller (*q*); but any application which owing to any default or neglect on the part of the applicant is not completed so as to enable registration to be effected within twelve months from the date of the application will be deemed, under the new Act, to be abandoned (*r*). Fourteen days' notice of the non-completion is to be given by the Comptroller before the abandonment becomes effective (*rr*).

§ 69. The Act (*s*) provides that the application must be made in "the prescribed form and manner"; and by the statutory Rules (*t*) this is amplified by the requirement that it shall contain a statement of the article to which the design is to be applied, and of the class or classes of goods in which the applicant desires that the design should be registered. Where the Comptroller requires it, the applicant must also state for what purpose the design to be applied is used, and the material of which the article is made; and he must further, if required, indorse on the application a brief statement of the novelty he claims for his design (*u*). The description of purpose or novelty need not be elaborate as in the

(*p*) Rule 62. And see (1907) Sect. 83, which deals with declarations, &c., when the applicant is an infant, lunatic or under other disability.

(*q*) (1907) Sect. 49 (5).

(*r*) *Ibid.*, Sect. 49 (4).

(*rr*) Rule No. 35.

(*s*) (1907) Sect. 49 (1).

(*t*) Rules Nos. 17, 18.

(*u*) Rules 18, 19. The old Rules also required that the application should state whether the design was applicable "for the pattern, or for the shape, or for the configuration, or for any two or more of such purposes, as the case might be, and the means by which it was applicable"; but the new Rules and Forms do not require any such statement, and it is undesirable to volunteer it in any case. See *Re Bayer's Design* (1907), 24 R. P. C. 65.

case of specification of the patent (*v*), but it should state enough to enable the Comptroller to give such information as is required by sect. 57 of the Act, *i.e.*, to identify the design.

§ 70. 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 amending statute 21 & 22 Vict. c. 70, the registration of a pattern or portion of an article of manufacture to which a design was applied, instead or in lieu of a drawing or description in writing, was made valid. The Act of 1883 provided that an applicant might furnish exact representations or specimens of the design (*w*), and these might take the place of drawings or photographs, though not, it seems, of a written description. The provision as to representations or specimens is continued by the now Statutory Rules (*x*); but it is to be remembered that if the registration be by sample only, there can ordinarily be no infringement unless the whole design be reproduced (*xx*). In view of the terms of sect. 49 (1) of the Act of 1907 and of the provisions of Rule 4 and the prescribed forms, it is submitted that now no description in writing can be required, and the registration is valid if the application contains only the several particulars above specified.

§ 71. It is, however, to be noted that where representations other than the prescribed drawings are furnished, the only "design" put on the register will be the representation, though the application will be filed as well as the design, and may be called in evidence to explain it.

(*v*) *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380; *Harper v. Wright and Butler* (1895), 12 R. P. C. 483; *In re Rollason's Design* (1897), 14 R. P. C. 909; and *In re Bayer's Design* (1906), 23 R. P. C. 355.

(*w*) Act of 1883, sect. 48 (1).

(*x*) Rules of 1908, No. 20.

(*xx*) A written description of the parts claimed as novel may be added; but, unless some further statement is called for by the Comptroller, it is generally better to leave the design to speak for itself.—See note (*u*), *supra*.

The effect of any explanatory note accompanying the representation will be to limit the claim to what the applicant says is novel, but such a “quasi-disclaimer” is not a statutory obligation, nor provided for in the Act or Rules (*y*).

§ 72. The following cases may be referred to on the above points; but it is to be observed that, having regard to the altered requirements as to the statements to be furnished by applicants on registrations, many of the old decisions as to the effect of claims for “pattern, shape or configuration” will in future only apply to registrations already effected under the Act of 1883.

Norton v. Nicholls (*z*) (commenced 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 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 be considered an infringement of the supposed combination? Is the defendants’ shawl an infringement, although it

(*y*) See the statement of the Comptroller in *Re Bayer’s Design* (1906), 23 R. P. C. 553.

(*z*) (1859) 28 L. J. Q. B. 225.

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 sect. 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?"

Holdsworth v. McCrea (a) 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, the 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. In giving judgment, Lord Chelmsford said (b): "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 (c): "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

(a) (1867) L. R. 2 H. L. 380. The second proposition in this case was, it was thought, altered by sect. 47 (3) of the Act of 1883 and the Statutory Rules under it. The third proposition shows the desirability of making a written statement of what is claimed when registration is applied for by deposit of a sample or representation other than a drawing.

(b) Page 384.

(c) Page 388.

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." The meaning of these latter words was explained in the later case of *McCrea v. Holdsworth* (*d*) by Lord Hatherley, L.C., who 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."

In *Thom v. Sydall* (*e*) 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 registration is by sample, there can be no infringement unless the whole design be reproduced.

Barran v. Lomas (*f*) 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; but 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

(*d*) (1870) L. R. 6 Ch. 418, 420. See the new Rule, No. 19, as to requiring a statement of the novelty claimed.

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

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

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 (g).

In *Walker v. Falkirk Iron Co.* (h) it was laid down that no elaborate specification by the author of the design is either required or allowed, and that the *purpose* for which a design is registered may be proved by evidence (hh). Lord Shand, in giving judgment, said: "The statute (1883, sect. 47 (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 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."

In *Gordon and Munro v. Patrick* (i) the plaintiffs' claim in their application was for ornamental design; and this being admittedly old, though a similar moulding had never been applied to a coffin-plate of the same shape, the defendants contended that the plaintiffs could not succeed, not having claimed for the ornament in combination with the shape; but Cave, J., dismissed this contention, and granted the injunction as prayed and an order for delivery up of the infringing plates.

In *Harper v. Wright and Estler* (k), in the course of the argument, it was urged that the plaintiffs, by the form of their application, viz., that the design was applicable for the

(g) See *Smout v. Slaymaker* (1890), 7 R. P. C. 90.

(h) (1887) 4 R. P. C. 390, 395.

(hh) The new Rules provide for the statement of "purpose" in the application, where required by the Comptroller (Rule 18).

(i) (1894) 12 R. P. C. 22.

(k) (1895) 12 R. P. C. 483.

“pattern, ornamentation, shape and configuration,” must be taken to have claimed novelty or originality in each of these four particulars, and the registration was therefore bad if there was want of novelty or originality in any one of these respects; but Herschell, L.C., said: “Whether each one of these things was claimed *per se* or in combination only with the others was not material, as the whole was claimed, and there was no other way, under the rules, of claiming the whole than the manner in which the plaintiffs had claimed.” A. L. Smith, L.J., said, in giving judgment: “The next point which arises is this: they say to the plaintiffs, ‘Your claim is bad, because what you claim in your registration is for pattern, ornament, shape and configuration: you claim for each of those separately, and do not claim for those collectively’; and they went on to say that, as regards shape, that would be a bad claim, because they said a similar shape for a hexagonal stove, standing upright, was known before. But, in my opinion, whatever this claim may embrace, it does embrace these matters collectively—it claims for the design, and it claims, as part and parcel of that design, the pattern, ornament, shape and configuration. The word ‘totality’ has been used more than once during this case. I adopt that word. The design is claimed—that is, the pattern, ornamentation, shape and configuration—that is, the totality of it.”

In *Re Rollason's Design* (1), where the design (for coffin-plates) was registered “for the pattern,” although the registration was upheld, some difference of opinion was shown by the judges in the Court of Appeal as to the effect of this claim. Lindley, M.R., said: “With reference to the word ‘pattern,’ I cannot help thinking that, in a case of this kind, the pattern includes the shape and ornamentation. The word ‘ornamentation’ is dropped out of the rule, although it is in sect. 60 of the Act; but when you talk of the pattern of a thing like this, I do not see that it is necessary or even proper to leave out the outline. The ornamentation not being dropped out, of course it is not for shape alone. It is, to my mind, for shape, plus ornamentation, in a case like this.” Vaughan Williams, L.J., however, said: “I wish to make two propositions plain according to my view of the Act of Parliament. One of those propositions is, that the Act draws such a distinction between pattern and shape that when an applicant in his application chooses to base his application upon pattern, one must, in dealing with the question of originality or novelty, limit the right to registration to matters clearly falling within ‘pattern’ accord-

(1) (1897) 14 R. P. C. 909.

ing to the meaning of that word as used by the applicant in his application; and I wish further to say that, according to my view of the construction of this Act, if the result of the registered design, whether defined by paper, plan, or otherwise, is to leave it in ambiguity whether a particular matter is included in it or is not included in it, you ought to make the turn of the scale against the person registering, whose duty it is, according to my view, to make it perfectly clear what design it is in respect of which he seeks to become the proprietor to the exclusion of the general public."

In *Re Bayer's Design (m)*, on the trial before Warrington, J., some discussion arose as to the effect of the explanatory note attached by the claimants to their deposited drawing, and, in giving judgment, Warrington, J., said: "Something turns upon the mode in which the respondent has complied, or purported to comply, with one of these rules—I mean the 9th rule of the Designs Rules of 1890. . . . Now, it will be observed that, in that rule, there is nothing which requires the applicant to state what it is in the design that he is registering that he claims as novel; all that he is required to do is to state the particular quality of the subject to which the design is applicable, and the means by which it is so applicable. The next thing is, what is the object of that note 'The novelty consists in a corset having the gores or gussets out horizontally . . . as shown in the representation'? Obviously, the object of that note is to point out in a picture, the whole of which cannot be novel, that part which the applicant says is novel; in other words, to restrict that which, without the note, might be a wider claim than it is with the note." But on the hearing of the appeal, Fletcher Moulton, L.J., said on this: "The fair construction, as between the public and the owner of the registered design, of these words is that he claimed a corset with horizontal gores or gussets, and the reference to the representation is not by way of limitation but by way of illustration. His 'as shown in the representation' does not mean the particular length or breadth of the gores or gussets that you find there shown in that particular corset, but it means that he claims the method of making corsets with horizontal gores."

§ 73. The Act of 1883 provided (sect. 48) that in addition to the application there should 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

(m) (1906) 23 R. P. C. 552, and, on appeal (1907), 24 R. P. C. 65.

the design, but that instead of such copies the applicant might furnish exact representations or specimens of the design. These provisions are now incorporated in the new Statutory Rules which prescribe that every application for the registration of a design shall be accompanied by three exactly similar drawings, photographs, tracings or other representations of the design, or by three specimens; and where the design is for a set, or for goods in the Manchester Classes, an additional drawing or specimen is to be supplied (*mm*).

Further Rules provide (*inter alia*) “that all applications, notices, papers having representations affixed and other documents sent to the Comptroller shall be upon strong paper (on one side only), of the size of 13 inches by 8 inches, with a margin of two inches on the left-hand part (*n*); that when representations of designs are lodged they must be upon paper of the prescribed size and not on cardboard, the figures being placed in an upright position on the sheet (*nn*); that when drawings or tracings are furnished they must be in ink, and if upon tracing-cloth, mounted on paper of the prescribed size (*o*); that when the design is to be applied to a set, each of the representations should show all the various arrangements in which it is proposed to apply the design to the articles included in the set (*oo*); and that when specimens are lodged, if they are not of a kind which can be pasted into books, representations of the designs must be furnished for insertion in the Register (*p*).

Where the names or representations of living persons or of persons recently dead appear on the design, the Comptroller may require to be furnished with the consents of such persons or their legal representatives before proceeding to register the design (*q*).

(*mm*) Rules of 1908, Nos. 20, 21.

(*o*) Rule 23.

(*oo*) Rule 24.

(*n*) Rule 7.

(*p*) Rule 25.

(*nn*) Rule 22.

(*q*) Rule 30.

§ 74. If the three sets of drawings, &c. are not sent with the application, it does 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 the proper number of correct representations has been sent in substitution for the sketch. If these are not sent within the prescribed time, so as to enable the registration to be completed, the registration will be deemed to be abandoned (*r*). But the Comptroller has power to extend the time in a proper case (*s*).

§ 75. The Act further provides (*t*): “Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall (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 statutory copyright (with all its remedies) dates from the time the application, accompanied by a single sketch, is received by the Comptroller and it is provided by sect. 49 (5) that the registration is to be of that date.

The proprietor may not sell articles to which the design has been applied until the prescribed number of drawings or sketches have been supplied. But the only thing forbidden is the actual delivery on sale of the completed article, so that a person who has obtained a

(*r*) Instructions, § 9; Act of 1907, sect. 49 (4), and Rule 35.

(*s*) Rule No. 64.

(*t*) (1907) Sect. 54 (1) (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. He may also, it would seem, sell and assign his rights or give licenses.

The proprietor of a design, if he fails to comply with the requirements of this sub-section, does not lose his rights absolutely, but only if the matter is brought to the attention of the Comptroller *and he decides to erase the entry.*

As this is the exercise of a discretionary power, the Comptroller is bound to give the applicant a preliminary notice of his intention to erase, and by sect. 73 of the Act he must give the applicant an opportunity of being heard before exercising the power adversely.

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

In *Hotherhall v. Moore* the difference between Classes 13 and 14 under the old Rules was considered, and Bristowe, V.-C., said that he had come to the conclusion that there was a substantial difference between the two classes, 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 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” (*y*).

§ 77. The registration may be of single designs or may be of a set, *i.e.*, of any number of articles of the same

(*u*) (1907) Sect. 49 (2); Rule No. 17.

(*x*) Rule 6, and Sch. III. to the Rules. See *ante*, § 36.

(*y*) (1892) 9 R. P. C. 27, 38.

general character ordinarily on sale together or intended to be used together, all bearing the same design with or without modifications not sufficient to alter the character or not substantially affecting the identity thereof (z). This is irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article (zz).

§ 78. In any case of doubt as to the class in which a design ought to be registered, or as to the given articles constituting a set or not, the Comptroller may decide the question (a); but if the decision be adverse to the applicant, the Comptroller must, at the applicant's request, hear him (b). In case of doubt or difficulty, the Comptroller may apply to either of the law officers for directions in the matter (c); but on such a question there is no appeal from the Comptroller's decision to the Board of Trade (d).

§ 79. 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 (e); e.g., the registration of a design in Class 13 is not infringed if the alleged imitation is applied to goods in Class 14 (f). 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 (g). 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

(z) Rule No. 5.

(zz) See *In re Rollason's Design* (1897), 14 R. P. C. 909.

(a) (1907) Sect. 49 (2), and Rule 5.

(b) *Ibid.*, Sect. 73, and Rule 55.

(c) *Ibid.*, Sect. 74.

(d) *Ibid.*, Sect. 49 (3).

(e) *Ibid.*, Sect. 60 (1).

(f) *Hothersall v. Moore, supra.*

(g) (1907) Sect. 49 (2).

application by omitting any particular goods or classes of goods in connection with which he has desired the design to be registered (*h*).

In *Re Read & Greswell's Design (i)*, Chitty, J., said 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 (of the Act of 1883), 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." This decision must now be read in conjunction with the new provisions made by sect. 50 of the 1907 Act, by which a registered proprietor, in any one or more classes, may obtain registration of the design subsequently in some one or more other classes, and thus deprive any other persons of the "liberty to use the design for goods not included in the class or classes" for which the registration was originally effected.

§ 80. Though the protection does not extend beyond the particular class in which the design is registered, yet it is not open to a person to register a similar design for a like purpose 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 imitator cannot have registration allowed to him, as his design is not new and original.

In *Re Read & Greswell's Design (i)*, T. registered a design in Class 5 in Schedule III. to the old Rules, viz., "Articles composed wholly or partly of paper," 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

(*h*) (1907) Sect. 70 (a).

(*i*) (1889) 6 R. P. C. 471.

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, and that though T.'s copyright doubtless was limited to goods in Class 5, nevertheless R. & G. could not register the design in any other class. In the course of his judgment he 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 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*."

In *Re Bach's Design* (*j*), 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."

In *Re Clarke's Design* (*k*), the same principles were applied

(*j*) (1889) 6 R. P. C. 376.

(*k*) (1896) 13 R. P. C. 351, and see *ante*, Chap. III., "Novelty."

by the Court of Appeal to a design for a lamp for electric lighting registered as applicable for its shape, which consisted as to its lower part of a reflecting screen (old as applied to oil or gas lamps), and as to its upper part of a ventilating top, not identical with, but still not substantially differing in shape from, the ventilating top of an old lamp; and this was held not to have sufficient novelty to be entitled to registration as a whole, nor to be infringed by a lamp having a similarly shaped screen, but surmounted by a top differing from the registered design.

§ 81. 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; so when the registration of a trade-mark is asked for. This is not the case with designs; there is no provision for public advertisement or opposition (*m*).

The Comptroller considers the application, and may refuse to register any design presented to him for registration (*n*). There are no special directions given by the Acts as to the grounds upon which he must refuse to register, save that sect. 75 provides that he may refuse to register a design of which the use would, in his opinion, be contrary to law or morality; and the terms of sect. 56 (1) 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 the right of appeal provided by the Act. Of course the discretion must be judicially exercised, but assuming this is so, there is no restriction as to the grounds upon which the refusal may be based (*o*).

§ 82. Before exercising his discretionary power adversely to the applicant for registration, the Comptroller is bound to give the applicant who requires it an

(*m*) See the observations of Fletcher Moulton, L.J., in *Re Bayer's Design* (1907), 24 R. P. C. at p. 76.

(*n*) (1907) Sect. 49 (3), and Rule 31.

(*o*) See *Eno v. Dunn* (1890), 7 R. P. C. 311—a trade-mark case.

§§ 81—84. REFUSAL TO REGISTER AND APPEAL THEREON. 89

opportunity of being heard personally or by agent (*p*). A statement of the objection is sent to the applicant in writing (*q*); and the applicant has one month from the date of the Comptroller's objection within which he may apply for a hearing on these objections. The matter then proceeds as follows (*r*): (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 must 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.

§ 83. Any person aggrieved by the refusal of the Comptroller to register may appeal to the Board of Trade, and the Board of Trade will, 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 (*s*). By the 62nd section of the Act the Board of Trade has conferred upon it a general superintendence over the Comptroller, and he is bound to obey the Board's directions.

§ 84. The steps in the appeal procedure are these (*t*): (1) The applicant may, within one month from the date of the decision appealed against, require the Comptroller to state in writing the grounds of his decision and the materials used by him in arriving at the same; (2) within one month from the sending of this statement, or, if it is not applied for, then from the date of the decision the applicant must lodge notice of intention to appeal, stamped with a fee of 5*s.* in respect of each decision

(*p*) (1907) Sect. 73.

(*q*) Rule 32.

(*r*) Rules of 1908, Nos. 57, 58.

(*s*) (1907) Sect. 49 (3).

(*t*) Rules of 1908, Nos. 33, 34, and Nos. 89—94.

appealed against (*u*); (3) the notice must be accompanied by a copy of the form of application and six representations of the design applied for, a copy of the grounds of the Comptroller's decision (if applied for), a statement of the grounds of appeal, and of the applicant's case in support thereof; (4) a copy of the notice and of all the accompanying documents must also be sent by the applicant forthwith to the Secretary of the Board of Trade at Whitehall.

The Board of Trade may, upon receipt of the notice, 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 (*x*).

No appeal will be entertained of which notice is not given within the prescribed time, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

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.

§ 85. When it has been determined, either by the Comptroller or the Board of Trade on appeal, to register a design, the applicant is entitled to a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office (*y*). The registration dates from the day of application, but actual registration does not take place until the certificate is sealed (*z*).

(*u*) See Form 25, *post*, p. 386.

(*x*) Rules of 1908, No. 93.

(*y*) Act of 1907, sect. 51 (1). For form of Certificate, see Form D.O., No. 1, *post*, p. 377.

(*z*) Act of 1907, sect. 49 (5).

§ 85. CERTIFICATES—CORRECTIONS AND AMENDMENTS. 91

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. The fee for each copy is one shilling, and the application should be made in the form proscribed by the Rules (*a*).

§ 86. The Comptroller may allow any document or drawing or other representation of a design 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 (*b*). He may extend the time proscribed by the Rules for doing any act or taking any proceeding thereunder (*c*). Any such amendment or extension will be in the discretion of the Comptroller, and subject to such terms as he may think fit.

§ 87. The Comptroller may also, on request in writing, accompanied by the proscribed fee, (*a*) correct any clerical error in an application or in the representation of a design (*d*); or (*b*) any clerical error in the representation of a design or in the name or address of the registered proprietor of a design, or in any other matter which is entered in the register (*e*); or (*c*) permit a registered owner of a design to amend the registration by omitting any particular goods or classes of goods in connexion with which he has desired the design to be registered (*f*).

§ 88. Special provision for applications on behalf of persons under disability, *e.g.*, for infants or lunatics, is made by sect. 83 of the Act.

Power to prescribe fees on registration is given by

(*a*) (1907) Sect. 51 (2); and Form 27, *post*, p. 389.

(*b*) Rules of 1908, No. 63.

(*c*) Rule No. 64.

(*d*) Rule No. 51; Form No. 17, *post*, p. 382.

(*e*) (1907) Sect. 70 (*c*). See *In re Grocott's Design* (1899), 17 R. P. C. 139.

(*f*) (1907) Sect. 70 (*b*).

sect. 95 of the Act; 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.

Provisions are also made (sect. 80) for the transmission of certified copies of all specifications, drawings, and amendments left at the Comptroller's 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.

§ 89. The new Act also provides (*h*) for the establishment, by Rules under the Act, of branch offices for designs at Manchester and elsewhere, and for any document or thing required by the Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established; and the Rules of 1908 (*i*) have accordingly established such offices at Manchester (the office of the Keeper of Cotton Marks, 48, Royal Exchange), where applications for registration of designs in Classes 13, 14 and 15 may be lodged at the option of the applicant instead of at the Patent Office.

All applications for registration of designs in these three classes, and other documents relating to such designs must be in duplicate, one of the documents being stamped and the other unstamped. A separate register of all designs in these classes is to be kept at the Manchester office; and when any alteration or addition is made at the office of an entry in the register relating to such a design, the Comptroller must forthwith give notice to the Keeper, who will make a corresponding alteration in the Manchester Register.

(*h*) (1907) Sect. 62 (4).

(*i*) See Rules of 1908, Nos. 80—88.

CHAPTER VI.

THE REGISTER.

(The full references to all the Reports will be found in the Table of Cases ante.)

- § 90. Entry of Proprietorship.
- § 91. Provisions as to Equitable Interests.
- § 92. Original Registration.
- § 93. Entry of Transmission.
- § 94. Registration of Assignments and other Interests.
- § 95. Powers of Comptroller to dispense with Evidence.
- § 96. Necessity of Writings to prove Title?
- § 97. Death or Bankruptcy of Proprietor.
- § 98. Inspection of the Register.
- § 99. Rectification and Expunging of Entries.
- § 100. Grounds for Expunging.
- § 101. Rectification of Owners' Names—*Re Guiterman's Design—Re Grocott's Design.*
- § 102. Change of Name of Owners.
- § 103. Costs and Damages on Rectification.
- § 104. Improper Use or Conduct as affecting Registration.
- § 105. Persons entitled to apply for Rectification—*Re Powell's Trade-Mark—Apollinaris Case.*
- § 106. Summary of Authorities as to "Person aggrieved."
- § 107. Jurisdiction on Application for Rectification—Scotch and Irish Cases.
- § 108. Procedure on Applications for Rectification—Motion or Summons.
- § 109. Notices to be given—Application for leave.
- § 110. The Order to Rectify and its Entry on the Register—Right of Appeal.
- § 111. Application for Cancellation for Non-manufacture in United Kingdom.
- § 112. Procedure on Application to Cancel.
- § 113. Register *primâ facie* Evidence—Certificates of Entries by Comptroller.
- § 114. Falsification of Documents.

§ 90. The Act provides 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

(*a*) As to Proprietorship, see Chapter VII., *post*.

assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed (*b*). The old register of designs formed under the 1883 Act is incorporated with and forms part of the register under the new Act (*c*).

§ 91. No notice of any trust, express, implied or constructive, can be entered upon the register or be received by the Comptroller (*d*). The new Act, however, contains an express provision (*e*) that where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a design the Comptroller shall, on request and proof of title to his satisfaction, cause notice of the interest to be entered on the register.

This will not materially alter the old practice, for it was long ago decided, on sect. 23 of the Act of 1883 (the corresponding section of that portion of the Act which related to patents), that equitable assignments might be entered on the register, not as in themselves legal assignments, but as documents which affected the proprietorship. And deeds containing declarations of trust have been commonly filed in the Comptroller's Office though no notice was taken of the trust in the entry on the register.

The Act (*f*), moreover, provides for the enforcement of any equities in respect of a design in the same way as in respect of any other personal property.

In *Stewart v. Casey* (*g*), 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

(*b*) (1907) Sect. 52 (1). As to Classes 13, 14 and 15, see Rule 85.

(*c*) (1907) Sect. 52 (2).

(*d*) *Ibid.*, Sect. 66.

(*e*) Sect. 71 (2).

(*f*) Sect. 71 (3).

(*g*) (1892) 9 R. P. C. 9. The point was queried by Kekewich, J., in *Haslett v. Hutchinson* (1891), 8 R. P. C. 457, but *Stewart v. Casey* is a direct decision on the question and has since been followed.

letter above set out; and the Court of Appeal hold that the letter was an immediate equitable assignment of an interest in the patent, and was properly entered on the register.

§ 92. The registration of the name of the original proprietor is effected upon the sealing of the certificate of registration, though the date of application is the day from which the registration will date (*h*). The Comptroller must enter on the register the name (*i*), address, and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller.

§ 93. Subsequent proprietors are entitled to be placed upon the register, on compliance with the provisions of sect. 71 (1) of the Act, which runs as follows:—

“Where a person becomes entitled by assignment, transmission, or other operation of law, to the copyright in a registered design, the Comptroller shall on request, and on proof of title to his satisfaction, register him as the proprietor of a design.”

§ 94. Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, as assignee, mortgagee, licensee, or otherwise, or 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, is to be addressed to the Comptroller (*k*).

Every such request must, 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 a director, or by the secretary or other proper officer, or

(*h*) Sects. 49 (5) and 51 (1).

(*i*) A body corporate may be registered by its corporate name: see Rule 8.

(*k*) Rules 43, 44. And see Forms Nos. 11, 13, *post*, pp. 379, 380.

their agent authorised in like manner(*l*). It may be made jointly with the registered proprietor, in which case the Comptroller may forthwith, on receipt of the joint request, make a note in the Register of such interest(*m*). Where no such joint application is made the request must state the name, address and description of the claimant, and the particulars of the assignment, mortgage, license, or other mode of transfer by virtue of which the request is made, so as to show the manner in which and the person or persons through whom the interest in the design has been acquired(*mm*).

The request must be supported, if the Comptroller requires it, by a statutory declaration verifying the several statements in the case, and declaring that the particulars given comprise every material fact and document affecting the matter(*n*). The claimant must also furnish to the Comptroller such other proof of title as he may require for his satisfaction(*nn*). Where the name of a person is entered on the Register as mortgagee or licensee, the entry may be vacated on lodgment of an acknowledgment of the determination of the interest, signed by him or his agent(*o*).

§ 95. In any case in which the Comptroller thinks it right he may take evidence *viva voce* in lieu of or in addition to evidence by declaration, or allow any declarant to be cross-examined on his declaration(*p*). He may also dispense with compliance with any of the above provisions, and accept other evidence of transmission of title (subject to such conditions as he may think fit) wherever he is satisfied that from any reasonable cause the person entitled cannot sign the request or make the statutory declaration or produce the documents or other evidence of title(*pp*).

(*l*) Rules 8, 12.

(*m*) Rule 43, Form No. 11, *post*, p. 379.

(*mm*) Rules 44, 45, Form No. 13, *post*, p. 380.

(*n*) Rule 46, Form No. 14, *post*, p. 381.

(*nn*) Rule 47.

(*o*) Rule 49, Form No. 15, *post*, p. 381.

(*p*) (1907) Sect. 77 (1).

(*pp*) Rule 62.

§ 96. It may be considered doubtful whether an assignment must be in writing. This was assumed to be the case under the older Acts (*q*), but the Rules of 1900 (which are repeated in the new Rules above quoted) seem to have contemplated cases where a written assignment could not be produced. In *Woolley v. Broad* (*r*), where unregistered verbal licensees joined with the proprietor in an action for infringement, judgment was given against them on the ground that there was no written evidence of their title; but this is scarcely a direct decision on the point. The effect of the new Rules is that the Comptroller may accept less than legal evidence, and that whenever he is satisfied that the claimant is entitled to the entry of his name, he may make a note on the register of such interest (*rr*).

§ 97. It will be necessary, in all cases, to complete the original registration before an assignment can be registered (*s*).

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

§ 98. The register kept under the Act is required to be open to the inspection of the public at all convenient times, subject to the provisions of the Act and to such regulations as may be prescribed (*t*).

During the existence of the copyright in a design, or (under the Act of 1907) such shorter period, not being less than two years from the registration of the design, as may be prescribed, the design itself cannot be inspected except (1) by the registered proprietor; or (2) by a

(*q*) *Jewitt v. Eckhardt* (1878), 8 Ch. D. 404 (a license case). And see Act of 1842, sect. 6.

(*r*) (1892) 9 R. P. C. 208.

(*rr*) See Rules 48, 62. The question is more fully dealt with in Chap. VII. on "Proprietor," *post*, p. 122.

(*s*) *Jewitt v. Eckhardt*, *supra*.

(*t*) (1907) Sect. 67; Rules 61, 69.

person authorised in writing by him ; or (3) by a person authorised by the Comptroller or by the Court (*u*). And 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 (*x*) ; and must not take any copy of the design, or of any part of it (*y*).

But where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration is entitled to inspect the design so registered (*z*), and this, it is said, affords in practice an easy means of obtaining inspection of almost any design.

The new Act has given power to throw designs open to inspection before the expiration of the copyright, and by sub-section 3 of the 56th section different periods may be prescribed for different classes of goods. The Rules of 1908 have fixed two years from the date of registration as the period after which inspection may be obtained as of right for all classes (*a*), except Classes 13, 14 and 15.

When the copyright in a design has ceased, the design is open to inspection by any member of the public, and copies thereof may be taken by any person on payment of the prescribed fee (*b*).

Where an application for a design has been refused or not been duly proceeded with so that it becomes liable to be treated as abandoned under the new provisions of sect. 49 (4) of the 1907 Act, the application, and any drawings or specimens left in connection with the application, is not at any time to be open to public inspection or published by the Comptroller (*c*).

(*u*) (1907) Sect. 56 (1).

(*x*) Rules of 1908, Sched. I. (No. 26).

(*y*) (1907) Sect. 56 (1).

(*z*) Proviso to Sect. 56 (1).

(*a*) Rules of 1908, No. 69.

(*b*) (1907) Sect. 56 (2).

(*c*) (1907) Sect. 69 (2).

§§ 98, 99. INSPECTION OF THE REGISTER—RECTIFICATION. 99

§ 99. It is provided by sect. 72 of the new Act (corresponding with sect. 90 of the Act of 1883) that—

“The Court may, on the application in the proscribed manner of any person aggrieved by the non-insertion in or omission from the register of designs of any entry, or by any entry in such register made without sufficient cause, or by any entry wrongly remaining on, or by any error or defect in any entry in such register, make such order for making, expunging, or varying such entry, as it may think fit.”

This provision is much wider in its wording than that of the corresponding section in the old Act, under which it was held that the words “omission without sufficient cause of the name of any person” would not enable a person whose design had been refused by the Comptroller to appeal to the Court, and that as an appeal of such a kind was required to be to the Board of Trade (*d*), this provision could not be evaded under cover of an application to rectify the register (*e*). The new Act has added the words “non-insertion in . . . the register of designs of any entry,” and although an appeal is given as before (*f*) to the Board of Trade against any refusal of the Comptroller to register, it may be questioned whether this excludes the express power given to the Court by this provision.

Other new grounds for an application for rectification introduced by the 1907 Act are: (a) any entry wrongly remaining on the register; (b) any error or defect in any entry; and in all these cases, although the Comptroller may sometimes have a concurrent power (*g*), full jurisdiction is given to the Court itself.

§ 100. The grounds upon which an entry will be varied or expunged by the Court are, in general, similar

(*d*) (1883) Sect. 47.

(*e*) *Re the Trade Mark Normal* (1886), 4 R. P. C. 123. Sect. 90 of the Act of 1883 applied to patents, designs and trade marks alike, and assistance in construing it was to be obtained from cases on all three subjects.

(*f*) See Act of 1907, sect. 49 (3).

(*g*) See sect. 70 (b) and (c).

to those upon which the Comptroller ought, in the first instance, to refuse registration. Thus the Court has expunged entries on the ground—(1) that the person registered had no title enabling him to register (*h*); (2) that the design was not novel or had been previously published (*i*); (3) that the entries in the register had been caused by misrepresentation (*k*); (4) that the entry was not *bonâ fide*, and had been made without sufficient cause (*l*).

§ 101. The Court may expunge any entry or may rectify by varying the entry (*m*). An improper entry should be expunged, and not rectified (*n*). And although at one time it was doubted, there seems to be power to substitute one name as registered proprietor for another, which may be exercised by the Court (*p*), or even by the Comptroller (without application to the Court), in proper circumstances.

The trade mark authorities on the point apply generally in the case of designs (*q*), but it is to be noted that the reasons which have led the Court to refuse to substitute the name of the proper proprietor for that of the person improperly registered, in the case of trade marks, are not as strong in the case of the register of designs, upon which names are placed by the Comptroller without preliminary notice or other opportunity for opposition.

(*h*) *Re Guiterman's Design* (1886), 55 L. J. Ch. 309.

(*i*) *Le May v. Welch* (1884), 28 Ch. D. 24; *Smith v. Hope* (1889), 6 R. P. C. 200; *Re Read and Greswell's Design* (1889), 6 R. P. C. 471; *Smout v. Slaymaker* (1890), 7 R. P. C. 90.

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

(*l*) *Re Batt's Trade Mark* (1899), 16 R. P. C. 411.

(*m*) An example of this is to be found in the trade mark case, *Baker v. Rawson*, cited above. See also *Re Grocott's Design* (1899), 17 R. P. C. 139.

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

(*p*) *Re Grocott's Design*, *supra*.

(*q*) Per North, J., in *Re Ormonde Cycle Co.'s Trade Mark* (1896), 13 R. P. C. 475.

In *Re Rivière's Trade Mark (r)*, 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 may the name of the person properly entitled to the mark be substituted, yet in my view, *as a rule* (and I do not know a case where there would be an exception), where anyone 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 (s)*, 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 (t)* the partner applied in his own name only, and substitution, by way of rectification, of the firm's name, was refused; and in *Re Greenlees' Trade Marks (u)* this 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.

In *Re Guiterman's Design (x)* 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 real proprietor, and no reasons for his refusal were given by the judge.

In *Re Grocott's Design (y)* is an instructive case on this point. In this case a design had been registered by the instructions of H., the author, but was inadvertently registered by the agent, G., who was employed by him to manufacture the articles in his own name. H. moved to vary the register by removing G.'s name and substituting his own name as the proprietor of the design. G. did not appear; and it appearing by the evidence that it was a case of mistake and not fraud on the part of the agent, who had offered to assign the registration to H., the application was not opposed

(r) (1885) 55 L. J. Ch. 545.

(t) (1881) 29 W. R. 391.

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

(s) (1880) 29 W. R. 393.

(u) (1892) 9 R. P. C. 93.

(y) (1899) 17 R. P. C. 139.

by the Comptroller. Counsel for the applicant said G. could not make a title by assignment, as he was not the author or the proprietor within sect. 61; and if the name of the true author and proprietor could not be substituted, the design would become common property. Kokowich, J., said there was reasonably clear evidence of a mistake, and he would make the order to vary the register, putting on the face of it the reason: "It appearing to the satisfaction of the Court that the registration by G., in his own name, was made inadvertently and by mistake in lieu of the name of H."

§ 102. 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 (z). And where the name of a company or firm has been altered, it is not necessary to apply to the Court to make an order to vary under sect. 72 of the Act, but the Comptroller may do it under sect. 71 (a).

§ 103. The costs of such an application were declared by the old section (90 (1)) to be in the discretion of the Court; but there seems to have been no fixed rule as to the orders made in this regard (b). In contested cases the party who was unsuccessful generally had to pay them, and the Comptroller was usually allowed his costs of appearance.

Power was also given to the Court by sect. 90 (2) of the 1883 Act to award damages to the party aggrieved by any false entry in the register. Judging from the reported cases on designs, this was seldom, if ever, done, although it might be in a proper case. Under a similar

(z) *Re Patent Plumbago Crucible Co.'s Trade Mark* (1890), 7 R. P. C. 282.

(a) See, however, *In re Pneumatic Tyre Co.'s Design* (1894), 11 R. P. C. 636, where the Comptroller declined in similar circumstances to change the name of the proprietor on the register from that of an old to that of a new company without an order of the Court, and the order was made (by consent) on payment of his costs.

(b) See e.g., *Re Batt & Co.'s Trade Mark* (1898), 15 R. P. C. 262, 534, where no order was made for the Comptroller's costs, while in *Re Pneumatic Tyre Co.'s Design*, *supra*, they were ordered to be paid. And see *infra*, § 113.

section of the Companies Act, 1862 (c), Lindloy, 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 was made.*

The Act contains a general provision (sect. 72 (3)) that the Court may, in any proceeding under the section, decide any question that it may be necessary or expedient to decide in connection with the rectification of a register, and this would probably be held to include any question of costs, and even of damages in a proper case.

§ 104. Although the Court has power under its general jurisdiction to refuse relief to a registered proprietor of a design on the ground of improper conduct disentitling him to assistance in support of his rights against an alleged infringer (d), this will not be carried to the extent of removing his registered design from the register unless there are good legal grounds under the Act.

In *Harper v. Wright & Butler* (e), Herschell, L.J., in giving judgment for the plaintiff, said: "Then, it is said that the plaintiffs are disentitled from recovering because they have misled the public. It is said that they have obtained registration for their handles to the stove and for a cover to the stove—a particular pattern or ornament of the cover—and they have, first of all, on stoves which they have sold, put the registered number of the original design, and also put the registered number of the designs which they registered subsequently as applicable to particular parts of the stove. It is said that that was misleading, and that the public would not know to what those numbers referred; and, if the lid was a new-registered lid, then they ought not to have put on the number of the original design, because that was a different design. Now, there is nothing in the Act of Parliament which deprives a person who has registered a design of his right to protection, and to prevent infringement of it if he puts on articles that he sells registered numbers which ought

(c) Sect. 35; *Ottos Kopje Diamond Mines* (1893), 62 L. J. Ch. 166. In *Reid v. Thomson* (1905), 22 R. P. C. 376 (a Scotch case), it was held that damages for an illegal registration could not be recovered either at common law or under the statute.

(d) Per Stirling, J., in *Sen Sen Co. v. Britten* (1899), 16 R. P. C. 137.

(e) (1895) 12 R. P. C. 483.

not to be there. If he sells without putting on the registered number of a design which is within his registration, then no doubt he loses his protection; and it may sometimes be a difficult question to know exactly what numbers he ought to put on, and on what parts of the articles sold, and it is only natural that a person who has registered designs should err on the side of caution, because if he does not put the number on, he certainly loses his rights. But there is no clause in the Act of Parliament which deprives him of his rights if he, even mistakenly, puts numbers on the articles which he sells which have no business there."

So, in *Re Bayer's Design (f)*, it was held that the facts that the owner had sold articles differing, but not substantially, from the registered design marked with the registered number, and that he had, after registration, made statements in his catalogue and otherwise as to the extent of his protection and monopoly, ought not to affect the construction of the application or the validity of the registration. Warrington, J., in giving judgment, said: "It is said that the respondent has misrepresented the nature of his design; that is to say, that he has in his advertisements represented as covered by his design a number of articles which vary. They vary in this way: they vary both in number and in the shape of the pieces of which the stays are composed. Now, in the first place, no authority has been produced to me for the rectification of the register on that ground, and I am not prepared to say that in the case of a design it ought to be struck off the register because the applicant for the design has been guilty of misconduct in selling as registered something which is not covered by the registered design. That, of course, would be an answer to the objection. I do not think that the register ought to be rectified or the design struck out from it because subsequently the proprietor of the design has made a statement which would lead people to believe that he has a greater protection than he has."

And on the hearing in the Court of Appeal, where the registration was invalidated on other grounds, it being urged that the owner of a design might in his advertisements anticipate the construction to be put on his design, and perhaps err on the side of safety, Vaughan Williams, L.J., said: "The advertisements are quite immaterial. I agree with you there."

§ 105. The persons entitled to demand rectification, if there be due cause, must come under the description of "person aggrieved." There has been at different times

(f) (1906) 23 R. P. C. 553; and (on appeal) (1907), 24 R. P. C. 65.

much discussion as to who may fall within this description (*g*).

In the case of *Rivière's Trade Mark* (*gg*), Solborne, L.C., said: "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 *a 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 sentimental grievance; but is it possible for us to say *a 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* (*h*) 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.

In *Re Powell's Trade Mark* (*i*), 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

(*g*) For survey of the decisions, see § 106, *post*, p. 107.

(*gg*) (1884) 53 L. J. Ch. 455, 578.

(*h*) (1891) 8 R. P. C. 137.

(*i*) (1893) 10 R. P. C. 195. Affirmed by the House of Lords (1894), 11 R. P. C. 4.

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 unbusiness-like 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 ought not to be there, he is a person who, to my mind, is sufficiently aggrieved to come within the section." And in the House of Lords, Herschell, L.C., said: "Wherever it can be shown that the applicant is in the same trade as the person who first registered the trade mark, and wherever the trade mark if remaining on the register would or might limit the legal rights of the applicant, so that by reason of the existence of the entry upon the register he could not lawfully do that which, but for the appearance of the mark upon the register he could lawfully do, it appears to me that he has a *locus standi* to be heard as a person aggrieved."

In *Re Wright, Crossley & Co.'s Trade Mark (k)*, an application to expunge was made by the Royal Baking Powder Co., who had had other litigation with the respondents but were unable to show that they had any *bonâ fide* intention to trade in the goods covered by the mark; and it was held, that the applicants were not persons aggrieved, as they had not shown any practically possible way in which they might be damaged by the presence of the trade mark on the register, and that the trade mark was not in itself illegal or improper. Rigby, L.J., said: "So far from assenting to the statement that *In re Powell* (11 R. P. C. 4) is an authority that the mere fact that a man is engaged in the same trade is sufficient to make him a person aggrieved, I think it is carefully guarded against, and that statement is contrary to the principles of the case as stated in the House of Lords."

(k) (1898) 15 R. P. C. 131.

The same view has been upheld under the Literary and Art Copyright Acts (*l*), where similar powers of expunging entries are given; and in the leading case of *Re Graves* (*m*), Hannen, J., said: "A person to be 'aggrieved,' within the meaning of the statute, must show that the entry is inconsistent with some right that he sets up in himself or in some other person, or that the entry would really interfere with some intended action on the part of the person making the application."

So in patent cases in *Horsley & Knighton's Patent* (*n*), 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 (*o*).

In *Re Green's Patent* (*o*), a patentee having assigned his patent to persons who omitted to register the assignment, afterwards *fraudulently* assigned the patent to another person, who registered it on the same day. The first assignees registered their assignment a week afterwards. The Court, on the motion of the first assignees, ordered the register of the second assignment to be expunged, and with costs.

And in *Re Morey's Patent* (*p*), a patentee assigned half his patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a licence to work and use to A. B.'s assignment was first registered. It was held that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register that the licence referred to in B.'s assignment was the deed of assignment to A. subsequently entered.

§ 106. Thus the following are persons aggrieved—
 (a) those who are engaged in a business and who desire to deal in a design covering goods in that business, which they allege to be improperly on the register (*q*);
 (b) proprietors of designs registered before the design which it is desired to remove, and who allege some prejudice to their rights through the subsequent registration (*r*); (c) persons attacked in an action for infringe-

(*l*) 5 & 6 Vict. c. 45, s. 14, and 25 & 26 Vict. c. 68, s. 5.

(*m*) (1869) L. R. 4 Q. B. 724. See *Chappell v. Purday*, 14 M. & W. 303, and *Ex parte Poulton*, 53 L. J. Q. B. 320.

(*n*) (1869) 39 L. J. Ch. 157.

(*o*) (1857) 24 Beav. 145.

(*p*) (1858) 25 Beav. 581.

(*q*) See *Smith v. Hope* (1889), 6 R. P. C. 200; *Re Bach's Design* (1889), 6 R. P. C. 376; and *Re Talbot's Trade Mark* (1894), 11 R. P. C. 77, in addition to the cases above cited.

(*r*) *E.g.*, *Re Read and Greswell's Design*, 42 Ch. Div. 260.

mont (s); and (d) persons setting up some right or title which is interfered with by the registration.

§ 107. To expunge or 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 (t). This will be so even when the registered proprietor is domiciled in Scotland or Ireland (u); but there have been conflicting decisions in the two countries on this point.

In Scotland there is the authority of *Cowie Brothers v. Herbert* (x). This was an action in the sheriff Court of Lanarkshire for infringement of a trade mark of a Glasgow firm, during the dependence of which the defender presented a petition to the Lord Ordinary in the Court of Session (Outer House) to have the trade mark expunged under sect. 90. Held, by the Lord Ordinary, that the petition to him for rectification of the register was a competent application, and that the petitioner was an aggrieved person in the sense of the Act. The Lord Ordinary, however, said: "I have been informed that there is no report in our books of any petition for rectification of the register of trade marks, but no objection has been taken to my jurisdiction, and I suppose there is no doubt about it."

In Ireland, however, the contrary opinion was expressed, after full argument, in the case of *Charles Bayer v. Connell* (y). This was an action for infringement of the trade mark of a London firm of corset makers, the defendant, who traded in Dublin, denying infringement. By an interlocutory motion the defendants applied for an order that the registration should be set aside and expunged, and the register rectified; but this was opposed by the plaintiff, on the point that the High Court of Justice in Ireland had no jurisdiction to order any alteration in the register. Held, that the Irish Court had no jurisdiction under the Patents Act, 1883, to order any alteration or rectification of the register of trade marks, which was a special jurisdiction conferred on the High Court of Justice in England.

In giving judgment the Master of the Rolls (Porter) said: "The sole question at present to be decided is whether the Patents, Designs, and Trade Marks Act of 1883 (46 & 47

(s) *Great Tower Tea Co. v. Smith* (1889), 6 R. P. C. 165.

(t) (1907) Sect. 92 (1). See also sects. 94 (4) and 95 (2) of the Act.

(u) *Re King & Co.'s Trade Mark* (1892), 10 R. P. C. 350; and *Kinahan v. Kinahan*, 8 R. P. C. 18.

(x) (1896) 14 R. P. C. 426. See also *Dewars, Ltd. v. J. T. Dewar* (1899), 17 R. P. C. 341, where an order to expunge was made; and *Reid v. Thomson* (1905), 22 R. P. C. 376, where the claim was not resisted.

(y) (1897) 14 R. P. C. 275.

Vict. c. 57) confers upon the Irish Courts any power to order the register to be altered, by expunging a trade mark or otherwise rectifying it. The question is one apart from the ordinary jurisdiction of the Court. The power, if it exists, is the creature of the statute, and must be found in it. That which is sought in this motion is plainly an exercise of a special jurisdiction under the Act, and that alone. There can be no inherent or general authority in an Irish Court to correct a register of trade marks in England It is important to note that in the first Trade Mark Act, properly so called, the Act of 1875 (38 & 39 Vict. c. 91), the only Court which could possibly touch the register directly was 'any of Her Majesty's Courts of law or equity at Westminster.' That appears to me to have a very important bearing upon the question. It is an Act to establish a register of trade marks. Of course it has been repealed, but that does not affect the importance of it in considering the question now before me. . . . There is thus no decision upon the point; and although the Trade Marks Act, 1875, is mentioned in some of the judgments in the last-mentioned case (*King & Co.'s Trade Mark*), its bearing upon this question does not seem to have been considered. I regard that Act as of very great importance. Some departure from the phraseology of a statute dealing only with trade marks was necessary, when the Legislature came to embody in one Act provisions relating to trade marks, designs, and patents; but if so grave a departure was intended as the depriving of the English Courts of an exclusive jurisdiction in reference to trade marks (which undoubtedly they had under the Act of 1875), and the conferring of a co-ordinate jurisdiction upon the Irish and Scotch Courts, it would certainly have been expressed in direct language, and we should not have been left to spell it out of doubtful and ambiguous expressions, such as are to be found in the 111th section. I need not dwell upon the inconvenience which might result from conflicting decisions as to the registration of the same trade mark in the Courts of the three countries. The question is one of the construction of the statute, and on that alone I decide it" (yy).

§ 108. It would ordinarily be an abuse of the process of the Court to bring an action for rectification; nor will the Court grant the relief on a counterclaim (z). The

(yy) The new Act provides for such applications being made in "the prescribed manner" (sect. 72 (1)), and for the attendance of the Comptroller on the hearing (sect. 72 (3)), and it is difficult to see how these provisions can be deemed to apply to Scotch or Irish Courts.

(z) Per Bowen, L.J., in *Pinto v. Badman* (1891), 8 R. P. C. 181, 187. See, however, *Reid v. Thomson, supra*, where an action for a declaration and damages was brought, and costs were awarded.

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 into Court, it will often be better to proceed by motion (*a*). As the application is not by petition, the provisions of sect. 92 (2) of the new Act creating a special Court for the hearing of certain specified classes of cases under the Act will not apply, and the application need not therefore be made to any particular judge.

If the application to rectify be the answer to an action for infringement, the course is to take out a 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 (*b*). If there be no action pending, the application, if made by summons, must be made by originating summons (*c*).

Particulars of objections will generally be ordered and interrogatories will also be allowed, and that against either party, in a proper case (*d*).

§ 109. Notice of any application under the section is required to be given to the Comptroller, who has the right to appear and be heard thereon.

Four clear days' notice of every application is required to be given to the Comptroller (*e*). As a rule, all persons who are affected should be served in the ordinary way prescribed for a motion or summons; but 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

(*a*) Forms of notice of motion are given in Appendix B., *post*, p. 401.

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

(*c*) (1893) Ord. LIV. r. 4 (b), (c), (d).

(*d*) *In re Buyer's Design* (1906), 23 R. P. C. 553.

(*e*) Rule 95.

suffice (*f*). It is not necessary to obtain preliminary leave of the Court; but leave may, if desired, be obtained on an *ex parte* application (*g*).

In *Re King & Co.'s Trade Mark* (*h*), 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. 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."

§ 110. The order for rectification (*i*) must direct that due notice of the order be given to the Comptroller (*k*). And the person in whose favour the rectification is made must forthwith leave at the Comptroller's Office an office copy of the order (*l*). The register must thereupon be rectified, or the purport of such order otherwise duly entered in the register, as the case may be (*m*). When the rectification is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree or other authority for the rectification is to be served on the Comptroller, and he must rectify the register accordingly (*n*). If a name is to be removed, the register is rectified by striking out the name and adding, "By order of the Court of _____, dated, &c., this name has been erased." Whenever such an order is made the Comptroller, if he thinks that the effect of the order should be made public, may advertise a notice of it in the official journal (*nn*).

There is an appeal from the decision of the High Court

(*f*) *Re King & Co.'s Trade Mark* (1892), 9 R. P. C. 350; and see *Re Compagnie Générale d'Eaux Minérales Trade Mark*, 10 R. P. C. 446.

(*g*) *In re Robertson, Sanderson & Co.'s Trade Mark*, 9 R. P. C. 215.

(*h*) See note (*f*) above.

(*i*) See Forms, *post*, p. 401.

(*k*) (1907) Sect. 72 (4).

(*l*) Rule 96.

(*m*) *Ibid.* In the case of goods in the Manchester Classes, the entry in the Manchester Register must also be altered. (Rule 86.)

(*n*) (1907) Sects. 94 (7) and 95 (3). As to the meaning of "required," and generally as to the effect of these provisions, see *Charles Bayer v. Connell* (1897), 14 R. P. C. 275.

(*nn*) Rule 97.

to the Court of Appeal on any application under the section; and for purposes of procedure it is treated as an appeal from a final order (o).

In *Re Bayer's Design* (p), rectification being refused, the applicants appealed and applied to the Court of Appeal for leave to adduce fresh evidence on the hearing of the appeal, on the ground of surprise at the trial. Leave was given to adduce such evidence by affidavit, with answering evidence by the respondent; with liberty to cross-examine witnesses on the hearing of the appeal.

§ 111. The new Act contains a further provision (q) for cancellation of the registration of a design at any time on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom. This modifies the law under the old Act (sect. 54) by which the copyright *ceased* if the design was used in any foreign country and not used in the United Kingdom within six months of its registration. The application for cancellation may be made by any person; but it is provided that where such an application is made the provisions of the Act with respect to the revocation of patents worked outside the United Kingdom (*including those relating to costs*) shall apply with the necessary modifications.

These incorporated provisions are contained in sects. 27 and 39 of the Act, which provide that—

- (1) On an application for revocation the Comptroller shall make inquiry, and if satisfied that the allegations contained in the application are correct, he may (unless the registered owner proves that the article is manufactured *to an adequate extent* in the United Kingdom, or gives satisfactory reasons why it is not) make an order of revocation either forthwith or after such reasonable interval as may be specified in

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

(p) (1906) 23 R. P. C. 553.

(q) (1907) Sect. 58 (1).

the order, unless again it is shown to his satisfaction that in the meantime the article has been manufactured within the United Kingdom to an adequate extent, or the owner gives satisfactory reasons why it is not so manufactured, in which case the Comptroller may extend the period mentioned in the previous order for a further period not exceeding twelve months. (Sect. 27.)

- (2) The Comptroller shall in such proceedings have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court; and if the applicant neither resides nor carries on business in the United Kingdom he may be required to give security for costs of the proceedings, and in default of such security the proceedings may be treated as abandoned. (Sect. 39.)

Every case arising under these provisions will have to be considered on its own merits, and particular circumstances by the Comptroller, to whom an almost unlimited discretion is given in the case of designs, as no appeal is given from his decision (*r*).

§ 112. The Rules provide that an application for cancellation under this section is to be commenced by lodgment of a request, bearing a 1*l*. stamp, asking that the registration may be cancelled on the ground stated in the section and giving an address for service in the United Kingdom. A copy is to be served on the proprietor, who must, within fourteen days, or such further time as the Comptroller may allow, leave at the Patent Office, and also deliver to the applicant, evidence by way of statutory declaration stating whether the allegations contained in the application are correct, and if incorrect to what extent, and in what place the design is used for manufacture

(*r*) Sect. 58 (1). See notes to this section in Part II., *post*, p. 238 *et seq.*
E. 8

in the United Kingdom. The applicant may file evidence in answer to this, and no further evidence is then to be filed except by leave, and subject to such conditions as the Comptroller may think fit. The Comptroller will thereupon appoint a time for the hearing of the case, and give the parties ten days' notice of the appointment; and in the event of his deciding to take evidence *vivâ voce*, or to allow cross-examination on the declarations, he may require the attendance of any declarant or other person whose evidence he may consider desirable (*rr*).

Any person may apparently make the application, and the provision applies to all designs now on the register as well as to any which may be registered under the new Act (*s*).

§ 113. Sect. 52 (3) of the Act provides that the register of designs shall be *primâ facie* evidence of any matters by the Act directed or authorised to be entered therein.

Sect. 79 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, on payment of the prescribed fee (*t*). 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, is *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 (*u*).

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

(*rr*) Rules of 1908, Nos. 70--75.

(*s*) See sect. 98 (2) and notes thereon, *post*, p. 285.

(*t*) (1907) Sect. 67. For fee, see Schedule I. to the Rules, No. 19, *post*, p. 319.

(*u*) (1907) Sect. 78, Rule 67. For application for certificate, see Form No. 22, *post*, p. 385.

(*v*) (1907) Sect. 89 (1).

CHAPTER VII.

THE PROPRIETOR.

(The full references to all the Reports will be found in the Table of Cases ante.)

- § 115. Definition of "Proprietor."
- § 116. Persons who may be Proprietors.
- § 117. The Author of the Design.
- § 118. Persons employing Authors—Commissioned Works.
- § 119. Persons acquiring a Design—*Lazarus v. Charles*; *Re Guiterman's Design*.
- § 120. Persons acquiring Right to Apply—*Nevill v. Bennett*.
- § 121. Licenses—*Jewitt v. Eckhardt*.
- § 122. Evidence of Title on Licenses and Assignments.
- § 123. Remedies of Unregistered Proprietors—*Hole v. Bradbury*; *Ihlee v. Henshaw*.
- § 124. Distinction between License and Written Consent.
- § 125. Necessity of Registration to complete Title.
- § 126. License or Assignment by part Proprietor—*Lauri v. Renad*.
- § 127. Devolution on Death.
- § 128. Equitable Proprietorship.
- § 129. Effect of Bankruptcy.

§ 115. 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. 93 a definition of these words is given. It runs as follows:—

"Proprietor of a new and original design,"—

(a) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and

(b) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(a) (1907) Sect. 49 (1).

(o) In any other case, means the author of the design :
And where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

§ 116. There are, therefore, five classes of persons who may be considered proprietors: (1) the author of the design; (2) any person who employs the author to execute the work for good consideration; (3) any person acquiring the design either exclusively of any other person or otherwise; (4) any person acquiring the right either exclusively or otherwise to apply the design to any article; (5) any person on whom the design or these rights may devolve.

§ 117. As to who is the "author" of a design no definition is given by the Act, and there is little direct judicial authority on the subject (*b*). The analogy of other copyright productions, where design or invention is the principal factor in the creation of a work, will here be of considerable assistance. If a person merely suggests the idea of the work to another, he can scarcely claim to be the "author" (*c*); but the case is different where he not only suggests the idea, but has a share in or actually superintends the execution of the work (*d*).

"The term 'design,' " says Mr. Curtis (*e*), dealing with the question of engraving copyright, "means the visible form given to the conception of the mind, and must be done by the inventor himself." But the inventor of the subject of an artistic design, although himself unable to draw, may nevertheless be properly

(*b*) See, however, the cases of *Nevill v. Bennett* (1898), 15 R. P. C. 412, and *Pearson v. Wilkinson* (1906), 23 R. P. C. 738, cited *infra*.

(*c*) *Shepherd v. Conquest* (1856), 17 C. B. 427.

(*d*) *Hutton v. Kean* (1859), 8 W. R. 7; *Springfield v. Thame* (1903), 19 Times L. R. 650.

(*e*) Curtis on Copyright, p. 145.

regarded as the “author” if he supplies all the material from which the design is produced and only has the drawing done by another person.

Thus, in *Stannard v. Harrison* (*f*), where a war map was in question, the ideas and material for which had been provided by the plaintiff, the Vice-Chancellor said: “That the plaintiff cannot draw himself is a matter wholly important if he has caused other persons to draw for him. He invents the subject of the design beyond all question. He proscribes the proportions and the contents of the design; he furnishes a part of the materials from which the drawing has to be made in the first instance, and afterwards collects daily from the proper sources accounts of the different phases of the war. These he communicates to the man whom he has employed to make a drawing for him. . . . Can there be anything more plainly within the words of the Act of Parliament (*g*) than that Mr. Stannard did himself invent, that he did procure another person to design and draw for him and do that which he himself could not do?”

In *Nottage v. Jackson* (1883) (*h*), the question arose as to who was the “author” of a photograph within the meaning of the Art Copyright Act (*i*), and the definition of the Master of the Rolls (Lord Esher) was: “It is the person who effectively is, as near as he can be, the cause of the picture which is produced”; Cotton, L.J., said: “In my opinion ‘author’ involves originating, making, producing as the inventive or master mind, the thing which is to be protected whether it be a drawing or a painting or a photograph”; and Bowen, L.J.: “The ‘author’ is the man who really represents or creates, or gives to the ideas or fancy, or imagination, the local habitation—the man, in fact, who is most nearly the effective cause of the representation” (*k*).

In the matter of designs, the only case bearing directly on this question is the recent one of *Pearson v. Wilkinson* (*l*), in which a question arose as to the authorship of a design for the shape of a new body for perambulators, and it was held that the person who drew the original rough sketch of

(*f*) (1871) 24 L. T. 570. See *Kenrick v. Laurence* (1890), L. R. 25 Q. B. D. 99; and *Petty v. Taylor*, [1897] 1 Ch. 465.

(*g*) 7 Geo. III. c. 38.

(*h*) L. R. 11 Q. B. D. 627.

(*i*) 25 & 26 Vict. c. 68.

(*k*) And see *Wooderson v. Tuck & Sons* (1887), 4 Times L. R. 57; *Melville v. Mirror of Life Co.*, [1895] 2 Ch. 531.

(*l*) (1906) 23 R. P. C. 738.

the shape desired, which, coupled with the verbal instructions, proved sufficient for the workman to work by, was the "author" of the design. In giving judgment for the plaintiff Kekowich, J., said: "Then is Mr. Pearson the original designer; is the novelty his? That was questioned in the opening of the motion, but on the evidence it seems to be quite clear that Mr. Pearson made the rough sketch which I hold in my hand, and on which he made some remarks. He gave the size of it in inches and he gave some rough instructions. Then he sent for Mr. Harry Eaton and told him to make a perambulator according to that sketch. . . . What is important is that Eaton with the sketch and the verbal instructions produced the very thing that Mr. Pearson intended to be produced. He took it back to Mr. Pearson and he at once approved it. There was no alteration, no going backwards and forwards; once the article was produced it was also approved as being the thing Mr. Pearson wanted. Eaton may have slightly improved on Mr. Pearson's instructions; that is quite possible; but the article which he made was the article which Mr. Pearson wanted to be made. So that I have every condition fulfilled, and the article here is really the invention, as regards design, of Mr. Pearson."

This case runs on all fours with the copyright case of *Standard v. Harrison*, before quoted, and the result may therefore be taken to be that the originator of a design will be regarded as the "author" whether he actually draws it or not, provided he not only gives the ideas, but actually furnishes the materials for, or superintends the execution of, the work (*m*).

§ 118. For practical purposes the question is partly, but only partly, covered by cases coming within (2), *i.e.*, where the author is employed "for good consideration," but in such cases the consideration must, of course, be proved. It is, in fact, frequently disputed, and then the question of authorship is of primary importance.

In *Re Heinrich's Design* (*n*), the applicant, D., moved to rectify the register by striking out the name of H. as the registered owner of a design for a writing table, and for the insertion of his own name as proprietor, on the ground that

(*m*) See also *Nevill v. Bennett* (1898), 15 R. P. C. 412.

(*n*) (1891) 9 R. P. C. 73. See *In re Grocott's Design* (1899), 17 R. P. C. 139, where in similar circumstances, variation of the entry of proprietorship was ordered, there being, however, no opposition.

he, D., had in the previous year invented the design, and in order to have it carried out had employed H., whom his firm had been in the habit of employing in making similar articles of furniture. He told H. what he wanted him to do, and H. carried out that design, but not in a way which D. approved, and therefore there were several alterations and various modifications till it was at last approved. Subsequently, without any consent on D.'s part, H. registered the design in his own name, and the question was whether, under the circumstances, he ever was the proprietor, as D. was either the author of the design or was entitled as proprietor, having paid H. for the work he did in carrying it out. It was contended on the part of H. that he was an independent author, and that he supplied things of his own design, and conducted an independent business. Romer, J., in giving judgment, said: "This is a mere question of fact. It is a case where clearly the respondent H. made this desk and sold the desk in the ordinary way of business as a desk; but *prima facie* he was the maker for D. of the desk, and by selling the desk, of course, he did not sell any right to the design. I think H. was the inventor of this design for all substantial purposes, though it is quite possible that the nature or kind of article that was wanted by D. was indicated by him."

§ 119. The normal case to which (2) applies is that referred to by Malins, V.-C., in *Luzurus v. Charles* (o), where he said: "I take it that where a person is engaged in any ornamental business, and has a workman in his employ 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 same case shows the limits within which the claims of persons demanding registration under (3), *i.e.*, as having acquired the design for good consideration, will be allowed.

The plaintiffs had seen a design in a shop in Frankfort, and they entered into a contract with the designer and manu-

(o) (1873) 42 L. J. Ch. 507. 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. And for similar questions arising under the Art Copyright Acts, see *Levi v. Champion* (1887), 3 Times L. R. 286; and *R. Tuck & Sons v. Priester* (1887), L. R. 19 Q. B. D. 48 and (on appeal) 629.

facturer 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 anyone 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 plaintiffs' title."

§ 120. As to (4) a person acquiring the right to apply the design is a proprietor, whether he uses the right exclusively of any other person or otherwise.

In *Nevill v. Bennett (p)*, the plaintiffs had prepared a design for textile goods suitable to the Persian market on materials supplied to them by one Foliadi, a dealer in Constantinople, who, having approved the design, gave the plaintiffs orders which they executed, and they limited the use of that design to Foliadi for the Persian market, although it was their property, and for their sole use as they pleased in any other market. In giving judgment, Hall, V.-C., said: "The defendants say that under these circumstances the plaintiffs are not the proprietors. Now, assuming that Foliadi was the author of the design, it seems to me that for a good and valuable consideration the plaintiffs acquired the right in that design. The design actually printed was the result of the collaboration of Foliadi and the plaintiffs, which resulted in that suitable working practical design, and under those circumstances the plaintiffs did become proprietors of the design under sect. 61 (of the Act of 1883)."

§ 121. Licensees also may be registered as proprietors (*q*), and unless they are so registered they cannot proceed under the Act against infringers (*r*). 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 design to goods manufactured elsewhere.

In *Re Guiterman's Design* (*s*), the sole agent of a foreign firm for the sale of articles of a novel design, who was authorised to apply for registration of the design in his own name, but to whom an assignment of the design or the right to apply the design to goods had not been given, was held not to be the proprietor of the design.

In *Jewitt v. Eckhardt* (*t*), 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.

(*q*) *Jewitt v. Eckhardt* (1878), 8 Ch. Div. 404.

(*r*) *Woolley v. Broad* (1892), 9 R. P. C. 208. But see *Raphael Tuck & Sons v. Canton* (1882), 51 L. J. Q. B. 363, an Art copyright case.

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

(*t*) (1878) L. R. 8 Ch. Div. 404.

§ 122. Under the old Acts it was generally held to be necessary to registration of assignees or licensees that the assignment or license should be in writing (*u*). But the Act of 1883 contained no similar provision to that in the 1842 Act (*v*), which referred in terms to “any writing purporting to be a transfer of such design and signed by the proprietor thereof,” as operating as an “effectual transfer,” and provided a statutory form of transfer for such operations. The rules of 1890 did not insist on the production of a written assignment, and, on the contrary, they contained provisions (*w*) which appear to have contemplated cases where registration of proprietorship might be claimed and effected on other evidence, without the production of any such document. The same observations apply to the new Act and the rules thereunder, which repeat these provisions (*x*).

It may, therefore, be doubted whether the old authorities on this point have any longer any binding effect (*y*), and whether the general rule of the common law, that a parol assignment is sufficient to pass personal property, does not apply in the case of designs (*z*) in the absence of any statutory provision making a writing essential (*u*). It is submitted that a person who has obtained an unregistered design, by gift or otherwise, is not prevented, by the absence of a written transfer, from

(*u*) *Jewitt v. Eckhardt, supra.*

(*v*) Act of 1842, sect. 6.

(*w*) Rules of 1900, Nos. 23 and 29.

(*x*) Rules of 1908, Nos. 46, 48 and 62.

(*y*) The observation of Wright, J., in *Woolley v. Broad* (1892), 9 R. P. C. 208, to the contrary was only *obiter*, and there is no direct decision on the point.

(*z*) Designs are expressly referred to as “personal property,” and they are transmitted and devolve accordingly (Act of 1907, sect. 71 (3)).

(*a*) See Copinger on Copyright (Edit. 1905), p. 142, and the case of *Longman v. Oxberry* (1820) (a patent case) cited in Godson on Patents, p. 314. In *Crossley v. Dixon* (1863), 10 H. L. Cas. 293, it was held that a license to use a patent may be verbal.

applying, under sect. 49, as a person “claiming to be proprietor” for registration of the design.

§ 123. The remedies for infringement given by the Act(*b*) are expressly conferred on “registered proprietors,” and a person who is not registered cannot therefore proceed under the Act(*c*). But it may be doubted whether this would exclude an unregistered proprietor (*e.g.*, an assignee who had not registered his assignment under sect. 52) from obtaining relief other than that specially given by the Act.

Thus, in *Hole v. Bradbury* (*d*), it was held that the plaintiffs, not having been the registered proprietors of the copyright claimed on at the time when the copies complained of as infringements were printed, were not entitled to have them delivered up for their benefit under the 23rd section of the Literary Copyright Act, 1842; but that the Court had power, under its general jurisdiction, to order delivery up for destruction of all articles created in violation of the plaintiffs’ rights. Fry, J., in giving judgment, said: “It must be observed that the words of the section seem to be clear to show that the only person who is entitled to maintain the action of detinue or trover for the copies is a person who is the registered proprietor. That appears from several passages in the section. The very first words which introduce it, ‘all copies of any book wherein there shall be copyright, and of which entry shall have been made in the registry book,’ appear to me, on the face of them, to refer to an entry made in the registry book at the time of the creation of the copies; and then the section goes on throughout to speak of the registered proprietor as the person who is entitled to the right In my judgment the plaintiffs, not having been the registered proprietors at the time of printing this book, are unable to maintain their right to have these copies delivered up to them for their own benefit under the 23rd section. There remains this question: whether there is any authority in the Court, independently of the statute, to cause to be delivered up any copies which may have been printed even to a person who is not the registered proprietor at the time they were printed, simply from the general jurisdiction of the Court to order delivery up for destruction of all articles which have been

(*b*) (1907) Sect. 60.

(*c*) See *Liverpool Brokers’ Assn. v. Commercial Press*, [1897] 2 Q. B. 1.

(*d*) (1879) L. R. 12 Ch. Div. 886.

created in violation of the plaintiffs' rights. It appears to me that there is distinct authority in favour of that view. I find that in the case of *Prince Albert v. Strange* (e), the Court ordered the delivery up of the copies which had been there piratically printed to the Record and Writ clerks for the purpose of destruction; and I find that in the case of *Kelly v. Hodge* (f), which was before Vice-Chancellor James in 1870, before the passing of the Judicature Acts, the Court ordered delivery up to the plaintiffs for the purpose of destruction—a delivery up which could not have been under the 23rd section of the Act, because that section gave an express action at law, and did not enlarge the jurisdiction of the Court at all. I bear in mind, further, the analogy to the numerous cases which have arisen where the defendant has violated either the patent rights of the plaintiff, or the right to the trade mark of the plaintiff, or, as in the case of *Emperor of Austria v. Day* (g), the sovereign rights of the plaintiff. In all these cases the Court has delivered up the copies for destruction."

In *Cooper v. Whittingham* (h), where the action was brought under the Literary Copyright Act, 1842, for "importing for sale," contrary to the provisions of the Act, and an injunction was claimed, Jessel, M.R., said: "There was a point not insisted upon, but mentioned during the course of the argument. It was said that the 17th section of the Act created a new offence of importation, and enacted a particular penalty; and it was argued that where a new offence and a penalty for it had been created by statute, a person proceeding under the statute was confined to the recovery of the penalty, and that nothing else could be asked for. That is true as a general rule, but there are two exceptions. The first of the exceptions is the ancillary remedy in equity by injunction to protect a right The second exception is that created by the Judicature Act, s. 25, sub-s. 8, which enables the Court to grant an injunction in all cases in which it shall appear to the Court to be just or convenient. This section may be said to be a general supplement to all Acts of Parliament."

In *Ihlee v. Henshaw* (i), where a trade mark had been registered by H. & Co., and had subsequently been assigned to I. and then to I. and S., who brought an action to prevent the use of the trade mark without having registered either of the assignments, North, J., said: "I think

(e) 2 De G. & Sm. 652.

(f) (1870) cited Seton, Vol. I. p. 668.

(g) 3 D. F. & J. 217.

(h) (1880) L. R. 15 Ch. Div. 501.

(i) (1886) L. R. 31 Ch. D. 323. And see *Magnolia Metal Co. v. Atlas Co.* (1897), 14 R. P. C. 389.

that the Act contemplated registration from time to time where an assignment took place; but I do not find anything in the words of the Act making such registration of the assignment a condition precedent to the right to sue I cannot, in the absence of a statutory provision to that effect, say that an assignee is not entitled to sue unless not only the trade mark but the assignment also is registered."

§ 124. The above observations and authorities apply equally to licensees, who come within the definition of "proprietors" under sect. 93 of the Act. But there is an additional doubt as to the necessity of a writing in the case of licenses, which is introduced by the wording of sect. 60, which prohibits the application of a design "without the license or *written consent* of the registered proprietor."

In *Griffith v. Hughes (j)* it was held that the words "in writing" in sect. 6 of the Trustee Act, 1888, providing for indemnity to a trustee who has committed a breach of trust, "at the instigation or request or with the consent in writing of a beneficiary," apply only to "consent" and not to "instigation" or "request," and that a trustee who had acted at the instigation of a life tenant, though without any written consent, was entitled to indemnity. Kekewich, J., said: "It is common ground that there is nothing here in writing. It is equally common ground that the payment was made at the request of the married woman who is the beneficiary. Is that request, which was presumably by parol only, no writing having been proved, sufficient to bring the case within the statute? There may be good ground for the distinction between a consent, which is to be given in writing, and an instigation or request which need not be in writing; and seeing that, grammatically, the section will bear the construction which I think ought to be given to it, I hold that the words 'in writing' apply only to consent, and are not applicable to instigation or request."

§ 125. An assignment or license cannot be registered until the original proprietorship has been registered.

In *Jewitt v. Eckhardt (k)*, Jessel, M.R., said: "It would have this very singular consequence if you could. If a license by the author or the sole proprietor of a design be granted before

(j) [1892] 3 Ch. 105.

(k) (1878) L. R. 8 Ch. Div. 404.

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 (of the Act of 1842), and that grant must be in writing."

§ 126. Where the proprietorship is vested in more than one person a license by one will not affect the rights of the others (*l*); but any one or more of the co-proprietors may assign his or their interests in the copyright, and the assignee may register such transfer and maintain an action for infringement of the entire copyright.

In *Lauri v. Renad (m)*, in March, 1879, the brothers L. acquired the dramatic copyright in a French play, and in 1886 two of the brothers died. Subsequently the plaintiff took an assignment from the three surviving brothers L. of all their rights in the play, and in February, 1902, he registered himself as the proprietor of all such rights. The defendants contended, *inter alia*, that the plaintiff had no right to sue, no title having been acquired from all the owners, and the ownership of a copyright in several persons, being a tenancy in common and not a joint tenancy. In giving judgment, Kekewich, J., said: "The title might be good if there was a joint tenancy, in which case the right would survive to the others. But it is not a joint tenancy: that has been finally decided, I think, once for all in the case of *Powell v. Head* before Sir G. Jessel, and it must be considered as now settled law. Registered owners of a copyright are tenants in common, and they are tenants in common of a peculiar kind. It is impossible for us English lawyers dealing with the English language to express our views, except in the technical language of our law; but it is not perhaps accurate even to call such owners tenants in common, and the Master of the Rolls took care not to call them simply tenants in common; he calls them 'tenants in common or part owners.' And there are or may be many differences and distinctions between tenants in common and part owners as regards their

(*l*) *Powell v. Head* (1879), 12 Ch. D. 686.

(*m*) [1892] 3 Ch. 402.

rights *inter se* and in respect of strangers. He not only decided that, but he also expressed a strong opinion 'that one part owner could not either lend or deal with the entirety of the property without the authority of the other part owner.' That at first sight seems to be a blot on the plaintiff's title, but Mr. Warmington's answer to it is, I think, sound. He says: 'We may not have the complete title to the whole property, but we are as part owners, entitled to, at any rate, the three-fourths, taking the assignment as being that of three out of four (and the argument is equally applicable if there were two out of four, or the same number out of five or more), in that character we are entitled to sue as for trespass, to prevent a stranger interfering with our rights—the rights which belong to us, it may be in common with others, for which we may be accountable to others, and which may be possibly to some extent defeated if that stranger can set up a title through others. But so long as we are suing a stranger so long as we are preventing interference with that, of which we are part-owners, we are right and can maintain our action.' That argument proceeds strictly on the analogy of the law from which tenancies in common and part ownership came, and I think it would be departing from an analogy, which is perhaps more strictly applicable than analogies often are, to say that the plaintiff fails on that ground. So far, therefore, I do not think the objection to the plaintiff's motion prevails."

§ 127. On the death of the proprietor, the property in the design, being personal property, goes to his personal representatives, and they become the proprietors. In disputed cases the burden of proving proprietorship is on those who claim it (*n*).

§ 128. It is also to be noted that, though notices of trusts affecting the proprietorship cannot be received by the Comptroller (sect. 66), any document which creates an equitable proprietorship, though not amounting to a legal assignment, may be entered on the register, and will entitle the equitable owner to all the rights (qualified or absolute, as the case may be) of a registered proprietor (*o*); and, by a proviso to sect. 71, it is declared

(*n*) *Hothersall v. Moore* (1892), 9 R. P. C. 27. And see *Re Heinrich's Design* (1891), 9 R. P. C. 73.

(*o*) *Stewart v. Casey* (1892), 9 R. P. C. 9. See also sect. 71.

that any equities in respect of the design may be enforced in like manner as in respect of any personal property.

§ 129. In case of bankruptcy of a registered proprietor, the property in the design passes to his trustee (*p*), and this would probably be the case notwithstanding a transfer of the copyright if the registration were still allowed to stand in the name of the original proprietor (*q*), unless some steps had been taken to take the property out of the "order and disposition" of the bankrupt (*r*). If the design has not been registered, the right to register it also devolves on the trustee, who becomes proprietor under the Act (*s*).

(*p*) Act of 1907, sect. 93 (definition of "Proprietor").

(*q*) *In re Dilworth* (1833), 1 Deac. & C. 411; *Longman v. Tripp* (1805), 12 N. R. 67.

(*r*) See Bankruptcy Act, 1883, s. 44.

(*s*) Act of 1907, sect. 71. Per Jessel, M.R., in *Jewitt v. Eckhardt*, *supra*.

CHAPTER VIII.

MARKING.

(The full references to all the Reports will be found in the Table of Cases ante.)

- § 130. Statutory Requirements as to Marking.
- § 131. Application of the Rules.
- § 132. Differences between the old and repealed Acts and the Act of 1907.
- § 133. Mere Desire and Intention to Mark ineffectual—Proviso in favour of Proprietor taking proper Steps.
- § 134. Illustrative Cases—*Woolley v. Broad*; *Re Rollason's Design, &c.*
- § 135. Failure of Co-proprietor to Mark—*Wedekind v. General Electric Co.*
- § 136. Failure of Licensee to Mark.
- § 137. Wearing out or Removal of Mark—*Fielding v. Hawley.*
- § 138. Method of Marking—Paper-hangings (*Heywood v. Potter*)—Trimmings (*Blank v. Footman*)—Dusters (*Hothersall v. Moore*)—Cuff-links (*Re Morton's Design*).
- § 139. Irregularities in Marking—Addition of other Marks (*Harper v. Wright & Butler*).

§ 130. Before the Act of 1907, every protected design must not only have been registered, but every article to which it was applied must have been marked in order to secure the statutory copyright. By sect. 51 of the Act of 1883 it was 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.*”

This provision still applies to all designs published before the coming into operation of the new Act, as if a copyright has once ceased through neglect of the statutory provisions it cannot afterwards be renewed by any

retrospective operation of the Act (*a*). The Act of 1907, however, modifies the law by providing (*b*) that the only effect of failure to mark copies shall be that—

The proprietor shall *not be entitled to recover any penalty or damages* in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place *after the person guilty thereof knew or had received notice* of the existence of the copyright in the design.

This assimilates the law affecting designs to that applicable to patents, except that the onus of proving knowledge (in the absence of marking) is thrown on the plaintiff. The result of non-marking of copies is no longer forfeiture of the copyright, but only inability to claim the special remedies given by the Act, unless actual knowledge of the existence of the copyright can be proved against the infringer.

The new Act further provides (*c*) that the Board of Trade may, by rules under the Act, dispense with or modify any of the requirements as to marking as regards any class or description of articles, subject to such conditions as they think fit.

§ 131. The old rules (*d*) prescribed that the proprietor should, if the article was included in any of the Classes 1 to 12, cause the article to be marked with the abbreviation “R.”, and if the article was included in Classes 13 or 14 (*e*), cause each such article to be marked with the abbreviation “REG.” On any article in Classes 1 to 12 other than lace the number appearing on the certificate

(*a*) See Act of 1907, sect. 98 (2); and the Copyright cases *Moul v. Groenings*, [1891] 2 Q. B. 443; *Hanfstaengl Art Publishing Co. v. Holloway*, [1893] 2 Q. B. 1; and *Schauer v. Field*, [1893] 1 Ch. 35, decided on the retrospective provisions in the International Copyright Act, 1886.

(*b*) Sect. 54 (1) (b).

(*c*) Sect. 54 (2). The only special provision in this respect in the Rules of 1908 is Rule 68, exempting lace and goods in the Manchester Classes from the general obligation to affix the number as well as the registration mark.

(*d*) Rules of 1893, No. 32.

(*e*) For details of the classes under the new Rules, see *ante*, p. 29.

of registration must also be placed. The Act had to be construed strictly (*f*). But it was decided under it that if an article in Classes 1 to 12 was marked "REG.," the copyright in the design was not lost, inasmuch as the greater included the less (*g*). These provisions have been modified by the new Rules (*gg*), which require that the proprietor of the design shall cause each article to be marked with the word "REGISTERED," or with the abbreviations "REG.," or "R.," as he may choose; but this of course only applies to goods first delivered on sale after the coming into operation of the new Act.

Under the 1883 Act the copyright would be lost, and now the statutory remedies will be stopped for want of marking, even though the sale be made abroad, and though, apparently, the article be also made abroad (*h*). And though but one article be sold without a mark, the same results will follow (*i*). The fact that the proprietor is a foreigner trading abroad, as well as in England, will make no difference (*j*).

§ 132. Under 5 & 6 Vict. c. 100, it was provided that the mark must be upon every article to which the design was applied "after publication" of the design (*jj*). This was modified by the 1883 Act, which provided that the mark must be upon the articles only "before delivery or sale," and the same wording has been preserved in the present Act. 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 earlier Acts, under the present law that action or even the distribution of samples without sale will not cause forfeiture.

(*f*) Per Giffard, V.-C., in *Pierce v. Worth* (1868), 18 L. T. N. S. 710.

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

(*gg*) Rules of 1908, No. 68.

(*h*) *Sarazin v. Hamel* (1863), 32 L. J. Ch. 380.

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

(*j*) *Sarazin v. Hamel*, *supra*.

(*jj*) Sect. 4.

The Act of 1907 further provides expressly (*d*) that the disclosure of a design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design (which would be the case on a mere submission of samples), and, as regards textile designs, even the acceptance of a first and confidential order on goods bearing a new design intended for registration shall not be deemed a publication of the design so as to invalidate the copyright.

§ 133. But mere desire and intention to comply with the Act will not avail, if as a fact the article is delivered on sale unmarked. Nor will the proviso “unless the proprietor shows that he took all proper steps to ensure the marking of the goods” protect, unless proper precautions are taken to secure the order for marking being carried out.

§ 134. The above rules are illustrated by the following cases:—

In *Pierce v. Worth* (*e*), under the old Acts, 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 (*e*). Even the proviso would not protect in such a case.

In *Woolley v. Broad* (*f*), W., the registered proprietor of a lace design, agreed to sell to W. & Co., and did sell, lace manufactured by him 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. It further 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

(*d*) (1907) Sect. 55.

(*e*) (1868) 18 L. T. N. S. 810.

(*f*) (1892) 9 R. P. C. 429.

the finishing operation, otherwise it would be destroyed. And 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.

In *Wittman v. Oppenheim* (g), 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 the error; Pearson, J., decided that the copyright was not lost, and that the proprietor was protected by the proviso, the letters "R^D." being stamped on the article, though the numbers were incorrect.

In *Johnson v. Bailey* (h), 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 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 was 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 was 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," said the Lord Ordinary, "must be judged according to its own special circumstances, and it is in such case a jury question whether the proper steps have been taken."

In *Re Rollason's Design* (i), it was proved that a considerable number of articles to which the design had been applied had been marked with the No. 252,908, instead of No. 232,908, the mistake having originated in a stamping die; but the plaintiff gave evidence to show that he had taken all proper steps to ensure the correct marking of the articles. Held by Kekewich, J., on the hearing of the motion, that the design must be expunged for want of novelty; but, on the other point, that R. had established that he had taken all steps that

(g) (1884) 54 L. J. Ch. 56.

(h) (1893) 11 R. P. C. 21.

(i) (1897) 14 R. P. C. 893, 909; and on appeal to the House of Lords, 15 R. P. C. 44.

could reasonably be required of him to ensure proper marking. Held, on appeal, that the design, being limited to pattern, was novel, and that the decision of the Court below as to the marking was correct; and the order to expunge was therefore reversed. In giving judgment in the Court of Appeal, Lindley, M.R., said: "Then there is the other point about the 51st section, which I had forgotten for a moment. It turns upon a mistake which was made by the die-sinker in putting a 5 for a 3. . . . The learned judge in the Court below thought Mr. Rollason brought himself within the last part of that section. I think so, too. . . . I think his instructions to the die-sinker were quite right. He gave him the proper number and he did not observe the slip. The slip was made in one plate only, out of a great many, and it was corrected as soon as it was discovered. I think it would be very lamentable if we were to hold that sect. 51 did not cure a defect by an unintentional slip such as that." And in the House of Lords a similar view was expressed by Lord Herschell.

§ 135. It is the duty of the proprietor to put the mark upon the article, and this applies, of course, where there are co-proprietors, so that any sale by one of the proprietors of the article without the registration mark would formerly cause forfeiture of the entire copyright and now affect the right to either penalty or damages.

In *Wedekind v. General Electric Co. (k)*, the defendants pleaded that A. and K., by whom the design was originally registered, had, before the assignment of the design to the plaintiff, sold to the defendants a number of telephones of the plaintiff's design and patterns for the purpose of resale by the defendants, which were not marked as prescribed by the Act. They also alleged that the A. Company, of which A. and K. were directors, granted to the defendants a license to manufacture and sell telephones, which were in part made of the plaintiff's patterns and designs, without any stipulation that such telephones should be marked with a mark or figure denoting that the design was registered, and the defendants had, to the knowledge of A. and K., manufactured and sold telephones of such design under this license without any such mark. The defendants contended that, on these facts, the copyright in the design had ceased. Held, by Charles, J., that at least one case was proved of a sale by A. to the defendants of a telephone which was not marked (and pro-

(k) (1897) 14 R. P. C. 190.

bably others by A. and K.), and that in any event this was an act of one of the partners which affected the firm; that it was clear there was acquiescence by both A. and K. in sales by the defendant under the license of unmarked articles; that by such conduct A. and K. had lost their copyright under sect. 51 of the Act, unless they could show that they had taken all proper steps to ensure the marking of the article; that A. and K. had certainly failed to show that; and the action was accordingly dismissed.

§ 136. Under the old Acts the interest of the person who published without the mark was alone affected by the want of marks (*l*). But the Act of 1883 and the present statute contain no such provision, and it is doubtful whether a forfeiture may not be created through the omission of the mark by a licensee who, under sect. 93, comes under the description of "proprietor" within that Act. The better opinion, however, seems to be that the proprietor of the full copyright may claim protection under sect. 54 if he can show that he has taken reasonable steps to secure marking by the licensee notwithstanding any default by the latter (*m*).

§ 137. If the mark be properly placed on an article, the copyright will not be affected though the mark be removed by any person, *e.g.*, a purchaser, not being the proprietor (*n*); nor though the mark has become illegible.

In *Fielding v. Hawley* (*o*) 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 (*p*).

§ 138. The manner in which the mark should be applied sometimes raises difficult questions. The provisions of

(*l*) Act of 1842, sect. 4.

(*m*) Per Charles, J., in *Wedekind v. General Electric Co.*, *supra*.

(*n*) Per Coleridge, J., in *Heywood v. Potter* (1853), 22 L. J. Q. B. 133; *Sarazin v. Hamel* (1863), 32 L. J. Ch. 380.

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

(*p*) See *Johnson v. Bailey* (1893), 11 R. P. C. 21.